



THE TIPSHEET

State Bar of Texas Intellectual Property Law Section

Vol. 17 No. 1

MESSAGE FROM THE CHAIR



by Joseph F. Cleveland, Jr.

As we attempt to resume our normal lives following the COVID-19 pandemic, I believe it is imperative that lawyers take every opportunity to reconnect in person with our professional colleagues and friends.

According to the latest American Lawyer's Annual Mental Health Survey, when it comes to overall levels of anxiety, depression, and substance abuse, 2021 saw a slight decline compared to 2020 but did not quite drop to pre-pandemic levels. About 35% of respondents said they suffered from depression in 2021. Although that is a decrease from the 37% in 2020, it still is a slight increase from the 31% who said they suffered from depression in 2019.

The survey also found that anxiety levels followed a similar pattern. Anxiety levels were at 67% for 2021, down from the 70.7% reported in 2020 but above the 2019 level of 64%. Overall, the number of respondents who felt mental health and substance abuse in the legal industry were "at crisis levels" was up about 3 percentage points (44%) compared to 2019 (41%) and 2020 (41.7%).

To address the needs of its members, the State Bar of Texas provides resources and solutions for lawyers dealing with substance abuse and mental health issues. The premiere State Bar program is Texas Lawyers' Assistance Program (or TLAP). TLAP provides 24/7 confidential phone support, recommended therapists, support from local peers, funding for treatment, after-care support, and educational programs.

But we must all take the initiative and help each other out by recognizing signs of substance abuse and mental depression and then doing something about it. If you see a colleague in distress, you should visit with that individual privately and really ask how they are doing and offer ways to help. Or, if you observe a lawyer who has violated an ethical standard that raises a substantial fitness question and that lawyer is impaired by drug or alcohol dependency or by mental illness, Rule 8.03 of the Texas Disciplinary Rules of Professional Conduct allows a report to an approved peer assistance program—such as TLAP—rather than reporting to a disciplinary authority. TLAP can then reach out and help.

To learn more, you can receive FOR FREE one (1) hour of legal ethics CLE by clicking on this [link](#) and watching the online program entitled “Just Ask: How We Must Stop Minding our own Business in the Legal World” produced by TexasBarCLE..

The Section is also doing our part to reconnect our members and provide ways in which to have more frequent and healthy personal interactions. In June 2022, the Section held its first in-person annual meeting since the onset of the pandemic. At the annual meeting, we had outstanding MCLE presentations followed by the IP Section luncheon where Kathi Vidal, the recently appointed Director of the USPTO and Hope Shimabuku, the Director of the Texas Regional Office of the USPTO, offered their insights on upcoming issues and initiatives facing the USPTO and the IP bar.

At the annual meeting, the IP Section also recognized Gale R. “Pete” Peterson as this year’s recipient of the Tom Arnold Lifetime Achievement Award. I was honored to receive the Fritz G. Lanham Trademark Award. We also expressed our gratitude to Michael Locklar, the immediate Past Chair, for his long and distinguished service to the Section. Craig Stone received the Chair’s award for his outstanding service to the Section. The IP Section’s Diversity Scholarship was awarded to Jessica Henry attending St. Mary’s University Law School and Nicholas Wang attending The SMU Dedman School of Law. Dr. Corey Clark won this year’s Inventor of the Year Award.

At the annual meeting, members of the IP Section also elected the following slate of officers and new Council members:

2022-2023 Section Officers

Devika Kornbacher, Chair-Elect
Clifford Chance

Craig Stone, Treasurer
Phillips 66

Nick Guinn, Secretary
Gunn, Lee & Cave PC

Erin Choi, Newsletter Officer
Weil, Gotshal & Manges LLP

Julie Bell, Website Officer
Gunn, Lee & Cave PC

2022-2025 Council Members

Christine Pompa
YETI Coolers

Chris Joe
Buether, Joe & Counselors LLC

Carlyn Burton
Osha, Bergman, Watanabe & Burton LLP

I am confident that our recently elected Section Officers and the entire IP Council will provide new and innovative ways in which our members can reach out and reconnect with one another.

For example, last month, members of the IP Section, USPTO personnel, and lawyers from Texas Lawyers and Accountants for the Arts (TALA) participated in the IP Section's Pro Bono Tour. Fifteen lawyers from the IP Section traveled to Laredo and San Antonio to make presentations, participate in group sessions, and offer one-on-one counseling to approximately 75 inventors, small business owners, and entrepreneurs.

And on February 23-24, 2023, we are scheduled to have an in-person Advanced IP CLE program at the Hotel Laura in Houston, Texas. We hope you will plan to attend.

