

THE

# ALABAMA LAWYER

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▲  
**The Human Touch:  
Copyright Challenges in the Age of AI**  
Page 70

▲  
**IP Protection: Common Mistakes and  
How to Avoid Them**  
Page 76

▲  
**Patent Issues for the Non-Patent Lawyer**  
Page 83

**THE INTELLECTUAL PROPERTY ISSUE**





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Paralegals .....73

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Apollo Counseling .....65

Attorneys Insurance Mutual  
Of the South.....54

Cain & Associates Engineers.....71

Davis Direct .....74

J. Forrester DeBuys, III.....75

The Finklea Group, Inc.....67

Hilton Sandestin .....63

Insurance Specialists, Inc.....108

LawPay.....107

National Academy of  
Distinguished Neutrals.....59

Redding Crash  
Reconstruction LLC .....69

Schreiber ADR.....105



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## On The Cover

Azaleas blooming at Lake Martin, Tallapoosa County, Alabama

## FEATURE ARTICLES

### THE INTELLECTUAL PROPERTY ISSUE

#### The Human Touch: Copyright Challenges in the Age of AI

*By Benjamin P. Mayer*

70

#### IP Protection: Common Mistakes and How to Avoid Them

*By Rudy Hill and Jake Gipson*

76

#### Patent Issues for the Non-Patent Lawyer

*By Joe Bird*

83

#### Alabama State Bar 2023 Admittees

88

#### President's Page

60

#### President-Elect Profile

62

#### Executive Director's Report

64

#### Editor's Corner

66

#### Important Notices

68

#### Memorials

95

#### Opinions of the General Counsel

98

#### The Appellate Corner

100

#### Disciplinary Notices

104

#### About Members, Among Firms

106

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## P R E S I D E N T ' S   P A G E

Brannon J. Buck  
*bbuck@badhambuck.com*



# ADVERSIVILITY: Are We Up to the Challenge?

**Adversivility.** noun. (ad-vər-'sə-'vi-lə-tē):

- (1) adeptness at treating others in a respectful manner during confrontation;
- (2) the ability to remain civil in an adversarial situation.

What's your level of adversivility? Do you allow anger to dominate your reactions in a tense encounter with an opposing lawyer? Do you use intimidation tactics or threats that would disappoint your sweet grandmother? Are you a keyboard warrior, using language in emails that you would never utter to a person's face? Or are you calm and level-headed – using your intellect, your mastery of the law and the facts, and your persuasive skills to effectively represent your clients while being civil and collegial toward your adversary?

Adversivility – it's a word we don't use enough. Our profession, like no other, holds a tension between confrontation and collegiality. We are duty bound to provide zealous representation to our clients and, at the same time, conduct ourselves with professionalism. No word captures the challenge quite like adversivility.

Ok ... it's not a word. But it should be. Because as a profession, we have long struggled to find a healthy balance between fierce advocacy and civility. In meetings throughout the state this year, we have asked lawyers to raise their hands if they have experienced incivility from another attorney in the last six months. Invariably, well



more than half the hands in the room go up. None of us needs convincing that combative interactions create anxiety, and it comes as no surprise anymore that we have a mental health crisis. Recent studies show that 71 percent of lawyers struggle with anxiety.<sup>1</sup> There is a direct connection between incivility and anxiety.

In Alabama, we have a proud history of being a collegial bar, but it requires effort and regular reinforcement to maintain that culture. Thirty years ago, some thoughtful lawyers drafted a Code of Professional Courtesy and a Lawyers' Creed for our bar. They are well written, well intentioned, and probably even more relevant to us today than they were when our board of bar commissioners approved them on April 10, 1992. If you are like me, you were not aware of them. They exist on the bar's website but have been largely forgotten or ignored by many of us. I reprint these valuable statements of principle here because we could use a refresher:

## Code of Professional Courtesy

1. A lawyer should never knowingly deceive another lawyer.
2. A lawyer must honor promises and commitments made to another lawyer.
3. A lawyer should make all reasonable efforts to schedule matters with opposing counsel by agreement.
4. A lawyer should maintain a cordial and respectful relationship with opposing counsel.
5. A lawyer should seek sanctions against opposing counsel only where required for the protection of the client and not for mere tactical advantage.
6. A lawyer should not make unfounded accusations of unethical conduct about opposing counsel.
7. A lawyer should never intentionally embarrass another lawyer and should avoid personal criticism of another lawyer.

8. A lawyer should always be punctual.
9. A lawyer should seek informal agreement on procedural and preliminary matters.
10. When each adversary proceeding ends, a lawyer should shake hands with the fellow lawyer who is the adversary; and the losing lawyer should refrain from engaging in any conduct which engenders disrespect for the court, the adversary or the parties.
11. A lawyer should recognize that adversaries should communicate to avoid litigation and remember their obligation to be courteous to each other.
12. A lawyer should recognize that advocacy does not include harassment.
13. A lawyer should recognize that advocacy does not include needless delay.
14. A lawyer should be ever mindful that any motion, trial, court appearance, deposition, pleading or legal technicality costs someone time and money.
15. A lawyer should believe that only attorneys, and not secretaries, paralegals, investigators or other non-lawyers, should communicate with a judge or appear before the judge on substantive matters. These non-lawyers should not place themselves inside the bar in the courtroom unless permission to do so is granted by the judge then presiding.
16. A lawyer should stand to address the court, be courteous and not engage in recrimination with the court.
17. During any court proceeding, whether in the courtroom or chambers, a lawyer should dress in proper attire to show proper respect for the court and the law.
18. A lawyer should not become too closely associated with a client's activities, or emotionally involved with a client.
19. A lawyer should always remember that the purpose of the practice of law is neither an opportunity to make outrageous demands upon

vulnerable opponents nor blind resistance to a just claim; being stubbornly litigious for a plaintiff or a defendant is not professional.

## Lawyers' Creed

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 reconciliation and, if we fail, 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 welfare. I will strive to make our association a professional friendship.

To the profession, I offer assistance. 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 the representation of my clients.

Unlike our Rules of Professional Conduct, there is no enforcement mechanism for the Code of Professional Courtesy or the Lawyers' Creed. But they are not merely aspirational. They are achievable. We just have to make the effort. Thirty years ago, a generation of lawyers re-committed our bar to the work of professionalism. Are we up to the challenge today?

Choose Civility – Adversivility. ▲

## Endnote

1. *ALM 2021 Mental Health and Substance Abuse Survey*, The American Lawyer (May 3, 2021, 5:00PM), <https://www.law.com/americanlawyer/2021/05/03/the-legal-industrys-mental-health-problem-grew-in-2020-our-survey-shows/>.

*Pursuant to the Alabama State Bar's Rules Governing the Election of President-Elect, the following biographical sketch is provided of Frederick G. Helmsing, Jr., who was the sole qualifying candidate for the position of president-elect of the Alabama State Bar for the 2024-2025 term and will assume the presidency in 2025.*

## Frederick G. Helmsing, Jr.

Fred Helmsing is a 1996 graduate of the University of Alabama School of Law and a 1993 graduate of Washington & Lee University. He has a civil and criminal trial practice based in Mobile, focusing on white-collar criminal defense, complex commercial, and product liability litigation. Fred practiced with the McDowell Knight firm in Mobile and its predecessor for more than 27 years. He is admitted to practice before all state and federal courts in Alabama.



*Helmsing*

Fred frequently represents clients in connection with accusations of bank fraud, mail fraud, conspiracy, and criminal anti-competitive activity. He routinely handles complex commercial litigation and regularly counsels clients regarding these matters outside the scope of formal litigation in matters involving multi-party contract disputes, procurement disputes, shareholder disputes, derivative litigation, corporate, and partnership disputes. He also has extensive experience representing both manufacturers and distributors throughout Alabama and regionally in cases involving a variety of products, including prescription and over-the-counter drugs, medical devices and products, consumer products, specialty products, agricultural and industrial equipment, and toxic substances.

For the past nine years, Fred has served on the Board of Bar Commissioners, including two terms of service on the Executive Council, and is chair of the Finance & Audit Committee. He has also served on the Mobile Bar Association Executive Committee for more than 10 years.

Fred is a member of the American Bar Association, the Product Liability Advisory Council, the Alabama Defense Lawyers Association, and the DRI. He is married to Greer Megginson Helmsing, and they have three children: Sara Margaret Helmsing, Frederick G. Helmsing, III, and Joseph Greer Helmsing. ▲



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## EXECUTIVE DIRECTOR'S REPORT

Terri Lovell  
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March is recognized as Women's History Month – a month dedicated to celebrating the contributions and achievements of women. This month, it is fitting that we give special recognition to the Alabama State Bar's Women's Section, who just wrapped up a big celebration of its own – the section's 25<sup>th</sup> anniversary.

With a gala, a service project, and a brunch honoring female judges as well as lawyers who've practiced for 50 years or more, members of the section did a fantastic job marking this milestone anniversary.

I enjoyed hearing stories from those whose work led to the inception of the section. Celia Collins, who served as the co-chair of the Alabama State Bar's Committee on Women in the Profession in 1996, offered her personal recollections and research to put together the history of how the section was formed.

As she explained, their work began during the bar's annual meeting in the summer of 1993. Seeing a lack of women in attendance, several women approached newly-elected bar President Spud Seale, who decided to appoint a Task Force on Women in the Profession to review what the state bar could do to better serve its women members.



The task force became a standing committee, and by 1999, it was officially approved by the board of bar commissioners as a section, and retired Judge Caryl Privett served as the founding chair. Not long thereafter, I attended my first Women's Section event, an overnight trip to Monroeville to experience the production of *To Kill a Mockingbird* on the historic courthouse grounds. The friendships I made on that trip have carried forward with me to this day.

