

Office of School Board Attorney
Walter J. Harvey, School Board Attorney

SUBJECT: AUTHORIZATION TO FILE A LAWSUIT AGAINST PREP SPORTSWEAR, INC. AND ITS AFFILIATED COMPANIES TO PROHIBIT THE UNAUTHORIZED SALE OF SCHOOL MERCHANDISE AND TO SEEK RECOVERY OF MONETARY DAMAGES

On several occasions, the School Board has recognized the importance of intellectual property to the school system as a possible source of additional revenue. Through the November 22, 2011, Board Agenda Item H-15 sponsored by Dr. Dorothy Bendross-Mindingall and the April 25, 2013 Board Agenda Item A-2 submitted by the Superintendent, the Board endorsed a series of steps to establish of a District-managed trademark registration and licensing program in order to protect the value of our District and school brands, as well as generate additional revenue through the collection of royalties and licensing fees which could be used to enhance opportunities for our schools and students.

In order to make such a program effective, however, it is necessary to identify school trademarks, protect them through proper marking, register them with the proper agency if possible and prevent third parties from exploiting the marks without authority. The School Board Attorney's Office ("SBAO") has registered trademarks, names and logos associated with all Miami-Dade County public high schools with the State of Florida, and has also registered several marks that have national brand recognition with United States Trademark and Patent Office. The SBAO has also worked with District staff to identify certain vendors who have sold unauthorized school merchandise and has either negotiated agreements with these vendors or issued cease and desist letters to halt their unauthorized activities.

Recently the SBAO became aware of a company called Sportswear, Inc. which operates a website at www.prepsportswear.com. This company, with its principal place of business in Seattle, Washington, operates an online market for school branded products. The site copies the name of the school, the name of its sports team, the school colors and, in some cases, even the logo or mascot. Attached are samples of Miami-Dade school-branded merchandise that are being offered for sale on Sportswear, Inc.'s website.

The SBAO has discussed this company's illegal infringement with representatives of several private educational institutions who have also been victims of the company's unlawful infringement of their trademark and logos and we are aware of one lawsuit that has already been filed against Sportswear, Inc. by the Savannah College of Art and

Design, Inc. The SBAO believes that it can obtain valuable information and assistance from the attorneys in that matter and that collaboration with these institutions to initiate additional litigation in South Florida.

The School Board Attorney therefore requests that the School Board authorize litigation to stop Sportswear, Inc.'s use of its Miami-Dade County Public Schools' intellectual property. It is anticipated that the legal action would take place simultaneously with other litigation initiated by private institutions in Miami-Dade County, but these actions would be filed separately.

This item also requests that the School Board retain the attorneys of Espinosa Trueba PL, who have offered a substantial reduction of their usual hourly rates, to work with the SBAO concerning this matter.

RECOMMENDED:

That The School Board of Miami-Dade County, Florida authorize the School Board Attorney to:

1. File a lawsuit against Prep Sportswear, Inc. and/or its affiliated Companies for the purposes of prohibiting the unauthorized advertisement, sale and distribution of merchandise bearing the names, mascots, logos and trademarks of public schools in Miami-Dade County; and
2. Retain the law firm of Espinosa Treuba PL to provide legal counsel for the Board in intellectual property matters at the hourly rate of \$395.00 per hour blended rate for partners and senior level attorneys, and \$125.00 for paralegals, a substantial reduction of their typical hourly rates for intellectual property matters.