2012–13 VSB President
W. David Harless

feature articles by the
Intellectual Property Section

Highlights of the June Council Meeting
and the 74th Annual Meeting

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Cover: Virginia State Bar President W. David Harless and his family were photographed at the Col. C. W. Woodson, Jr. Memorial Gallery at the Virginia State Police Academy in Richmond. The gallery houses portraits of sworn members of the State Police who have given their lives while protecting and serving the public. David’s father, Trooper Warren Y. Harless (portrait center), was killed in the line of duty in 1968.

Pictured (left to right) are children Kenzie, Taylor, and Sarah; David and his wife Debbé; and children Jordan and Ann Warren.
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One morning when W. David Harless was thirteen years old, he and his two younger brothers woke to find what he later described as “a bunch of strangers in my house.” They were there because the night before, while David slept, his father had been shot.

Warren Yokely Harless was a Virginia State Trooper. It was the November 1968 deer hunting season in Lee County, where the Harlesses lived, and David’s father had been helping to arrest a mentally ill man who had occupied an abandoned house on a property that was popular with hunters. The man, who was armed, claimed he owned the property and was taking rifles away from the passing hunters.

Because the roads were washed out by a storm, the police couldn’t get their armored vehicle to the site. Trooper Harless volunteered to approach the house with a spotlight in his hand so others could shoot teargas inside. The man opened fire, probably at the light, and Warren Harless was hit. He died in the morning. That, of course, changed David Harless’s life.

Harless grew up in Jonesville, population about 800, in Lee County. “There were no traffic lights in the entire county, no fast food joints, no 4-lane roads,” Harless said. The road system was so bad it wasn’t possible to safely transport students, so there were eight community high schools in the small county. Jonesville High School had about 300 students, grades 7–12. Harless’s graduating class numbered about 55. Apart from school, he spent his days hunting and fishing and doing what jobs he could find — mowing lawns, shoveling snow, putting up hay, working on farms, bagging groceries.

As the years passed after his father’s death, Harless was more and more in the company of lawyers. Two of those Jonesville lawyers who came to his house that morning were Glen Williams, who had been a state senator and went on to be a United States District Court judge, and Edgar Bacon, who was also a member of the Virginia House of Delegates. “I think Mr. Bacon was probably the first one to approach me,” about becoming a lawyer. “He and Judge Williams separately encouraged me. I knew by age 15 that was what I wanted to do.”

Harless’s connections with the lawyers and judges around him grew. His mother took a job as a legal secretary with a local attorney, Ronnie Montgomery. Harless’s first legal job was during college as an intern with Commonwealth’s Attorney Larry Lewis and he spent time there with many local judges and lawyers. He clerked at law firms while in law school and his first job out of law school was as a law clerk in Big Stone Gap with Judge Williams. In 1982, he joined Christian & Barton LLP in Richmond.

While his father’s death was a tragedy, “there are a lot of opportunities I had that I probably wouldn’t have had,” he said. “I probably wouldn’t be practicing law today,” if it hadn’t been for the many lawyers who came to the aid of the family.

Today, Harless is a partner at Christian & Barton and this fall he will mark thirty years as a practicing lawyer. What’s his area of practice? “Pick a pile,” he said, laughing, during a recent interview in his downtown Richmond office. The papers and files all have to do with commercial litigation matters, but it’s a very broad field. “I’ve had the good fortune to be involved in a lot of really interesting cases.” One he mentioned was a suit involving the family of the pilot of the space shuttle Challenger. His firm represented the company that manufactured the O-rings many say were suspect in the explosion.

Harless and his wife, Debbe, have five children. Sarah works for CNN International in Hong Kong after receiving her master’s degree in broadcast journalism at the University of Hong Kong; Taylor, a UVA graduate in sociology, is a union organizer in Los Angeles; Jordan is a 2011 economics graduate of Hampden-Sydney College and works for a commercial construction company in Richmond; and Kenzie is a May graduate of Virginia Tech and is in the graduate program for elementary education at Virginia Commonwealth University. Their youngest daughter, Ann Warren, now 14, is a rising sophomore at Mills Godwin High School.

“They are all remarkably close,” he said of his family.

Harless has been “involved” in bar and other activities for many, many
years. He is a former president of the Richmond Bar Association and served for seven years on its board before assuming the presidency. He has chaired the VSB Bench-Bar Relations Committee, served on the Budget and Finance Committee and was on the task force that established the Diversity Conference.

Christian & Barton has a long tradition of bar service. Harless is the fifth member of the firm to serve as VSB president and many partners have served as president of other bar organizations, such as the VBA, Richmond Bar Association, and American College of Trial Lawyers.

On top of all his bar-related activities, he was a director of the Virginia Public Safety Foundation from 1992 to 2006 and its president in 1997–98. The foundation provides scholarship assistance and financial aid to dependents of public safety officers killed in the line of duty. It also persuaded the General Assembly to allow dependents to attend state schools tuition-free. Given what happened to his father, working with that organization “was right in my wheelhouse,” Harless said.

Harless sought the presidency of the Virginia State Bar after serving four years on Council. He was encouraged to consider the post by former presidents and leaders of the bar, including his partners R. Harvey Chappell and Mike Smith. “I believe in the mission of the bar,” Harless said. “Our profession’s ability to self-regulate under the Supreme Court is quite a privilege. After talking to lawyers in other states, I appreciate how well our bar operates.”

Harless brings a simple philosophy to his new position. “I do not believe a successful president of a state bar or any other statewide bar association needs a specific project,” he said. “If we continue to do well and improve on what we do, then we can turn it over to (President-elect) Sharon Nelson at the end of my term better than we found it.”

And he said he intends to be careful with the bar’s finances. “I don’t have in mind any project or initiatives that will require the expenditure of additional money. We are stewards of the dues of our members. I choose to call it their money, not ours. If someone has a proposal, one of the first things that I will ask is how much? And second, is there a demonstrable return to our members on those dollars?”

He also knows it won’t be easy. “I am not a thrill seeker, but we’ve got our hands full of a lot of things. We’ve got a lot of successes and activities we can improve on.” Harless acknowledged that unanticipated issues will pop up. “We have an energetic and extremely wise Council; we have very good relationships with our colleagues at the VBA, VTLA, and other statewide bar organizations. I’m very confident that we will take a collaborative approach to the issues.”

Though he has been a lawyer in Richmond for thirty years, he hasn’t forgotten his small-town, rural background. Now, “the county has a four-lane road and a red light in Jonesville. The town still doesn’t have a fast food restaurant, but the county does.” His mother still lives in his boyhood home. His brother Ron is a businessman living in North Carolina, and his brother Gary, a recently retired Virginia State Trooper, lives in nearby Clintwood, Virginia. Harless and his brothers gather often at their mother’s home. “I really enjoy going back and seeing the folks who were so kind to us then,” he said.
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Nominations Sought for Board and Committee Vacancies

Volunteers are needed to serve the Virginia State Bar’s special boards and committees. The Nominating Committee will refer nominees to the VSB Council for consideration at its October meeting.

Vacancies in 2013 are listed below. All appointments or elections will be for the terms specified, beginning on July 1, 2013.

**Council Members at Large:** 3 lawyer vacancies (of which 2 incumbents are eligible for reappointment to a second term and 1 incumbent is not eligible for reappointment). May serve 2 consecutive 3-year terms.

**Disciplinary Board:** 7 lawyer vacancies and 1 lay member vacancy (of which 3 lawyer members are eligible for reappointment to a second 3-year term, 4 lawyer members are not eligible for reappointment, and 1 lay member is eligible for reappointment to a second 3-year term). District committee service is required. May serve 2 consecutive 3-year terms.

**Mandatory Continuing Legal Education Board:** 3 lawyer vacancies (of which 1 current member is eligible for reappointment to a second term and 2 members are not eligible for reappointment). May serve 2 consecutive 3-year terms.

Nominations, along with a brief résumé, should be sent by September 7, 2012, to George W. Shanks, Chair, VSB Nominating Committee, Virginia State Bar, 707 E. Main St., Suite 1500, Richmond, VA 23219, or emailed to nominations@vsb.org.
IN JUNE, I TOOK THE OATH as the seventy-fourth president of the Virginia State Bar. I am humbled and will endeavor to serve in a manner commensurate with the trust you have reposed in me. I will strive also to be guided by the example and wisdom of my immediate predecessors, George Shanks and Irv Blank. We are indebted to each for their dedication and tireless work.

In preparation for this column, I reviewed the articles submitted by my five predecessors. I concluded that there are few topics of immediate importance to the bar that they have not addressed comprehensively. I will attempt to avoid repetition.

Recently, many folks have asked me related questions that seem particularly appropriate for discussion in this inaugural column. What new programs will you propose? Do you have a project? Will you seek changes in VSB operations? In contemplating the need for such undertakings, I inventoried the recent activities of the bar. I am delighted to share this sample of the accomplishments and activities of the VSB during the past year:

• Through the dedication of the Committee on Lawyer Discipline, bar counsel’s staff, and our district committees, the bar has hired additional investigators and a new assistant bar counsel, dramatically improved response times to and quicker investigations of disciplinary complaints, and reduced pre-FY 2011 cases as of March 31, 2012, from 197 to 54, a remarkable 72.5 percent reduction.
• The Conference of Local Bar Associations conducted solo and small-firm conferences free of charge in the Northern Neck, Farmville, and Big Stone Gap, areas historically underserved with live CLEs by traditional providers. More than 400 attendees received seven hours of CLE, four in ethics. These sessions concluded with town hall meetings conducted by Justice Mims, Justice Lemons, and Chief Justice Kinser, respectively.
• More than 1,000 active volunteers devoted their services this past year to fulfillment of the VSB’s mission. By the conclusion of FY 2012, these volunteers will have driven more than 300,000 miles and invested thousands of hours of their labors to the improvement of our profession.
• The fiscal condition of the VSB is strong. The bar is a frugally operated, fiscally austere agency. Indeed, with a $25 reduction of dues in 2011–12, our annual dues are tied for the lowest among mandatory bars in the nation.
• The statewide bar organizations share a robust commitment to cooperation and collaboration in addressing issues critical to the public and our profession. For example, during the past year representatives of the VSB, VBA, VTLA, VADA, and VWAA met to address multi-faceted approaches to protecting the public from lawyer defalcations. This task force has recommended two measures for consideration by the Supreme Court and Bar Council that entail a proposed payee notification statute, and a proposal that the Clients Protection Fund and Bar Council increase the sums available and payable for such losses.

I believe that the VSB is serving well the mission and core purposes for which it was created by the General Assembly and the Supreme Court. The bar has no immediate need for “new” projects and I will exercise restraint in proposing such endeavors.

To be clear, I am not advocating complacency. We are committed to improving our current operations and programs and service to the public and our members. However, the bar’s success this year will be attributable to our devoted council members, talented staff professionals, and committed lawyer volunteers, not to a passing program or initiative.

Years ago I accompanied my two sons on two trips to Philmont Scout Ranch in northern New Mexico. Philmont covers 137,000 acres, approximately 214 square miles, of rugged mountain terrain. Over ten days young men and their adult leaders packed seventy pounds of food, water, and personal gear over seventy miles of undeveloped terrain.

The campsites and natural environment of Philmont should now reveal the scars of the 950,000 campers who have lodged there since 1939. However, through a practice known as “no trace camping,” Philmont today is as pristine as when it opened. This practice is simple: Leave the campsite better than you found it with no trace of your earlier presence.

This summarizes our simple goal. If through good stewardship of your money and fulfillment of our appointed purposes we leave the bar better than we found it with no trace of our presence, we will have done our job well this coming year. I hope you will agree.
FIFTEEN FORMER PRESIDENTS of the Virginia State Bar recently joined George Warren Shanks to socialize and renew long friendships at the second Presidents Dinner. The event, which included many spouses, was at the Jepson Alumni Center at the University of Richmond on May 10, 2012.

At the suggestion of past President Jon D. Huddleston, Irving M. Blank organized the first Presidents Dinner in 2011 and said he hopes the event will become an annual affair.

While there was some reminiscing, the main topic of discussion was how the former presidents can continue the work of supporting and improving the bar and serving the public.

Former Governor Gerald L. Baliles, a lawyer who is now director of the Miller Center of Public Affairs at the University of Virginia, struck a familiar note and stuck to the theme of the evening when he spoke about the importance, and relative lack, of lawyer-legislators in the Virginia General Assembly.

Today, the Virginia General Assembly includes a mere thirty-seven lawyers. That’s just one-quarter of the total membership, and it is a huge change from just a few elections ago when as many as three-quarters of our lawmakers were lawyers. In fact, it seems a little counter-intuitive that the number of lawyer-legislators has declined when one considers that the current and all eight living former governors are lawyers.

VSB presidents have also made serving the public a common theme. Huddleston promoted it through the Virginia is for Good Lawyers initiative that he started; Shanks did the same when he wrote in his October 2011 column that we should encourage our colleagues to run for public office at all levels, and support them when they do.

In the interest of further encouraging would-be lawyer-legislators, following is the text of Governor Baliles’s call to service.

Remarks continued on page 16
Distinguished guests, ladies and gentlemen.

It’s a pleasure to be a part of this gathering of leaders of the bar, many — if not most — I’ve known, worked with and admired over the years.

While I now reside in Charlottesville, where I am the director of the Miller Center at the University of Virginia, I lived in Richmond for almost forty years. I grew up in a small town in a rural area along Southern Virginia’s Blue Ridge Parkway. So, all my life, as a child, as a teenager, and as an adult, I have known, observed and worked with many wonderful lawyers — in small towns, suburban counties and large cities. Attorneys, in general, have always impressed me with their dedication to the law, their representation of their clients and their leadership roles in their communities.

During my public career and private practice, I have attended bar meetings, served on legal issues committees and work on pro bono projects. I have seen leaders of our profession up close, consider myself a lawyer who cares about our profession.

The lawyer-leaders in this room are good examples of what I wish to focus on for a few minutes.

When one thinks about it, Virginia has an unrivaled tradition of citizen lawyers — lawyers of honed ability and integrity who take positions of civic and political leadership, and apply their skills for the broad public good. Many of our schoolbook heroes from Virginia history (four hundred-plus years of it now) are lawyers: Patrick Henry, Thomas Jefferson, James Monroe, John Marshall, Lewis Powell, Oliver Hill, Harry Carrico, Leroy Hassell, Liz Lacy and Cynthia Kinser — to name only several.

And this assembled gathering tonight — without flattery — brings together true citizen lawyers, of the first order, from across the commonwealth.

The profession is strong in Virginia, its seedbed, and is doing good work, all the political chatter and criticism of lawyers notwithstanding.

But something hard to put a finger on, something hard to name exactly, increasingly feels awry with the profession, with OUR profession. I suspect you’ve had occasional senses of it, too.

According to an old Roman saying, an illness, that is at first hard to diagnose, but easy to treat, later becomes increasingly easy to diagnose but impossible to treat.

It’s hard to put a finger on it, this sense of something amiss, but I have it.

Sometimes the sense washes over me when I’m reading Virginia Lawyers Weekly and I see an article about this or that company “automating” some of its legal needs — having a software program fill out patent applications or employment contracts. Not too many years ago a bill was introduced in the General Assembly to allow automated legal kiosks that would dump out legal formula wills and divorce papers. And today, I’m sure you must have seen the advertisements by a recognizable name in the legal profession, about the convenience of visiting a website to find the forms to assist one with setting up wills, opening businesses, and a variety of related legal services anywhere in the country.

Sometimes it washes over me when I’m at a bar meeting and I talk to law students who express deep concerns about finding law firm employment in this economic environment or if they do, they worry that actually practicing law will be intolerable, and they lament heading down the track to becoming a lawyer. Or it rushes over me when I talk to lawyers in practice who are burned out and desperate to change careers.

The profession is strong in Virginia, its seedbed, and is doing good work, all the political chatter and criticism of lawyers notwithstanding.

A colleague and I were remarking recently that the future of the profession is promising, too — the commonwealth today has a more glittering array of law schools, I think, than perhaps any other state.
The Intellectual Property Section of the Virginia State Bar was formed in 1970 in recognition of Virginia’s significance to the field of intellectual property law. The United States Patent and Trademark Office (USPTO) had recently relocated from Washington, D.C., to Arlington, and many intellectual property attorneys followed. Since that time, intellectual property has become increasingly significant to the overall U.S. economy, and intellectual property issues are now frequently before the United States Supreme Court and Congress. Thus, it is now particularly important to keep section members up-to-date on the latest developments in intellectual property law.

Our section strives to achieve many of the same goals set by its founders by providing low-cost and high-quality continuing legal education to our members through three annual programs: the Fall CLE Weekend Seminar; the Spring CLE Ethics Seminar; and the CLE program at the Virginia State Bar’s Annual Convention. Our twenty-third annual Fall CLE Weekend Seminar featured Robert Stoll, the Commissioner of Patents, speaking on the America Invents Act, a live hearing of the Trademark Trial and Appeals Board, and a panel discussion with Judge Liam O’Grady and Magistrate Judge T. Rawles Jones Jr. of the Eastern District. These presentations provided our section members with invaluable insider practice tips and insights so our members could more effectively represent their clients before the USPTO and Federal District Courts.

