



THE TIPSHEET

State Bar of Texas Intellectual Property Law Section

Vol. 18 No. 2

MESSAGE FROM THE CHAIR



Hi All,

I hope you had a chance to relax and enjoy Thanksgiving. It's often said, but we work so hard that the holidays can sometimes feel like an interruption. No matter your situation, I wish you a wonderful holiday season.

As 2025 approaches, many of us are working towards professional goals with deadlines at the end of December. Keep pushing – you've accomplished so much before, and you'll do it again this year.

Looking ahead, our next major event is the Advanced Intellectual Property Law and Intellectual Property Litigation courses, which will be held as a live webcast on February 20-21, 2025. The sessions will offer valuable insights on trademark protection, IP licensing, technology transfer, and more. I hope you can join us.

Wishing you a fantastic end to your year.

Thomas Kelton, Chair
Intellectual Property Section, State Bar of Texas

Naterra International, Inc. v. Bensalam

A Case Summary by: Joshua H. (“Josh”) Gold-Quiros

Texas-based company Naterra International, Inc., owner of several registrations for its BABY MAGIC mark, recently celebrated the outcome of a Federal Circuit appeal that breathed life into its cancellation petition against Miami-based Samah Bensalem, who owns a trademark registration for BABIES’ MAGIC TEA that Naterra alleges is confusingly similar to its mark.

The Federal Circuit vacated and remanded a decision by the Trademark Trial and Appeal Board (“TTAB”) denying Naterra’s petition for cancellation of Bensalem’s BABIES’ MAGIC TEA trademark registration based on a likelihood of confusion with Naterra’s BABY MAGIC mark. Bensalam’s mark was registered in connection with medicated tea for babies, while Naterra’s trademark registrations cover a variety of baby-related toiletry goods. Naterra appealed the denial, alleging that the TTAB’s likelihood of confusion analysis was unsupported by substantial evidence and improperly weighed the relevant *DuPont* factors. The Federal Circuit agreed, vacating the decision and remanding in part on both points.

First, the Federal Circuit held that it could not discern whether the TTAB considered testimony that third-party companies sell both types of goods within its analysis under the second *DuPont* factor, which considers the similarity and nature of the goods in question. Under the third *DuPont* factor, which weighs the similarity of trade channels, the Federal Circuit found that the TTAB failed to address Bensalem’s admission that “both parties utilize similar channels of trade” and did not identify any evidence showing a lack of similarity in trade channels.

Then, the Federal Circuit held that the TTAB erred in failing to weigh the first *DuPont* factor heavily in favor of a likelihood of confusion despite its finding that the marks were “more similar than dissimilar.” Finally, the Federal Circuit considered Naterra’s argument that greater weight should be given to the fame of its mark under the fifth *DuPont* factor, but concluded that the TTAB did not err because fame was not unquestionably established.

Naterra Int’l, Inc. v. Bensalam (Fed. Cir. Feb. 15, 2024) (Moore, Stoll, Cunningham) (on appeal from the Trademark Trial and Appeal Board) [LIKELIHOOD OF CONFUSION]

Joshua H. (“Josh”) Gold-Quiros is an associate with Jones Day. His practice focuses on managing domestic and international trademark portfolios and counseling clients on the use and enforcement of trademarks and other intellectual property rights in the United States and abroad. Josh can be reached at 832.239.3770 or jgoldquiros@jonesday.com.

IP Section Successfully Completes its Military Veterans Pro Bono Tour

“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*

By: Joe Cleveland and Kirby Drake

Over the last six 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 Pro Bono Tour is a state-wide program to provide educational workshops on how to protect the intellectual capital of small business owners, entrepreneurs, and inventors located in underserved communities throughout Texas. The IP Section has offered this free program to 700+ stakeholders in Corpus Christi, McAllen, Fort Worth, El Paso, Waco, Nacogdoches, Lubbock, Odessa, Alpine, and Laredo.

In October 2024, 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. 11 lawyers from the IP Section traveled to underserved military veteran communities in South-West Texas to serve approximately 68 inventors, small business owners, and entrepreneurs.

In Corpus Christi, the Pro Bono Tour was hosted by Texas A&M University’s Coastal Bend Business Innovation Center. In San Antonio, the Pro Bono Tour was hosted by the Good Samaritan Veterans Outreach & Transition Center, the Texas South-West Small Business Development Centers (SBDC) Network, and the University of Texas at San Antonio (UTSA).

With opening remarks each day from Kirby Drake, Past Chair, State Bar of Texas IP Section, and Hope Shimabuku, Regional Director USPTO, 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 preparation of 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.

