

## Focus On

WILLIAM L. ROBERTS

# The FBA's Intellectual Property and Communications Law Section: Strong and Growing Stronger

**INTELLECTUAL PROPERTY, in all its manifestations, is rapidly becoming the backbone of the American economy. Communications law is similarly at the cutting edge of a fundamental technological shift in the way we communicate. Those of us who practice in these areas are fortunate to have vital and challenging legal issues with which we can grapple on a daily basis.**

My goal as chair of the Intellectual Property and Communications Law Section is to help the FBA continue to improve on the high-quality professional association experience it provides to practitioners in these fields. The mission of the Intellectual Property and Communications Law Section is to inform and educate bar members who are interested in these areas of the law and to provide opportunities for professional interaction among private practitioners, the judiciary, and attorneys in the government and academic sectors. In addition, from time to time, the section weighs in on significant developments in the law from the perspective of practicing lawyers in this field.

Currently, the section is about 1,000 members strong, making us one of the larger FBA sections. The membership is geographically diverse, with members in every region of the country. The section serves its members in a variety of ways, which are described below.

### Newsletter

Our section's flagship publication is a quarterly newsletter, *IPC Legal Browser*. We think of this publication largely as a newsletter "by the section, for the section," in the sense that it provides a forum for section members to gain exposure through publishing their ideas and also serves section members' need to stay abreast of developments important to all IP practitioners. Each issue of the newsletter revolves around a theme of interest to section members. The last issue focused on patent reform, and contained a number of excellent articles analyzing the various proposed reforms now working their way through Congress. Our next issue, which is now in production, will feature hot topics in copyright law. Future issues will address trademark, trade secrets, and communications law issues.

The quality of the section's newsletter depends on a reliable flow of quality submissions from our members. The publication provides a valuable opportunity for contributing authors to gain exposure to 1,000 active professionals across the country. I hope you'll consider submitting an article for publication soon. If you are interested, please contact one of our co-editors, Jack Schechter in Boston, at JSchechter@bromsum.com, and Scott Moriarty in Minneapolis, at Tbonelaw@gmail.com.

### Programs

The section sponsors educational programs held regionally as well as nationally. Currently in the works is a program on a topic that has generated controversy both within and outside IP circles: patenting the human gene. This program will explore the legal, social, and ethical implications of patents directed at certain isolated human genes and methods for their use in diagnosis and treatment of disease. We know this will be a lively program and expect to present the program in cooperation with the FBA's Indian Law Section as co-sponsors. A number of other events are on the drawing board, including exploration of a major national event in conjunction with a future FBA annual meeting. Please look for program announcements in your area and try to attend—and bring a colleague as well!

In addition to programs that the section creates, an important role the section can play is to provide support and co-sponsorship for programs on topics related to intellectual property that are presented by FBA chapters. Please consider involving the section in your chapter's next IP-related program. We are happy to serve as a partner and resource in any of a variety of ways.

### Leadership Opportunities

The FBA provides outstanding opportunities for leadership, and the Intellectual Property and Communications Law Section is no exception. There is no crowd at the top in this organization. As section chair, I strive to maintain a flexible approach that is highly responsive to the interests and needs of our membership on a regional and national basis. If you have a good idea for a program or other IP-related event in your region, the section has resources to help make your event happen as well as a network to draw upon for dynamic speakers and organizers. In addition, we

**IPC SECTION** *continued on page 28*

and when it is in actual bona fide use in commerce.

### The Monster in the Closet

So why were all the trademark law practitioners so scared of *Medinol*? After all, shouldn't these practitioners, as a matter of routine procedure, review with their clients all the goods and services listed in an application or registration and confirm bona fide use or bona fide intent? Don't all trademark lawyers have to counsel their clients that trademark law is designed, first and foremost, to protect consumers? Although the three major types of intellectual property are often lumped together, unlike patents and copyrights, which are enumerated rights given to authors and inventors in Article I, § 8 of the U.S. Constitution, trademark law is not enumerated and is derived from the Commerce Clause. Therefore, if the goods or services are not in the stream of interstate commerce, there are no consumers, and the mark is not functioning as a source indicator—the ultimate definition of a trademark. Practitioners may have been uncomfortable with a legal concept of fraud without intent, but *Medinol* served to keep them honest.