Our Spring Ethics Seminar speaker is William R. Covey, Deputy General Counsel for Enrollment and Discipline at the USPTO. Our Annual Convention CLE features a panel discussion with the two lead attorneys that represented DuPont in obtaining a $920 million judgment in a trade secrets case.

The Intellectual Property Section also continued its annual Intellectual Property Law Student Writing Competition, now in its eighth year. The brainchild of former section chair Lee N. Kump, the writing competition seeks to promote academic debate and the dissemination of ideas and scholarly writing in the field of intellectual property. Open to students at any Virginia law school or residents of Virginia who are students at a law school outside the state, the competition awards a cash prize and publication to the top article on an issue concerning intellectual property law or practice. The Honorable Richard Linn of the U.S. Court of Appeals for the Federal Circuit has generously honored our section with his support for the writing competition by serving as the final judge each year since the contest’s inception. Judge Linn was a founding member and past chair of the section board of governors, and the section has appreciated his continued involvement.

The articles in this issue of Virginia Lawyer reflect the diverse practices of our section membership, including patents, trademarks, trade secrets, and Federal District Court practice.

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First-To-File or First-To-Invent: What’s the Difference?
The U.S. Patent System Transitions

by Matthew R. Osenga

Matthew R. Osenga is a registered patent attorney with Goodman Allen & Filetti in Glen Allen. He previously practiced with large international law firms in Washington, D.C., and Chicago, and at smaller law firms in Richmond. His practice includes a wide variety of technology areas encompassing all aspects of patent prosecution before the U.S. Patent and Trademark Office, patent opinions, and other transactional matters, as well as patent litigation support. He is a member of the Board of Directors of the Intellectual Property Section and a past president of the Greater Richmond Intellectual Property Law Association. He has been the author of a blog dedicated to patent law issues and strategies called Inventive Step since 2008.

The America Invents Act (AIA) of 2011 makes a number of changes to U.S. patent law. One of the most significant will be the transition from a first-to-invent system to a first-to-file system that takes effect in 2013. The most significant implications of the transition to first-to-file include changes in awarding priority between applications claiming the same subject matter and in pre-dating prior art.

Current System: Priority Between Applications
In the vast majority of cases, when a patent application is filed, whether it is entitled to a patent is simply a matter of examining the application to determine whether it meets the requirements for patentability under the Patent Act. At times, however, two or more applicants may claim the same subject matter. If multiple inventors claim to have invented the same invention, which, if any, is entitled to a patent? Should the patent go to the party that filed its application first? Should it go to the party that invented the invention first? Should they both get a patent for the invention?

Throughout its history, the United States has decided between two applications that claim the same subject matter by awarding the patent to the first inventor. The facts of which party was the first to invent the subject matter was determined by a rather complex administrative procedure called an “interference.” An interference is basically a mini-trial where the various parties submit evidence and testimony to the U.S. Patent and Trademark Office (PTO) to determine which inventor was the first. The mini-trial takes place before a panel of Administrative Patent Judges (APJs) that are part of the Board of Patent Appeals and Interferences (BPAI). The decision as to the priority between the applications is made by the APJs.

Current System: Pre-Dating Prior Art
Under current patent rules, once a patent application is filed, the examiner will review the application for compliance with the Patent Act and patent rules. This includes performing a search of the prior art to determine whether the invention meets the statute’s novelty and non-obviousness requirements. Under current rules, if the search finds prior art that was published less than one year before the patent application’s filing date, the applicant has the opportunity to file an affidavit with evidence to demonstrate that he invented the claimed subject matter prior to the publication date of the prior art. If the applicant can make

During an interference, the party that has the earlier patent application filing date is the “senior party,” while the party that has a later filing date is the “junior party.” The senior party is presumed to have been the first to invent the interfering subject matter. The junior party can overcome this presumption with evidence showing that its invention pre-dates the invention of the senior party. The senior party would then have the opportunity to demonstrate an earlier invention date by presenting its own evidence.

To prove that it was the first to invent, a party needs to show corroborated evidence that it was the first to “conceive” of the invention and that it worked diligently from the time of that conception to “reduce the invention to practice.” “Conception” refers to “formation in the mind of the inventor of a definite and permanent idea of the complete and operative invention, as it is thereafter to be applied to practice.” In other words, conception is the mental act of thinking of the idea of the invention and how it would be implemented. “Reduction to practice” refers to the act of actually making the invention work for its intended purpose. Alternatively, constructive reduction to practice occurs when an inventor files a patent application for the invention that complies with the requirements of the Patent Act.
such a demonstration, he can still obtain a patent despite the intervening publication.

The standard for pre-dating the prior art is similar to that for an interference as stated above. The inventor must demonstrate conception of the invention prior to the prior art publication date. Because patent applications are filed on an ex parte basis, this is significantly less onerous than in the interference context.

**New System: First-to-File**
The AIA changes the first-to-invent system to a first-to-file system. The new first-to-file rules will apply to most patent applications filed after March 16, 2013 (eighteen months after enactment of the AIA). Under the new system, applicants will no longer be able to rely on earlier inventive activity to pre-date prior art or to win an interference over a senior party. Instead, if multiple applications are filed that claim the same subject matter, the patent will generally be awarded to the first applicant to file an application that meets the patentability requirements.

We will be working under both the first-to-invent and the first-to-file systems for quite some time. Patents whose applications were filed before the transition date will be subject to the first-to-invent rules throughout their enforceable lives, up to twenty years or more from their earliest filing dates. Further, some applications that are filed after the transition date will still be subject to the first-to-invent rules. In some circumstances, an applicant can file another patent application, known as a continuation application, based on the invention disclosure in an earlier application. Continuation applications that include only claims that are supported by the disclosure of an application filed prior to that date will still be governed by the current first-to-invent system. In that case, the applicant may still use earlier inventive activity to pre-date prior art and overcome a senior party in an interference.

**Derivation Proceedings**
The AIA contains a potential exception to the strict first-to-file rule. If a junior party can prove that a senior party “derived” the invention from the junior party, the junior party may still be entitled to the patent. Situations where such derivation might occur include where an inventor has left the company where the inventive activity took place and took the invention with him.

These proceedings may be somewhat akin to interference proceedings with a significant difference: in an interference, the junior party must provide evidence to prove that it conceived of the invention before the senior party’s filing date; in a derivation proceeding, the junior party must provide evidence that the senior party “derived” the invention from the junior party. In the interference context, if such evidence exists, it will be in the possession of the junior party. In a derivation proceeding, if such evidence exists, it will often not be available to the junior party. It may therefore be more difficult for a junior party to prevail in a derivation proceeding than in an interference.

To initiate a derivation proceeding, the PTO will require a petition that: states with particularity the basis for finding that a named inventor in the earlier application derived the claimed invention from an inventor named in the petitioner’s application; and is filed within one year of first publication of the earlier application. The derivation proceeding will then proceed before a panel of APJs who are part of a new Patent Trial and Appeal Board (PTAB). The APJs will decide whether the invention was derived by the senior party from the junior party in a manner similar to how interferences are currently decided.

**The Dilemma**
What does the change from first-to-invent to first-to-file mean for clients? It seems that one implication will be a rush to the PTO to file applications earlier in the invention process.

Rushing to the PTO may have several negative effects on patent applications. First, a rushed patent application may not be adequate to protect the invention. Patent applications must include disclosure of the invention in such detail to enable one of ordinary skill in the art to make and use the invention. This typically requires more than mere conception of the invention; it usually requires a significant understanding of how it can be implemented. If a patent application does not include sufficient disclosure to meet this requirement, the claims of the patent will not be valid.

Second, applications will likely be filed before the invention is fully developed. As an inventor works to reduce an invention to practice and implement the invention in ways that will be of...
IP Owners in Foreign Proceedings May Force the Disclosure of Information Inside the United States

by Christopher P. Foley

Christopher P. Foley is a partner in the Reston office of Finnegan, Henderson, Farabow, Garrett & Dunner LLP. From 2000 to 2006, he served as the firm’s managing partner and chairman of the firm’s management committee. He is chair-elect of the IP Section of the Virginia State Bar.

In the global economy of the 21st century, geographic boundaries set no barriers to consumer interest in innovation. The latest iPad computer attracts as many customers in Osaka, Japan, as in Columbus, Ohio. Similarly, the introduction of Nike’s “Galaxy Foamposite” causes raucous lines at midnight in Orlando and sellouts in stores around the world. One feature common to Apple’s iPad and Nike’s Galaxy sneakers is their intellectual property, which is constrained by regulations that vary from country to country. As innovators market their new products globally, the risk of litigation outside the United States increases. And that litigation quite likely will involve intellectual property — patents, trademarks, and copyrights.

Judicial and administrative proceedings outside the U.S., however, commonly do not provide parties to intellectual property disputes with discovery in order to obtain relevant information about the issues in dispute. Even in countries where some form of discovery exists, courts outside the U.S. most likely cannot exercise jurisdiction over individuals or companies residing in the U.S. In appropriate cases, 28 U.S.C. § 1782 may provide the answer.

Section 1782 authorizes a federal court to permit people involved in legal proceedings outside the U.S. to obtain discovery from people in the U.S. for use in those foreign proceedings. Under this statute, an ex parte application may be filed in federal district court seeking documents or testimony from an individual within the court’s jurisdiction for use in a foreign or international tribunal.

The Supreme Court has identified four factors to aid courts in their decisions to grant these applications:

• Whether “the person from whom discovery is sought is a participant in the foreign proceeding [in which case] the need for § 1782(a) aid generally is not as apparent as it ordinarily is when evidence is sought from a nonparticipant in the matter arising abroad”;
• The “nature of the foreign tribunal, the character of the proceedings underway abroad, and the receptivity of the foreign government or the court or agency abroad to U.S. federal-court judicial assistance”;
• Whether the request “conceals an attempt to circumvent foreign proof-gathering restrictions or other policies of a foreign country or the United States”; and

While § 1782 is not commonly used in intellectual property proceedings, some parties have found that it provides a very powerful tool.

FG Wilson, a subsidiary of Caterpillar Inc., has been a world leader in the manufacture and sale of diesel and gas-powered generator sets for decades. The company has authorized dealers operating in more than 100 countries worldwide. Without FG Wilson’s consent, a U.S. resident fraudulently obtained trademark registrations in Colombia for FG Wilson’s name and logo, and transferred the registrations to a Panamanian shell company. The plan was hatched in collusion with others in Colombia for the purpose of negotiating a ransom for rights in the intellectual property.
In response, FG Wilson contemplated petitioning the Colombian Council of State to cancel the third-party registrations. In Colombia, petitions to cancel must be complete when filed. In other words, evidence sufficient to substantiate the registrant’s bad faith must accompany the petition. The petitioner also may not take discovery following submission of the petition. Further, the Colombian Council of State cannot exercise jurisdiction over the U.S. resident and require his appearance at a hearing or a deposition, even when the registrant is a Colombian citizen. As a result, the situation was troubling since the registrant had information highly relevant to FG Wilson’s anticipated claims. Indeed, the registrant had information about the Colombian kingpin who formed the shell company, about the kingpin’s bad-faith intent in engaging in the fraudulent filing scheme, and about the details of how the kingpin directed and orchestrated the scheme.

FG Wilson took a chance and filed an application under 28 U.S.C. § 1782(a) in federal court in Atlanta seeking targeted discovery of the registrant, a Georgia resident, for use in the Colombian proceeding. In re Application of FG Wilson (Engineering) Limited for Order to Obtain Discovery for Use in a Proceeding Before the Colombian Council of State, 09-mi-0519, N.D. Ga. (Dec. 2, 2009). The district court promptly granted the ex parte application, and the third-party registrant immediately sought reconsideration. In particular, the registrant maintained that the court committed a manifest error of law in its order by holding that the Supreme Court in Intel required there to be a dispositive ruling in an already pending proceeding. But when viewed in the context of the rest of the 30-plus page Intel decision, the only reasonable interpretation of that language is that a dispositive ruling be “within reasonable contemplation.”

The Intel case involved the filing of an antitrust complaint before a European agency. 542 U.S. at 254. The complaint did not mark the commencement of an action against Intel; rather, it merely began an investigation by the agency with which the complaint was filed. Id.

Accordingly, the Supreme Court was concerned with whether a dispositive ruling was within reasonable contemplation because that would be the point at which a proceeding could be initiated. But in FG Wilson the dispositive-ruling language did not apply because the filing of the Colombia proceeding was the relevant trigger point (i.e., there was no dispositive motion that needed to be decided before FG Wilson’s action before the

Colombia Council of State could be initiated) and the filing of that proceeding was clearly within reasonable contemplation. In fact, dispositive rulings were already issued by the Colombian Trademark Office in granting registrations, which gave rise to FG Wilson’s ability to appeal those decisions to the Colombia Council of State.

The registrant in FG Wilson also maintained that proceedings before the Colombian Council of State were not judicial in nature. The Supreme Court in Intel, however, specifically discussed legislative history on expanding § 1782 to administrative and quasi-judicial proceedings. The Supreme Court pointed out that Congress recognized that judicial assistance would be available whether the foreign or international proceeding or investigation is of a criminal, civil, administrative, or other nature. Id. at 258-59. Therefore, the Supreme Court specifically considered the issue of whether a proceeding of any nature needed to be pending to invoke § 1782, not just whether a judicial proceeding needed to be pending. Furthermore, in response to the question of whether a proceeding before a foreign tribunal must be pending or at least imminent for an applicant to successfully invoke § 1782(a), the Supreme Court answered, unequivocally, “no.”

Following the approach in Intel, the federal district court in Atlanta rejected the motion for reconsideration and granted FG Wilson’s application for ex parte discovery, thus ordering the registrant to appear for a deposition and produce documents. Through the deposition, FG Wilson gained conclusive evidence that the registrant registered the FG WILSON trademark in Colombia in bad faith, and that evidence was available for use in the Colombian proceeding. In addition, based on the registrant’s failure to produce documents, FG Wilson succeeded in a motion for con-

The Intel case involved the filing of an antitrust complaint before a European agency.
In view of the experiences reflected in the FG Wilson, API, and Lilly cases, a party to a judicial or administrative proceeding in a foreign country may need to compel testing or discovery of information relating to an intellectual property right that is essential to establish the infringement or validity of a patent or copyright, trademark, or trade secret. This is known as Section 1782 discovery, which is available in disputes involving patents and copyrights.

Engineeringsky, a company that engaged in trademark infringement by prominently using the API trademark in its advertisements without authorization from API, that Internet users were diverted to the infringing engineeringsky.com website, and that Engineeringsky engaged in unfair-competition activities by defining its products using the API trademark. Shortly after obtaining the requested discovery from Google, the foreign litigations settled favorably to API.

Because Engineeringsky advertised its online business via Google, API reasonably believed that Google had information relevant to API's actions against Engineeringsky in China. Thus, API sought limited discovery of Google under Section 1782(a), including documents sufficient to identify Engineeringsky’s sponsored-link advertisements distributed by Google, Engineeringsky’s payments to Google (as charged on a cost-per-click basis), the publishers’ websites on which Engineeringsky’s sponsored-link advertisements appeared, the publishers’ names, and the amounts of Google’s payments to the publishers. These documents were relevant to API's copyright, trademark, and unfair-competition actions in China because, among other things, they would show that Engineeringsky engaged in trademark infringement by prominently using the API trademark in its advertisements without authorization from API, that Internet users were diverted to the infringing engineeringsky.com website, and that API was damaged by Engineeringsky’s unlawful activities. Shortly after obtaining the requested discovery from Google, the foreign litigations settled favorably to API.

Among other things, the complaints in API’s cases in China alleged that a company doing business under the name Engineeringsky engaged in copyright infringement, trademark infringement, and unfair competition by using API’s trademarks without authorization and by offering unauthorized and infringing copies of API’s standards, specifications, and recommended-practices publications on its website in violation of API’s copyrights. Engineeringsky conducted its business online and advertised its engineeringsky.com website online via Google. Specifically, Engineeringsky had one or more “sponsored-link advertisements” it created using Google’s advertising services. Google distributed Engineeringsky’s sponsored-link advertisements on Google’s main google.com website.

In view of the experiences reflected in the FG Wilson, API, and Lilly cases, a party to a judicial or administrative proceeding in a foreign country may need to compel testing or discovery of information relating to an intellectual property right that is essential to establish the infringement or validity of a patent or copyright, trademark, or trade secret. This is known as Section 1782 discovery, which is available in disputes involving patents and copyrights.
administrative proceeding that is outside the United States and that involves intellectual property should seriously consider using § 1782 to uncover factual information in the U.S. that would aid the foreign proceeding. Circumstances may arise when an inventor, scientist, or researcher relocates to the U.S., or when a trademark is licensed or assigned to a company in the U.S.. In these situations, valuable information may go with the individual or be transferred to the company, and thus fall outside the jurisdiction of the judicial or administrative tribunal in the foreign country.

Section 1782 does not seek to replace foreign law or foreign evidentiary requirements. Instead, it enables a litigant to obtain information directly relevant to issues in the foreign proceeding. It also does not try to circumvent foreign proof-gathering restrictions. Indeed, it is well recognized that the foreign tribunal has the power to determine admissibility of any information obtained under § 1782. Notwithstanding these concerns, given the significant role of intellectual property in the global economy, § 1782 provides a valuable tool when individuals or companies, who may have information relevant to a foreign dispute, reside in the United States.

