

# THE MISSISSIPPI Lawyer

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Intellectual Property  
INTELLECTUAL PROPERTY  
Patents  
Trademarks  
Copyright  
Trade Secret  
Licensing  
Brands  
Novelty  
Innovation  
Authorship  
Invention  
Idea  
Trade  
Secret  
Counseling  
Creation  
Guidance  
Novelty

## INSIDE

- De-Mystifying Damages for Copyright Infringement
- Patent and Trademark Licensing at Universities
- Annual Meeting Highlights
- Making Heads and Tails Out of the Patent Reform Act
- Dissecting Intellectual Property Issues in Motion Pictures
- A Good Lawyer and the Golden Rule

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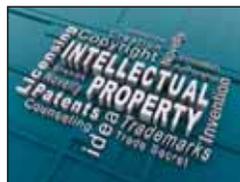
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VOL. LVIII                      SUMMER                      2012                      NO. 4

*Features*



<b>De-Mystifying Damages for Copyright Infringement</b> <i>By Jason R. Bush</i>	<b>8</b>
--	----------

<b>Patent and Trademark Licensing at Universities</b> <i>By A. Meaghin Burk and Jacquelyn Knapp</i>	<b>15</b>
--	-----------

<b>Making Heads and Tails out of the Patent Reform Act</b> <i>By Hemant Gupta</i>	<b>21</b>
--	-----------

<b>Dissecting Intellectual Property Issues in Motion Pictures</b> <i>By Anita Modak-Truran</i>	<b>25</b>
---	-----------

	<b>A Good Lawyer and the Golden Rule</b> <i>By David Maron</i>	<b>38</b>
---	---	-----------

	<b>Annual Meeting Highlights</b>	<b>43-54</b>
---	----------------------------------	--------------

*Departments*

<b>President's Farewell Message</b>	<b>6</b>
-------------------------------------	----------

<b>2012-2013 Section Orientation Session</b>	<b>30</b>
--	-----------

<b>President-Elect Nominees</b>	<b>32</b>
---------------------------------	-----------

<b>Final Disciplinary Actions</b>	<b>35</b>
-----------------------------------	-----------

<b>In Memoriam</b>	<b>57</b>
--------------------	-----------

<b>Lawyers Helping Lawyers</b>	<b>59</b>
--------------------------------	-----------

<b>CLE Calendar of Events</b>	<b>60</b>
-------------------------------	-----------

<b>Professional Announcements</b>	<b>63</b>
-----------------------------------	-----------

<b>Classified Advertising</b>	<b>66</b>
-------------------------------	-----------

*A special thanks to the Intellectual Property Section of The Mississippi Bar, chaired by Anita Modak-Truran, for providing the feature articles of this issue.*

# A Farewell Message

*“Don’t cry because it’s over. Smile because it happened.”*

THEODORE SUESS GEISEL

Early in my tenure as president, Lem Adams and I had dinner at Walker’s Restaurant following one of numerous meetings related to Bar business. As the conversation evolved, I’ll never forget the question Lem posed. “As a young lawyer, in your wildest dreams, did you ever imagine becoming president of The Mississippi Bar?” It was, of course, a question for both of us and brought home the magnitude of the journey and the opportunity. You see, as one who worked his way through night law school at Mississippi College School of Law, with student loans to repay and who was having a hard time rubbing two nickles together in those days, I never envisioned the office of president of our wonderful organization. My focus was on the tasks of the day and to put food on the table for my family.

As Lem and I reflected on our respective paths, we realized that we shared a common denominator. That denominator was a desire to give back, however possible, for the privilege of being a member of our noble profession. Our desire was motivated by the hope of making a positive difference in some small way. To give back, you must become involved. As the dinner concluded, we were almost over-whelmed as we recognized the profound gift and responsibility we shared.

Throughout this past year, with each objective or challenge and with each meeting or event, my appreciation of the meaning of “servant leadership” was continuously reaffirmed. At every turn, I was reminded of how many outstanding human beings we have as members of our profession. At every turn, I found others giving of themselves without expectation of return. Whether it was members of our Board of Commissioners, standing committees, MVLP and Access to Justice programs, LJAP, sections or Young Lawyers Division programs, or in our communities in ways unrelated to the practice of law, the spirit of volunteerism to improve the state of our profession and our quality of life permeated all undertakings. ...It was, at once, energizing and uplifting to be surrounded by those whose goals and sacrifices were outcome driven.

During 2011-2012, we achieved some important goals. Under the leadership, vision and action of Chief Justice William L. Waller, Jr., with the assistance of the Bar and its membership, our legislature enacted long over-due judicial and prosecutorial pay realignments. These changes will help to ensure the stability and enhance the administration of justice for years into the future. We continued to emphasize the need for and benefits of supporting and maintaining strong MVLP and LJAP programs. We initiated a legal heritage/history committee chaired by Judge David Ishee to focus on the preservation of the treasures of our past. Also, the Mississippi Bar website was updated to be more user friendly. ...By the way, I recommend that you browse our site. It is full of useful and valuable aids to your practice.

Years pass with a flash these days. I will be forever humbled for the privilege and honor you entrusted to me. I will be forever grateful for those without whose support my service would not have been possible. Larry Houchins, Melanie Henry, the staff of The Mississippi Bar, our membership, past-presidents, current leadership under Lemuel G. Adams, III, the shareholders of Dukes, Dukes, Keating and Faneca, P.A. and, most importantly, my rock and bride of 30 years, Donna, all cleared the path, showed me the way and kept me on track.

And now, since I have exhausted my “time” and I am partial to the Irish, I leave you with this Irish blessing.

“May you always have work for your hands to do.

May your pockets hold always a coin or two.

May the sun shine bright on your window pane.

May the rainbow be certain to follow each rain.

May the hand of a friend always be near you.

And, may God fill your heart with gladness to cheer you.”



Hugh Keating  
President of The Mississippi Bar  
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# copyright

*In any case, whether big or small, it is important to evaluate what the case is worth. A good plaintiffs' attorney will do his or her best to assess what a judge or jury might award the client and advise the client accordingly. Along the same lines, defense attorneys will do the same, often trying to estimate worst case scenarios, most likely scenarios and make settlement recommendations. This article will address damages available under the Copyright Act for copyright infringement and what is required to recover these damages.*

*By: Jason R. Bush<sup>1</sup>*

# De-Mystifying Damages for Copyright Infringement

“Copyright protection subsists ... in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”<sup>2</sup> In a copyright infringement action, a copyright owner may elect to recover the copyright owner’s actual damages and any additional profits of the infringer, or alternatively, statutory damages. *See* 17 U.S.C. § 504.<sup>3</sup> Thus, there are technically three types of damages available: the plaintiff’s actual damages, the defendant’s profits attributable to the infringement or statutory damages.<sup>4</sup>

## Statutory Damages

Section 504(c) deals with statutory damages. The statute provides for a range of damages between \$750 and \$30,000 for infringement with respect to any one work. 17 U.S.C. § 504(c)(1) states:

(1) Except as provided by clause (2) of this subsection, the copyright owner may elect, at any time before final judgment is rendered, to recover, instead of actual damages and profits, an award of statutory damages for all infringements involved in the action, with respect to any one work, for which any one infringer is liable individually, or

for which any two or more infringers are liable jointly and severally, in a sum of not less than \$750 or more than \$30,000 as the court considers just. For the purposes of this subsection, all the parts of a compilation or derivative work constitute one work.

The Court has discretion to increase this award where the infringement was willful to a sum of not more than \$150,000, or reduce the award where the infringer was not aware and had no reason to believe that his or her acts constituted copyright infringement to a sum not less than \$200. 17 U.S.C. § 504(c)(2). The language of section 504(c)(1) indicates that a single infringer of a single work is only liable for one award within the permissible range, no matter how many times he or she has infringed that work. If a single infringer has infringed the copyrighted work several times, and there is good evidence of defendant’s profits, the copyright owner may elect to pursue those damages instead of statutory damages, particularly if the profits exceed \$150,000. Conversely, where one defendant has infringed multiple copyrighted works, but it will be difficult to prove actual damages or the defendants’ profits, statutory damages are attractive. *See, e.g. Playboy Enterprises, Inc. v. Webbworld, Inc.*, 968 F. Supp. 1171 (N.D. Tex. 1997)

(court set appropriate level of statutory damages at \$5,000 per work, but because there were 62 works at issue multiplied the award and entered judgment for \$310,000).

Another case that received a good bit of media attention was the case *Capitol Records, Inc. v. Thomas-Rasset*,<sup>5</sup> where the plaintiffs were recording companies that owned or controlled exclusive rights to copyrights in sound recordings, including 24 songs that defendant Thomas-Rasset downloaded. The case went to trial three separate times, resulting in large jury verdicts each time in favor of the plaintiffs and against the individual defendant, based on statutory damages. The jury verdicts for the three trials were 1) \$220,000, 2) \$1.9 Million and 3) \$1.5 Million.<sup>6</sup> Just something to think about next time you are online.

In determining an award of statutory damages, courts look to factors including “(1) expenses saved and profits reaped by the infringing party, (2) revenues lost by the copyright holder, and (3) whether the infringing party acted willfully.”<sup>7</sup> While the focus of this article is on damages and not liability, it is worth noting that neither lack of knowledge nor intent is a defense to a claim of copyright infringement.<sup>8</sup> Thus, intent is only relevant for damages; not on the issue of liability. A defendant’s

*Continued on next page*

## De-Mystifying Damages for Copyright Infringement

infringement is willful under section 504 if he “knows his actions constitute an infringement; the actions need not have been malicious.”<sup>9</sup> Some courts have stated that actual knowledge is not required to show willfulness; constructive knowledge of infringement satisfies the willfulness standard. Evidence that the defendant received notice before the infringement occurred is “persuasive evidence of willfulness.”<sup>10</sup>

Some courts have held that an award of statutory damages is particularly appropriate in the default judgment context “because a defaulting party has information needed to prove actual damages.”<sup>11</sup> The purposes of the “increased level of damages are to punish the defendant’s willful behavior and deter future infringement.”<sup>12</sup> Additionally, in cases involving willful infringement after a defendant has refused a licensing offer, courts often will award statutory damages in amounts that are between two and three times the license fee refused by the defendant.<sup>13</sup>

Although the Copyright Act allows for

statutory damages and attorneys’ fees, this option may not be available for copyright owners who do not timely register the work with the United States Copyright Office. In order to seek statutory damages, the plaintiff must have registered the work before the date of the infringing conduct, or in the case of published works, within 3 months of publication.<sup>14</sup> What constitutes “publication” may be an issue in some cases, but the Act generally defines publication as “the distribution of copies ... of a work to the public by sale or other transfer of ownership. . . .”<sup>15</sup> So, the message here is to register the works early, particularly before a work is published, so that the owner will have the option of statutory damages and recovering attorneys’ fees.

### Actual Damages Suffered by the Copyright Owner and Profits of the Infringer Attributable to Infringement

If the copyright owner does not elect

to recover statutory damages, or they are not available, then the following damages are available. 17 U.S.C. § 504(b) provides:

#### (b) Actual Damages and Profits.—

The copyright owner is entitled to recover the actual damages suffered by him or her as a result of the infringement, and any profits of the infringer that are attributable to the infringement and are not taken into account in computing the actual damages. In establishing the infringer’s profits, the copyright owner is required to present proof only of the infringer’s gross revenue, and the infringer is required to prove his or her deductible expenses and the elements of profit attributable to factors other than the copyrighted work.

“Section 504(b) was designed to serve the dual purposes of compensating a copyright owner for his actual losses and preventing infringers from unfairly benefiting from their wrongful acts.”<sup>16</sup> Based on the language of the statute, the copyright owner is entitled to recover both 1) the actual damages suffered by him or her as a result of the infringement, and 2) any profits of the infringer that are attributable to the infringement, so long as these “are not taken into account” in computing the actual damages. In other words, these two types of damages are not intended to give the plaintiff a double recovery. In many cases, the plaintiff will focus primarily, or exclusively on one of the two categories.

As previously noted, often the copyright owner will seek to recover actual damages and profits, either because 1) registration was not done timely, or 2) because the copyright owner believes this could lead to a higher recovery than statutory damages.

#### Actual Damages Suffered by the Copyright Owner

Usually, a copyright owner’s actual damages consist of either his own lost profits on sales, or lost royalties.<sup>17</sup> Courts have construed the “actual damages” measure to include license fees that the copyright owner would have obtained for

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the infringer's use of the copyrighted material.<sup>18</sup> "[W]here the infringer could have bargained with the copyright owner to purchase the right to use the work, actual damages are 'what a willing buyer would have been reasonably required to pay to a willing seller for plaintiffs' work.'"<sup>19</sup> The license fee is determined by reference to fair market value, which is an objective analysis. Thus, proof of prior licenses or industry practice is key to recovery.<sup>20</sup> Generally, a plaintiff must show that a license would have been available for the type of use at issue, and that the fee sought is reasonable.

### Profits of the Infringer that are Attributable to the Infringement

As one treatise appropriately states: "[w]hen losses to the copyright owner are difficult to quantify, it is better to look to defendant's profits."<sup>21</sup> In some cases, determining the profits of the infringer that are attributable to the infringement is straightforward and easy, particularly, when good evidence of the infringer's sales and profits are obtained through discovery. But in many cases, it can be complicated, and often require some form of expert testimony. There can also be some confusion between the requirement in the first sentence of 504(b) that limits the damages to profits "attributable to the infringement" and the second sentence, which provides that in "establishing the infringer's profits, the copyright owner is required to present proof only of the infringer's gross revenue, and the infringer is required to prove his or her deductible expenses and the elements of profit attributable to factors other than the copyrighted work." 17 U.S.C. § 504(b).

Once liability has been established, "§ 504( b) creates an initial presumption that the infringer's 'profits ... attributable to the infringement' are equal to its gross revenue."<sup>22</sup> But, in meeting its initial burden, "a copyright holder must show more than the infringer's total gross revenue from all of its profit streams .... Rather, 'gross revenue' refers only to revenue reasonably related to the infringement."<sup>23</sup> Thus, "gross revenue" does not mean the infringer's gross revenue "from all its commercial endeavors."<sup>24</sup> "The copyright holder must establish the existence of a causal link between the infringement and

the infringer's gross revenue before the burden shifting provisions of § 504(b) will apply."<sup>25</sup> Again, proving the profits *attributable to the infringement* can be difficult.

The defendant may introduce evidence of deductible expenses, such as costs of producing the infringing copies or phonorecords, and associated overhead costs to reduce the overall award. Once the copyright owner has met the burden of proving the infringer's gross revenues, (meaning revenue reasonably related to the infringement), then, the burden shifts to the infringer "to prove his or her deductible expenses and the elements of proof attributable to factors other than the copyrighted work." § 504(b).<sup>26</sup> "Expenses that may be deducted from defendants' profits consist of all production and overhead costs, including income taxes, incurred in producing the gross revenue. If defendants willfully, consciously and deliberately infringed plaintiff's copyright, the jury need not deduct defendants' expenses for income taxes and overhead costs (i.e., indirect costs) from defendants' profits during any time period in which their infringement was willful, conscious and deliberate."<sup>27</sup>

Generally, the defendant/infringer also has the burden of demonstrating a sufficient nexus between each expense claimed and the revenue acquired from the sales of the infringing goods.<sup>28</sup> In calculating the deductions from his or her gross revenue, the infringer is required to use a "reasonably acceptable formula."<sup>29</sup>

In cases where the defendant did not directly profit from the use of the copyrighted materials, it can be even more difficult for a plaintiff to prove damages. These cases are often referred to as indirect profit cases.<sup>30</sup> This scenario often comes up when the copyrighted work, such as a photograph, is used for advertising purposes. In other words, the photograph is not directly sold, but is used to promote another event. In an indirect profits case, the profits 'attributable' to the infringement are generally more difficult to quantify. For instance, in *Straus v. DVC Worldwide, Inc.*, the defendants move for summary judgment on the ground that plaintiff, Straus, could not meet his burden of establishing a causal link between the defendants' gross rev-

enues and the alleged acts of infringement. The court stated:

This is not a case in which the defendants are alleged to have sold the copyrighted work for a profit. Rather, this is an indirect profits case, in which defendants are alleged to have used a copyrighted photograph to sell other products. ...

"[I]n an indirect profits case, the profits 'attributable' to the infringement are more difficult to quantify. But that difficulty does not change the burden of proof established by the statute. The burden of establishing that profits are attributable to the infringed work often gets confused with the burden of apportioning profits between various factors contributing to the profits." ... "The plaintiff has the burden to demonstrate a nexus between the infringement and the indirect profits before apportionment can occur." ... Once

*Continued on next page*

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that nexus is established, if “an infringer’s profits are attributable to factors in addition to use of plaintiff’s work, an apportionment of profits is proper. ...”

In *Straus*, the court granted partial summary judgment for the defendant on this issue, stating “[e]ven assuming that the general GSK advertising campaign was causally linked to the revenues GSK received for selling the advertised products, ... there is no basis in the record to link the limited unauthorized and infringing uses of the copyrighted photograph that Straus alleges to all or any part of those revenues.”<sup>31</sup>

### Attorneys’ Fees

The Court may, in its discretion, award costs and attorneys’ fees to the prevailing party.<sup>32</sup> In the Fifth Circuit, while the recovery of attorneys’ fees is “not automatic”, it is generally stated that attorneys’ fees awards are the rule rather than

the exception and should be awarded routinely.<sup>33</sup> This applies equally to both prevailing plaintiffs and defendants, but as noted previously, a copyright owner must timely register in order to recover for attorneys’ fees. In determining whether a fee award is appropriate, a court should consider the factors: “frivolousness, motivation, objective unreasonableness (both in the factual and in the legal components of the case) and the need in particular circumstances to advance considerations of compensation and deterrence.”<sup>34</sup>

### Punitive Damages

Sometimes, a plaintiff in a copyright infringement case will seek to recover punitive damages. The Copyright Act does not provide for punitive damages as a remedy for copyright infringement.<sup>35</sup> Regardless of whether a plaintiff is seeking actual or statutory damages, “punitive damages are not available under the Copyright Act of 1976.”<sup>36</sup> ■

1 Jason Bush is an attorney in the Jackson, Mississippi office of Baker, Donelson, Bearman, Caldwell & Berkowitz, P.C. His practice focuses primarily on commercial litigation and intellectual property litigation. Jason currently serves on the executive committee of the Mississippi Bar’s Intellectual Property, Entertainment and Sports Section.