I commend the past and present leaders of the Women's Section for all they have done to pave the way for the next generation of female attorneys. Those same mentoring and networking components were key elements in the formation of all our Alabama State Bar sections. And I encourage you, like the founders of the Women's Section did in 1993, to step up when you see a need, and let us know how the Alabama State Bar can better serve you. ▲

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## EDITOR'S CORNER

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Welcome to the intellectual property edition of *The Alabama Lawyer*.

We are always looking for themes that we either haven't previously covered, or for themes that can be covered in a fresh way. And when we find those themes, we work pretty hard to present them in a way that we hope you will find both interesting and useful. We trust that you'll agree that we've climbed both mountains with this edition.

Rudy Hill functioned as our edition editor. Over an excellent lunch at a small barbeque place near my office, he suggested the topic. He then roped in the authors and did an enormous amount of work helping put together this issue. And he co-authored one of the articles. Rudy, we all appreciate your hard work.

So, let's see what we have.

We open with Benjamin Mayer's "The Human Touch: Copyright Challenges in the Age of AI" (**page 70**). Could any topic be hotter than artificial intelligence? I suspect this article will get lots of eyes on it just for the sake of curiosity. Who knew that artificial intelligence would cause us to turn to the topic of copyrights? Our author did, and we are all the better off for it.

Rudy Hill and Jake Gipson begin their article, "IP Protection: Common Mistakes and How to Avoid Them," with an interesting tactic – they define their topic by telling us what it's not (**page 76**). From there, they show us the differences between patents, trademarks, and copyrights, their stated goal being to help all




of us avoid some common pitfalls. After I read it, I felt like they achieved their goals. Even if you don't plan on becoming a patent or a trademark specialist, you will certainly be asked questions about the subjects, and you just never know when a working knowledge will come in handy. Rudy and Jake do a great job helping us out.

We close with Joe Bird. Joe's article is of the sort that is near and dear to my heart, written for everyone to read, not just specialists. I even like his title: "Patent Issues for the Non-Patent Lawyer" (page 83). If you've ever felt the need to grab the topic of patents by the horn, here is your chance. After spending a few minutes with Joe, I felt like I had at least a preliminary grasp on a tough topic.

I hope you enjoy this issue as much as we enjoyed putting it together for you.

And just wait until you see what we have for you next time.

So, enjoy the articles. Email me at [wguard@mindspring.com](mailto:wguard@mindspring.com) if you have questions, or comments, or want to write. We are always looking for our next group of excellent writers. ▲



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## IMPORTANT NOTICES

### ▲ Notice of Election and Electronic Balloting

### ▲ Notice of and Opportunity for Comment on Amendments to The Rules of the United States Court of Appeals for the Eleventh Circuit

## Notice of Election and Electronic Balloting

Notice is given here pursuant to the Alabama State Bar Rules Governing Election and Selection of President-elect and Board of Bar Commissioners that the election of these officers will be held beginning Monday, May 20, 2024, and ending Friday, May 24, 2024.

On the third Monday in May (May 20, 2024), members will be notified by email with instructions for accessing an electronic ballot. Members who wish to vote by paper ballot should notify the secretary in writing on or before the first Friday in May (May 3, 2024) requesting a paper ballot. A single written request will be sufficient for all elections, including run-offs and contested president-elect races during this election cycle. All ballots (paper and electronic) must be voted and received by the Alabama State Bar by 5:00 p.m. on the Friday (May 24, 2024) immediately following the opening of the election.

### Nomination and Election of President-Elect

Candidates for the office of president-elect shall be members in good standing of the Alabama State Bar as of February 1, 2024 and shall possess a current privilege license or special membership. Candidates must be nominated by petition of at least 25 Alabama State Bar members in good standing. Such petitions must be filed with the secretary of the Alabama State Bar no later than 5:00 p.m. on February 1, 2024.

### Nomination and Election of Board of Bar Commissioners

Bar commissioners will be elected by those lawyers with their principal offices in the following circuits:

**2nd Judicial Circuit**

**4th Judicial Circuit**

**6th Judicial Circuit, Place 2**

**9th Judicial Circuit**

**10th Judicial Circuit, Place 1**

**10th Judicial Circuit, Place 2**

**10th Judicial Circuit, Place 5**

**10th Judicial Circuit, Place 8**

**10th Judicial Circuit, Place 9**

**12th Judicial Circuit**

**13th Judicial Circuit, Place 2**

**15th Judicial Circuit, Place 2**

**15th Judicial Circuit, Place 6**

**16th Judicial Circuit**

**18th Judicial Circuit, Place 2**

**20th Judicial Circuit**

**23rd Judicial Circuit, Place 2**

**23rd Judicial Circuit, Place 4**

**24th Judicial Circuit**

**27th Judicial Circuit**

**29th Judicial Circuit**

**38th Judicial Circuit**

**39th Judicial Circuit**



# Notice of and Opportunity for Comment on Amendments To the Rules of the United States Court of Appeals for The Eleventh Circuit

Pursuant to 28 U.S.C. § 2071(b), notice and opportunity for comment is hereby given of proposed amendments to the Rules of the United States Court of Appeals for the Eleventh Circuit. The public comment period is from Wednesday, April 3, to Friday, May 3, 2024.

A copy of the proposed amendments may be obtained on and after Wednesday, April 3, 2024, from the court's website at <http://www.ca11.uscourts.gov/rules/proposed-revisions>. A copy may also be obtained without charge from the Office of the Clerk, U.S. Court of Appeals for the Eleventh Circuit, 56 Forsyth St., NW, Atlanta 30303 Phone (404) 335-6100.

Comments on the proposed amendments may be submitted in writing to the Clerk at the above address, or electronically at <http://www.ca11.uscourts.gov/rules/proposed-revisions>, no later than Friday, May 3, 2024. ▲

Additional commissioners will be elected for each 300 members of the state bar with principal offices therein. New commissioner positions for these and the remaining circuits will be determined by a census on March 1, 2024, and vacancies certified by the secretary no later than March 15, 2024. All terms will be for three years.

A candidate for commissioner may be nominated by petition bearing the signatures of five members in good standing with principal offices in the circuit in which the election will be held or by the candidate's written declaration of candidacy. Nomination forms and/or declarations of candidacy must be received by the secretary no later than 5:00 p.m. on the last Friday in April (April 26, 2024).

## Submission of Nominations

Nominating petitions or declarations of candidacy form, a high-resolution color photograph, and biographical and professional data of no more than one 8 ½ x 11 page and no smaller than 12-point type must be submitted by the appropriate deadline and addressed to Secretary, Alabama State Bar, P.O. Box 671, Montgomery, AL 36101-0671.

## Election of At-Large Commissioners

At-large commissioners will be elected for the following place numbers: **1, 3, 4, and 7**. Petitions for these positions, which are elected by the Board of Bar Commissioners, are due by April 1, 2024. All terms will be for three years.

## Submission of At-Large Nominations

Nominee's application outlining, among other things, the nominee's bar service and other related activities must be submitted by the appropriate deadline and addressed to Executive Council, Alabama State Bar, P.O. Box 671, Montgomery, AL 36101-0671.

All submissions may also be sent by email to [elections@alabar.org](mailto:elections@alabar.org).

It is the candidate's responsibility to ensure the executive council or secretary receives the nomination form by the deadline.

Election rules and petitions for all positions are available at <https://www.alabar.org/board-of-bar-commissioners/election-information/>.

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# The Human Touch: Copyright Challenges in the Age of AI

*By Benjamin P. Mayer*

## A Google search of “What AI thinks Americans from each state look like”

can yield some interesting results. Numerous people have used artificial intelligence tools to generate output images of Americans from each state, and the images of what AI thinks about Alabama are pretty much what one would expect: stereotypical, offensive, hilarious and/or accurate, depending on how you feel about the state.

We’ve all seen many of these images being used for monetary gain as well. These days, it is easy enough to copy and paste a cartoon-y AI output image of an Alabama yokel, slap a caption on it, and sell it online for profit.

Should you be required to pay royalties for using that image? If so, who owns the copyright on an image not “authored” by a human? With the use of AI on a meteoric rise and, seemingly, infiltrating countless aspects of our lives, the need for guidance in anticipation of regulation is a constant. The Congressional Research Service



issued a Legal Sidebar report summarizing issues and opinions pertaining to this topic.<sup>1</sup>

But first, a bit of background on copyright law is warranted. The federal government provides copyright protection for original works of authorship to the authors of such works. This form of intellectual property allows artists, authors, and creators to publicize and distribute their creative works to the public without fear of interference by infringement and piracy. Copyright exists to incentivize creation of works that benefit the public. The holder of copyright protection over a work has the power to capitalize on the economic value of the work through authorization of certain uses of that work (i.e., licensing). Indeed, the framers of the constitution believed promotion of the arts was important enough to grant authors and inventors “the exclusive Right to their respective Writings and Discoveries.”<sup>2</sup>

The subject matter protected by copyright generally, extends to literary works, music, dramatic works, pictorial and graphic works, sculptures, songs, and even architecture, just to name a few. The protection lasts for the life of the author plus 70 years for works created after January 1, 1978. What copyright protection does not protect are ideas, methods of operation, principles, and concepts, such as a scientific method or a recipe. There is also no copyright protection for names, titles, and slogans because they contain an insufficient amount of authorship. There lies one of the differences between

copyright and trademark: Trademark protects words, phrases, and designs that identify goods and services.

