

### Hill Birthday Thanks

On behalf of the Oliver White Hill Foundation and Oliver W. Hill Sr. and his family, I would like to thank Governor Kaine, former Governors Holton, Robb, Baliles, Wilder and Warner, Chief Justice Hassell and the Justices of the Supreme Court of Virginia, Senator Webb, Congressmen Scott and Cantor, the Virginia State Bar and its president and officials, the Virginia Law Foundation and its president and board, The Virginia Bar Association, the Old Dominion Bar Association, the Richmond Bar Association, the Roanoke Bar Association and its incoming president, George A. McLean Jr., members of the General Assembly, and all of the judges, law firms and lawyers who supported the Oliver White Hill 100th Birthday Gala.

Mr. Hill really enjoyed the event, and it is because of all of your support that this was possible.

Thank you, thank you, thank you.

Clarence M. Dunnville Jr.  
Richmond

### MCLE Job Well Done

I am an Air Force attorney and a member of the Virginia State Bar who essentially has been an Air Force lawyer from day one of my VSB membership. With the exception of one year, I have spent my entire practice (starting six days after my graduation from the University of Virginia in 1968) in every state but Virginia.

Despite this long-distance relationship, I have enjoyed great support from the VSB whenever I have requested help, informa-

tion or guidance. In the present case, I have been working with the mandatory continuing legal education office concerning allowance of CLE credit for the various judge advocate general courses I have taken over the past year. Not only has your office been supportive in every sense of the word, your staff has gone out of their way to ensure I was aware of the distance-learning options available to me. In a job which often involves 24-7 work, such proactive advice is most appreciated.

In particular, I would like to pass on my thanks to Gale M. Cartwright, who patiently worked with me on my latest "ping" of your office. Her helpful and patient (worth repeating) e-mails have reminded me of the quality of VSB service compared to some other state bars (it's very easy to make comparisons in a multi-bar environment such as the Air Force). I am very aware it often is far easier for clients to complain than compliment. In this case, I would like to ensure Ms. Cartwright receives proper recognition for her help and guidance. Thank you.

Charles E. Laedlein, Chief Counsel  
Air Force Communication Agency  
Scott Air Force Base, Illinois

*Letters continued on Page 8*

### Letters

Send your letter to the editor\* to:  
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<http://www.vsb.org/site/publications/vlawyer/>.

# Magna Carta—Rule of Law

by Howard W. Martin Jr., 2007–08 VSB President



In this first column written in my capacity as president of the Virginia State Bar, I want to say what an honor it is for me to assume this role; it is surely my highest honor and calling as an attorney. Secondly, I want to say how fortunate the bar is to have had such a wonderful 2006–2007 president in the person of Karen A. Gould of Richmond. Karen has been a diligent and progressive president who has moved graciously and effectively to enhance our relationship with our parent entity, the Supreme Court of Virginia. She has successfully shepherded the bar through several legislative and administrative issues that have been resolved during her year. In a future column I will address some of the items that I would like to continue to pursue as Karen's successor.

However, today I want to discuss the Rule of Law, the foundation of our American legal system. The cover photo of this magazine highlights the Magna Carta, an original of which was displayed in the Virginia Beach Contemporary Arts Center through mid-June this year in commemoration of the Jamestown anniversary. It is Magna Carta (the "Great Charter") from which our state and our nation derive the Rule of Law.

In April of this remarkable four hundredth anniversary year of the founding of Jamestown, the University of Richmond School of Law held a conference specifically dedicated to the Rule of Law. Judges, professors, attorneys, business executives and other distinguished citizens from the United

States, the United Kingdom and elsewhere attended the conference and offered their insights on the Rule of Law. Lord Phillips, Lord Chief Justice of England and Wales, affirmed at the conference the fact that our 1607 Jamestown ancestors brought with them to Virginia (and the entire New World) the Rule of Law.

The 1606 charter that King James I granted to the Virginia Company demanded that persons in the new colony would "...have and enjoy all liberties, franchises and immunities as if they had been abiding and borne within this our realme of Englande...." Guided by that mandate, the Jamestown settlers brought to Virginia in 1607 all the benefits that had been won in 1215 at Runnymede and confirmed in Magna Carta.

That specific fact is commemorated by a plaque on the inside wall of the Memorial Church, the church erected in 1907 on the site of the first house of worship established four hundred years ago in Jamestown. The plaque was installed on the church wall by the Virginia State Bar on May 17, 1959, and it says "Since Magna Carta the common law has been the cornerstone of individual liberties, even as against the Crown." The plaque goes on to say that the principles of Magna Carta "...have inspired the development of our system of freedom under law, which is at once our dearest possession and proudest achievement."

During the conference at Richmond, Law School Dean Rodney A. Smolla

asked some of the participants to state what they believed the term "Rule of Law" means. U.S. Supreme Court Justice Stephen G. Breyer and other speakers asserted that in a democracy, people tend to accept the Rule of Law *even when they don't like it*. The Rule of Law is our choice of *order over disorder*. Judge J. Harvie Wilkinson III of the United States Court of Appeals for the Fourth Circuit, said that to him "...the Rule of Law means a balance between two supreme (values) in our society—liberty and order." In exactly the same vein, over a century ago, General Henry M. Robert, the man who in 1876 created and then wrote the first five editions of *Robert's Rules of Order*, said "Where there is no law, but every man does what is right in his own eyes, there is the least of real liberty." That's the point: We are not really free unless there is ordered liberty under law in our society.

If, as I do, you want to see your definitions and explanations on a piece of paper in order fully to digest them, you might like what Justice Anthony Kennedy said about the Rule of Law at an American Bar Association meeting in August 2006. In summary, Justice Kennedy outlined his definition of the Rule of Law as follows:

1. The Law is superior to, and thus binds, the Government and all its officials.
2. The Law must respect and preserve the dignity, equality and human rights of all persons.

*Rule of Law continued on page 13*

**Lawyers Should Support Court Data Collection**

Criminal defense attorneys who represent indigent defendants in Virginia now have a new system where they can actually be compensated for the time required to represent clients properly.

It is imperative that all attorneys accurately and completely fill out the Revised Form

DC-40(A) and Waiver of Fee Cap forms, whether they request a waiver or not. The new forms are more cumbersome to fill out, because they require attorneys to provide greater specificity as to services rendered, time spent in and out of court, and why they are requesting a waiver of the fee cap. But the data is essential.

The Supreme Court will be collecting all of the information submitted, and that infor-

mation will form the basis for future budget requests. Even if the \$8.2 million allocated for this upcoming year runs out before the year is up, it is critical that lawyers continue to submit the forms to provide the Supreme Court with accurate statistical information so that future budgets will adequately cover the cost of fulfilling Virginia's Sixth Amendment obligation.

Our trial court judges will serve as the gatekeepers for fee-cap waivers and, just as importantly, will ensure that attorneys account for all their time when completing their list of allowances. Those of us who have worked hard for many years to win an increase in court-appointed pay urge every judge who signs a request for payment to instruct their local attorneys to bill for every necessary hour spent on a case. This should be done irrespective of whether a fee-cap waiver is requested.

The new system serves the greater good of ensuring that people who will need competent counsel in the future will be protected, because we were able to document how much money is needed to fund indigent defense. If we fail to take the time to do it right, indigent defense will never be properly funded, and the momentous legislative decision to allow fee-cap waivers will be squandered.

Let us all work together to finish a job well-done by leaders across the political spectrum who realize that justice and fairness requires competent counsel for our less fortunate.

Alex N. Levay Jr.  
Chair, Virginia State Bar Indigent Defense Task Force  
Leesburg

*Editor's Note: See the Supreme Court of Virginia's related article on the new waiver system on page 32 of this issue, as well as an article on the Virginia Fair Trial Project on page 30.*

# New VSB President Steps Up to the Plate

by Dawn Chase

Howard W. Martin Jr. once played first base on the Washington and Lee University baseball team in the 1960s. Today, at 65 with a 6-foot-4-inch frame, he still looks like he could knock one out of the park.

One could apply many sports analogies to the challenges that await him as he takes on the presidency of the Virginia State Bar. Sworn in June 15, 2007, during the agency's annual meeting in Virginia Beach, Martin's most urgent duty will be to preside as the bar hires a successor to longtime Executive Director Thomas A. Edmonds, who will retire at the end of the year.

Martin also will continue the work of his predecessors, Karen A. Gould (2006–2007) and Phillip V. Anderson (2005–2006), to prepare the way for an eventual hike in bar dues, which will require an increase in a statutory ceiling set by the General Assembly.

Martin comes to the job with extensive bar experience. He grew into VSB work through the disciplinary system, which he considers the bar's primary responsibility. "The bar has a lot of other roles, but the regulatory function is the one that is first and foremost," he said. He has represented his home circuit, Norfolk, on the VSB Council, and he has been on its executive committee since 2003.

As a past president and now fellow of The Virginia Law Foundation—and former chair of the VSB Budget and Finance Committee—he commands the fiscal stature to oversee the bar's \$12.7 million budget.

He was secretary of the Virginia Bar Association and a member of its executive committee in the late 1980s and early 1990s. That duty and his friendship with leaders of other statewide bar associations have attuned him to the missions and chal-

lenges of the commonwealth's voluntary bars. "One of the things I am very interested in is encouraging cooperation and mutual assistance between all of the statewide bars," he said.

He had some success with that in 1997–1998, when he was president of the Norfolk & Portsmouth Bar Association. His bar joined with the Virginia Beach Bar Association for some political, educational and social activities. He was unsuccessful in his attempt to pull Hampton Roads bars together for recommendations on judicial appointments. However, the experience gave him early grounding on a political issue that is still contentious today—efforts by bar groups to more effectively advise the General Assembly in the selection of judges.

From his corner office on the twelfth floor of the Bank of America Building in downtown Norfolk, Martin pointed out landmarks he has known since his earliest days: The fork where the eastern and southern branches of the Elizabeth River join to flow toward Hampton Roads and the Chesapeake Bay. The Norfolk Naval Shipyard—actually across the water in Portsmouth—where Martin's father worked as a crane operator during World War II. Two blocks from the riverbank, the Berkley neighborhood where Martin lived before the family moved to Virginia Beach, when he was 8.

He described new landmarks—the baseball stadium where the Norfolk Tides play; the MacArthur Center, an upscale shopping mall; and gleaming modern office buildings, including the Bank of America edifice, the Dominion Tower and the Norfolk Southern Tower, all erected on land once blighted with warehouses and substandard structures. As a lawyer who represents housing authorities in Norfolk and neighboring jurisdictions, Martin had a

hand in the development that has taken place in downtown Norfolk.

Despite increased bustle and a large population of out-of-towners drawn by the military, "The city is typified by Southern hospitality," Martin said. Martin's manners are courtly, of a style that somehow keeps tenacious hold in Virginia, like the Norfolk Island pine that determinedly lays claim, among books and papers, to a corner of Martin's office.

Martin has lived his life in Hampton Roads, with the exception of college (W&L and the University of Virginia School of Law) and a four-year stint in the Navy during Vietnam (two years as a line officer on a fleet oiler, then two years of shore duty in Charleston, South Carolina, in the Judge Advocate General's Corps).

He and his wife, Heather, met in ninth grade homeroom at Princess Anne High School in Virginia Beach, but didn't get serious until after his second year at Washington and Lee. The two make their home in Suffolk. They have three children: Jeffrey, a U.S. Naval Academy graduate who flew airplanes for the service and now is a financial manager for General Mills near Atlanta; Brad, a civil engineer in Virginia Beach; and Hilary Chaney, a lawyer in Fayetteville, Arkansas. Howard and Heather Martin also enjoy two grandchildren.

Martin credits his family's athletic skills with winning the VSB Executive Committee its first-ever championship title in the traditional volleyball tournament that ends the annual meeting. VSB Director Edmonds, the team coach, displayed the trophy with glee at a staff meeting following the victory.

Martin is senior partner of Crenshaw, Ware & Martin PLC, a firm that has prided itself for generations on bar leadership and



development of young lawyers. The firm originated in 1923 and five past or present partners have been presidents of the Norfolk & Portsmouth Bar Association, with two as VSB presidents—Edward Rouzie Baird in 1959–1960, and Martin.

“As a young lawyer, I was the beneficiary of picture-perfect mentoring,” he said at his swearing-in by Virginia Chief Justice Leroy R. Hassell Sr. Martin paid tribute to partners Frank Crenshaw—“a pillar of the bar and the community,” Guil Ware—“the perfect Essex County, Virginia, gentleman,” and Walkley “Johnny” Johnson—“one of the very best litigators around.” All three attended the inaugural banquet.

While Martin’s time will be engaged with administrative and legislative leadership of the VSB, he plans to try to keep his eyes on the stars. There are lots of reminders around of what those stars are: The nation celebrates the four hundredth anniversary of Jamestown this year. Eighteen miles away, in Virginia Beach, a copy of the Magna Carta has been on display at the Contemporary Art Museum. 2007 is the 100th birthday year of Oliver White Hill Sr., a Virginia lawyer whose cases forever changed the landscape of civil rights in the United States.

Martin contemplated the James River—which his firm can see from another side of its office suite—and said, “The shores on each side are exactly what those settlers saw four hundred years ago. This could have been a Spanish place. This

could have been a Norwegian place. This could have been an Indian place.”

While suggesting that any settlement would have had its pros and cons, he focused on what might be the best the English gave this country: the Rule of Law, English version. That’s why he asked that the cover photo for this magazine invoke the heritage of the Magna Carta. And he wrote his first VSB presidential column (page 6), on the Rule of Law.

Martin is detail-oriented and he is serious. But at the end of the day, he kicks back and talks about barbecue and baseball.

Barbecue, because his mother was a North Carolinian and his father a Virginian. They’d round up the family, climb into their DeSoto on a Saturday morning and drive 134 miles to Bob Melton’s, in Rocky Mount, North Carolina, for a meal that cost 40 cents (a nickel for a Coke and 35 cents for a sandwich).

When he was Norfolk bar president, Martin made a cause célèbre in his president’s column of his quest for good barbecue; *Virginia Lawyers Weekly* picked up the challenge, and Virginia lawyers contributed nominations for the best ‘cue in the state. Dozens of lawyers responded with phone calls and letters. A circuit court judge called to say that he had perused Martin’s column and was waiting to see how Martin would tie barbecue to weighty matters of law.

“You never did,” the judge chortled. “Congratulations!”

Martin’s favorite barbecue joint remains the White Swan, at exit 90 off I-95 in Smithfield, North Carolina. Nothing fancy about it he says. “Good ol’ eastern North Carolina barbecue, vinegar-based.”

Then there’s baseball. Most of his favorite players are from the old days—“Gehrig, Musial, Clemente, Ted Williams, Mays, Brooks Robinson, Aaron, Yogi, Moose Skowron, Whitey Ford. And even a few of the more modern-day heroes like Cal Ripken,” he wrote in an e-mail.

His favorite was Mickey Mantle. Martin has a photo in his office that compares his own batting stance with Mantle’s, and a baseball with the Yankee’s signature is the favorite in Martin’s signed baseball collection.

In 1985, he went to a New York Yankees fantasy camp in Fort Lauderdale, Florida, where he met Mickey Mantle, was coached by Moose Skowron and Ralph Houk, and credited with base hits against Hoyt Wilhelm and Whitey Ford.

With a record like that, will bar associations be proffering mitts and baseballs for him to autograph?

Martin didn’t miss a nanosecond in the e-mail exchange. “I usually get Pete Rose to sign them for me,” he said. ☺

**Rule of Law** *continued from page 6*

3. The Law must ensure a free society in which all citizens have a meaningful voice in shaping and enacting the rules that govern them.
4. The Law must devise and maintain systems to advise all persons of these rights, and it must empower them to seek redress of grievances without fear of penalty or retaliation.

This short list, from Justice Kennedy, gives me my best-yet understanding of what is meant by the term “Rule of Law.”

The Rule of Law is critical, as it preserves order in our society. And it is incumbent upon all of us, as Virginia lawyers, to protect and defend it. Further, we ought to explain it, publish it, and educate lawyers and lay persons as to its meaning and importance. Under the Rule of Law, we are meant to have liberty and justice for all. And justice for all means that no one is above the law—not even the king. 𐄂

## Highlights of the Virginia State Bar Council Meeting June 14, 2007

At its annual meeting on June 14, 2007, in Virginia Beach, the Virginia State Bar Council:

- Heard the bar's Ethics Counsel James M. McCauley describe improved procedures for notifying bar members and the public about proposed rule changes and bar opinions. In addition to the usual press release and publication of the proposed rule changes and opinions in the bar's publications and on its Web site, they will also be referenced in electronic communications to bar members, and improved procedures for posting these matters on the Web site are being implemented.
- Was informed about new procedures and further refinements in the bar's process for evaluating judicial candidates. The changes are designed to develop more complete information during the background investigation on each candidate for a judicial vacancy, as well as provide for more effective participation by the bar's executive committee in the process.
- Elected Jan L. Brodie of Fairfax, Michael C. Guanzon of Danville and Theophani K. Stamos of Arlington as new members of the executive committee for the 2007–08 bar year.
- Approved and recommended to the Supreme Court of Virginia a change in Paragraph 15 of the Rules of Court, the Third Year Student Practice Rule. The change would eliminate the 10-day prior approval requirement by the judge or administrative tribunal before whom a third-year law student expects to appear. Under the change, the court or the administrative tribunal can impose whatever advance approval requirement it feels is necessary or appropriate under the circumstances.
- Heard discussion of a proposed amendment to Paragraph 18 of the Rules of Court recommended by the Special Committee on Lawyer Malpractice Insurance. The amendment would have required lawyers who indicate on their annual dues statement that they are in private practice and covered by a malpractice insurance policy to provide proof that they do, in fact, have such insurance. Following discussion, the chair of the committee, Darrel Tillar Mason, withdrew the proposal.

In the alternative, it was agreed by the council that the time has come for the body to give direction to the committee on the fundamental question whether the bar should require malpractice insurance of all active members in private practice representing clients drawn from the general public. This philosophical question will be debated and a vote taken on it at the October 2007 council meeting. Should the council indicate to the committee that it wishes to consider a proposal for requiring such insurance, the committee will develop a specific proposal for subsequent consideration by the Council.

- Unanimously adopted a resolution commending Karen A. Gould of Richmond for her effective and diligent service as president during 2006–07, and a resolution thanking her law firm for its support of her service.

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## Gould Announces “E-News” and Online Member Directory

In response to many requests, 2006–07 VSB President Karen A. Gould recently announced two new services for bar members.

In May, June and July, bar members received electronic newsletters to keep them informed about important news and upcoming events. Each periodic edition of the “E-News” provides brief summaries of

news and events with links to more detailed information.

Gould also asked all members to sign up to have their names and addresses of record included in a new online member directory. The directory—requested by both members and the public—provides access to attorneys’ contact information.

It includes only the name, address and telephone number of anyone who agrees to be listed.

Classes listed are limited to active, associate, active Virginia corporate counsel and emeritus members.

## Manuel A. Capsalis of Arlington Is President-elect of the Virginia State Bar

Arlington attorney Manuel A. “Manny” Capsalis is the new president-elect of the Virginia State Bar. He took office on June 15, during the VSB’s annual meeting in Virginia Beach.

He will serve a year in that position, then will succeed Howard W. Martin Jr. as president of the 38,000-lawyer agency for the 2008–09 fiscal year.

Capsalis is managing partner in the law firm Capsalis, Bruce & Reaser PLC and practices criminal and civil litigation. He also is a substitute judge in general district and juvenile and domestic relations courts in Northern Virginia, and he serves as prosecutor and deputy town attorney for the Town of Herndon.

A native of Durham, N.C., he was admitted to the Virginia bar in 1988, after receiving

a law degree from George Mason University, where he was editor-in-chief of the law review. He received a bachelor’s degree from Duke University in 1981 and a master’s from George Mason University in 1984.

He is a former president of the Arlington County Bar Association, a former board member of Lawyers Helping Lawyers, and a member of the Virginia Trial Lawyers Association and the George Mason American Inn of Court. He also is on the board of directors of the Virginia Law Foundation.

Capsalis is a past chair of the Virginia State Bar’s Conference of Local Bar Associations. He is a member of the VSB’s governing council and executive committee. He serves on the VSB Budget and Finance Committee and the Chief Justice’s

Indigent Defense Training Initiative. He has been a faculty member of the VSB Professionalism Course.

He is a longtime volunteer with the Herndon Optimist Club’s youth sports program, for which he coaches baseball, basketball and softball.

His wife, Carole H. Capsalis, also is an attorney with Capsalis, Bruce & Reaser. They have two daughters and a son and live in Herndon.



## Bar Groups to Assist in Evaluating Candidates for Supreme Court Vacancy

The Virginia State Bar Executive Committee will meet on Wednesday, Aug. 29, at 11 A.M. at the Virginia State Bar office in Richmond to receive and act on the report and recommendations of the Judicial Nominations Committee concerning persons who seek to fill the vacancy on the Supreme Court of Virginia created by the retirement from active service of Justice Elizabeth B. Lacy.

Gov. Timothy M. Kaine has asked for the assistance of the statewide bar groups in identifying and evaluating candidates for the vacancy, which he will fill by appoint-

ment. The person appointed will need to stand for election by the General Assembly when it meets in January 2008.

He has asked for recommendations by Aug. 30. The VSB’s Judicial Nominations Committee has elected Carter Glass IV of Richmond as its 2007 chair, and established a schedule for preparing a response to Kaine’s request.

The deadline for receipt of nominations and supporting materials in the VSB office is July 23, and interviews will be conducted with the candidates on Aug. 17.

The nomination committee’s report and recommendations will be sent to the executive committee about one week prior to the Aug. 29 meeting.

The executive committee then will authorize VSB President Howard W. Martin Jr. to transmit the bar’s recommendations to Kaine.

For more information and a copy of the questionnaire that must be completed by all candidates, please contact Valerie Breeden at the VSB, [breededen@vsb.org](mailto:breededen@vsb.org) or (804) 775-0551.



## Roanoke BLI Provides Opportunities for Learning, Exchange

At this year's second Bar Leaders Institute and Solo & Small-Firm Practitioner Forum, legal professionals gathered at the Jefferson Center in Roanoke on May 23 for a free, daylong program including panel discussions and presentations on a variety of topics.