2 17 U.S.C. § 102(a).

3 17 U.S.C. § 504 is titled “Remedies for infringement: Damages and profits” and states:

(a) In General.—Except as otherwise provided by this title, an infringer of copyright is liable for either—

(1) the copyright owner’s actual damages and any additional profits of the infringer, as provided by subsection (b); or

(2) statutory damages, as provided by subsection (c).

4 This article will rely heavily on Fifth Circuit precedent, although the Fifth circuit has referred to the Second Circuit as “the *de facto* Copyright Court of the United States.” See *Easter Seal Soc. for Crippled Children and Adults of Louisiana, Inc. v. Playboy Enter.*, 815 F.2d 323, 325 (5th Cir.1987).

5 799 F. Supp. 2d 999 (D. Minn. 2011).

6 *Id.*

7 *Barnstormers, Inc. v. Wing Walkers, LLC*, 2011 WL 1671641 (W.D. Tex. 2011).

8 *Microsoft Corp. v. Software Wholesale Club, Inc.* 129 F. Supp. 2d 995, 1002 (S.D. Tex. 2000)(citing *Fitzgerald Publishing Co. v. Baylor Publishing Co., Inc.*, 807 F.2d 1110, 1113 (2d Cir. 1986)).

9 *Broadcast Music, Inc. v. Xanthas, Inc.*, 855 F.2d 233, 236 (5th Cir.1988). See also *Microsoft Corp.* 129 F. Supp. at 1002.

10 *Microsoft Corp.* 129 F. Supp. at 1002 (citing *Swallow Turn Music v. Wilson*, 831 F. Supp. 575, 579 (E.D. Tex. 1993)).

11 *Barnstormers, Inc.*, 2011 WL 1671641, \*5.

12 *Id.* (citing *Lance v. Freddie Records, Inc.*, 986 F.2d 1419, at \*2 (5th Cir.1993)).

13 *Barnstormers, Inc.*, 2011 WL 1671641, \*5; *Cynthia Hunt Prods., Ltd. v. Evolution of Fitness Houston Inc.*, 2007 WL 2363148, at \*6 (S.D.Tex. Aug.16, 2007) (quoting *EMI April Music Inc. v. Know Group, L.L.C.*, 2006 WL 3203276, at \*4 (N.D.Tex. Nov.6, 2006).

14 17 U.S.C. § 412 states:

In any action under this title, other than an action brought for a violation of the rights of the author under section 106A(a), an action for infringement of the copyright of a work that has been preregistered under section 408(f) before the commencement of the infringement and that has an effective date of registration not later than the earlier of 3 months after the first publication of the work or 1 month after the copyright owner has learned of the infringement, or an action

instituted under section 411(c), no award of statutory damages or of attorney's fees, as provided by sections 504 and 505, shall be made for—

(1) any infringement of copyright in an unpublished work commenced before the effective date of its registration; or

(2) any infringement of copyright commenced after first publication of the work and before the effective date of its registration, unless such registration is made within three months after the first publication of the work.

See also *Beau Rivage Resorts, Inc. v. Bel Aire Productions, Inc.*, 2008 WL 3978097, \*2-3 (S.D. Miss. 2008)(court granted Beau Rivage's motion to dismiss in part, holding that the claims for statutory damages and attorney's fees pursuant to Tarragon's copyright claims should be dismissed based on the effective date of the registration); *Qualey v. Caring Center of Slidell*, 942 F. Supp. 1074, 1075 (E.D. La. 1996).

15 17 U.S.C. § 101.

16 *Looney Ricks Kiss Architects, Inc. v. Bryan*, 2010 WL 5068938, \*2 (W.D. La. 2010) (quoting *Abeshouse v. Ultragraphics, Inc.*, 754 F.2d 467, 472 (2d Cir.1985)).

17 See Roger Schechter & John Thomas, Principles of Copyright Law, p. 410.

18 *Interplan Architects, Inc. v. C.L. Thomas, Inc.*, 2010 WL 4366990, \*11 (S.D. Tex. 2010)(citing *On Davis v. The Gap, Inc.*, 246 F.3d 152, 165 (2d Cir. 2001)).

19 *Id.* (quoting *Jarvis v. K2 Inc.*, 486 F.3d 526, 533 (9th Cir.2007) (quoting *Frank Music Corp. v. Metro-Goldwyn-Mayer, Inc.*, 772 F.2d 505, 512 (9th Cir.1985)).

20 As the court in *Interplan Architects, Inc.* stated: Fair market value may be established where: "(1) a plaintiff demonstrates that he previously received compensation for use of the infringed work; or (2) the plaintiff produces evidence of benchmark licenses, that is, what licensors have paid for use of similar work." 2010 WL 4366990, \*11.

21 Nimmer on Copyright § 14.02.

22 *MGE UPS Systems, Inc. v. GE Consumer and Indust. Inc.*, 622 F.3d 621, 366-67 (5th Cir. 2010)(quoting *Bonner v. Dawson*, 404 F.3d 290, 294 (4th Cir. 2005)).

23 *Id.*

24 *Leland Medical Centers, Inc. v. Weiss*, 2007 WL 2900599 (E.D. Tex. Sep 28, 2007) ("Gross revenue," as defined in 17 U.S.C. § 504(b), "does not mean the infringer's gross revenue from all of its commercial endeavors." Instead, "a copyright owner is only entitled to present the gross revenue for the infringer's line of business or project related to the infringement.")

25 *Leland Medical Centers, Inc.*, 2007 WL 2900599, \*1. (citing *Bonner v. Dawson*, 404 F.3d 290, 294 (4th Cir. 2005)).

26 *Pham v. Jones*, 2006 WL 1342826 (S.D. Tex., May 13, 2006). After the copyright owner meets

her burden; the burden then shifts to the infringer to prove any direct expenses and/or overhead that may be subtracted from the gross revenues offered by the copyright owner. *Hamil America, Inc., v. GFI*, 193 F.3d 92, 104 (2d Cir. 1999).

27 *Plain Jane, Inc. v. Lechters, Inc.*, 1995 WL 608483, (E.D.La. Oct 17, 1995)(citing Nimmer on Copyright, supra, § 14.03[B], at 14-37 & n.13, 14-39 & n. 21; *In Design v. K-Mart Apparel Corp.*, 13 F.3d 559, 565-66 (2d Cir. 1994).

28 *New Line Cinema Corp., v. Russ Berrie & Co., Inc.*, 161 F.Supp.2d 293 (S.D.N.Y. 2001).

29 *Frank Music Corp., v. Metro-Goldwyn-Mayer, Inc.*, 772 F.2d 505, 516 (9th Cir. 1985).

30 See, e.g. *Straus v. DVC Worldwide, Inc.*, 484 F. Supp. 2d 620 (S.D. Tex. 2007) (granting defendants' summary judgment on the issue of indirect profits).

31 *Straus*, 484 F. Supp. 2d at 647. The case *Leland Medical Centers, Inc. v. Weiss*, 2007 WL 2900599 (E.D. Tex. Sep 28, 2007) is also instructive regarding the difficulty of proving profits attributable to infringement in an indirect profits case. Other courts have also required that the plaintiff demonstrate a nexus between infringement and indirect profits. See, e.g., *Bus. Trends Analysts, Inc. v. Freedonia Group, Inc.*, 887 F.2d 399, 404 (2d Cir.1989) (holding that a plaintiff can recover indirect profits in the form of "value received from an infringing product used to enhance commercial reputation" if it first demonstrates that "the amount of an award is based on a factual basis rather than undue speculation") (internal quotation marks omitted); see also *Estate of Vane v. The Fair, Inc.*, 849 F.2d 186, 189-90 (5th Cir.1988) (affirming district court's refusal to award indirect profits damages allegedly resulting from infringing use of photographic slides in advertising).

32 17 U.S.C. § 505.

33 *Randolph v. Dimension Films*, 634 F. Supp. 2d 779, 792-93 (S.D. Tex. 2009); *Virgin Records Am., Inc. v. Thompson*, 512 F.3d 724, 726 (5th Cir. 2008) (quoting *Positive Black Talk v. Cash Money Records, Inc.*, 394 F.3d 357, 380 (5th Cir. 2004)).

34 *Virgin Records*, 512 F.3d at 726 (quoting *Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 524, 534, n. 19, 114 S.Ct. 1023, 127 L.Ed.2d 455 (1994)).

35 See *Bucklew v. Hawkins, Ash, Baptie & Co.*, 329 F.3d 923, 931 (7th Cir. 2003).

36 *Granger v. Gill Abstract Corp.*, — F.Supp.2d —, 2008 WL 2791264, \*5 (S.D.N.Y. 2008.) (quoting *Oboler v. Goldin*, 714 F.2d 211, 213 (2d Cir.1983)). See also *Nuckles v. Wal-Mart Stores, Inc.*, 2007 WL 1546092, \*2 (E.D. Ark. May 25, 2007) ("Punitive damages are not available for copyright infringement. The Copyright Act sets out what can be recovered for copyright infringement, and it contains no provision for punitive damages.").

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# Patent and Trademark Licensing at Universities

**M**any colleges and university administrators have begun examining their own institutional stores of intellectual property as potential sources of revenue. Patents and trademarks are particularly rich sources of potential licensing revenue. This article will explore the various court cases, statutes, and educational trends that have placed universities in the forefront of technology and trademark licensing.

## Patents and Universities

The United States Constitution provides for the protection of scientists' discoveries and inventions. Specifically, the Constitution gives the United States Congress the power "to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries" (U. S. Constitution, Art. 1, § 8, cl. 8) through patents and copyrights. A patent is a government-created set of rights that gives the creator of a new and useful invention exclusive control over the manufacture, sale, and development of that invention. In exchange, the owner must fully disclose the nature of the invention through a formal application process (*Bauer & Cie. v. O'Donnell*, 1913).

Owners of patents can sell the rights to produce or distribute the patented inventions, a process known as licensing. In America, a series of historical and legal events has created a situation where universities are frequently patent owners. Federal funding for university research has increased dramatically since the 1940s. In 1940, the federal government supplied 31 million dollars to support scientific research at universities; thirty years later

the government spent more than three billion dollars (Rosenzweig, 1982). The ebb and flow of federal monies can be closely connected to several key historical events. World War II ushered in an era of tremendous financing of university research in the pursuit of military and weaponry advancements (Geiger, 1993). As the Cold War escalated in the 1950s, public debate intensified over the funding of scientific research at universities. Academic support was generally high for federal funding of scientific research because the federal agencies were careful to use a peer review process in their decision-making processes (Savage, 1999).

The launching of Sputnik by the Soviets in 1957 quieted much of the public debate and led to another surge in research funding in universities. Academic research in the 1980s was marked by increases in funding and tremendous changes in the legal landscape. Fourteen pieces of legislation that increased protection for intellectual property rights were passed in the 1980s (Katz & Ordovery, 1990). *Diamond v. Chakrabarty* (1980), which expanded patent protection to include organisms developed through biotechnology, was handed down. Of all these legal expan-

*Continued on next page*

*By A. Meaghin Burk<sup>1</sup> and Jacqueline Knapp<sup>2</sup>*

## Patent and Trademark Licensing at Universities

sions, the University and Small Business Patent Protections Act of 1980 (more commonly referred to as the Bayh-Dole Act) proved to be the most expansive in its stated goal, though perhaps not in its actual effect.

During the 1960s and 70s, universities were faced with a dizzying array of regulations and potentially conflicting authority governing the ownership of federally-funded projects and inventions (Mowery et al., 2001). Mowery et al. note that before 1980, the government automatically gained ownership of any patent that was developed with federal funds, and universities had to develop Institutional Patent Agreements with each federal funding agency if they wanted to reserve any intellectual patent rights. The Bayh-Dole Act was designed to facilitate the patenting process by providing a blanket law that applied to all university research funded from any federal source and therefore expedite the patenting and licensure of new inventions.

The Bayh-Dole Act of 1980 allows universities to retain patent ownership of inventions created with federal funds in

exchange for complying with several statutory requirements. First, a university must notify the federal government of any invention developed with federal funds and pursue patent protection in accordance with American patent laws. If a patent is received, the university must grant the government a nonexclusive and irrevocable license in any patent sought. Finally, a university must use the proceeds from the licensing of the patents to remunerate the inventor and further support educational and research endeavors.

Before the passage of the Bayh-Dole Act, the United States government owned more than 30,000 patents but only licensed approximately five percent of them (Leaf, 2005). Very few university patents were granted during this time period. As McManis (2006) noted, only 150 academic patents were granted to just 25 universities in 1980. After the passage of the Bayh-Dole Act, academic patenting skyrocketed; fifteen-hundred academic patents were granted in 1992 (McManis). Patents represent an attractive source of income for universities. State spending on higher education fell by more than one

percent in 2010, and that number would have been three and a half times larger without federal stimulus money (Kelderman, 2011). Understandably, therefore, universities have attempted to generate revenue from the creation and licensing of university-owned patents. To facilitate these processes, many universities have established technology transfer offices that assist in the management of intellectual property. Technology transfer offices essentially function as patent agencies, performing patent searches and filings and seeking appropriate licensees for newly patented inventions (Evans, 2008). After the Bayh-Dole Act was passed, the number of technology transfer offices at universities increased to over 200 (Phan & Siegel, 2006). As of 2004, universities were receiving approximately 1.4 billion dollars from the licensing of intellectual property (Phan & Siegel). Over 5000 new products that were invented or improved through university research were introduced to the market between 1998 and 2006 (Keutsch, 2008). More than 500 startup companies emerged from university research (Keutsch).

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This newfound interest in patent creation and technology transfer has fostered the development of a new feature in higher education: the university research park. As Link and Scott (2003) described, no generally accepted definition of a research park exists. The Association of University Related Research Parks (AURRP) has described three major components that make up a research park: (1) a real estate development; (2) a well-developed method of technology transfer; (3) a thriving partnership between government entities, academic entities, and members of the private sector. MacDonald (1987) defined research parks as packages that encompass a real-estate-based initiative near an academic center that provides high quality research units.

Echols and Meredith (1998) argued that just as Bayh-Dole ushered in an era of patent creation by universities, it also ushered in an era of research park formation. Lockett et al. (2005) posited that the rise in American research parks is actually the result of the overlap of several pieces of legislation: the Bayh-Dole Act, the 1982 Small Business Innovation Development Act, the 1984 National Cooperative Research Act, and the 1992 Small Business Technology Transfer Act. Whatever the cause, university research parks have markedly increased in number over the last three decades. There are now over 170 active university research parks of varying size and mission in North America, and they continue to increase their vital role in the development and licensing of university-owned patents.

### Trademark and Universities

Besides patents, universities have another potential source of licensing revenue: trademarks. A trademark is "any word, name, symbol, or device, or any combination thereof used...to identify and distinguish...goods...and to indicate the source of the goods" 15 U.S.C. § 1127. In *Qualitex v. Jacobsen Products Co.* (1995), the Supreme Court held that trademarks can incorporate a variety of components, including fragrances, sounds, and colors. In *Board of Supervisors of Louisiana State University v. Smack Apparel, Inc.* (2008), the Fifth Circuit expanded on that ruling and held

that school colors, when used with other indicia of a university, could acquire secondary meaning and be protected under trademark law.

Colleges and universities with highly recognizable logos can license manufacturers to include those logos on various items, including (among many other things) shirts, cup holders, dog collars, and dinnerware. According to the International Licensing Industry Merchandisers' Association, in 2005, trademark licensing for the entire American collegiate sector generated over \$200 million in revenue.

Many universities, including several in the state of Mississippi, outsource their trademark licensing to independent licensing companies. The University of Mississippi is represented by the Collegiate Licensing Company (CLC). CLC is headquartered in Atlanta and chaired by Bill Battle, an Alabama native and former head football coach for the University of Tennessee. Mississippi State University and the University of Southern Mississippi outsource their trademark licensing to the Licensing

Resource Group (LRG), a full-service trademark management company that handles over 180 colleges and universities.

In addition to licensing a university's logo to be used on merchandise, independent licensing companies such as LRG and CLC can also be used to stop vendors from selling unlicensed or counterfeited material. These policing measures are very important to trademark owners because failure to actively protect a mark can result in the loss of the mark. It is therefore important for universities or their hired licensing agents to protect their own marks by preventing unauthorized use of trademarks. At the most recent SEC football championship game, the CLC seized 1,012 unlicensed items worth an estimated \$15,000. Throughout the 2010-2011 academic year CLC confiscated 60,000 unlicensed items valued at greater than \$1 million.