Endnotes:

1 According to 28 U.S.C. § 1782(a), “the district court of the district in which a person resides or is found may order him to give his testimony or statement or to produce a document or other thing for use in a proceeding in a foreign or international tribunal, including criminal investigations conducted before formal accusation. The order may be made pursuant to a letter rogatory issued, or request made, by a foreign or international tribunal or upon the application of any interested person and may direct that the testimony or statement be given, or the document or other thing be produced, before a person appointed by the court. By virtue of his appointment, the person appointed has the power to administer any necessary oath and take the testimony or statement. The order may prescribe the practice and procedure of the foreign country or the international tribunal, for taking the testimony or statement or producing the document or other thing. To the extent that the order does not prescribe otherwise, the testimony or statement shall be taken, and the document or other thing produced, in accordance with the Federal Rules of Civil Procedure.”

2 The Supreme Court granted review on the following two questions. First, does § 1782(a) make discovery available to complainants, such as AMD, who do not have the status of private “litigants” and are not sovereign agents? See Pet. for Cert. (i). Second, must a “proceeding” before a foreign “tribunal” be “pending” or at least “imminent” for an applicant to invoke § 1782(a) successfully? Compare In re Letter of Request from Crown Prosecution Service, 870 F.2d 686, 691, 276 U.S. App. D.C. 272 (D.C. Cir. 1989) (proceeding must be “within reasonable contemplation”), with In re Ishihari Chemical Co., 251 F.3d 120, 125 (CA2 2001) (proceeding must be “imminent — very likely to occur and very soon to occur”); In re International Judicial Assistance (Letter Rogatory) for Federative Republic of Brazil, 936 F.2d 702, 706 (2nd Cir. 1991) (same). In answering “yes” to the first question and “no” to the second, the Supreme Court affirmed the Ninth Circuit’s judgment. Id. at 253–54 (emphasis added).
Trademark Board Finds CRACKBERRY Infringing and Not a Parody of BLACKBERRY 

by Timothy J. Lockhart

A recent decision of the Trademark Trial and Appeal Board (TTAB) of the United States Patent and Trademark Office (USPTO) is one of the relatively few decisions involving a successful trademark dilution claim. In Research in Motion Ltd. v. Defining Presence Marketing Group, Inc. & Axel Ltd. Co. the TTAB held that the proposed uses of the trademark CRACKBERRY would blur and therefore impermissibly dilute the distinctiveness of the famous BLACKBERRY mark. The TTAB also held that most of the proposed uses of CRACKBERRY would be likely to cause confusion with BLACKBERRY. Accordingly, the TTAB sustained the opposition of Research in Motion (RIM) to the trademark applications in question.

In December 2006 and May 2007, Defining Presence Marketing Group filed four intent-to-use applications to register CRACKBERRY with the USPTO for clothing items and for marketing, computer, and communications services. Axel Ltd. Co. obtained the applications by assignment in September and December 2007, and after RIM filed three Notices of Opposition to the applications in August, September, and December 2007, the TTAB joined Axel as a defendant.

RIM claimed that the CRACKBERRY mark would be likely to cause confusion with its several marks consisting of or including the word BLACKBERRY (in block or stylized lettering and with and without design elements) and its mark CLOUDBERRY as used and registered for "handheld devices including smart phones and related goods and services as well as promotional and collateral goods." RIM also claimed that CRACKBERRY would dilute, by blurring, the distinctive quality of its allegedly famous BLACKBERRY mark.

The TTAB found that the USPTO records submitted in the case proved its BLACKBERRY and CLOUDBERRY registrations were valid and subsisting, thereby establishing RIM’s standing to bring the opposition proceedings. The TTAB also found that RIM had priority over the defendants with respect to RIM’s goods in International Classes 9 and 16 and its services in International Classes 38 and 41.

In their answers the defendants argued, among other things, that their CRACKBERRY mark was a parody of the BLACKBERRY mark. The TTAB acknowledged that some court cases indicate that “a successful parody seems to make confusion less likely.” For example, the TTAB cited the case of Hormel Foods Corp. v. Jim Henson Productions, Inc., in which the court held that the Henson company’s use of the term “Spa’am” on merchandise for its movie Muppet Treasure Island was a successful parody of, and therefore not likely to cause confusion with, Hormel’s SPAM mark as used with luncheon meat.

The TTAB also noted that when courts deal with alleged trademark infringement, the First Amendment’s “protective penumbra of free speech” applies. According to the TTAB, the right of free speech “may well support the premise that members of the public have a right to use words in the English language to interest and amuse other persons,” thereby making a finding of infringement less likely.

In contrast, the question of an applicant’s right to obtain a trademark registration under Section 2(d) of the Lanham Act is a “narrower” one, said the TTAB, and in that context “the First Amendment claim is not as strong as with issues...
of restraint on use.” Thus, if the *du Pont* factors used in the likelihood-of-confusion test for trademark infringement point to a similarity between parties’ respective goods or services and the relevant channels of trade such that consumers might believe those goods or services have a common source, “the likelihood of confusion will usually trump any First Amendment concerns.”

Before applying the *du Pont* factors, the TTAB considered whether BLACKBERRY is a famous mark. The TTAB noted that, according to documents RIM submitted in the case, RIM has sold billions of dollars’ worth of BLACKBERRY-brand products to millions of consumers and spent tens of millions of dollars advertising and promoting its BLACKBERRY marks. The TTAB also noted that RIM’s documents show that the media have extensively covered the BLACKBERRY brand and that BLACKBERRY consistently appears on the lists of the most famous and valuable trademarks in the world. Thus, the TTAB concluded, based on the evidence RIM made of record, BLACKBERRY is a famous mark and therefore is entitled to “the wide latitude of legal protection” that such a mark receives.

Given the marks’ obvious similarities in sight and sound and the significant fact that the public began using the nickname “Crackberry” to refer to “addictive” BLACKBERRY devices before the defendants applied to register CRACKBERRY, the TTAB readily found that the *du Pont* factors point toward a likelihood of confusion. The TTAB also found that the *du Pont* factors supported RIM’s position that its goods and services and the defendants’ services are “quite closely related.” The defendants argued that because their CRACKBERRY-brand goods and services were intended to be offered online as opposed to in retail stores, there was “no overlap between the goods and services of the parties.” But the TTAB noted that “it is not necessary that the goods and services overlap in order to be found related in such a way that confusion is likely.”

The TTAB did find a “large overlap” in the parties’ channels of trade, given that “applicants’ prospective customers are by design substantially all prior customers of [RIM].” Accordingly, the TTAB found a likelihood of confusion with respect to the applicants’ three applications to register the CRACKBERRY mark for services. Because of a lack of relevant evidence of record, however, the TTAB did not agree with RIM that its alleged common-law rights in the mark BLACKBERRY supported its position regarding the defendants’ application for clothing.

Turning to the issue of dilution under Section 43(c) of the Lanham Act, the TTAB found that the BLACKBERRY mark is sufficiently famous to meet the higher standard for fame required in the dilution context (as opposed to the lower standard in the likelihood-of-confusion context). The TTAB also found that BLACKBERRY became famous before the filing dates of any of the four applications at issue.

The TTAB then considered whether, under the six relevant statutory factors, CRACKBERRY was likely to dilute, by blurring, the distinctiveness of the BLACKBERRY mark. A major factor in such an analysis is the degree of similarity between the famous mark and the junior mark. The TTAB said that in this context the marks need not be “substantially identical,” only “highly similar.” Noting that in their parody defense the applicants had conceded some similarity between the marks, the TTAB found “a high degree of similarity.”

The TTAB also found that BLACKBERRY is a distinctive and widely recognized mark and that RIM was engaged in substantially exclusive use of the mark. Finally, the TTAB found that the applicants intended to, and did, choose a mark that the public would actually associate with the BLACKBERRY mark. Thus, the TTAB concluded, all six statutory factors supported RIM’s contention that CRACKBERRY was likely to dilute BLACKBERRY by blurring the distinctiveness of RIM’s famous mark.

The TTAB considered at some length whether the defendants were, as they claimed, entitled to the statutory “fair-use” defense of parody under Section 43(c)(3)(A). The TTAB observed that, as Professor J. Thomas McCarthy has said, the “safe harbor” that the dilution statute affords to parody “is obviously intended to accommodate the interests of using famous marks in free speech and expression,” not to permit the use of parodies as trademarks. Nevertheless, as some cases have held, under certain narrow circumstances the use of a parody of a famous mark may be permissible in a trademark context.

The TTAB also found that BLACKBERRY is a distinctive and widely recognized mark and that RIM was engaged in substantially exclusive use of the mark.
For trademark purposes “a ‘parody’ is defined as a simple form of entertainment conveyed by juxtaposing the irreverent representation of the trademark with the idealized image created by the mark’s owner.”29 To be a parody, a mark “must convey two simultaneous — and contradictory — messages: that it is the original, but also that it is not the original and is instead a parody.”30 A parody of a trademark must “communicate some articulate element of satire, ridicule, joking or amusement”31 and therefore “relies upon a difference from the original mark, presumably a humorous difference, in order to produce its desired effect.”32

In support of that position the defendants relied heavily on the Virginia case of Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC.33 In that case the court held that Haute Diggity Dog’s CHEWY VUITON mark for inexpensive pet chew toys was clearly a joking reference to the plaintiff’s expensive LOUIS VUITTON handbags. The court said that given the rhyming nature of the parties’ respective marks, the defendant’s parody of the plaintiff’s trade dress as well as of its word mark, and other factors, consumers were not likely to be confused into thinking that CHEWY VUITON pet toys came from the same source as LOUIS VUITTON handbags.34

The CRACKBERRY defendants claimed that in view of the Louis Vuitton Malletier case, the TTAB should impose on RIM an “increased burden” to demonstrate that the distinctiveness of its famous mark is likely to be impaired” by the defendants’ parody.35 The TTAB disagreed, stating that, per the express language of the federal dilution statute,36 the “safe harbor” is available to an entity only if its parody does not designate the source of that entity’s goods or services.37

In that case the court held that Haute Diggity Dog’s CHEWY VUITON mark for inexpensive pet chew toys was clearly a joking reference to the plaintiff’s expensive LOUIS VUITTON handbags.

The TTAB noted, however, that the foregoing observation “does not end the inquiry,” and that, like the Fourth Circuit, the TTAB would “assess the alleged parody ‘as part of the circumstances to be considered for determining whether [RIM] has made out a claim for dilution by blurring.”38 In other words, using a parody as a trademark may, depending on the circumstances, sometimes be permissible even if such use does not fall within the safe harbor provided by the dilution statute. But in Research in Motion Ltd. the TTAB held that “the alleged parody does not . . . insulate the defendants from the claim of dilution.”39

The TTAB listed two key reasons for its ruling. First, the public, not the defendants, had adopted “Crackberry” as a nickname for BLACKBERRY-brand devices. Second, the defendants’ applied-for services were, for the most part, closely related to RIM’s goods and services. According to the TTAB, those facts served to distinguish the claimed parody of CRACKBERRY from the actual parody of CHEWY VUITON, where the parody mark identified an inexpensive toy to be chewed by a dog in sharp contrast to the original mark’s identification of an expensive handbag that must not be chewed by a dog.40 Accordingly, the TTAB sustained RIM’s opposition to all four CRACKBERRY applications on the grounds of dilution.41

The CRACKBERRY decision shows that owners of arguably famous marks should consider alleging dilution when opposing the registration of identical or highly similar marks used or intended for use with non-competitive goods or services. (Such owners can allege a likelihood of confusion as well as dilution if the defendants’ goods or services are competitive with those of the plaintiffs.) The decision also suggests the sorts of defenses the owners are likely to face in making a case for dilution as well as for a likelihood of confusion. Finally, the decision shows that, given relevant statutory and case law, the TTAB is not likely to be sympathetic to applicants who claim their marks are permissible parodies of famous marks.

Endnotes:
1. Opposition Nos. 91178668, 91179490, & 91181076 (February 27, 2012) [precedential]. The TTAB’s decision is available online at http://ttabvue.uspto.gov/ttabvue/?v=pno=91178668&pty=OPP&eno=65.
2. The four applications are: (1) No. 77059205, filed on December 7, 2006, for marketing services, namely providing informational web pages designed to generate sales traffic via hyperlinks to other websites; online retail store services featuring downloadable ring tones; online retail store services featuring consumer electronics and telecommunication products and accessories; providing online directory information services also

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TRADEMARK BOARD FINDS CRACKBERRY INFRINGING AND NOT A PARODY OF BLACKBERRY

Research in Motion Ltd. v. Prods., Inc.

See In re E.I. du Pont de Nemours & Co., 476 F.2d 1482, 1486 (10th Cir. 1987) (LARDASHE jeans for larger women a successful and permissible parody of JORDACHE jeans).

Although it followed Louis Vuitton Malletier, the TTAB noted that the case “has on occasion come under criticism.” Research in Motion Ltd. at fn. 33 (citing Anthony L. Fletcher, “The Product with the Parody Trademark: What’s Wrong with CHEWY VUITON?” 100 Trademark Reporter 1091 at 1142-45 (September-October 2010)).

Parody continued on page 32
Recent Developments Regarding Business Method Patents

by Suzanne C. Walts and William J. Sauers

In recent years there has been considerable debate about whether business methods should be patentable. Although there is no precise definition of business methods, they often relate to trading, finance, economics, advertising, or customer service. In a recent decision, *Bilski v. Kappos*, a fractured Supreme Court rejected a categorical rule that business methods are unpatentable.

Instead, the Supreme Court emphasized the limitation that patents should not be granted for abstract ideas. In addition, recently enacted legislation is likely to have a significant impact on business method patents.

Section 101 of the Patent Act states that “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor.” The term “process” is defined as a “process, art, or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.” However, despite this broad statutory language, the Supreme Court and the Court of Appeals for the Federal Circuit have imposed limitations on patentable subject matter, with significant consequences for business methods.

**Business Method Patents Post-*Bilski***

As the Supreme Court noted in *Bilski*, its precedents prohibit granting patents for “laws of nature, physical phenomena, and abstract ideas.” The applicant in *Bilski* claimed a method of protecting against the risk of price fluctuations in a market. The Supreme Court analyzed the claimed method in view of its decisions in *Benson*, *Flook*, and *Diehr*, and concluded that the claimed method was an example of an unpatentable abstract idea.

According to the Supreme Court, granting a patent in *Bilski* would impermissibly give the applicant a monopoly over risk hedging in all fields. Further, claims limiting the method to commodities and energy markets were mere field-of-use restrictions that did not render the idea patentable. In analyzing the patentability of the claimed method, the Supreme Court rejected the machine-or-transformation test proposed by the Federal Circuit as the sole test for patentability under Section 101, because this test may not always be suitable for evaluating inventions in the Information Age. However, the machine-or-transformation test may provide an important and useful clue for determining whether an invention is patentable.

The Supreme Court invited the Federal Circuit to develop further principles clarifying the limits on the patentability of business methods. Since *Bilski*, the Federal Circuit has decided several cases that provide further guidance regarding what constitutes an unpatentable abstract idea. The Federal Circuit itself has noted the substantial difficulties in defining an abstract idea, as well as its own internal disagreements regarding what constitutes patentable subject matter.

In *Cybersource*, the Federal Circuit held that a method of detecting credit card fraud in transactions over the Internet was unpatentable. The court first affirmed that the claimed method failed to meet the machine-or-transformation test. With regard to the machine prong, the explicit language of the claim did not require the method to be performed by a machine, such as a computer or the Internet. Further, although the credit card transaction was performed over the Internet, the claim did not require the Internet to be used to obtain the data. In addition, the...
Applying these principles to the claimed invention in *Ultramercial*, the Federal Circuit reasoned that a purpose of the invention was to address problems with banner advertising, thereby improving existing technology in the marketplace. Further, the claimed invention recited a practical application of the abstract idea of using advertising as currency. Many of the recited method steps were “likely to require intricate and complex computer programming,” and some steps “clearly require specific application to the Internet and a cyber-market environment.” However, the Federal Circuit purposefully declined to define the required level of complexity of computer programming, and did not hold that using an Internet website to practice the method was necessary or sufficient to render the invention eligible for patent protection. The court implied that the invention in *Ultramercial* would satisfy the machine prong of the machine-or-transformation test, because a general purpose computer would become a special purpose computer upon being programmed to perform the claimed method, even though the claims did not explicitly recite a computer or processor. Further, failing to recite a specific mechanism for delivering the copyrighted products to the consumer did not render the claims too abstract.

The Federal Circuit characterized the invention in *Ultramercial* as “a particular method for collecting revenue from the distribution of media products over the Internet.” This distinguished the invention from the mental process that was found to be unpatentable in *Cybersource*. Specifically, the court concluded that the controlled interaction with the consumer via the

The court noted that although abstract ideas are unpatentable, it may be possible to patent the application of an abstract idea to a “new and useful end.”

Internet website in *Ultramercial* was “far removed from purely mental steps.”