Justice Donald W. Lemons of the Supreme Court of Virginia gave the luncheon address about the Rule of Law and its place as one of the legacies of Jamestown. Following the program, Chief Justice Leroy R. Hassell Sr. held a Town Hall Meeting during which participants asked questions about Virginia's courts.

The Bar Leaders Institute and Solo & Small-Firm Practitioner Forum is sponsored by the Virginia State Bar Conference of Local Bar Associations. For more information on the CLBA, visit [www.vsb.org](http://www.vsb.org) and click on Conferences.



Left: Virginia Justice Donald W. Lemons gives the luncheon address about the Rule of Law and its place as one of the legacies of Jamestown at the May 23 Bar Leaders Institute and Solo & Small-Firm Practitioner Forum.



Right: Chief Justice Leroy R. Hassell Sr. answered questions from area legal professionals during the latest in his continuing series of Town Hall Meetings.

### Free and Low-Cost Pro Bono Training

Visit the Pro Bono page on the VSB Web site for free and low-cost pro bono trainings and volunteer opportunities: [www.vsb.org/site/pro\\_bono/resources-for-attorneys/](http://www.vsb.org/site/pro_bono/resources-for-attorneys/).

### For confidential toll-free consultation

available to all Virginia attorneys on questions related to legal malpractice avoidance, claims repair, professional liability insurance issues and law office management, call the

VSB's risk manager, McLean lawyer John J. Brandt, at

**1-800-215-7854.**

### Virginia State Bar Publications

The Virginia State Bar publishes pamphlets and handbooks on law-related issues for Virginia's lawyers and Virginia's citizens. Please note that some are available in bulk quantities, and others only in single copies. All publications can be found on the VSB Web site at <http://www.vsb.org/site/publications>.

# Birthday Gala Honors Oliver Hill

by Dawn Chase

Oliver White Hill Sr.—whose tenacious legal leadership helped overturn “separate but equal” and many other discriminatory practices—turned 100 on Law Day, celebrated by well-wishers who included leaders of premiere law firms, six Virginia governors, a former president of the United States and the queen of England.

More than 1,000 people attended a birthday gala on May 4—three days after Hill’s actual birthday. The event took place at the Richmond Marriott Hotel.

Broadway performer Craig Schulman, who donated his appearance, inspired the crowd with songs that included “Make Them Hear You” from the musical “Ragtime”: *Go out and tell the story, Let it echo far and wide, Make them hear you. Make them hear you. How that justice was our battle and how justice was denied. Make them hear you. Make them hear you.*

A short documentary about Hill’s life followed—he was raised by his mother in Roanoke, attended Howard University and practiced in Richmond—and then the accolades began.

One after another, Governor Timothy M. Kaine and five former governors—A. Linwood Holton Jr., Charles S. Robb, Gerald L. Baliles, L. Douglas Wilder and Mark R. Warner—offered tribute.

Wilder recalled returning home to Richmond after serving in the Korean War. He was angry that rights he had fought for on behalf of Koreans were denied to him in the United States. “I’d given up on thinking anybody could make anything happen,” he said. But then “white judges said *Plessy v. Ferguson* was wrong ...

“I thought, ‘Hey, look! Look what is happening!’ From Richmond, Virginia, this could happen, and lawyers could make it happen.” Wilder left his job as a chemist, went to law school and many years later became the first elected black governor in the United States.

Congressman Robert C. “Bobby” Scott paid tribute in person, and former President Bill Clinton, who awarded Hill the Presidential Medal of Freedom in 1999, sent recorded congratulations.

Virginia Law Foundation Chair John A.C. Keith of Fairfax, a former Virginia State Bar president, quoted Henry David Thoreau: “It’s not what you look at that matters. It’s what you see.”

And Richmond lawyer James W. Morris III, a member of the Oliver W. Hill Foundation, brought the house down with a heartfelt sentiment: “I want to thank you, Oliver Hill, for the white people—for saving our souls.”

Clarence M. Dunnaville Jr. and Esther H. Vasser, who organized the party on behalf of the foundation, announced that Hill’s boyhood home in Roanoke had been purchased and will be used to continue his work for civil rights.



Oliver White Hill Sr. (seated) celebrates his 100th birthday on May 4, 2007, with more than 1,000 people, including (left-right) Gov. Timothy M. Kaine, former Govs. A. Linwood Holton Jr., Gerald L. Baliles and L. Douglas Wilder, and Congressman Robert C. “Bobby” Scott. Hill’s actual birthday was May 1.



Queen Elizabeth II conveys birthday greetings to Oliver White Hill Sr. on May 3, 2007, during her visit to Richmond.

## Oliver Hill’s Autobiography Updated, Reissued

An updated edition of Oliver White Hill Sr.’s autobiography, *The Big Bang: Brown v. Board of Education*, has been published by the Oliver W. Hill Foundation in commemoration of his 100th birthday on May 1, 2007.

The 2007 version of the book, originally published in 2004, includes updated information, recent photographs and a new forward by its editor, Professor Jonathan Stubbs of the University of Richmond School of Law. Proceeds from the book’s sale benefit the foundation.

The book costs \$35, which includes \$5 postage and handling. It can be ordered from the foundation at P.O. Box 2246, Richmond, VA 23218.

**In Memoriam**

**Richard Anthony Buddeke**  
McLean  
September 1913–March 2007

**A.J.T. Byrne**  
Charlottesville  
June 1943–March 2007

**Robert Cantor**  
Glen Allen  
July 1924–April 2007

**John M. Carter**  
Richmond  
September 1922–December 2006

**J. Jay Corson IV**  
McLean  
May 1935–March 2007

**Hovey Slayton Dabney**  
Charlottesville  
September 1923–February 2007

**The Hon. Beverly Andrew Davis III**  
Rocky Mount  
May 1925–March 2006

**F. Elmore Butler**  
Richmond  
December 1924–May 2006

**James E. Espe**  
Lincoln, California  
November 1934–February 2007

**Jana Kay Guggenheim**  
Bethesda, Maryland  
September 1958–March 2007

**William Douglas Hager**  
Lexington  
January 1920–October 2006

**Eugene Bruce Harvey**  
Altavista  
October 1919–March 2006

**John F. Kelly**  
Midlothian  
March 1929–February 2007

**Eldon Earl Lewis**  
Annandale  
January 1929–May 2006

**Edmond J. Newbould**  
Alexandria  
April 1918–March 2007

**Daniel M. O’Connell Jr.**  
Warrenton  
March 1942–May 2007

**M. Ralph Page**  
Richmond  
February 1923–May 2007

**Gregory Fred Patton**  
Galax  
March 1957–November 2006

**Rise Jean Peters**  
Washington, D.C.  
April 1961–May 2007

**John J. Reed**  
Pittsboro, North Carolina  
April 1927–April 2007

**Ambrose Alexander Rucker**  
Bedford  
January 1916–January 2007

**Oliver D. Rudy**  
Chesterfield  
May 1937–March 2007

**Harry H. Rumble II**  
Contoocock, New Hampshire  
June 1920–May 2004

**Peter W. Runkle**  
Richmond  
February 1932–March 2007

**Hoskins M. Sclater**  
Roanoke  
June 1918–December 2006

**Robin Lee Strickler**  
Virginia Beach  
October 1953–January 2007

**Anson W.H. Taylor Jr.**  
Berwyn, Pennsylvania  
July 1929–March 2006

**Dabney W. Watts**  
Advance, North Carolina  
August 1918–November 2006

**Jay Kenneth Wilk**  
Woodstock  
December 1963–May 2007

**Stephen C. Willard**  
Charlottesville  
August 1934–March 2007

**Cdr. Paul Wohl, JAGC, USN (Ret.)**  
Vienna  
April 1923–August 2006

**Williams Mullen and Habitat for Humanity Form a Pro Bono Partnership**

Williams Mullen law firm and Richmond Metropolitan Habitat for Humanity are new pro bono partners.

The firm will provide legal expertise in a variety of areas that will help Habitat expand its business model from single-family homes on single lots to multi-family homes in developments.

“We are answering the call for affordable and work force housing,” said G. Andrew Nea Jr. of Williams Mullen. “By leveraging our capacity as a large-size firm, we can do the heavy lifting required to make these building projects a success.”

Each year, Richmond Habitat builds nearly 30 houses, provides social services to

more than 550 families, manages mortgages for all Habitat homeowners, and operates a store that resells building supplies and furniture.

## Globalization, Diversity are Conclave Themes

On June 8, 100 practicing lawyers, judges, and law-school deans and professors gathered at the University of Virginia School of Law in Charlottesville for a half-day conclave on legal education.

The purpose of the meeting was to discuss issues of common interest to all three branches of the legal profession and to exchange ideas and information about legal education and ways in which the practicing bar and the bench can be helpful to the law schools in Virginia.

Following opening remarks by William R. Rakes, current chair of the Council of the American Bar Association's Section of Legal Education and Admissions to the Bar, and Thomas A. Edmonds, executive director of the Virginia State Bar and former dean of the University of Richmond Law School, two panels of distinguished lawyers, judges and legal educators presented the program.

One panel addressed globalization of the legal profession and curricular changes needed in the law schools to better prepare students for practice in the much-changed profession they will enter. The other focused on how to achieve greater diversity in both law-school student bodies and in the profession, including innovative "pipeline projects" designed to identify promising students from minority groups as early as their middle-school years and encourage them to consider attending law school and entering the profession.

The conclave ended with an inspiring after-dinner presentation by College of William and Mary law-school dean W. Taylor Reveley III documenting the historical role lawyers have played as "public citizens" and encouraging attendees to develop ways in which to inculcate the same aspirations to serve the public and their communities in today's students, lawyers and judges.

The occasion for the conclave, the fourth that has been held in Virginia during the past 15 years, was the spring meeting of the council of the ABA section in Charlottesville. Rakes encouraged the bar to work with the section in planning and conducting the conclave to coincide with the council meeting. The Virginia State Bar's Section on Education of Lawyers, the only group of its kind at the state level in the country, partnered with the ABA Section on the conclave.

In attendance were 28 ABA council members and staff as well as 68 Virginia lawyers, judges and academics.



Opening remarks at the ABA Conclave were made by VSB Executive Director Thomas A. Edmonds.



Dean W. Taylor Reveley III of the College of William & Mary School of Law (l), spoke on "The Lawyer as a Public Citizen" at the conclave dinner. Closing remarks were made by William R. Rakes, a former VSB president (r).



"Educating Lawyers for the 21st Century" panelists were (l-r) Dean Blake D. Morant of Wake Forest University School of Law; Dean John C. Jeffries Jr. of the University of Virginia School of Law; Dean Rodney A. Smolla of the Washington and Lee University School of Law, moderator; Carolyn B. Lamm of White and Case LLP; and Dean Mathew D. Staver of the Liberty University School of Law.



"How Can We Achieve Greater Diversity in Our Profession and Bar Organizations?" panelists were (l-r) 2006-07 VSB President Karen A. Gould; Dean Clinton W. Shinn of Appalachian School of Law; Dean Jeffrey A. Branch of Regent University School of Law; Annamaria Nields, assistant dean for academic affairs at George Mason University School of Law; W. Scott Street III, secretary of the Virginia Board of Bar Examiners and a former president of the Virginia State Bar; Judge Cleo E. Powell of Chesterfield Circuit Court; and Virginia Supreme Court Justice Elizabeth B. Lacy, moderator.

# Centuries After Jamestown, Rule of Law Provides Means to Racial Justice

by Dawn Chase

While the United States marked the founding of Jamestown as the 400th anniversary of the Rule of Law in North America, many African-Americans consider entitlement to basic rights a more recent event.

Rights established by English law and carried to the New World by the Jamestown colonists have applied to black people only since the 1930s, said Elaine R. Jones, former president of the National Association for the Advancement of Colored People's Legal Defense Fund.

It was not until 1935 that black lawyers began chiseling away methodically at institutionalized discrimination, and blacks began to be fully enfranchised, she said.

Jones delivered her remarks April 12, 2007, during the Rule of Law Conference sponsored by the University of Richmond in recognition of the Jamestown quadri-centennial.

The conference, held April 11–14 in Richmond and Jamestown, drew an international faculty. Along with many lectures about how the Rule of Law is practiced around the globe, a highlight of the program was the unveiling of a commemorative plaque given by the English Inns of Court in honor of the founding of Jamestown Colony in 1607.

Jones said she prepared for her lecture by researching the Rule of Law in the 17th and 18th centuries "from the perspective of persons of African-American descent . . . I have never had more depressing reading."

Citing 19th-century slave laws compiled by abolitionist George M. Stroud, Jones listed the harsh "Rule of Law" faced by slaves and sometimes freed blacks.

"Proposition five: Slaves have no legal right to property in terms of both real and personal," she read, and continued: Owners could not rent their slaves to others. Slaves could not marry. While owners could sue over injury to a slave, the slave could not be a party in the suit or recover damages.

"You're talking about cold! You're talking about a 'Rule of Law'! . . . This is what we had."

The Civil War brought emancipation, but decades of oppression continued. "You can have a right on the books, but if it's not enforced, . . . it gives you an argument, but it doesn't give you a right," Jones said. Lynchings, abetted by the silence of state legislatures that refused to make them a crime, reminded African-Americans of the threat of mob rule. Jim Crow laws established "separate but equal" treatment of the races. "We had separate, but we never had equal," Jones said.

From 1865 until 1988, "Everything Congress managed to accomplish, the Court took back," she said.

In 1907, Oliver White Hill Sr. was born, Jones said, gesturing to the audience that included Hill, a few days from his 100th birthday. Hill grew up in Roanoke and endured the bullying of white boys and recurring news of lynchings.

When Oliver Hill was 12 years old, Charles Hamilton Houston, a black, brilliant veteran of the battlefields of World War I, enrolled at Harvard Law School, where he planned his next fight: an attack on Jim Crow.

Houston decreed that "there must be Negro lawyers in every community," and

he set out to train them. He took a teaching position at Howard University Law School, which trained the majority of black lawyers in the United States. Through courses such as jurisprudence and administrative law, he gave a generation of promising students the grounding required to put a record together and challenge the system.

Hill was among those Howard students. So was future U.S. Associate Justice Thurgood Marshall. The two were close, Jones said. Hill called Marshall "Turkey"; Hill was "Peanut." Marshall called Houston "Iron Shoes."

Starting with a challenge to *Plessy v. Ferguson*, the 1896 U.S. Supreme Court decision that established "separate but equal," Houston and his students began their struggle for civil rights. Hill made his mark as leader of the Virginia team that participated in *Brown v. Board of Education*, then went on to win dozens of other cases that affected schools, transportation, equal pay for equal work, housing and many other issues.

The efforts were aided by an unusual alignment through which civil and voting rights were enacted, affirmed and enforced on the federal level. "It's rare to get Congress, the executive branch and the courts on the same page at the same time," Jones said. The newly empowered law gave the litigators a framework on which they could build their cases and appeal when lower courts shot them down.

Jones said Hill, who practiced in Richmond, worked against a background of constant threat and harassment. Often,

he and his wife took the phone off the hook to get a full night's sleep, she said.

Jones traced her own history as it evolved from the successes of Hill and his Howard University classmates. She and Virginia Court of Appeals Judge James W. Benton Jr.—who also was in the audience—were “100 percent of the African-American members of the class of 1970” at the University of Virginia School of Law, she said. Jones went on to many other firsts, as a woman and an African-American.

But at the Rule of Law Conference, before a proclamation was read in honor of Hill and a birthday cake with 100 candles was carried in, Jones paid tribute to her friend and teacher.

“We owe Oliver a debt of gratitude,” she said.

To African-Americans, most of the past 400 years were brutalizing. In the end, though, Jones saluted “what was solidified in Jamestown and the Founding Fathers gave us—a system where we could challenge injustice.”



1: Elaine R. Jones, former president of the NAACP Legal Defense Fund, speaks at the University of Richmond's Rule of Law Conference.

2: Reading a tribute to civil rights lawyer Oliver White Hill Sr. are (left-right) Elaine R. Jones, University of Richmond Law School Dean Rodney A. Smolla and Virginia Justice Donald W. Lemons.



3: A plaque commemorating the 400th anniversary of Jamestown is unveiled by (left-right) U.S. Chief Justice John G. Roberts Jr., Virginia Justice Donald W. Lemons, retired U.S. Associate Justice Sandra Day O'Connor and the Right Honorable Phillips of Worth Matravers, the Lord Chief Justice of England and Wales. The event took place at Jamestown. The plaque was presented by the English Inns of Court.



## Local and Specialty Bar Association Elections

### Augusta County Bar Association

John Charles Wirth, President  
Rupen Rasiklal Shah, President-elect  
Humes Jefferson Franklin III, Vice President  
Michelle Kelsay Bishop, Secretary  
David Leslie Meeks, Treasurer  
Paul Aaron Dryer, Immediate Past President

### Loudoun Chapter, VWAA

Jennifer Rose Dillow, President  
Stephanie Grant Troxell, Vice President  
Jennifer Dore Cisneros, Secretary  
Lorren Tyus Johnston, Treasurer  
Stephanie Grant Troxell, Immediate Past President

### Loudoun County Bar Association

Lawrence Joseph McClafferty, President  
Thomas Vincent Mulrine, President-elect  
Cheryl Kaye Graham, Secretary  
Stephen Edward Sincavage, Treasurer  
James Edwin Plowman, Immediate Past President

### Martinsville-Henry County Bar Association

Robert William Haley, President  
Joan Ziglar, Vice President  
Donald Patrick Goodman III, Secretary-Treasurer  
Kimble Reynolds Jr., Immediate Past President

### Montgomery-Radford Bar Association

Gail Cook Devilbiss, President  
Paul Michael Barnett, President-elect  
Christopher Austin Tuck, Vice President,  
David Adam DeVries, Vice President,  
Peggy Harris Frank, Secretary  
Marshall Jay Frank, Treasurer  
Donald Stephen Haga Jr., Immediate Past President

### Northern Virginia Chapter, VWAA

Debra Lynn Powers, President  
Cynthia Kaplan Revesman, President-elect  
Kyung Nam Dickerson, Secretary  
Mary Grace Anne O'Malley, Treasurer  
Mary Catherine H. Gibbs, Immediate Past President

### Richmond Chapter, VWAA

Courtney Allen Van Winkle, President  
Lauren Ebersole Hutcheson, Secretary  
Darrel Tillar Mason, Treasurer  
Darrel Tillar Mason, Immediate Past President

### Salem-Roanoke County Bar Association

Thomas Edward Bowers, President  
John Stuart Koehler, 1st Vice President  
Leisa Kube Ciaffone, 2nd Vice President  
John Christopher Clemens, Secretary-Treasurer  
Compton Moncure Biddle, Judge Advocate  
John Stuart Koehler, Corresponding Secretary  
Aaron Tremayne Lavinder, Immediate Past President

### The Bar Association of the City of Richmond

Carolyn Anne France White, President  
William Reilly Marchant, President-elect  
Gregory Franklin Holland, Vice President  
The Honorable Thomas O. Jones, Hon. Vice President  
Thamer Eugene Temple III, Secretary-Treasurer  
Hugh McCoy Fain III, Immediate Past President

### Virginia Trial Lawyers Association

Charles Joseph Zauzig III, President  
Andrew Michael Sacks, President-elect  
Matthew B. Murray, Vice President  
Edward Lefebvre Allen, Vice President  
Lisa Palmer O'Donnell, Vice President  
Sandra Martin Rohrstaff, Vice President  
Barbara S. Williams, Treasurer  
Gerald Arthur Schwartz, Immediate Past President

### Winchester-Frederick County Bar Association

Thomas Alan Louthan, President  
Marc Herbert Abrams, President-elect  
William August Bassler, Secretary  
William Abraham Crane, Treasurer  
Robert Lee Jones III, Member At-Large  
Phebe Kay Adrian, Immediate Past President

## Edmonds to Receive Bolton Award from NABE

Thomas A. Edmonds, executive director and chief operating officer of the Virginia State Bar, has been named the 2007 recipient of the National Association of Bar Executives Bolton Award for Outstanding Bar Leadership.

The Bolton Award, the NABE's highest accolade, is presented annually to a bar

executive who epitomizes the highest standard of professional excellence. It is named in honor of Fred Bolton, executive director and secretary of the Pennsylvania Bar Association from 1966–77.

Edmonds will receive the award during the NABE Annual Meeting in San Francisco, Aug. 9–14.

## Professional Guidelines

The 2007–08 Professional Guidelines will be mailed to active members of the VSB in mid-October 2007, accompanying the October issue of *Virginia Lawyer*.

The 2006–07 are available online at [www.vsb.org](http://www.vsb.org).

For amendments approved after September 1, 2006, see the supplement to the Professional Guidelines online at [www.vsb.org/site/regulation/amendments](http://www.vsb.org/site/regulation/amendments).

# Monroe Birthplace Restoration Plan Announced

by S. David Schiller

April 28, 2007, the 249th anniversary of James Monroe's birthday, marked a long-overdue acknowledgment of the accomplishments of one of Virginia's lawyers who served his country in many capacities. The date also marked the groundbreaking for restoration of Monroe's birthplace in Westmoreland County.

Monroe, who practiced law in Fredericksburg in the 1780s, exemplified public service, which also is a hallmark of the Virginia State Bar. After Revolutionary War service, Col. Monroe served in the Virginia legislature, the first Congress, as Virginia's governor four times and as a foreign minister. He also negotiated the Louisiana Purchase and led the Virginia Constitutional Convention. During his two terms as the fifth president of the United States, Monroe articulated the doctrine that bears his name and elevated America to global prominence.

The James Monroe Memorial Foundation, established to preserve and honor the life, ideals, work and memory of Monroe, has begun an active effort to restore his birthplace, and develop the site as an

educational, historical, recreational, archaeological and environmental landmark for future generations.

A 1780 *Virginia Gazette* advertisement described the 550-acre property, which included peach and apple orchards and numerous outbuildings. Monroe's description also included a listing of the stable, kitchen, smokehouse and tobacco barn. An early 19th-century etching and engraving of the modest birthplace house matches the archaeological site. Restoration will be based on archaeological studies by the College of William and Mary, in conjunction with the Colonial Williamsburg Foundation. The archeological team has uncovered a 20 feet by 58 feet house foundation corresponding to the etching.