Trademark licensing revenue is highly correlated with the strength and success of a university's athletic program. For instance, Auburn University doubled the

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## Patent and Trademark Licensing at Universities

royalties it received from licensed merchandise sales after winning the 2011 BCS National Championship (Levinson, 2011). CLC's highest grossing client, the University of Texas at Austin, is a sports powerhouse that collected over \$10 million in royalties between July 2010 and June 2011 (Levinson). ■

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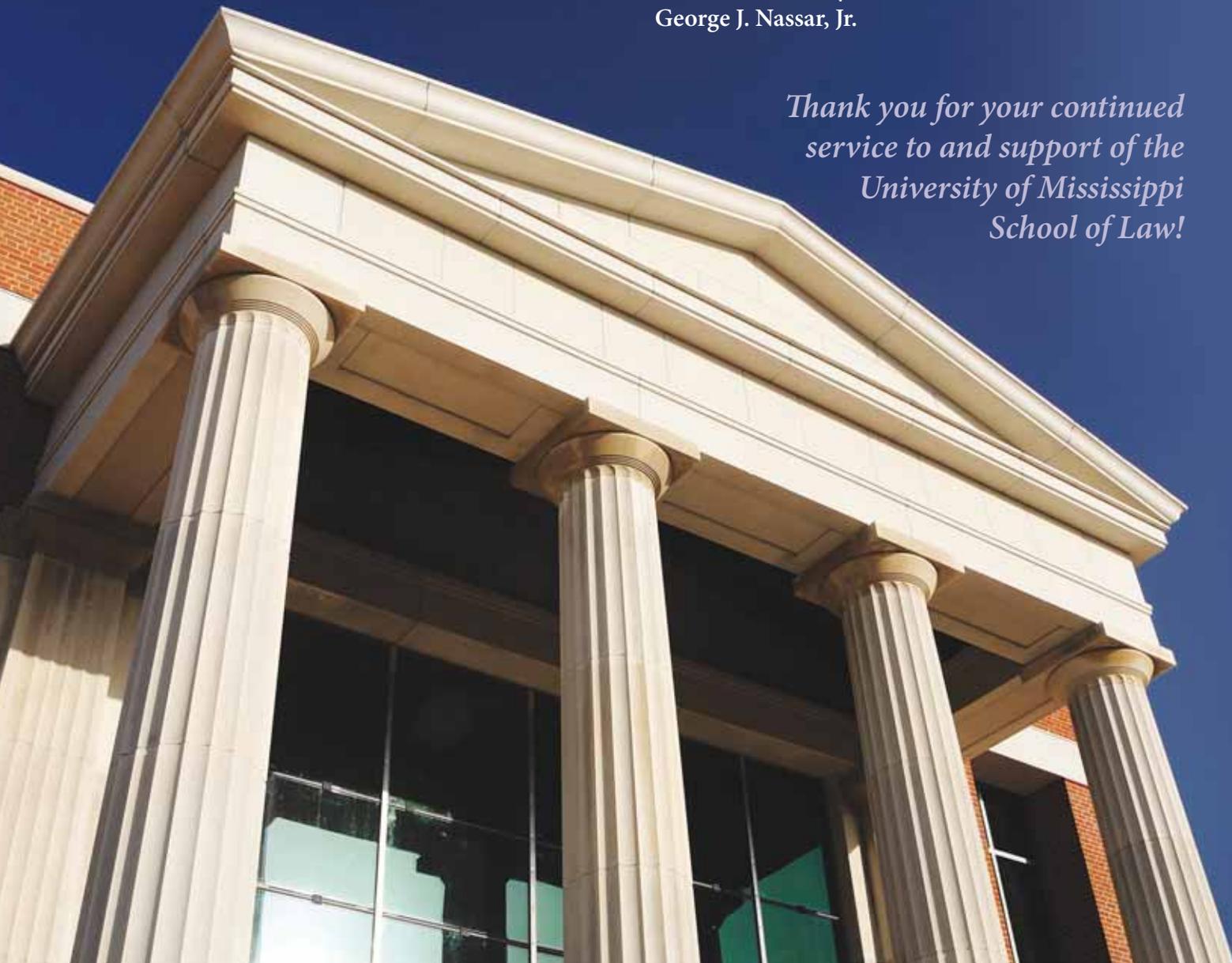
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# Making Heads and Tails out of the Patent Reform Act

**W**ith the patent office backlogged by hundreds of thousands of applications, and corporations being hit with soaring patent damages awards, patent holders and corporations sought help in the form of Congressional action. These stakeholders argued that the United States patent system was not keeping pace with the rapid growth of technology and that it was due for an overhaul. The last significant changes to the patent system were made sixty years ago, and, since that time, there have been major advances in all technology areas, including molecular biology, computing and cellular communications. Many companies felt that the patent system needed to be updated to address the current patent climate.

Others argued that the U.S. patent system needed to be changed in order to better compete globally. The U.S. system was the last remaining patent system that granted patents to the earliest inventor, regardless of whether he filed first. They contended that foreign corporations were more likely to file patents and operate in the United States if the patent systems were similar.

After years of failed attempts at legislation in Congress, significant patent reform was finally passed in the form of the Leahy-Smith America Invents Act (AIA) on September 16, 2011. The changes were intended to harmonize the United States' patent system with those of much of the rest of the world while updating the legislation to ensure that higher quality patents issued. The sweeping changes have been hailed by some as much needed, and strongly disliked by others. Critics assert that the changes benefit large corporations at the expense of small inventors and fledgling companies and that the switch to a first-to-file system makes the U.S. less competitive.

The various provisions of the AIA are phased in so that they become effective at

different times. This article addresses the most important changes of which companies should be aware.

## **First-Inventor-To-File**

The most significant change as a result of the passage of the AIA is that patents filed on or after March 16, 2014, will be granted to the inventor who first *files* a patent application. This is in stark contrast to the first-to-invent system that had been in place for over 200 years.

Under the first-to-invent system, the inventor who first conceived of the invention and then reduced it to practice is entitled to the patent. The system was intended to reward the inventor who first conceived of the idea, regardless of the time that it took him to develop it. Under this system, an applicant could challenge the priority of multiple applications or patents filed by others. A special proceeding before the USPTO's Board of Patent Appeals and Interferences, called an interference proceeding, was used to ascertain which applicant was entitled to the patent. Under the AIA's new system, referred to as a first-inventor-to-file system, an inventor

*Continued on next page*

*By Hermant Gupta<sup>1</sup>  
Butler, Snow, O'Mara, Stevens & Cannada, PLLC*

## Making Heads and Tails out of the Patent Reform Act

who first files the patent application is entitled to the patent. In essence, it creates a race to the patent office, and the patent can be granted to an applicant who may have conceived of the invention at a later date than an earlier inventor but who files an application first. Because interference proceedings are no longer necessary, the AIA changed the name of the Board of Patent Appeals and Interferences to the Patent Trials and Appeals Board.

The AIA also adds a one-year “grace period” that will exist prior to patent filing during which an inventor’s disclosure will not be a bar to patentability. However, a *third-party disclosure* prior to filing will become a novelty bar to patentability, unless it occurs *after* the inventor’s disclosure during the grace period. Thus, in some cases, it will make sense for a company to disclose its inventions that it does not intend to patent. This will prevent a competitor from seeking a patent on that same technology.

Proponents of the change from a first-to-invent to a first-inventor-to-file system argue that it puts the United States on equal footing with the patent statutes of the rest of the world. The U.S. was the only remaining country using the first-to-invent system. However, detractors believe that the change only benefits larger corporations that have significant legal budgets to prepare and file applications quickly. Smaller companies and independent inventors are theoretically at a disadvantage because they may not have the capital immediately available to prepare and file applications.

### Derivation Proceedings.

The change from a first-to-invent to a first-inventor-to-file system theoretically creates the opportunity for “patent theft” in which someone steals the idea from the inventor and files the application first. The AIA addresses this possibility by establishing a system for inventors to assert that the patentee had used information that was learned from the inventor. These proceedings are referred to as derivation proceedings and become available in March of 2013. According to the AIA, a petition for a derivation proceeding must be filed within a year from the publication date of the claims that are purportedly “the same or substantially the same as the earlier application’s claim to the invention.”<sup>2</sup>

### Expanded Opportunities to Challenge Issued Patents

The AIA attempts to improve the quality of patents and decrease time spent in litigation by expanding the options for challenging the validity of an issued patent. Currently, patent validity can be challenged through reexamination (*ex parte* and *inter partes*) and through infringement litigation. Third-parties will have a right within nine months of patent issue to request further USPTO review of the patent claims by raising a novel legal issue or submitting evidence of unpatentability of at least one claim. However, this post-grant review process will only be available for patents that issue under the first-inventor-to-file system.

A new *inter partes* review (“IPR”) procedure is also established by the AIA

that allows any enforceable patent to be challenged. The IPR will replace the current *inter-partes* re-examination system, and will be handled by a panel of administrative judges on the Patent Trial and Appeals Board. The AIA mandates that the IPR be initiated no earlier than nine months after the issuance of the patent. It also requires that the IPR be completed within eighteen months, which is significantly less than the time it typically takes to challenge the validity of a patent through the federal courts.

### Patent Marking Requirements

Prior to enactment of the AIA, there had been a sharp increase in false patent marking lawsuits by plaintiffs that had claimed that goods or services had been marked with expired, invalid, or inapplicable patents. The increase in filings could be attributed to the *qui tam* provision of 35 U.S.C. § 292(b) under which “any person may sue for the penalty, in which event one-half shall go to the person suing and the other to the use of the United States.” In one case, a plaintiff had alleged that each of the plastic cups sold by the Solo Cup Company was a falsely marked product because it was stamped with an expired patent number<sup>iii</sup>. The plaintiff had asked for \$500 damages for each of the 21 billion cups that had been sold, thus potentially entitling him to damages in the trillions of dollars. Due to the explosion of such filings, patent holders sought to have the false marking provisions revised in the AIA.

The AIA relaxed the patent marking

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requirement, and changed the *qui tam* provision. Under the new act, patent markings no longer have to be on the product but can now be implemented by reference to a freely-accessible web page. This makes it significantly easier for a company to update the list of patents. Instead of changing the manufacturing or labeling process, they can make changes to the website. Additionally, under the AIA, only the government or a person who can prove competitive injury can pursue a false marking claim. Furthermore, marking a product with an expired patent number is no longer actionable. These changes became effective immediately upon enacting the AIA and have already greatly reduced the number of false marking lawsuits.

**Prior User Defense**

Prior to the enactment of the AIA, only accused infringers of business method patents could assert that their use of a patented technology for more than a year prior to the filing date was not infringement. However, in a first-inventor-to-file system, it would be possible for a company that chose not to file an application on an invention to be sued for infringement once a patent issued to a later filing applicant. The AIA addressed this possibility by expanding the scope of the prior user defense so that it covers all technology areas and applies to almost all patents not owned by universities. The prior user defense benefits those who commercially used the patented technology at least one year prior to the effective patent filing date. Thus, a company that was already using the technology more than a year before the filing date can continue to use it without being liable for patent infringement.

**Preparing for the Changes.**

The USPTO is still in the process of adopting rules to implement and clarify some of the changes. However, it is clear that businesses and individual inventors need to prepare now for the changes.

First, inventors should consider filing provisional applications on inventions as soon as possible to prevent a possible competitor from filing first. For each invention, companies will be forced to quickly evaluate whether they wish to pursue a patent for themselves on a tech-

nology, or whether they should publicly disclose the technology to prevent a competitor from getting a patent on it.

Second, companies should monitor their competitor's patent applications and consider challenging the patent within the statutory time frame. If the company recognizes that prior art was not considered in allowing claims, the company should challenge the patent during the time frame set for post grant review.

Finally, companies should consider moving their listing of patents on their

products to a website where it can easily be updated. ■

<sup>1</sup> Hemant Gupta is an attorney in the Memphis office of Butler, Snow, O'Mara, Stevens & Cannada, PLLC, where his practice focuses on intellectual property and corporate matters. Hemant currently serves on the board of Tennessee Bar Associations' Intellectual Property Section as well as on Memphis Bar Association's Intellectual Property and Entertainment section.

2 35 USC § 135(a)

3 *Pequignot v. Solo Cup Co.*(Fed. Cir. 2010)

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C12-0201-010 (2/12)

A white envelope is shown, tied with a vibrant red ribbon in a bow. The words "Screen Play" are printed in a bold, black, serif font across the center of the envelope. To the right, the text "© Copyright" is visible, also in a black serif font. The envelope is set against a dark background, and a portion of a light-colored wooden surface is visible at the bottom left corner.

**Screen Play**

© Copyright

*By: Anita Modak-Truran'*

# Dissecting Intellectual Property Issues in Motion Pictures

## OVERVIEW

**T**hrough competitive investment incentives, unique locations, a state of the art sound stage, and a strong pool of talent in front of and behind the camera, Mississippi's motion picture industry stands ready for an avalanche of opportunities.<sup>2</sup>

This past year, *The Help*, which was filmed in Greenwood, Clarksdale and Jackson, made headlines when it received four Academy Award nominations (including Best Picture) and Octavia Spencer won Best Supporting Actress. *The Help* represents an unparalleled convergence of Mississippi forces, where the director and producer, both from Mississippi, brought the movie based on a Mississippi author's best selling novel, back home to film. This movie, which was one of many, but the most noteworthy in the last two years, created a rippling effect of economic benefits for local people and businesses.<sup>3</sup>

The critical and commercial success of *The Help* and recent amendments to the Mississippi Motion Picture Incentive Program ("MPIP")<sup>4</sup> have reinvigorated the Mississippi film industry. An increasing number of production companies with viable projects (*i.e.*, financing) seek to film here (the most recent inquiry I received was from two French filmmakers), and they need Mississippi-based attorneys to help them.

You may wonder why a production company would hire a Mississippi attorney when there are a glut of entertainment attorneys in New York and Los Angeles. The answer is motion picture investment rebates. Legal services by Mississippi attorneys for an approved project may be subject to a twenty-five percent (25%) cash rebate under MPIP.<sup>5</sup> Also, there is a strong and growing group of Mississippi attorneys who have the expertise to do the work. Indeed, many of the intellectual

property issues found in a motion picture are similar to those in commercial litigation.

Like other commercial products, films are made to be sold, and a movie that cannot be sold is a dead project. This article provides a snapshot of the intellectual property ("IP") law applicable to motion pictures, analyzes the anatomy of the film and dissects different components of film from an IP perspective.

## A SNAP SHOT OF IP LAW APPLICABLE TO MOTION PICTURES

The United States Copyright Act, 17 U.S.C. §§ 101 *et. seq.* (2011), sets forth the legal framework for issues concerning the copying and distribution of motion pictures. Copyright is a form of protection provided by federal law to an author of "original works of authorship," including literary, dramatic, musical, artistic, and certain other intellectual works.<sup>6</sup> Section 106 of the Copyright Act states that the owner of the copyright, subject to Section 107 through 121, has the exclusive rights to do and to authorize any of the following:

- (1) to reproduce the copyrighted work in copies . . . ;
- (2) to prepare derivative works based upon the copyrighted work;
- (3) to distribute copies . . . of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;
- (4) in the case of . . . motion pictures and other audiovisual works, to

*Continued on next page*

## Dissecting Intellectual Property Issues in Motion Pictures

perform the copyrighted work publicly;

- (5) in the case of . . . pictorial . . . works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly[.]<sup>7</sup>

Anyone who violates any of the exclusive rights of the copyright owner as provided in the Act “is an infringer of the copyright or right of the author, as the case may be.”<sup>8</sup> In a copyright infringement action, the registered holder of the copyright is entitled to actual damages and any additional profits of the infringer, statutory damages and possibly attorney’s fees and costs.<sup>9</sup>

In addition to copyright issues, federal and state trademark and unfair competition laws may be implicated in a motion picture.<sup>10</sup> These laws seek to protect the commercial value of trademarks (such as brand identities, comic book characters, titles) and “are designed to guard consumers against confusion as to the source or authorization of an item connected to a trademark.”<sup>11</sup> This protection allows consumers to rely on the information conveyed by the mark, thereby significantly reducing consumer search costs and encouraging manufacturers to invest in the creation of quality product and consumer goodwill.<sup>12</sup>

Trademark and unfair competition laws differ in significant respects from copyright laws. Copyright laws “seek to protect the original writings of an author

and is mainly concerned with a character’s development and individualization as a threshold for protection.”<sup>13</sup> On the other hand, “[t]rademark and unfair competition laws seek to protect the commercial value of trademarks, and are mainly concerned with the ability of a mark to symbolize the source of goods or services as a threshold for protection.”<sup>14</sup>

But the list of laws to be offended does not end with copyright and trademarks. Commercial misappropriation,<sup>15</sup> the right to publicity<sup>16</sup> and privacy laws<sup>17</sup> also may be issues in a film project. Each film project has one of a kind legal issues, but all of them, at a minimum, involve copyright law.

### ANATOMY OF A MOTION PICTURE

A motion picture is more than “a series of pictures projected on a screen in rapid succession with objects shown in successive positions slightly changed so as to produce the optical effect of a continuous picture in which the objects move.”<sup>18</sup> Generally speaking, films contain expression of ideas, stories, scripts, acting, directing, editing, cinematography, production designs, art direction, costume designs, make-up, locations, music, sound tracks and more. Any component that requires creative expression that is placed in a fixed medium should sound warning bells that copyright law may be involved.

The goal of all commercial film projects is to make money from the exploitation of the product. To sell a motion picture, the final product and everything

within it must be “cleared.” A “cleared” film is one that can be distributed, performed, copied, and otherwise exploited by the filmmaker (or its assignees, licensees, and/or distributors) without infringing or violating, and without the likelihood of a claim of infringing or violating, some person or some entity’s rights.<sup>19</sup> Without proper clearance, a film is generally not distributable (*i.e.*, it cannot be sold).

Understandably, distributors want clear and free title to the film in the same way a buyer purchasing a home wants a clear chain of title. Without clear and free title, there may be unresolved questions regarding ownership, which in turn increases litigation risks. These lawsuits may come in a variety pack of claims, from copyright infringement to trademark infringement to commercial misappropriation actions and more. Accordingly, distributors require production companies to make warranties as to the clearance of the film and provide supporting documentation.

### DISSECTING INTELLECTUAL PROPERTY ISSUES IN MOTION PICTURES

All movies begin an idea. Ideas are not protected by copyright. Copyright protection covers the expression of an idea never the idea itself. So practitioners need to remind clients to not blurt out their latest and greatest “reality show” concept at a social gathering. A letter of agreement may be established before the disclosure

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## Dissecting Intellectual Property Issues in Motion Pictures

of an idea if it is made clear that the person will be paid if his idea is used.

All movies have a story. The source for the story may be an idea, a verbal pitch, historical events, novels, short stories, plays, comic books, poems, songs, stage plays, television shows, original screenplays, magazine articles and a variety of other sources. If the movie is based on an original screenplay, then the screenwriter needs to register the script with the U.S. Copyright Office. While an original creation is automatically protected under copyright law, the registration of the script provides proof of ownership and protection and remedies (including attorneys' fees) under the Copyright Act.<sup>20</sup> But if the screenplay is based on someone else's material, then the writer does not own the copyright in the work that existed before the project, but does own a copyright in additions and creations.

For movies based on a copyrighted story that has already been published in some form, the production company must acquire the underlying rights of any copyrighted story. This is typically done by way of an option/acquisition agreement. This agreement provides the production company with the option to purchase the motion picture rights for an agreed upon price. This agreement also should include a warranty from the author that he or she owns the material and an indemnity provision from the author to the production company for any liability in the event of a breach of the warranty.