For example, about a decade ago, Dominique Ansel became a viral sensation when his bakery started selling the Cronut, a cross between a doughnut and a croissant. Ansel obtained trademark protection for the word “Cronut” but cannot obtain copyright protection for the process of making the cronut. He would be able to copyright the recipe in the limited sense of protecting the exact pattern of words that make up the recipe, but not the underlying facts or the list of ingredients, generally. (He might consider keeping it confidential and maintaining it as a trade secret, however).

Once upon a time, the author of such a work was required to apply for copyright registration to receive such protection. As of the date of this writing, however, copyright protection exists as soon as the work of authorship is “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>3</sup> While it is still a good idea to apply for federal registration, such registration is not a requirement for an author to publish a work with that familiar symbol we’ve all seen before: ©.

But we are in uncharted waters when it comes to how to apply this scope of protection to works generated by AI. The White House issued an “Executive Order on the

Safe, Secure, and Trustworthy Development and Use of Artificial Intelligence” on October 30, 2023, which provided very little, if any, guidance on the relationship between AI and copyright law.<sup>4</sup> The U.S. Copyright Office (“the Office”) is still trying to make heads or tails of these new developments as well. On August 30, 2023, the Office issued a notice of inquiry stating that it is “undertaking a study of the copyright law and policy issues raised by generative AI and is assessing whether legislative or regulatory steps are warranted.”<sup>5</sup> Regardless of the order of priority, issues concerning the relationship

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between AI and the scope of intellectual property protection are on the rise. As such, it will largely be up to the courts to set standards in the coming years.

For now, the best we can do is handle one issue at a time. This article will focus on a recent case that may, hopefully, get us a little closer to defining how AI relates to one of the most basic elements of copyright law: authorship. The case to be discussed is *Stephen Thaler v. Shira Perlmutter and The United States Copyright Office* (1:22-cv-01564) (June 2, 2022). Dr. Thaler attempted to register a copyright for an AI-generated work titled “A Recent Entrance to Paradise,” an image depicting a flowery tunnel entrance that vaguely resembles the style of a classic Monet painting. The Office denied the application on the basis that the work “lacks the human authorship necessary to support a copyright claim” and further stated that Dr. Thaler was not entitled to apply for registration because he listed AI as the author and himself as the owner.<sup>6</sup> In fact, it was not just “AI” that was listed as the author; the author was listed as the “Creativity Machine,” an algorithm Dr. Thaler developed for generating images. Essentially, since Dr. Thaler wrote the code that generated the image, he listed himself as the owner of the copyright because his algorithm generated the image in the capacity of a pseudo-employee under the “work made for hire” doctrine, which essentially says that, when a work is “made for hire” and certain other conditions are met, the author is not the person who created the work, but rather the person who hired the individual who created the work.<sup>7</sup>

## When the Office denied his first request for reconsideration, Dr. Thaler filed a second request for reconsideration in which he argued that the Office’s requirement that the author of a work be human was both unconstitutional and unfounded in precedent.<sup>10</sup>

Dr. Thaler’s initial application for copyright protection was met with resistance. The Office refused to register the work, stating in support thereof that “this work . . . lacks the human authorship necessary to support a copyright claim.”<sup>8</sup> When a work is denied copyright registration, that decision may be reviewed for reconsideration.<sup>9</sup> Dr. Thaler decided the best course of action in his request for reconsideration was to come out swinging.

Dr. Thaler never attempted to name himself or any other “human” as the author of the work. Instead, he always confirmed that the work was generated by AI and lacked “traditional human authorship” in recognition of the standard that the Office applies when reviewing applications. When the Office denied his first request for reconsideration, Dr.

Thaler filed a second request for reconsideration in which he argued that the Office’s requirement that the author of a work be human was both unconstitutional and unfounded in precedent.<sup>10</sup> He further argued that the “work made for hire” doctrine applies to AI-generated works because it recognizes companies as authors.<sup>11</sup>

At this point, I feel that it is important to briefly switch to future tense for dramatic effect and discuss the standard that Dr. Thaler will have to satisfy to prevail. Dr. Thaler’s second request for reconsideration will be examined by a three-member Review Board of the U.S. Copyright Office (“the Board”). For Dr. Thaler to prevail, he must either provide evidence that the work is the product of human authorship or convince the Board to depart from a century of copyright jurisprudence. All parties agree that the work is not the product of human authorship, so there is no need to discuss that requirement. All that is left is to convince the Board to abandon everything they know and believe about human authorship that has been established since the inception of our nation’s copyright laws. No pressure.

Assuming the above subtle foreshadowing was not obvious enough, the Board denied Dr. Thaler’s second request for reconsideration. In response to Dr. Thaler’s constitutional argument, the Board explained that human authorship is an essential element of copyright protection.<sup>12</sup> The Board bolstered their argument with support from the Ninth Circuit and the Compendium,<sup>13</sup> which show consistent findings that works derived from non-human



expression are not the kind of works copyright laws were intended to protect.<sup>14</sup>

The Board then discussed the impact of computing technology on copyright.<sup>15</sup> In 1978, the National Commission on New Technological Uses of Copyrighted Works (“CONTU”) concluded that the laws requiring human authorship did not need to be amended and that judicial construction was sufficient to enable protection for works created with the use of a computer. It is essentially the same conclusion that one can obtain copyright on a work generated using a camera. Photographs are entitled to copyright protection because the photographer makes decisions regarding creative elements.<sup>16</sup> However, in order to obtain copyright on a photograph, the camera must still be used by a *human*: “These court decisions are reflected in the Office’s guidance in the *Compendium*, which provides examples of works lacking human authorship such as ‘a photograph taken by a monkey’ and ‘an application for a song naming the Holy Spirit as the author.’”<sup>17</sup>

The Board concluded the analysis of the human authorship requirement by affirming that public sentiment has not changed in almost 50 years. In 2020, the United States Patent and Trademark Office (“PTO”) sought public comment on whether a work produced by an AI algorithm without the involvement of a natural person qualifies as a work of authorship.<sup>18</sup> The Board used this public comment report as a final “but don’t just take our word for it” nail in the coffin sealing the rebuttal against Dr. Thaler’s public policy argument: “the vast majority of

commenters acknowledged that existing law does not permit a non-human to be an author [and] this should remain the law.”<sup>19</sup> Needless to say, Dr. Thaler’s public policy argument never really stood much of a chance.

As for Dr. Thaler’s assertion of the “work made for hire” doctrine, the Board dismissed his argument with a simple premise: if a machine cannot enter into a contract, as is required for a work-made-for-hire agreement, it cannot author a work under the same.<sup>20</sup> The Board affirmed the decision to not allow copyright protection for Dr. Thaler’s AI-generated work, and his path for relief within the jurisdiction of the Copyright Office ended. However, Dr. Thaler was not done.

Dr. Thaler next appealed the Board’s refusal by way of judicial action under the Administrative Procedure Act (“APA”). With that, we have circled back to *Stephen Thaler v. Shira Perlmutter and The United States Copyright Office* in which Dr. Thaler argued that the Office’s “denial of copyright registration” was “an arbitrary and capricious agency action and not in accordance with the law.”<sup>21</sup> Dr. Thaler’s arguments were much the same: the Copyright Act allows protection of AI-generated works in the same realm as protection for corporations; the position of the Office is not supported by case law; and the “work made for hire” doctrine permits registration (even though AI cannot execute a binding contract).<sup>22</sup>

Unsurprisingly, Dr. Thaler did not fair any better this next go-around. On August 18, 2023, Judge Beryl Howell issued an order denying Dr. Thaler’s motion

for summary judgment and granting the Copyright Office’s cross-motion for summary judgment. The supporting memorandum opinion from Judge Howell noted that Dr. Thaler attempted to complicate the issues by arguing the “viability of legal theories under which a copyright in the computer’s work would transfer to him, as the computer’s owner.”<sup>23</sup> Judge Howell explained that an argument concerning to whom the valid copyright should be registered ignores the fact that no valid copyright ever existed due to the lack of human involvement.<sup>24</sup> This defeated Dr. Thaler’s work-for-hire argument and his other arguments directed to whom this non-existent copyright belongs.

Interestingly, Dr. Thaler did attempt to shoehorn in one issue not previously argued before the Board: that the Court should determine “whether a machine can make something indistinguishable from a person for purposes of copyright protection.” This was too little, too late, because the judicial relief provided by the APA only extends to a review of whether an agency action is found to be “arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law.”<sup>25</sup> Review is limited to “the grounds that the agency invoked when it took the action” and, as such, there can be no *de novo* arguments from either party.<sup>26</sup>

Even though the standard of review is limited to what is in the record upon which the agency acted, the Court devotes a significant portion of the discussion to the history and supporting authority to hammer the point home: the author *must* be human. The laws, as written, were meant to adapt to a changing world and the absence of *any* human involvement in the creation of the work will not suffice. Sure, a human is responsible for the initial text input that will somewhat guide the program to deliver an output image in line with the user’s request. But at this stage in the game, it’s not enough.