As Ralph Waldo Emerson once wrote, "Go often to the house of thy friend for weeds choke the unused path." During this bar year, let's all commit to making a special effort to reconnect in person with our professional colleagues and friends.

Best regards,

Joe

A handwritten signature in blue ink, appearing to read "Joe Cleveland".

Joseph F. Cleveland, Jr., Chair
Intellectual Property Law Section
State Bar of Texas

OCTOBER 2022 TIPSHEET FEATURED ARTICLES

No Lifeline in Trademark Suit Against “Millionaire” Reading Program

*By: Anna Raimer, Jones Day, Houston and
Nikolas Fotinos, The University of Texas School of Law*

Describing the trademark infringement case as “déjà vu all over again,” on May 10, 2022, the U.S. Court of Appeals for the Fifth Circuit affirmed the summary judgment ruling that a Texas school district’s “millionaire”-themed reading challenge was not likely to cause confusion with a literacy-promotion program. *Springboards to Educ., Inc. v. Pharr-San Juan-Alamo Indep. Sch. Dist.*, 33 F.4th 747 (5th Cir. 2022). Finding the case “materially indistinguishable” from the plaintiff’s suit against another school district in which the Fifth Circuit affirmed dismissal, *Springboards to Education, Inc. v. Houston Independent School District*, 912 F.3d 805 (5th Cir. 2019) (the “HISD Case”), the court reached the same decision in this “functionally identical” case.

In connection with its “Read a Million Words Campaign,” Springboards to Education, Inc. (“Springboards”) sells to school districts reading incentive products that bear the registered marks “Read a Million Words,” “Million Dollar Reader,” “Millionaire Reader,” or “Millionaire’s Reading Club.” In 2016, Springboards sued the Pharr-San Juan-Alamo Independent School District (“PSJA”), alleging various Lanham Act claims based on PSJA’s “millionaire”-themed reading program. The district court granted summary judgment to PSJA and dismissed the case after the Fifth Circuit released a decision in the HISD Case.

In reviewing Springboards’ trademark infringement claim on appeal, the Fifth Circuit focused on the “most foundational threshold inquiry” of “whether PSJA’s use of Springboards’ marks was ‘likely to cause confusion[] . . . mistake, or to deceive’ in the first place.” In doing so, the court noted that it need not parse the eight likelihood of confusion factors because “the practical effect of any conceivable confusion on the sophisticated school districts to which Springboards markets its products is at most exceedingly remote.” Not only are “millionaire”-themed goods and reading challenges widespread in the educational space, such that distinguishing between such goods is not difficult, but there was no evidence that PSJA’s use of “words and phrases bearing abstract similarity to Springboards’ marks” confuses Springboards’ target purchasers of sophisticated school districts. Indeed, Springboards did not even allege that PSJA is in the business of competing with Springboards by selling its own products to Springboards’ customer base, making actual confusion highly unlikely. Therefore, the court concluded that no reasonable jury could find a likelihood of confusion: “sophisticated school-district customers can tell the difference between goods Springboards is selling them and goods and slogans PSJA is not.”

The Fifth Circuit also dispatched Springboards’ remaining Lanham Act claims. As trademark counterfeiting and false designation of origin require a threshold showing of likelihood of confusion, those claims failed. Springboards’ marks also did not have the requisite fame—being

“widely recognized by the general consuming public of the United States”—for trademark dilution.

The views and opinions set forth herein are the personal views or opinions of the authors; they do not necessarily reflect views or opinions of the law firm or university with which they are each associated or any clients.

IP Section Completes Another Successful Pro Bono Tour

By: Kim Boyle

“I am responsible to assure that all persons have access to competent representation regardless of wealth or position in life. . . .I commit myself to an adequate and effective pro bono program.”

The Texas Lawyer’s Creed, A Mandate For Professionalism, Promulgated by The Supreme Court of Texas and the Court of Criminal Appeals November 7, 1989

Over the last five years, the IP Section and the USPTO have held Pro Bono Tour workshops at local colleges and universities—from the Texas Gulf Coast to the Rio Grande Valley and from far West Texas to East Texas. The IP Section has offered this free program to 500+ stakeholders in Corpus Christi, McAllen, Fort Worth, El Paso, Waco, Nacogdoches, Lubbock, Odessa, and Alpine.