The Federal Circuit has provided two additional examples of business methods considered to be unpatentable abstract ideas in *Dealertrack* and *Fort Properties*. In *Dealertrack* the court held that a computer-aided method of processing credit applications over electronic networks was unpatentable. The claims were “directed to an abstract idea preemptive of a fundamental
It is clear that an application for a business method patent must be carefully drafted to illustrate that the invention is not an abstract idea.

or the significance of a computer to the performance of the method." The district court construed the claims as not being limited to any specific algorithm, and the patentee did not challenge this construction. Further, using the clearinghouse only for car loan applications was a “field of use” limitation that was insufficient to render the claims patentable.

Similarly, in Fort Properties the Federal Circuit held that an investment tool for enabling owners to buy and sell properties without incurring tax liability was unpatentable. The court found that the claimed method of aggregating property, making the property subject to an agreement, and issuing ownership interests in the property to multiple parties consisted “entirely of mental processes and abstract intellectual concepts.” The ties to deeds, contracts, and real property were insufficient to render the investment tool patentable. Further, like the “computer aided” recital in Dealertrack, a claim limitation requiring a computer to generate deedshares was characterized as “insignificant post-solution activity.”

The computer did not play a significant role in allowing the claimed method to be performed. During claim construction, the patentee agreed that “using a computer” should be interpreted simply as “operating an electronic device that features a central processing unit.”

The cases discussed above provide some guidance regarding best practices for preparing, prosecuting, and enforcing business method patents. It is clear that an application for a business method patent must be carefully drafted to illustrate that the invention is not an abstract idea. Some possibilities include explaining why a computer or the Internet is required to perform the method, providing examples of specific algorithms that can perform the method, and distinguishing data analysis steps from merely gathering or organizing the data. Complex computer programming and a specific Internet application seem to weigh heavily in favor of patentability of a business method. Also, a patentee should avoid agreeing to claim constructions that characterize the invention as being performed by a general-purpose computer.

Post-Grant Review Under the America Invents Act
In September 2011, the Leahy-Smith America Invents Act (the AIA) was signed into law. The AIA created a new “post-grant review” procedure that will allow third parties to challenge the validity of issued patents, including business method patents. Under the new post-grant review procedure, a petitioner may challenge a patent based on any ground of invalidity, except for best mode. The petitioner must show that it is more likely than not that at least one of the challenged claims is unpatentable, or raise a novel or unsettled question of law. For example, the petitioner will be able to challenge a business method patent under Section 101 based on the grounds discussed in the above cases. However, post-grant review will not be effective until September 16, 2012, and only applies to patents with an effective date on or after March 16, 2013. Moreover, the petitioner must institute post-grant review within nine months of the issuance of the patent.

In view of these limitations, the AIA also includes a transitional program that allows for post-grant review of certain types of business method patents. This transitional program may only be used by parties that have either been sued or charged with infringement of “covered business method patents.” A “covered business method patent” is “a patent that claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, except that the term does not include patents for technological inventions.” As with the other post-grant review procedure, the transitional program related to covered business method patents will take effect on September 16, 2012. However, unlike the other post-grant review procedure, the transitional program will apply “to any covered business method patent issued before, on, or after that effective date . . . .” Also, it is unnecessary to request post-grant review for cov-
Business Method Patent or Trade Secret?

As described above, there are noticeable inconsistencies in the Federal Circuit decisions, and it may be difficult to predict how the U.S. Patent and Trademark Office and the federal courts will analyze a specific business method claim. Moreover, even if a party successfully obtains a business method patent, it may be subject to post-grant review by a third party, increasing the chances that the patent will be invalidated or limited. As a result, the inventor of a business method may want to consider keeping the business method as a trade secret, especially if it would be difficult for a competitor to reverse-engineer the method based on publicly available information. Alternatively, if the inventor only plans to file a patent application in the United States, the inventor could file a non-publication request, in which case the application would be published only if it eventually issues as a patent. The business method could remain a trade secret if the patent is never granted.

Of course, a party that chooses to practice its invention as a trade secret must meet certain requirements. In Virginia, trade secrets are defined by the Virginia Uniform Trade Secrets Act (VUTSA) as “information, including but not limited to, a formula, pattern, compilation, program, device, method, technique, or process, that:

- Derives independent economic value, actual or potential, from not being generally known to, and not being readily ascertainable by proper means by, other persons who can obtain economic value from its disclosure or use, and

- Is the subject of efforts that are reasonable under the circumstances to maintain its secrecy.”

Thus, while the up-front costs of filing a patent application and obtaining an issued patent may be a significant, the ongoing costs associated with maintaining the secrecy of the information can be substantial and difficult to implement, especially for certain types of business information. In addition, if the trade secret can be reverse engineered easily, it may be advantageous to seek patent protection at least as a defensive measure.

Conclusion

The law related to obtaining and enforcing business method patents is undergoing substantial changes stemming from the *Bilski* decision and the AIA. As a result, companies seeking to protect their intellectual property rights and business operations face an uncertain landscape when trying to determine the proper course of action. Entities are therefore likely to be best served by closely considering the business and legal implications associated with pursuing the differing types of intellectual property protection available on a case-by-case basis.

Endnotes:

1 130 S. Ct. 3218, 3228-29 (2010). Four of the Justices would have held that all business methods are unpatentable. *Id.* at 3232 (Stevens, J., concurring).
2 *Id.* at 3229-30.
5 *Bilski*, 130 S. Ct. at 3221.
6 *Id.* at 3223.
10 *Bilski*, 130 S. Ct. at 3229-30.
11 *Id.* at 3231.
12 *Id.*
13 *Id.* at 3225-26. The Federal Circuit had held that an invention is patentable only if “(1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.” *Bilski v. Kappos*, 545 F.3d 943, 954-956 (Fed. Cir. 2008) (en banc).
14 *Id.* at 3227.
15 *Id.* at 3222-23.
16 *MySpace, Inc. v. Graphon Corp.*, 2012 U.S. App. LEXIS 4375 (Fed. Cir. 2012) at *19-21. As Judge Plager colorfully remarked: “This effort to descriptively cabin § 101 jurisprudence is reminiscent of the oenologists trying to describe a new wine. They have an abundance of adjectives—earthy, fruity, grassy, nutty, tart, woody, to name just a few—but picking and choosing in a given circumstance which ones apply and in what combination depends less on the assumed content of the words than on the taste of the tongue pronouncing them.” *Id.* at *21.
17 *Cybersource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366 (Fed. Cir. 2011).
18 *Id.* at 1370.
According to the Federal Circuit’s precedents, “mere data-gathering steps cannot make an otherwise nonstatutory claim statutory.”

Id. at 1371.

Id. at 1372.

Id. at 1373 (emphasis in original).

Id. at 1374-75. The Federal Circuit previously held that “as a general matter, programming a general purpose computer to perform an algorithm ‘creates a new machine, because a general purpose computer in effect becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software.’” Id. at 1375, citing In re Alappat, 33 F.3d 1526, 1545 (Fed. Cir. 1994). In Cybersource, the Federal Circuit clarified that “simply reciting the use of a computer to execute an algorithm that can be performed entirely in the human mind” did not fall within the Alappat rule.

Id. at 1375.

Id.

Ultramercial, LLC v. Hulu, LLC, 657 F.3d 1323 (Fed. Cir. 2011).

Id. at 1327 (citing Benson).

Id. at 1328.

Id.

Id.

Id.

Id. at 1329. Specifically, “a programmed computer contains circuitry unique to that computer. That ‘new machine’ could be claimed in terms of a complex array of hardware circuits, or more efficiently, in terms of the programming that facilitates a unique function.” Id.

Id.

Id.

Id. at 1330 (emphasis in original).


Parody continued from page 27

Research in Motion Ltd. at 36.

15 U.S.C. § 1125(c)(3)(A) (fair use does not include a person’s use of a parody “as a designation of source for the person’s own goods or services”).


Id. at 36-37 (citing Louis Vuitton Malletier at 507 F.3d at 266, 84 U.S.P.Q.2d at 1978).

Id. at 37.

Id. (citing Louis Vuitton Malletier, 507 F.3d at 261, 84 U.S.P.Q.2d at 1974).

Id. at 38.
commercial significance, improvements or changes are inevitably developed. Often, these improve-
ments or changes can alter the invention in signif-
icant ways. An earlier filed patent application may
not even cover the invention once it reaches this
stage of development. Currently, by keeping good
records of inventive activity, inventors can take
advantage of the pre-dating procedures to wait
until an invention is perfected or at least well
developed before filing a patent application. This
will not be the case under a first-to-file system.

Further, the race will create more pressure on
patent attorneys. Each day that an invention
disclosure or patent application is not filed is a day
that could result in loss of the race to the PTO or
the ability to pre-date new prior art. Attorneys
will be required to file applications more quickly
or risk the loss of patent rights for their clients.

File Early, File Often
The best advice for winning the race to the Patent
Office is to be the first one to file.13 File a patent
application at an early stage in the inventive
process. As the invention is developed further and
improvements and other changes take place, addi-
tional patent applications should be filed. Each
filing will provide protection to the inventor
against filings by other parties.

During the first year of an invention’s devel-
opment, applicants may choose to file a provi-
sional patent application.14 A provisional patent
application is a patent application that may be
filed at the PTO that can be used to establish an
early filing date. The PTO does not examine provi-
sional applications, but merely keeps them in its
records. The application expires a year from its
filing date. In order to claim the benefit of the
provisional application filing date, a non-provi-
sional application and any foreign applications
must be filed within that twelve month period.
The public does not get access to a provisional
application unless and until a non-provisional
application that claims the benefit of the provi-
sional application filing date is published.15

In order for a later-filed non-provisional
application to obtain the benefit of the filing date
of an earlier provisional application, the claims of
the non-provisional application must be sup-
ported by the disclosure of the provisional appli-
cation. The applicant must include sufficient
detail in the provisional application to permit one
of ordinary skill in the art to make and use the
invention.16 Otherwise, the application is only
entitled to the filing date of the non-provisional
application.

Currently, inventors often file a quick provi-
sional application before a public disclosure and
then wait a year to file a full non-provisional
application that includes sufficient detail to war-
rant a patent. Under the first-to-file system, if the
first provisional is not adequately supported and

The best advice for winning the race to the Patent
Office is to be the first one to file.

enabled, an intervening filing by a competitor
may trump the first provisional. That first provi-
sional still has merit, but during the first year of
development inventors should consider filing
additional provisional applications often as details
of the invention are developed to prevent the
harm from intervening applications. Applicants
will no longer be able to rely on inventive activity
to pre-date prior art.

Although the March 16, 2013, deadline may
seem a long way off, now is the time for clients
and attorneys to prepare for the change to the
U.S. patent system. Inventors should seek to file
applications prior to the deadline to take advan-
tage of the current rules as long as possible. Then,
they must gear up for a system that will require a
race to the Patent Office after that date by prepar-
ing to file more patent applications with greater
frequency.

Endnotes:
1 Leahy-Smith America Invents Act of 2011, Pub.
Law 112-29, 125 Stat. 284.
3 Townsend v. Smith, 36 F.2d 292, 295 (CCPA 1930).
4 Eaton v. Evans, 204 F.3d 1094, 1097 (Fed. Cir. 2000).
6 37 C.F.R. § 1.131.
7 Pub. Law 112-29, 125 Stat. 284, 293.
8 Id.
10 http://www.intellectualpropertylawfirms.com/
resources/intellectual-property/patents/first-
file-derivation-proceedings.htm.
11 PTO proposed rules.
13 Additional information on transitioning to first-
to-file is available at
012_01_18-FirsttoFileTips.pdf.
14 Additional information on provisional applica-
tions is available at http://inventivestep.net/
2011/10/31/provisional-patent-applications-2/.
§ 1.14(a)(1)(v).
At White House, Whitfield Describes Valley’s Legal Aid Woes and Heroes

by Dawn Chase

Blue Ridge Legal Services Executive Director John E. Whitfield lauded the community spirit of Shenandoah Valley bar associations but underscored the dire condition of legal aid funding, in a presentation at the White House on April 17.

Whitfield was one of six legal aid directors invited to speak about the state of civil legal assistance in a program co-sponsored by the Legal Services Corporation (LSC) and the White House. President Obama made a brief appearance at the program. He said civil legal assistance to the poor is “central to our notion of equal justice under the law.”

Blue Ridge’s funding has fallen by twenty percent in the last two years. Whitfield said the program was hit by a “double whammy — collapsing IOLTA revenue and federal funding cuts.” Interest on Lawyers Trust Accounts contributions declined with the housing market and interest rates, and in the fall of 2011 Congress significantly cut LSC’s budget, which supports civil legal assistance to low-income Americans. Blue Ridge is one of six Virginia programs that receives LSC grants.

Blue Ridge came into the recession with only a few employees in each of its four offices, in Winchester, Harrisonburg, Lexington, and Roanoke. “They’re dedicated, hardworking, smart. They’re doing great legal work,” he said.

In the last eighteen months, however, the program had to lay off 26 percent of its employees. “We’re trying to keep those four offices open, but they’re only going to be skeletal staffed, with just two or three people in each office. We’ve lost all benefit of economy of scale, and that’s really frustrating. Our costs per case have gone up, because we have to keep the lights on. We still have to maintain the office, with half as many attorneys in some of the offices.

“In the meantime our poverty population has increased 42 percent. We’re focusing on the most urgent cases,… but we’re forced to turn away two or three times as many as we help.”

Whitfield said that in the face of these “crippling statistics,” one support stands stalwart — a “strong culture of nurturing pro bono” by the Valley’s local bar, led by the Harrisonburg-Rockingham Bar Association. The HRBA’s pro bono referral program accepts 130 to 140 cases a year, including difficult cases and appeals, and distributes them among 170 volunteer attorneys. Since the Harrisonburg-Rockingham pro bono referral program began in 1982, volunteer attorneys have handled more than 2,700 cases and spent 22,000 hours on those cases — a contribution of $3.2 million at a modest billing rate of $150 per hour.

The bar association’s pro bono program is still flourishing thirty years later, Whitfield said. Eighty-five percent of the HRBA’s firms and solo practitioners have been involved in an active pro bono case in the last eighteen months.

Richardson Receives Norfolk & Portsmouth Bar Association’s Eggleston/I’Anson Professionalism Award

Virginia Beach attorney John Y. Richardson Jr. was recently named the recipient of the Norfolk & Portsmouth Bar Association’s Eggleston/I’Anson Professionalism Award. The award was presented at the association’s annual dinner on May 8, 2012. At the same event, Andrew R. Fox was presented the Walter E. Hoffman Award for Community Service.
JusticeServer Pro Bono Matchmaker Will Improve Services

by Dawn Chase

In Central Virginia now, getting a pro bono case referral is as easy as sitting at your computer, logging onto a password-controlled bulletin board, and selecting from a list of clients with the types of case the website knows you prefer.

At first, all you’ll see is the names of the client and adverse party. If your conflicts check is clean, you hit “accept.” The case file — and the client — are yours.

The case is brought to you by JusticeServer — developed through a collaboration among the Virginia Bar Association, Capital One, several of the state’s law firms, the Greater Richmond Bar Foundation, and two Legal Aid programs. The JusticeServer project offers cases from the Central Virginia Legal Aid Society, the Legal Aid Justice Center, and the Pro Bono Clearinghouse, which helps nonprofit groups.

In 2013, JusticeServer will be available to more Legal Aid programs and others that provide civil legal services to the poor and to volunteer lawyers from firms large and small, across Virginia.

When plans for the pro bono matchmaking software were unveiled at the Virginia Chief Justice’s Pro Bono Summit on April 24, James J. Sandman, president of the federal Legal Services Corporation, told the Supreme Court that JusticeServer “has the ability to transform legal services in the United States.”

JusticeServer is designed to save Legal Aid staff time and, by making the process more convenient, to increase the number of pro bono lawyers.

But Richmond law firms and Capital One donated the cost of developing the system. Capital One provided senior staff from its information technology and other departments to do the initial work and train Legal Aid staff.

JusticeServer is designed to save Legal Aid staff time and, by making the process more convenient, to increase the number of pro bono lawyers. It also will replace the legal aid program’s aging internal case management system. Early in the development, the designers realized it would be more efficient to create a new system with the pro bono referral service as a feature, rather than try to cobble the pro bono manager onto the existing system.

The collaboration started with the first Pro Bono Summit in April 2010, convened by the late Chief Justice Leroy R. Hassell Sr., who throughout his administration had tried to muster Virginia lawyers to provide more pro bono representation in civil matters. He often said he did not believe it was right for a parent to have to fight a child custody battle or termination of parental rights without a lawyer.

Before the summit, in his State of the Judiciary address, Hassell enlisted the Virginia Bar Association to create a plan to increase pro bono.

By the 2010 summit, the key players were assembled. They included:

• The co-chairs of the VBA Pro Bono Committee: Harry M. “Pete” Johnson III of Hunton & Williams and Scott C. Oostdyk of McGuireWoods. As these two partners of competing firms collaborate on the JusticeServer project, they demonstrate what Oostdyk calls a “nonaggression pact” to support Legal Aid.

• Supreme Court Justice Donald W. Lemons, who served as the Court’s liaison for the project.

• The Greater Richmond Bar Foundation, which develops resources to fix legal access problems. The foundation agreed that “you can link attorney resources with need by using technology,” said its president, Brian A. Marron.

