

IP COMMITTEE MINUTES
January 10, 2013 (BLS Mid-Year Meeting)
Airport Marriott, Orlando, Florida

I. WELCOME AND INTRODUCTION BY THE CO-VICE CHAIRS

Chair Leora Herrmann welcomed everyone to the meeting. Attendees then introduced themselves.

In attendance were Joshua Brown, Kimberly Bursum, Michael Chesel, Donna Chesteen, Erica Cipparone, Amber Davis, Ava Doppelt, Leslie Evans, Ury Fischer, Leora Herrmann, Lawrence Kunin, Allison Imber, Keith Kanouse, Kyle Kennelly, Robert Kain, Samuel Lewis, Cian O'Brien, Kimra Major-Morris, Doug McDonald, Moish Peltz, Steve Peretz, Joel Rothman, Josh Saltz, Dineen Pashoukos Wasyluk, and special guest Brenda Tadlock, Trademark Buereau Chief, Florida Department of State.

II. OLD BUSINESS

A. Adoption of Meeting Minutes

The minutes of the January 10, 2013 committee meeting were approved by voice acclimation.

B. Legislative Update

(1) Non Compete Statute -- Sam Lewis, *Miami*

Sam Lewis reported that he has reached out to Hal Litchford, but nothing happening at the present. Anti-Trust is taking up the issue at its next meeting later in the day. A section-wide task force was appointed to bring in stakeholders from throughout the BLS. Ava Doppelt will report to Sam Lewis regarding the discussion at the Anti-Trust and Franchising meeting.

(2) CFAA -- Robert Kain, *Fort Lauderdale*

The task force has had several phone calls and is working on analyzing the issue. The task force has agreed that a combined civil and criminal statute will not work. Looked at Florida Computer crimes standpoint and it is completely ineffective from a civil perspective, because you can't sue unless there is a criminal conviction, which is ineffective. The statute also has the same defects as Federal CFAA. The Task Force has some written reports and is continuing to look into possible legislative solutions. The Task Force intends to have a proposal to work with some time in the next year.

(3) Possible Amendments to Public Records Statute, Ury Fischer, *Coral Gables*

Per requests of state entity, reviewing state Public Records Statute to determine whether it makes sense to amend the statute. In Ury Fischer's inquiries, not much interest in taking this issue up, but he will continue to follow up with the state on this.

(4) Possible Legislation re State Ownership of IP – Ava Doppelt, Orlando

In the absence of Stephen Luther, Ava Doppelt reported that their firm, on behalf of a client, is working on a legislative change to the statute on state ownership. Right now, it says unless there is an express statutory exception, all intellectual property is owned by the state, but not clear how it is administered. The legislation does have a sponsor and is moving forward. There is legislation that has been proposed, and Stephen is working with the Legislation Committee and there are sponsors lined up, and has been talking with the Department of State. It's turned out to be a hot issue. This year there probably is going to be a trademark-specific bill for school districts that is not going to go through the BLS, but there is not going to be a broader bill this year.

(5) New Legislative Issues, if any

None. for the committee. Section lobbyist Bill Wiley came in and mentioned a few section-wide pieces of legislation coming up this session: LLC, UCC Assignments for Benefits of Creditors. He reported that pre-filed bills are just starting to come out. There will be a few thousand bills coming up in the next few months. He will flag the bills and send them to the Chair for further dissemination if bills of interest to our Committee are proposed. We need to be able to react promptly so that we can move forward with the process. Bill Wiley noted that there is brand new House and Senate leadership, and for the first time in his memory both the House and Senate Judiciary Committee chairs are not lawyers, so it will be interesting. He asked that he committee members let him know if we have contacts with any prominent members of the Florida House or Senate.

C. Diversity Committee

Carly Johnson was unable to attend the meeting. Josh Brown volunteered to attend the Diversity Committee meeting later today and report back to the Chair.

D. E-Discovery Task Force

There was no report from the task force today.

E. Intellectual Property Certification, Michael Chesel, *Miami*

Michael Chesel reported that there are currently 135 board certified lawyers in FL, 78 of whom applied for recertification. The committee is very busy. Lack of peer review is the biggest obstacle to recertification, particularly for patent prosecution lawyers who have a limited number of clients and don't have a lot of other lawyer to give them peer review. Next exam is in May, and the committee is currently writing it. In all, 14 applicants have been cleared to sit for the exam in May. The standard for passing the exam is being raised across the board for all certification areas, with score on exam required to be 70%.