The following IP attorneys and USPTO personnel participated:

Court Allen—Pizarro Allen (San Antonio)

Justen Barks – Barks Law (Houston)

Jacob Choi - Regional Assistant Director of the Texas Regional United States Patent and Trademark Office (Dallas)

Kirby Drake—Kirby Drake Law (Dallas)

Dr. Shubha Ghosh—Syracuse University College of Law (Houston)

Rachel Greene—Greene IP (Houston)

Herb Hammond—Holland & Knight (Dallas)

Chris Joe—Buether, Joe & Counselors (Dallas)

Shirazi Jaleel-Khan—LZ Legal Services (Houston)

Ken Kula - Buether, Joe & Counselors (Dallas)

Derrick Pizarro—Pizarro Allen (San Antonio)

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



The Intellectual Property Workshop at the Good Samaritan Veterans Outreach & Transition Center

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:

An “enriching experience.”

The presenters’ “expertise and dedication to helping others protect their intellectual capital made the event a success.”

“This event brought together passionate entrepreneurs, inventors, and artists eager to learn about the essentials of intellectual property law. It was a day filled with knowledge, inspiration, and community engagement!”

And what does that mean for the participants? 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 that is provided in such a unique way, 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://texasbariplaw.org) or contact Joe Cleveland at jcleveland@belaw.com.

Joe Cleveland is a Director/Shareholder with Brackett & Ellis, P.C.. His practice includes a broad range of complex commercial litigation involving patent, copyright, trademark, trade secrets, antitrust, contracts, employment, oil and gas, securities, and other commercial matters. He can be reached at 817.339.2454 and jcleveland@belaw.com.

Kirby Drake is the Founding Partner of Kirby Drake law. With a special focus on the patent process, as she is a registered patent attorney, Kirby's practice helps clients successfully navigate their intellectual property challenges. She can be reached at 972.635.0531 and kirby@kirbydrakelaw.com.

2024 Diversity Scholarship Recipients

The Intellectual Property Law Section of the State Bar of Texas (IP Law Section) awarded three \$5,000 scholarships at the Annual Meeting in June. The 2024 law student recipients were:

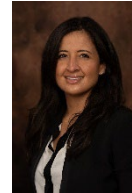
Dawit Tegbaru
UNT Dallas College of Law
2E



Dawit is a rising third-year evening student at UNT Dallas College of Law, with interests in transactional and intellectual property law. He is Director of Community Publishing Services at Knowledge Futures Group, and has had internships at the 5th District Court of Appeals and the Dallas Free Press, where he focused on nonprofit law.

At UNT Dallas College of Law, Dawit has been active in its Intellectual Property Society, serving as Vice President and Secretary, and is a member of the Black Law Students Association. He holds a B.A. in Global Affairs from George Mason University, where he graduated magna cum laude.

Maryam Nasizadeh
South Texas College of Law
2L



Maryam attends South Texas College of Law Houston and will graduate in December 2025. She has a Master of Science in Subsurface Geoscience from Rice University and a Bachelor of Science in Geology with a Minor in Global Energy Management from the University of Houston. Maryam serves as the Secretary of the Intellectual Property and Technology Law Society and as a Pupil at the Nancy F. Atlas Intellectual Property Inn of Court. Before pursuing law, she spent seven years as a geologist.

As an immigrant who moved to the USA at the age of five, Maryam's dedication to volunteering is deeply personal and played a significant role in her decision to study law. Maryam has clerked at Liskow & Lewis APLC and also served as a Judicial Clerk for The Honorable Dedra Davis at the 270th District Court.

Moriah Bisewski
University of Houston Law Center
3L



Moriah joined Fletcher Yoder in July 2017 as a technical advisor, where she worked part-time through law school as a patent agent. Moriah graduated from the University of Houston Law Center (UHLC) in May 2024, and will continue her employment with Fletcher Yoder after the summer.

Moriah graduated cum laude from the University of Houston in 2017 with a Bachelor of Science in Electrical Engineering and previously worked in the electrical reliability engineering departments of Marathon Petroleum Corporation and INEOS. She is an active IEEE member and has previously served as vice-chair of the IEEE Houston Section, and regularly presents to non-profit groups about intellectual property and mentors young engineers in their early careers. These efforts, among others, were celebrated when she was awarded the 2018 IEEE Region 5 Outstanding Young Professional award.

ANNOUNCEMENTS AND UPCOMING EVENTS

Intellectual Property Litigation and Advanced Intellectual Property Law Annual Courses: The IP Section in partnership with TexasBarCLE will present its annual Intellectual Property Litigation and Advanced Intellectual Property Law courses via live webcast on February 19-21, 2025. A webcast replay of the Intellectual Property Litigation course will occur on March 12, 2025 and the Advanced Intellectual Property Law course on March 13-14, 2025. The Intellectual Property Litigation course provides 6.5 hours of CLE credit (1 hour of Ethics CLE) and the Advanced Intellectual Property Law Annual Course provides 13 hours of CLE credit (2.75 hours of Ethics CLE). Visit TexasBarCLE.com for more information and to register for these courses.