The foundation is the fiscal manager for the project. It obtained grants of $50,000 from the Mary Morton Parsons Foundation and $25,000 from
Access to Legal Services

the Community Foundation, and is seeking more financial support. Through its Pro Bono Clearinghouse, the foundation is testing JusticeServer, and it plans to market the system, train users, and recruit more volunteer lawyers when the pilot ends and the system attains wider usage.

• John G. Finneran Jr., general counsel and corporate secretary of Capital One Financial Corporation. Finneran pledged Capital One’s commitment to the project at the 2010 Pro Bono Summit and brought with him senior managers, including the IT staff that built the system.

• Firms in Service-Richmond, a group of law firms that work together to support pro bono.

• Steve Dickinson, executive director of the Richmond-based Central Virginia Legal Aid Society, and Alex R. Gulotta, executive director of the Charlottesville-based Legal Aid Justice Center.

In January 2012, the JusticeServer team announced its plans at a gathering of law firm partners. Capital One said that it was jumpstarting the project with a $25,000 grant.

A partner of one law firm stood and said, “We donate $25,000.” A second lawyer from another firm matched the $25,000. The pledging continued. By the end of the week, $155,000 had been promised by eight firms, bringing JusticeServer’s seed money to $180,000.

Alexandra S. Fannon, the foundation’s director of programs and development, said, “We were thrilled that the Richmond law firms immediately understood the potential of the project and chose to invest in its success.”

Foundation President Marron said he doesn’t think the response was choreographed. “There’s a certain level of fundamental competition among all the firms around town, whether it’s winning cases in court or doing good works,” he said.
“I’ve never seen anything like it before,” said Capital One’s Finneran. Donations continue. The Salesforce .com Foundation donated the platform and the initial ten licenses for use with the project, as it has done for 15,000 nonprofits and higher education organizations nationally. Etherios, a tech consultant company, gave the foundation a 20 percent discount on the cost of customizing the platform to meet requirements for case management and confidentiality protection, and transferring data from the old system to the new. Dominion Resources will provide ongoing basic tech support without charge.

The JusticeServer team was in high spirits as they outlined their progress and plans to the Supreme Court in April.

• “It will bring about huge efficiencies in our internal ability to manage clients and cases and to place cases with pro bono lawyers,” the Legal Aid Justice Center’s Gulotta said. “It’s the first system that’s been designed with legal aid lawyers in mind.”

• In a joint press release, the team announced goals: the waiting time for pro bono case placement will be cut by 35 percent, and Central Virginia’s backlog in uncontested divorce cases will fall from 250 to zero.

• JusticeServer will double the participating Legal Aid programs’ capacity from 1,500 to 3,000 matters in twelve months, and the number of volunteer lawyers who help Legal Aid will increase from 200 to 700, according to the press release.

• “Distance lawyering” — a vision of Oostdyk’s — could become commonplace. Urban lawyers from Richmond and Northern Virginia, for example, can help clients in areas where pro bono activity is low, such as Southwest Virginia and Hampton Roads.

• JusticeServer will be available to other providers of legal services — every Legal Aid program in the state and nonprofits that help cancer patients, veterans, and restoration of prisoners who have returned to the community, for example.

• The licensing costs will be significantly lower than what Legal Aid is paying now — at least for the immediate future, said Central Virginia Legal Society’s Dickinson. “We have had a small taste of the power that Salesforce.com is, and we realize the power that JusticeServer could be.” If they add features such as searchable scanned documents — the price will go up.

The outpouring of support has been heartening to a Legal Aid system that has been slammed by the recession and government funding cutbacks in recent years. “Capital One has been incredibly generous with their time and treasure,” Dickinson said. The company has put in probably 1,600 personnel hours into the project so far, at a cost of $150 to $175 per hour.

Capital One’s IT director, Andy Schwarz, put the human face on the project in his report to the Court. He said he had recently received a phone call from a Capital One employee who asked if he was “JusticeServer.” She said she desperately needed help. She’s a young woman with two children, and she said her husband was beating her.

“I usually don’t have these kinds of conversations. I’m in IT, so I get to hide,” Schwarz said. “All the statistics, all the work you do — it is extremely important. It’s not about me. It is about the person on the other side.”

Dawn Chase is director of communications for Virginia’s legal aid system. She works at the Virginia Poverty Law Center, 700 East Main St., Suite 1410, Richmond, Virginia 23219. http://www.vplc.org

Free and Low-Cost Pro Bono Training

Visit the Pro Bono page on the VSB website for free and low-cost pro bono training and volunteer opportunities: http://www.vsb.org/site/pro_bono/resources-for-attorneys
At its meeting on June 14, 2012, in Virginia Beach, the Virginia State Bar Council heard the following significant reports and took the following actions:

**Budget**
The council approved a $13.6 million budget for 2012–13. This is an increase of $793,000 over the 2011–12 operating budget. The budget includes a 3 percent bonus for VSB staff and an increase in funding for Lawyers Helping Lawyers.

**Payee Notification**
The Payee Notification Task Force’s recommendations will be presented to the VSB Council for a vote in October. The legislation would require insurers to notify claimants when they disburse settlement proceeds of $5,000 or more to claimants’ attorneys. The proposed statute is out for notice and comment. See below. The task force also passed a measure encouraging the Clients Protection Fund and VSB Council to increase the current loss limits of $50,000 per individual client to at least $100,000 and to increase the current 10 percent of the net worth of fund limit per attorney to at least 15 percent.

**Personnel Matters**
Robert L. “Scott” Prince and Anastasia K. Jones will join the Department of Professional Regulation as the newest assistant bar counsel. Prince has spent twenty years as a general practitioner focusing on criminal defense and domestic relations. Jones spent six years on a partnership track at an Orange County, California, law firm before relocating to Virginia. She has been a general practitioner since then focusing on criminal defense, domestic relations, estates, and small business.

**Resolutions**
The council unanimously approved a resolution honoring Kimberly Slayton White for her years of service to the VSB. The council also approved resolutions honoring George Warren Shanks for his years of service and his law firm for its support of Shanks during his years on the VSB Council.

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**Proposed Payee Notification Statute**

On April 25, 2012, the Virginia State Bar Payee Notification Task Force approved the proposed statute. The task force has recommended unanimously that insurance companies be required to notify claimants or judgment creditors that the insurer has issued a payment of $5,000 or more in settlement of a liability claim or judgment to the attorney or other representative of the claimant or judgment creditor. The proposed statute will be presented to the VSB Council in October.

**Notice of settlement payment.**

A. Upon payment by any insurer of at least $5,000 in a single check to an attorney licensed in Virginia, or other representative, in settlement or satisfaction by an insured or a third party of any claim arising out of an insurance policy issued or delivered in Virginia, the insurer shall send to the claimant or judgment creditor on the underlying insurance or liability claim a notice of such payment as required by subsection B within five business days of the date payment is made or sent to the attorney or other representative of the claimant or judgment creditor.

B. The notice required pursuant to subsection A shall be sent to the physical or electronic address furnished by the claimant or judgment creditor to the insurance company, unless the claimant or judgment creditor has advised the insurance company that no such notice shall be sent. In the absence of any address or advice furnished by the claimant or judgment creditor, the notice shall be sent to the last known physical or electronic address of the claimant or judgment creditor.

The notice shall be sent by the insurance company only after a settlement has been agreed to by the attorney or other representative of the claimant or judgment creditor and within five business days of the date payment is made or sent to the attorney or other representative, and the notice shall contain only the following language:

“Pursuant to § _____ of the Code of Virginia, you are hereby notified that a payment was sent on (insert date on which payment sent) by (insert name of insurer) to your attorney or other representative (insert name, address, and telephone number of attorney or other representative known to insurer), in satisfaction of your claim or judgment against (insert name of insurer, or insured, whichever is appropriate).

If you have any questions, please contact your attorney or other representative.”

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Payee Notification continued on page 39
Sharon D. Nelson is President-elect of Virginia State Bar

Sharon D. Nelson, president of Sensei Enterprises Inc., is the Virginia State Bar’s new president-elect. She will serve for a year, then succeed W. David Harless for the 2013–14 term as president.

Nelson took the office June 17 during the VSB’s annual meeting in Virginia Beach.

Sensei Enterprises Inc. is a digital forensics, information security, and legal technology firm in Fairfax.

Nelson graduated from Georgetown University Law Center and has been in private practice since, now concentrating exclusively in electronic evidence law.

She is a past president of the Fairfax Bar Association, a director of the Fairfax Law Foundation, and serves as a member of ARMA’s E-Discovery Advisory Group. She is also a past chair of the American Bar Association’s Law Practice Management Publishing Board and chair of the Law Practice Management Education Board.

She is a member of Leadership Fairfax, is a past chair of the American Bar Association’s TECHSHOW, and serves on the Virginia State Bar governing Council and on its Executive Committee, on its Technology Committee, and as chair of the Unauthorized Practice of Law Committee.

The Supreme Court of Virginia appointed her to the statewide E-Filing Committee beginning in 2010.


Nelson is the author of the noted electronic evidence blog, Ride the Lightning and is a co-host of the American Bar Association podcast series called “The Digital Edge: Lawyers and Technology” and the Legal Talk Network podcast “Digital Detectives.”

She is a frequent author and speaker on legal technology, information technology, and electronic evidence. She is also a court appointed special advocate for abused and neglected children.

Nelson is married to John W. Simek, vice-president of Sensei Enterprises.

Payee Notification continued from page 38

C. Nothing in subsection A or B shall (i) create any cause of action for monetary damages for any person against an insurer based upon a failure to provide notice as required by this section or the provision of a defective notice, (ii) establish a defense for any person to any cause of action based on a failure to provide notice as required by this section or the provision of a defective notice, or (iii) invalidate or in any way affect the settlement or satisfaction for which the payment was made by the insurer.

D. Except as provided and authorized by this section of the Code of Virginia, no insurer shall otherwise communicate with a claimant or judgment creditor known to be represented by an attorney licensed in Virginia, or other representative, regarding settlement of a claim or satisfaction of a judgment, without the written consent of such attorney or other representative.

Deadline for comment: September 30, 2012

Comments should be submitted in writing to Karen A. Gould, Executive Director, Virginia State Bar, 707 E. Main Street, Suite 1500, Richmond, VA 23219, no later than the end of the business day on the day of the deadline.

The VSB E-News

Have you been receiving the Virginia State Bar E-News? The E-News is a brief monthly summary of deadlines, programs, rule changes, and news about your regulatory bar. The E-News is emailed to all VSB members. If your Virginia State Bar E-News is being blocked by your spam filter, contact your email administrator and ask to have the VSB.org domain added to your permissions list.
VSB Dues Can Be Paid Online

Lawyers can now renew their Virginia State Bar memberships and pay their dues online.

Online Membership Renewal is available to members in good standing with active, active/Virginia corporate counsel, and associate memberships. Members also still have the option of renewing by postal mail. Dues statements were mailed June 15.

The online service accepts individual attorney renewals only.

Access is provided through the secure “Member Login” area of VSB.org. As with the paper statements, members who choose “Online Membership Renewal” certify whether they are covered by a professional liability insurance policy, select what voluntary sections they wish to join, and pay their mandatory annual dues (including the mandatory $25 Clients' Protection Fund fee), plus any section dues, by credit card.

The site accepts MasterCard and Visa, which can be applied to dues-related payments only. These include late fees that accrue after the membership compliance deadline of July 31. The membership renewal, insurance certification, and dues payment are processed immediately, and a receipt is issued.

Access to the Online Membership Renewal option is available until early October, when attorneys are administratively suspended for membership non-compliance.

Online Membership Renewal is the first of several planned improvements to give members more flexibility and convenience through the VSB website.

“Forever Tree” Dedicated

John H. Tate Jr., past chair of the Senior Lawyer’s Conference of the Virginia State Bar; Cynthia D. Kinser, Chief Justice of the Supreme Court of Virginia; and Robert L. Calhoun, chair of the Senior Lawyer’s Conference were among those who attended the dedication of a “Forever Tree” memorial to former Chief Justice Leroy Rountree Hassell Sr. at the State Capitol on April 24.

NOTICE:
Check Your MCLE Hours Online Now

The Mandatory Continuing Legal Education compliance deadline is October 31, 2012. Go to https://member.vsb.org/vsbportal/ to review your MCLE record.

An Interim Report and information on new MCLE requirements will be mailed to all active members in July. Of the 12.0 CLE hours required each year, 2.0 must be in ethics and 4.0 must be from live, interactive programs. If you have any questions, please contact the MCLE Department at (804) 775-0577 or mcle@vsb.org.
How do we make better lawyers without increasing the already excessive cost of a legal education?

That question was woven through the 20th Anniversary Conclave on the Education of Lawyers in Virginia held in Charlottesville on April 22 and 23. The conclave brought together more than seventy of the best legal minds in Virginia, including lawyers from across the state, educators from all eight law schools, and judges at every level of the bench including the seven justices of the Supreme Court of Virginia.

Program Chair W. Taylor Reveley III, president of the College of William and Mary, opened the conclave by noting that “the education of lawyers is a long journey.” He guided the participants through four panel discussions:

- How are law schools addressing major changes in the practice of law and in accrediting standards for legal education?
- How should we measure preparedness for admission to the bar?
- How do we most effectively seek to educate lawyers throughout their careers?
- Do judges have a meaningful role in legal education?

Conclave participants offered extensive suggestions for dealing with the questions.

They included providing incentives for a different kind of law school professor who specializes in teaching and is not required to research and publish scholarly work; changing the curriculum for the second and third years of law school; eliminating the third year of law school; changing the bar exam to focus more on what a lawyer really needs to be a lawyer; creating mandatory mentoring programs at law firms and bar associations; and providing continuing legal education credits for activities aimed at educating and mentoring.

While the panels touched on multiple subjects, some common laments included: legal writing is bad and getting worse and must be improved; the American Bar Association requirements are difficult when considering changes in legal education; the U.S. News and World Report rankings of law school are detrimental; and the bar exam forces law schools to teach to the test.

All four discussions, along with the lunch and dinner presentations, will be covered by reporters assigned to the panels, and will be summarized in the October issue of Virginia Lawyer.
VIRGINIA STATE BAR DIVERSITY CONFERENCE’S CLARENCE M. DUNNAVILLE, JR. ACHIEVEMENT AWARD
Presented by the Diversity Conference

Clarence M. Dunnaville, Jr.

Beginning with the civil rights demonstrations of the 1950s and continuing through a distinguished legal career, Dunnaville has devoted his life to the cause of equal justice. He is the first recipient of this annual award, which is being created in his honor, and is being recognized as setting the example of excellence the members of the Diversity Conference aspire to achieve.

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VSB Honors Local Bar Associations

The following bar associations received awards from the Conference of Local Bar Associations during the Virginia State Bar Annual Meeting. The awards recognize projects that serve the bench, the bar, and the people of Virginia.

The CLBA makes information on winning projects available to other groups that want to consider similar programs. For information, contact Paulette J. Davidson at Davidson @vsb.org or (804) 775-0521.

AWARDS OF MERIT
For excellence in bar projects

First-time Awardees:

Virginia Women Attorneys Association, Loudoun Chapter
Empty Bowls, an international effort to fight hunger, benefiting the local food pantry for Loudoun County.

Metropolitan Richmond Women’s Bar Association
CARITAS Partnership, providing pro bono legal services, donations of furniture and home goods, and volunteer labor.

The Prince William County Bar Association Inc.
Holly Acres Pro Bono Project, providing free legal services to residents of the Holly Acres Mobile Home Park who were displaced by flooding from tropical storm Lee.

Sustained Projects:

Local Government Attorneys Association of Virginia

The Prince William County Bar Association Inc.
So You’re 18 presentations in schools, started in 1999.

Roanoke Bar Association
Santa in the Square holiday party for children and their families living in area shelters, started in 2006.

CERTIFICATES OF ACHIEVEMENT
For high achievement in bar projects

Virginia Women Attorneys Association, Prince William Chapter
Holiday Party and Gift Drive, providing gifts to more than twenty needy children in the area.

Virginia Women Attorneys Association, Prince William Chapter
Annual Circuit Court Judicial Law Clerks’ Reception, fostering acquaintances among local practicing lawyers and new law clerks.

Virginia Women Attorneys Association, Hampton Roads Chapter
Norfolk Social Services Holiday Foster Care Project, providing gifts to needy foster children.

Fredericksburg Area Bar Association
Law Day, educating as many students as possible in elementary, middle and high schools about the law.

Loudoun County Bar Association
Back to School with the Loudoun Bar, distributing more than 300 backpacks containing school supplies to needy children in the county.

The Prince William County Bar Association Inc.
Books for Troubled Teens, providing books about positive role models to teens in the county juvenile detention center and the juvenile shelter.

Virginia Law Foundation Taps New Officers, Board Members

At its Annual Meeting on June 15, the Virginia Law Foundation Board of Directors elected its new slate of officers for FY 2012–13, as follows:

President Manuel A. Capsalis (Capsalis Fitzgerald, PLC, Leesburg), President-Elect James V. Meath (Williams Mullen, Richmond), Vice-President John D. Epps (Hunton & Williams, Richmond), Secretary Yvonne C. McGhee (Virginia Bar Association, Richmond), and Treasurer Karen A. Gould (Virginia State Bar, Richmond)

Current board member G. Michael Pace Jr. (Gentry Locke Rakes & Moore, LLP, Roanoke) and Kathy Mays Coleman (Richmond), and new members Matthew E. Cheek (Williams Mullen, Richmond), Jan Leslie Proctor (Deputy City Attorney, City of Chesapeake), and George W. Shanks (Miller Earle & Shanks, PLLC, Luray) were elected to three-year terms ending in 2015.

