



AAA Mediation.org™

**FN-4800918 MN-4800918 LN-4800918,
Esq.**

Aventura, Florida



Current Employer-Title Mark Stein Law, P.A. – Partner

Profession Attorney

Work History Partner, Mark Stein Law, 2015 – Present; Partner, Higer Lichter & Givner LLP, 2010 – 2014; Partner, Lott & Friedland P.A., 1995 – 2010; Attorney, Mitrani Rynor & Gallegos, 1992 – 1995; Attorney, Kozyak Tropin Throckmorton & Humphries, 1989 – 1992.

Experience Experienced trial and transactional attorney practicing only intellectual property law, including: trademark, trade dress, trade secret, unfair competition, dilution, false designation of origin, false advertising, copyright, patent, licensing, computer law, software licensing, software development, internet law, domain name disputes, Uniform Dispute Resolution Policy (UDRP) proceedings, privacy policies, terms of service agreements, NFTs, Metaverse.

Litigation experience includes trademark infringement, trade dress infringement, trademark counterfeiting, copyright infringement, patent infringement, unfair competition, trademark dilution, trade secrets, licensing and franchising and domain name disputes. Counsels clients on trademark, copyright, trade secret and computer and Internet law issues, protecting computer software and protecting other intellectual property assets.

TRADEMARK, UNFAIR COMPETITION AND TRADE DRESS

Represented plaintiffs and defendants in trademark infringement, unfair competition and trade dress cases under Lanham Act. Obtained injunctive relief, judgments and/or settlements in apparel, fine art, food and beverage, cosmetics, footwear, jewelry, furniture, luxury goods, magazine, gift and souvenir, software and website businesses. Tried to a verdict before judge and/or jury multiple trademark infringement cases. Frequently prosecute trademark applications. Provide advice regarding trademark protection including applications, and registrations in the United States and throughout the world in food and beverage, apparel, gift and souvenir, music, footwear, software, hardware, education, sports equipment, medical, jewelry, coffee, travel, oil and gas, steel, security, fitness, marine, diet, automotive, real estate, urban development, cooling and refrigeration industries. Represented trademark applicants in numerous contested Office Actions before the Trademark Trial and Appeal Board (TTAB), successfully overcame numerous Office Action

rejections, and other practice before the United States Patent and Trademark Office (USPTO).

TRADE SECRETS

Represented plaintiffs and defendants in misappropriation of trade secret cases under federal trade secret law and Florida trade secret law, including the defense of Trade Secrets Act and The Florida Uniform Trade Secrets Act (FUTSA).

COPYRIGHT

Represented plaintiffs and defendants in copyright infringement cases pertaining to artwork, sculptural works, computer software, gifts and souvenirs, the internet, architectural works, pharmaceutical packaging and labels, apparel and footwear. Also assisted many clients in registering copyrights and in general counselling related to copyright protection, licensing and infringement issues.

SOFTWARE AND TECHNOLOGY

Represented plaintiffs and defendants in transactional and litigation matters involving computer software, computer source code and software development, including preparing terms of service, terms of usage agreements, privacy policies, software development, software licensing agreements, software as a service and platform development agreements. Experience litigating cases under the computer fraud and abuse act (CFAA), the Florida Computer Abuse and Data Recovery Act (CADRA) and the Communications Decency Act (CDA).

DOMAIN NAME AND INTERNET

Assisted clients with domain names and internet legal issues, securing domain names through purchase and transfer, Uniform Dispute Resolution Policy (UDRP) proceedings under ICANN (Internet Corporation for Assigned Names and Numbers), blockchain, cryptocurrency and smart contract legal issues.

LICENSING

Represented clients in relation to license agreements in food and beverage, apparel, gift and souvenir, music, footwear, software, hardware, education, sports equipment, medical, jewelry, coffee, travel, oil and gas, steel, security, fitness, marine, diet, and automotive industries.

Mediator Experience

Served as a mediator in just under 40 matters involving all aspects of patent, trademark, trade dress, trade secret, dilution, unfair competition, copyright, licensing, trademark counterfeiting, copyright counterfeiting, theft of software, hacking of computers and computer systems, software development, software licensing, patent licensing, false advertising, domain name disputes, computer and internet issues, including breach of contract agreements involving licenses and also involving use or development of software or hardware. The amounts in dispute have ranged from very small amounts to more than \$100 million dollars. Commonly mediate disputes in which the amount in controversy exceeds several million dollars.