This restoration project will be the focal point of the 250th James Monroe Birthday Commemoration on April 28, 2008. The James Monroe Memorial Foundation has received substantial financial support from multiple sources, including the Jesse Ball DuPont Fund, the Dominion Foundation and the Commonwealth of Virginia.

By restoring his birthplace, the foundation hopes that Monroe will be restored to his proper place in history. The humble farmhouse and farm illustrate how individuals from such beginnings can progress to lead the nation. The educational benefits of the project afford a distinct opportunity for interpretation of both cultural and national histories.

In addition, the farmhouse will be the centerpiece to a historic park, which will stimulate recreational activities, tourism, conservation and economic development. Most importantly, the restoration will provide an understanding of the blessings of our liberties and freedom from a Colonial period point of view to a 21st-century perspective. Further information is available at [www.MonroeFoundation.org](http://www.MonroeFoundation.org).

**S. David Schiller** is a Richmond attorney and chair of the James Monroe Memorial Foundation Development Committee. He spoke about the foundation's activities and goals at a recent meeting of the VSB Council.

## VSB Offers Confidential Law Practice Management Reviews to Solos and Small Firms\*

If you are concerned about being a competent professional and want your practices and procedures to reflect this, consider having a half-day confidential review of your law practice management systems for the low cost of \$150 per attorney. The VSB's risk management program covers the remainder of the cost associated with these reviews. Since the number of reviews that can be conducted each year is limited, please don't delay in writing to or calling Janean S. Johnston, J.D., in order to receive an application form.

Johnston is a licensed attorney in Minnesota, and she has conducted legal risk management and ethics audits and reviews nationwide since 1987. She has recently returned to Virginia and has been retained by the VSB Malpractice Insurance Committee to assist with its overall risk management efforts on behalf of Virginia lawyers. **You may reach her at 250 South Reynolds Street, #710, Alexandria, VA 22304 or at (703) 567-0088.**

Take advantage of this limited offer and gain peace of mind as a result of improved practices and procedures that can reduce your exposure to both malpractice claims and ethics complaints.

\*(law firms with a maximum of five attorneys)





# The Virginia State Bar congratulates the following attorneys who are recipients of its 2007 awards:

## FAMILY LAW SERVICE AWARD

**Mary G. Commander**, Mary G. Commander, Attorney-at-Law, Norfolk

*Presented by the Family Law Section*

Commander is a family law attorney and volunteer for the Community Mediation Center of Southeastern Virginia. The center teaches new mediators about issues such as spousal support, equitable distribution and the process of divorce. She also helped bring together lawyers, financial planners and mental-health professionals to form the Hampton Roads Collaborative Law Group.

*The award was presented April 27 during the Family Law Section's Advanced Family Law Seminar in Richmond.*



## LIFETIME ACHIEVEMENT AWARD

**Philip Schwartz**, Schwartz & Associates, Vienna

*Presented by the Family Law Section*

Schwartz has practiced law for almost 50 years. Fluent in Russian, French and Spanish, he has cultivated an international niche in his domestic law practice. He teaches other attorneys to be sensitive to body language, gestures and linguistic elements that can cause misunderstandings with other cultures. He also is a recognized mentor to young lawyers.

*The award was presented April 27 during the Family Law Section's Advanced Family Law Seminar in Richmond.*



## LOCAL BAR LEADER OF THE YEAR AWARD

**Steven L. Higgs**, Higgs Law Firm, Roanoke

*Presented by the Conference of Local Bar Associations*

Higgs increased the number of programs and recognition of members during his term last year as president of the Roanoke Bar Association. Under his leadership, the association formed a committee to oversee its numerous public service projects, expanded legal education opportunities, and established lifetime achievement and young lawyer awards.

*The award was presented June 15 during the VSB Annual Meeting in Virginia Beach.*



## LEWIS F. POWELL JR. PRO BONO AWARD (TWO WINNERS)

*Presented by the Special Committee on Access to Legal Services*

**John M. Oakey Jr.**, McGuireWoods LLP, Richmond

Oakey has dedicated himself to pro bono work in his retirement from law firm partnership. He has represented clients through the Richmond Legal Aid Housing Program, prosecuted child support cases, advocated for domestic violence victims, and handled many cases in which needy clients did not qualify for pro bono help from legal aid.

**Volunteer Lawyers, Mortimer Caplin Public Service Center**, University of Virginia Law School, Charlottesville  
These members of the U.Va. Law School faculty and other volunteer attorneys prepare students for pro bono work and other public interest law. They provide institutional support that is unmatched in Virginia. Among their projects is a program that assists domestic-violence victims and immigrants seeking asylum.

*These awards were presented May 17 at the VSB Pro Bono Conference in Richmond.*



## HARRY L. CARRICO PROFESSIONALISM AWARD

**Rodney G. Leffler**, Leffler & Hyland PC, Fairfax

*Presented by the Criminal Law Section*

Leffler has served as a police officer, a prosecutor and a defense attorney. He has tried more than 250 criminal and civil cases before juries. A former chair of the section, his commitment to the highest ideals of professionalism has won him many invitations to provide ethics training at law schools, continuing legal education courses, and the Criminal Law Section's annual seminar.

*The award was presented February 9 at the Criminal Law Seminar in Williamsburg.*



**TRADITION OF EXCELLENCE AWARD****James C. Roberts**, Troutman Sanders, Richmond*Presented by the General Practice Section*

Roberts has maintained a general practice in a large firm during the 50 years he has been a member of the Virginia bar. He was lead counsel on high-profile cases such as the A.H. Robins Co. Inc. Chapter 11 bankruptcy and he defended *U.S. v. Holland*, in which a state senator and his son were acquitted on 31 charges. He is a mentor to young lawyers, and was an early leader in legal work for the poor in Richmond.

*The award was presented June 16 during the VSB Annual Meeting in Virginia Beach.***VIRGINIA LEGAL AID AWARD****Andrew K. Block Jr.**, JustChildren, Legal Aid Justice Center, Charlottesville*Presented by the Special Committee on Access to Legal Services*

Block started the Charlottesville-based JustChildren program in 1998 with the help of a Soros Justice Fellowship. JustChildren helps improve education and mental-health services by working to increase resources and by training lawyers, other professionals and families to be better advocates. Block also founded the Child Advocacy Clinic at the University of Virginia School of Law.

*The award was presented June 15 during the VSB Annual Meeting in Virginia Beach.***R. EDWIN BURNETTE JR. YOUNG LAWYER OF THE YEAR****Sarah Loupe Petcher**, Colten Cummins Watson & Vincent, Fairfax*Presented by the Young Lawyers Conference*

As chair of the YLC's Immigrant Outreach Committee, Petcher led the conference to form a partnership with the National Center for Refugee and Immigrant Children. She has provided training on undocumented-status juveniles to judges in Northern Virginia, and she has been attorney advisor to a George Mason School of Law clinic for self-represented litigants in uncontested divorces.

*The award was presented June 15 during the VSB Annual Meeting in Virginia Beach.*

## Virginia Law Foundation Accepting Nominations for Fellows Class of 2008

Nominations for the 2008 Class of Virginia Law Foundation Fellows will be accepted through September 10, 2007. The 2008 class will be inducted at a dinner meeting in Williamsburg on January 17, 2008, during The Virginia Bar Association's Annual Meeting.

Candidates must (1) be an active or associate member of the Virginia State Bar for at least ten years; (2) be a resident of Virginia; (3) be a person of integrity and character; (4) have maintained and upheld the highest standards of the profession; (5) be outstanding in the community; and (6) be distinguished in the practice of law. Retired and senior status judges are eligible. Sitting full-time judges and constitutional office holders are not eligible during their tenures.

Nominations must be received by September 10 and should be submitted on a nomination form provided by the Virginia Law Foundation. To obtain a nomination form, please contact the Virginia Law Foundation at 700 East Main Street, Suite 1501, Richmond, VA 23219, phone (804) 648-0112, or by email at: [mprichard@virginialawfoundation.org](mailto:mprichard@virginialawfoundation.org). To obtain a nomination form online, go to [www.virginialawfoundation.org/fellownoms.htm](http://www.virginialawfoundation.org/fellownoms.htm) and for a complete listing of current fellows, please visit the foundation's Web site at [www.virginialawfoundation.org/currentfellows.htm](http://www.virginialawfoundation.org/currentfellows.htm).

## Caplin Center Volunteers, Oakey and Nolan Honored at VSB Pro Bono Conference

The Virginia State Bar's 2007 Pro Bono Conference, "Expanding Access to the Court," presented resources available for lawyers and programs that provide legal services to the poor.

Attorneys who work in public interest law and guardians ad litem from across the state met at the University of Richmond School of Law May 17–18 to discuss topics such as legal assistance to the armed forces, immigration rights, ethics of using electronic communications, and alternatives to court—including mediation, arbitration, restorative justice and collaborative law.

The lawyers also discussed preparing cases with special attention to transportation needs, physical barriers, interpreters and cultural differences. The conference is sponsored annually by the VSB Special Committee on Access to Justice.

During the conference, the committee awarded its top honors for volunteers—the Lewis F. Powell Jr. Pro Bono Award and the Oliver White Hill Law Student Pro Bono Award.

In photo 1, Mortimer M. Caplin (left) and John M. Oakey Jr. pose with 2006–07 VSB President Karen A. Gould. Oakey, of Richmond, received the Powell Award for his commitment to pro bono causes after his retirement from firm partnership at McGuireWoods LLP. Caplin accepted the award on behalf a second winner of the Powell Award—volunteer faculty and cooperating counsel who mentor students and direct projects through the Mortimer Caplin Public Service Center, which Caplin established at the University of Virginia.

Oliver W. Hill Sr., who turned 100 on May 1, attended the conference in person to present the award named for him to Maryann Nolan, a third-year law student at the College of William & Mary. [photo 2] Nolan performed more than 1,000 uncompensated or minimally compensated work for the poor during her law schooling.

Hill, of Richmond, was a leader in many groundbreaking civil rights cases, including *Brown v. Board of Education*. The late Lewis Powell, also of Richmond, served on the U.S. Supreme Court.

In addition to formal programs, the conference offered opportunities for networking. In photo 3 are retired Judge Dale H. Harris, 2006–07 chair of the access committee, and attorney David P. Baugh of Richmond, recipient of the 2006 Powell Award.



## Lawyers Receive Training on Indigent Defense: Free Program Supports Court-Appointed Cases

Nationally recognized practitioners of criminal defense gathered in Richmond May 4, 2007, to present the third annual seminar “Indigent Criminal Defense: Advanced Skills for the Experienced Practitioner.”

The daylong seminar drew 480 attorneys to the live presentation in Richmond and 100 to a simulcast in Abingdon. The seminar was sponsored by the justices of the Supreme Court of Virginia, the Chief Justice’s Indigent Defense Training Initiative and the Virginia State Bar.

Among the eight speakers was Lisa M. Wayne of Denver, Colorado, who addressed the question of how to handle voir dire when a judge allows only 30 minutes for jury selection. She advised the audience to file motions for more time, “get right to the heart of your case,” and note for the record physical reactions by potential jurors to questions.

“Don’t apologize about who you are, because you are defending someone who deserves to be defended,” she said. “You are a modern-day saint.”

Luncheon speaker Joshua I. Dratel of New York City described the challenges he faced defending a detainee at Guantanamo Bay, outside the jurisdiction of U.S. courts. He lamented disinterest from the news media, an uninformed public and bizarre occurrences that probably would not have occurred on American soil—for example, judges who had not yet been sworn in ruling on motions.

Dratel saluted the Virginia lawyers before him who represent indigent persons. “I got these accolades from representing just one person in this system,” he said. In the audience were people “who do it every day, anonymously, tirelessly, passionately, effectively.” He thanked them “for your righteous commitment to justice for those who cannot afford to purchase it.”

Colette Tvedt of Seattle, Washington described strategies for defending some of the most detested defendants in the criminal justice system: accused child molesters.

“When your client is charged with raping his daughter, you are starting with a deficit,” she said. But “we’re starting to win these cases more and more.” Successful strategies include getting to know the child and how evidence was collected, gathering impressions from friends and neighbors acquainted with the family, and bringing in experts who can opine on how children can receive certain injuries or be manipulated to lie.

The seminar was offered free of charge to public defenders and court-appointed counsel in criminal cases.



Shown clockwise from top left: Lisa M. Wayne of Denver, Colorado; Joshua I. Dratel of New York City; Colette Tvedt of Seattle, Washington, with Virginia Court of Appeals Judge Walter S. Felton Jr. (left) and Richmond attorney Steven D. Benjamin

# Virginia Fair Trial Project Continues Indigent Defense Reform Efforts

by Betsy Wells Edwards  
Executive Director, Virginia Fair Trial Project

A name can tell us a lot about a person or group. It should say who you are and what you do. Our new name, the Virginia Fair Trial Project, does just that. For four years, as the Virginia Indigent Defense Coalition, we worked to help reform Virginia's indigent defense system.

The Virginia Fair Trial Project and its partner organizations—the Virginia Trial Lawyers Association (VTLA), Virginia Association of Criminal Defense Lawyers (VACDL), National Association of Criminal Defense Lawyers (NACDL), Virginia CURE and the Virginia Interfaith Center for Public Policy (VICPP)—will continue to improve the indigent defense system by collaborating with The Virginia Bar Association, the Virginia State Bar and the Virginia League of Women Voters.

Our mission hasn't changed. We communicate with the public, the media and policymakers about the need for a fair trial for everyone—no matter what the financial resources. The Virginia Fair Trial Project will conduct research and grassroots training, issue reports, and work with our partner organizations and others.

Our reform fight was carried this year to the General Assembly. During the 2007 legislative session, the Virginia Fair Trial Project worked with the governor, attorney general, VTLA, VBA, and VSB and a number of other groups on increasing indigent defense funding. At an April veto session, Virginia took an important step toward improving the indigent defense system in the commonwealth by approving waivers for court-appointed fee caps. For the first time, court-appointed lawyers in Virginia may request additional compensation for complicated or lengthy cases.

The final legislation included:

- 1) \$8.2 million in the final budget specifically allocated for waivers.
- 2) A first-round waiver up to an additional cap on all charges approved by the trial judge, subject to guidelines issued by the executive secretary of the Supreme Court.
  - An additional \$120 for misdemeanors and juvenile delinquency cases (fee cap was \$120), for a total of \$240.
  - An additional \$155 for lower- and mid-level felonies (fee cap was \$445), for a total of \$600.
  - An additional \$850 for high-level felonies (fee cap was \$1,235), for a total of \$2,085.
- 3) An unlimited waiver beyond the additional caps that can be granted by the chief judge in the circuit or district court, subject to guidelines issued by the executive secretary of the Supreme Court.
- 4) A requirement that all court-appointed attorneys submit a detailed accounting of the time expended for that representation.
- 5) Supreme Court tracking of hours worked, waivers requested and amounts paid.

Additional funding of \$3.7 million was provided for state public defender offices, where low pay has led to high turnover in recent years. The additional funding will allow the agency to fill 26 additional positions and provide a 9 percent raise, which will be added to a 4 percent raise for all state employees, yielding a total 13 per-

cent increase in November 2007 for public defender office attorneys administrative and support personnel. Starting salaries for public defenders will increase from \$42,600 to \$48,183. Capital public defenders will receive a 24 percent raise in base salary along with the 4 percent increase for all state employees, for a total of 28 percent.

There are 25 public defenders offices in Virginia. They handle about 60 percent of the indigent defense cases in the state. All other indigent defendants are represented by court-appointed attorneys—lawyers in private practice who take court-appointed criminal cases.

During the past three years, the General Assembly has appropriated nearly \$17 million to increase court-appointed fees (\$2.4 million in 2005, \$6.3 million in 2006 and \$8.2 million in 2007). These increases helped Virginia's underfunded indigent defense system, but much work remains to be done. The Virginia Fair Trial Project and its partners will continue to improve Virginia's indigent defense system so that fair trials are a reality for all Virginians.

The Virginia State Bar's  
Special Committee on Access to Legal Services is sponsoring a

# CALL FOR NOMINATIONS

Under Phase Two of a Pilot Project in the Twentieth, Twenty-first, Twenty-third  
and 2A Judicial Circuits

*to recognize*

**Extraordinary Contributions made to the  
Virginia Justice System  
by Local Appointed Counsel or Pro Bono Attorneys**

Nominally compensated court-appointed attorneys or pro bono attorneys in civil or criminal matters who make extraordinary contributions to the Virginia Justice System are eligible for recognition. Members of the legal profession, bar associations and the general public may submit nominations. Among others, candidates who represent parents in removal and termination proceedings; act as guardians *ad litem*; function as mediators in court-annex programs; or who accept indigent criminal defense work as appointed counsel may be considered. Additional details about contributions that qualify as pro bono under Virginia Public Service Rules 6.1 and 6.2 may be viewed at [http://www.vsb.org/docs/2006-07\\_pg.pdf](http://www.vsb.org/docs/2006-07_pg.pdf).

Entries will be reviewed by the VSB Access to Legal Services Committee. Virginia attorneys selected as honorees will be presented with an embossed certificate jointly signed by the Chief Justice and VSB president **at a term of circuit court or other suitable occasion in the locality**. There is no official form to complete. Nomination letters describing the extent, quality and duration of contributions and any letters of endorsement should be forwarded by August 25, 2007, to:

VSB Special Committee on Access to Legal Services  
c/o Maureen Petrini, Access to Legal Services Director  
707 East Main Street, Suite 1500  
Richmond, VA 23219

Phone inquiries may be directed to Maureen Petrini at the bar's Access to Legal Services Office at (804) 775-0522.

For phase two of the pilot, the committee has selected the following four judicial circuits or divisions: the Second (2A-Eastern Shore counties of Accomack and Northampton only); Twentieth (Fauquier, Loudoun and Rappahannock); Twenty-first (Martinsville and Patrick and Henry counties); and Twenty-third (Salem and Roanoke City and County.) They represent sample rural, urban and mixed jurisdictions where results from continuing initial efforts can help inform the bar's future planning if the pilot is expanded to other circuits in future years. As was the case in the inaugural year of 2005, participation in 2007 is and will remain optional.

# How to Request a Fee-Cap Waiver

## Court-Appointed Counsel Representing Indigent Defendants in Criminal Matters May Now Seek Waivers of the Statutory Fee Caps

by **Katya N. Herndon**  
Director of Legislative and Public Relations  
Supreme Court of Virginia

The General Assembly amended Virginia Code § 19.2-163, effective July 1, 2007, to allow attorneys appointed to represent indigent defendants in criminal matters to seek waivers of the statutory fee caps. Introduced as companion bills by Delegate Lacey E. Putney and Senator Kenneth W. Stolle, the new law permits a court to grant a waiver when the effort expended by the attorney, the time reasonably necessary for the representation, the novelty and difficulty of the issues, or other circumstances warrant such a waiver. To receive compensation for the representation, including any waiver, court-appointed counsel must submit a detailed accounting of the time expended for the representation within thirty days of the completion of the proceedings.

The amended statute sets forth two separate levels of waivers beyond the statutory fee caps. The court has discretion to grant both levels of waivers subject to guidelines issued by the executive secretary of the Supreme Court of Virginia. The first level allows the court that heard the case to grant a waiver up to a certain supplemental amount depending upon the type of charge and the court hearing the case. The specific waiver amounts permitted under this first-level waiver are listed in Table 1 under "Supplemental Statutory Waiver Amount." The second-level waiver has no cap; however, it requires approval by both the presiding judge and the chief judge of the circuit court or district court that heard the case.

The General Assembly appropriated \$8.2 million for these waivers. If at any time the funds allocated for the waivers are exhausted, the executive secretary of the Supreme Court is required to certify that

fact to the courts, and no additional waivers may be approved. Every court across the state has been provided with a budget estimate for its portion of the \$8.2 million. These guideline budget estimates have been developed based on past expenditures from the Criminal Fund by each court. The percentage of the Criminal Fund used by each particular court has been multiplied by the \$8.2 million to determine the estimated amount for each court. Monthly reports of expenditures for waivers will be provided to each court. The Executive Secretary's Office has estimated that the \$8.2 million appropriated is sufficient to allow first-level waivers in approximately 20 percent to 25 percent of cases where counsel has been appointed.

In order to develop the guidelines that courts are to consider in deciding whether to grant waivers, a working group was established that consisted of judges from circuit, general district and juvenile and domestic relations district courts; commonwealth's attorneys; the executive director of the Indigent Defense Commission; attorneys in private practice who serve as court-appointed counsel; and staff from the Office of the Executive Secretary. To provide guidance to courts and attorneys, the working group recommended the guidelines set forth in Table 2.

To apply for a waiver, an attorney must complete both Form DC-40, LIST OF ALLOWANCES (revised effective 7/07) and new Form DC-40(A), APPLICATION OF AUTHORIZATION FOR WAIVER OF FEE CAP, and submit them to the court with an attorney time sheet. (See pages 34 and 35 for copies of Forms DC-40 and DC-40(A)). A separate Form DC-40(A) must be submitted for each charge for which the attor-

### SCV Executive Secretary to Oversee Waivers



Karl R. Hade, executive secretary of the Supreme Court of Virginia since 2005, heads the office that is implementing collection of court-appointed fee data and payment of fee-cap waivers under newly amended Virginia Code § 19.2-163. He holds a bachelor's degree in biology and a master's in business administration from the University of Richmond.

ney is seeking a waiver. The reason for the request for waiver must be explained on Form DC-40(A), and an attorney time sheet must be included. A sample attorney time sheet is available online at [www.courts.state.va.us/news/ctappt\\_counsel/ctappt\\_counsel\\_time\\_sheet.pdf](http://www.courts.state.va.us/news/ctappt_counsel/ctappt_counsel_time_sheet.pdf); however, any time sheet that provides a detailed accounting of hours spent on the case is acceptable.

Form DC-40(A), which provides space for the judge to explain the basis for approving the request for waiver, will be retained in the court's file with the attorney time sheet. Revised Form DC-40, LIST OF ALLOWANCES, on which the court will specify whether any waiver has been authorized and the amount allowed, will be submitted by the court to the Office of the Executive Secretary for payment.