Motion picture rights to a novel, short

story, play or comic book are normally retained by the author, not the publishing company. To acquire the film rights for a published work, a deal needs to be negotiated with the owner of the copyrights. If the owner of the copyrights is the author, then it is customary to contact their agent. To ensure you are dealing with the actual owner of the rights you can search the records in the U.S. Copyright Office to determine if the work has been registered and who without a doubt the owner is.

For certain movie characters based in written material, there may be trademark issues. For example, Marvel Comics owns the copyright for all of their super heroes. But Marvel also owns trademarks in some of the names and words they have created.<sup>21</sup> For example, a movie called "Plasmer" may provoke a trademark claim by Marvel.<sup>22</sup>

Titles are not protected by copyright, but they may be protected by trademark law. Practically speaking, "where the title includes the name of a place, musical group or product, a search of the trademarks registry to ascertain whether the name is trademark protected. It will also be necessary to do searches of the trademark registries in other markets in which the film will be distributed. If the name is registered, then the filmmaker may need to contact the trademark owner and enter into a licensing agreement for use of the name, and that agreement should be included in the film's chain of title."<sup>23</sup>

Releases must be obtained from all people who have contributed to the proj-

ect, because such contributions raise the potential of clouding the clear title to the story. Also all talent, whether in front of the camera or behind it, must execute a talent agreement releasing all rights they have in their works, performances, images, likeness and other personalty rights for the film. This applies to the actors, directors, illustrators, graphic designers, choreographers to extras.

If the project includes copyrighted material in the motion picture, such as archive film footage, music and consumer brands/products, the production company must have the right to do so in the form of an outright transfer or a license from the owner of these rights. A transfer serves to place the producer in the shoes of the owner, with total control over use of the copyright material. You would normally expect this type of transfer of rights from the cast and crew in relation to the copyright they generate in connection with making the film.

A license, which is the most common form of clearance, is where the copyright owner gives you a limited right to use the copyright material. Often the license will be limited in terms of the territories in which the material can be used, the media (e.g. only film festivals and not television) or the time period. It is important as a producer to negotiate as wide a license as possible to make your end-product capable of wide exploitation. If a particular piece of copyright work is proving difficult to clear, it may be better to do without

*Continued on next page*



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## Dissecting Intellectual Property Issues in Motion Pictures

it, rather than risk your ability to distribute the motion picture.

Accordingly, all music, film clips and trademarks in motion picture must be cleared for use. For music, this includes master use licenses from the owners of pre-recorded sound recordings, composer agreements, songwriter agreements and synchronization licenses. For film clips, the production company must obtain a license from the copyright holders. If the film clip includes music, then the music needs to be cleared separately. Likewise, if any trademarks are used in the film, such as company logos on shirts, brands of coffee or beer, then the production company must get trademark clearance from the owners of the marks.

Don't forget artwork. The new 3-D version of *Titanic*, like the original, shows a modified version of Picasso's painting "Les Demoiselles d'Avignon" aboard the sinking ship. James Cameron, the director of the film, asked permission to use the painting in the original film from Picasso's estate, which owns the copyright in the image.<sup>24</sup> The estate said no. Cameron used the image anyways, and after the fact, reached an agreement with the Artists Right Society to pay a fee for the right to use the image in the original film. This issue resurfaced with the new version of *Titanic*. While Cameron obviously can pay the fee, some production companies cannot. They should be aware that something as removed from the story as artwork could hang up a deal to sell the film.

### WRAP UP

Every production company wants the ability to sell its film. To do so requires diligent steps in maintaining ownership and clearing the rights of others in the project. Entertainment lawyers can help guide production companies in the proper documentation to sell the final product, including the preparation of option/acquisition agreements if a film is based on copyrighted material, releases, talent agreements, clearances for music, film clips, trademarks, art works and any other agreements that may have an impact on the ownership of rights in the final product. ■

<sup>1</sup> Anita Modak-Truran is a member of Butler Snow Attorneys, where part of her practice focuses on media and entertainment law and intellectual property litigation. Anita is the past chair of The Mississippi Bar Intellectual Property Section. She is also president of Questidore Entertainment, LLC, and the film critic for 16-WAPT News and Mississippi Public Broadcasting.

<sup>2</sup> Miss. Code §§ 57-89-1, *et. seq.* (2011).

<sup>3</sup> The movie industry in Mississippi started back in 1916 with the filming of the black and white silent film, *The Crisis*. "In the decades since, movies you remember: *Baby Doll*, *This Property Is Condemned*, *O, Brother Where Art Thou?*, *The Reivers*, *My Dog Skip*; some you don't: *Tomorrow*, *Intruder In The Dust*, *Mississippi Masala*; and some you should: *Thieves Like Us*, *Down By Law*, *Big Bad Love*, *Cookie's Fortune*...have been filmed in Mississippi. Mississippi Film Office, <http://www.visitmississippi.org/film/mississippi-film-office.aspx> (last accessed July 5, 2012).

<sup>4</sup> See Miss. Code § 57-89-7, which provides in pertinent part:

(1)(a) A motion picture production company that expends at least Fifty Thousand Dollars (\$50,000.00) in base investment or payroll, or both, in the state shall be entitled to a rebate of a portion of the base investment made by the motion picture production company. Subject to the provisions of this section, the amount of the rebate shall be equal to twenty-five percent (25%) of the base investment made by the motion picture production company.

(b) In addition to the rebates authorized under paragraphs (a) and (c) of this subsection, a motion picture production company may receive a rebate equal to twenty-five percent (25%) of payroll paid for any employee who is not a resident and whose wages are subject to the Mississippi Income Tax Withholding Law of 1968. However, if the payroll paid for an employee exceeds One Million Dollars (\$1,000,000.00), then the rebate is authorized only for the first One Million Dollars (\$1,000,000.00) of such payroll.

(c) In addition to the rebates authorized under paragraphs (a) and (b) of this subsection, a motion picture production company may receive a rebate equal to thirty percent (30%) of payroll paid for any employee who is a resident and whose wages are subject to the Mississippi Income Tax Withholding Law of 1968. However, if the payroll paid for an employee exceeds One Million Dollars (\$1,000,000.00), then the rebate is authorized only for the first One Million Dollars (\$1,000,000.00) of such payroll.

(d) If a motion picture has physical production activities and/or post-production activities both inside and outside the state, then the motion picture production company shall be required to provide an itemized accounting for each employee regarding such activities inside and outside the state for the purposes of proration of eligible payroll based on the percentage of activities performed in the state.

(e) The total amount of rebates authorized for a motion picture project shall not exceed Eight Million Dollars (\$8,000,000.00) in the aggregate.

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- 5 The Mississippi motion picture rebate of 25% applies “to legal, payroll and insurance costs when purchased from a Mississippi vendor.” See Mississippi Film Office, “Incentives,” [http://www.visitmississippi.org/uploads/docs/film\\_office/mississippi\\_film\\_incentive\\_guide\\_lines.pdf](http://www.visitmississippi.org/uploads/docs/film_office/mississippi_film_incentive_guide_lines.pdf) (last accessed July 5, 2012). See also Miss. Code § 57-89-7.
- 6 17 U.S.C. §§ 101 *et. seq.* (2011)
- 7 *Id.* at § 106.
- 8 *Id.* at § 501(a).
- 9 *Id.* at §§ 504-505.
- 10 See generally, 15 U.S.C. § 1125 (a) (1) (2010) .
- 11 Christine Nickels, *The Conflicts Between Intellectual Property Protections When a Character Enters the Public Domain*, UCLA Ent. L. Rev. 133, 155 (1999). See also Kathryn M. Foley, *Protecting Fictional Characters: Defining the Elusive Trademark-Copyright Divide*, 41 Conn. L. Rev. 921 (2009) [hereinafter cited as “Foley, *Trademark-Copyright Divide*”].
- 12 William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & Econ. 265, 269 (1987).
- 13 Foley, *Trademark-Copyright Divide*, 41 Conn. L. Rev. at 939.
- 14 *Id.*
- 15 Commercial misappropriation is a category of invasion of privacy where one’s name or likeness is used without permission for commercial purposes. See generally, Restatement (Second) of Torts § 652 (c); *accord Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977).
- 16 Like trademark and copyright, the right of publicity involves a cognizable property interest. *Zacchini*, 433 U.S. at 573; *Restatement (Third) of Unfair Competition* § 46 cmt. g. Most formulations of the right protect against the unauthorized use of certain features of a person’s identity—such as name, likeness, or voice—for commercial purposes. 1 J. Thomas McCarthy, *The Rights of Publicity and Privacy* §§ 4.9-4.151.1[A][1] (1996). Publicity rights, then, are a form of property protection that allows people to profit from the full commercial value of their identities.
- 17 The right of privacy protects individual personality and feelings. It centers on damages to “human dignity. Damages are usually measured by “mental distress”—some bruising of the human psyche.” *Allison v. Vintage Sports Plaques*, 136 F.3d 1443, 1447 (11th Cir.1998). (citing J. Thomas McCarthy, 5 *McCarthy on Trademarks and Unfair Competition* § 28:6 (1997)).
- 18 Merriam-Webster’s On-Line Dictionary, Definition of “Motion Picture,” <http://www.merriam-webster.com/dictionary/motion%20picture> (last accessed July 5, 2012).
- 19 John Cones, *Creating and Maintaining a Clean Chain of Title for A Feature Film*, [http://www.baselineintel.com/research-wrap?detail/C8/creating\\_and\\_maintaining\\_a\\_clean\\_chain\\_of\\_title\\_for\\_a\\_feature\\_film](http://www.baselineintel.com/research-wrap?detail/C8/creating_and_maintaining_a_clean_chain_of_title_for_a_feature_film) (last accessed on July 5, 2012).
- 20 17 U.S.C §§§ 101 *et. seq.*
- 21 *Marvel’s Intellectual Property Issues*, <http://www.comicbookmovie.com/fansites/steveorjoe/news/?a=41001> (last accessed July 6, 2012).
- 22 *Marvel Comics v. Defiant*, 837 F. Supp. 546 (S.D.N.Y. 1993) (Marvel Comics brought a trademark and unfair competition action against a competitor for defendant’s use of the word “Plasmer”).
- 23 John Cones, *Creating and Maintaining a Clean Chain of Title for A Feature Film*, [http://www.baselineintel.com\\_research-wrap?detail/C8/creating\\_and\\_maintaining\\_a\\_clean\\_chain\\_of\\_title\\_for\\_a\\_feature\\_film](http://www.baselineintel.com_research-wrap?detail/C8/creating_and_maintaining_a_clean_chain_of_title_for_a_feature_film) (last accessed on July 5, 2012); See generally, *L.C. Page & Co. v. Fox Film Corp.*, 83 F.2d 196 (2nd Cir. 1936)(defendant bought film based on representation of free title); .
- 24 Patricia Cohen, “Art Is Long; Copyrights Can Even Be Longer,” *New York Times* (April 24, 2012), <http://www.nytimes.com/2012/04/25/arts/design/artists-rights-society-vaga-and-intellectual-property>

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# Bar Hosts the 2012 Section Orientation Session

Over 50 new Section Officers attended the FY 2012-2013 Orientation Session in August 2012. The half-day program is designed to familiarize new Section leaders with their duties and brief them on resources available to them through the Bar. This year's session included an overview by MS Bar President Lem Adams.



*2012-2013 Appellate Practice Section Officers are Michael Bentley, Vice-Chair; John Henegan, Chair; and David McCarty, Secretary.*



*2012-2013 Litigation Section Officers are Ted Connell, Vice-Chair; Brooke Driskell, Chair; and Rebecca Wiggs, Secretary.*



*Workers Compensation Section Officers include Carlos Moore, Vice-Chair and Amanda Alexander, Chair.*



*Representing the Government Law Section are Melissa Carleton, Vice-Chair and Michael Wolf, Chair.*



*2012-2013 SONREEL Section Officers are Trey Smith, Vice-Chair; John Brunini, Chair; and Chris Wells, Secretary.*



*Business Law Section Officers for 2012-2013 include Kenneth Farmer, Chair and Stan Smith, Vice-Chair.*



*Gaming Law Section Officers are Tom Mueller, Secretary; Cathy Beeding, Chair; and Anthony Del Vescovo, Vice-Chair.*



*Intellectual Property Section Officers are Meaghin Burke, Chair; Jason Bush, Secretary; and Molly Ferguson, Vice-Chair.*



*2012-2013 Senior Lawyers Section Officers are Joe Meadows, Vice-Chair; Jimmie Collins, Chair; and Judge Vernon Cotten, Secretary.*



*Health Law Section is represented by Stephen Clay, Secretary and Bill Grete, Vice-Chair.*



*Real Property Section Officers are Kenneth Farmer, Secretary; David Allen, Chair; and William Smith, Vice-Chair.*



*2012-2013 Estates & Trusts Section Officers include Keith Kantack, Secretary and Pete Cajoleas, Vice-Chair.*



*Representing the Taxation Section are Don Goode, Secretary and Jim Pettis, Chair.*



*Representing the 2012-2013 Alternative Dispute Resolution Officers is Jim Warren, Vice-Chair.*



*Labor & Employment Section Officers include Pope Mallette, Vice-Chair and Bob Richardson, Chair.*

# 2012-2013 President-Elect Nominees

Ballots will be sent in January, 2013



**John Richard (Rick) Barry**  
Meridian

**John Richard (Rick) Barry** is a partner in the firm of Hammack, Barry, Thaggard and May, LLP, formerly Bourdeaux & Jones, LLP, in Meridian, Mississippi. His practice areas include civil litigation, insurance defense, county government law, hospital law and public sector litigation. Rick received his Bachelor of Public Administration from the University of Mississippi in 1976, and his Juris Doctorate from the University of Mississippi Law School in 1979. While in law school, Rick served as Vice President then President of the student body and

was a member of Phi Delta Phi legal fraternity.

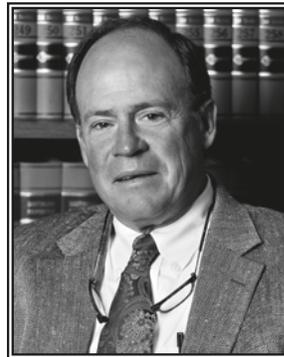
Rick is involved within his community dedicating his time to serve on numerous boards and committees. He has been the Board Attorney for the Lauderdale County Board of Supervisors for 20 years. Rick is a member of the Board of Directors and General Counsel for Rush Health Systems, Inc. He is also General Counsel for the Meridian Housing Authority. Rick is currently a Board Member for the Mississippi State Board of Mental Health. Governor Phil Bryant appointed Rick to the Judicial Appointments Advisory Committee which he will be a part of from 2012 to 2014.

Active in the legal profession, Rick has served as President of the Young Lawyers Division of The Mississippi Bar 1986-1987; Secretary, Treasurer and President of the Lauderdale County Bar Association 1980 and 1993; and President of the Fellows of the Young Lawyers of The Mississippi Bar 2002-2003. He was also Chair of the Health Law Section of The Mississippi Bar 2009-2010. Rick is a former member of the Board of Bar Commissioners 1985-1988 and the Bar Foundation's Board of Trustees 1989-1992. He was inducted as a Bar Foundation Fellow in 1990, and is a member of the Lamar Order.

Rick was nominated by President George W. Bush to the United States District Court for the Southern District of Mississippi in July 2008. He was approved by the American Bar Association Standing Committee on Federal Judiciary as "Well Qualified." However, Rick never received a confirmation hearing before the Senate Judiciary Committee and the nomination expired.

In addition to being a member of the American Bar Association, Rick is a part the ABA Litigation Section of which he served on the Minority Trial Lawyer Committee, and the ABA Health Law Section. He is also a member of The Mississippi Bar's Litigation Section, The Mississippi Bar's Health Law Section and the American Health Lawyers Association.

Rick is a member of the Episcopal Church of the Mediator where he volunteered his time to be Chairman of the Finance Committee, member of the Vestry and a Senior Warden. He has been married to Cheri Merritt Barry, current Mayor of Meridian, for 35 years. They have three children: Jennifer and her husband, David Fowler of Nashville, TN; Jay Barry of Denver, CO; and Merritt Barry of Meridian, MS, and one grandchild, George Bass Fowler.



**Eugene (Gene) M. Harlow**  
Laurel

**Eugene (Gene) M. Harlow** is a native of Clarksdale, Mississippi, and is currently a partner in the Laurel law firm of Hortman Harlow Bassi Robinson & McDaniel, PLLC, where he has practiced for the past 30 years. He received his BBA from Ole Miss in 1979, majoring in Banking & Finance. He attended law school at Ole Miss, receiving his Juris Doctor degree in 1982. During school, Gene was a member of Delta Theta Phi law fraternity. Upon graduation, he joined the predecessor to his current firm, then known as Gibbes Graves Mullins Bullock & Ferris.

Gene's areas of practice include general litigation, workers' compensation, mediation/arbitration, personal injury, wrongful death, product liability, construction, bad faith and trucking litigation. He was certified as a mediator in 1998 and has served as a mediator since that time.

He is a member of the Jones County Bar and is a past President. Gene has served as President of the Young Lawyers Division in 1989 - 1990 and served on the Board of Bar Commissioners from 1988 - 1991. He has served on many bar committees and was Chairman of the Local Affiliates Committee and the Child Advocacy Committee while in the Young Lawyers Division. He also served on the Bar Admissions Committee, Long Range Planning Committee, the Study Committee on the Code of Professional Responsibility and on the Bench/Bar Liaison Committee. He is a member of the American Bar Association, Mississippi Defense Lawyers Association and associate member of American Associates for Justice. Gene was admitted as a Fellow of the Mississippi Bar Foundation in 2003 and currently serves as a Trustee of the Foundation. He is a Fellow of the Young Lawyers Division and served as its President 2003-2004. He is a participating member of the Mississippi Volunteer Lawyers Project and received the Mississippi Pro Bono Project's Exceptional Service Award in 1984. Gene was selected as a member of the American Board of Trial Advocates (ABOTA) in 2009.