Representative Issues Handled as a Mediator

Mediated cases involving all aspects of intellectual property law and related issues. These include cases involving:

- False advertising claims in the nutritional supplements industry.
- Copyright infringement arising from alleged copying of architectural plans for a restaurant
- Copyright infringement arising from alleged unauthorized use of computer software and name and likeness.
- Copyright infringement arising from unauthorized use of musical compositions and sound recordings and photographs.
- Trademark counterfeiting in the apparel, footwear and luxury goods industries.
- Trademark infringement involving the use of a name in the following industries: dry cleaning, HVAC, apparel, drug and alcohol rehabilitation, sanitation, real estate, automotive and boating industries.
- Trade secret violations between former licensor and former licensee.
- Domain name disputes.
- Breach of trademark and copyright license agreements.
- Patent infringement.

Mediator Style & Process Preferences

Facilitative mediator that believes in the process and allowing the process to work. Approach involves asking many questions to help the parties understand the strengths and the weaknesses of their position and to understand possible outcomes. Prepare thoroughly in advance of mediation.

Believes that most business disputes should settle because in mediation business people control the outcome. Also believes in continuing to work with parties post mediation if no settlement is reached at the mediation.

Uses same approach to mediation regardless of the number of parties, but recommends, if the parties will permit it, more rigorous preparation to try to resolve as many issues as possible prior to start of mediation.

Technology Proficiency	A paperless law firm; has excellent technology skills. Has strong computer and internet skills in all Microsoft programs, Adobe Acrobat and Westlaw.
Education	University of Florida (JD - 1989); Florida State University (BA - 1985).
Professional Licenses	Admitted to the Bar: Florida (1989); Florida Supreme Court Certified Mediator.
Professional Associations	<p>International Trademark Association (INTA):</p> <ul style="list-style-type: none">• Member, Panel of Trademark Mediators• Member Law Firm Committee (2024 to Present) <p>Member, Brands and Innovation Committee (2019-2023)</p> <ul style="list-style-type: none">• Co-Chair, Brands and Innovation Committee, Technology Monitoring Sub-Committee (2021-2023)• Member - Government Officials Education and Training Committee (2012-2015)• Co-Chair, USPTO Industry Seminar Project Team (2014-2015)• Member – Internet Committee, Social Media and Mobile Application Subcommittee (2015-2019)• Chair Team V, Educational Programs on Trademark Protection in Social Media, Internet Committee, Social Media and Mobile Application Subcommittee (2015-2019)• Yearly Attendee – Annual Meeting and Leadership Meeting <p>Florida Bar:</p> <ul style="list-style-type: none">• Chair, Business Law Section (2023-2024)• Member, First Intellectual Property Law Certification Committee (2007-2008)• Member of the Business Law Section Executive Council (2006 – present)• Member, Business Law Section Computer Law Committee (From committee formation – present).• Member and Past Chair of Business Law Section Intellectual Property Committee (2000 to present)• Chair of the Business Law Section Pro Bono Committee (2012-2014)• Chair of the Business Law Section Retreat Committee (2013-2014)• Member of Business Law Section Legislation Committee (2014 to Present)• Chair of the Business Law Section Legislation Committee (2019-2020)• Member of the Business Law Section Sponsorships Committee (2015-2017)• Member Drafting Team, §668.801, Fla. Stat., the Computer Abuse and Data Recovery Act (“CADRA”), the Business Law Section Intellectual Property Committee.
Recent Publications & Speaking Engagements	<ul style="list-style-type: none">• Speaker Architectural Works and Intellectual Property Protection, American Institute of Architects, Miami Chapter, “A Blueprint for IP Protection,” February 2011.• Speaker, Red Alert: “Critical Times to Think Intellectual Property.” Beginning March 2011 given to various law and firms in Miami-Dade and Broward Counties, Florida.• Speaker, Lunch Seminar Dade County Bar Association, Intellectual Property Committee, “Copyright: The Mile High View,” June 8, 2011.• Speaker, Critical Times for the Accountant to Think IP, Beginning November 2011 given to various accounting firms in Miami-Dade and Broward Counties, Florida.• Speaker, North Dade and Beaches Bar Association, 7 Deadly Sins – What Every Company Needs to Know about Cyber and Social Media Law, Sunny Isles Florida November 14, 2012.• Quoted Extensively, Issues Surround Bring Your Own Device Movement by Cindy Krischer Goodman, The Miami Herald, July 2, 2013.• Author, 4 Ways to Protect Your Brand During gTLD Expansion by Mark E. Stein, published in Law360, November 22, 2013.• Speaker, ALA Lunch, 7 Deadly Sins – What Every Company Needs to Know about Cyber and Social Media Law, Fort Lauderdale, Florida February 11, 2014.• Speaker, The LAB (Sponsored by the Dade County Bar Association, Venture Law Project) Top 10 IP Issues for Start-Ups, August 2014.• Co-Moderator, INTA Annual Meeting Table Topic, Big Data and New Issues for the Trademark

