

# AGENDA ITEM

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Proposed New Specialty in  
Trademark Law and  
Appointment of Consulting  
Group

**DATE:** June 25, 2010

**TO:** Members, Board of Governors  
Members, Board Committee on Member Involvement Relations & Services

**FROM:** Stafford Matthews, Chair, Board of Legal Specialization  
Gayle Murphy, Senior Executive, Admissions

**SUBJECT: PROPOSED NEW SPECIALTY IN TRADEMARK LAW AND  
APPOINTMENT OF CONSULTING GROUP**

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## EXECUTIVE SUMMARY

The Board of Legal Specialization (BLS) requests that the Board Committee on Member Involvement Relations & Services recommend that the Board of Governors create a consulting group to develop standards for certification in the area of trademark law.

The Legal Specialization program is a self-funded Supreme Court approved method of certifying attorneys as specialists in particular areas of law. Formal certification protects the public by regulating advertising of special skills by attorneys to assure that such claims are not misleading to the public. The BLS administers the program, and, as stated in the program rules, one of its duties is to propose additional fields of law to be added to the program.

Based on a request from practitioners in the area of trademark law, the BLS is recommending the creation of a consulting group to develop standards for a new specialty in that field. This is the first step in the process to consider whether specialization certification in this particular field should be made available.

For questions on this item, please contact Gayle Murphy at [gayle.murphy@calbar.ca.gov](mailto:gayle.murphy@calbar.ca.gov) or (415) 538-2322.

## BACKGROUND

The Legal Specialization program is a Supreme Court approved method of certifying attorneys as specialists in particular areas of law. Certification validates an attorney's specialty through testing, completion of rigorous task and experience requirements, and peer review by fellow attorneys and bench officers. That validation process serves two important needs: 1) improving the level of practice for attorneys who participate in the certification

program, and 2) assisting consumers in identifying lawyers whose procedural and substantive skills match a consumer's specific legal needs. Formal certification protects the public by regulating advertising of special skills by attorneys to assure that such claims are not misleading.

The BLS administers the Legal Specialization program, which is completely self-funded. Over the past 35 years, the program has been expanded to provide certification in 11 fields: Admiralty and Maritime Law, Appellate Law, Bankruptcy Law, Criminal Law, Estate Planning, Trust and Probate Law, Family Law, Franchise and Distribution Law, Immigration and Nationality Law, Legal Malpractice Law, Taxation Law and Workers' Compensation Law.

The BLS is responsible for proposing new specialties and recommends that establishment of a Trademark Law specialty be considered. If the concept is approved, members to a Consulting Group, who would be responsible for drafting standards subject to approval by the BLS and the Board of Governors, will need to be appointed.

#### **FISCAL IMPACT**

Minimal. The expenses associated with meetings of the Consulting Group could be absorbed by the 2010 budget for the Legal Specialization department, which was approved by the Board of Governors.

#### **BOARD BOOK IMPACT**

None.

#### **RULE AMENDMENTS**

None.

#### **SCHEDULE OF CHARGES AND DEADLINES:**

N/A

#### **PROPOSED BOARD COMMITTEE ACTION**

If the Board Committee on Member Involvement Relations & Services agrees that the BLS proposal to create a consulting group to consider the establishment of specialization certification in the area of trademark law and to develop standards for certification in that area should be approved, the following resolution is recommended:

**RESOLVED**, upon recommendation from the Board of Legal Specialization, that the Board Committee on Member Involvement Relations & Services recommends that the Board of Governors create a Trademark Law Consulting Group to consider the establishment of specialization certification in the area of trademark law and to develop standards for certification in that

area, subject to final approval of any proposed standards by the Board of Legal Specialization and approval by the Board.

### **PROPOSED BOARD ACTION**

Should the Board of Governors agree with the Board Committee on Member Involvement Relations & Services' recommendation, if adopted, regarding the establishment of a consulting group in trademark law, the following resolution would be in order:

**RESOLVED**, upon the recommendation of the Board Committee on Member Involvement Relations & Services, that the Board of Governors hereby authorizes the creation of a Trademark Law Consulting Group to consider the establishment of specialization certification in the area of trademark law and to develop standards for certification in that area, subject to final approval of any proposed standards by the Board of Legal Specialization and approval by the Board.

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