They join the following continuing board members: Frank A. Thomas (Orange); David P. Bobzien (Fairfax); Barbara Ann Williams (Richmond); Hon. Paul F. Sheridan (Arlington); Irving M. Blank (Richmond); Stephen D. Busch (Richmond); Cynthia E. Hudson (Hampton); Angelica D. Light (Norfolk); F. Anderson Morse (Clifton); John M. Oakey Jr. (Richmond); Lucia Anna Trigiani (Alexandria); and J. Page Williams (Charlottesville).

The Virginia Law Foundation, a law-related not-for-profit organization, was established in 1974. Both the Virginia State Bar and the Virginia Bar Association nominate members of its board. Its mission is to promote through philanthropy the rule of law, access to justice, and law-related education. As a grant maker, the Foundation has provided over $23 million to support law-related public service projects throughout Virginia.
In Memoriam

Scott Aaron Ammons
Charlotte, North Carolina
July 1969–May 2012

Robert G. Bailey
Charlottesville
July 1943–January 2007

George F. Ball
Alexandria
February 1926–April 2011

William G. Beninghove
Mechanicsville
March 1933–April 2012

C. Glasgow Butts
South Hill
January 1917–May 2012

Johnny F. Catterton
Richmond
December 1916 – May 2012

L. Shelton Clarke
Richmond
July 1922–December 2011

Kenneth F. Currier
Alexandria
February 1943–March 2012

Raymond A. Delahantry Jr.
Yardley, Pennsylvania
December 1928–April 2012

Fred Gorham Folsom Jr.
Alexandria
September 1914–January 2012

Duval Q. Hicks Jr.
Fredericksburg
March 1920–October 2005

John Le Cato Hummer
Laguna Niguel, California
July 1921–April, 2012

L. Farnum Johnson Jr.
Littleton, Colorado
January 1930–March 2012

Julian O. Von Kalinowski
Los Angeles, California
May 1916–February 2012

William J. Kinnamon Jr.
Fredericksburg
August 1937–April 2012

Louis Koutoulakos
Arlington
August 1917–November 2010

Mark David Krohn
Washington D.C.
March 1959–April 2012

Edwin P. Latimer
Manassas
October 1930–March 2012

Richard L. Lawrence
Roanoke
January 1938–March 2012

Harold Levine
Dallas, Texas
April 1931–February 2011

John L. Lewis III
Powhatan
March 1938–May 2012

William Randall Light
Lynchburg
September 1958–October 2011

Hubert H. Marlow Jr.
Front Royal
December 1933–February 2012

Roderick B. Mathews
Richmond
March 1941–April 2012

Cleyburn L. McCauley
Wilmington, N.C.
February 1929–December 2010

Garland T. McCoy
Lansdowne
March 1922–November 2012

Chandler A. Nelson
South Boston
March 1932–November 2011

Gail Susan Ogle
Charlottesville
March 1955–January 2012

H. L. Opie Jr.
Staunton
March 1916–January 2006

Dabney Lancaster Pasco Jr.
Covington
January 1971–May 2012

Frederick W. Richards
Arlington
October 1921–November 1997

Glenwood P. Roane
Memphis, Tennessee
July 1930–December 2011

Spencer T. Nissen
Alexandria
April 1928–March 2012

Julian D. Sanger
Richmond
March 1918–February 2012

Julian Savage
Chevy Chase, Maryland
February 1919–February 2012

William V. Slaughter
Richmond
December 1912–April 2005

Richmond O. Swim
Virginia Beach
May 1927–April 2010

H. Franklin Taylor III
Richmond
October 1940–March 2012

Hugh R. Thompson Jr.
Richmond
January 1915–August 2005

Thomas Greer Valentine
Richmond
September 1947–May 2012
Local and Specialty Bar Elections

Conference of Local Bar Associations
Plato George Eliades II, Chair
Eugene Millan Elliott Jr., Chair-elect
Mary Margaret Benzsinger, Secretary
George William Nolley, Treasurer
Jack W. Burtch Jr., Member At-Large
Renae Reed Patrick, Member At-Large
Barbara Sattler Anderson, Member At-Large
Rebecca Elizabeth Duffie, Member At-Large
Juan Ever Milanes, Member At-Large
David Wayne Lannetti, Member At-Large
Bernard Alan McGraw, Member At-Large
Petula Cherise Alston Metzler, Member At-Large
Chuong Dong Nguyen, Member At-Large
Edward Laurence Weiner, Immediate Past Chair

Metropolitan Richmond Women's Bar Association
Sakina Karima Paige, President
Colleen Marea Quinn, President-elect
Sharon Choi Stuart, Vice President
Melissa Suzanne VanZile, Secretary
Kimberly Anne Skiba, Treasurer

Powhatan Bar Association
Robert Beman Beasley Jr., President
Tara Dowdy Hatcher, Vice President
Richard Kenneth Cox, Secretary
Philip Leroy McDaniel, Treasurer

The Bar Association of the City of Richmond
Craig Thomas Merritt, President
Anne Gaines Scher, President-elect
John Kirkland Burke Jr., Vice President
The Honorable Melvin R. Hughes Jr., Hon. Vice President
John Tracy Walker IV, Secretary-Treasurer

Virginia Academy of Elder Law Attorneys
Evan Harris Farr, President
Karen L. Fortier, President-elect
Yahne Yvonne Miorini, Vice President
Elizabeth Ellen Bircher, Secretary
Elizabeth Louise Wildhack, Treasurer

Virginia Trial Lawyers Association
Lisa Palmer O'Donnell, President
Barbara S. Williams, President-elect
Thomas Joseph Curcio, Vice President
John Eric Lichtenstein, Vice President
Stephanie Elaine Graña, Vice President
Ronald Lee Livingston, Vice President
Michael Bryan Slaughter, Treasurer

Williamsburg Bar Association
William Hunter Old, President
Gordon Carmalt Klugh, Vice President
Nancy Kahn Bolash, Secretary
Matthew Westcott Smith, Treasurer

Lawyers Helping Lawyers Video Wins Public Relations Award

A video about the value and history of Lawyers Helping Lawyers has won a Capital Merit Award from the Public Relations Society of America — Richmond Chapter. The video, titled “Lawyers Helping Lawyers — Confidential Road to Recovery,” features members of the Virginia legal community discussing substance abuse and mental illness among lawyers and judges and how the organization works to help them overcome their problems. Appearing on the video are William D. Dolan III of Venable, George H. Hettrick of Hunton & Williams, Barbara Ann Williams of McGuireWoods, David S. Mercer of MercerTrigiani, the Honorable Marilynn C. Goss, Thurston R. Moore of Hunton & Williams, Professor Susan S. Grover from the College of William and Mary School of Law, the Honorable R. Terrence Ney, Senior Chief Justice of the Supreme Court of Virginia Harry L. Carrico, the Honorable E. Eugene Luther, legal secretary Barbara Treese, and James E. Leffler, executive director of Lawyers Helping Lawyers.

The award in the “external video programs” category was presented on May 16, 2012, to Patricia C. Hassard, President of GateHouse Communications, during the 65th Virginia Public Relations Awards ceremony at The Jefferson Hotel in Richmond. David S. Mercer developed the video concept and he and his partner, Pia Trigiani, funded production. Originally showcased during September 2010 in recognition of the organization’s 25th anniversary, the video is now presented during CLE seminars conducted for Virginia law firms, law schools, bar associations, and judicial groups.

Virginia Lawyers Helping Lawyers is a non-profit organization using a statewide network of volunteers to provide confidential, 24-hour assistance to attorneys and judges who are experiencing substance abuse or mental health problems. Trained volunteers serve as peer counselors, conduct assessments, implement interventions, provide treatment referrals, monitor rehabilitation contracts, and support family members. For more information on Lawyers Helping Lawyers or to obtain a DVD of the video, contact David Mercer at David.Mercer@MercerTrigiani.com Public Relations Society of America — Richmond hosts the Annual Virginia Public Relations Awards to recognize the most innovative and influential public relations programs of the year. This year more than eighty-nine entries were submitted in twenty-three categories for public relations campaigns and tactics.
Ask judges and senior lawyers to identify the most disturbing things about younger lawyers and they will reply in one voice: “They can’t write.”

Recently, I took part in a Conclave on the Education of Lawyers convened by the Virginia State Bar Section on the Education of Lawyers in Virginia and attended by a number of judges, law school deans and professors, and lawyers involved in bar leadership. The number one issue raised at the conference was that recent law school graduates seem to emerge from their education with such poor writing skills.

With that in mind, I wanted to spread the word about an excellent new book I just finished called Writing to Win: The Legal Writer by Steven D. Stark. The first edition was published twelve years ago. The new edition includes substantial revisions including sections on writing in the digital age (sorely needed).

Mr. Stark has taught legal writing at Harvard Law for more than a decade so he is well-qualified to speak with authority. As he points out, lawyers who improve their writing also improve their credibility and their attractiveness to potential employers.

This book is a pleasure to read because Mr. Stark infuses his own writing with examples of excellent and terrible writing samples from real life along with a good mix of memorable quotations which illustrate his points. I can’t imagine any lawyer (myself included) who wouldn’t benefit from a careful reading of this very timely and effective book.

Sharon D. Nelson is president of Sensei Enterprises Inc., a legal technology, information security and computer forensics firm based in Fairfax, Virginia. (703) 359-0700 or www.senseient.com. She is president-elect of the Virginia State Bar.
An Overview of Patent Prosecution

by Fred Dingledy

Whether it is talk about the new America Invents Act or patent wars between smartphone manufacturers, patents have been appearing in the news quite frequently lately. While most people understand the basic idea of a patent and what it does, the process of obtaining a patent remains shrouded in mystery to many, containing terms of art specific to the field, not to mention terms that take on a special meanings in patent law other than what may normally come to mind.

The process of obtaining a patent is called prosecution — not to be confused with criminal prosecutions. Patents come in different types: utility, design, and plant; but the most common is the utility patent, which covers items designed to produce a useful invention. This article presents a simplified summary of the prosecution process for a utility patent.

Overview of Patent Prosecution

Patent prosecution begins with filing an application with the U.S. Patent and Trademark Office (USPTO). Traditionally, the United States awards patent protection to the person deemed the first to invent. The recently-passed America Invents Act, however, changed that; as of March 16, 2013, the priority for an invention will go to the party deemed “first to file.”

At the USPTO, an examiner evaluates the application. The examiner’s job is to check the application and ensure it adequately discloses what the invention is, how it is made, and how it is used. The examiner will also weigh the claims in the application. In patent law, claim takes on a very specific meaning — it defines exactly what the applicant is seeking patent protection for, the thing the applicant wants no one else to be able to make without the applicant’s permission. Claims must also belong to one of the acceptable categories of patentable subject matter. The subject of the patent must have a useful purpose, and it has to be “novel” and “non-obvious.” Novel means it was never been invented before; non-obvious means it should not be something that any expert in the field could have thought of based on existing technology. This is where the term prior art comes into play — it refers to the state of technological development before an application is filed. To be considered “new,” the invention must be different from the prior art. After the examiner studies the application, the claims will either be accepted or rejected; rejected claims may be amended. Once all the claims are accepted, a patent can be granted.

Free Patent Resources

So now you know the basics of the prosecution process, but what free resources are available to research patents? Fortunately, the USPTO’s website has an excellent patent research section at http://www.uspto.gov/patents/index.jsp. You can use this site to search for patents or patent owners, and get a useful description of the prosecution process. Note that normally patent applications are not made public, or published, until eighteen months after they are filed. An applicant can prevent their application from being published by swearing that they will not file the same patent in any other country, but this is very unusual.

You can use the USPTO’s public PAIR (Patent Application Information Retrieval) system http://www.uspto.gov/patents/process/status/index.jsp to search for file wrappers, which are the collections of filings and communications connected with a patent’s prosecution process. PAIR’s public system contains information about patent applications and patents; the private version is used by patent attorneys and USPTO examiners, and has detailed information on prosecution histories. People who prefer searching Google-style can take advantage of Google’s Advanced Patent Search http://www.google.com/advanced patent_search – a useful tool if you’re trying to find completed patents.

The filed patents themselves are also a source of useful information. The front page of a patent alone will give you information on prior art, who owns the patent, and what classifications the patent was filed under, among other things. Queen’s University has a useful sheet that lists all the information available on the first page at http://library.queensu.ca/webeng/patents/Anatomy_of_a_US_patent.pdf.

Special thanks to Alyssa Altshuler and Pam Cline of Ropes & Gray for their invaluable help writing this article.

Endnotes:

Understanding Botnets

by Blackwell N. Shelley Jr.

Recent news stories have reported that hacker groups, such as Anonymous and LulzSec, have threatened or carried out distributed denial of service (DDoS) attacks on websites in response to, for example, the arrests of Julian Assange and Kim Dotcom, and the threatened passage of the Stop Online Piracy Act (SOPA). The basic idea of a DDoS attack is simple: all websites are based on computer servers that can accept a finite number of simultaneous connections. To effectively shut down a website, hit it with more simultaneous connections than it can handle. Orchestrating the simultaneous attack requires a botnet.

A botnet is a network of computers that have been compromised by a malicious computer program (a "bot") and surreptitiously programmed to follow instructions issued by a different computer. The compromised computers in a botnet, sometimes called nodes or zombies, are typically home or office desktop computers. The hacker who issues the command and control instructions to the botnet is called a bot herder or bot master.

The user of a zombie computer is rarely aware that the machine has been compromised because the process usually starts quietly, either by exploiting vulnerability in the computer’s software or security system, or by tricking the user into installing the malicious code. Examples of this are varied, but include old school hacking (“password1” is not a strong password), or through bogus software (that animated screensaver that you downloaded for free, for example), or through deceptive email (“RE: Why did you put this photo online?”). The hacker, the bogus software, and the link sent through deceptive email all have the purpose of installing unwanted and malicious code — the bot — on the user’s computer.

Technically sophisticated bot herders might choose to write the malicious code themselves, but as with so much on the Internet, bot creation has been simplified by the use of malware kits. These kits are collections of software tools that enable aspiring bot herders to assemble their own bots by creating and spreading customized malware variants. Some malware kits have been published as free open source code, and offer discussion forums for users to suggest new features and modules for the malware, report bugs and other errors, or enter into discussion with their fellow developers. Other kits are developed by individuals or groups and sold like legitimate commercial software products. For bot herders with money and little time, independent contractors will make bespoke code according to the bot herders’ needs.

By keeping a low profile, bots are sometimes able to remain active and operational for the life of the computer. Most office and residential Internet services are now high-speed, always-on connections that provide the bot-herder with a large contingent of accessible zombies. Botnets are attractive to criminals because investigators typically cannot follow the trail past the innocent owner of a zombie computer.

After the bot has infected the user’s computer, it attempts to contact a centralized command and control server in order to get its instructions from the bot herder. A bot herder has several choices when setting up this command and control server. If the bot herder has already gained access to a compromised computer, he or she may install the server software on it. Other choices include establishing secret channels on public Internet Relay Chat servers, setting up servers on the bot herder’s own computer, or signing on with a provider that resists or ignores efforts to disconnect lawbreakers.

Once the botnet is up and running, it can be used to carry out a variety of criminal activities. Apart from the Denial-of-Service attacks, described above, a botnet may be used to steal the confidential information stored on each infected computer, as a spam generator, or for click fraud, depending on how the bot herder chooses to configure the individual nodes. A botnet can also be self-propagating, as a means of distributing more of the malicious code. With time and patience, a bot herder can use this latter technique to build networks of thousands of infected computers.

Notwithstanding the publicized attacks and threats of “hacktivist” groups like Anonymous and LulzSec, bot herding is almost entirely a for-profit endeavor. In May, 2012, an Armenian court sentenced 27-year-old Georgy Avanesov to four years in prison following his con-
viction on charges of computer sabotage. Avanesov, prosecutors said, was part of a group of bot herders making about $125,000 a month by renting out a botnet comprised of some 30 million zombie computers worldwide and 143 command and control servers in France and the Netherlands.7 In an April, 2012, post on Reddit,8 an admitted bot herder, who used the handle Throwaway236236, offered this prediction:

The whole fraud system will soon escalate and only then people will start worrying about the fundamental flaws in the system. Antiviris don’t work, firewalls never helped, fraud detection systems are blind when abusing the victim computer as a proxy. The only cure is strong cryptography and simple yet unbreakable solutions, even if it’s inconvenient. Some European countries for example already use private/public key authentication for banking and only allow credit cards with chips. Magnetic stripes are the most hilarious thing ever, but still work almost everywhere on the globe. Today Cybercrime is already more profitable than drug dealing and it will grow even further.

When asked by other users how to stay secure on line, Throwaway236236 offered the following suggestions:9

• If the attachment is ending in .exe and pretending to be something else, it’s malware for sure. …

• Facebook friends don’t share funny cat pictures on randomly generated domain names.