### Negligence: The New “Get Out of Jail Free” Card

In *Bose*, the Federal Circuit clearly stated that “[b]y equating ‘should have known’ of the falsity with a subjective intent, the Board erroneously lowered the fraud standard to a simple negligence standard.”<sup>9</sup> Then, citing one of their own previous holdings, the Federal Court went so far as to say that they “even held that ‘a finding that particular conduct amounts to “gross negligence” does not of itself justify an inference of intent to deceive.’”<sup>10</sup> Both these statements beg the question: What is the consequence of negligence? It is apparent that the consequence is not loss of the registration. Obviously, when an inaccurate listing of goods and services is discovered, there is a duty to correct the registration, but beyond that, there does not appear to be any consequence.

Other questions also arise: Where are the checks and balances? Why should a verified statement of use be filed at all if there is no point in diligently crafting the description of goods or services? It has been proposed that in the age of digital photography and electronic filing that an applicant or registrant should be required to supply a specimen for every one of the goods and services listed in an application. This simple change would not be burdensome to either the applicant or the Trademark Office.<sup>11</sup>

In light of the *Bose* decision and the lack of ramifications for filing inaccurate descriptions of goods and services, this sensible idea should be given serious consideration now more than ever. What is to prevent the proverbial “rush to the courthouse” to obtain the benefit of a filing date without worrying about the details until much later? While clarifying and refining the description of goods and services during the prosecution process is often expected, particularly with

certain types of services—such as complex financial products or goods developed as a result of cutting-edge scientific developments—what is to prevent the development of a walk-in clinic for trademark registrations where one can fill out a simple form, pay an attorney a low, flat fee, and file a trademark application? Just don't ask and they won't tell. **TFL**

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### Endnotes

<sup>1</sup>*Medinol Ltd. v. Neuro Vasx Inc.*, 67 U.S.P.Q.2d 1205 (T.T.A.B. 2003) (precedential).

<sup>2</sup>*Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 U.S.P.Q.2d 1483 (Fed. Cir. 1986).

<sup>3</sup>*In re Bose*, 91 U.S.P.Q.2d 1938 (Fed. Cir. 2009).

<sup>4</sup>*Id.* at \*1941 (emphasis added).

<sup>5</sup>*Medinol* at 1205, 1210 (precedential).

<sup>6</sup>Joseph R. Dreitler, *Why the TTAB Got It Right in Medinol*, ALLEN'S TRADEMARK DIGEST, September 2009, at 1.

<sup>7</sup>*Id.*

<sup>8</sup>*Id.*

<sup>9</sup>*In re Bose* at 1940.

<sup>10</sup>*Id.* at 1941.

<sup>11</sup>John L. Welch, *The TTABlog®: TTABlog Comment: Fraud and the Digital Camera* (May 11, 2009), [thettablog.blogspot.com/2009/05/ttablog-comment-fraud-and-digital.html](http://thettablog.blogspot.com/2009/05/ttablog-comment-fraud-and-digital.html).

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### IPC SECTION *continued from page 27*

are constantly on the lookout for new leaders. If you would like to assume a leadership role in presenting an educational program or seek to participate in leadership at the national level, I hope you'll contact me.

### Join the Section!

Finally, if you're reading this issue of *The Federal Lawyer*, which focuses on intellectual property, with interest, then you're a candidate for membership in the section. The cost is minimal and the potential rewards are great—and they become greater as the section's membership grows. In today's economy, professional associations like this one are more valuable than ever. If you're not already a member, I hope you'll join today by contacting the FBA staff at (571) 481-9100!

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