Revised Form DC-40 permits only one charge to be listed per block; accordingly, only three charges may be listed per form. This change and other revisions to Form DC-40 were made to ensure that the executive secretary is able to comply with the new quarterly reporting requirement added to § 19.2-163. The executive secretary must report to the governor, members of the House Appropriations Committee and members of the Senate Finance Committee on the number and category of offenses charged involving adult and juvenile offenders where counsel is appointed. These reports must also include the amounts paid for waivers of the statutory fee caps. Additional changes to Form DC-40 include requiring greater specificity as to the charged offense and requiring attorneys to specify actual hours spent on each charge, even if a waiver is not requested. This information is essential to accurately project the cost of funding any increase to or elimination of the statutory fee caps.

Requests for waivers should be filed in the court in which the case was concluded. There is no appeal process available if an application for waiver of fee cap is denied. In any case where a waiver has been requested, the defendant will only be assessed attorney's fees equal to the statutory fee cap for the applicable charge.

Questions about the waiver process and forms should be addressed to any district or circuit court clerk's office.

More information, including answers to frequently-asked questions, is available at [www.courts.state.va.us/news/2007\\_0626\\_waivers\\_of\\_statutory\\_fee\\_caps.html](http://www.courts.state.va.us/news/2007_0626_waivers_of_statutory_fee_caps.html).

**Table 1: Fee and waiver amounts for court-appointed counsel pursuant to § 19.2-163, effective July 1, 2007.**

Court	Charge	Statutory Fee	Supplemental Statutory Waiver Amount	Fee for Additional Waiver
District	Misdemeanor	\$120	Up to \$120	Discretion of Court
J&DR District	Delinquency	\$120	Up to \$120	Discretion of Court
District	Felony, Class III-VI resolved in district court	\$445	Up to \$155	Discretion of Court
District	Felony, Class II resolved in district court	\$1,235	Up to \$850	Discretion of Court
Circuit	Misdemeanor	\$158	Not Available	Discretion of Court
Circuit	Felony, Class III-VI	\$445	Up to \$155	Discretion of Court
Circuit	Felony, Class II	\$1,235	Up to \$850	Discretion of Court

**Table 2: Statutory Criteria for Fee Cap Waiver Guidelines, including examples of "exceptional case" factors, promulgated by the Office of the Executive Secretary pursuant to § 19.2-163.**

**Statutory Criteria for Fee Cap Waiver Guidelines**

1. Representation required additional time and effort.
2. Representation presented novel and difficult issues.
3. Representation involved other circumstances warranting a waiver.

**Examples of "exceptional case" factors to be considered for fee cap waivers (including but not limited to the following):**

- Single-charge representation (especially misdemeanor and juvenile cases).
- Juvenile charged with an offense that would be a felony if committed by an adult.
- Jury trials, including misdemeanors.
- Extensive travel required during representation.
- Juvenile certification/transfer hearings where Juvenile and Domestic Relations District Court jurisdiction retained.
- Issues requiring extensive legal research.
- Matters involving DNA and other scientific evidence.
- Multiple defendant, victim, or "spree" cases.
- Complex fraud cases.
- Representation of a client requiring the services of an interpreter.
- Representation of a client with serious mental health issues, or accessibility challenges.
- Insanity defense.
- Complex investigation, considering number and accessibility of witnesses interviewed, record collection, document organization and use of investigative, expert or other services.
- Matters involving unusually long and complex pretrial hearings, trial, or sentencing hearing.
- Serving as advisory counsel to pro se defendant during felony trial.
- Change-of-venue cases.

**See sample forms on pages 34–35.**



**LIST OF ALLOWANCES**

Commonwealth of Virginia

VENDOR INVOICE NO. ....  
 VENDOR REFERENCE .....  
 (MAXIMUM 23 CHARACTERS)

.....  
 CITY OR COUNTY  
 .....  
 VENDOR F.I.N. OR SOCIAL SECURITY NUMBER  
 .....  
 PAY TO THE ORDER OF: FIRM, CO., INDIVIDUAL  
 .....  
 ADDRESS  
 .....  
 CITY, STATE, ZIP

[ ] General District Court [ ] Traffic [ ] Criminal  
 [ ] Juvenile & Domestic Relations District Court [ ] Circuit Court

**CERTIFICATE OF ALLOWANCE FOR PAYMENT**  
 Said account has been duly examined by the undersigned and it appearing to be correct and unpaid, the account is hereby certified to the Supreme Court of Virginia for payment.  
 \_\_\_\_\_ / \_\_\_\_ / \_\_\_\_  
 CLERK/DEPUTY CLERK DATE

**SEE INSTRUCTIONS ON REVERSE**

Defendant's Name	Case Number	Original Code § Charged	Chart of Allowances Code §
Trial/Service Date: / /	Specify case type: ___ Adult ___ Juvenile	For district court felony, was case certified? ___ Yes ___ No	
For adult criminal and juvenile delinquency cases, specify offense type or equivalent: ___ Misdemeanor ___ Felony (Class 1) ___ Felony (Class 2) ___ Felony (Class 3-6) ___ Felony (unclassified, punish. by more than 20 yrs.) ___ Felony (unclassified, punish. by 20 yrs. or less)		For non-delinquency juvenile court cases, specify type of representation: _____	
Calculate total time spent for charge and expenses claimed. Itemize expenses and include receipt for any over \$20. List expenses: _____	<b>Time:</b> Total in court: Hrs. ___ Min. ___ \$ _____ Total out of court: Hrs. ___ Min. ___ \$ _____ Total Expenses: \$ _____ Waiver amount requested: \$ _____ <b>Total amount claimed:</b> \$ _____	<b>AMOUNT ALLOWED</b> (PER JUDGE APPROVAL) Fee amount \$ _____ Waiver amount \$ _____ <b>TOTAL:</b> \$ _____	

Defendant's Name	Case Number	Original Code § Charged	Chart of Allowances Code §
Trial/Service Date: / /	Specify case type: ___ Adult ___ Juvenile	For district court felony, was case certified? ___ Yes ___ No	
For adult criminal and juvenile delinquency cases, specify offense type or equivalent: ___ Misdemeanor ___ Felony (Class 1) ___ Felony (Class 2) ___ Felony (Class 3-6) ___ Felony (unclassified, punish. by more than 20 yrs.) ___ Felony (unclassified, punish. by 20 yrs. or less)		For non-delinquency juvenile court cases, specify type of representation: _____	
Calculate total time spent for charge and expenses claimed. Itemize expenses and include receipt for any over \$20. List expenses: _____	<b>Time:</b> Total in court: Hrs. ___ Min. ___ \$ _____ Total out of court: Hrs. ___ Min. ___ \$ _____ Total Expenses: \$ _____ Waiver amount requested: \$ _____ <b>Total amount claimed:</b> \$ _____	<b>AMOUNT ALLOWED</b> (PER JUDGE APPROVAL) Fee amount \$ _____ Waiver amount \$ _____ <b>TOTAL:</b> \$ _____	

Defendant's Name	Case Number	Original Code § Charged	Chart of Allowances Code §
Trial/Service Date: / /	Specify case type: ___ Adult ___ Juvenile	For district court felony, was case certified? ___ Yes ___ No	
For adult criminal and juvenile delinquency cases, specify offense type or equivalent: ___ Misdemeanor ___ Felony (Class 1) ___ Felony (Class 2) ___ Felony (Class 3-6) ___ Felony (unclassified, punish. by more than 20 yrs.) ___ Felony (unclassified, punish. by 20 yrs. or less)		For non-delinquency juvenile court cases, specify type of representation: _____	
Calculate total time spent for charge and expenses claimed. Itemize expenses and include receipt for any over \$20. List expenses: _____	<b>Time:</b> Total in court: Hrs. ___ Min. ___ \$ _____ Total out of court: Hrs. ___ Min. ___ \$ _____ Total Expenses: \$ _____ Waiver amount requested: \$ _____ <b>Total amount claimed:</b> \$ _____	<b>AMOUNT ALLOWED</b> (PER JUDGE APPROVAL) Fee amount \$ _____ Waiver amount \$ _____ <b>TOTAL:</b> \$ _____	

I certify that the above claim for fees and/or expenses is true and accurate and that no compensation for the time or services set forth has previously been received.

\_\_\_\_\_/\_\_\_\_\_/\_\_\_\_\_  
 VENDOR'S SIGNATURE DATE VSB MEMBER NUMBER

**AMOUNT CERTIFIED FOR PAYMENT** \$ \_\_\_\_\_

I have reviewed the foregoing information and authorize the amount allowed to the vendor named above.

\_\_\_\_\_/\_\_\_\_\_/\_\_\_\_\_  
 JUDGE Date  
 \_\_\_\_\_/\_\_\_\_\_/\_\_\_\_\_  
 CHIEF JUDGE Date

**APPLICATION AND AUTHORIZATION FOR WAIVER OF FEE CAP**

COMMONWEALTH OF VIRGINIA

Case No. ....

Vendor Invoice No. ....

General District Court  Circuit Court  
 Juvenile and Domestic Relations District Court

.....  
CITY OR COUNTY

.....  
PRESIDING JUDGE

.....  
DEFENDANT'S NAME

.....  
DATE OF APPOINTMENT

.....  
CHARGE AT TIME OF APPOINTMENT (CODE SECTION)

.....  
DATE CASE CONCLUDED

.....  
COUNSEL'S NAME ADDRESS CITY STATE ZIP

**PLEASE CHECK ALL THAT APPLY:**

- On the basis of the factors below, I request that the Court waive the otherwise applicable statutory fee cap and authorize supplemental compensation in the amount of \$ ..... (See instructions on reverse for supplemental statutory waiver amount which can be requested.)
- On the basis of the factors below, I also request that the presiding judge and the chief judge authorize a fee for additional waiver in the amount of \$ .....

Please explain in detail the basis for your request for waiver of the fee cap (Attach Form DC-40, LIST OF ALLOWANCES and Attorney Time Sheet):

My representation of this client on this charge required additional time and effort:  
.....  
.....

My representation of this client on this charge presented novel and difficult issues:  
.....  
.....

My representation of this client on this charge involved the following circumstances which warrant a waiver:  
.....  
.....

I certify that the above claim for fees is true and that no compensation for these services has previously been received.

..... DATE ..... COUNSEL SIGNATURE ..... VSB MEMBER NUMBER .....

**TO BE COMPLETED BY PRESIDING JUDGE AND/OR CHIEF JUDGE**

I authorize supplemental statutory waiver compensation in the amount of \$ ..... for the following reason(s):  
.....  
.....

Supplemental statutory waiver request is denied.

..... JUDGE DATE .....

I authorize a fee for additional waiver in the amount of \$ ..... for the following reason(s):  
.....  
.....

Request for a fee for additional waiver is denied.

..... PRESIDING JUDGE DATE ..... CHIEF JUDGE DATE  
(Whether approved or denied)

# Intellectual Property Section Educates Lawyers, Encourages Lawyers-to-Be

by Cynthia C. Lynch

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, the economic impact of intellectual property has grown, the public has become more aware of intellectual property, and intellectual property law has gained increased importance and celebrity. The USPTO is located on a campus in Alexandria, and the U.S. District Court for the Eastern District of Virginia is a prominent venue for intellectual property cases. Today our section strives to achieve many of the same goals set by its founders, and the past year presented exciting opportunities, in addition to the section's traditional annual continuing legal education programs.

In October 2006, the U.S. Court of Appeals for the Federal Circuit, which has exclusive jurisdiction over patent appeals and which reviews both trademark and patent decisions by the USPTO, for the first time held special sittings of the court at the University of Virginia and the University of Richmond. The sittings offered Virginia law students and citizens the chance to see this specialized intellectual property court in action. Our section, in conjunction with the Federal Circuit Bar Association, sponsored events surrounding the special sittings, including two programs in Charlottesville and one in Richmond. The programs afforded section members, Virginia law students and faculty, and the federal circuit judges an opportunity to meet and exchange ideas about intellectual property law and practice.

The Intellectual Property Section also continued its annual Intellectual Property Law Student Writing Competition, now in its third year. The winning article appears in this issue. 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.

This issue of *Virginia Lawyer* reflects the diversity in intellectual property law and highlights intellectual property issues that may spark the interest of lawyers, law students and the public at large.



**Cynthia Cordle Lynch** is administrator for trademark policy and procedure at the USPTO. She also worked at the U.S. International Trade Commission on intellectual property-based unfair-import investigations. She spent several years in private practice at Kaufman & Canoles in Norfolk, handling intellectual property and commercial litigation. Lynch is a graduate of the University of North Carolina at Chapel Hill and the University of Virginia School of Law. The views expressed in this column are her own, and do not necessarily reflect those of the USPTO or the United States government.

# Summary Judgment at the TTAB: *Is It Worth Pursuing?*

by Christopher P. Foley

Failure to resolve cases that could be decided on summary judgment has important business ramifications. Sophisticated businesses select marks after carefully evaluating competing uses and registrations. Once the mark is selected and an application is filed, considerable time and investment are directed toward product development, beta testing and marketing. From an applicant's perspective, an unanticipated opposition puts that investment in jeopardy. Similarly, an application for a similar mark for related goods or services can encroach on the goodwill in another's mark and threaten to short-circuit that investment, justifying an opposition. If the only issue is the application of law to undisputed facts, then the case is ripe for summary judgment.

The Trademark Trial and Appeal Board (TTAB or Board) routinely acknowledges in every case involving a motion for summary judgment that Rule 56(c) of the Federal Rules of Civil Procedure provides an appropriate method for disposing of cases with no genuine issues of material fact in dispute. Meeting this standard at the Board, however, has proved particularly difficult in recent years. Consideration of successful cases and pitfalls faced by some litigants may help summary judgment become a more useful tool.

Seven years ago, an administrative law judge at the Board and two other authors reported that summary judgments were losing ground at the TTAB.<sup>1</sup> In evaluating TTAB decisions between 1998 and 2000, the authors found that three-quarters of such motions were denied.

The authors discovered that likelihood of confusion was a ground for seeking summary judgment in 55 percent of 205 motions considered, yet 75 percent of the motions based on likelihood of confusion were rejected.

Those authors concluded that the trend may have derived from a series of federal circuit decisions that reversed TTAB summary judgment determinations, particularly on claims of likelihood of confusion. The decisions represented a break from precedent, which touted the use of summary judgment as an expeditious vehicle for resolving TTAB cases.<sup>2</sup>

Recent TTAB cases suggest that the reluctance toward granting judgment has not changed. A review of 108 TTAB decisions involving motions for summary judgment published over a 14-month period beginning January 2006 reveals that 32 of the motions were granted in whole or in part.<sup>3</sup> Of the 108 decisions involving summary judgment, likelihood of confusion was raised 55 percent of the time, the same figure as in the 1998–2000 study. In the cases in which motions were granted, likelihood of confusion was an issue half of the time. In 95 percent of those cases, the TTAB found a likelihood of confusion. Significantly, however, the TTAB still denied 75 percent of the cases based on this ground—the same percentage reported by the prior study.

The TTAB's reluctance toward granting summary judgment raises the questions of who pursues summary judgment, what motions are successful, why they are suc-

cessful, and whether there are frequent pitfalls faced by litigants seeking summary judgment. Sixty-four percent of recent motions for summary judgment were filed by opposers to a trademark application or petitioners seeking cancellation of a registration. Thirty-three percent of those motions were successful. Applicants in opposition proceedings and respondents in cancellation actions pursued summary judgment in only 36 percent of the cases in which summary judgment was raised, and their success rate was less than 25 percent.

Likelihood of confusion is raised more frequently than any other issue by parties seeking summary judgment before the TTAB.<sup>4</sup> To prevail, however, § 2(d) of the Lanham Act generally requires the dominant portion of the marks to be identical, and evidence must clearly establish an overlap in goods or services, or both.

An example of a case in which an opposer was successful on summary judgment is *Venture Out Properties LLC v. Wynn Resorts Holding, LLC*,<sup>5</sup> which involved Wynn's applications to register a CABANA BAR & CASINO in a standard character form and a word form for "casino services," as well as applications to register CABANA BAR for "restaurant bar and cocktail lounge services." Opposer, Venture Out Properties, offered evidence that it provided "hotel services" predating Wynn's date of first use—the date applicant's hotel offering casino services opened. In evaluating the similarity of the marks, the TTAB emphasized that the involved marks "share and stress" the same term—namely CABANA—and that

the other terms are generic. While opposer's hotel was in Hawaii, where gambling is illegal, the TTAB emphasized that there was substantial evidence of record, through third-party uses and registrations, of a relationship between opposer's hotel services and applicant's services. The TTAB also referred to earlier decisions finding hotel and restaurant services to be related. Accordingly, the TTAB found the services to be closely related and granted opposer's motion.

In *Concord Apparel LLC v. International Mark Management SA*,<sup>6</sup> involving Registration No. 2,378,903 covering various clothing items for a design featuring a stylized "Z" and the term ZAGATO, petitioner moved for summary judgment on the ground of likelihood of confusion based on its prior use and registration of ZAGATO for overlapping apparel. While respondent asserted that the configuration of the "Z" for both marks was visually dissimilar, the TTAB was compelled by the distinctiveness of the dominant literal terms, which were identical.

*Dole Fresh Fruit Co. v. Economy Cash & Carry LP*<sup>7</sup> was an opposition proceeding involving an application for the mark TROPICAL GOLD for "nonalcoholic beverages, namely, noncarbonated flavored drinks and fruit juice." Dole Fresh Fruit Company, the opposer, cited prior use and registration of the identical mark for fresh fruit. Opposer also submitted a declaration identifying the use by many companies, including Ocean Spray, Sunkist and Tropicana, which sold fresh fruit and fruit juices under the same marks. In light of this evidence, the TTAB concluded that purchasers would likely assume that applicant's and opposer's goods came from the same source.

A registration for the IMPERIAL mark for "paper products . . ." was cancelled on summary judgment on the basis of uncontroverted evidence of use of the same mark for the same types of products offered in the same channels of trade. *Sysco Corp. v. Princess Paper Inc.*<sup>8</sup> Similarly, Chemical Financial Corporation succeeded on summary judgment in

opposing an application to register CHEMICAL BANK for banking and financial services. *Chemical Financial Corp. v. 200 Kelsey Associates*.<sup>9</sup> In that case, opposer submitted extensive evidence that it used the mark CHEMICAL BANK as a trademark and commercial name for its subsidiaries for more than 100. In granting summary judgment, the TTAB concluded that identical marks and virtually identical services can create a likelihood of confusion even among sophisticated customers in the banking field.

Likelihood of confusion  
is raised more  
frequently than any  
other issue by parties  
seeking summary  
judgment before  
the TTAB.

Where the difference in the marks is one word versus two or singular versus plural, the TTAB has found when the marks are viewed in their entireties, no issue of material fact regarding similarity in sound, appearance and commercial impression. See, e.g., *Fram Trak Industries v. WireTracks LLC*<sup>10</sup> (a cancellation action between WIRE TRAK versus WIRETRACKS for electrical, telephone and signal wires); *Acosta v. Barmar LLC*<sup>11</sup> (another cancellation action between the marks LAS PALAPAS and LAS PALAPA for restaurant services).

Well-known marks apparently receive greater latitude in obtaining summary judgment on a § 2(d) claim. For example, in *Warner Bros. Entertainment Inc. v. Los*

*Primos Productions*,<sup>12</sup> the TTAB held that applicant's use of the name HARRY POTHEAD in an animated production as a prominent means to poke fun at something was not a parody or fair use of the popular HARRY POTTER name. Accordingly, summary judgment was granted despite the obvious difference in connotation and appearance. In *Amazon.com Inc. v. Von Eric Lerner Kalaydjian*,<sup>13</sup> the TTAB held that COSMETICSAMAZON for retail-store and online ordering services for skin-tanning services and various lotions was likely to be confused with AMAZON.COM for soaps, perfumery and cosmetics. In granting summary judgment, the TTAB concluded that consumers would view AMAZON as the source-identifying element and discount the generic word COSMETICS. Further, in *Hearst Communications Inc. v. TVNESS LLC*,<sup>14</sup> the TTAB was presented with an application to register COSMO PARTY. The application was opposed on the basis of the COSMOPOLITAN mark owned by Hearst Communications Inc., and opposer's family of COSMO marks, including COSMO GIRL and COSMO QUIZ. In this case, opposer's activities related to magazines and collateral goods, whereas applicant's sought to register the COSMO PARTY mark in connection with an Internet-dating Web site, among other things, and certain entertainment services. The TTAB sustained the opposition on likelihood of confusion.

Despite commonality in goods or services, questions regarding the similarity in appearance, sound and connotation in marks can avoid summary judgment. Cases include the following marks: RESVIS XR v. RESIVIT,<sup>15</sup> CHARLOTTE v. CHARLOTTE TILBURY,<sup>16</sup> MILK DUDS v. MILKDUDZ—NOT YOUR MOMMAZ NURSING WEAR,<sup>17</sup> CHARLOTTE v. CHARLOTTE RONSON,<sup>18</sup> WRITEABOUT and WRITE@BOUT v. WRITE!,<sup>19</sup> TWENTY BENCH v. TWENTY ROWS,<sup>20</sup> BIG O, BIG FOOT and BIG v. BIG HOSS,<sup>21</sup> HOME OF THE NO JOB LOAN v. HOME OF THE COST LOAN,<sup>22</sup> STUDIO v. STUDIO SERIES,<sup>23</sup> IMMUNOTECH IMMUNOCALL v. IMMUNOCCELL,<sup>24</sup> BONGOS CUBAN

CAFE v. COCO BONGO HOUSE OF ROCK & POP,<sup>25</sup> and LEDISON v. EDISON.<sup>26</sup>

Marks may be substantially identical, but factual disputes over the relatedness of goods and services can preclude summary judgment. In *Casper's Ice Cream v. Corn Products International Inc.*,<sup>27</sup> applicant sought to register the mark CASCO for unmodified corn starch used as an ingredient in various food products and was opposed by opposer's registration and longstanding use of CASCO for confections. The Board denied applicant's motion for summary judgment, finding genuine issues of material fact regarding the overlap of purchasers, trade channels, marketing environments and strength of mark. See also *L.C. Licensing Inc. v. Cory Berman*<sup>28</sup> (ENYCE for automatic accessories versus ENYCE, ENYCE and design, and LADY ENYCE for men's, women's and children's apparel); *Nanogen Inc. v. Pharmwest Inc.*<sup>29</sup> (NANOGEN for cosmetics and nonmedicated skin and hair preparations versus NANOGEN for medical reagents and assays); and *Centex Homes v. Citihomes Realty Corp.*<sup>30</sup> (CITIHOMES for real estate brokerage services versus CITYHOMES residential home construction and real estate development).

