

Sunshine law: Assessing Florida's approach to IP

Area attorneys mixed on whether certification would work up here

BY JOYCE PELLINO CRANE
SPECIAL TO THE JOURNAL

John Steele calls it bizarre. **Randy Pritzker** thinks the idea has merit — but he wouldn't suggest Massachusetts go along with it.

The Florida Bar's recent move to offer certification for attorneys who practice intellectual property law is meeting with mixed reviews among area IP attorneys.

By becoming the first state in the nation to offer the optional certification, Florida is sifting for lawyers with high-level technical backgrounds who deeply understand patent, trademark, and copyright law, said **Lisa Garcia**, a spokeswoman for the **Florida Bar Board of Legal Specialization and Education**.

"The standards of the Supreme Court say this program is being approved to help the public identify qualified specialists," she said.

Garcia said IP lawyers are not required to become certified, but are being given an option to strengthen their IP qualifications. Applicants will take the state exam on Oct. 1.

Steele, special counsel to Boston-based **Fish & Richardson PC**, said the notion "that Florida would be certifying intellectual property lawyers on matters of federal law seems bizarre."

Steele said a "huge chunk" of IP law falls strictly under federal jurisdiction, making Florida's designation for an IP patent specialist ambiguous.

"They're going to be certifying people in an area where they have zero

jurisdiction and zero expertise," said Steele. "So there's a real danger that the Florida Bar will be confusing consumers."

Peter D. McDermott, co-chairman of the business law section at the **Massachusetts Bar Association**, also expressed concern over consumer confusion, but for different reasons.

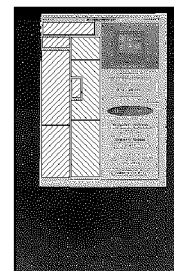
"It is as likely to be misleading as it is to be useful," he said. "More than any other area of the law, intellectual property law has subspecialties, so intellectual property lawyers practicing one area of IP law may not have expertise in any other sub areas."

McDermott said there's been no discussion of certifying IP lawyers in Massachusetts — which, incidentally, has no continuing education requirements for lawyers.

Under Florida's newly adopted system, only board-certified lawyers are permitted to identify themselves as "specialists" or "experts." It also comes with a laundry list of requirements for certification — covering such things as the extent of patent-prosecution experience and continuing education.

While he doubts such a certification program would ever get implemented in Massachusetts, **Gene Feher**, a member of the intellectual property section at **Mintz Levin Cohn Ferris Glovsky and Popeo PC** in Boston, said its purpose could be useful to patent litigators like himself, who have seen a proliferation of cases in recent years.

Between 2001 and 2006, the number



of IP-related cases exploded nationwide from a total of 8,434 to 12,038, according to the **Administrative Office of the U.S. Courts** — a 43 percent jump.

That trend, he said, has resulted in occasional courtroom face-offs between highly qualified, technically knowledgeable IP lawyers with engineering or science backgrounds, and general practitioners who dabble. The results can be detrimental to clients who may not understand what qualifications to seek when hiring an attorney.



Pritzker: It's a potential burden

“If you have a general practice lawyer out there who’s dabbling in patent litigation,” said Feher, “he or she may not have the technical background to sufficiently understand the strengths or weaknesses of his or her case, and that inefficiency can get in the way of resolving the case.”

Randy Pritzker, chairman of the electrical and computer technologies patent practice at **Wolf Greenfield & Sacks**, also sees value in a certification pro-

gram. The boutique IP law firm has been practicing patent, copyright, and trademark law in Boston since 1927 and today employs about 80 lawyers and technology professionals.

“I favor it but I hesitate to recommend it,” Pritzker said of Florida’s IP certification effort. “It will be burdensome for many of us who deserve the certification. But I think the policy behind the rule change is a good idea.”

Pritzker noted that lawyers qualified to prosecute patents are currently required to pass a patent bar administered by the U.S. Patent Office. But that qualification covers only one narrow area of IP law, he said, and the host of other IP services require no defining test of a lawyer’s understanding and knowledge.

Because IP is such a specialized area that requires expertise, unless an attorney keeps current with frequently changing laws and rules, “you can do your client a disservice and lose IP rights that they are entitled to. We have seen it happen far too frequently when those who don’t have the appropriate level of IP expertise dabble in that area.” he said.