This year, all of the inaugural committee members will be rotating off, and they need some folks who are not patent folks to serve on the committee. Seeking applicants -- who must be

Board Certified -- to take on a 3 year term for the certification committee. Applications are due next week.

F. Update of IP Pamphlet

The proposed amendments to the IP Pamphlet were circulated, in clean and red lined form. The Chair asked that a patent-specific person take a look at the proposed changes, and that several patent people take a look at it and send edits to her by **February 15** so as to ensure that the changes are comfortable. Justin did a great job, and made the changes on his own. Bob Kain and others will review.

G. IP Committee Blog

Joel is currently hosting the blog and offered to host it as long as necessary. The Committee is in the process of moving the blog to the sections servers. Special thanks to Ury Fischer and Josh Saltz for cleaning up the blog to get it in better shape and get the registration portion up to date. There are listservs that have been used so frequently that people unsubscribe, but so far we have not abused the posting, and need to get more postings. Committee members are encouraged to reach out to Ury if they wish to write a blog posting. Blog postings are indexed by Google and can serve as good marketing.

H. State Trademark Procedures Initiative

Michael Chesel introduced Brenda Tadlock, Bureau Chief, Florida Department of State. Darren Spielman and Mike Chesel have been discussing the issue and trying to get a meeting in Tallahassee but it hasn't happened. Brenda Tadlock is the Bureau Chief that oversees the trademark registration process.

Ms. Tadlock has been with DoS for 30+ years (she started as a secretary!) and has worked her way up. She reported that annually the department issues about 1,233 registrations, and it receives 3 times that many applications. The high rejection rate among TM applications seems to be because they receive a lot from fictitious name registration filers who do not realize there are no rights in registering a fictitious name and are acting *pro se*.

Renewals and assignments are rare. People are not diligent in following up with trademark renewals. Most of those applicants end up doing new applications instead. Current term is 5 years. Most applications are small Mom and Pop entities. Not a lot of applications from trademark attorneys. In her view, it would do the public some justice by making the lawyers more known. The Department of State can't recommend one attorney, but post a list of attorneys willing to do this, that would be helpful for the Department. Following up on this point, Joel Rothman recommended that the issue of providing names for IP attorneys to help could be solved by giving a link to the Board Certified list.

The Department gets a lot of requests for registration of trade names. Ms. Tadlock explained that the Department will reject a Florida mark based on a Federal registration, based on a recommendation from this committee about 20 years ago. She requested that we give some

guidance as to whether that is still the opinion of the committee? A lot of attorneys who have applied argue this point.

Ms. Tadlock also requested that we seek to get the trademark statute amended to include reference to LLCs and other business entities. Currently, the statute states that they department cannot deny a registration based on a corporate name or a fictitious name. Needs to be updated to include LLCs and other business entities to ensure uniformity.

There is no provision at this time in Chapter 495 to correct a pending application. The Department would like to see a procedure to do so in the statutes.

There is also an issue as to whether an applicant has to be registered to do business in Florida in order to own a mark in the state of Florida. If they provide an affidavit that they are not doing business, the Department will let them register.

Chapter 495 has the word "Verify" as to signatures on applications. Does this really mean that it needs to be notarized? Is that something needs to be changed? One of the reasons of rejection is lack of the notarization.

Issue a certificate registration is prima facie evidence of the right to use the mark in the state of Florida. Ms. Tadlock pointed out that the workers in the department do not have a good understanding of the issues of national use. Applicants have argued to the department that it should not be the final arbiter of who has the right to use a Mark. She identified this as another area that could be studied by the Committee.

Ms. Tadlock also raised the issue of disclaimers in trademark registrations -- it depends on who you ask whether you can have a mark if you disclaim each specific element. They will skip a disclaimer rather than rejecting the application, but would like more guidance on this issue.

Signature requirements for who needs to sign what when there is an assignment.

Ury Fischer asked the basis for most rejections, and it has historically been incomplete applications.

DoS is migrating to a new database, and they are hoping to have the trademarks online and available for public review in the future. State does not currently send renewal notices, but it could be possible to set up a system with e-mailing as part of the new database. Would need to change the form to collect e-mail addresses.