The TTAB will not grant summary judgment based on likelihood of confusion if it detects issues on the distinctiveness and strength of the nonmovant's mark. In *Delegats Wine Estate Limited v. The Fresh Oyster LLC*,<sup>31</sup> applicant filed an application to register THE FRESH OYSTER for wines and was opposed on the basis of opposer's use and registration of OYSTER BAY and design for wines. The Board denied applicant's motion because it found genuine issues on whether Oyster Bay was a known geographic location, whether the location was associated with wine, and whether the location would be material to a consumer's purchase. See also *Health Venture Partners v. Meta Balance, Inc.*<sup>32</sup> (NATURE'S LABEL versus NATURE'S CODE for related goods, namely vitamins); and *Mrs. United States National Pageant Inc. v. Richardson*<sup>33</sup> (MRS. U.S. INTERNATIONAL v. MRS.

The TTAB will not grant summary judgment based on likelihood of confusion if it detects issues on the distinctiveness and strength of the nonmovant's mark.

UNITED STATES NATIONAL PAGEANT and MRS. UNITED STATES in connection with pageants and contests).

But the Board will grant summary judgment of no likelihood of confusion where the evidence shows a distinct difference in sound, appearance, connotation and commercial impression. *Inspiration Software Inc. v. Teachers Inspired Practical Stuff Inc.*<sup>34</sup> In this case, applicant filed an application to register the mark T.I.P.S.—TEACHER INSPIRED PRACTICAL STUFF for course material for elementary school children. Inspiration Software Inc. opposed, asserting its registration INSPIRATION for computer programs in the field of idea development. The Board, in granting applicant's motion, cited the different visual appearance and sound of the two marks and the lack of common terms to offset those differences. Some pitfalls were observed in recent summary judgment proceedings. One of the most common is pursuing summary judgment on an unpleaded issue. Under § 528.07(a) of the Trademark Trial & Appeal Board Manual of Procedures (TBMP), a party may not obtain summary judgment on an issue that has not been pleaded. This rule is frequently overlooked by litigants, causing many motions to be denied that otherwise might have had merit. For example, in *Hurley*

*International LLC v. Volta*,<sup>35</sup> opposer filed an initial motion for summary judgment based on a claim of fraud. The TTAB, however, held that the fraud claim had not been properly pleaded in the notice of opposition. Similarly, in *Kidsart Inc. v. Kidzart Texas LLC*,<sup>36</sup> opposer argued that "if its mark is generic or nondistinctive, so too is applicant's mark." The notice of opposition did not include this allegation. While opposer's motion was granted, the TTAB instructed opposer to file an amended notice of opposition, if it intended to press its claim regarding the generic nature or nondistinctiveness of applicant's mark.

In another situation, a petitioner in a cancellation action sought summary judgment on a claim of likelihood of confusion with respect to a family of marks. *Orozco et al. v. Hwang*.<sup>37</sup> Two of the marks argued in petitioner's brief in support of the motion were not pleaded in the petition to cancel. Accordingly, the TTAB held that the petitioner could not obtain summary judgment on a claim of likelihood of confusion with respect to those marks.

As noted in *Kidsart Inc.*, when a party desires to pursue summary judgment on an unpleaded ground, the appropriate procedure is to move to amend the notice of opposition or petition to cancel. TBMP, § 528.07(a). In *Hurley International*, after the TTAB denied its initial motion, the opposer filed a combined motion to amend its notice of opposition and a motion for summary judgment. Despite claims of prejudice by the applicant, the TTAB held that leave to amend should be freely given, citing Fed. R. Civ. P. 15(a) and TBMP § 507.02. See also *Asics Corp. v. Paragon Development Corp.*,<sup>38</sup> *Drive Trademark Holdings v. Inofin*,<sup>39</sup> and *Florida Engineered Construction Products Corp. v. Cast-Crete Inc.*<sup>40</sup>

Summary judgment motions frequently are denied as untimely. TBMP § 504.01 explains that the testimony periods in an *inter partes* proceeding before the TTAB corresponds to the trial phase in a court proceeding. Therefore, to be timely, a motion for summary judgment must be

filed before the opening of the first testimony period.

Parties often fail to respond to discovery, including requests for admissions, only to have that oversight be deemed an admission on summary judgment. In *Hearst Communications*,<sup>41</sup> *supra*, applicant failed to respond to 116 requests for admission relating to priority, fame, distinctiveness and confusing similarity. As a result of this failure, opposer filed a motion for summary judgment asserting that applicant's failure to respond was an admission. Applicant ignored the ramifications for not responding and all 116 requests were held to be admitted.<sup>42</sup>

In *Florida Engineered Construction Products Corporation*,<sup>43</sup> opposer served requests for admissions regarding, among other things, likelihood of confusion. Applicant failed to respond to the requests, and opposer moved the TTAB to deem the requests admitted. The motion was granted. On summary judgment, the TTAB did not consider applicant's arguments on likelihood of confusion. The Board found that the admissions demonstrated no genuine issue of material fact with respect to opposer's 2(d) claim. Thus, requests for admission are a very useful tool for parties seeking summary dismissal of a case.

Parties commonly introduce arguments during briefing that are not supported in the record. Facts must be in evidence to be considered by the Board. In *International Flora Technologies v. Desert Whale Jojoba Co.*,<sup>44</sup> petitioner failed to introduce any evidence during its assigned testimony period. Instead, petitioner attached various exhibits to its main brief, including copies of its pleaded registrations. Not surprisingly, the Board deemed petitioner's tactic a request to take judicial notice of the registrations.

Finally, the Board will not resolve issues of fact against a nonmoving party. *Gamers Inc. v. Game-Expert Inc.*<sup>45</sup> In pursuing summary judgment, movants must rely on uncontroverted evidence in the record to prevail. *Hoganas AB v. Konica Minolta*



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*Printing Solutions USA Inc.*<sup>46</sup> Therefore, in preparing declarations and supporting exhibits, litigants must avoid facts for which the nonmoving party has contradictory evidence, but litigants must recognize that expressing disagreement with the facts does not by itself raise a genuine issue. *Id.*, citing the Federal Circuit in *Otocom Systems Inc. v. Houston Computer Services Inc.*<sup>47</sup>

While statistical analysis might suggest reluctance by the Board to grant summary judgment, the details of cases involving such motions indicate that litigants can do a much better job presenting the Board with sustainable motions. With closer attention given to the marks at issue and the rules of practice, the percentage of granted motions should increase. Therefore, summary judgment remains a viable strategic alternative, particularly for a litigant who is mindful of the rules and is careful to rely on facts not in dispute. ♪

#### Endnotes:

- 1 Linda K. McLeod, Erin M. Falk & May F. Walters "Summary Judgment Is Losing Ground Before Panel," *Nat'l L.J.*, May 1, 2000, at c6. Linda K. McLeod is a former administrative law judge and currently is of counsel at Finnegan Henderson.
- 2 In the fall 2006 meeting of the Virginia State Bar Intellectual Property Section, Administrative Trademark Judge Gerard F. Rogers acknowledged the effect of the Federal Circuit decisions on summary judgment determinations by the board. Gerald F. Rogers, Administrative Trademark Judge, Address at the Meeting of the Virginia State Bar Intellectual Property Section, *Prosecuting and Defending Opposition and Cancellation Actions Before The Trademark Trial and Appeal Board* (Oct. 6, 2006).
- 3 The summary judgment decisions were identified through analysis of the Westlaw database. The author wishes to acknowledge the assistance of Dr. Marcus Luepke, a member of Finnegan Henderson's Trademark and Copyright Practice Group, in providing invaluable research in support of this article.

- 4 Priority and standing follow likelihood of confusion in terms of the frequency of issues raised in motions for summary judgment. No other issues are presented with any regularity.
- 5 Opposition Nos. 91167237, 91167238, 9116752 and 91168647, 2007 WL 39112 (TTAB Jan. 3, 2007).
- 6 Cancellation No. 92044693, 2006 WL 2558350 (TTAB Aug. 22, 2006).
- 7 Opposition No. 91164233, 2006 WL 2927867 (TTAB Sept. 28, 2006).
- 8 Cancellation No. 92042937, 2006 WL 752426 (TTAB Mar. 22, 2006).
- 9 Opposition No. 91163169, 2006 WL 717523 (TTAB Mar. 6, 2006).
- 10 77 U.S.P.Q.2d 2000 (TTAB Jan. 23, 2000).
- 11 Cancellation No. 92043837, 2006 WL 3540109 (TTAB Nov. 30, 2006).
- 12 Opposition No. 91156299, 2006 WL 2850871 (TTAB Sept. 13, 2006).
- 13 Opposition No. 91122000, 2006 WL 2860228 (TTAB Sept. 22, 2006).
- 14 Opposition No. 91162261, 2007 WL 616038 (TTAB Feb. 20, 2007).
- 15 *Biofutura Pharma v. Day Corp.*, Opposition No. 91169267, 2006 WL 3736516 (TTAB Dec. 12, 2006).
- 16 *GMA Accessories v. Charlotte Tilbury Ltd.*, Opposition No. 91171089, 2006 WL 3776384 (TTAB Dec. 8, 2006).
- 17 *Hershey Chocolate & Confectionary Corp. v. Wall*, Opposition No. 91166974, 2006 WL 3776385 (TTAB Dec. 6, 2006).
- 18 *GMA Accessories, Inc. v. Sanei Charlotte Ronson, LLC et al*, Opposition No. 91167353; 91168148 & 91172117, 2006 WL 3337623 (TTAB Nov. 6, 2006).
- 19 *Curriculum Associates, Inc. v. Scholastic, Inc.*, Opposition No. 91166288, 2006 WL 3043977 (TTAB Oct. 20, 2006).
- 20 *Unfiltered Napa LLC v. Twenty Rows LLC*, Opposition No. 91168224, 2006 WL 2804131 (TTAB Sept. 26, 2006).
- 21 *Big O Tires Inc. v. Gale Banks Engineering*, Opposition No. 91169596, 2006 WL 2513919 (TTAB Aug. 16, 2006).
- 22 *Alpine Mortgage Corp. v. The Mortgage Department*, Opposition No. 91166379, 2006 WL 2401271 (TTAB Aug. 14, 2006).
- 23 *Gibson Guitar v. First Act, Inc.*, Opposition Nos. 91162183 & 91163660, 2006 WL 1864809 (TTAB June 30, 2006).
- 24 *Immunotech Research v. Rath*, Opposition No. 91162850, 2006 WL 1488837 (TTAB May 25, 2006).

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# Patent Owners Beware: Offering a License Could Land You in Court

by Michael I. Coe, Stephen W. Palan and Mark M. Supko

In a recent decision sure to have far-reaching consequences for patent owners, the U.S. Supreme Court in *MedImmune v. Genentech* rejected the traditional “reasonable apprehension of suit” requirement for bringing a declaratory judgment action on a potentially infringed patent.<sup>1</sup> Now, as the federal circuit confirmed in *SanDisk v. STMicroelectronics*, there appears to be virtually no circumstance under which a patent owner can offer a license to a potential infringer without risking a lawsuit.<sup>2</sup>

## Declaratory Judgment Jurisdiction Before *MedImmune*

Grounded in Article III of the U.S. Constitution, the Declaratory Judgment Act creates subject-matter jurisdiction in federal courts only where there is a case of “actual controversy” between the parties.<sup>3</sup> To determine whether the actual controversy requirement was met in a given declaratory-judgment case, the U.S. Court of Appeals for the Federal Circuit (the court to which all patent appeals are taken) traditionally required a showing of some affirmative action by the patentee that justified a reasonable apprehension of an infringement suit on the part of the declaratory-judgment plaintiff, plus some activity by the plaintiff sufficient to show that the potentially infringing conduct had

occurred or was at least imminent.<sup>4</sup> The effect of the reasonable apprehension of suit requirement was that a patentee generally could offer a license without a substantial risk of a declaratory-judgment action simply by taking care not to accuse the prospective licensee of infringement.<sup>5</sup>

## Rejection of the Reasonable Apprehension of Suit Test

Ironically, despite the chilling effect that *MedImmune* may have on patent licensing offers, the case actually arose in the context of a fully executed license agreement. *MedImmune*, a drug manufacturer, had licensed an existing Genentech patent and a pending patent application relating to the production of certain antibodies. After the patent application issued, Genentech informed *MedImmune* that its most popular drug product, Synagis, was covered by the newly issued patent, and that Genentech therefore expected additional royalties under the license agreement.

While *MedImmune* believed the new patent did not cover its product, it was unwilling to breach the license agreement and risk the possibility of treble damages, attorney fees and an injunction, since Synagis accounted for as much as 80 percent of *MedImmune*’s revenue. So *MedImmune* paid the additional royalties

under protest, but then filed an action seeking a declaratory judgment of noninfringement and invalidity as to the new patent.

The district court dismissed *MedImmune*’s declaratory judgment action for lack of subject-matter jurisdiction, relying on well-established Federal Circuit precedent holding that a patent licensee in good standing cannot satisfy the reasonable apprehension of suit requirement.<sup>6</sup> The Federal Circuit affirmed the dismissal, relying on the same precedent.<sup>7</sup> *MedImmune* then appealed its case to the Supreme Court.

In analyzing the dismissal of *MedImmune*’s declaratory judgment action, the Supreme Court first reviewed its own precedent interpreting the Declaratory Judgment Act. While conceding that its cases “do not draw the brightest of lines between those declaratory-judgment actions that satisfy the case-or-controversy requirement and those that do not,” the Court observed that its decisions require a real, substantial, definite and concrete dispute for which specific relief can be granted.<sup>8</sup>

As framed by the Supreme Court, the key question in the case at hand was whether a party can satisfy the “actual controversy” requirement of the Declaratory Judgment



Act even though its own actions (e.g., MedImmune's payment of royalties) eliminated any imminent threat of harm (i.e., a patent infringement suit by Genentech). The Supreme Court answered yes, by analogizing to cases involving coercive government action. It noted that in such cases, a party facing a genuine threat of government enforcement need not "bet the farm" by taking the violative action before seeking a declaration that it was acting within its rights.<sup>9</sup>

Thus, in the context of coercive private action, the Court reasoned that Article III does not require a declaratory-judgment plaintiff to "bet the farm" or "risk treble damages and the loss of 80 percent of its business" before seeking declaratory relief.<sup>10</sup>

Based on this analysis, the Supreme Court held that MedImmune need not break or terminate its license agreement with Genentech in order to seek a declaratory judgment against Genentech's new patent. The Supreme Court criticized the Federal Circuit's reasonable apprehension of suit test as "conflict[ing] with," "contradict[ing]," and "in tension with" Supreme Court precedent on the requirements for declaratory-judgment jurisdiction.<sup>11</sup>

### **The Federal Circuit's Broad Application of *MedImmune***

In *SanDisk v. STMicroelectronics*, the Federal Circuit relied on the Supreme Court's *MedImmune* decision to reverse a district court's dismissal of a declaratory judgment action for failure to present an actual controversy. However, unlike the facts in *MedImmune*, in *SanDisk* the accused infringer had not yet entered into a license agreement with the patentee.

STMicroelectronics (ST) had approached SanDisk seeking to cross-license certain of the companies' patents relating to flash memory-storage products. After exchanging several letters, the parties met and ST made a presentation that purported to show how SanDisk's products infringed various ST patents. At the conclusion of the meeting, ST presented SanDisk with a packet of materials that documented its

infringement analysis, including diagrams detailing how SanDisk's products allegedly satisfied the elements of ST's patent claims. Likely mindful of the reasonable apprehension of suit requirement, ST acknowledged that these materials "would allow SanDisk to DJ" ST, but assured SanDisk that "ST has absolutely no plan whatsoever to sue SanDisk."<sup>12</sup>

... in the context of coercive private action, the Court reasoned that Article III does not require a declaratory-judgment plaintiff to "bet the farm" or "risk treble damages and the loss of 80 percent of its business" before seeking declaratory relief.

After several more months of negotiation, SanDisk brought an action for declaratory judgment of noninfringement and invalidity as to ST's patents. In response, ST moved to dismiss for lack of subject-matter jurisdiction. Applying the traditional reasonable apprehension of suit test (this was pre-*MedImmune*), the district court granted ST's motion on the basis that there was no actual controversy between the parties. The district court noted that ST's infringement analysis did not constitute an express charge of infringement and that, under the totality of the circumstances, there was no actual controversy because ST told SanDisk that it did not intend to sue.<sup>13</sup>

The Federal Circuit reversed, noting the recent rejection of the reasonable-apprehension-of-suit test in the

*MedImmune* decision. While recognizing that *MedImmune* addressed declaratory-judgment jurisdiction in the context of a signed license agreement, the Federal Circuit analyzed how the Supreme Court's rationale should be applied to conduct prior to the existence of a license.

The Federal Circuit noted that, without some affirmative act by the patentee, a potential infringer merely learning of the existence of a patent or perceiving that a patent poses an infringement risk would not support declaratory-judgment jurisdiction. However, Article III jurisdiction would arise if a patentee's actions "put[] the declaratory judgment plaintiff in the position of either pursuing arguably illegal behavior or abandoning that which he claims a right to do."<sup>14</sup> ST's presentation of a detailed infringement analysis to SanDisk was deemed sufficient to satisfy this standard.<sup>15</sup>

In a concurring opinion in *SanDisk*, Judge Wilson Curtis Bryson accurately observed that the Federal Circuit's new test would have a broad reach. He noted that any invitation to license would give rise to an Article III case or controversy "if the prospective licensee elects to assert that its conduct does not fall within the scope of the patent."<sup>16</sup> Bryson opined further that, under this new standard, there is "no practical stopping point short of allowing declaratory judgment actions in virtually any case in which the recipient of an invitation to take a patent license elects to dispute the need for a license and then to sue the patentee."<sup>17</sup>

### **The Practical Effects of *MedImmune* and *SanDisk***

The *MedImmune* and *SanDisk* decisions reflect a new balance of power between patentees and potential infringers. No longer can a patentee offer a license to a potential infringer knowing that, so long as it does not explicitly or implicitly threaten an infringement suit, the patentee need not fear being dragged into protracted litigation. To the contrary, in the post-*MedImmune/SanDisk* world, a potential infringer presented with an offer of a patent license can establish declaratory-

judgment jurisdiction simply by taking the position that its activities fall outside the scope of the patent at issue.

As Judge Bryson implicitly recognized in his *SanDisk* concurrence, control over the timing of litigation is now shared by the prospective licensee. Even if the patentee is careful not to make any accusation of infringement, or even avoids identifying particular products that might be covered by a patent, a prospective licensee need only ask whether the patentee believes its activities fall within the scope of the patent.<sup>18</sup> If the patentee says no, it has made a damaging admission that will limit future litigation; if the patentee says yes or equivocates, it will have satisfied the *SanDisk* test and created declaratory judgment jurisdiction.<sup>19</sup>

The relaxation of the declaratory judgment jurisdictional requirement significantly diminished the leverage that patentees previously enjoyed in licensing negotiations. Under the old regime, a patentee typically would try to avoid creating declaratory-judgment jurisdiction to preserve the patentee's historical prerogative to decide whether, when, and where patent litigation would take place. This was a significant advantage, as the patentee could embark on licensing negotiations without forfeiting the ability to choose a convenient or strategically important forum, while also ensuring that a litigation did not commence until the patentee had completed its preliminary legal work (giving the patentee a further leg up on the potential infringer).<sup>20</sup>

Likewise, a patentee was often able to avoid the burden, risk, and expense of actually litigating its patents, yet still take advantage of the specter of litigation during licensing negotiations. The continued viability of these privileges of the patentee are now very much in doubt. Under the new regime, a patentee has a very limited ability to prevent a prospective licensee from taking the initiative itself by filing a preemptive suit at the time and in the forum of its choosing.

... in the post-*MedImmune/SanDisk* world, a potential infringer presented with an offer of a patent license can establish declaratory-judgment jurisdiction simply by taking the position that its activities fall outside the scope of the patent at issue.

A patentee that desires to control the course of litigation now has few options when making a license offer to a potential infringer. One possibility is to file suit first, and then negotiate with an accused infringer during the course of a pending lawsuit. This approach, however, involves the expense and burden of a lawsuit and also requires a reasonable investigation beforehand of the facts underlying the alleged infringement beforehand (i.e., to satisfy the requirements of Rule 11 of the Federal Rules of Civil Procedure), which may or may not be feasible or economical without information from the potential infringer. A variation on this approach is for the patentee to file but not immediately serve an infringement complaint against the potential infringer before offering a license. This would buy the patentee up to 120 days, under Rule 4(m) of the Federal Rules of Civil Procedure, to negotiate a license agreement before having to complete service of process. If a satisfactory agreement is reached, the complaint can be withdrawn. While such an approach may allow a patentee to effectively choose the forum (under the first-to-file rule), a significant downside is that 120 days may not be enough time to reach a deal if the

licensing issues are complex. The approach could lead to undesired effort and expense to litigation while negotiations continue.

### Conclusion

Under the new legal regime, patentees need to be more cautious and discriminating in how, and who, they approach in license negotiations. Those patentees who are unwilling or unable to litigate their patents in court must be especially careful, since they now have little control over whether a license offer will escalate into a lawsuit. Thus, it may be advisable to avoid "hard-ball" negotiation techniques which could provoke a retaliatory declaratory-judgment suit. In any event, patentees that seek to license their patents would be well-advised to do advance work in order to be able to bring suit quickly, or react quickly to a declaratory-judgment suit, in the event the negotiations break down.

Potential licensees, on the other hand, now enjoy a much more level playing field when approached for a patent license. The prospect of a declaratory judgment action may tend to deter those patentees who are merely "fishing" for royalties, and patentees with a more serious claim of infringement will likely approach license negotiations more gingerly than in the past. Those companies that are regularly targeted by royalty-seeking patentees should develop the capacity to file suit quickly when faced with a patent threat, as a well-chosen declaratory-judgment suit or two may establish a company's reputation as an uninviting target.