I imagine most people will agree with the decision. One of the fun-

damental concepts of copyright law is that one cannot copyright an idea. An idea can be expressed in writing or drawings that can then be registered. But to allow registration of an AI output image at this stage would be tantamount to registering an idea while circumventing the requisite human touch. I must admit that my favorite part of the opinion is a playful footnote referencing a *Columbia Journal of Law* article that states: “The day sentient refugees from some intergalactic war arrive on Earth and are granted asylum in Iceland, copyright law will be the least of our problems.”<sup>27</sup> It emphasizes the mindset of the Court in analyzing Dr. Thaler’s attempt to shoehorn

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the human authorship requirement of copyright protection and how it relates to what the “big picture” concerning AI is: if AI becomes advanced enough to demand civil rights afforded to humans, we have bigger fish to fry.<sup>28</sup>

Some final food for thought: The opinion went on to emphasize that copyright laws in their current form have been able to cover advancements in technologies throughout time.<sup>29</sup> The Court believes the use of a camera is the use of a mechanical device to reproduce original intellectual conceptions of the author in creating a new type of work.<sup>30</sup> Should an AI program be treated the same as a camera? After all, a camera requires the user to adjust the depth of field, shutter speed, and other variables for it to capture what the user desires. With AI, a narrow, defined text input will yield a more definite output image that may fall in line with the creative vision of a user. Are the images generated by the program too unpredictable, regardless of the specificity of input from the user? Can text prompts and algorithms be enough to bridge the gap from unpredictable to predictable? Needless to say, there have been and will continue to be several legal and societal disruptions caused by the continued advances of AI. Better to face them now because this technology is here to stay. ▲

## Endnotes


1. Christopher T. Zirpoli, CONGRESSIONAL RESEARCH SERVICE, *Generative Artificial Intelligence and Copyright Law*, LSB10922 (September 29, 2023).
2. U.S. Constitution, Article I section 8, clause 8.
3. 17 U.S.C.A. § 102.

4. Joseph R. Biden, Jr., THE WHITE HOUSE, <https://www.whitehouse.gov/briefing-room/presidential-actions/2023/10/30/executive-order-on-the-safe-secure-and-trustworthy-development-and-use-of-artificial-intelligence/> (October 30, 2023).
5. Copyright Office Issues Notice of Inquiry on Copyright and Artificial Intelligence, U.S. COPYRIGHT OFFICE, NewsNet Issue No. 1017 (August 30, 2023), <https://www.copyright.gov/newsnet/2023/1017.html>.
6. *Thaler v. Perlmutter*, No. CV 22-1564 (BAH), 2023 WL 5333236, at \*1 (D.D.C. Aug. 18, 2023) (see Ex. D, Copyright Office Refusal Letter Dated August 12, 2019 at 1, ECF No. 13-4.).
7. See, e.g., *Id.*
8. *Perlmutter*, 2023 WL 5333236, at \*1.
9. 37 C.F.R. § 202.5(c).
10. *Perlmutter*, 2023 WL 5333236, at \*1 (see Ex. G, Second Request for Reconsideration at 2, ECF No. 13-7.).
11. See *Id.*
12. See *Id.* Ex. H, Copyright Review Board Refusal Letter, February 14, 2022 at 1, ECF No. 13-8.
13. U.S. Copyright Office, Compendium of U.S. Copyright Office Practices § 306 (3d ed. 2017) (provides guidance on institutional practices and principles of law concerning Title 17 of the US Code and Chapter 37 of the Code of Federal Regulations).
14. See *Id.* at 4-5, ECF No. 13-8.
15. See *Id.* at 5, ECF No. 13-8.
16. See *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 4 S. Ct. 279, 28 L. Ed. 349 (1884).
17. See U.S. COPYRIGHT OFFICE, COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES § 313.2 (3d ed. 2021).
18. See U.S. PATENT AND TRADEMARK OFFICE, PUBLIC VIEWS ON ARTIFICIAL INTELLIGENCE AND INTELLECTUAL PROPERTY POLICY at 19 (2020), available at [https://www.uspto.gov/sites/default/files/documents/USPTO\\_AI-Report\\_2020-10-07.pdf](https://www.uspto.gov/sites/default/files/documents/USPTO_AI-Report_2020-10-07.pdf).
19. *Perlmutter*, 2023 WL 5333236, at \*1, ECF No. 13-8.
20. See *Id.*, ECF No. 13-8.
21. *Id.* at \*2.
22. See *Id.* at \*3.
23. See *Id.*
24. See *Id.*
25. See 5 U.S.C. § 706(2)(A).
26. *Michigan v. EPA*, 576 U.S. 743, 758 (2015).
27. *Perlmutter*, 2023 WL 5333236, at \*4 n.2.

28. 44 COLUMBIA J. L. & ARTS 383, 408 (2021).
29. See, e.g. *Id.* at \*3.
30. See, e.g. *Id.* at \*3.

## Benjamin P. Mayer

Benjamin Mayer began his legal career representing debtors in Chapter 7 and Chapter 13 bankruptcy. In 2019, Mayer was licensed to practice before the United States Patent and Trademark Office and represented inventors and entrepreneurs prior to joining McPhail Sanchez LLC of Mobile. He now represents creditors in a variety of civil matters in his capacity as the firm’s managing litigation attorney.



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# IP PROTECTION: Common Mistakes and How to Avoid Them

*By Rudy Hill and Jake Gipson*

Intellectual property may be described in a general sense as the opposite of real property

— an intangible property right as opposed to something that you can see or hold in your hand. It is this intangible nature that, for many business owners, renders the existence of intellectual property rights and, more importantly, their value, illusory, underappreciated,

and misunderstood. This article is intended to identify some common mistakes that business owners make with respect to intellectual property and how those mistakes can be avoided. When managed properly, intellectual property rights can provide important competitive advantages, protect a company's good will and reputation, and add value in their own right.

Intellectual property rights can take several forms, and four in particular are most useful to businesses. **Patents** provide their owners



the exclusive right to make, use, offer to sell, or sell an invention within the United States or import it into the United States.<sup>1</sup> They do not bestow upon their owner the right to practice an invention, but rather the right to prevent others from doing so. The most well-known type is the utility patent, which protects any “new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.”<sup>2</sup> For many business owners, the lesser-known design patent, which protects a “new, original and ornamental design for an article of manufacture,”<sup>3</sup> may be equally useful. **Trademarks** comprise any word, term, name, symbol, or device,<sup>4</sup> by which the goods or services of one may be distinguished from the goods or services of another.<sup>5</sup> Typical trademarks may include a word or combination of words, logos used by a business to identify itself, slogans, or combinations thereof. **Copyrights** protect “original works of authorship fixed in any tangible medium of expression” including literary, musical, artistic, and audiovisual works.<sup>6</sup> And finally, **trade secrets** constitute “all forms and types of financial, business, scientific, technical, economic, or engineering information” that have been maintained as confidential by their owner and derive independent economic value as a result.<sup>7</sup> Each of these forms of intellectual property can play a role in protecting and strengthening a business, sometimes in combination.

It is no coincidence that support for these differing types of IP rights comes in whole or in part from federal statutes. The founding fathers recognized long ago, in the Constitution, the importance of protecting them: “[The Congress shall have 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.”<sup>8</sup> But businesses must take proactive steps to maximize the benefits they provide.

For those who are thinking that these intellectual property rights are reserved only for the Silicon Valley startups and the Googles of the world, you have already made the first mistake. Every business has intellectual property assets, and every business can take measures to protect and utilize them. We now discuss in turn the most common mistakes that businesses make in failing to do so – failing to recognize and secure ownership of IP; failing to invest in IP; failing to give notice of IP; and failing to leverage IP.

## Failing to Recognize And Secure IP

Perhaps the most common mistake occurs at the outset, when many businesses fail to recognize IP or take the steps necessary to secure it. This critical step is often overlooked, sometimes until it is too late.

Picture this: a new client calls quite upset. The business owner has just paid thousands of dollars to a consultant to develop new marketing material only to discover that a third party has copied the work. But no problem, the business owner asserts, he paid for the work, so he just needs you to sue for infringement. Or picture this: a client comes to you about a revolutionary new technology developed by an employee that vastly improves the business’s manufacturing process. Excited, the business owner begins to rattle off the possibilities of obtaining a patent to block her competition or to generate an additional revenue stream through licensing. Unfortunately, both business owners may be wrong, and the situation is not all that uncommon.

The critical error in both scenarios is failing to understand that specific rules govern ownership and transferability of IP, and those rules differ between types of IP. For instance, while an employer is generally the author and initial owner of any copyrightable work created by an employee in the scope of his employment,<sup>9</sup> the same is not true of a work created by a consultant or independent contractor – even if the business paid good money for it! Instead, a written agreement is required to vest ownership in the business, either as a work made for hire or through an assignment of rights.<sup>10</sup>

The rules for patents are different. The starting point there is that an inventor – an individual – is presumed to be the owner.<sup>11</sup> That is true even for employees. Generally speaking, unless there is a written agreement assigning rights to the employer or the employee was specifically hired to invent, the employer may have no ownership in the invention.<sup>12</sup>

Businesses are thus well-advised to address and secure ownership from the outset. Most often, this involves implementing policies and procedures that help identify when IP might arise and that put into place safeguards to ensure proper documentation is

obtained, whether in the form of employment agreements, contractor agreements, or otherwise. Without this care, fixing ownership after the fact may be impossible or, at the very least, more difficult (and costly) once tangible value has attached to the IP.

The potential pitfalls do not end there, however. Businesses must also understand what is required to obtain and maintain protection. A mistake here can sometimes lead to a complete loss of rights.

A common misunderstanding is how different types of IP arise and the varying importance of the federal statutory schemes to the creation of those rights. While copyright arises upon creation of a work and trademark rights arise from use of a mark, patent rights arise only if an inventor obtains a patent from the federal government.<sup>13</sup> In other words, unlike with other IP, patent rights arise only if an inventor applies for a patent and satisfies various requirements of the Patent Act.