Gene has been a member of the Laurel Rotary Club for many years and currently serves as its President. He is also a Paul Harris Fellow of the Rotary Foundation. Gene is a past Trustee of the St. John's Day School Board. He served as President of the Jones County Unit of the American Cancer Society. He is a member of the Board of Trustees of Lake Park Cemetery and serves as its Vice Chairman. Gene is a member of St. John's Episcopal Church where he is a Licensed Lay Minister and a member of the Vestry. He has also served the Economic Development Authority of Jones County as Chairman of the Consumer Protection Committee and as a member of the Membership Committee. He is a sustaining member of the Lamar Order of the University of Mississippi Law School and a past President of the Lamar Order.

Gene has been married to Jan Baird Harlow, formerly of Greenwood, Mississippi, for 35 years, and they have three children—two daughters, Daphne (31) and Meacham (27), and a son, Chand (23).



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## Disbarments, Suspensions, Inactive Disability Status and Irrevocable Resignations

**Charles H. Evans of Jackson, Mississippi.** A Complaint Tribunal accepted the **Irrevocable Resignation** of Mr. Evans in accordance with Mississippi Rule of Discipline 10.5 in Cause No. 2010-B-227.

**Kenneth L. Jones of Gulfport, Mississippi.** The Supreme Court of Mississippi accepted the **Irrevocable Resignation** of Mr. Jones in accordance with Mississippi Rule of Discipline 10.5 in Cause No. 2011-BD-1810.

**David A. Roberts of Pascagoula, Mississippi.** A Complaint Tribunal **Disbarred** Mr. Roberts in Cause No. 2011-B-1850 for violations of Rules 1.2(a), 1.3, 1.4, 1.16(a), 1.16(d), 8.1 and 8.4(a) and (d), MRPC.

Mr. Roberts was personally served with a copy of the Formal Complaint but failed to answer within the time allowed. The Bar subsequently applied for default, which was entered on February 24, 2012. The Bar also filed a Motion for Default Judgment on the same day. Mr. Roberts failed to answer or respond to any pleading or motion filed by the Bar. The Complaint Tribunal entered a Default Judgment on March 27, 2012 disbarring Mr. Roberts from the practice of law in Mississippi. At the time of the disbarment order, Mr. Roberts was serving his second one year suspension from the practice of law.

Rule 1.2(a), MRPC, provides that a lawyer shall abide by a client's decisions concerning the objectives of representation and shall consult with the client as to the means by which they are to be pursued. Rule 1.3, MRPC, provides that a lawyer shall act with reasonable diligence and promptness in representing a client. Rule 1.4, MRPC, provides that a lawyer shall keep a client reasonably informed about the status of a matter and promptly comply with reasonable requests for information. Rule 1.16(a), MRPC, provides that a lawyer shall withdraw from representation of a client if the representation will result in violation of the rules of professional conduct or other law or the lawyer's phys-

ical or mental condition materially impairs the lawyer's ability to represent the client. Rule 1.16(d), MRPC, provides that upon termination of representation, a lawyer shall take reasonable steps reasonably practicable to protect a client's interests, such as surrendering papers and property to which the client is entitled. Rule 8.1(a) and (b), MRPC, provides that a lawyer shall not knowingly make a false statement of material fact or fail to disclose a fact necessary to correct a misapprehension known by the person to have arisen in the matter, or knowingly fail to respond to a lawful demand for information by a disciplinary authority. Rule 8.4(a) and (d), MRPC, provides that it is professional misconduct for a lawyer to violate or attempt violate the rules of professional conduct or engage in conduct that is prejudicial to the administration of justice.

**Gary Keith Silberman of Jackson, Mississippi.** A Complaint Tribunal **Suspended** Mr. Silberman in Cause No. 2012-B-210 for six months for violations of Rules 1.2(a), 1.3, 1.4(a), 1.5(a), 1.16(d), 8.1(b), and 8.4(a) and (d), MRPC.

Mr. Silberman was personally served with a copy of the Formal Complaint but failed to answer within the time allowed. The Bar subsequently applied for default, which was entered on April 20, 2012. The Bar also filed a Motion for Default Judgment on the same day. Mr. Silberman failed to answer or respond to any pleading or motion filed by the Bar. The Complaint Tribunal entered a Default Judgment on May 7, 2012 suspending Mr. Silberman from the practice of law in Mississippi of a period of six months.

Rule 1.2(a), MRPC, provides that a lawyer shall abide by a client's decisions concerning the objectives of representation and shall consult with the client as to the means by which they are to be pursued. Rule 1.3, MRPC, provides that a lawyer shall act with reasonable diligence and promptness in representing a client. Rule 1.4(a), MRPC, provides that a lawyer shall keep a client reasonably informed about the status of a matter and promptly comply with reasonable requests for information. Rule 1.5(a) requires a lawyer's fee to be reasonable. Rule 1.16(d), MRPC, provides that upon termination of representation, a lawyer shall take reasonable steps

reasonably practicable to protect a client's interests, such as surrendering papers and property to which the client is entitled. Rule 8.1(b), MRPC, provides that a lawyer shall not knowingly fail to respond to a lawful demand for information by a disciplinary authority. Rule 8.4(a) and (d), MRPC, provides that it is professional misconduct for a lawyer to violate or attempt violate the rules of professional conduct or engage in conduct that is prejudicial to the administration of justice.

## Public Reprimands

**James Arnold of Durant, Mississippi.** A Complaint Tribunal imposed a **Public Reprimand** in Cause No. 2009-B-1938 for violations of Rules 5.3(a), 5.5, 7.7 and 7.1, MRPC. This case was consolidated with Cause No. 2009-B-1937 (C. Ray Scales, Jr. ("Ray")).

Around 1995, Clarence R. Scales ("Clarence") placed Mr. Arnold's name on the letterhead for Clarence's law firm, Scales & Scales, PA. ("the Scales firm"). After Clarence informed him that he had put Mr. Arnold's name on the letterhead, Mr. Arnold failed to oppose it. Clarence was the sole owner of the firm and the only lawyer at the Scales firm at that time. Mr. Arnold was not affiliated with the Scales firm except that he had been associated with Clarence on fewer than five cases over a 15 year period.

Philip Scales ("Philip") worked at the Scales firm as a paralegal. Philip is not a lawyer. After Clarence died in 2000, Philip continued to operate the firm until approximately 2009, when the Unauthorized Practice of Law Committee of the Bar issued him "cease and desist" letter.

Mr. Arnold became aware that his name was still on the Scales firm's letterhead in 2003 and 2007. He was also aware that Clarence had died in 2000. He knew or should have known at those times that the firm was operating without the benefit of a lawyer and that his name was improperly attached to the firm. Mr. Arnold was given notice that an informal Bar complaint had been filed on October 8, 2008. The gravamen of the allegations of the Bar complaint was that Mr. Arnold had assist-

*Continued on next page*

ed Philip in the unauthorized practice of law. In spite of this notice, Mr. Arnold continued to work with the Scales firm and Philip on at least two cases after October 8, 2008.

The Complaint Tribunal found that Mr. Arnold violated Rules 5.3, 5.5, 7.7, and 8.4(a) and (d).

Rule 5.3, MRPC, provides that with respect to a non-lawyer associated with a lawyer shall be responsible for conduct of such a person that would be a violation of the rules of professional conduct if engaged in by a lawyer if the lawyer, with knowledge of the specific conduct, ratifies the conduct involved. Rule 5.5, MRPC, provides that a lawyer shall not assist a person who is not a member of the bar in performance of activity that constitutes the unauthorized practice of law.

Mr. Arnold assisted Philip in the unauthorized practice of law because of his continuing relationship with Philip from Clarence's death in 2000 and continuing past October 2008. Mr. Arnold's work on the two cases after 2008 was evidence that he had failed to take steps to ensure Philip's conduct was compatible with Mr. Arnold's professional obligations.

Rule 7.7, MRPC, provides that a lawyer shall not use a firm name, letterhead, or other professional designation that violates Rule 7.1, MRPC. Rule 7.1 provides that a lawyer shall not permit to be made a false, misleading, or deceptive communication about the lawyer or the lawyer's services. It further provides that a communication violates the rule if it contains a material misrepresentation of fact.

Mr. Arnold's acquiescence with having his name on the Scales firm's letterhead and his ineffective attempts to have his name removed from the letterhead was a violation of Rule 7.7 such that the letterhead was false and deceiving as to the identity of the lawyers associated with the firm.

**C. Ray Scales of Jackson, Mississippi.** A Complaint Tribunal imposed a **Public Reprimand** in Cause No. 2009-B-1937 for violations of Rules, 5.3, 5.4(a), 5.5(b) and 8.4(a), MRPC. This case was consolidated with Cause No. 2009-B-1938 (James H. Arnold).

Ray Scales is the son of Clarence Scales and the older brother of Philip Scales. Ray and Philip did not get along with each other.

Ray has a solo practice that until 2009 was located immediately adjacent to the Scales firm in what is commonly referred to as the Dixie Building in Jackson. Ray had no ownership interest in and was not an associate of the Scales firm. Ray had no keys to the Scales firm's office, nor did the Scales firm have keys to his. Philip continued to operate the Scales firm following Clarence's death in December 2000 until it was eventually closed in 2009. No lawyer worked at the Scales firm during the time Philip operated the Scales firm.

In 2007, Philip requested Ray Scales to help get a minor settlement approved in a wrongful death case. Philip negotiated a settlement on behalf of the minors. Ray appeared before the Chancery Court of Hinds County on a petition to have the settlement approved and signed the pleadings as "C. Ray Scales, Jr. for Scales & Scales, PA." Included in the pleadings was a request for the Scales firm to be paid an attorney's fee of \$16,666.67 plus firm expenses of \$1,174.72. At that time, there was no attorney practicing at the Scales firm.

In another case, Philip requested Ray to handle a personal injury matter on the premise it was "over their head" at the Scales firm. Ray agreed and had the clients sign a contract with him as "C. Ray Scales, Jr. for Scales and Scales Attorneys." Because Ray did not handle personal injury cases, he associated another lawyer. In his association letter, Ray agreed to split the attorney fee whereby the lawyer to whom the case was referred would be compensated for his work by receiving 60% of any attorney fee due under the settlement and Mr. Scales would receive 40%.

According to Mr. Scales, his fees were to be capped at \$10,000 and the balance of any fees due to him would be paid to the Scales firm. This arrangement was not provided for in the written fee splitting agreement between him and the associated lawyer. Likewise, there is no written agreement between Ray and the Scales firm memorializing this arrangement.

At the time Ray and the clients signed the contingency fee contract, Ray believed Jim Arnold was the lawyer at the Scales firm. Notwithstanding his belief, Ray did not contact Mr. Arnold about the alleged fee splitting agreement between himself and the Scales firm. The clients did not know who Mr. Arnold was and Philip had signed all of the correspondence on behalf of the Scales firm with regard to the clients' case.

Ray testified that he inserted the phrase "C. Ray Scales, Jr. for Scales and Scales Attorneys" into the contract to protect the Scales firm's lien. There is no other language in the contract that refers to any lien of the Scales firm.

The Complaint Tribunal found that Ray Scales violated Rules 5.3, 5.4(a), 5.5(b), and 8.4(a) and (d).

Rule 5.3, MRPC, provides that with respect to a non-lawyer associated with a lawyer, the lawyer shall be responsible for conduct of such a person that would be a violation of the rules of professional conduct if engaged in by a lawyer if the lawyer, with knowledge of the specific conduct, ratifies the conduct involved. The Complaint Tribunal found that Ray Scales allowed himself to be associated with Philip and that Ray had not made reasonable efforts to ensure Philip's conduct was compatible with Ray's professional obligations.

Rule 5.4, MRPC, provides that a lawyer shall not share legal fees with a non-lawyer except in limited circumstances not presented in this case. Ray Scales entered into a contract as "C. Ray Scales, Jr. for Scales and Scales Attorneys" with the intention of sharing all fees otherwise due him with the Scales firm.

Rule 5.5, MRPC, provides that a lawyer shall not assist a person who is not a member of the bar in performance of activity that constitutes the unauthorized practice of law. The Complaint Tribunal found that Ray violated this rule by negligently assisting the Scales firm in such a manner as to be paid an attorney's fee and expenses in the wrongful death case.

**Peter A. C. Stewart, III of Jackson, Mississippi.** The Committee on Profes-

sional Responsibility imposed a **Public Reprimand** in Docket No. 10-520-2 for his violation of Rules 1.2(e), 1.3, 1.4, 1.16(a) and (d), 5.5, 8.1(b) and 8.4(a) and (d), MRPC.

Mr. Stewart filed a petition for post-conviction relief on behalf of his client while suspended from the practice of law by the Supreme Court of Mississippi. Mr. Stewart failed to inform his client he was suspended and therefore unable to carry out the representation.

Rule 1.2(e), MRPC, requires a lawyer to consult with the client regarding the relevant limitations on the lawyer's conduct when the lawyer knows the client expects assistance not permitted by the Rules of Professional Conduct. Mr. Stewart violated Rule 1.2(e) when he failed to explain to his client that his suspension from the practice of law prohibited him from filing the post-conviction relief petition desired.

Rule 1.3, MRPC, requires a lawyer to act with reasonable diligence and promptness in representing a client. Mr. Stewart violated Rule 1.3 when he failed to pursue the post-conviction matter prior to his suspension and when he failed to notify the opposing party and the court of his suspension.

Rule 1.4, MRPC, requires a lawyer to keep a client reasonably informed about the status of the matter and promptly comply with reasonable requests for information. Mr. Stewart violated Rule 1.4, MRPC, by failing to keep his client reasonably informed as to the status of his case and failing to inform his client that Mr. Stewart had been suspended from the practice of law.

Rule 1.16(a) requires a lawyer to withdraw from the representation of a client if the representation will result in a violation of the rules of professional conduct or other law. Further, Rule 1.16(d) requires a lawyer upon termination of representation to take steps reasonably practicable to protect his client's interest, including giving reasonable notice to the client. Mr. Stewart violated Rule 1.16(a) by filing the petition while suspended, thereby engaging in the unauthorized practice of law in violation of Rule 5.5 and Miss. Code Ann. §73-3-55. Mr. Stewart violated Rule

1.16(d) when he failed to notify his client, the court, or the district attorney of his one (1) year suspension or take any step to protect the interests of his client.

Rule 5.5(a), MRPC, prohibits a lawyer from engaging in the unauthorized practice of law. Mr. Stewart's filing of a petition while suspended by the Supreme Court of Mississippi constitutes the unauthorized practice of law.

Rule 8.1(b), MRPC, requires a lawyer to respond to the Bar's lawful demands for information related to a disciplinary proceeding. An Investigatory Hearing was properly noticed in this matter and Mr. Stewart's failure to appear is a violation of Rule 8.1(b).

Rule 8.4(a), MRPC, states it is professional misconduct to violate or attempt to violate the Rules of Professional Conduct. Rule 8.4(d), MRPC, states it is professional misconduct to engage in conduct prejudicial to the administration of justice. Mr. Stewart's violations of Rules 1.2, 1.3, 1.4, 1.16, 5.5, and 8.1, MRPC, as described above constitute misconduct that is prejudicial to the administration of justice under Rule 8.4.

**Jeffrey Lynn Ellis of Pascagoula, Mississippi.** The Committee on Professional Responsibility imposed a **Public Reprimand** in Docket No.10-360-2 for violations of Rules 1.2(a), 1.3, 1.4(a), 1.5(a), 1.16, 8.1 and 8.4(a) and (d), MRPC.

Mr. Ellis was hired and paid to handle a divorce and an alienation of affection case. The client was granted a divorce, but was unhappy with the custody award and requested Mr. Ellis appeal. Mr. Ellis timely filed a notice of appeal of the custody award; however, he failed to pay the appeal costs to the lower court, designate the record or file a certificate of compliance. Mr. Ellis further failed to cure the deficiencies, once notified by the clerk, resulting in dismissal of the appeal. Mr. Ellis did not inform the client that the appeal was dismissed at any time. Mr. Ellis also failed to have the defendants in the alienation of affection case served. Mr. Ellis did not respond to the informal [Bar] complaint.

Rule 1.2(a), MRPC, requires a lawyer to abide by the decisions of his clients regarding the objectives of the representation. Mr. Ellis failed to complete the work he was retained to perform in violation of Rule 1.2(a).

Rule 1.3, MRPC, requires a lawyer to act with reasonable diligence and promptness in representing a client. Mr. Ellis violated Rule 1.3 when he failed to pursue the appeal and failed to have the defendants served in the alienation of affection case.

Rule 1.4(a), MRPC, requires a lawyer to keep a client reasonably informed about the status of the matter and promptly comply with reasonable requests for information. Mr. Ellis violated Rule 1.4(a), MRPC, by failing to communicate to his client that the appeal was dismissed and that he failed to serve the defendants in the alienation of affection case.

Rule 1.5(a) requires a lawyer's fee to be reasonable. Mr. Ellis violated Rule 1.5 when he failed to perform the work for which he was paid.

Rule 1.16(d) requires a lawyer upon termination of representation to take steps reasonably practicable to protect his client's interest, including giving reasonable notice to the client. Mr. Ellis violated Rule 1.16(d) when he failed to complete the representation, gave his client no notice that he would not complete the representation, and failed to take any action to protect the client's interests in his legal matters.

Rule 8.1(b), MRPC, requires a lawyer to respond to the Bar's lawful demands for information related to a disciplinary proceeding. Mr. Ellis violated Rule 8.1 when he failed to respond in any way to the informal [Bar] complaint.

Rule 8.4(a), MRPC, states it is professional misconduct to violate or attempt to violate the Rules of Professional Conduct. Rule 8.4(d), MRPC, states it is professional misconduct to engage in conduct prejudicial to the administration of justice. Mr. Ellis's violations of Rules 1.2, 1.3, 1.4, 1.5, 1.16, and 8.1 as described above constitute misconduct that is prejudicial to the administration of justice under Rule 8.4. ■



# A Good Lawyer and the Golden Rule

*By David Maron  
President, Capital Area Bar Association*



# DENY RULE

**I**ncivility is one of the greatest threats to our justice system. Whether rudeness or outright personal attacks, unprofessional behavior (once the exception) has become more frequent. Certainly at times the tension and stress of the adversary system can take its toll on our better judgment. As Luther Munford's article on the consequences of "legal warfare" notes: "Much unprofessional conduct occurs when attorneys substitute feeling for thinking. Fear and frustrated expectations stir up emotions block good judgment, and lead to uncontrolled haranguing of judges, colleagues, and witnesses."<sup>1</sup>

That accurately assesses a majority of the problem; but other unprofessional conduct is not so understandably explained. Instead it has become a tactic—part of an intentional, Machiavellian win "at all costs" strategy that, sadly, is rewarded with success and often is tolerated as part of the "adversary system."