Continuing to build on the program originally developed by Hope Shimabuku, in September 2022 Section Chair Joe Cleveland led members of the IP Section, USPTO personnel, a 3L from SMU, and lawyers from Texas Lawyers and Accountants for the Arts (TALA) for the 10th and 11th session of the Pro Bono Tour to Laredo and San Antonio. Fifteen lawyers from the IP Section traveled to these underserved communities and were hosted by Texas A&M International University, UT San Antonio, Randolph-Brooks Federal Credit Union, and Small Business Development Centers (SBDC) where they served approximately 75 inventors, small business owners and entrepreneurs.

With opening remarks each day from Joe Cleveland, Chair, State Bar of Texas IP Section; Hope Shimabuku, Regional Director USPTO; and Allissa McCain, Executive Director, TALA, the workshop continued with general IP, patent, trademark, and copyright overviews presented by IP Section member attorneys.

Then, following remote presentations from USPTO colleagues that walked attendees through prior art searching and patent and trademark applications, the team hosted breakout group discussions in four tracks: software, mechanical/electrical, consumer products, and art/music. To finish each day-long event, attendees were able to meet with individual attorneys for one-on-one guidance. In Laredo, Telemundo interviewed Joe and Hope and the workshop was featured on a Telemundo newscast.

The following IP attorneys, law students, and USPTO personnel participated:

Justen Barks—Beard & Barks, PLLC (Houston)

Julie Bell—Gunn, Lee & Cave (San Antonio)

Rodney Beard—Beard & Barks, PLLC (Houston)

Kim Boyle—Richard Law Group (Dallas)

Joe Cleveland—Brackett & Ellis (Fort Worth)

Brandon Cook—Gunn, Lee & Cave (San Antonio)

Angelique McCall Ditty—Brackett & Ellis (Fort Worth)

Kirby Drake—Kirby Drake Law (Dallas)

Herb Hammond—Holland & Knight (Dallas)

David Henry—Munck Wilson Mandala (Waco)

Megan Hoyt—HomeVestors (Dallas)

Alissa McCain—Texas Accountants and Lawyers for the Arts (Austin)

Iris Mok—Intel Corporation (Austin)

Hope Shimabuku—Director of the Texas Regional United States Patent and Trademark Office (Dallas)

Porter Thames—Southern Methodist University School of Law (Dallas)

Reynaldo Vasquez—Regional Outreach Officer, Texas Regional United States Patent and Trademark Office (Dallas)

Wei Wu— Grable Martin Fulton PLLC (Dallas)

To understand the impact the Pro Bono Tour has, the excellent reviews and words of gratitude from observers, attendees, and hosts alike say it all:

“What a tremendous level of resources and knowledge were shared, all in support of the small business/entrepreneurial community. Words cannot adequately express the value of the contributions each one of you made to the stimulation of thought and innovation in our economy.” *Mary Peters, Associate Director of Operations for the Texas South-West Small Business Development Center (SBDC) at the UTSA Institute for Economic Development*

“I was delighted to hear all the positive feedback from your audience Friday afternoon. You guys really knocked it out of the ballpark!” *Novie Allen, Business Lending Development Officer, RBFCU Commercial Lending*

“Loved the event! Very informative and enlightening. A great way for small business owners to get in front of lawyers where some of us may have little to no knowledge of the legal aspect of a business. A great way for us to help prevent major headaches down the road. You don't know what you don't know but that will be your biggest liability.” *Attendee*

“In law school, we get a feel for how to analyze the law and think like a lawyer. And law school essays require us to unload any potentially relevant information to a given legal

situation. But our time in law schools fails to show how law is commonly practiced. Observing the presentations as well as our breakout group showed me how experienced, successful attorneys counsel clients. *William "Porter" Thames, J.D. Candidate, May 2023, Science & Technology Law Review, Articles Editor, SMU Dedman School of Law*

And what does that mean for the participants? The positive comments are gratifying, and there is something really special about collaborating with colleagues, sharing knowledge, and knowing you are reaching communities that may not otherwise have ready access to the guidance provided, and – as Hope Shimabuku says “spur[ring] the innovators, artists, and business owners/entrepreneurs in Texas.”

The IP Section is already planning the next Pro Bono Tour, and welcomes Section members to be a part of this positive professional experience to give back to our community in such a uniquely significant way. To join the IP Section, please visit [Join Us – Intellectual Property \(texasbariplaw.org\)](http://Join Us – Intellectual Property (texasbariplaw.org)) or contact Joe Cleveland at jcleveland@belaw.com.