Mark Stein recommended that we help create a FAQ for trademark registrations, which Ms. Tadlock was amenable to. He also enquired about rulemaking versus statutory changes, and Brenda states that the DoS is not very receptive to rulemaking. Changes would better come through the statute.

Joel Rothman also suggested that there be a requirement that the trademark lapses if they haven't registered their company annually.

Michael Chesel mentioned that they also want to review whether we can move to a system that requires submission of a drawing of the mark.

Leora Herrmann asked who determines things like accepting a declaration in review of a verification, and she said it is the General Counsel's office would give them approval. His name is Carlos Ray. He's not very well versed in the trademark field, and is kind of new. She would recommend approaching him with a unified list of suggestions.

The committee enthusiastically thanked Brenda for coming to our meeting. Josh Salz and Dineen Wasylik will work with Mark Chesel and Darren Spielman regarding putting together the issues.

III. NEW BUSINESS

A. Networking Events with Law Students

University of Miami group did a networking event in Miami and it went well, and it was a good networking opportunity. The Chair recommended that committee members endeavor to do similar networking events locally and when they do so, let students know they can contact Dineen Wasylik for information on attending the symposium.

B. AIPLA

Ury and Leora will be doing a conference call of chairs of IP committees -- 5-6 Southeastern states. Ury is going to participate as well to ensure continuity. Members were encouraged to attend the AIPLA midwinter meeting in Tampa since it is local and easy to travel to.

C. Malpractice Insurance Issues and the AIA

Doug McDonald reported that in late November, went to the ALAS insurance consortium for large firms patent consultation group. ALAS and the smaller firms are really quite concerned about the potential confusion of running two systems for the next few years. He recommended that everyone contact their docketing system vendor and confirm that it is going to be fully up to date to insert AIA dates on applications that are filed, and when. There is concern that not all systems are being updated promptly to ensure that all the new types of dates are docketed and new time periods are docketed. Insurers are scared to death because of the parallel sets of dates, plus all of the new post-approval procedures. Be sure to train staff as well.

D. Already LLC v. Nike Inc, U.S. Supreme Court, No. 11-982.

Ury Fischer pointed out that the Supreme Court yesterday decided an important case on declaratory judgment jurisdiction in trademark cases, and held that a covenant not to sue will strip the court of declaratory judgment jurisdiction.

IV. 4th ANNUAL IP SYMPOSIUM

Dineen Wasylik encourage everyone to make sure this is on their calendars, and announced that registration for the symposium will be available in the coming week or so. We have a great speaker line up, and well as a committee meeting and good networking opportunities scheduled. We also noted that we have been approached by out-of-state practitioners asking to speak, so the profile of this symposium is growing. We are going to consider whether to apply for CLE from other states for the Fifth Annual Symposium. Also, if anyone is interested in stepping up to lead the Symposium next year, please talk to the Chair.

V. VISIT FROM BLS LEADERSHIP

Brian Gart, Chair, Steph Nagin, Chair-Elect, and Judge Van Northwick, Secretary/Treasurer, briefly attended the meeting. Brian welcomed everyone and invited everyone to attend the Executive Council. They noted that the section has three important legislative initiatives. First, amendments to the LLC statute. There will be a special call January 24, 2013 for the Executive Council to vote with respect to the redraft of 608. Final product is already in bill drafting, and the materials for approval will be available in the coming week for review. Comments need to go to Lou Conti and Brian Gart. Second, amendments to the ABC statute will be brought forward.

Steph Nagin also noted that there is a short presentation on having a mobile app for the Fall Retreat. Annual Retreat is over Labor Day, and it's going to be at the Boca Raton Resort in Boca Raton, Florida.

Judge Van Nortwick asked that we give him a heads' up if we have any planning that will require budgeting.

VI. CLE PRESENTATION

Stephen D. Milbrath, Orlando, and Matthew Horowitz, Miami, both of Allen Dyer Doppelt Milbrath and Gilchrist, P.A. gave a CLE presentation entitled *The Hague Agreement and Patent Treaty Implementaiton Act and Their Likely Impact*. The Bar approved the presentation for 1 hour of General CLE, and also for 1 hour of Business Litigation, Intellectual Property Law, and International Law certification credits. The course number is 1300094N.

VII. ADJOURNMENT

The meeting was adjourned at 10:30 and the Committee members were advised that the next meeting would take place on March 21, 2013 at 3 p.m. at the West Palm Beach Marriott.