Whether a lapse in judgment or intentional, incivility diminishes the practice of law and its reputation and, not surprisingly, erodes the public trust and respect for the justice system. And it is not always an ethics issue, either. While some of these practices may violate the Mississippi Rules of Professional Conduct and/or Rule 11, many do not. Simply expecting lawyers to accept these practices as appropriate for the "changing times" is not a solution. Nor would additional rules<sup>2</sup> solve the problem because, as Winston Churchill once observed, "[with] 10,000 regulations, you destroy all respect for the law."

The issue belongs to lawyers—each of us. Beyond formal regulations, the law is one of the few remaining self-governing professions—a fact that places both the blame and the solution for the current situation primarily in our hands. And self-governance is not limited to following or enforcing the written rules. In fact, the preamble to our Rules of Professional Conduct acknowledges that in addition to the rules, "a lawyer is also guided by *personal conscience* and the approbation of professional *peers*."<sup>3</sup> Our collective conscience hasn't changed that dramatically; but it may be asleep.

In the Foreword to his ethics treatise, Professor Jackson hints at a potential source of the problem: The Rules of Professional Conduct "mandate honesty, loyalty, competence, diligence, discretion, fairness and respect for clients, adversaries, third parties, and for the courts.

*Continued on next page*

## A Good Lawyer and the Golden Rule

Good lawyers understood this even *before* the MRPC made that plain.<sup>24</sup>

What is “good lawyer?” Good lawyers don’t always win—just read *To Kill a Mockingbird*. Financial success can’t be the sole measure of a good lawyer either. It means something more; something like “honorable” — a word that, outside the military and formal titles, has been left on the shelf collecting dust. But words like “honorable” and “integrity” have meaning and best reflect the authentic character of a true professional - a good lawyer.

True professionalism is not a shallow, public display for important people (judges, bosses, and clients); nor can it be reduced to (the appearance of) congeniality among adversaries. As Supreme Court Justice Anthony Kennedy observed “civility is not some bumper sticker slogan, ‘have you hugged your adversary today?’ Civility is the mark of an accomplished and superb professional, but it is even more than this. It is an end in itself.” Civility, integrity, professionalism are not theoretical aspirations either. They must be foundational to our profession not merely because they make our jobs more

pleasant (which they do), but because they are essential to a functioning and respected justice system that the public entrusted to us.

If, as Justice Kennedy observed, civility should be an end in itself: *what should it look like in practice?* and *what practical steps can we take we ensure that it remains a lasting legacy of our profession?* Those were far easier questions a generation ago. But today we have principled standards that capture the essence of professionalism and civility and tell us what it should look like in practice. Two excellent examples are The Mississippi Bar’s *A Lawyer’s Creed*<sup>5</sup> and the American Board of Trial Advocates’ (ABOTA) *Principles Of Civility, Integrity, And Professionalism*.<sup>6</sup> Mississippi Bar’s Lawyers’ Creed provides straightforward guidance:

**To my clients,** I offer faithfulness, competence, diligence, and good judgment. I will strive to represent you as I would want to be represented and to be worthy of your trust.

**To the opposing parties and their counsel,** I offer fairness, integrity, and civility. I will seek to fairly resolve differences and, if we fail to reconcile disagreements, I will strive to make our dispute a dignified one.

**To the courts,** and other tribunals, and to those who assist them, I offer respect, candor, and courtesy. I will strive to do honor to the search for justice.

**To my colleagues in the practice of law,** I offer concern for your reputation and well-being. I will extend to you the same courtesy, respect, candor and dignity that I expect to be extended to me. I will strive to make our association a professional friendship.

**To the profession,** I will strive to keep our business a profession and our profession a calling in the spirit of public service.

**To the public** and our systems of justice, I offer service. I will strive to improve the law and our legal system, to make the law and our

legal system available to all, and to seek the common good through effective and ethical representation of my clients.

The Creed answers our first question (what it should look like in practice) by requiring honor, dignity and integrity; and it gives meaningful guidance by describing a lawyer’s duty to his *clients* and *colleagues in the practice of law* applying the timeless principle of the golden rule. As with the Biblical injunction “so whatever you wish that others would *do* to you, *do also* to them . . .”<sup>7</sup> our duty is not passive restraint. It requires action. To ensure these standards endure within the practice of law requires that we: (1) *control* our own behavior and (2) positively *influence* those around us.

As a self-regulating profession, we own this issue both individually and corporately. Reform won’t happen on its own. It starts with each of us. Our second question is more personal: How can we ensure that these qualities endure? In the Foreword to his ethics treatise Professor Jackson begins “In law practice, *I had a mentor . . .*” Mentoring is vital to both personal character and professional development—and each is essential to producing the next generation of good lawyers. Mentoring is *teaching* through both words and actions; consistently *following* professional standards of our practice (honesty, integrity, civility, and courtesy); *encouraging* respect for the law; and *reflecting* a commitment to the practice as a learned profession.

Whether formal<sup>8</sup> or informal, mentoring is not optional. Professor Jackson’s mentor taught him that good lawyers conformed to norms of professional behavior even without rules and importantly “*even when not being observed by others.*” Mentoring (or at least influence) happens whether we know it or not because rarely is no one watching. Perhaps, more than any well-meaning instruction, what is done under adversity and against hostility—especially when the correct thing is also the unpopular thing—is probably the most instructive and remembered teachers of these values.

Since this issue belongs largely to lawyers, what can we do? Here are a few practical guides:

### MEDIATION ARBITRATION

#### JACK F. DUNBAR

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e-mail: Jackd@holcombdunbar.com

- **Don't start it.** And when you feel drawn into the fray, don't take the bait and respond in kind. As the old saying goes: "Never argue with an idiot, someone watching might not be able to tell the difference."
- **Talk about it first.** When you receive a "hot" letter, "toxic" email, or the unilaterally set deposition, try practicing the golden rule. It may not succeed; but at least first *try* to talk with opposing counsel—by phone, at lunch or over a cup of coffee.
- **Keep perspective on what is at stake.** While responding in kind might make us feel better in the short term (about 3 seconds after pressing "send") it rarely does anything to advance our client's cause, our own credibility, the reputation of the profession, or—most importantly—the public's respect and trust for the justice system.
- **Don't be Rambo.** Remember guerrilla warfare is a terrorist tactic. Zealous representation never requires hostility or

cheap shots. If the NFL thinks they're dangerous, not to mention bad for its image, lawyers should learn a lesson.

- **Guard your credibility and reputation.** The importance of reputation with the court and among your peers cannot be overstated. In his article, *How to Persuade a Judge—The Art of Legal Writing*, U. S. District Judge Daniel P. Jordan succinctly captured the issue: "Judges talk, and they know who does great work and who they can and cannot trust. This is not to say that judges intentionally alter rulings to favor certain attorneys; but the line between success and failure is often thin, and your reputation can affect the judge's attitude toward your arguments."<sup>9</sup>
- **Never make it personal.** For the times a lawyer's conduct is *the* issue, the solution still will involve the facts and the law, not whether you *feel* that your opponent is a no-good, lying liar—however true it may be. Instead, make your record. Introduce relevant evidence. Argue the law. Do everything possible

to keep the dispute on the facts and law instead of a personal attack. Zealous advocacy is not venomous advocacy and ad hominem attacks should always be avoided. They rarely are persuasive; and, worse, when you (inevitably) overstate your case, they will backfire. As the Mississippi Supreme Court has cautioned: "This litany of unreliable representations . . . compels us to place little reliance on [counsel's] briefs and we strongly urge [him] to carefully consider and check the accuracy of his representations to this Court before signing them."<sup>10</sup>

- **Get to know your fellow lawyers.** Long before conflict has a chance to arise, get to know your colleagues as more than names on letterhead, an email address or signatures on a pleading. Get involved with your state and local bar associations. One of the greatest benefits of the Mississippi Bar, CABA and other bar associations is the opportunity to develop relationships with fellow lawyers

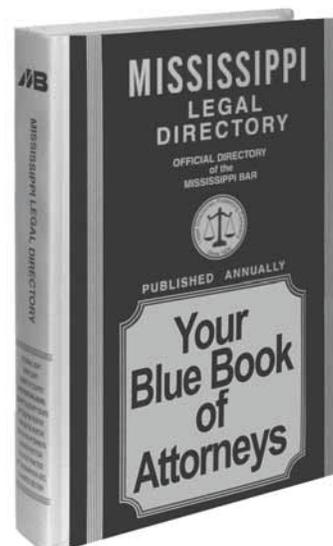
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## A Good Lawyer and the Golden Rule

whether at the bar convention, other social events, or working together on public service projects.

- **Avoid even the seemingly harmless jab.** Remember “a soft answer turns away wrath, but a harsh word stirs up anger.”<sup>11</sup> By consciously refusing to practice or tolerate even “incremental” incivility, (angry letter, sarcastic argument) your relationship with others is less likely to escalate to scorched-earth or personal attacks. And when someone does push your button, wait. Let your letter sit for an hour. Ask someone else to read your email or draft motion before it is sent.
- **If you need to ask, the answer is usually “no.”** The Rules of Professional Conduct and the “personal conscience and the approbation of professional peers” provide sufficient clarity in most situations. But what if (and especially if) there is no rule that seems to directly provide guidance? The Mississippi Bar’s

Lawyers Creed incorporates the principles of the golden rule. And if the golden rule proves too esoteric, try the following: The “smell test.” The newspaper headline test. The exhibit to a motion test. The “would I want the person I most admire to know what I’ve done/said” test.

These suggestions are certainly not all-inclusive. But hopefully they offer some practical guidance. The Mississippi Bar Lawyers Creed calls us to “strive to keep our business a profession and our profession a calling in the spirit of public service.” Ultimately, to keep true professionalism engrained in the practice of law, let’s all be vigilant *examples* and *defenders* of these principles. ■

- 1 Luther T. Munford, *The Peacemaker Test: Designing Legal Rights to Reduce Legal Warfare*, 12 Harv. Neg L. Rev. 377, 413 (2007).
- 2 The Mississippi Rules address honesty, diligence, candor, loyalty, but some state bar associations have formally included civility as part of their

oath of admission. Florida’s oath, for example, includes the following pledge for its new admittees: “To opposing parties and their counsel, I pledge fairness, integrity, and *civility*, not only in court, but also in all written and oral communications.”

- 3 Miss R. Prof Cond. Preamble (emphasis added).
- 4 Jeffrey Jackson, Donald Campbell, *Professional Responsibilities for Mississippi Lawyers*, MLI Press (2010) at iii (emphasis added).
- 5 See <http://www.msbar.org/admin/spotimages/2400.pdf>
- 6 See <https://www.abota.org/index.cfm?pg=ProfEthicsCivility>
- 7 See Matthew 7:12 (emphasis added),
- 8 Many law firms have formal mentoring programs and the Mississippi Bar’s James O. Dukes Professionalism Program also includes a pilot mentoring program to match up mentors with new bar admittees. Information on this is available on the Mississippi Bar website at <[www.msbar.org/professionalism.php](http://www.msbar.org/professionalism.php)>
- 9 Judge Daniel P. Jordan III, *How to Persuade a Judge—The Art of Legal Writing*, The Mississippi Lawyer, 11, 14 (March-April 2010).
- 10 *In re Blake*, 912 So. 2d 907, 913 (Miss 2005).
- 11 See Proverbs 15:1



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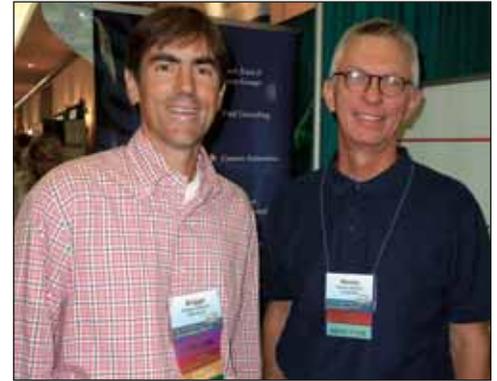
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# 107th Annual Meeting Highlights of the 2013 Bar Convention



Bar President Hugh Keating, pictured left, presented the gavel to incoming President Lem Adams of Brandon

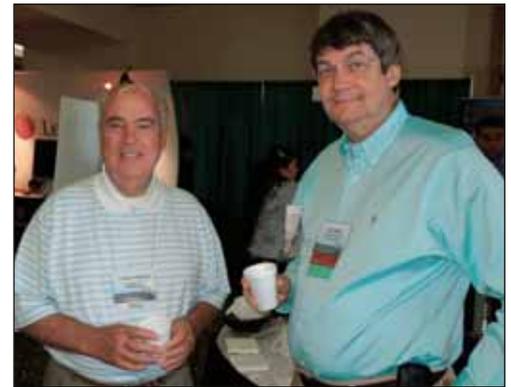
Senator Briggs Hopson of Vicksburg and Ronny Roberts of Columbus at the Exhibit Hall



Gail Pittman and Donna Keating. Gail was the convention's featured artist this year.



Many people attended the Annual Business Session to hear the State of Judiciary report



Judge Prentiss Harrell and Jon Mark Weathers, both from Hattiesburg, at the Coffee Bar sponsored by Trustmark Bank



The Young Lawyers Division 76th Anniversary General Assembly.



Author Michael Rejebian was the speaker of the Young Lawyers Division General Assembly, pictured with YLD President Jennifer Hall.



Legal Run-around



First time attendee Daniella Shorter of Greenville with Craig Brown



Bingo winners



*“Women Trailblazers” honored at the Price-Prather Luncheon were (front row) Constance Slaughter-Harvey, Michelle Easterling, Lenore Prather, Clare Sekul Hornsby, Mary Libby Payne, Kay Cobb, Amanda G. Alexander and Lynn Fitch; (back row) Susan Tsimortos, Lydia Quarles, Joy Phillips, Karen Sawyer, Lisa Ross, Nina Stubblefield Tollison, Melissa Carleton and Tamra Cascio.*



*MS State Treasurer Lynn Fitch, far left, was the featured speaker at the Price-Prather Luncheon. Diala Chaney served as the luncheon subcommittee chair; Cindy Mitchell and Maura McLaughlin, Trailblazing Women Tribute subcommittee chairs; (back row) Jessica Dupont, Committee Chair, and La’Verne Edney, who gave the opening prayer.*

## Breakfasts and Luncheons



*Joy Phillips, Vice-President of the Fellows of the Young Lawyers, greeted the newly inducted Fellows – David Pharr of Jackson and Nina Stubblefield Tollison of Oxford*



*Price-Prather Luncheon – Gayla Carpenter-Sanders of Ridgeland and Tiffany Graves of Jackson*



*Price-Prather Luncheon – Jenny Tyler Baker of Biloxi and Je’Nell Blum of Gulfport*



*Price-Prather Luncheon – Leslie Lee and Meta Copeland, both from Jackson*



*Price-Prather Luncheon – Gene Harlow of Laurel and Rick Barry of Meridian*



*Judge Janace Goree of Lexington and Judge Betty Sanders of Greenwood*

*Justice Ann Lamar, receiving the Susie Blue Buchanan Award, with previous winners Lenore Prather and Kay Cobb*



*Judge Jacqueline Mask of Tupelo and Katherine Kerby of Columbus*



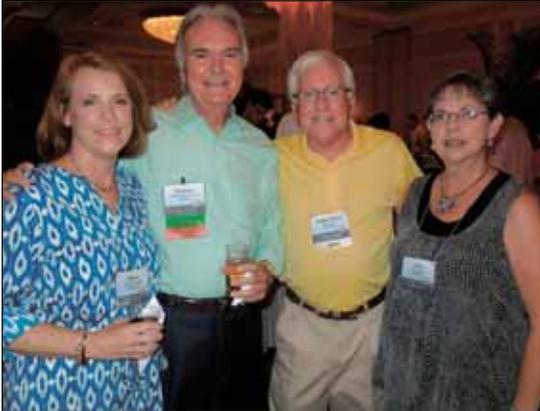
# Welcome Reception



*Guy and Susan Mitchell of Tupelo*



*John Cocke of Clarksdale and Anne Barnwell and Judge Jon Barnwell of Greenwood*



*Ginny and Richard Roberts of Jackson and Judge John Grant and Julia Grant of Brandon*



*Justice Mike Randolph and Kathy Randolph of Hattiesburg*



*Meade and Holly Mitchell of Jackson*



*Judge Ed Patten and Jacqui Patten of Hazlehurst and Judge Jim Kitchens of Caledonia*



*York Craig of Ridgeland and Judge Jim Davidson of Columbus*



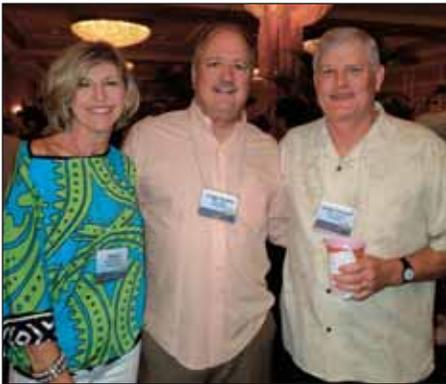
*Fred, Rachel, Gabrielle, and Pamela Banks of Jackson*



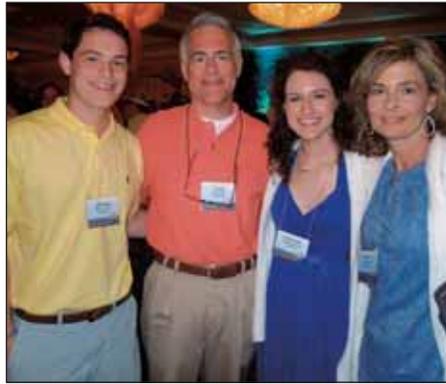
*Gram and Kathryn Meadors of Alpharetta, GA and Sam and Kim Kelly of Jackson*