• If your AV says it’s clean … it can still be malware, been there, seen that. Srsly, don’t trust your AV.

• Windows updates, yes, do them. If you have a pirated copy, just buy that s**t or use linux.

• Scan your [network] traffic while your PC is idle and see if you find something suspicious …

• Read a blog from [antivirus] vendors … That stuff is interesting and you are always informed what most common threats are.

• Most important: Try to step out of your consumer role, think about how malware works. The core functions of malware all work the same and are very fragile.

Endnotes:
5 IRC is a real-time Internet chat protocol, designed for group text-based conferencing. An IRC “channel” is a named chat group which will all receive messages addressed to that channel. The Internet Engineering Task Force (IETF), "Internet Relay Chat Protocol, Section 1.3 Channels", available at https://tools.ietf.org/html/rfc1459 (last visited June 10, 2012).
6 Recently, botnets that use peer-to-peer (P2P) networks for remote control of the compromised machines have appeared in the wild. A P2P botnet does not use a central command point; instead, each zombie computer passes on instructions to each other zombie in the botnet. The lack of a centralized command and control server makes P2P botnets more difficult to shut down and the command source more difficult to track. See The Hacker News, "Thor, another P2P botnet in development," available at http://thehackernews .com/2012/03/thor-another-p2p-botnet -in-development.html (last visited June 10, 2012).
9 Id.
Lawyer’s Duty of Confidentiality and Securing Your Smartphone and Handheld Device

by Wendy F. Inge
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What’s not to love about a smartphone? It’s a great tool for keeping up while on the go. And smartphones aren’t just phones; they’re computers. The use of smartphones and other mobile devices such as iPads is pervasive, and lawyers too have embraced them.

But as with all technology used by lawyers, we have certain ethical duties that apply. State bars have consistently held that the use of technology, such as e-mail, cloud computing and portable devices requires consideration of the rules of professional conduct addressing competency and confidentiality. Specifically, lawyers using this technology should be competent in understanding the technology (Rule 1.1 Competence) and how its use might impact the client either positively or negatively. Also, the lawyer needs to act diligently to protect client confidences and ensure that client information remains secure (Rule 1.6 Confidentiality of Information).

Inherent Risks
As we all know, the risks inherent in using any device that stores or accesses our data are that it will be hacked, corrupted, misused, or stolen. Specific to smartphones, hacking and corruption can occur through the downloading of applications that are corrupted or contain malware. Theft of information can occur if the device is lost or stolen. In order to protect the sensitive information and the client, and to fulfill your ethical duties, you must secure your mobile devices.

Who Owns the Device?
One of the first things to consider when giving employees access to client and corporate data remotely is who is going to own the device. It may be preferable from a security and policy standpoint for the firm to own the mobile devices used by employees. It makes it easier to set policies and controls when the firm owns the asset. This also allows the firm to select the wireless carrier and the device that will be used by the employees.

If you don’t own the devices being used by employees to access data on your network you may want to consider using a Mobile Device Manager (MDM). An MDM sits between your infrastructure and the mobile device. It can be installed on your network or provided by a host, such as your wireless carrier. It allows you to identify what devices should be allowed to connect to the network and can regulate security policies that are to be applied to the devices. To read more about MDMS, see Smartphones for Lawyers: Selecting, Managing and Securing Them by Sharon Nelson and John Simek of Sensei Enterprises.

Securing Your Mobile Devices
Your firm should make it a policy that lawyers and staff using mobile devices that have access to client information follow these security procedures.

Encrypt Data: Encrypt the data on the phone and the expansion card if applicable. BlackBerry, Android varieties, and iPhones have varying levels of encryption available. (Many argue the Blackberry is the most secure because of the inherent encryption on the phone and during the communication.) You may need additional third-party software to get certain functions to upgrade the base phone if necessary. Just note however that for iPhones third-party software for encryption is not available.

Manufacturer’s Security Recommendations: Follow security recommendations from the wireless carrier and phone manufacturer.

Password Protection: All smartphones, tablets, laptops, and mobile devices must have password protection. Your firm should have a password policy for all mobile devices (desktops too) requiring use of a strong password prior to use of the device. Use power on passwords and enable auto-lock features (phone automatically locks after a period of time) to protect all devices that carry data about a client or their matter. If able, use a strong password that is a combination of uppercase and lowercase letters, numbers, and symbols, and is a minimum of eight characters long. For more on smart passwords see Don’t Trifle with Password Safety by Vivian Manning. Also, some apps will allow you to set up an additional pass code. If you are using an app that will contain sensitive data, create an additional pass code. Finally, some smart phones, like the iPhone, can be set to erase all data after ten failed attempts to
Risk Management

Login: this feature provides additional security if the device is lost or stolen.

Physically Protect the Device: Keep your device with you and under your control at all times. (Don’t lose or misplace it, or lend it to others.)

VPN Connection Only: If using the device to connect to the office network, only ever do so by way of a secure VPN connection. Text messages, email, and documents should never be sent in an unencrypted format, which means don’t do any work using a Wi-Fi signal.

Limit Bluetooth: Only enable Bluetooth functionality when you need to use it. For all other times, turn it off.

Backup Your Data: Devices do get lost, are stolen, or sometimes simply get destroyed. Accidents do happen, so make sure any critical data is backed up.

Remote Data Wipe: Install and use a remote data wipe application on all mobile devices. This may require a third-party application. If your phone or device were lost or stolen you need to be able to wipe the data clean so that the thief or others would not be able to hack into it (because of course it has a strong password.) The Android market has hundreds of different apps that will provide this service, some free and some for a fee, but be careful to install only a reputable product (AndroidForums.com). You should pick one that is highly rated and that comes from a reliable source such as the Android market place (Google) or the iPhone app store. For droid users consider “AGV Antivirus Pro.” For iPhone users check out “Virus Barrier.” Some products will provide both antivirus protection and remote wiping ability.

Applications: Do your research and only install applications from trusted sources. There have been problems with malware apps when downloading from iTunes and caution is even required in the Android store.

Equipment Upgrades: When the time comes to upgrade user phones, make certain that all data on the old phones is wiped prior to recycling. One way this can be done is by resetting the device to factory settings. Prior to taking this step, however, make certain that any data you want saved has been copied to another device or computer prior to restoring to factory settings. Be aware that factory resets do not erase data on any microSD cards. That data must be taken care of separately.

Finally, a disclaimer. This risk management information is provided by ALPS as general information only. It is not intended to be used or relied on as legal advice. Also, as technology changes quickly, this information may become out-dated. ALPS does not endorse any products. Readers should always engage in their own research and evaluation of products and services.

Wendy Inge is the Virginia risk manager for Liability ALPS, the Virginia State Bar-endorsed legal liability insurer. She is available to answer risk management questions at no charge for all members of the VSB. She can be reached at (800) 367-2577.
Remarks continued from page 16

I am not humorless, but it hits me when I hear the ubiquitous lawyer jokes, and I laugh at most of them.

It hit me recently when I realized how few lawyers there are now in the General Assembly — less than a third of the members. When I was first elected to the House some thirty-five years ago, almost three quarters of the members of the General Assembly were lawyers. The best, most substantive

fostering more and more tight specialization. In many regards wisely, we’ve become very conscious of conflicts of interest, and often preclude ourselves, and our law partners, from sitting on boards — public or private — with which we may do business in our practices.

The past few decades have brought us an increasing number of excuses for avoiding summons to leadership as a profession.

Shaped by practice, lawyers have skills which are sorely missed when absent in public affairs.

debates came up on the floor when a lawyer legislator would ask a penetrating question that hadn’t been considered in committee. Citizen lawyers have been at the heart of the work of the General Assembly.

When I look at civic organizations today in Virginia, I likewise also often find myself wondering, where are the citizen lawyers?

Automated contracts, lawyer jokes, nervous law students and burned-out lawyers point to a real unease with, and in, the profession. Our thinning ranks in the General Assembly and civic organizations, even bar activities, point to diminished leadership by citizen lawyers.

I think the unease and our diminished leadership are related.

Let me explain.

Over the past generation or so, to be sure, the billable hour, especially in the larger firms, has come to lord it over us like never before. The dizzying array of statutes and regulations has only grown, demanding more and more time of us to keep pace, and

You’ve heard these responses, I’m sure: “I’m too busy,” “It’s outside what I do,” “I can’t, because I have a potential conflict.” Any of these, in any given circumstance, may be utterly appropriate for any one of us, individually, to say.

We may, though, have begun to say them collectively as a profession.

When we don’t rise to service, and our profession fails to deeply encourage it, it’s not entirely surprising that law students become nervous and lawyers become burned out — because I believe lawyers choose the profession and go into practice in order to contribute to the public good. Lawyers are practical, but lawyers also — especially the best — have a twinge of idealism, a yearning to do good, to act as citizen lawyers, in the long tradition.

Much of the dissatisfaction in the profession, I think, stems from frustration in not engaging in earnest in that tradition so proudly established in the commonwealth many generations ago.

In my judgment, we would very much help ourselves by a new devotion, as a profession, to leading as citizen lawyers. We would help our image and understanding with the public as well.

But, most importantly, we would also further contribute to the public good, in vital ways, that others — non-lawyers — simply cannot accomplish with the same honed ability. Shaped by practice, lawyers have skills which are sorely missed when absent in public affairs.

Maybe we don’t enunciate these skills often enough.

Consider them with me quickly. On reflection I think it’s clear what is missing when we don’t offer them to the public good.

These “lawyers skills” fall into three basic categories — to my way of thinking. Put very simply, lawyers are good at connecting the dots; we’re good with language; and we’ve typically got a good “people sense.”

Let’s look briefly at each of these.

1. Good at Connecting the Dots.

Lawyers by profession assess risk all the time. All the time we’re thinking “how does this affect that?” We do this in almost everything we do — cases, contracts, transactions, advising.

Having to assess risk all the time leads to a honed sense for trends, especially with the government, which is, really a machine made up of laws. Sensing trends — connecting the dots — is very important. Again and again throughout our history in Virginia and America, lawyers have stood to protect freedoms: Jefferson for religion, Lincoln against slavery, Thurgood Marshall for civil rights.

This logical thinking, risk assessing, leads also to a honed sense for trends, especially with the government, which is, really a machine made up of laws. Sensing trends — connecting the dots — is very important. Again and again throughout our history in Virginia and America, lawyers have stood to protect freedoms: Jefferson for religion, Lincoln against slavery, Thurgood Marshall for civil rights.

Lawyers have always known that the old saying from Shakespeare — “First thing we do, let’s kill all the lawyers” — is not a reproach but a compliment. Lawyers are especially entrusted to be guardians — whom tyrannizing and demagogic forces (at
loose today, just as in history) would just as soon not have around.

2. Good with Language.
   Lawyers, because we tend to write every day, tend to write well and precisely. And also, since by profession we’re required to speak frequently, we tend to speak well. Also importantly, with their practiced precision with language, lawyers tend to listen well too, and get to the heart of matters.

   Language is crucial. The written word is what the public has to memorialize agreements and set policy and law. The spoken word is the means to explain and debate, so plainly vital to democracy.

3. Good “People Sense.”
   Lawyers, because of what we do — in our practice, our pro bono work, in our duties as citizen lawyers — deal substantively with lots and lots of people doing lots and lots of different types of things — things the details of which lawyers come to have a real sense of. Because lawyers know and deal with so many different people in such detailed ways, we tend to be good at directing traffic — at making connections: “Oh you need help with this — well, Jones might be good to talk to; you might also try Smith.”

   Related to this: law is a profession that especially has in it a real diversity of people too, something I’m very proud of. Lawyers, maybe a little more than the average person, know people of all colors and all stripes — making them even better at making connections.

   On the “people sense” front as well, because of all of the people lawyers deal with and all of the human drama we witness, lawyers often have a good, quick sense of what motivates people.

The public good — government and civic life — fundamentally depends on citizen lawyers, present from the beginning of the American experiment in free society, and depends on citizen lawyers’ rare abilities — to clarify, to harmonize.

   I’m preaching to the very faithful here, of course, my friends. You carry the tradition.

   Indulge me here, to close with a few thoughts.

   You are citizen lawyers and leaders of the law. So, keep serving — and offer time to wrap things up and say thanks very much.

   Very candidly, whether Republican or Democrat, consider public office. If not you, then who?

   Find a young lawyer of promise — or two — or three — and tell them with conviction that they are a part of the Virginia tradition, unbroken, of citizen lawyers, with duties to the commonwealth and the public good.

   We can help with the needed revival of the citizen lawyer, already alive among you here. The way I see things, anything awry can be set straight, and our profession, already storied, should ensure that storied days are still ahead. That’s the way our predecessors thought. That’s what they would want us to do — all across Virginia.

   There’s one other thing they might want me to say: It’s been a long day. It’s
### Introduction to Virginia’s Sentencing Guidelines — six-hour seminars, 9:30 AM – 5 PM
- **August 9** — Richmond
  Henrico County Training Center
  7710 E. Parham Road

- **August 17** — Wytheville
  Wytheville Community College
  1000 E. Main Street

### Advanced Sentencing Guidelines Issues and Ethical Hypotheticals — six-hour seminars, 9:30 AM – 5 PM
- **October 12** — Roanoke
  Roanoke Higher Education Center
  108 N. Jefferson Street

- **October 16** — Portsmouth
  Department of Social Services
  1701 High Street

### Refresher Regional Sentencing Guidelines Topics — three-hour seminars, 9 AM – 10 PM or 1 PM – 4 PM
- **September 25** — Richmond
  Henrico County Training Center
  7710 E. Parham Road

- **September 27** — Chesapeake
  Sheriff’s Department
  401 Albermarle Drive

- **October 11** — Abingdon
  Southwest VA Higher Education Center
  One Partnership Circle

Virginia Lawyer publishes at no charge notices of continuing legal education programs sponsored by nonprofit bar associations and government agencies. The next issue will cover October 15, 2012, through December 16, 2012. Send information by September 7 to hickey@vsb.org. For other CLE opportunities, see Virginia CLE offerings below and “Current Virginia Approved Courses” at http://www.vsb.org/site/members/mcle-courses/ or the websites of commercial providers.

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### Virginia CLE Calendar
Virginia CLE will sponsor the following continuing legal education courses. For details, see http://www.vacle.org/seminars.htm.

#### July
- **23**
  Estate Planning for Unmarried Adults
  Telephone, NOON – 2 PM

- **24**
  Recent Developments in the Law: News from the Courts and General Assembly Video — Norton
  9 AM – 4:55 PM

#### August
- **7**
  Telephone, 9 AM – 12:15 PM

- **14**
  Absent Employees: AWOL or Protected?
  Telephone, NOON – 2 PM

- **15**
  Immigration Ethics
  Telephone, NOON – 2 PM

- **15**
  Traffic Offenses: Your First Case
  Telephone, 3 – 5 PM

- **21**
  Attorney Fee Awards and Sanctions
  Telephone, NOON – 2 PM

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### Brief Writing a Chore?
I have spent thirty years representing a large federal agency in EEO and other kinds of cases in federal district and appellate courts. Over the last twenty years, I have been attorney of record in over 150 cases in the federal appellate courts.

Let me do what I do best: write persuasive briefs and memoranda, while you build your practice servicing and representing your clients.

Writing samples available.