The statutory requirements for obtaining patents create several traps for the unwary. Among others are the dreaded “statutory bars.” If an inventor sells his invention or makes it available to the public (e.g., discloses it without a non-disclosure agreement), a patent may not be obtained unless an application is filed within a year.<sup>14</sup> This disincentive to public disclosure is in notable contradistinction to a trademark, which requires public use to establish rights. A further trap is a delay in the filing of a patent application – even if no public disclosures are made. Under the Patent Act, the first inventor to file, subject to limited exceptions, is entitled to a patent.<sup>15</sup> Thus, an earlier inventor who delays filing can lose not only the right to obtain his own patent but also his right to practice his invention.<sup>16</sup> This system of priority is another characteristic of patents that is markedly different from copyrights and trademarks.

Not to be forgotten, trade secrets present their own obstacles to securing rights. Chief among them is the requirement that the trade secret be “the subject of efforts that are reasonable under the circumstances to maintain its secrecy.”<sup>17</sup> Unfortunately, there is no bright line rule on what efforts are sufficient. But what is clear is that affirmative steps must be taken.<sup>18</sup> As with other potential pitfalls in the establishment of IP rights, the best advice for business owners is to follow a prescriptive approach that sets forth clear policies and procedures developed with trade secret and other IP rights in mind.

## Failing to Invest in IP

Recognizing and securing IP rights are just the first steps of several for the IP-savvy business, however. Further steps must be taken to truly capture and maximize their value. And this often requires an investment on the front end to protect the unique products, processes, and know-how that give businesses a competitive edge.

The first investment decision is the easiest one: All businesses should invest in the policies, practices, and written agreements discussed earlier that will alert them to the presence of potential IP rights; maintain those rights as confidential; and keep them within the business. If IP rights are never realized or captured, there will never be a second investment decision to discuss.

Many businesses can also benefit from policies that promote and incentivize innovation. While employment agreements should do many things to ensure that IP rights stay with the company, they can also provide employees with a vested interest in innovation in the form of additional compensation for confidential disclosures that lead to additional revenues or royalty streams (and perhaps even for the making of such disclosures in the first place, whether or not they later benefit the bottom line). Such benefits encourage both innovation and employee adherence to the IP policies discussed earlier. And in many industries – particularly those where scientists and engineers are on the payroll – their very existence can constitute a material component of employee compensation that aids in attracting top talent.

The next investment decision for the company – and the harder one – is whether to allocate the resources necessary to pursue those rights further through federal registration. For patents, trademarks, and copyrights, there are formal application and registration procedures through federal agencies that, if executed successfully, create (for patents) and enhance (for trademarks and copyrights) the IP rights at issue. The investment cost varies.

Patents typically require the most capital investment. Significant effort is required to prepare a utility patent application, including the drawings and technical disclosure, and the process of filing an application and prosecuting it before the U.S. Patent & Trademark



Office (“USPTO”) is incredibly involved and can take several years and tens of thousands of dollars (with no guarantee of a patent ever issuing!). For this reason, patent protection may not be feasible to pursue for *all* inventions, and care should be taken on the front end to evaluate the potential upside of obtaining patent protection for a given invention before deciding whether to pursue it. And for products or inventions that have unique aesthetic components, businesses should keep in mind the possibility of design patent protection, which is generally simpler and less costly to pursue. Regardless, securing patent protection requires significant investment.

The value of a company’s trademarks and branding can also benefit significantly from investment on the front end. Two types of investments are most common – investment in clearance searches and investment in federal registration.

Clearance searches assess the strength and registrability of proposed new marks and identify potential risks caused by existing uses of similar marks by third parties. When utilized properly, they can help businesses select strong, registrable marks and avoid third-party issues that might otherwise stop the launch of a new product dead in its tracks. Depending on the type of mark under consideration and how crowded the field is, they can cost a few thousand dollars. But the investment can pay dividends through aiding in selection of a strong brand and avoidance of third-party issues.

Federal registration of a trademark also requires investment (both in filing fees and attorney’s fees). It is not required to enjoy trademark rights but, if obtained, it provides the registrant with several enhanced benefits including nationwide rights and key presumptions in litigation. In a similar vein, federal registration of copyrights can unlock some advantages if litigation is later required and, on balance, are the cheapest and easiest registrations to pursue. While not all businesses create fine art, most have websites and some create software, both of which can benefit from federal copyright registrations. Many times, even the artistic components of logos can be viable candidates for federal copyright registration.

On balance, strategic investment in IP including these various modes of federal registration can pay dividends for any business.

## Failing to Give Notice Of IP

Once a business secures and invests in IP, a critical next step is giving notice of rights. Proper notice is often critical to recovering the maximum available damages for infringement, and it also serves as an important deterrent to uninformed would-be infringers. Many businesses fall short in this area, however, by failing to satisfy the applicable marking requirements, forgetting to register copyrights, or failing to take other proactive steps for providing notice. These common issues are discussed in turn.

Each type of IP has its own specific marking requirements – and at least one specific way that businesses frequently err in marking.

For patents, businesses often think advertising their product as “patented” is good enough. It is not. The Patent Act sets forth specific requirements for marking.<sup>19</sup> In a nutshell, the product must be physically marked with (i) the word “patent” or “pat.” *and* (ii) either the patent number covering that article or a web address where the article is specifically associated with the patent number.<sup>20</sup> If this requirement is not strictly satisfied, the patent owner loses all right to recover damages for infringement until actual notice of infringement is provided.<sup>21</sup>

For trademarks, two errors are common: some ineligible businesses use the registration symbol, while other eligible businesses fail to use it. The symbol to indicate that a mark has been federally registered is ® (the “circle R symbol”). This symbol may be used only after a registration is issued.<sup>22</sup> Using the symbol earlier – even if an application has been filed or allowed – is improper<sup>23</sup> and can be the basis for a fraud claim.<sup>24</sup> Instead, before registration (or without a registration), a trademark owner may use the <sup>TM</sup> or <sup>SM</sup> symbol. Once registered, however, the owner should then use the circle R symbol, lest he lose entitlement to damages for infringement of the registered mark.<sup>25</sup>

For trade secrets, there is no statutorily prescribed marking requirement, but the requirement for reasonable efforts to maintain secrecy usually carries an expectation that the business labels the trade secret as “confidential” or something similar.<sup>26</sup> The absence of such a notice may later be used as evidence to defeat the IP claim altogether.

Finally, for copyrights, many businesses fail to include a copyright notice on at least some of their copyrightable works. While the Copyright Act no longer requires such notices to secure rights, these notices are a clear deterrent and defeat any innocent infringer defense.<sup>27</sup> A copyright notice requires three elements: the copyright symbol ©, the year of first publication, and the name of the copyright owner.<sup>28</sup>

In a similar vein, many businesses make the mistake of waiting to register their work with the United States Copyright Office – another way to provide notice of copyright – until after infringement has already begun. Although not fatal, these copyright owners can lose several advantages, including the right to seek statutory damages and to recover attorneys’ fees.<sup>29</sup> These benefits can be quite substantial – up to \$150,000 in statutory damages for willful infringement, for instance<sup>30</sup> – and made available for only a nominal registration fee.<sup>31</sup>

Another avenue that many businesses fail to exploit is recording their trademarks and copyrights with United States Customs and Border Protection. For a relatively small fee,<sup>32</sup> an IP owner may record such rights with Customs and employ the full force of the United States government to stop the importation of infringing goods. Where such infringements are likely to come from abroad, this form of notice can provide powerful and cost-effective protection of IP.

## Failing to Leverage IP

Of course, investing in IP is a poor investment if it does not add to a business’s bottom line. Sometimes that value is derived from exploiting exclusivity, such as, for instance, prohibiting competitors from offering a similar product or ensuring that consumers recognize a brand as a single indicator of source. Other times, however, the value is more directly monetary. Licensing IP and enforcing it against infringers are two common examples. Regardless of the plan, it is important to understand the pitfalls to protection, enforcement, and monetization.

One common mistake in this area is failing to take action – or delaying action – against infringers. Inaction has consequences, some of which can be dire.

On the most extreme end, the failure to protect trademarks can result in a partial or total loss of rights. This consequence arises from the fact a trademark’s

value derives from its ability to signify source. If infringement occurs unabated, a mark’s ability to indicate source is impaired or lost. In the worst case, a trademark “lose[s] its significance as a mark” and all rights are abandoned.<sup>33</sup> But even if all rights are not lost, a delay in addressing infringement can make future enforcement difficult.<sup>34</sup>

Consequences also arise from failing to take action against patent or copyright infringers. Although the Patent Act does not impose a statute of limitations, it does limit the availability of damages. “No recovery shall be had for any infringement committed more than six years prior to the filing” of the claim.<sup>35</sup> The Copyright Act, on the other hand, imposes a three-year statute of limitations.<sup>36</sup> Courts are split on how to apply this statute, but in the Eleventh Circuit, at least in some circumstances, the statute of limitations begins to run when the copyright owner “learns, or should as reasonable person have learned,” of the infringement.<sup>37</sup>

Failing to take action has indirect consequences too. Allowing infringement to go unaddressed encourages more infringement. And that problem is not small. Several years ago, an updated report by The Commission on the Theft of American Intellectual Property estimated that the annual cost of IP theft to the U.S. economy continues to exceed \$225 billion (and is perhaps as high as \$600 billion) in counterfeit goods, pirated software, and theft of trade secrets.<sup>38</sup> Well-planned enforcement efforts can reduce the likelihood that a business’s IP becomes part of that statistic.

For IP owners seeking value through licensing, other pitfalls abound. To most lawyers, it will come as no surprise that a *written* license agreement is strongly recommended. But what may be surprising is the potential consequences of no agreement or an inadequate one. For example, if a trademark owner licenses its mark without proper quality control, it has engaged in “naked licensing.”<sup>39</sup> While that term may sound funny, its consequences are not. If “the license is ‘naked,’” “the trademark is abandoned.”<sup>40</sup> The importance of a thoughtful and well-drafted license agreement – and one that is in turn followed and enforced by the owner – cannot be overstated.