*Briggs and Dot Smith of Batesville and Blake and Stacey Teller of Vicksburg*



*Barbie Harkey and Judge Dale Harkey of Pascagoula and Judge Lee Howard of Starkville*



*Michael, Tony, Katherine, and Karen Farese of Ashland*



*Judge Deborah Gambrell, Maura McLaughlin, and Carol Jones-Russell, all from Hattiesburg*

## Welcome Reception



*Judge Joe Lee and Renee Lee of Jackson and Ruthie and Rodger Wilder of Gulfport*

*Emily and Harry Allen of Gulfport*



*Parrish Fortenberry of Madison and Terry Weill of Memphis, TN*



*Diala Chaney of Oxford with her husband Phillip and sons Elliott and Michael*



*Anthony Simon and Barbara and Mike Wallace, all from Jackson*



*Alison and Ian Baker of Biloxi*



*Judge Cem Morgan of Kosciusko and Pepper and Cindy Crutcher of Madison*



*Jamie White of Oxford, Karen Peairs of Oxford, and Judge E. J. Russell of Jackson*



*Perry Phillips of Hattiesburg with his family*

## Welcome Reception



*Natalie and Bobby Bailess of Vicksburg and Don Fruge of Oxford*

*Judge John Gargiulo and Katherine Gargiulo of Gulfport*



*Shronda Leggett of Hattiesburg and Davetta Lee of Jackson with Morgan*



*Keith and Sherry Miller of Pascagoula*



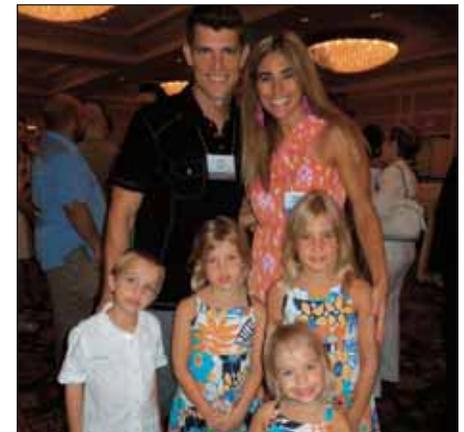
*Charlene Priester and Melvin Priester Jr. of Jackson*



*Mary Ruth and David Allen of Biloxi*



*Joel Smith of Gulfport, Albert Ncaise of Gulfport, and Bradley Vance of Jackson*



*Tim Sensing of Jackson and family*



*Government Law Section*



*Business Law Section*

## Section Meetings



*Government Law Section – Thomas Hood with MS Ethics Commission*



*Real Property Section*



*Business Law Section – speaker Jet Hollingsworth*



*Real Property Section*



*ADR Section*



*ADR Section*



*Health Law Section*



*Gaming Law Section*



*Senior Lawyers Section*



*Health Law Section – speaker Mike Wallace*



*Estates & Trusts & Taxation*

## Section Meetings



*SONREEL Section*



*Family Law Section*



*Workers' Comp & Labor & Employment*



*Intellectual Property – Chair Anita Modak-Truran*



*Litigation Section*

# President's Reception



*"Beatlemania" arrives at the President's Reception*



*Matthew Thompson of Jackson and his wife Karen, daughter Claire and son Will*



*Lem and Marcia Adams of Brandon, Ruthie and Rodger Wilder of Gulfport, Larry Houchins of Jackson, Ginny and Richard Roberts of Ridgeland*



*Eric and Natalie Dillon of Madison*



*Bar President Hugh Keating and his wife Donna*



*Rusty Brown of Oxford and Cindy Meek of Oxford*



*Jager and Janet Smith of Brandon*



*Gerry and Gerald Cruthird of Picayune and Judge Ronald Doleac of Hattiesburg*



*Judge Lee Howard of Starkville, Judge Jim Kitchens of Caledonia, Judge Jim Davidson of Columbus, and Judge Lee Coleman of West Point*



*John Weddle, Karen Weddle and Anna Grace Weddle and Miley Wise and Josh Wise, all from Tupelo*

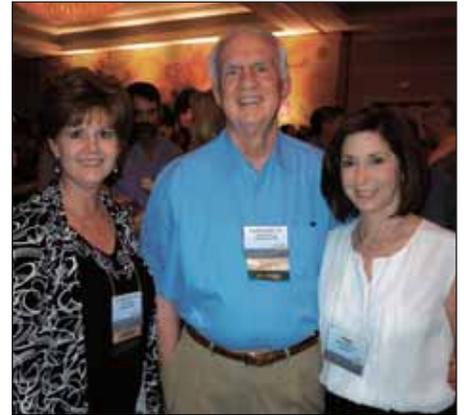


*Bryan and Sandra Buckley Brandon and Joe and Lisa Stevens of Hattiesburg*

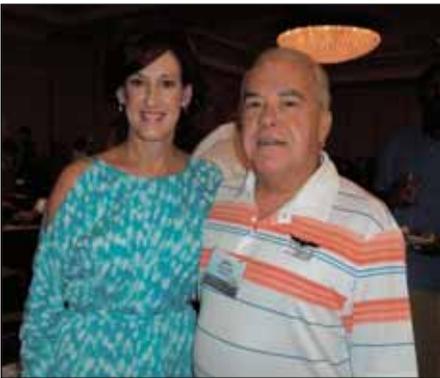
*The Crab Hunt is sponsored by the Koerber Company during the Family Beach Bash*



## President's Reception



*President's Reception sponsor, Fox Everett - Sandi East, Bill and Patty Mathison*



*Sherry Pitts and John Colette of Jackson*



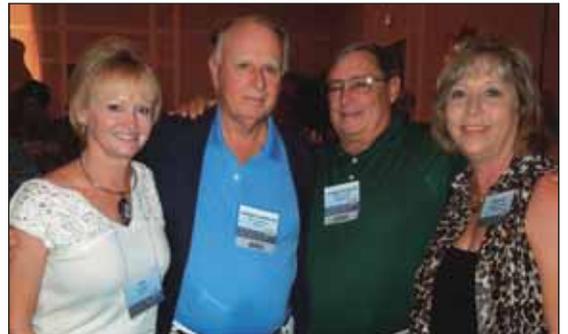
*Selene Maddox of Tupelo and Nina Stubblefield Tollison of Oxford*



*Jim and Susan Johnstone of Pontotoc*



*Rhae and Reed Darsey of Meridian*



*Pat Ward of Laurel, Judge B.J. Landrum of Laurel, Judge Lamar Pickard and Marsha Pickard of Hazlehurst*

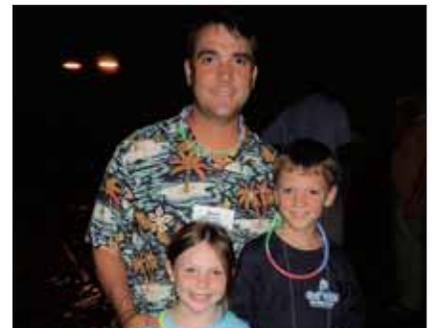
## Family Beach Bash



*Sam and Tabitha Buchanan of Hattiesburg*



*Judge Kenny Griffis and family*



*Mark Majors, Emily and Michael Majors of Madison*

## Children's "Build-a-Bear" Party



## Sandcastle Contest



## Kite Decorating & Kite Flying Contest



## 2011-2012 Distinguished Service Award

La'Verne Edney  
Jackson



*La'Verne Edney, pictured right, was awarded the 2011-2012 Distinguished Service Award. Presenting the award was Mississippi Bar President Hugh Keating.*

## 2011-2012 Judicial Excellence Award

Judge John M. Roper  
Gulfport



*The Mississippi Bar awarded the 2011-2012 Judicial Excellence Award to Judge John M. Roper, pictured left. Presenting the award was Mississippi Bar President Hugh Keating.*

## 2011-2012 Lifetime Achievement Award

Harold D. Miller  
Ridgeland



*Hal Miller, pictured left, received The Mississippi Bar's 2012 Lifetime Achievement Award. Presenting the award was Mississippi Bar President Hugh Keating.*

Judge James L. Roberts, Jr.  
Pontotoc



*The Mississippi Bar honored Judge James L. Roberts, Jr., pictured left, with the 2012 Lifetime Achievement Award. Bar President Hugh Keating presented the award.*

2011-2012  
Susie Blue Buchanan  
Award presented by the  
Women in the  
Profession Committee

Justice Ann Lamar  
Senatobia



Justice Ann Lamar, center, received the 2012 Susie Blue Buchanan Award from the Women in the Profession Committee. Presenting the award is Committee Chair Jessica Dupont, left, and Susie Blue Buchanan Sub-Committee Gayla Carpenter-Sanders, right.

2011-2012  
Curtis E. Coker  
Access to Justice Award  
presented by MVLP

Wesley Hisaw  
Horn Lake



The Curtis E. Coker Access to Justice Award was presented to Wesley Hisaw, pictured left. Presenting the award is Bar President Hugh Keating, pictured right.

2011-2012  
Outstanding Young Lawyer  
Award presented by the  
Young Lawyers Division

Jennie S. H. Pitts  
Jackson



Jennie Pitts received the 2012 Outstanding Young Lawyer Award. Presenting the award was Young Lawyers Division Immediate Past President Derek Arrington of Hattiesburg.

2011-2012  
50 Year  
Anniversary Members



50 Year Anniversary members attending convention were Sandy Sams, Judge Bobby Elliott, Bill Mullins, Ray Brown, and Judge Jerry Terry.

# Justice Carlson receives Chief Justice Award

Mississippi Supreme Court Presiding Justice George C. Carlson Jr. of Batesville is the recipient of the 2012 Chief Justice Award.

Mississippi Supreme Court Chief Justice Bill Waller Jr. announced the award on Friday, July 13, at the Mississippi Bar Convention in Sandestin, Fla. The annual award recognizes individuals whose work improves the judicial system.

Presiding Justice Carlson was honored for his 30 years of public service, including 11 years on the Supreme Court and 19 years as 17th District Circuit Judge, and for his leadership. Presiding Justice Carlson chairs the Supreme Court Rules Committee on Civil Practice and Procedure and the Mississippi Model Jury Instructions Commission. He became a presiding justice and a member of the court's Executive Committee in 2009.

Chief Justice Waller said that Presiding Justice Carlson "believes that there is no higher calling than that of public service, and has devoted 30 years of his life to serving the people of the state of Mississippi through his work on the bench. You see that commitment to service in the tone of his opinions, in the conduct of his personal life, and in his association with other justices, attorney and employ-



ees. He is a tireless worker who often is the first in the office and the last to leave. Yet he always makes the time to stay in touch with his home district, such as swearing in local public officials."

Chief Justice Waller, who is the only member of the Supreme Court with longer service than Presiding Justice Carlson, said that his friend and colleague's leadership and assistance in the administrative and rule-making matters of the court have been invaluable. "He has performed tremendous service far above and beyond the duties of deciding cases," Chief Justice Waller said, noting that Justice Carlson has authored more than 300 majority opinions for the court.

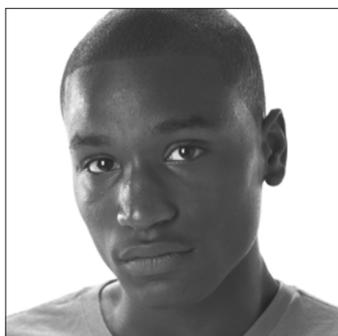
After receiving the Chief Justice

Award, Justice Carlson stated, "This indeed is an occasion I will always remember. To have my wife, our children and their spouses, and our three grandchildren in attendance made the day especially memorable for me. I am honored that Chief Justice Waller felt that I was deserving of such a prestigious award. Also, to have Whit Waide, one of my former law clerks and now a professor at Mississippi State University, in attendance to make remarks on my behalf was very meaningful as well."

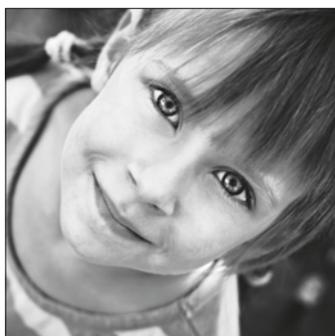
Presiding Justice Carlson was appointed to a vacancy on the Supreme Court on Nov. 1, 2001. He previously served for 19 years as a circuit judge for the 17th Circuit District of DeSoto, Panola, Tallahatchie, Tate and Yalobusha counties. He served as vice-chair of the Mississippi Circuit Judges Conference in 1998-1999, and chair of the Conference in 1999-2000.

Justice Carlson served as a member on the Governor's Criminal Justice Task Force in 1991, and as a member of the Commission on the Courts in the 21st Century 1992-1993. He served as a member of the Professionalism Committee of the Mississippi Bar 1998-1999, and as a member of the Law School Professionalism Program Task Force 1998-1999. ■

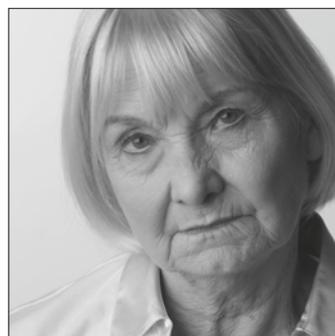
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### Phillip D. Bryant

Phillip D. Bryant, 74, of Tupelo, died February 2, 2012. A graduate of the University of Mississippi School of Law, he was admitted to practice in 1966.

### Kenneth Earl Crawford, Sr.

Kenneth Earl Crawford, Sr., 86, of Collins, died June 14, 2012. A graduate of Mississippi College School of Law, he was admitted to practice in 1972. He was retired as the Assistant Attorney General for the State of Mississippi. He also served as District Attorney for the 13th Judicial District, and as Sheriff of Covington County. He was a member of the Mount Olive Masonic Lodge. He proudly served his country in the United States Air Force during World War II.

### Arthur Dale Currie

Arthur Dale Currie, 78, of Jackson, died July 1, 2012. A graduate of the University of Mississippi School of Law, he was admitted to practice in 1962. He was a pilot in the U.S. Marine Corps where he obtained the rank of Captain.

### Sheldon Leroy Foreman

Sheldon Leroy Foreman, 83, of Franklin, TN, died May 3, 2012. A graduate of the University of Mississippi School of Law, he was admitted to practice in 1957. He proudly served for three and a half years in the U.S. Marine Corp. For over thirty years he was actively involved at St. James Episcopal Church, in Newport Beach, CA.

### Thomas Henry Freeland, III

Thomas Henry Freeland, III, 82, of Oxford, died May 10, 2012. A graduate of the University of Mississippi School of Law, he was admitted to practice in 1958. Freeland lived in Oxford for 58 years. He practiced law for more than a half century. He was a founding member and past president of the North Mississippi Chapter of the American Inns of Court. Freeland was a member of First Presbyterian Church in Oxford.

### Cecil Gillsmith Jr.

Cecil Gillsmith Jr., 83, of Natchez, died May 23, 2012. A graduate of Tulane University Law School, he was admitted to practice in 1959. Smith volunteered to go to Korea, where he earned a bronze star. Smith practiced law for over 45 years.

### James Russell Hayden

James Russell Hayden, 65, of Hattiesburg, died April 27, 2012. A graduate of the University of Mississippi School of Law, he was admitted to practice in 1973. He served in the United States Marine Corps during the Vietnam War from 1969-1971. He practiced law in Hattiesburg for 38 years.

### Dannye L. Hunter

Dannye L. Hunter, 71, of Brandon, died July 12, 2012. A graduate of the University of Mississippi School of Law, he was admitted to practice in 1965. He was a lifetime member of the Ole Miss Alumni Association. Hunter served in numerous official capacities Youth Court Judge, County Attorney, State Bar Commissioner, Governor of Mississippi Trial Lawyers Association, Member of the Bar's Specialization and Certification Committee, President of the Scott County Bar Association, Assistant District Attorney and District Attorney for the Eighth Judicial District of Mississippi and Chancery Judge for the Second Judicial District of Mississippi. He was a member of the First Baptist Church of Forest. He also served in the Mississippi National Guard.

### Jack Brooks Lacy Jr.

Jack Brooks Lacy, Jr., 69, of Brandon, died June 29, 2012. A graduate of the University of Mississippi School of Law, he was admitted to practice in 1984. He taught at the University for fourteen years. He practiced law as a government attorney.

### Paul Richard Lambert

Paul Richard Lambert, 60, of Gulfport, died July 23, 2012. A graduate of the University of Mississippi School of Law, he was admitted to practice in 1975. Lambert set up his law practice in Hattiesburg. He represented his city for three terms as Hattiesburg's District 45 state senator in the Mississippi State Senate. While there, Lambert served as Chairman of the Senate Finance, Judiciary and Municipalities Committees. He also served on the Senate Public Utilities Committee his entire tenure in the Senate and served as Vice-Chairman for four years. He was also appointed City Attorney for the City of Hattiesburg for seven years. In addition to Atmos Energy Corporation, Lambert was general counsel to the Mississippi Rural Independent Telephone Companies and legal counsel to the President of The University of Southern Mississippi. In June 2012, Lambert was appointed by Governor Phil Bryant to the Judicial Appointment Advisory Committee to represent the Second Supreme Court District. Lambert was a member of Broad Street United Methodist Church in Hattiesburg, where he was a Sunday school teacher and lay leader. He was a charter member of Heritage United Methodist Church. Since residing in Gulfport, he has been a member of Trinity United Methodist Church in Gulfport.

### James Franklin Mixson

James Franklin Mixson, 61, of Greenville, died April 5, 2012. A graduate of Mississippi College School of Law, he was admitted to practice in 1978. He was a member of the Kappa Alpha Order. Mixson practiced law for thirty-five years.

*Continued on next page*

## IN MEMORIAM

### Thomas A. Pritchard

Thomas A. Pritchard, 62, of Ocean Springs, died May 5, 2012. A graduate of the University of Mississippi School of Law, he was admitted to practice in 1974. He resided on the Gulf Coast since 1974. He played baseball for the University of Florida. He practiced law in Biloxi.