Although the full ramifications of the *MedImmune* decision in the patent world have yet to be felt, at least one thing is clear: any patent owner who decides to offer a license to a potential infringer must be prepared to defend its patent rights in court. It also appears likely that fewer licensing offers will be made outside the context of litigation, as a patent owner must sue first or risk losing control over the timing and location of a lawsuit in which its patent rights will be determined. In an age when federal court dockets are already bogged down by ever-increasing

caseloads, an unfortunate consequence of *MedImmune* is thus the creation of a significant disincentive to trying to resolve patent disputes absent litigation. ☞

Endnotes:

- 1 *MedImmune, Inc. v. Genentech, Inc.*, 549 U.S. \_\_\_, 127 S. Ct. 764 (Jan. 9, 2007).
- 2 *SanDisk Corp. v. STMicroelectronics, Inc.*, 480 F.3d 1372 (Fed. Cir. Mar. 26, 2007).
- 3 28 U.S.C. § 2201(a).
- 4 See, e.g., *Teva Pharm. USA, Inc. v. Pfizer, Inc.*, 395 F.3d 1324, 1330 (Fed. Cir. 2005); *BP Chems. Ltd. v. Union Carbide Corp.*, 4 F.3d 975, 978 (Fed. Cir. 1993).
- 5 See, e.g., *Phillips Plastics Corp. v. Kato Hatsujou Kabushiki Kaisha*, 57 F.3d 1051, 1054 (Fed. Cir. 1995); see also *Shell Oil Co. v. Amoco Corp.*, 970 F.2d 885, 888 (Fed. Cir. 1992).
- 6 *MedImmune*, 127 S. Ct. at 768 (citing *Gen-Probe Inc. v. Vysis, Inc.*, 359 F.3d 1376 (Fed. Cir. 2004)).
- 7 *Id.*
- 8 *Id.* at 771 (citing *Aetna Life Ins. Co. v. Haworth*, 300 U.S. 227, 240-241 (1937)).
- 9 *Id.* at 772.
- 10 *Id.* at 775.
- 11 *Id.* at 774 n.11.
- 12 *SanDisk*, 480 F.3d at 1375-1376.
- 13 *Id.* at 1377.
- 14 *Id.* at 1381.
- 15 *Id.* at 1382.
- 16 *Id.* at 1384.
- 17 *Id.* at 1385.
- 18 *Id.* at 1384.
- 19 *Id.* at 1384-85.
- 20 Some federal courts are known to be well-versed in patent matters (e.g., the U.S. District Court for the Northern District of California), particularly patent-friendly (e.g., the U.S. District Court for the Eastern District of Texas), or fast (e.g., the U.S. District Court for the Eastern District of Virginia).



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- 25 *Estefan Enterprises v. Robert Noble and Bongo, S.A.*, Opposition No. 91121980 & Cancellation No. 92042251, 2006 WL 690684 (TTAB Mar. 14, 2006).
- 26 *Cooper Industries, LLC v. Mule Lighting, Inc.*, Cancellation No. 92042545, 2006 WL 148628 (TTAB Jan. 13, 2006).
- 27 Opposition No. 91159086, 2006 WL 332549 (TTAB Feb. 8, 2006).
- 28 Opposition No. 91162330, 2006 WL 983337 (TTAB Apr. 11, 2006).
- 29 Opposition No. 91167477, 2006 WL 1355819 (TTAB May 15, 2006).
- 30 Opposition No. 91161887, 2006 WL 1876344 (TTAB July 3, 2006).
- 31 Opposition No. 91164955, 2007 WL 745238 (TTAB Feb. 28, 2007).
- 32 Opposition No. 91159353, 2006 WL 1931866 (TTAB July 10, 2006).
- 33 Opposition No. 91165290, 2007 WL 745240 (TTAB Feb. 28, 2007).
- 34 Opposition No. 91164083, 2007 WL 760522 (TTAB Mar. 7, 2006).
- 35 Opposition No. 91158304, 2007 WL 196407 (TTAB Jan. 23, 2007).
- 36 Opposition No. 91166639 & Cancellation No. 92045114, 2006 WL 2007542 (TTAB July 13, 2006).
- 37 Cancellation No. 92043811, 2006 WL 2482428 (TTAB Aug. 22, 2006).
- 38 Opposition No. 91160352, 2007 WL 775578 (TTAB Feb. 28, 2007).
- 39 Opposition No. 91168402, 2007 WL 616039 (TTAB Feb. 22, 2007).
- 40 Opposition No. 91159554, 2006 WL 1087855 (TTAB Apr. 13, 2006).
- 41 *See Supra* at note 14.
- 42 Rule 36(b) permits a motion to amend or withdraw admissions. In *Work 'n Gear, LLC v. Work-N-Wear, Inc.*, Opposition No. 91165686, 2006 WL 833977 (TTAB Mar. 26, 2006), the TTAB considered applicant's response to a motion for summary judgment, together with applicant's cross-motion for summary judgment, to be effectively a motion to withdraw.
- 43 *See Supra* at note 40.
- 44 Cancellation No. 92045643, 2006 WL 3192313 (TTAB Oct. 25, 2006).
- 45 Opposition No. 91164969, 2007 WL 745241 (TTAB Feb. 27, 2007).
- 46 Opposition No. 91168421, 2006 WL 3825182 (TTAB December 18, 2006).
- 47 918 F.2d 937, 16 U.S.P.Q.2d 1783 (Fed. Cir. 1990).

# The Race to Protect *Personal Information*

by Melanie C. Holloway and Janet P. Peyton

The concept of a “right to privacy” has been enshrined in state statutes and case law for decades. A constitutional right to privacy is rooted in the penumbra of the Bill of Rights.<sup>1</sup> The concept of privacy in our personal lives—to make personal choices about religion, education, marriage or contraception—is probably considered the most fundamental “right to privacy” today. Early privacy concerns focused on keeping the government out of our bedrooms and passersby from peeping through our window blinds.

Over time, many states, including Virginia, had statutes to protect commercial aspects of privacy. The focus of these laws, however, was to give individuals the right to prevent their names or likenesses from being used to advertise goods or services without the individual’s permission. Privacy laws were not typically designed to protect consumers from crime or to prevent unwanted distribution of contact information for marketing purposes.

Over the past 20 years, however, the value of personal data for both criminal and commercial purposes has grown exponentially, and entrepreneurial businesses (legitimate and otherwise) have taken advantage of the absence of laws in this area to capitalize on the availability of valuable data assets. State legislatures and the federal government continue to play catch-up as they try to protect consumer information without placing an undue burden on commerce. This article will survey existing privacy laws at the federal level and in Virginia and will discuss proposed

and pending legislation that likely will change the face of privacy law.

## Federal Privacy Laws and Regulations

Although no one federal agency is tasked with enforcement of privacy laws, the mission of the Federal Trade Commission (FTC) in preventing the use of deceptive practices in commerce<sup>2</sup> has created a nexus between the agency and privacy issues. In the late 1990s, as companies rushed to have a presence on the World Wide Web, many Web site owners created what they called “privacy policies” to bolster consumer confidence in the security of information shared over the Web. The FTC began reviewing the published “privacy policies” of online Web site owners in an effort to root out deceptive practices. In doing so, the FTC developed five principles to be applied in evaluating privacy practices:

- **Notice**—A company should develop a clearly written, understandable privacy policy that explains its information practices.
- **Consent**—Consumers should be given options regarding the use and disclosure of their personal information.
- **Access**—Consumers should be able to access the personal information collected about them, as well as have the ability to modify this information or request that it be deleted.
- **Security**—Companies should use appropriate measures to protect the security of personal information they collect.

- **Enforcement**—Appropriate enforcement mechanisms must exist to ensure compliance with these principles.

Other major federal legislation enacted in the past 10 years was directed at specific kinds of information deemed to be extremely sensitive. For example, the Children’s Online Privacy Protection Act (COPPA), enacted in 1998, was a response to the surge in use of the Internet by children and concerns about their vulnerability. Similarly, the Financial Modernization Act of 1999 (better known as the Gramm-Leach-Bliley Act) was intended to protect sensitive financial information; it required financial institutions to be transparent with consumers about how financial information will be used, protected and, if necessary, disclosed. The spirit of the act is similar to the five principles used by the FTC to assess online privacy policies. The laws are less focused on what can be done with the information and more focused on disclosure to the owner of the data about the actual practices of the company, so that the consumer can make educated choices about use of data.

The Do-Not-Call Registry and CAN-SPAM (Controlling the Assault of Non-Solicited Pornography and Marketing) Act signaled a return to the concept of physical privacy. These laws give consumers tools to keep telemarketers at bay and to stop unsolicited e-mails that clog our inboxes. As concerns about protecting personal data continue to evolve, however, there is a push to regulate how the information is obtained and when and how it can be used.

### Proposed Federal Privacy Legislation

Most existing federal privacy law is focused on protecting a specific category of personal information, such as medical (Health Insurance Portability and Accountability Act, or HIPAA), financial (Gramm-Leach-Bliley Act), children's (COPPA), or e-mail addresses (CAN-SPAM Act). Recently, however, the trend toward sweeping legislation to protect anything labeled "personal" has become pronounced. The proposed legislation falls into several categories. One is commonly referred to as "breach notification" legisla-

**"Major security breach" is defined as a breach that impacts 10,000 or more individuals or any security breach of federal government databases.**

tion. The objective of these kinds of laws is to require companies that experience a breach of security that results in possible disclosure of consumer data to take steps to notify those consumers so they can protect themselves from identity theft. One of the most significant pending proposals at the federal level is the Notification of Risk to Personal Data Act of 2007 (S. 239). The bill, re-introduced in 2007 by Senator Dianne Feinstein (D-California), would require not only notification of a data security breach to the affected individuals themselves, but also credit agencies for breaches affecting more than 1,000 individuals; the media, for breaches affecting more than 5,000 individuals; and the U.S.

Secret Service, for breaches affecting more than 10,000 individuals.

In the House of Representatives, a proposal by Representative Lamar Smith (R-Texas) would criminalize the intentional withholding of information about major security breaches. His bill, the Cybersecurity Enhancement and Consumer Data Protection Act, would provide for up to five years in prison for knowingly failing to provide notice to either the FBI or the Secret Service regarding a major security breach with the intent to prevent, obstruct or impede a lawful investigation of such breach. "Major security breach" is defined as a breach that impacts 10,000 or more individuals or any security breach of federal government databases.

### Virginia Privacy Law

Like early federal legislation, the first Virginia privacy laws that affected data protected highly sensitive information, such as medical, court, tenant and insurance records.

### Proposed Virginia Legislation

More recent Virginia privacy legislation has focused on fraudulent or otherwise improper methods of obtaining or using all personal identifying information. "Peeping Toms" invade our privacy by catching glimpses of our account, personal identification or credit card numbers, or passwords, as they travel the information superhighway. The absence of legislation to protect consumers from such invasions may simply be a case of leaving the blinds open.

In 2007, a number of bills were proposed in the General Assembly to address the identity-theft dilemma—both prevention (record disposal) and remediation (breach notification and credit freezes).

### Disposal of Records

House Bill 2600 included a proposal to add protection under the Virginia Consumer Protection Act<sup>3</sup> by prohibiting unauthorized access to or use of personal information contained in discarded records. The proposed legislation identi-

fied "reasonable measures" that businesses must take after disposal of records, including burning and shredding documents and destroying or erasing electronic and other nonpaper media.<sup>4</sup>

### Breach Notification

The General Assembly was unable to pass breach notification legislation this year, despite numerous attempts. With some minor variations, each bill required a person or entity whose information system has been breached, resulting in unauthorized disclosure of personal information, to notify law enforcement, the Virginia resident whose personal information was accessed, and the Virginia attorney general's office.

The bill<sup>5</sup> proposed in the House required *immediate* notification to a Virginia resident whose personal information has been accessed, or is reasonably believed to have been accessed, as a result of a breach in the security of an individual or commercial entity's system. Although the proposed law required immediate notification to the affected Virginia resident, it allows for a reasonable delay if law enforcement determines that notification will impede a criminal investigation.

If a company's own breach-notification policies and procedures are consistent with the timing requirements of the proposed law, then the company is deemed in compliance, provided that it complies with its own policy.

The bill provided a private right of action for Virginia residents, including mandatory award of treble damages and attorneys fees for prevailing victims. The attorney general's office also would have been granted a cause of action.

Four additional bills were introduced in the House<sup>6</sup> and one in the Senate that attempted to implement a breach notification requirement to protect residents of the commonwealth. Each bill would require the owner of the breached system to notify Virginia residents of the breach and makes an exception if notification may hamper a criminal investigation. Debate

among lawmakers appears to center around the following issues:

- **Civil rights**—Are victims of identity theft entitled to bring their own causes of action for damages? Treble damages?
- **Periodic credit reports for victims**—Should the company whose system was breached pay for consumers to receive periodic credit reports for a period of time following the breach? For how long?
- **Definition of “personal information”**—How much information do hackers need to steal a consumer’s identity? Last name and date of birth? Social Security number and mother’s maiden name?

The next logical question then becomes: Will lawmakers be able to keep up with the pace of hackers who acquire more and more information about an individual with less and less data; or will legislators continue to play catch-up?

### *Credit Freezes*

If you have ever been a victim of identify theft, you have experienced the peculiar feeling of being assaulted without physical injury. A first step for victims to recover their identities, restore their credit and halt the progression of financial harm is to freeze access to their credit reports. Freezing access to credit reports prevents the identity thief from opening new lines of credit, securing loans and obtaining services in the victim’s name.

Five bills in the House<sup>7</sup> and three in the Senate<sup>8</sup> fell short of enactment as security- or credit-freeze legislation. Each draft attempted to establish guidelines for consumers and credit-reporting agencies, and each varied on timing of the service (from two to five business days to implement a freeze), fees for services (from \$5 to \$20 per freeze or lift), and damages (\$100, as provided under the Virginia Consumer Protection Act, up to \$1,000<sup>9</sup>). Some of the open issues include whether the credit agency is required to notify the consumer whose credit is frozen that an attempt has been made to access his or her credit and whether consumer notices of the right to a credit freeze must be issued.

### **The Future of Privacy Law— What’s Next?**

In the wake of the Virginia Tech shootings of May 2007, Virginia legislators are likely to redirect at least a portion of their efforts away from protecting privacy and toward disclosure of private information—namely mental health records, for the protection of the public at large. In fact, Governor Timothy M. Kaine has already made strides in that direction by issuing an executive order requiring that any adjudication resulting in involuntary treatment for mental illness be reported to the national database related to the purchase of firearms.<sup>10</sup>

Still, it seems likely that we will see significant legislation passed at the federal level this year, in the area of data security-breach notification and credit freezes. As a result, companies that maintain databases of personally identifiable information or enter into contracts relating to management of data should be ready to take necessary steps toward compliance. Contracts for services involving data should commit the vendors (whether data-center providers, information technology consultants, application service providers, or others who will have the potential for involvement in a data security breach) to

comply with changing requirements (not just existing ones), to cooperate in remediation following any breach, and to share the costs of such compliance. ☪

Endnotes:

- 1 See *Griswold v. Connecticut*, 381 U.S. 479 (1965).
- 2 See <http://www.ftc.gov/opp/index.shtml>.
- 3 See Va. Code § 59.1-196 et seq.
- 4 See HB 2600, 2007 Gen. Assem., Reg. Sess. (Va. 2007)
- 5 See HB 1154, 2007 Gen. Assem., Reg. Sess. (Va. 2007)
- 6 See HB 995, 2007 Gen. Assem., Reg. Sess. (Va. 2007); HB 1508, 2007 Gen. Assem. Reg. Sess. (Va. 2007); HB 2140, 2007 Gen. Assem. Reg. Sess. (Va. 2007); HB 3148, 2007 Gen. Assem. Reg. Sess. (Va. 2007)
- 7 See HB 1877, 2007 Gen. Assem. Reg. Sess. (Va. 2007); HB 2681, 2007 Gen. Assem. Reg. Sess. (Va. 2007); HB 2804, 2007 Gen. Assem. Reg. Sess. (Va. 2007); HB 2963, 2007 Gen. Assem. Reg. Sess. (Va. 2007); HB 3056, 2007 Gen. Assem. Reg. Sess. (Va. 2007)
- 8 See SB 805, 2007 Gen. Assem. Reg. Sess. (Va. 2007); SB 946, 2007 Gen. Assem. Reg. Sess. (Va. 2007); SB 1030, 2007 Gen. Assem. Reg. Sess. (Va. 2007)
- 9 See SB 946.
- 10 See “Reporting Critical Safety Data to the Central Criminal Records Exchange,” Executive Order 50 (2007) Gov. Timothy M. Kaine; [http://www.governor.virginia.gov/Initiatives/ExecutiveOrders/2007/EO\\_50.cfm](http://www.governor.virginia.gov/Initiatives/ExecutiveOrders/2007/EO_50.cfm)



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The following article by Ajeet Pai, a student at the University of Virginia School of Law, won the Intellectual Property Section Student Writing Competition. This is the third year of the section's competition.

# Written Description of Software Inventions: An Argument for the Status Quo

by Ajeet Pai

*As regards the written-description requirement,  
"It is not so easy to tell what the law of the Federal Circuit is."<sup>1</sup>*

It has long been established that patent claims in the United States must be adequately supported by a written description. This requirement stems from the first paragraph of 35 U.S.C. § 112, which provides that a patent's specification shall contain:

... a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

A line of cases beginning with *In re Ruschbig*<sup>2</sup> and continuing through *Vas-Cath v. Mahurkar*<sup>3</sup> confirmed that the written-description requirement would be used as a priority policing tool, applied to bar the improper expansion of a patent through later amendments of the claims or specification. For the decades between 1967 and 1997, this was arguably the only way in which the written-description requirement was applied.<sup>4</sup> In the past 10 years, however, the written-description jurisprudence of the Federal Circuit has undergone a sea change.

In 1997, *Regents of the Univ. of California v. Eli Lilly & Co.*<sup>5</sup> marked the beginning of the rigorous application of a freestanding written-description requirement in the biotechnology context.<sup>6</sup> Rather than using the doctrine solely to regulate improper

introduction of new material or unsupported expansion of existing claims, the U.S. Court of Appeals for the Federal Circuit now also applies the doctrine to original, unamended claims as a separate disclosure requirement. After *Eli Lilly*, modern written-description doctrine in the context of biotechnology (but apparently not elsewhere) requires that the disclosure provide "a precise definition, such as by structure, formula, chemical name, or physical properties, not a mere wish or plan for obtaining the claimed chemical invention."<sup>7</sup> This stringent requirement applies to original biotechnology claims—not just to claims which are added or amended after a patent application has already been filed with a given disclosure. It appears that written-description doctrine will be applied stringently to the original claims of each biotechnology patent that is filed.

Courts often state that patent law as written is not technology-specific. While ostensibly true, the same law of written-description in practice is applied differently in different arts. The treatment of biotechnology contrasts with the treatment of software inventions under § 112, paragraph 1. While a functional claim is unlikely to pass muster for a drug or genetic invention, functional claiming appears to be standard practice for computer-based inventions.

Although many of the same policy concerns that underlie the Federal Circuit's biotechnology written-description jurisprudence would seem to be present in the

context of the computer arts as well, the court has not chosen to reconcile its disclosure jurisprudence in the two areas.

## **The written-description requirement applies to software inventions, not just biotechnology.**

While the staggering number of articles on the subject might lead one to believe that the written-description requirement rears its head in the biotechnology arts alone, it seems apparent that the requirement is not so narrow. Though in practice it is applied most rigorously to genetic, chemical and DNA-based inventions,<sup>8</sup> the Federal Circuit has begun to apply written-description analysis in a broad range of other fields of invention.<sup>9</sup> These include, for example, reclining sofas,<sup>10</sup> a computerized airline reservation system,<sup>11</sup> oil refining and a resulting petroleum compound,<sup>12</sup> Web browser software,<sup>13</sup> injection-molded plastics<sup>14</sup> and image processing software.<sup>15</sup> The applicability of the doctrine to all fields of invention was made explicit in a 2004 decision.<sup>16</sup> The trend of the court appears to be towards expanding the reach of the requirement. Thus, written description should not be seen as a technology-specific doctrine applied only to bar overly broad biotechnology claims, but rather as an evolving doctrine that impacts all fields of invention, including software.

## **Software-Based Inventions: a Low Written-Description Bar**

In contrast with the stringent disclosure required for an adequate biotechnology written description, the written-description



requirement is more honored in the breach when it comes to software inventions. While courts have applied the written-description requirement to invalidate software patents on priority grounds,<sup>17</sup> no court appears to have invalidated a software patent for lack of disclosure akin to the missing “precise definition” of *Eli Lilly*. The few cases that do address the written-description issue for software suggest a much lower bar exists for disclosures of software-related inventions than for biotechnological inventions.

### ***In re Sherwood* and the Beginnings of the Low § 112 Bar for Software**

The first major indication that software as an art would require little disclosure came in *In re Sherwood*, a 1980 case before the Court of Customs and Patent Appeals.<sup>18</sup> The patent at issue in *Sherwood* had been rejected for, among other reasons, failure to satisfy § 112’s best-mode requirement. The program listing that the inventor had used to carry out the claimed invention was not included in the patent application.<sup>19</sup> While the best mode was disclosed at a general level—using a computer to achieve the desired result—the examiner and the Board of Patent Appeals agreed that the disclosure was not enabling since program flow-charts and algorithms were not included.<sup>20</sup>

The *Sherwood* court disagreed, holding that a detailed program listing was not required to enable (or disclose the best mode) of a computer-related invention.<sup>21</sup> In a famous and oft-quoted passage, the court wrote:

In general, writing a computer program may be a task requiring the most sublime of the inventive faculty or it may require only the droning use of a clerical skill. The difference between the two extremes lies in the creation of mathematical methodology to bridge the gap between the information one starts with (the “input”) and the information that is desired (the “output”). If these bridge-gapping tools are disclosed, there would seem to be no cogent reason to require disclosure of the menial

tools known to all who practice this art.<sup>22</sup>

By characterizing programming in this way, the court apparently took the view that programmers are quite skilled and a relatively low disclosure is necessary as long as the “trick” or functional goal is communicated.<sup>23</sup> Translation of this functional goal into a working computer program is assumed to require nothing more than a clerical skill, and the level of required disclosure for § 112 is correspondingly low. In contrast with biotechnology, this disclosure requirement (for best mode, and by analogy, for written description) is remarkably lax.