A final area that deserves mention is monitoring. In the world of the internet and sprawling commerce, it is virtually impossible for a business (even a very large one) to singlehandedly monitor for IP infringement. But businesses make a mistake when they ignore monitoring as too gargantuan of a task. Numerous third parties



offer various trademark and copyright monitoring services, which can be tailor fit to the IP assets of a business. Among other benefits, monitoring ensures that potential infringement is identified and addressed early, when the costs to action are typically at their lowest.

Leveraging IP to benefit a business's bottom line may seem too intangible or complicated to tackle, but hopefully this article provides few concrete suggestions to overcome the inertia of inaction. Otherwise, competitive advantages and real value are being left on the table. ▲

## Endnotes

1. 35 U.S.C. § 271
2. 35 U.S.C. § 101
3. 35 U.S.C. § 171
4. 15 U.S.C. § 1125
5. 15 U.S.C. §§ 1052, 1053
6. 17 U.S.C. § 102
7. 18 U.S.C. § 1839
8. U.S. CONST. ART. I, § 8
9. 17 U.S.C. §§ 101, 201(a)-(b).
10. *Id.* §§ 101, 204.
11. *See, e.g.*, 15 U.S.C. §§ 100(f), 101.
12. *Banks v. Unisys Corp.*, 228 F.3d 1357, 1359 (Fed. Cir. 2000). There are, however, various ways an employer may acquire some rights, such as through shop rights in a patent or asserting a claim for misappropriation as possessor of a trade secret. *See, e.g., Advanced Fluid Sys. Inc. v. Huber*, 958 F.3d 168 (3d Cir. 2020) (recognizing that state law governing trade secret misappropriation does not require ownership to establish standing).
13. *Compare* 17 U.S.C. § 102(a) (stating copyright exists in "authorship fixed in any tangible medium of expression") and 15 U.S.C. § 1051(a) (permitting trademark registration by an "owner of a trademark used in commerce"), *with* 35 U.S.C. § 101 (stating an inventor "may obtain a patent").
14. 35 U.S.C. § 102(a)(1), (b)(1).
15. *Id.* § 102(a)(2).
16. *See* 35 U.S.C. § 154(a)(1) (stating a patent owner has "the right to exclude others from making, using, offering for sale, or selling the invention").
17. Ala. Code § 8-27-2(1)(e).
18. *See, e.g., Jones v. Hamilton*, 53 So. 3d 134, 140 (Ala. Civ. App. 2010).
19. 35 U.S.C. § 287.
20. *Id.* The Patent Act also provides alternatives when this cannot be done.
21. *Id.*
22. 15 U.S.C. § 1111.

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23. Trademark Manual of Examination Procedure (November 2023) § 906.
24. *Copelands' Enters. Inc. v. CNV Inc.*, 945 F.2d 1563 (Fed. Cir. 1991).
25. 15 U.S.C. § 1111.
26. *Jones*, 53 So.3d at 140 (faulting business for not marking alleged trade secrets as "confidential").
27. 17 U.S.C. § 401(d).
28. *Id.* § 401(b).
29. 17 U.S.C. § 412.
30. 17 U.S.C. § 504(c).
31. See <https://www.copyright.gov/about/fees.html>.
32. Customs currently charges \$190 to record each copyright and \$190 per class of goods to record each trademark. See U.S. Customs & Border Protection e-Recordation Program, available at <https://iprr.cbp.gov/s/>.
33. 15 U.S.C. § 1127.
34. See, e.g., *Mr. Hero Sandwich Sys., Inc. v. Roman Meal Co.*, 781 F.2d 884, 889 (Fed. Cir. 1986) (holding that evidence that "marks have coexisted since 1967 without evidence of actual confusion ... suggest[s] that the marks are not so easily confused"); *Pinnacle Advertising & Marketing Grp. Inc. v. Pinnacle Advertising & Marketing Grp. LLC*, 7 F.4th 989, 1005–11 (11<sup>th</sup> Cir. 2021) (affirming application of laches to bar claims for infringement after four-year delay).
35. 35 U.S.C. § 286.
36. 17 U.S.C. § 507(b).
37. *Nealy v. Warner Chappell Music, Inc.*, 60 F.4th 1325, 1330 (11<sup>th</sup> Cir. 2023) (internal quotation marks and citation omitted).
38. *Update to the IP Commission Report: The Theft of American Intellectual Property: Reassessments of the Challenge and United States Policy*, The National Bureau of Asian Research (2017) (available at <https://www.nbr.org/program/commission-on-the-theft-of-intellectual-property/>).
39. *Blue Mountain Holdings Ltd. v. Bliss Nutraceuticals, LLC*, No. 22-13441, 2023 WL 5164472, at \*1 (11<sup>th</sup> Cir. 2023).
40. *Id.*

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#### Rudy Hill

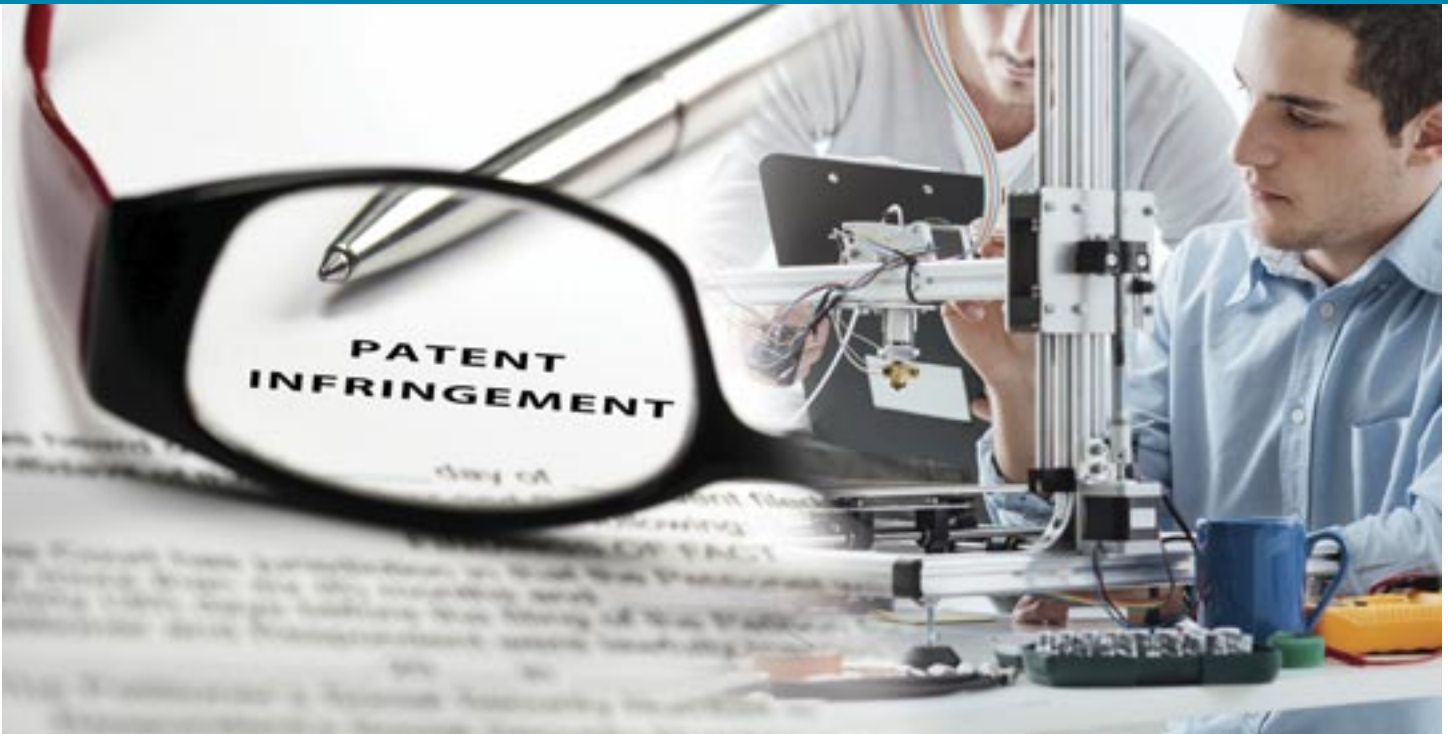
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# Patent Issues for the Non-Patent Lawyer

*By Joe Bird*

**This article is an introduction to patent issues for the lawyer who is not a patent attorney.**

It is meant to provide the non-patent lawyer the ability to identify issues and provide initial guidance for a client who might have a patentable invention, or who might receive a notice of patent infringement.

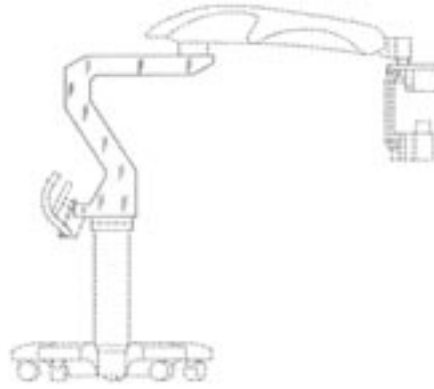
A patent is a right to exclude others from making, using, offering for sale, or selling an invention

throughout the United States or importing it into the United States.<sup>1</sup> If the invention is a process, the patent may exclude others from using, offering for sale, or selling throughout the United States, or importing into the United States, products made by that process.<sup>2</sup> A recipient of a patent is called a patentee. A common misconception is that a patent enables the patentee the freedom to do or sell something covered by the patent, but that is not true. A patent only allows the patentee to stop others from doing or selling something. Freedom to operate is a separate question from whether a patentee can get its own patent.