David G. Karro
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briefs4lawyers@gmail.com
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<td>September 18</td>
<td>Title Insurance</td>
<td>Live — Lexington, SCHEDULE: TBD</td>
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<tr>
<td>September 18</td>
<td>Tort-Related Damages</td>
<td>Live — Charlottesville/Webcast/Telephone, 3–5 PM</td>
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<tr>
<td>September 19</td>
<td>DUI Defense in Virginia</td>
<td>Live — Richmond, 9 AM–4:15 PM</td>
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<tr>
<td>September 19</td>
<td>Ethics Tsunami: Surviving the Rising Tide of Legal Ethics Complexity</td>
<td>Live — Fairfax, 9 AM–12:15 PM</td>
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<tr>
<td>September 19</td>
<td>Life Insurance</td>
<td>Live — Charlottesville/Webcast/Telephone, 10 AM–NOON</td>
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<tr>
<td>September 20</td>
<td>Ethics Tsunami: Surviving the Rising Tide of Legal Ethics Complexity</td>
<td>Live — Richmond, 9 AM–12:15 PM</td>
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<tr>
<td>September 20</td>
<td>Title Insurance</td>
<td>Live — Williamsburg, SCHEDULE: TBD</td>
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<tr>
<td>September 20</td>
<td>Representation of Children as a Guardian ad Litem 2011</td>
<td>Video — Abingdon, Alexandria, Charlottesville, Fairfax, Richmond, Roanoke, Virginia Beach 8:30 AM–5:15 PM</td>
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<tr>
<td>September 21</td>
<td>Commissioner of Accounts</td>
<td>Live — Fairfax, SCHEDULE: TBD</td>
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<td>September 21</td>
<td>Commissioner of Accounts</td>
<td>Live — Richmond, SCHEDULE: TBD</td>
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<tr>
<td>September 24</td>
<td>Medicare</td>
<td>Telephone, 10–NOON</td>
<td></td>
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<td>September 24</td>
<td>Navigating the CPS Maze</td>
<td>Telephone, NOON–1 PM</td>
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<tr>
<td>September 25</td>
<td>FRAUD — The Most Used and Least Understood Cause of Action: Allegations, Defenses, and Practice Tips</td>
<td>Live — Fairfax, 9 AM–1:05 PM</td>
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<td>September 25</td>
<td>Commissioner of Accounts</td>
<td>Live — Roanoke, SCHEDULE: TBD</td>
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<tr>
<td>September 25</td>
<td>Current Ethical Dilemmas Facing the Family Law Practitioner</td>
<td>Telephone, 10–11 AM</td>
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<tr>
<td>September 27</td>
<td>Title Insurance</td>
<td>Live — Fredericksburg, SCHEDULE: TBD</td>
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<tr>
<td>September 27</td>
<td>Business-Related Damages</td>
<td>Live — Charlottesville/Webcast/Telephone, NOON–2 PM</td>
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<tr>
<td>September 27</td>
<td>The Top 10 Malpractice Mistakes (and How to Avoid Them)</td>
<td>Telephone, 3–4:30 PM</td>
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<th>Details</th>
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<tr>
<td>September 28</td>
<td>Commissioner of Accounts</td>
<td>Live — Virginia Beach, SCHEDULE: TBD</td>
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<tr>
<td>September 28</td>
<td>13th Annual Virginia Information Technology Legal Institute — 2012</td>
<td>Live — Fairfax, 8 AM—4:25 PM</td>
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<tr>
<td>September 28</td>
<td>Eminent Domain Law in Virginia</td>
<td>Live — Charlottesville, SCHEDULE: TBD</td>
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<tr>
<td>September 28</td>
<td>Life Insurance</td>
<td>Telephone, 10 AM—NOON</td>
</tr>
<tr>
<td>October 2</td>
<td>Recent Developments in the Law: News from the Courts and General Assembly</td>
<td>Video — Alexandria, Charlottesville, Richmond, Roanoke, Virginia Beach 9 AM—4:55 PM</td>
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<tr>
<td>October 3</td>
<td>Trials of the Century</td>
<td>Live — Richmond, 8:55 AM—4:15 PM</td>
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<tr>
<td>October 3</td>
<td>Depositions 101: Exploring the Basics</td>
<td>Telephone, 3–5 PM</td>
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<tr>
<td>October 4</td>
<td>Trials of the Century</td>
<td>Live — Fairfax, 8:55 AM—4:15 PM</td>
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<tr>
<td>October 4</td>
<td>Recent Developments in the Law: News from the Courts and General Assembly</td>
<td>Video — Tysons Corner, 9 AM—4:55 PM</td>
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<tr>
<td>October 4–5</td>
<td>5th Annual Advanced Business Litigation Institute</td>
<td>Telephone, NOON—2 PM</td>
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<tr>
<td>October 9</td>
<td>Exit Strategies for the Business Owner</td>
<td>Telephone, 10 AM—NOON</td>
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<tr>
<td>October 9</td>
<td>Covenants Not to Compete</td>
<td>Telephone, NOON—3 PM</td>
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<tr>
<td>October 10</td>
<td>Ethics Tsunami: Surviving the Rising Tide of Legal Ethics Complexity</td>
<td>Video — Alexandria, Williamsburg 9 AM—12:15 PM</td>
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<tr>
<td>October 11</td>
<td>Ethics Update for Virginia Lawyers 2012</td>
<td>Live — Charlottesville/Webcast/Telephone, NOON—2 PM</td>
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<tr>
<td>October 11</td>
<td>Ethics Tsunami: Surviving the Rising Tide of Legal Ethics Complexity</td>
<td>Video — Charlottesville, Hampton, Richmond, Roanoke, Tysons Corner, Virginia Beach, Warrenton 9 AM—12:15 PM</td>
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<tr>
<td>October 11</td>
<td>Civil Practice in the General District Court</td>
<td>Telephone, NOON—2 PM</td>
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<tr>
<td>October 12–13</td>
<td>42nd Annual Advanced Business Law Seminar</td>
<td>Live — Williamsburg, SCHEDULE: TBD</td>
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<tr>
<td>October 15</td>
<td>Business-Related Damages</td>
<td>Telephone, NOON—2 PM</td>
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<tr>
<td>October 16</td>
<td>FRAUD — The Most Used and Least Understood Cause of Action:</td>
<td>Video — Abingdon, Alexandria, Danville, Hampton, Richmond, Roanoke 9 AM—1:05 PM</td>
</tr>
<tr>
<td>October 16</td>
<td>Tom Spahn on Unauthorized Practice of Law and Multi-Disciplinary Practice</td>
<td>Live — Charlottesville/Webcast/Telephone, 11 AM—1 PM</td>
</tr>
<tr>
<td>October 17</td>
<td>Appellate Practice</td>
<td>Live — Richmond, SCHEDULE TBD</td>
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<tr>
<td>October 17</td>
<td>DUI Defense in Virginia</td>
<td>Video — Abingdon, Alexandria, Charlottesville, Danville, Fredericksburg, Hampton, Richmond, Roanoke, Virginia Beach, 9 AM—4:15 PM</td>
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<tr>
<td>October 17</td>
<td>Tort-Related Damages</td>
<td>Telephone, NOON—2 PM</td>
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**Young Lawyers Conference**

**Professional Development Seminar**

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<tr>
<td>September 21, 2012</td>
<td>10:00 AM to 5:00 PM</td>
<td>Two locations this year:</td>
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<tr>
<td></td>
<td>Richmond:</td>
<td>Hunton and Williams, Riverfront Plaza, 951 East Byrd Street</td>
</tr>
<tr>
<td></td>
<td>Washington, DC:</td>
<td>Hunton and Williams, 2200 Pennsylvania Avenue, NW (Metro: Foggy Bottom-GWU)</td>
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<tr>
<td></td>
<td>Featuring:</td>
<td>• Quality Writing — Rachel Dufault, Copy Editor at Bloomberg BNA, Arlington, VA</td>
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<tr>
<td></td>
<td></td>
<td>• The Exceptional Oral Presentation — Alec Farr, Partner, Bryan Cave, Washington, DC</td>
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<td>• Dealing with the International Client and Climate — Jay Range, Partner, Hunton and Williams, Washington, DC</td>
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<td>More information at <a href="http://www.vayounglawyers.com">www.vayounglawyers.com</a></td>
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</table>
Robert Lee Aston has been awarded a prestigious special award by the Georgia State Bar Military Legal Assistance Program for pro bono work for war veterans, mainly WWII and Vietnam, in obtaining more than 104 combat medals for veterans’ meritorious and heroic actions that they had not received due to military administrative error or oversight.

Sonja N. Aoun and Jennifer L. Stanford, formerly of Aoun & Stanford PC, are pleased to announce that Aoun has joined the law offices of Mark R. Dycio PC, where she will continue her family law practice. Stanford is leaving the private practice of law to pursue a career in the federal government.

Edward Grantland Burns has joined America Fujikura Ltd. as vice president and general counsel in Spartanburg, South Carolina. He is responsible for all legal matters, including corporate governance, intellectual property, human resources, litigation, and securities compliance as well as government affairs.

Claire G. Cardwell, of Richmond, William E. Glover, of Fredericksburg, and John E. Lichtenstein, of Roanoke, have been chosen as fellows of the American College of Trial Lawyers. Thomas T. Albro, Virginia state chair, said an invitation to be a Fellow is extended only to trial lawyers who have mastered the art of advocacy and whose professional careers have been marked by the highest standards of ethical conduct, professionalism, civility and collegiality. Lawyers must have a minimum of fifteen years of trial experience before they can be considered for fellowship. Membership in the college cannot exceed one percent of the total lawyer population of a state.

Howard Feller, a partner in McGuireWoods LLP’s antitrust and trade regulation practice group in Richmond, has been nominated to be vice chair of the American Bar Association Section of Antitrust Law, effective August 2012. He will then serve as the chair-elect in August 2013 and will later be the chair of the ABA Antitrust Section, effective August 2014.

Andrew A. Gore has become an associate attorney with Greehan, Taves, Pandak & Stoner PLLC, practicing out of the Woodbridge office.

Hunton & Williams LLP announces its annual partner promotions. In Richmond, lawyers Steven M. Haas and Brian L. Hager were admitted to the partnership. Steven M. Haas, a member of the firm’s corporate team, concentrates his practice on mergers and acquisitions, corporate law and corporate governance. Brian L. Hager’s practice focuses on representing public and private companies in connection with mergers and acquisitions, securities offerings, and corporate and securities laws.

Patrick C. Henry II has joined The Marrs Law Firm PLLC as an associate attorney, at its offices at 7272 Glen Forest Drive, Suite 307, Richmond, VA 23226. He will continue his practice in civil litigation, with an emphasis on complex business and personal cases, construction law, and business-to-business collections.

Bradley Phipps Marrs has formed The Marrs Law Firm PLLC, with offices at 7272 Glen Forest Drive, Suite 307, Richmond, VA 23226. Marrs was previously a co-founder and, for more than twenty years, the head of civil litigation at Meyer, Goergen & Marrs P.C. He will continue his practice in civil litigation, with an emphasis on complex business and personal cases, construction law, and business-to-business collections.

Kathleen McMahon McDaniel, formerly of McGuireWoods LLP, has opened Kathleen M. McDaniel PLLC in Gloucester County. The firm’s focus is on juvenile and education law, social security disability benefits, employment law, ERISA litigation, family law, and work as a guardian ad litem. The office is located at 2894 George Washington Memorial Hwy, Hayes, Virginia 23072 and easily accessible to Mathews, Gloucester and York Counties, as well as the cities of Williamsburg and Newport News. (804) 302-4540 (o), (804) 302-4551 (f), kate@kmcdaniel-law.com.

Eugene C. Miller is a partner at the new firm of Weiner, Spivey & Miller PLC. Miller joined the firm in 2011 after twenty-five years as the managing attorney for the office of GEICO Staff Counsel in Fairfax. He has extensive experience in personal injury litigation, in depth knowledge of insurance coverage issues and insurance company policies and procedures.

Sharon D. Nelson has been named winner of the 2012 Small Business Leadership Award by Women in Technology, an organization of professional women in the technology community. Nelson is president of Sensei Enterprises.

G. Michael Pace Jr. has been selected to receive the Patrick Henry Award, given by the Wilson Center for Leadership in the Public Interest at Hampden-Sydney College.

William B. Poff has been honored with the Roger D. Groot Professionalism Award from the Ted Dalton American Inn of Court in Salem. Poff was president of the Virginia State Bar in 1981–82 and is a master in the American Inns of Court.

Lisa A. Robertson has become a senior associate attorney with Greehan, Taves, Pandak & Stoner PLLC practicing out of the Woodbridge office. She is the former deputy city attorney in Charlottesville and will focus on local government, land use, procurement, growth management, and advising of local boards of supervisors on a myriad of issues.

Anne Rocktashel has joined The Welter Law Firm PC as an associate in its Northern Virginia office. Rocktashel will focus on employment litigation, business torts, commercial matters, and business law.
Daniel B. Schy will join the law offices of Derek P. Richmond as an associate focusing on family law. Schy previously worked for Legal Services of Northern Virginia.

Jonathan Stone has joined Norris & St. Clair PC as an associate in the Virginia Beach office. His practice will focus on construction law and commercial litigation.

Joanna L. Suyes has joined the Social Security team at Marks & Harrison law firm where she focuses on obtaining disability insurance and supplemental security income benefits for clients. She also handles personal injury and Fair Labor Standard Act cases for the firm.

Benjamin J. Trichilo has become a principal in McCandlish & Lillard PC. He joined the firm last spring as counsel in its litigation and health care groups. His main practice areas include insurance defense, personal injury, professional malpractice, workers compensation, and sports injury claims.

Matthew Von Schuch has joined Wharton Aldhizer & Weaver PLC. He works in the litigation practice group with a focus in civil litigation. He previously tried matters in the Federal District Court and bankruptcy courts through his work at the United States Department of Justice. He was the lead counsel on a variety of cases, including fraudulent transfer, interpleader, trust fund recovery penalty, tax refund, and bankruptcy cases. Von Schuch also served as a Special Assistant United States Attorney in the United States Attorney’s Office for the Eastern District of Virginia where he prosecuted a variety of felony and misdemeanor offenses.

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74th Annual Meeting
Virginia Beach
June 14–17, 2012

The Virginia State Bar’s Seventy-fourth Annual Meeting blew into Virginia Beach on brisk ocean breezes. W. David Harless was sworn in as president of the VSB, succeeding George Warren Shanks. Sharon D. Nelson became president-elect.

A highlight was the second of what will probably become the annual “Judiciary Squares” CLE, sponsored by the Young Lawyers Conference. The “squares”—Honorable all—were Jane Roush, Robert W. Wooldridge, S. Bernard Goodwyn, Angela E. Roberts, Cleo Powell, B. Waugh Crigler, Rossie D. Alston Jr. and his dummy, Deborah S. Roe, and Robert J. Humphreys.

More than 300 lawyers attended this CLE, which is modeled on the old Hollywood Squares show, and watched the contestants—usually—get the answers right.

The day was packed with events and CLEs on everything from antitrust to trusts. Seminars included construction law/local government law, criminal law, health law/general practice, litigation, real property/taxation, administrative/environment, bankruptcy law, and family law.

The Virginia Legal Aid Award Luncheon featured, for the first time in the 20-year history of the event, two recipients—R. Peyton Whiteley and Abigail Turner. As Justice William Mims pointed out in his opening remarks at the luncheon, Whiteley and Turner both lived their lives as if they had taken to heart the words from Micah 6:8: “And what doth the Lord require of thee, but to do justly, and to love mercy, and to walk humbly with thy God?”

Later on Friday was the first Diversity Conference annual meeting. Clarence M. Dunnaville Jr. became the first recipient of the conference’s award, which will be named in his honor. He accepted the award and joked that, “I’m not dead yet.”

The speaker there was former Justice John Charles Thomas, who harkened back to his early career as a newsman to present the who, what, when, where, why, and how of “diversity.” He allowed that our society has come a long way, but we can’t rest. “We could lose this,” he warned.

Events at the annual meeting included multiple award ceremonies, the Council Reception and Dinner, the Friday night President’s Reception and Annual Banquet, the Lawyer’s Expo, a raffle for a free trip to the Midyear Seminar in Rome and, of course, bingo.
1. The Senior Lawyers Conference recognized more than 150 lawyers who had been members of the VSB for fifty years. Two dozen posed for a group picture at the General Session.

2. Michael HuYoung, chair of the Diversity Conference, presented the inaugural Diversity Conference Award to Clarence M. Dunnaville Jr., for whom the award will be named.

3. R. Peyton Whiteley (left) and Abigail Turner each received the Virginia Legal Aid Award at a luncheon hosted by the Special Committee on Access to Legal Services. The awards were presented by President Shanks.

1. Eugene M. Elliot (left), Nancy M. Reed and Edward L. Weiner joined in the festivities at the Conference of Local Bar Associations annual meeting and breakfast. The CLBA handed out fifteen Awards of Merit and Certificates of Achievement.

2. Judge Rossie D. Alston Jr., of the Virginia Court of Appeals, and his alter-ego Little Bro, were among the "celebrities" who participated in the Judiciary Squares—Civil Procedure Edition CLE program sponsored by the Young Lawyers Conference.

3. W. David Harless was sworn in as the 2012-13 VSB president as his wife, Debbe, held the Bible that Harless's mother gave him when he graduated from high school.

4. Virginia Supreme Court Justice William C. Mims gave the keynote address at the Virginia Legal Aid Award Luncheon in the Orion’s Roof dining room on Friday.

5. The Annual Meeting was packed with CLE programs, including this one Friday by the Litigation Section titled “Demise of the Civil Jury Trial: Change for the Better?”

6. Newly sworn-in President W. David Harless was surrounded by his bow-tied University of Virginia Law School classmates, class of 1981, after the Friday night banquet. They are (from left) Matthew L. Jacobs, John A. Anderson, the Honorable Michael Urbanski, William R. Van Buren III, T. Mark Flanagan Jr., Terence Murphy, and Steve Pearson.
1. Among those leaving the Council were left to right (first row): Jean K. Niebauer, Michael HuYoung, Andrea L. Bridgeman, Christy E. Kiely, Irving M. Blank, and (back row): Hugh T. Antrim, George Warren Shanks, Patrick B. McDermott, Wayne R. Hairfield, Robert L. Calhoun.

2. Douglas R. Burtch, of Richmond, blew away the field in the Thirty-first Annual Run in the Sun 5K, while his family cheered him on. They are, (from left), Addison, Douglas, Zachary, Jennifer, and Wesley.

3. The Lawyers Expo, sponsored by the VSB General Practice Section, featured law office products and services, a book signing, margaritas, popcorn, and a lot of balloons.

4. Outgoing President George Warren Shanks presented the VSB with a painting done by his daughter, Cindy.


6. Athletic activities include golf, volleyball, and early morning yoga by the sea.
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A picture is worth a thousand words. Rather than a tedious written description, we simply display the words that were added, and the words that were removed. At the top, we identify the Act that made the change, and when it went into effect. If the Act included any additional clauses, which might contain relevant information, they are set out at the bottom.

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