Inventor of the Year: Nominations are now being accepted for the IP Section's Inventor of the Year Award. The Inventor of the Year award honors a recipient whose invention(s) has significantly impacted the Texas or U.S. economy. Nominees must have at least one United States patent, either expired or existing. The nomination form is available online at www.texasbariplaw.org/awards, and can be submitted via email to Stephanie Dowdy at sraines21@hotmail.com. All nominations are due by April 25, 2025, and the 2025 Texas Inventor of the Year will be recognized at the Annual Meeting of the State Bar of Texas in San Antonio on June 19-20, 2025.

Fritz Lanham Annual Trademark Award: Nominations are now being accepted for the IP Section's 2025 Fritz Lanham Trademark Award (formerly the Annual Trademark Award). The purpose of the award is to recognize lawyers and businesses for their accomplishments on brand-related projects. Attorney nominees must be licensed in Texas. If a business or brand team is nominated, the company should have a headquarters or significant business operations based in Texas. Additional requirements and the nomination form are available online at www.texasbariplaw.org/awards, and can be submitted via email to jmatthysse@pirkeybarber.com and shiro.jaleelkhan@gmail.com. The 2025 Fritz Lanham Trademark Award will be recognized at the Annual Meeting of the State Bar of Texas in San Antonio on June 19-20, 2025.

2025 Diversity Scholarship Applications: The application process is expected to open in January 2025 and more details will be provided in the Tipsheet edition planned for publication in the first quarter of 2025. The purpose of the scholarships is to encourage law students who have not traditionally been represented in Intellectual Property practice to enter the Intellectual Property profession in Texas by providing financial assistance to help defray the expenses of a law-school education.

Selection criteria and more details are available online at www.texasbariplaw.org, and additional questions can be directed to Juanita DeLoach at juanita.deloach@btlaw.com and Marylauren Ilagan at marylauren.ilagan@olaplex.com.

2024–2025 IP SECTION OFFICERS & COUNCIL

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
Thomas Kelton	Chair	Thomas@fogartyip.com
Devika Kornbacher	Past Chair	devika.kornbacher@cliffordchance.com
Craig Stone	Chair-Elect	Craig.Stone@p66.com
Nick Guinn	Vice Chair	nick@gunn-lee.com
Michael Smith	Treasurer and liaison to Texas IP Journal Committee	Michael.Smith@solidcounsel.com
Marylauren Ilagan	Secretary and liaison to Diversity Committee	marylauren.ilagan@olaplex.com
Kim Boyle	Newsletter Officer	kim@richardlawgroup.com
Roshan Mansinghani	Website Officer	Roshan@unifiedpatents.com
Austin Teng	Council Member and liaison to Trade Secret Committee	Austin.teng@kirkland.com
Christine Pompa	Council Member and liaison to Trademark Committee	christine.pompa@yeti.com
Chris Joe	Council Member and liaison to Public Relations Committee	Chris.Joe@BJCIPLaw.com
Carlyn Burton	Council Member and liaison to Women in IP Committee	burton@obwbip.com

Mackenzie Martin	Council Member and liaison to New Lawyers Committee	mackenzie.martin@bakermckenzie.com
Elise Selinger	Council Member and liaison to Membership Committee	elise.selinger@cat.com
Justen Barks	Council Member and liaison to Copyright Committee	justen@beardandbarks.com
Julie Bell	Council Member	Julie.bell@gunn-lee.com
Jayne Piana	Council Member	jpiana@brownrudnick.com
Hope Shimabuku	Ex Officio	Hope.Shimabuku@USPTO.gov
Anna Raimer	Copyright Committee Co-Chair	Aeraimer@jonesday.com
Aly Dossa	Copyright Committee Co-Chair	aly.dossa@chamberlainlaw.com
Jered Matthyse	Trademark Committee Co-Chair	jmatthyse@pirkeybarber.com
Shiro Jaleel-Khan	Trademark Committee Co-Chair	shiro.jaleelkhan@gmail.com
Tim Hudson	Trade Secret Committee Chair	tim.hudson@btlaw.com
Beth Knuppel	Patent Committee Chair	beth.knuppel@kirkland.com
Stephanie Dowdy	Public Relations Committee Chair	stephanie.dowdy@terumbobct.com
Rachel Greene	Women in IP Committee Co-Chair	rachel@greeneip.com

Nik Sallie	Women in IP Committee Co-Chair	nrsallie@gmail.com
Niky Bagely	Diversity Committee Co- Chair	niky.bagley@toyota.com
Juanita DeLoach	Diversity Committee Co- Chair	juanita.deloach@btlaw.com
Max Metzler	Membership Committee Co- Chair	max.metzler@ericsson.com
Megan Luh	Membership Committee Co- Chair	mluh@porterhedges.com

CALL FOR 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 kim@richardlawgroup.com.

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 kim@richardlawgroup.com.