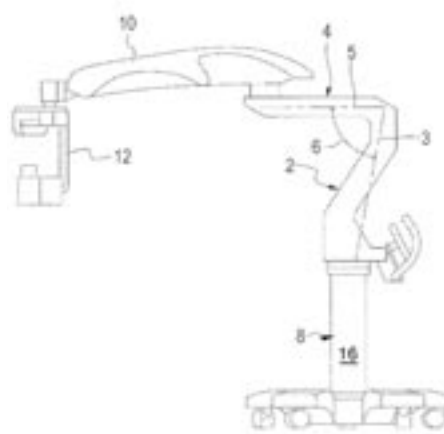
There are different types of patents. A utility patent (as opposed to a design patent, discussed below) may be issued by the United States Patent and Trademark Office (USPTO) for the structure, function, or composition of a physical object or for a process. The statutory list of patentable subject matter is “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.”<sup>23</sup> Patentable physical objects include a machine, a component, or a compound such as a pharmaceutical or a fertilizer. A patentable process can be for software or for manufacturing a physical product, among other things.

A design patent is different from a utility patent in that it protects the appearance of an object rather than its function, structure, or composition. For example, a stand for a surgical microscope could have a utility patent that covers its structure and can also be covered by a design patent that covers its appearance. For example, U.S. patent number 8,584,994 (utility) and U.S. patent number D685,405 (design) protect the structure and the appearance, respectively, of the same object. Design patents require only the filing of high-quality drawings of the object and a cursory description of those drawings.

Another common misconception about patents is that patent applications are simply rubber stamped by the federal government. The filing of a patent application by no means requires issuance of a patent. Patent applications are substantively reviewed by the USPTO to determine whether the disclosed invention is patentable. A patentable invention



*Figure 3 of U.S. Patent No. D685,405 (design patent)*



*Figure 2 from U.S. Patent No. 8,584,994 (utility patent)*

must be both novel and non-obvious. In lay terms, novelty means there is nothing else exactly like it that has been publicly displayed or previously produced by a third party or the inventor herself. U.S. patent law defines novelty as not having been “patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention.”<sup>24</sup>

Non-obviousness is a more difficult concept than novelty, however, and non-obviousness is the battlefield upon which most patent prosecutions are fought. Obviousness is a bar to a patent “if the differences between the claimed invention and the prior art are such

that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains.”<sup>25</sup> Prior art includes patents, patent applications, and non-patent literature (articles, advertisements, product manuals, and the like) by others that were made public before the priority date of the applicant’s own application. This standard is difficult to apply (and the subject of much litigation) and perhaps may be best explained by an example: imagine a first piece of furniture with wheels on the legs, say a chair. After it becomes public, this piece of furniture would make a later-filed patent application covering a table with wheels on the legs obvious, and the application would be rejected by the USPTO on that basis. Obviousness normally is supported by a patent examiner’s combination of two or more prior art documents having all the features and functions of the invention applied for that, in the patent examiner’s opinion, would have been obvious to combine by a person of at least ordinary skill in the art. Or at least that is what the patent examiner says and this is where the battle in prosecution often occurs.

Because the content of prior art can be so important to the success of a patent application, an inventor should investigate whether any similar invention exists before filing a patent application and may purchase a patentability search report from one of a number of vendors for this purpose. The search report is not a guarantee of patentability, but it can identify other similar products, processes, and the like. The cost for



a patentability search report typically does not exceed \$1,000 under normal circumstances.

If the client has interest in possibly protecting an invention with a patent, another critical consideration is whether the client herself has used the invention publicly already. In the United States, an inventor must apply for a patent within one year from any public use of, disclosure of, sale of, or offer to sell the invention. If the inventor wants to apply for a patent in any foreign country, however, in most countries there is no grace period at all, and any public use, disclosure, sale, or offer to sell prior to the filing of a patent application would prevent issuance of a foreign patent. Use of the invention only for beta-testing by a potential customer does not necessarily constitute public use or offer to sell, but it is a risky practice to engage in before filing a patent application. If a client approaches a patent attorney with an invention for which there has been very limited disclosure to third parties, one avenue is to treat the prior disclosure as a beta-test if the facts support it. For a beta use, there should be a written agreement stating expressly that the use is beta only and specifying that the potential customer must provide feedback to the inventor for R&D purposes, and that the potential customer will not disclose the invention in any way. Beta use is not the safest course and, if it is pursued, it needs to be defined in a clearly written document signed both by the client and the potential customer. For these reasons, one of the first questions to be asked of an inventor is whether any public use, disclosure, sale, or offer to sell has

**If the client has interest in possibly protecting an invention with a patent, another critical consideration is whether the client herself has used the invention publicly already.**

been made; if so, a clock may already be running on the deadline to file for patent protection.

If your client wants to pursue a patent application, you should refer the client to a patent attorney or a patent agent. Only persons admitted to the patent bar can represent an inventor in a patent prosecution before an examiner in the USPTO. A patent agent is not a lawyer but has passed the patent bar examination and can also prosecute patent applications for others.

The background and process of filing a patent application works this way. Utility patent applications require a good bit of time and preparation. Prior to filing a utility patent application, a common first step is the filing of a provisional application. The sole function of a provisional is to acquire a priority date, and the provisional is not examined by a patent examiner — examination occurs only for a utility or a design patent application. The priority date means that, after the provisional is filed, another

person who files a patent application on the same invention or makes public use of the same invention will not have patent rights superior to those of your client or be able to bar your client's application. If the provisional application does disclose the entire invention, then a provisional can be converted to an application for a utility patent, also called a nonprovisional patent application, claiming priority to the provisional. This can be done within one year of the provisional's filing. In this way, the provisional can provide an earlier priority date for the nonprovisional, but only for what is disclosed in the provisional. A provisional application is often advisable because it gives the inventor time to decide if investing further in the product and a nonprovisional patent application is worthwhile. Once a provisional has been filed, then later public use, disclosure, sale, and offers to sell (either by the inventor or by third parties) do not bar later patentability, either domestic or foreign. A provisional application is informal and can include hand drawings, provided that it must disclose all of the patentable features of the invention. Small- to medium-sized businesses can benefit greatly from filing a provisional: the low cost buys an early priority date and the succeeding year can be used to decide whether to spend money on a nonprovisional. If the client elects not to convert the provisional within a year, then it is abandoned and remains unpublished, and the client's information remains confidential.

The cost of pursuing a patent can vary greatly. Many patent attorneys will not charge for an initial discussion to understand what the

invention is and whether there are any issues (like prior use or public disclosure) that may have already impacted patentability. After a decision to pursue a patent has been made and an attorney client relationship has been established with an engagement letter, the next decision is whether to file a utility application (and then whether to file a provisional or a nonprovisional application), a design patent application, or both.

If an inventor decides to pursue a provisional application, she should prepare a written description of the invention and handwritten drawings and, if only minimal editing and additions are required by the patent attorney, the total cost for filing can be as low as a couple of thousand dollars. A nonprovisional, also called a utility application, is normally much more time-consuming and can be elected as the first step if the client wants to obtain a patent more quickly. The nonprovisional requires a lot of additional work over what is required for the provisional, including formalities such as detailed professional drawings, and the patent attorney must prepare patent claims. Patent claims in an issued patent are like a real property description in a deed – the patent claims define the metes and bounds of the invention and must adhere to very strict rules. An inventor can file her own patent, and some do, but one would be concerned about the validity and accuracy of the patent claims if enforcement were ever needed. The cost of a nonprovisional depends greatly on how much work the inventor does to define the invention and represent it in drawings. The less information and explanation the inventor provides to the patent

**If an inventor decides to pursue a provisional application, she should prepare a written description of the invention and handwritten drawings and, if only minimal editing and additions are required by the patent attorney, the total cost for filing can be as low as a couple of thousand dollars.**

attorney, the more attorney fees are incurred. The amount of work by the inventor has more influence over the cost than does the complexity of the invention. For a design patent, the cost of preparing the application is more in line with the cost of a provisional application, assuming the inventor can prepare detailed drawings.

The amount of time between filing a utility/nonprovisional and issuance of a patent, if one ultimately issues from the application, varies greatly. An applicant can pay an extra fee for expedited

review, which can result in a decision on patentability within one year. Without paying for expedited review, the process normally takes two to four years. Design applications are typically processed more quickly, normally being examined within a year.

The policy behind the granting of patents is that inventors receive a monopoly (20 years for a utility and 15 years for a design patent) from the date of filing of the application, and the public in return receives a written disclosure of the invention (in the form of a published and publicly available patent). Because patents are disclosed publicly and have a limited term, sometimes it is better not to pursue patent protection for a manufacturing method or recipe that can be protected as a trade secret for much longer than the term of a patent. But, if the method or recipe for producing a product can be “reverse engineered” by another person, then a trade secret strategy may prove to be inadequate.

The point in the inventive process that the inventor has reached is also important in determining whether to pursue patent protection. To be patented, inventions must be conceived of and reduced to practice. Conception occurs when one or more people (there can be and often are multiple inventors for a patent) have conceived of the invention in all aspects. Reduction to practice can be actual (e.g., a prototype) or constructive (e.g., describing all aspects of the invention on paper). The filing of a patent application does serve as constructive reduction to practice of the subject matter described in the application if enough detail is provided.