### ***In re Hayes*: An Adequate Written Description of Software Requires Very Little**

The major Federal Circuit opinion considering the application of the written-description requirement to software-based inventions, *In re Hayes*, confirmed the low bar for § 112 compliance that *In re Sherwood* suggested.<sup>24</sup> The patent at issue (the ’302 patent) in *In re Hayes* concerned the control of a modem.

The specification of the ’302 patent disclosed that the “decision making capability” of the modem “preferably reside[d] in a microprocessor,”<sup>25</sup> but details on programming the microprocessor were not included. Ven-Tel (the adverse party) argued that the ’302 disclosure failed to satisfy the requirements of § 112, paragraph 1: The “timing means” referenced in the claims was implemented using software executed by the microprocessor, but Hayes failed to include a program listing or otherwise provide the specifics of the program used.<sup>26</sup>

The court rejected this argument. Recognizing that “the specification is directed to one of skill in the art,”<sup>27</sup> the court found that the details of the microprocessor structure would be known to those so skilled. Because the desired function was disclosed, and the use of a microprocessor was suggested, “[o]ne skilled in the art would know how to program a

microprocessor to perform the necessary steps described in the specification.”<sup>28</sup>

The court disagreed that Hayes was required to disclose the firmware listing itself (i.e., the software code implemented in the microprocessor) in order to satisfy the written description requirement: “[A]ll that was required for one of ordinary skill in the art to understand what the invention was and how to carry it out was the disclosure of a microprocessor having certain capabilities *and the desired functions* it was to perform.”<sup>29</sup>

*In re Hayes* thus stands for the proposition that, in the ordinary case, a listing of the specific program used in a computer-based invention need not be supplied to provide a written description, so long as the functions of that program are disclosed along with a rough description of the hardware required to implement it. The remainder of the work involved—writing software to achieve those functions—is assumed to be well within the capabilities of one skilled in the art. In the court’s view, it does not require so much inventive facility that a functional disclosure is “a mere wish or plan.” As a result, functional claiming of software has become general practice.<sup>30</sup>

### **Arguing by Analogy: Best Mode and Enablement Suggest a Low § 112 Bar**

*Northern Telecom v. Datapoint Corp.*<sup>31</sup> and *Fonar Corp. v. Gen. Elec. Co.*,<sup>32</sup> a pair of Federal Circuit cases focusing on the remaining two requirements of § 112 enablement and best mode, respectively, also suggest a low disclosure burden for software.

The earlier of the two cases, *Northern Telecom*, found the patentee challenging the trial court’s decision that a software-implemented invention was invalid for lack of enablement. The Federal Circuit reversed.<sup>33</sup> The court held that “[t]he amount of disclosure that will enable practice of an invention that utilizes a computer program may vary according to the nature of the invention, the role of the program in carrying it out, and the complexity of the contemplated program-

ming.”<sup>34</sup> Given that the evidence showed that implementing the programming would not be beyond the ordinary skill in the art, the failure to include the specific code or program used did not amount to a lack of an enabling disclosure.<sup>35</sup> As with *In re Sherwood* and *In re Hayes*, this suggests a low bar for § 112 disclosure; absent unusual circumstances, only the intended function of the software need be disclosed to satisfy the patent statute. The court was careful to point out that such unusual cases could certainly exist (such as *White Consolidated Industries Inc. v. Vega Servo-Control Inc.*,<sup>36</sup> where implementing the claimed program took an entirely unreasonable amount of time—almost two programmer-years of work).

*Fonar Corp.*, decided seven years later in 1997, dealt with the best-mode requirement. Like the disclosure in *Northern Telecom*, the disclosure of the invention in *Fonar* did not include a program listing of two software routines necessary to render the invention operable.<sup>37</sup> The Federal Circuit rejected this argument, finding that best mode was satisfied by the disclosure of the functions of the software and the hardware upon which it might run.<sup>38</sup> In justifying the holding that “best mode is satisfied by a disclosure of the functions of the software” (as opposed to structural or code-level disclosure), the court wrote that “normally, writing code for such software is within the skill of the art.... Stating the functions of the best mode software satisfies that description test.”<sup>39</sup> The court then went on to further reduce the § 112 disclosure burden for software: “[F]low charts or source code listings are not a requirement for adequately disclosing the functions of software.”<sup>40</sup> While *In re Sherwood* and *In re Hayes* established that no source code listing was required, *Fonar* went so far as to suggest that a pure textual description of what the software should achieve, without diagrams or logic flowcharts, also could be sufficient. Taken together, the low bars for enablement and best mode suggest that written description will be equally lax when the invention concerns the art of computer programming.

### Divergent § 112 Standards Exist for Software and Biotechnology

*The Written-Description Bar Is Low for Software but High for Biotechnology.*

A major discrepancy has arisen between the Federal Circuit’s treatment of the written description requirement in the context of biotechnology and in software. While biotechnology must be claimed at a detailed level—either a recitation of chemical structure, or a recitation of function with a known correlation between structure and function—software may be claimed with only the thinnest of functional descriptions. This is easily demonstrated simply by substituting the court’s language from one discipline into another field of invention.<sup>41</sup> Take, for instance, *Fonar*’s low bar for best mode in the software context. Replacing every instance of “software” in the *Fonar* opinion with “DNA,” Professors Burk and Lemley write, results in the following:

As a general rule, where [DNA] constitutes part of a best mode of carrying out an invention, description of such [DNA] is satisfied by a disclosure of the functions of the [DNA]. This is because, normally, [identifying such DNA] is within the skill of the art, not requiring undue experimentation, once its functions have been disclosed.<sup>42</sup>

Perversely, such a rule would be “exactly antithetical to the actual rule in biotechnology cases, as stated by *Eli Lilly*.”<sup>43</sup> Disclosure of the functions of DNA is insufficient: structure or a structure-function correlation must be disclosed.

This seeming technological specificity of § 112 application has not been lost on the judges of the Federal Circuit. As Judge Randal R. Rader (an opponent of the use of the written-description doctrine in non-priority contexts) has noted, biotechnology is held to a more stringent standard, even after *Enzo Biochem* and *Univ. of Rochester*. In an earlier decision, he noted the contrast between the rule for software

(as set forth in *Northern Telecom*) and the rule for DNA-based inventions, writing:

This burdensome disclosure standard is tantamount to requiring disclosure, for a new software invention, of the entire source code, symbol by symbol, including all source code permutations that would not alter the function of the software. Ironically, the Federal Circuit has expressly rejected such a requirement for software inventions [in *Northern Telecom*], but apparently enforces the requirement for biotechnology....<sup>44</sup>

The different treatment of the two technologies is particularly puzzling in light of the policy concerns which underlie applying a strict written-description requirement in the biotechnology context (such as avoiding overreaching, and preventing an inventor from broadly claiming things she suspects exists but has not yet actually invented); these concerns would appear to be equally present in the software context.<sup>45</sup>

### *Understanding the Rationale for Disparate Treatment*

Having established that software and biotechnology are treated differently, it remains to be seen whether satisfactory rationales exist for the difference. This article posits that, as a descriptive matter, two explanations exist: Software and biotechnology are treated differently because of the varying level of predictability between the two arts and functional claiming (and hence less written description) of software makes more sense, given the intangible and multistructured nature of software inventions.

### *Software Is Currently a More Predictable Art Than Biotechnology*

*In re Hayes* illustrates the maxim that “an applicant’s disclosure obligation varies according to the art to which the invention pertains.”<sup>46</sup> This varying level of disclosure can be seen as relating directly to the predictability of the art. For less predictable arts, more disclosure is required to place

the public in possession of the invention; for more predictable arts, less disclosure is required, since much is already in the public sphere of knowledge.

Although the state of the science is advancing, biotechnology is currently a less predictable art than many of the traditional fields of invention (and some of the more recent ones, such as software). As one commentator succinctly said:

The electrical and mechanical arts, in contrast to the chemical and biotechnological arts, are considered “predictable” because once a single embodiment of the invention is enabled, other embodiments can be made without difficulty and their performance characteristics can be predicted by known scientific laws.<sup>47</sup>

While biotechnology patent litigation is replete with examples of unpredictable results, implementation of software appears to be more straightforward. This is because software, though a relatively young science, has developed at an astonishing rate. As indicated by Federal Circuit jurisprudence, one of skill in the art of programming is viewed as an expert; software is therefore predictable in the sense that a programmer is able to implement almost any function given sufficient time and direction.<sup>48</sup>

Written description works in the face of this basic level of unpredictability and acts as a check on the scope of claims. If a person skilled in the art is likely to recognize the full range of embodiments of an invention—in other words, understand the breadth of the invention—then less description is required. This is characteristic of more predictable arts (which this article posits includes software); given a functional claim, a skilled programmer would understand that any number of methods of achieving that function may be claimed. This result does not necessarily obtain with biotechnology; given that functionality may not be clear, even after a given DNA sequence is obtained, a person skilled in the art of genetics could not necessarily visualize (or possess) the entire

scope of the invention. In Judge Alan D. Lourie’s words, unlike software, “a functional description of DNA does not indicate which DNA has been invented.”<sup>49</sup> A stringent written description requirement is therefore applied to narrow the scope of what may be claimed.

### *For Software, Function Is More Important Than Structure*

A second major difference explaining the gap in application of the written-description requirement to software and biotechnology is the usefulness of functional claiming. For biotechnology, having a desired function does not necessarily give any indication of which existing DNA structure might map to that function. Indeed, functional claiming in DNA-based inventions is little more than a treasure hunt; some sequence of DNA encodes for the desired result, and allowing a claim for an unknown sequence would offer little public benefit. As a result, functional claiming (in the absence of a known function-structure correlation) is disallowed.

The opposite is true for software. In the usual case, the logical structures of software are the crux of a software-based invention.<sup>50</sup> While DNA inventions result from finding or creating a physical DNA sequence that achieves a given result, software inventions involve designing a desired functionality, and then creating a software structure to achieve that given result. DNA is an artifact of nature, and as a result exists independently of the inventor; software, in contrast, is a specific implementation of an inventor’s logical structures or functional plan. The way in which that implementation occurs (the specific programming routine, the data structure, or the language used) is generally irrelevant to the functionality and usefulness of the invention. Some implementations may be more desirable than others, but the invention can be achieved in multiple ways. Thus, functional claiming makes sense; functionality is what software *is*.

Since software can be adequately disclosed in functional terms, a detailed writ-

ten description of the structure of the resulting code is unnecessary. So long as the logical structure of the software is apparent, the invention has been described. In contrast, biotechnology cannot currently be described in shorthand with equal ease. As a result, the disclosure burden is higher.

### *Moving Forward: A Low § 112 Bar for Software Is Appropriate*

Given the continued vitality of the modern written-description requirement, the Federal Circuit will eventually be confronted with the divergent treatment of software and biotechnological inventions. It can reconcile these two treatments in one of two main ways: by lowering the bar in biotechnology to match that of software, or by raising the software bar to match that of biotechnology. Several factors suggest that the written-description bar for software should not be made more stringent, and that the better path is to wait for the eventual relaxation of the written-description bar for biotechnology as the field matures.

First, the predictability of biotechnology is improving. The evolving § 112 standard for chemical and genetic inventions supports this characterization. *Eli Lilly*, the earliest of the modern written-description biotechnology cases, required the most explicit disclosure. Subsequent cases such as *Enzo Biochem*<sup>51</sup> and *Falkner v. Inglis*<sup>52</sup> backed away from the nucleotide-by-nucleotide disclosure requirement as the art began to mature; once correlations between functions and structures emerged, recitation of known structure was no longer required. Presumably, this trend will continue as the art continues to advance, and biotechnology will once again be on equal footing with the other inventive arts.

Secondly, mechanisms more appropriate than written description exist to police the scope of software patents. The most important of these are the high bars in the software arts for obviousness and anticipation.<sup>53</sup> The high skill level imputed by the courts to programmers is a double-edged sword: While it reduces the disclosure

burden on the patentee, it also makes patents harder to obtain as the field is rich with generously interpreted anticipating references and opportunities to find new inventions obvious over the existing art. Given that obviousness and anticipation are well-established doctrines that are understood by courts and litigants, using those mechanisms instead of the newly minted written-description requirement to police claim scope should reduce cost and confusion.

Finally, the functional claiming typically used for software simply does not fit well into the structural-disclosure role of the modern written description requirement. Artificially emphasizing disclosure of the structure or implementation of software is counterproductive, regardless of how useful similar disclosure may be in the biotechnology context. The important question for software is not what the underlying structure is—the written description—but rather whether it is obvious (and hence not patentable) or not new (and hence not patentable). These questions are better answered by other doctrines.

In sum, maintaining the status quo with regard to written description and software is the preferable path; in time, disclosure for biotechnology will become harmonized without introducing yet another disclosure doctrine to software patent litigation.

The written-description requirement has spawned an astonishing level of confusion and debate in its short existence; the result has been uncertainty and increased costs in biotechnology development and patent practice. Extending this confusion

to software via a stringent written-description mechanism seems unwarranted. The better route, it seems, is to maintain a low written-description bar coupled with a high bar for anticipation and obviousness. ☺

#### Endnotes:

- 1 *Vas-Cath Inc. v. Maburkar*, 935 F.2d 1555, 1560 (Fed. Cir. 1991).
- 2 *In re Ruschig*, 379 F.2d 990 (C.C.P.A. 1967).
- 3 *Vas-Cath*, 935 F.2d at 1555.
- 4 For an exhaustive list of every case applying the written description requirement between *Ruschig* and *Eli Lilly*, see the appendix to *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 984 (Fed. Cir. 2002) (Rader, J., dissenting). Judge Rader lists some thirty cases and cites language in each that suggests that priority was the issue resolved using written description. But, as Judge Lourie points out in his thoughtful response to Judge Rader's dissent, the language of the statute does not limit written description to priority cases, and the cases that have been decided may simply reflect priority issues because of the arguments counsel chose to put forth. *Id.* at 972 (Lourie, J., concurring).
- 5 *Regents of the Univ. of California v. Eli Lilly & Co.*, 119 F.3d 1559 (Fed. Cir. 1997).
- 6 An in-depth analysis of the written description requirement's rise as a stringent disclosure doctrine (particularly in biotechnology) is beyond the scope of this article. The effects of *Eli Lilly* and the rise of the written-description requirement in biotechnology have been more than adequately examined by commentators. Good starting places for further reading would be Margaret Sampson, *The Evolution of the Enablement and Written Description Requirements Under 35 U.S.C. § 112 in the Area of Biotechnology*, 15 Berkeley Tech. L.J. 1233 (2000) and Corrin Nicole Drakulich, *Note: Univ. of Rochester v. G.D. Searle & Co.: In Search of a Written Description Standard*, 21 Berkeley Tech. L.J. 11 (2006).
- 7 *Eli Lilly*, 119 F.3d at 1566 (internal quotation and citation omitted).
- 8 See, e.g., *Eli Lilly*, 119 F.3d at 1559; *Enzo Biochem*, 323 F.3d at 956.
- 9 For additional examples of non-biotechnology applications of written description, see Burk & Lemley, *Is Patent Law Technology-Specific?*, 17 Berkeley Tech. L.J. 1165 n.41 (2002).
- 10 *Gentry Gallery v. Berklinc Corp.*, 134 F.3d 1473 (Fed. Cir. 1998).
- 11 *Lockwood v. Am. Airlines Inc.*, 107 F.3d 1565 (Fed. Cir. 1997).

- 12 *Union Oil v. Atl. Richfield*, 208 F.3d 989, 996 (Fed. Cir. 2000).
- 13 *Reiffin v. Microsoft Corp.*, 214 F.3d 1342 (Fed. Cir. 2000).
- 14 *Koito Mfg. Co. v. Turn-Key-Tech LLC*, 381 F.3d 1142 (Fed. Cir. 2004).
- 15 *LizardTech v. Earth Res. Mapping*, 424 F.3d 1336, 1345 (Fed. Cir. 2005).
- 16 *Univ. of Rochester v. Searle & Co.*, 358 F.3d 916, 925 (Fed. Cir. 2004).
- 17 See, e.g., *Reiffin*, 214 F.3d at 1342; *Symbol Techs. Inc. v. Lemelson Med. Educ. & Research Found. L.P.*, 301 F. Supp. 2d 1147, 1165 (D. Nev. 2004) (recognizing, but not reaching, written-description issue). In addition, at least one case has applied written-description to invalidate an unsupported claim to a software *genus* when only a few species were disclosed. *LizardTech*, 424 F.3d at 1345. This may be another emerging use of the written-description requirement, but does not implicate the stringent disclosure function in the sense of requiring detailed source code or structure.
- 18 *In re Sherwood*, 613 F.2d 809 (C.C.P.A. 1980).
- 19 *Id.* at 811–13.
- 20 *Id.* at 813.
- 21 Though the court discussed best mode, its logic applies equally well to enablement. Both of these foreshadow the court's treatment of written description: since the requirements are "related and spring[] from the same factual predicates," they usually rise and fall together. See *Crown Operations Int'l LTD v. Solutia Inc.*, 289 F.3d 1367, 1378 (Fed. Cir. 2002).
- 22 *Sherwood*, 613 F.2d at 816–17.
- 23 See Burk & Lemley, *supra* n.9 at 1192 ("[T]he court thinks of programmers as people of astonishing skill, capable of implementing any idea in a computer program as a matter of course.")
- 24 *In re Hayes Microcomputer Prod. Patent Litig.*, 982 F.2d 1527 (Fed. Cir. 1992).
- 25 *Id.* at 1533.
- 26 *Id.* at 1533–34.
- 27 *Id.* at 1533.
- 28 *Id.* at 1534.
- 29 *Id.* (emphasis added).
- 30 It is worth noting that the Patent and Trademark Office has adopted the *In re Hayes* fact pattern as an example of how examiners should apply the written-description requirement to software inventions: where a "claimed invention is supported by conventional hardware structure and because there is a functional description of what the software does to operate the computer, there is sufficient description of the claimed invention." United States Patent and Trademark Office, *Synopsis of Application of Written Description Guidelines 26* (Example No. 5), available at <http://www.uspto.gov/web/menu/written.pdf> (last visited Jan. 10, 2007).
- 31 *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931 (Fed. Cir. 1990).
- 32 *Fonar Corp. v. Gen. Elec. Co.*, 107 F.3d 1543 (Fed. Cir. 1997).
- 33 *Northern Telecom* 908 F.2d at 941.
- 34 *Id.*
- 35 *Id.* at 942–43.
- 36 *White Consol. Indus. Inc. v. Vega Servo-Control Inc.*, 713 F.2d 788,791 (Fed. Cir. 1983) (disclosure not enabling when 1.5–2 programmer-years of



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# CLBA Awards Given at Annual Meeting

The Virginia State Bar Conference of Local Bar Associations each year presents two awards to outstanding projects by voluntary bar groups: One—the Award of Merit—honors excellence, and the other—the Certificate of Achievement—recognizes high achievement.

The following associations received their awards during the VSB annual meeting:

## Awards of Merit

**Campbell County Bar Association—Adoption Saturday:** Honored adoptions finalized during 2006 and promoted adoption and foster care to the general community.

**Fairfax Bar Association—Colors of Justice Reception:** More than 150 judges, attorneys and law-school deans joined to award scholarships and encourage diversity.

**Harrisonburg-Rockingham Bar Association—Senior Citizens Law Day:** Presented information to an audience of 150.

**Henrico County Bar Association—(Three awards) Local Bench-Bar Conference:** Judges and clerks of Henrico's three courts discussed topics selected by members of the bar. **Senior Citizens Law Day:** A local state senator moderated a panel that talked about elder issues. **Pro Bono Protective Order Project:** More than 25 lawyers represented persons who sought court protection from family abuse.

**Loudoun Chapter, Virginia Women Attorneys Association—Adoption Day Ceremony and Fair:** Honored adoptive families and challenged opinions that adoptions are too expensive and time-consuming.

**Norfolk & Portsmouth Bar Association—(Two awards) NPBA Foundation Projects/Revitalization.** The association reactivated its foundation to award scholarships, display a copy of the Magna Carta to a local arts center, and planned a Law School for Journalists. **16th Annual Food Frenzy:** Law firms contributed food for needy people. The Food Frenzy was held statewide in 2006 with the

involvement of Virginia Attorney General Robert F. McDonnell.

**Northern Virginia Chapter, Virginia Women Attorneys Association—Navigating Judicial Selection Program:** Legislators described how judicial selection works and how the bar can influence it.

**Prince William County Bar Association—Circuit Court Conciliators Program:** An alternative way to resolve civil discovery disputes without using judges' time. Litigants met with trained conciliators, who help them resolve or narrow disputed issues.

**Richmond Bar Association, Bankruptcy Section—Courtroom Idol: The Judges Decide:** Bankruptcy judges formed a panel to discuss courtroom skills, etiquette and attorney preparedness.

**Virginia Association of Criminal Defense Lawyers—Mentorship for Indigent Defense Counsel:** Experienced attorneys paired with less experienced court-appointed counsel statewide to improve representation. The program also included 10 regional seminars.

**Virginia Women Attorneys Association—(Two awards) Privacy: Does It Exist Anymore? Individual Liberties versus National Security:** An educational panel that featured national experts. **Awards of Distinction Program and Reception:** Celebrated the VWAA's 25th anniversary by recognizing 550 Virginia women attorneys who have practiced 25 or more years.

**Richmond Chapter, Virginia Women Attorneys Association—Go Bring in Some Clients: Conquer Your Fear Factor in Rainmaking:** An opportunity to form networks for legal practice development.

**Roanoke Bar Association—Santa in the Square:** A holiday party for children and parents who lived in five shelters in the Roanoke area. The party took place at the Science Museum of Western Virginia.

**Virginia Beach Bar Association—2006 Membership Initiative, Every Lawyer a**

**Member:** The association identified 208 non-member lawyers who lived or practiced in Virginia Beach and invited them to a social attended by area judges and the VBBA executive board. The drive resulted in a 10 percent increase in membership.

## Certificates of Achievement

**Fairfax Bar Association—Family Law Subject Matter Panel:** Established minimum standards attorneys must meet to be included on a Lawyer Referral and Information Service for family law matters.