Practitioner, San Diego, CA May 6, 2015.

- Speaker, Florida Bar Business Law Section Intellectual Property Committee, Big Data and Trademark Issues, Boca Raton, Florida, June 25, 2015.
- Moderator, INTA USPTO Industry Training, The Internet of Things, at the USPTO, Alexandria, Virginia July 9, 2015.
- Speaker, Dade County Bar Association 2016 Bench & Bar Conference, Intellectual Property Rights in Today's Digital Economy: Things You Need to Know to Protect Your Client Miami, Florida February 26, 2016.
- Speaker, ABA ESL Conference, Current Issues in International Intellectual Property and Recent Developments in Cuba, Coral Gables, Florida April 8, 2016.
- Co-Moderator, INTA Annual Meeting Table Topic, The Internet of Things, Orlando, Florida, May 24, 2016.
- Author, Generic Top-Level Domain Name Expansion Brings New Opportunities, Risks for Business Owners by Mark E. Stein and Matthew N. Horowitz, published in The Computer & Internet Lawyer, Volume 33, number 6, June 2016.
- Moderator, INTA Leadership Meeting, In the Trenches with Social Media, Hallandale, Florida, November 18, 2016.
- Speaker, Florida Bar Business Law Section Intellectual Property Committee, Preparing for the Intellectual Property Law Certification Examination, St. Petersburg Beach, Florida, April 12, 2018.
- Moderator, Florida Bar Practicing Resource Center and Standing Committee on Technology and the Business Law Section, The Impact of Blockchain Technologies: from Cryptocurrencies to Smart Contracts, Orlando, Florida, June 13, 2018.
- Moderator, Florida Bar Practicing Resource Center and Standing Committee on Technology and the Business Law Section, Emerging Technology and Transformation in the Practice of Law in the Digital Age, Orlando, Florida, June 13, 2018.
- Speaker, Florida Bar Business Law Section Intellectual Property Committee, Preparing for the Intellectual Property Law Certification Examination, Orlando, Florida, April 11, 2019.
- Moderator, International Trademark Association Webinar, ICANN – What Every Practitioner Should Know From an Insider's View, June 6, 2019 (by web).
- Speaker, Florida Bar, Entertainment, Arts and Sports Law Section, Webinar, The Ten IP Issues that Should Keep Sports and Entertainment Lawyers Awake at Night, February 15, 2022
- Moderator, INTA Leadership Meeting, The New Frontier: Legal Developments in NFTs and the Metaverse; What it Means for Practitioners, Miami Beach, Florida, November 16, 2022

Mediation Rate	\$500 Per Hour
Languages	English
Citizenship	United States of America
Locale	Aventura, FL

The AAA's Rules provide the AAA with the authority to administer a mediation including, mediator appointment, general oversight and billing. Accordingly, mediations that proceed without AAA administration are not considered AAA mediations, even when the parties select an mediator who is on the AAA's Roster.

The information contained in this resume has been supplied solely by the individual mediator and may, or may not, be a complete recitation of their experience. The AAA assumes no responsibility for the content, completeness, accuracy, or reliability of the information contained in a mediator's resume. If you have any questions about a mediator's experience or background, you are encouraged to contact your case manager.

Mediators on the AAA Roster are not employees or agents of the AAA.