### Gertrude S “Trudy” Reid

Gertrude S. “Trudy” Reid, 84, of Corinth, died March 31, 2012. A graduate of the University of Arkansas School of Law, she was admitted to practice in 1972. She was the City Judge in Biloxi; the President of the Mississippi Mental Health Association and Chairman of the Women Republican National Committee in Washington DC. She was in law practice in Corinth. She was a member of The Church of Jesus Christ of Latter Day Saints.

### George Benjamin Taylor

George Benjamin Taylor, 79, of Hattiesburg, died July 9, 2012. A graduate of the University of Mississippi School of Law, he was admitted to practice in 1960. He served in the U.S. Army during the Korean Conflict. Taylor served in the Mississippi Legislature

as a representative from Noxubee County, worked as a judge for Workman’s Compensation in MS, received an appointment by President Richard Nixon to be a federal administrative law judge in 1973 where he served on the bench until his retirement in 1998. He was a member of the Ole Miss Alumni Association and Ole Miss Loyalty Foundation. He was a 32nd Degree Mason and was a member of Main Street United Methodist Church.

### Charles Royal White

Charles Royal White, 78, of Jackson, died April 23, 2012. A graduate of Mississippi College School of Law, he was admitted to practice in 1962. He joined the US Air Force as a second lieutenant. White was trained as a navigator/bombardier in the Air Force. After discharge, White returned to Jackson. While maintaining a law practice, he became a principal with the White Systems Savings and Loan Association, becoming CEO when the company became a separate entity. Upon obtaining a Federal Charter in 1975, the other parts of the business were renamed Consumer National Bank and he served as a Vice President of the bank, becoming its Chairman and CEO in 1991 until its merger with State Bank and Trust Company in 2005. White also served as president of the Mississippi Consumer Finance Association. White was a founding member of Lakeland Presbyterian Church.

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# LAWYERS HELPING LAWYERS

## Calling LJAP; What It Is And What It Isn't

Unfortunately and far too often I've heard the refrain, "I thought about calling you about (Insert possibly impaired attorney's name here), but I didn't want to get him in trouble." I've heard it from well-intentioned people in many, if not all, areas in and around or state; attorneys, judges, family members, law school personnel, law students, attorneys' staffs, the list goes on and on. When I hear this phrase in the aftermath of career or life altering events, "unfortunately" becomes "tragically". Given this recurring misconception, after a recent conversation with LJAP volunteers, I was encouraged to use this article as an opportunity to address just what a call to LJAP "IS", and possibly more importantly what it "IS NOT".

A call to LJAP is a call for assistance. When you contact LJAP, whether you are calling for yourself or a colleague, you are initiating the process by which LJAP staff and volunteers attempt to offer assistance to an attorney, judge, or law student who may be suffering with some sort of impairment. Men and women working in the legal profession suffer from addiction and/or other mental illness at a rate roughly twice that of the general population. It stands to reason

that you or someone you know is or will be dealing with these issues. You are in a position to help by bringing concerns to our attention. Our "broad brush" program is here to assist persons who are struggling with any form of impairment ranging from life stressors to situational anxiety or depression, substance abuse or addiction, or clinical mental health disorders. LJAP offers confidential assessment and referral services, as well as case management and/or monitoring after initial treatment is completed.

When you contact LJAP regarding a colleague, LJAP staff and volunteers will honor your request to remain anonymous if you choose. However, it is important to note that initial LJAP overtures attributed to concerns raised by an unnamed source are often unwelcome and/or met with denial and suspicion.

A Call to LJAP IS NOT a call to the Office of General Counsel (OGC). As a caller, you ARE NOT placing someone's license in jeopardy. You are not initiating a disciplinary inquiry or the Bar complaint process. There is no communication between LJAP and the OGC unless or until a client specifically authorizes such contact.

In some circumstances, you may have suspicions or knowledge that an attorney's conduct may have breached his or her ethical obligations. Mentioning such conduct will not result in an LJAP report to OGC. Moreover, you should know that if you feel you may have an obligation to report an attorney's actions or inactions under MRD 8.3, your call to LJAP does not satisfy that obligation. Again, LJAP is about assistance not discipline.

I hope and trust that the foregoing serves to alleviate concerns about contacting LJAP for yourself or someone you know. I hope that the next time you ask yourself, "I wonder if I should call LJAP", you will respond, "Yes I should, and I will." If you believe that you or someone you know needs assistance, you should call. If an attorney, in your Court or in your community, appears to be having problems, you should call. If you're concerned, but not sure, you should call. If you have a general question related to impairment, you should call. It's YOUR LJAP, and we look forward to being of service. ■

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# CLE Calendar of Events

The following live programs have been approved by the Mississippi Commission on Continuing Legal Education. This list is not all-inclusive. For information regarding other programs, including teleconferences and online programs, contact Tracy Graves, CLE Administrator at (601) 576-4622 or 1-800-441-8724, or check out our website, [www.mssc.state.ms.us](http://www.mssc.state.ms.us) Mississippi now approves **online programs** for CLE credit. For a list of approved courses, check the Calendar of Events on our website. For information on the approval process for these programs, please see Regulations 3.3 and 4.10 posted under the CLE Rules on our website or contact Tracy Graves at the numbers listed above.

## SEPTEMBER

- 11 NBI "Land Use Law: Current Issues in Subdivision, Annexation & Zoning." 6.0 credits. Jackson, MS, Jackson Convention Complex. Contact 715-835-8525.
- 13-14 UM CLE "Basic Mediation Skills Training." 14.0 credits (includes ethics). Oxford, MS, Yerby Conference Center. Contact 662-915-7283.
- 14 MC School of Law "Social Security Disability Practice." 6.0 credits (includes ethics). Jackson, MS, MC School of Law. Contact 601-925-7107, Tammy Upton.
- 21 UM CLE "Family Law Update." 6.0 credits (includes ethics). Greenwood, MS, Alluvian Hotel. Contact 662-915-7283.
- 27 MC School of Law "The Mary Libby Payne Annual Seminar Series." 3.0 credits. Jackson, MS, MC School of Law. Contact 601-925-7107, Tammy Upton.

## OCTOBER

- 11-12 UM CLE "Advanced Mediation Skills Training." 14.0 credits (includes ethics). Oxford, MS, Yerby Conference Center. Contact 662-915-7283.
- 11 Halfmoon LLC "Mississippi Land Boundaries and Access Rights." 6.5 credits. Jackson, MS. Contact 715-835-5900.
- 26 UM CLE "DUI Defenders' CLE Seminar." 6.0 credits (includes ethics). Bay St. Louis, MS, Hollywood Hotel. Contact 662-915-7283.

## NOVEMBER

- 1 Sterling Education Services, Inc. "Landlord-Tenant Law." 6.7 credits (includes ethics). Biloxi, MS. Contact 715-855-0495.
- 2 MC School of Law "14th Annual Guardian Ad Litem Training." 6.0 credits (includes ethics). Jackson, MS, MC School of Law. Contact 601-925-7107, Tammy Upton.
- 3 U.S. District Court/Northern District of Mississippi "Fifth Annual Bench & Bar Seminar." 4.0 credits (includes ethics). Oxford, MS, The Inn at Ole Miss. Contact 662-234-1971, Gina Kilgore.
- 9 MC School of Law "Mediation Conference." 7.0 credits (includes ethics). Jackson, MS, MC School of Law. Contact 601-925-7107, Tammy Upton.
- 9 UM CLE "Law Office Management." 6.0 credits (includes ethics). Ridgeland, MS, Embassy Suites. Contact 662-915-7283.
- 9 Sterling Education Services, Inc. "Landlord-Tenant Law." 6.7 credits (includes ethics). Jackson, MS. Contact 715-855-0495.

## DECEMBER

- 3-4 UM CLE "CLE by the Hour." 12.0 credits (includes ethics). Memphis, TN, Hilton Hotel. Contact 662-915-7283.

## JANUARY

- 24 UM CLE "Winter MS Municipal Attorneys' Seminar." 6.0 credits (includes ethics). Jackson, MS, Hilton Hotel. Contact 662-915-7283.

- 25 UM CLE "Social Security Disability Law." 6.0 credits (includes ethics). Ridgeland, MS, Embassy Suites. Contact 662-915-7283.

## FEBRUARY

- 8 UM CLE "19th Annual Mid-South Conference on Bankruptcy Law." 6.0 credits (includes ethics). Memphis, TN, Doubletree Hotel. Contact 662-915-7283.
- 8 E. Farish Percy "Summary of Recent Mississippi Law." 6.0 credits (includes ethics). Oxford, MS, The Inn at Ole Miss. Contact 662-832-8605, E. Farish Percy.
- 22 E. Farish Percy "Summary of Recent Mississippi Law." 6.0 credits (includes ethics). Biloxi, MS, The Imperial Palace Hotel & Casino. Contact 662-832-8605, E. Farish Percy.

## MARCH

- 1 UM CLE "13th Annual Guardian Ad Litem Certification CLE Seminar." 6.0 credits (includes ethics). Ridgeland, MS, Embassy Suites. Contact 662-915-7283.
- 1 E. Farish Percy "Summary of Recent Mississippi Law." 6.0 credits (includes ethics). Jackson, MS, Jackson Convention Complex. Contact 662-832-8605, E. Farish Percy.

## MAY

- 3-4 UM CLE "Mississippi Law Update." 12.0 credits (includes ethics). Natchez, MS, Monmouth Plantation. Contact 662-915-7283.

*Save the Date ...*



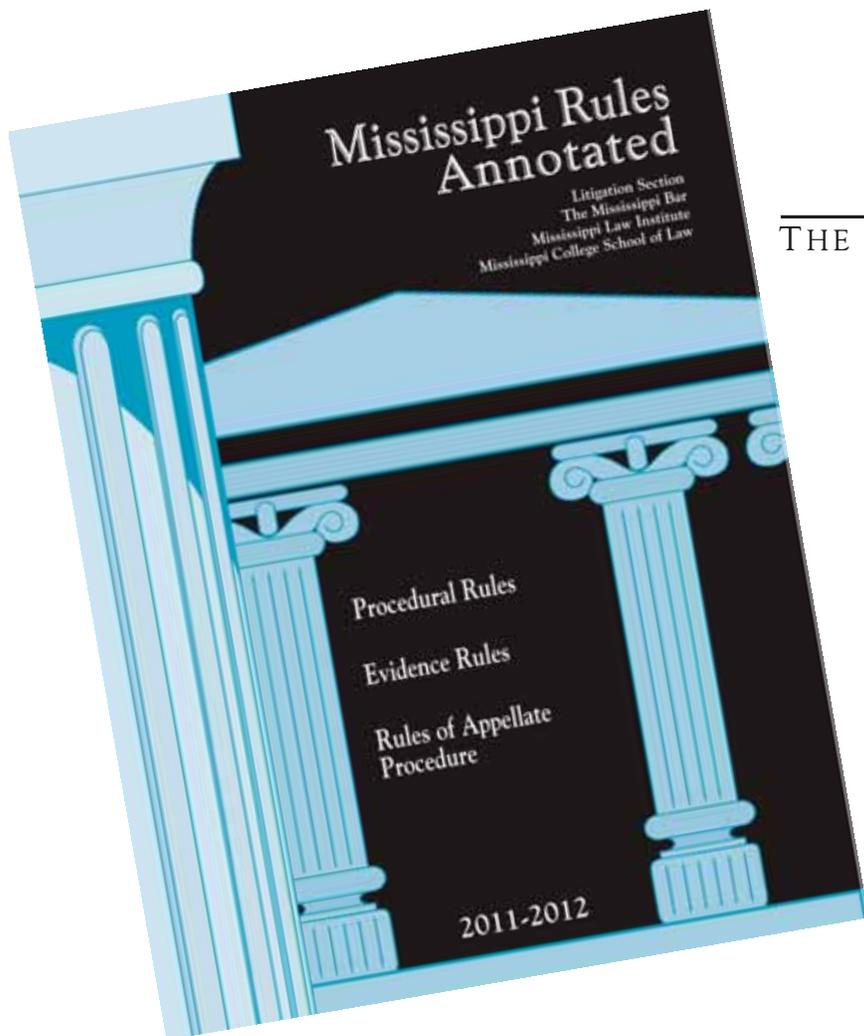
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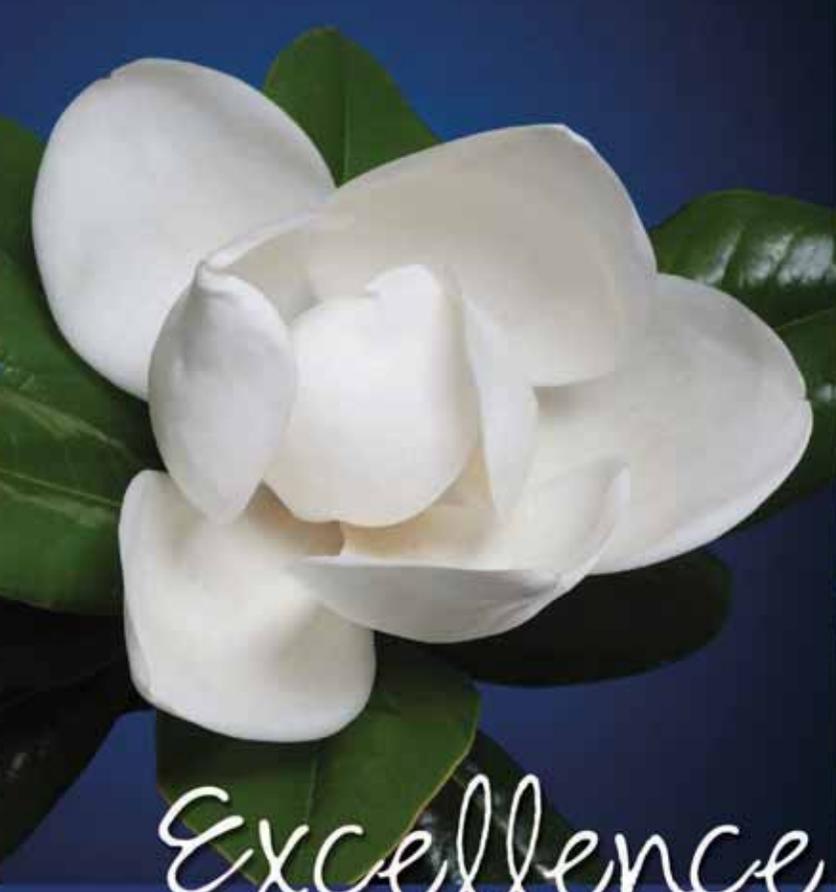
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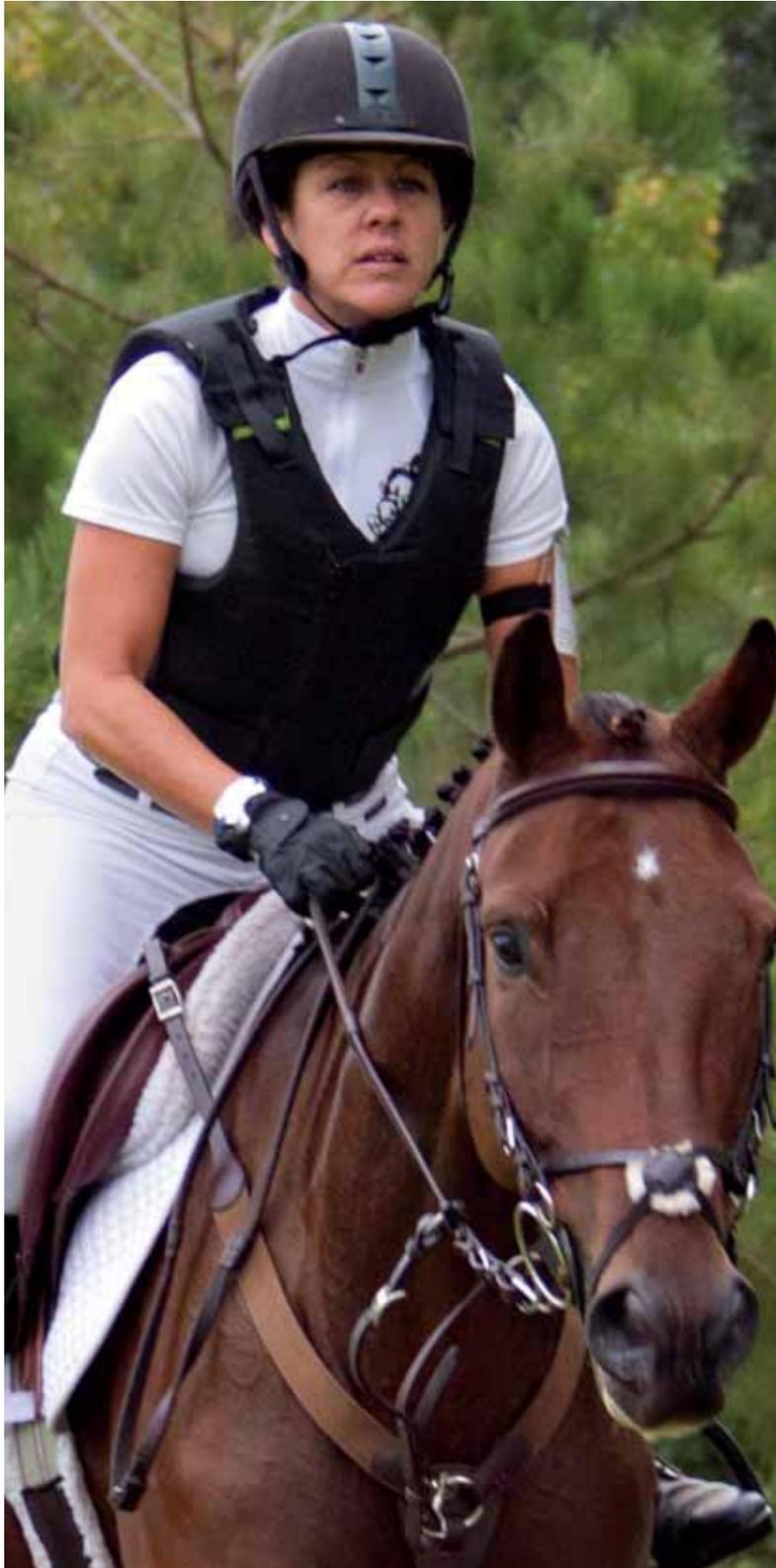
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