**Fredericksburg Area Bar Association—Reuniting Bar Members as a Community:** A series of professional and social functions.

**Henrico County Bar Association—Education Two-Part Program:** Lawyers contributed \$1,500 in school supplies to needy children and conducted mock interviews to prepare high-school students for job hunting.

**Metropolitan Richmond Women's Bar Association—Mock Trial Program:** Held at a local high school to promote knowledge of history and the law, inspire students to consider legal careers, and deter criminal activity.

**Prince William County Bar Association—Senior Citizens Project:** Volunteer attorneys visited the county's two Senior Citizens Centers to talk about issues that affect elders.

**Roanoke Bar Association—Community Outreach:** A Senior Citizen Law Day seminar and distribution of *So You're 18* and the *Senior Citizens Handbook*—two publications of the Virginia State Bar.

**Roanoke Chapter, Virginia Women Attorneys Association—(Two awards) Continuing Legal Education Program:** \$25 classes that allowed members to teach in their areas of practice. **Holiday Reception for the Local Judiciary:** Honored judges and their staffs and provided a social opportunity for lawyers and judges.

# Reminiscences

by George W. Shanks, 2006–07 Conference of Local Bar Associations Chair



The 2006–07 bar year has been incredibly productive for the Conference of Local Bar Associations. This year saw the first formal association of the CLBA with the Solo & Small-Firm Practitioner Forum initiative of Chief Justice Leroy R. Hassell Sr. The fit of the CLBA's Bar Leaders Institute with the forum was perfect. Presentations were held in Fredericksburg and Roanoke.

In Fredericksburg, the program was highlighted by the luncheon address of Jay G. Foonberg, a lawyer, author and speaker on the joys and challenges of solo practice.

In Roanoke, Justice Donald W. Lemons shared scholarship and humor in his address on "Jamestown Legacy: The Rule of Law."

Edward J. Walters, chief executive officer of Fastcase, explained the value of the legal research product, which is available as a membership benefit to all Virginia lawyers. Frank W. Rogers III described the bar's Fee Dispute Resolution Program, which now offers mediation as well as arbitration services. James E. Leffler, George H. Hettrick and John A. Gibney Jr. described the scope, procedure and benefits of Lawyers Helping Lawyers, program now entering its 20th year in service to Virginia lawyers, judges, legal staffs and families.

The centerpiece of these dynamic presentations was the Town Hall Meeting hosted by Chief Justice Hassell. He has heard lawyers' ideas and responded to their complaints and suggestions in Abingdon, Harrisonburg, Williamsburg, Danville, Fredericksburg and Roanoke. The CLBA will host its 2007–08 Solo & Small-Firm Practitioner Forums and

Town Hall Meetings in new venues to be announced in the coming months.

The conference continued to distribute its flagship publication, *So You're 18*, using a method developed under the leadership of then-Chair Manuel A. Capsalis, through driver's licensing ceremonies in the state's juvenile and domestic relations courts. The publication is circulated in English and Spanish. The CLBA continues to distribute the pamphlet *Legally Informed* that was conceived by former VSB President Bernard J. DiMuro. The pamphlet summarizes projects developed by local and specialty bars to improve communities and the legal profession.

It is with great pleasure that I can report that Stephen L. Higgs of Roanoke received the 2007 Local Bar Leader of the Year Award. He was honored at the CLBA meeting at Virginia Beach on June 15.

I am proud and humbled that I have been able to preside over the CLBA this year. It is a brief moment in the history of this vibrant conference, which was originally conceived in 1973. Oren R. Lewis Jr. was its first chair.

The conference chairmanship has been a stepping-stone for many leaders who have gone on to the bench, including Robert G. Doumar, Joanne F. Alper, David T. Stitt, William L. Dudley and Janine M. Saxe.

In 1991, at the urging of VSB President J. Flippo Hicks, a revitalized CLBA created its first executive committee, encompassing more than 55 local bars, with Joseph W. "Rick" Richmond Jr. as chair. Richmond's distinguished career included service as president of the

Virginia Law Foundation. By 1992, 94 participating bar associations were in the CLBA. The CLBA-Virginia Law Foundation connection continued with the service of Russell V. Palmore Jr., Jon D. Huddleston and Manuel A. Capsalis. Palmore is a former VLF chair, and Huddleston and Capsalis currently serve on the foundation's board.

The CLBA has been a resource for leadership in the Virginia State Bar. Several CLBA chairs have been elected or appointed to additional terms on the VSB council. They include Arlene T. Starace, H. Victor Millner Jr., Huddleston, Aubrey J. Rosser Jr., Saxe, Judith L. Rosenblatt, Capsalis and Janet M. Palmer.

Former conference executive committee members have aspired to the highest level of service with the bar. Current VSB President Howard Martin, President-elect Capsalis (2008–09) and Huddleston, a candidate for VSB president-elect, are former CLBA chairs.

Many more members of the executive committee of the CLBA have given selflessly of their time, energy and intellect in furtherance of the good works of the conference, and hundreds more volunteers have given substance to its programs. To each of them, I extend my heartfelt thanks and gratitude.

It has been an exciting year. The job is unfinished. In the capable hands of my successor, John Y. Richardson Jr. of Norfolk, I am confident of the continuing excellence of the work of the Conference of Local Bar Associations.

# Thank You

by Jack W. Burtch Jr., 2006–07 Senior Lawyers Conference President



I am amazed by the elasticity of time. When I was young, a school year felt like an eon. Those last school days before summer vacation seemed to move at glacier pace. Today it's just the opposite. Last week I was sitting with a client talking about a case scheduled for late September. "September's almost here," I said, "and we have a lot to do." Well, June has come and gone and another bar year is over. It has moved so quickly that it seems like a blur. I'm stepping aside as chair of the Virginia State Bar Senior Lawyers Conference. George W. Shanks will lead us for the next year, which he probably will find equally short.

There are many people who deserve my gratitude. Thank you, Patricia A. Sliger. As our liaison from the bar, Pat's good-humored persistence kept the program, and our board, on course. Without Frank O. Brown Jr., one of the founders of this conference, our Web site and newsletter would not be such

effective tools for our mission. Frank's continuing encouragement and enthusiasm for our work keeps us motivated. William Henry Oast III is coordinating a complete rewrite of the *Senior Citizens Handbook*. This formidable task will benefit every Virginia senior citizen who needs to know what resources are available to make the senior years better and more productive. William T. Wilson, a past chair, has nurtured the growth of our Senior Citizens Law Day Program so that every local bar association now can have the resources to put one on for the senior citizens in their areas. Robert L. Calhoun is working with the Alternative Dispute Resolution Committee to develop a senior-friendly dispute-resolution process. Each board member has contributed wisdom and energy to fulfill our purpose.

Last year, our presentation at the VSB Annual Meeting focused on the care for and rights of senior citizens in nursing

homes and continuing-care facilities. This year, our presentation will look at how experienced lawyers can pass on the best traditions of the bar to new generations. We will determine how our conference can work with the Virginia Department for the Aging's project to enhance legal assistance for seniors, and we will discuss how senior lawyers can retool their careers.

Every Virginia lawyer aged 55 and older is a member of our conference. There are more than 12,000 of us. I can't write 12,000 individual thank-you letters, but I do want to thank every conference member and especially every member of our board for their support, encouragement, energy and willingness to stay centered on our mission and service to our profession and Virginia's senior citizens.

Visit the Senior Lawyers Conference Web site at  
[www.vsb.org/slc/index.html](http://www.vsb.org/slc/index.html).

# Community Service Projects Mark Young Lawyers Conference Year

by Maya M. Eckstein, 2006–2007 Young Lawyers Conference President



I started this bar year with an article about the Young Lawyers Conference's extensive history of doing good works for the community. This past year was no exception. With the guidance of the YLC board of governors, program chairs and circuit representatives, the YLC:

- Provided free legal services to true American heroes—first responders—through the **Wills for Heroes** program. The conference provided free wills, advance medical directives and powers of attorney to police officers, sheriffs and firefighters in Charlottesville, Richmond and Lynchburg.
- Finalized and distributed the *Juvenile Rights Handbook*. Developed in partnership with the JustChildren program of the Legal Aid Justice Center, the handbook provides persons younger than 18 and their parents information regarding rights and responsibilities in the schools, with the police and in the courts. With grants recently awarded by the American Bar Association and the Virginia Law Foundation, the YLC will translate the handbook into Spanish and increase its distribution.
- Continued to advance the status of women and minorities in the legal profession through its **Minority Pre-Law Conference**, at which the YLC encourages college students to consider law school and the legal profession. The YLC held pre-law conferences in Northern Virginia and Lexington. Two hundred college students attended the programs.
- Expanded its work related to immigration. The **Immigration Outreach Committee** helped educate Virginia's juvenile and domestic relations judges with a panel discussion on special immigrant juvenile (SIJ) status that is afforded to some undocumented and unaccompanied minors who have been abused, abandoned and neglected. The special status gives the juveniles the opportunity of permanent residency. The committee also hosted a continuing legal education program in Hampton Roads on the immigration consequences of criminal convictions, and held a similar program in Northern Virginia that included a mock immigration trial focusing on SIJ.
- Partnered with the State Board of Elections to distribute "Know Your Rights and Responsibilities" voting-rights pamphlets to thousands of voters across the commonwealth.
- Continued to champion the rights of domestic-violence victims. The YLC

**Domestic Violence Safety Project** distributed 100,000 safety and legal brochures and provided training to lawyers on how to provide pro bono assistance to domestic-violence victims.

- Held the **Oliver Hill/Samuel Tucker Law Institute**, a free, one-week overnight camp for at-risk high-school students to encourage them to enter the legal profession.

These are just a few examples of the many good works done by the members of the Young Lawyers Conference this year. The YLC is proud of its achievements and proud of those who made them happen. We invite you to join us in making next year even more successful.

Visit the Young Lawyers Conference Web site at [www.vayounglawyers.org/](http://www.vayounglawyers.org/).



# Sharing Space

by John J. Brandt



Attorneys beginning their careers and established lawyers who have left a law firm frequently seek to reduce costs and participate in friendly and educational environs by sharing space with other attorneys.

The practice of office sharing is recommended for all younger lawyers. Office expenses for a young attorney are significant. Equally important are the assistance and sage advice of more experienced attorneys. Having said that, attorneys who begin the practice of office sharing—and attorneys willing to share their offices—should be cognizant of ethical and legal implications. First, it is suggested that an attorney place a clause in his or her representation agreement explaining that lawyers in adjoining offices are not practicing law as a partner or associate of the attorney. Second, ensure that your nameplate is separated from other lawyers' nameplates on the office door and in the building directory. Hopefully, this will rebut any suggestion that you and the other attorneys are part of the same firm.

If you are paying part of the cost of a receptionist, make certain that he or she distinguishes your law practice from the other lawyers in the same suite (for example, have her intone "Sam Smith's Law Office" instead of "Law Offices"). Be careful about commingling client files. The better practice is to maintain your client files in a separate space—preferably in your own office.

Whether you can represent a client adverse to a client represented by one

of your office mates can be a vexing question. In comparing Legal Ethics Opinion 1416 with LEO 1578, it is seen that an attorney who leases space to a commonwealth's attorney and shares a law library, a common waiting room and a receptionist who answers phones for both offices may not represent criminal defendants prosecuted by that commonwealth's attorney. The LEO finds such conduct would violate Rule 1.6 of the Virginia Rules of Professional Conduct because "it would be extremely difficult for the attorney to preserve the confidence and secrets of his clients."

Interestingly, a subsequent LEO 1578 reaches a different conclusion in a case in which the leasing commonwealth's attorney maintained a separate street number and entrance. The door stated "City of \_\_\_\_\_," and there was no sharing of common areas, receptionist or law libraries. Importantly, neither the attorneys' clients nor staffs had access to each other's space. The VSB Ethics Committee was concerned not only with the preservation of client confidences, but also with avoiding even the appearance of impropriety as it relates to influencing a "public official." It found the factual predicate was sufficiently distinguishable from that presented in LEO 1416 that problems of "client confidentiality and public perception of impropriety are not present here." Therefore, the arrangement was found to be proper.

Attorneys who share space, but not with a public official, would seem to face only the issue of "confidentiality of information," as addressed under Rule

1.6 of the Virginia Rules of Professional Conduct. If two lawyers share space with a common waiting room, common receptionist and common law library, LEO 943 suggests it would be inappropriate for one lawyer to represent a wife and the other a husband in a divorce action because of the appearance of impropriety, although the representations would technically be permissible if both parties consent in writing. However, the wife and husband would probably be suspicious that their respective attorneys would discuss confidential matters and would have access to each others' files. Thus my admonition is, "Don't do it unless it's truly necessary and you obtain consent."

As far as legal responsibility is concerned, there should be no liability attached to an attorney who is simply sharing office space with a colleague, if the colleague's client sues for legal malpractice. This is particularly true where the attorneys have separated their names on the office door and in the building directory, and if they have separate letterheads. Apparent or ostensible agency does not exist under these circumstances, and the doctrine is not recognized in Virginia anyway. See *Sanchez v. Medicorp Health System*, 270 Va. 299, 308, 618 S.E.2d 331, 335-36 (2005) (hospital not vicariously liable for negligence of emergency room physician-independent contractor).

Office sharing is economical, collegial and educational. Try it—but also be prudent—and you'll like it.

# VSB Teams With ALPS to Teach Lawyers About Trust Management

by Darrel Tillar Mason

The Virginia State Bar's Lawyers Malpractice Insurance Committee (LMIC) has partnered with Attorneys Liability Protection Society (ALPS), the bar's endorsed malpractice insurance carrier, to produce a new risk management continuing legal education program that is available for presentation to voluntary bar organizations.

The program is based on a 68-page publication, *Lawyers and Other People's Money: A Resource for Maintaining Trust Accounts*, now available for free download on the VSB's Web site. Bar members Frank A. Thomas III and Kathleen M. Uston donated their time to update a fourth edition of this publication. ALPS provided a grant to the VSB to cover the costs of professional editing and related expenses.

LMIC member and former VSB President Jean P. Dahnk, Ethics Counsel Leslie A.T. Haley and Uston, an assistant VSB bar counsel, developed an interactive program to teach principles of trust account management described in the book.

Local and statewide bar organizations interested in offering the program to their members should contact any of the following for details: Dahnk, at (540) 373-8600; Haley, at [haley@vsb.org](mailto:haley@vsb.org); or Paulette J. Davidson of the VSB staff, at (804) 775-0521. The program can be tailored to award one to two CLE credit hours. Costs of materials for attendees and travel expenses of presenters will be paid through the LMIC's risk management budget funded by ALPS. Sponsoring bar groups will be responsible for arranging a

place for the presentation and advertising the program.

With input from the LMIC, ALPS has nearly completed the development of a trust accounting software program based on Virginia ethics rules. The LMIC is working to make this software available to VSB members later this year. It is anticipated that a live tutorial for the software could be combined effectively with the trust accounting seminar for the presentations.

These efforts are part of the VSB's commitment to help lawyers maintain trust accounts in accord with the bar's legal ethics rules.

**Darrel Tillar Mason** is chair of the Virginia State Bar's Special Committee on Lawyer Malpractice Insurance. She practices in Glen Allen.

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## Student Essay *continued from page 53*

work required to implement non-standard software component).

37 *Fonar*, 107 F.3d at 1548.

38 *Id.*

39 *Id.* at 1549 (citing *In re Hayes*, 982 F.2d at 1537–38; *In re Sberwood*, 613 F.2d at 816–19).

40 *Id.*

41 *Burk & Lemley*, *supra* n.9 at 1183–84.

42 *Id.* at 1184.

43 *Id.*

44 *Moba v. Diamond Automation*, 325 F.3d 1306, 1325–1326 (Fed. Cir. 2003) (Rader, J., dissenting).

45 A casual search of recent news media will return an enormous number of articles arguing that software patent protection is far too broad or otherwise urgently in need of reform. Many of the articles in the past few years focus on either the debate over recognizing software patents in the European Union, *see, e.g.* “Software Patents: Not Here, Thank You,” *IT Week*, Feb. 6, 2006, at 28, or

on the *BlackBerry NTP v. RIM* decision, *see, e.g.*, Tim Wu, “Weapons of Business Destruction,” *Slate Magazine*, Feb. 6, 2006, <http://www.slate.com/id/2135559/>.

46 *In re Hayes*, 982 F.2d at 1534.

47 Drakulich, *supra* n.6 at 32 n.50 (2006). *See also* Thomas P. Nound, Mark S. Carlson & Paul T. Meikeljohn, *Patent Law Issues Affected by the Predictability of Technology in the Field*, 88 J. Pat. & Trademark Off. Soc’y 603, 637 (2006) (“[A] tension exists between the adequacy of the written description and the scope of the claimed invention in unpredictable fields such as biotechnology.”).

48 *See, e.g., In re Sberwood*, 613 F.2d at 816–17; Lance D. Reich, *One of Skill in the Art of Software Engineering: The Rising Tide*, 84 J. Pat. & Trademark Off. Soc’y 269 (2002); Burk & Lemley, *supra* n.9 at 1192 (“[T]he court thinks of programmers as people of astonishing skill, capable of implementing any idea in a computer program as a matter of course.”). Note, however, that Professors Burk and Lemley think the Federal Circuit misunderstands the level of technological

sophistication of a person having ordinary skill, overestimating it for software and underestimating it for biotechnologists. *See id.*

49 *Enzo Biochem*, 323 F.3d at 974 (Lourie, J., concurring).

50 *See* Robert Plotkin, *Computer Programming and Automation of Invention*, 2003 UCLA J.L. Tech. 7 (2003) (differentiating software from electro-mechanical inventions and arguing for patent reform allowing software to be claimed entirely functionally as logical constructs).

51 *Enzo Biochem*, 285 F.3d at 1013, *vacated, reh’g granted* 323 F.3d 956 (Fed. Cir. 2002), *reh’g en banc denied* 42 Fed. Appx. 439 (Fed. Cir. 2002).

52 *Falkner v. Inglis*, 448 F.3d 1357 (Fed. Cir. 2006), *reh’g en banc denied*, 2006 U.S. App. LEXIS 22630 (Fed. Cir. Aug. 24, 2006).

53 *See* Amir A. Naini, *Convergent Technologies and Divergent Patent Validity Doctrines: Obviousness and Disclosure Analysis in Software and Biotechnology*, 86 J. Pat. & Trademark Off. Soc’y 541, 555–56 (2004).

# 69th Annual Meeting

June 14–17, 2007



1: The Annual Meeting marks the beginning of a year of service for VSB officers, including (left–right) President-elect Manuel A. Capsalis of Arlington, President Howard W. Martin Jr. of Norfolk and Immediate Past President Karen A. Gould of Richmond.

2: Former Virginia Gov. Gerald L. Baliles (left) joins in the celebration with Heather and Howard Martin after Howard Martin is sworn in as 2007–08 VSB president.

3: In keeping with annual tradition, Executive Director Thomas A. Edmonds presents outgoing President Karen A. Gould with a caricature by Richmond attorney Michael L. Goodman. The caricature captured Gould's love of her dogs and technology while highlighting the successes of her presidency, including the development of the Online Member Directory.

4: A favorite stop for Annual Meeting attendees is the Lawyers Expo, where they can visit with exhibitors who offer the latest in law-office technology, legal publications, and related products and services. Here, Leesburg attorney Jon D. Huddleston (right) talks with the Virginia Law Foundation's Tom Payne and Sharon Tatum.

June 14–17, 2007 • Virginia Beach, Virginia



1: Each year, the VSB recognizes those who have been members in good standing for 50 years. The following honorees attended a luncheon sponsored by the Senior Lawyers Conference: (front row, left–right) Judge Michael R. Caprio Jr.; James M. Young; Richard Cocke; Thomas W. Moss Jr.; John F. Batte Jr.; Robert S. Cohen; Charles G. Aschmann Jr.; James A. Baber III; Jim Zegeer; (back row, left–right) John G. Mizell Jr., 2006–07 SLC secretary; Judge Jere M.H. Willis Jr.; Carter B.S. Furr; George W. Shanks, 2006–07 SLC chair-elect; James C. Roberts, VSB past president; Judge William T. Prince, VSB past president; Robert M. Hughes III; Judge Robert T.S. Colby; Thomas C. Broyles; Jack W. Burtch Jr., 2006–07 SLC chair; A. Hugo Blankingship Jr.; Martin Kelly, son of deceased honoree John F. Kelly, Frederick J. Dean III, William T. Wilson, 2006–07 SLC immediate past chair, Frank O. Brown Jr., SLC past chair, and William M. Phillips.

2: Humorist and Tennessee trial lawyer William “Wild Bill” Haltom (right) entertains attendees of his presentation at the Showcase Continuing Legal Education Program. Following Haltom’s remarks, a panel, including Spotsylvania Circuit Court Judge Ann Hunter Simpson and Richmond attorney David P. Baugh, fielded audience questions relating to professionalism and the lawyer’s search for happiness.

3: Judge Jeri K. Somers of the U.S. Civilian Board of Contract Appeals and retired Judge William H. Ledbetter Jr. of Fredericksburg chat during the noontime Beach Break Reception.



1: For his work to ensure that youths have access to services and support necessary to live successful lives, Charlottesville attorney Andrew K. Block Jr. (center) receives the Virginia Legal Aid Award. The award, presented by the Access to Legal Services Committee, was given to Block during a luncheon at which Virginia's first lady, Anne B. Holton (right), was the guest speaker and Judge Angela E. Roberts of Richmond's Juvenile and Domestic Relations Court was a guest.

2: Steven L. Higgs (center) is named Local Bar Leader of the Year for his guidance of the Roanoke Bar Association, including the expansion of its legal-education opportunities and the formation of a committee to oversee its public service projects. Higgs received his award from George W. Shanks, 2006–07 chair of the Conference of Local Bar Associations, and 2006–07 VSB President Karen A. Gould at a breakfast sponsored by the Conference of Local Bar Associations.



3: Sarah Louppe Petcher receives the R. Edwin Burnette Jr. Young Lawyer of the Year award from Maya M. Eckstein, 2006–07 Young Lawyers Conference president. Petcher was recognized for her outstanding work as a chair of the YLC's Immigrant Outreach Committee.

4: The annual Run in the Sun was hosted by the Young Lawyers Conference.