IP Section Pro Bono Tour at TAMIU (Laredo)



Joe Cleveland at the IP Section Pro Bono Tour at RBFCU (San Antonio)



Hope Shimabuku at the IP Section Pro Bono Tour at RBFCU (San Antonio)

UPCOMING EVENTS

- October 20, 2022 Society of Women Engineers World Conference, Houston, Texas
- February 23-24, 2023 Advanced IP CLE, Hotel Laura, Houston, Texas
- June 22-23, 2023 IP Section Annual Meeting, JW Marriott, Austin, Texas

ANNOUNCEMENTS

- **TIPLJ:** The last issue of TIPLJ was published as Volume 30, Issue 2, which was released in late spring of this year. More information about that issue can be found online at tiplj.org. The TIPLJ staff is hard at work selecting and editing articles for Volume 31, Issue 1, which is tentatively assigned a publication date of November 30. Volume 31, Issue 2 should release in May 2023, and the staff has begun early planning to have a Volume 31 summer issue release in August 2023.

2022-2023 IP SECTION COUNCIL & COMMITTEE CHAIRS

The council members for the Section were elected at the Annual Meeting last summer. In addition, much of the Section’s work is performed by committees, which help carry out its mission of educating, connecting, and serving the Section’s members. The council members and committee chairs are as follows:

NAME	POSITION	EMAIL
Joseph F. Cleveland, Jr.	Chair	Jcleveland@belaw.com
Michael Locklar	Past Chair	mlocklar@ewingjones.com
Devika Kornbacher	Chair-Elect	devika.kornbacher@cliffordchance.com
Thomas Kelton	Vice Chair	Thomas.Kelton@haynesboone.com
Craig Stone	Treasurer and liaison to Trademark Committee	Craig.Stone@p66.com
Nick Guinn	Secretary and liaison to Patent Committee	nguinn@gunn-lee.com
Erin M. Choi	Newsletter Officer	Erin.Choi@weil.com
Julie Bell	Website Officer	Julie.Bell@Gunn-Lee.com
Yocel Alonso	Council Member and liaison to Copyright Committee	yocel@alonsolaw.com
Marylauren Ilagan	Council Member and liaison to Public Relations Committee	marylauren.ilagan@gmail.com
George W. Jordan, III	Council Member and liaison to Diversity Committee	George.jordan@nortonrosefulbright.com
Michael Smith	Council Member and liaison to Texas IP Journal Committee	Michael.Smith@solidcounsel.com
Austin Teng	Council Member and liaison to Trade Secret Committee	austin.teng@kirkland.com
Saurabh Vishnubhakat	Council Member and liaison to Membership Committee	saurabh.vishnubhakat@yu.edu
Christine Pompa	Council Member and liaison to New Lawyers Committee	christine.pompa@yeti.com
Chris Joe	Council Member and liaison to Diversity Committee	Chris.Joe@BJCIPLaw.com
Carlyn Burton	Council Member and liaison to Women in IP Committee	burton@obwbip.com
Hope Shimabuku	Ex Officio	Hope.Shimabuku@USPTO.GOV
Justen Barks	Copyright Committee Chair	jbarks@beardandbarks.com

NAME	POSITION	EMAIL
Roshan Mansinghani	Patent Committee Chair	roshan@unifiedpatents.com
Kim Boyle / Jered Matthyse	Trademark Committee Chair	kim@richardlawgroup.com jmatthyse@pirkeybarber.com
Tim Hudson	Trade Secret Committee Chair	Tim.Hudson@btlaw.com
Mackenzie Martin	New Lawyers Committee Chair	Mackenzie.martin@bakermckenzie.com
Niky Bagley	Diversity Committee Chair	NBagley@coleschotz.com
Kat Li	Texas IP Law Journal Committee Chair	kat.li@kirkland.com
Stephanie Dowdy	Public Relations Chair	stephanie.Dowdy@terumobct.com
Mary Scott	SBOT Board Advisor	mscott@texasbar.com
Tracy Nuckols	Director, SBOT Sections	Tracy.Nuckols@TEXASBAR.COM

CALL FOR TIPSHEET SUBMISSIONS

The TIPSHEET welcomes the submission of articles for potential publication in upcoming issues, as well as any information regarding IP-related meetings and CLE events. If you are interested in submitting an article to be considered for publication or adding an event to the calendar, please email erin.choi@weil.com (Subject: SBOT Tipsheet Submission).

Article Submission Guidelines

STYLE: Journalistic, such as a magazine article, in contrast to scholarly, such as a law review article. We want articles that are current, interesting, enjoyable to read, and based on your opinion or analysis.

LENGTH: We accept a wide range of articles, with most falling into the 500-2500 word range.

FOOTNOTES AND ENDNOTES: Please use internal citations.

PERSONAL INFO: Please provide a one-paragraph bio and a photograph, or approval to use a photo from your company or firm website.

If you have any questions, please email erin.choi@weil.com.