Conception and reduction to practice bring up the need for clarity as to who owns the rights to an invention. Under U.S. law, patent rights belong initially to one or more inventors, all of whom must be a person (not a company or other entity). Patent rights, on the other hand, can be assigned in writing to other persons or entities. If no such assignment is made, patent rights remain with the individual inventors. It is sometimes debatable whether a person is a co-inventor or has only helped in reduction to practice. An employer or principal should require any employee or contractor (working in any way on a project that could lead to an invention) to sign an agreement including an NDA, a written assignment, and an inventor's oath form which can be filed in the USPTO with the patent application. NDAs should also be signed by any third party from whom the client is seeking work or advice of any kind before a confidential disclosure of the invention is made, an exception being that potential investors normally do not sign NDAs.

A major consideration for whether to invest in getting a patent is whether the client has the skill and resources to commercialize the invention. Patents, by themselves, are not normally sold. A company or individual who is already in the business related to the invention is most suited for patent protection. That is, if the invention is a one-off idea, even brilliant, thought of by someone not already in the business related to the invention, the inventor can find it hard to realize any benefit from a patent unless he starts a business selling or using the invention. If the client can establish good sales

and possesses a patent on the invention, then sale of the invention and the business relating to the invention to another is more plausible. Patents are also not self-enforcing, so another consideration on whether to invest in a patent is that patent infringement litigation can be very expensive. Full cost for infringement litigation would normally be at least six figures and more likely seven figures, although some patent litigation firms will take a case on a contingency basis against an infringer with deep pockets.

A company seeking to raise equity from investors should consider patenting important inventions because potential investors often take patent protection into consideration. This is not because a patent is guaranteed to stop a competitor from infringing, but because the threat of patent litigation can at least slow a competitor's plan to infringe. In that way, a relatively small investment in good patents can be worth more to a small company than to a larger one.

Claims of patent infringement against your client are another matter. Your client might receive a cease-and-desist letter alleging patent infringement. If that letter does not contain certain information – and even if it does but later turns out to be frivolous – it could be deemed to be an assertion of patent infringement made in bad faith prohibited by Alabama Code § 8-12A-2. Damages can be awarded for mere receipt of a frivolous demand letter, and this code section should be considered for inclusion in a response to a patentee who has sent a frivolous demand letter. Cease-and-desist letters for patent infringement were more rampant until recent changes in the

law, which now require that a patent infringement case must be filed where the defendant does business, but they can still be of concern. A registered patent lawyer, or a patent litigator, should be consulted upon receipt of such a letter.

Patents can represent opportunities for business clients in certain circumstances, especially when the invention is connected to the client's existing business. But before filing a patent application, the client should have a good understanding of the required investment of costs and resources required for patent prosecution. One efficient way to explain this would be to have your client read this article and then discuss with you whether to take the next step of investigating the patent process with a patent attorney. ▲

## Endnotes

1. 35 U.S.C. § 271(a).
2. 35 U.S.C. § 154(a)(1).
3. 35 U.S.C. § 101.
4. 35 U.S.C. § 102.
5. 35 U.S.C. § 103.

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## Joe Bird

Joe Bird is a registered patent attorney, litigator, and member of Maynard Nexsen's Intellectual Property Practice Group in the Birmingham office. He prosecutes, litigates, and counsels clients regarding patents, trademarks, copyrights, trade secrets, and restrictive covenants. Since 1982, Joe has gained broad experience in all aspects of intellectual property law and has been a registered patent attorney in the USPTO since 2001. He also has experience in post-grant review, including IPRs and re-examinations, and in federal district court patent litigation. His practice includes clients in bioelectronics, neurotechnology, cognitive neuroscience inventions, optical and audio devices, software and manufacturing processes, and mechanical devices.

# ALABAMA STATE BAR 2023 ADMITTEES



(Photograph by FOUTS COMMERCIAL PHOTOGRAPHY, Montgomery, photofouts@aol.com)

## B A R E X A M STATISTICS OF INTEREST

For detailed bar exam statistics, visit  
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Franchesca Dahmenique Alexander  
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Carley Dalane Green  
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 Christopher Allen Sparkman  
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 Stuart George Spooner  
 Sydney Reed St. John  
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 Elizabeth Lee Todd  
 Boston James Topping  
 NaTonia Dionta Trammell  
 Anna Leslie Traylor  
 Marshal Bryant Trigg  
 Christie Marie Trumble  
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 Melissa Elise Tucker  
 Madeline Dael Turner  
 Miles Josiah Turney  
 Leonard Elmo Underwood, III  
 Venoo Vahid  
 Michael Anthony Varchetta  
 Amanat Virk  
 Stephanie Michelle Wadsworth  
 Tyler Len Walker  
 William Walker

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 Jaleel Da'Marcus Washington  
 Victoria Talbot Waters  
 Alisha Watkins  
 John Jacob Watkins  
 Zachary Evan Watkins  
 James Whitt Watts  
 Robert M. Weinacker, IV  
 Louisa Davenport Chafee Weiss  
 Quax-Shawn Bryce Wembley  
 Sara Wendel  
 Brian Steven West  
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 Hayley Marketta White  
 Joanna Renita White  
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 Janey Lauren Whitney  
 Margaret Dale Wilbourne  
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 Christopher Grant Williams  
 Freddie Lee Williams, II  
 Joshua Graham Williams  
 Kayla Rose Williams  
 Ryan Christopher Williams  
 Jaquis Monique Willis  
 Titus Rodrick Willis  
 Christopher Paul Wilson  
 Diana Cannon Wilson  
 Robert William Winslett  
 Adam Kristopher Woelke  
 Brett James Wood  
 Tarah Dawnelle Wright  
 Tyler Elaine Yarbrough  
 Anne Miller Welborn Young  
 Lindsey Rene Young  
 Ragan Tolar Youngblood  
 J Elliott Zeller  
 Danielle Jordan Zickafoose  
 Courtney Renea Zota



# LAWYERS IN THE FAMILY



Melissa Elise Tucker (2023) and  
 Laura Hays Pearson (1997)  
*Admittee and mother*



Meghan Ruth McLeroy (2023) and  
 Darren Todd McLeroy (1992)  
*Admittee and father*



Taylor Steen (2023) and  
 Ronn Steen (1996)  
*Admittee and father*

# LAWYERS IN THE FAMILY



Robert Duncan Johnston, III (2023),  
Robert Duncan Johnston, Jr. (1982), and  
Mollie Penick Johnston (1982)  
*Admittee, father, and mother*



Sarah Hammitte (2023) and  
Judge Mark Hammitte (1997)  
*Admittee and uncle*



Harold Wayne Morris (2002),  
Alexandria Faye Jackson (2023), and  
Keith Jackson (1999)  
*Uncle, admittee, and uncle*



Chloe Dasinger (2023), Michael  
Dasinger (1991), Sharon Hoiles (1984),  
and Thomas Dasinger (1995)  
*Admittee, father, grandmother, and uncle*



William Powell Burgess, III (2023),  
C. Gregory Burgess (1995),  
W. Graham Burgess (2004), and  
William Powell Burgess, Jr. (1973)  
*Admittee, father, uncle, and grandfather*



Sidney Mitchell (2023),  
Judge Shannon Mitchell (1991), and  
Joe Wiley Mitchell (2021)  
*Admittee, father, and brother*



John Mitchell Sikes (2023) and  
John Douglas Cates (1965)  
*Admittee and grandfather*



James E. Cory (2023) and  
Ernie Cory (1981)  
*Admittee and father*



Jordan E. Loftin (2023) and  
G. Bartley Loftin (1991)  
*Admittee and father*



# LAWYERS IN THE FAMILY



Alex Gressett (2023), Cindy Fuhrmeister (1981),  
Jim Fuhrmeister (1978), and Susan Smith (1990)  
*Admittee, grandmother, grandfather, and mother-in-law*



Marjorie Milham Head (2023), J. Frank Head (1983),  
Judge Oliver P. Head (ret.) (1956), and G. Dan Head (2003)  
*Admittee, father, grandfather, and uncle*



Matthew C. Shumate (2023) and  
Amy M. Shumate (1992)  
*Admittee and mother*



Daniel Shawn Pickens (2023) and  
Martin Joseph Humble (2003)  
*Admittee and uncle*



Ragan Tolar (2023) and  
Gregory E. Tolar (1994)  
*Admittee and father*



Clay Martinson (2023), Doug Martinson, II  
(1989), and Mac Martinson (1991)  
*Admittee, father, and uncle*



Anna Katherine Sherman (2023),  
Kathy Sherman (1996), and  
Judge Michael Sherman (1995)  
*Admittee, mother, and father*



Caroline Price Mathews (2023),  
William G. Mathews (1989), and  
William G. Mathews, Jr. (2022)  
*Admittee, father, and brother*

# LAWYERS IN THE FAMILY



Victoria Waters (2023), Judge Shelly Slate Waters (1989), Judge Bill Cook (ret.) (1987),  
Beth Slate Poe (1983), and Cindy Slate Cook (1987)  
*Admittee, mother, uncle, aunt, and aunt*



Robert M. Weinacker, IV (2023) and  
Robert M. Weinacker, III (1986)  
*Admittee and father*



Kaitlyn Ann Sinclair (2023) and  
Tom Sinclair (1999)  
*Admittee and father*



Caleb T. Chancey (2023) and  
Richard L. Chancey (1994)  
*Admittee and father*



Callie Moss Shearer (2023) and  
Buzzy Riis (1985)  
*Admittee and stepfather*



Kyra Devan Perkins (2023) and  
Byron R. Perkins (1989)  
*Admittee and father*



Seton William Parsons (2023) and  
Elizabeth Skinner Parsons (1981)  
*Admittee and mother*



Ford Edwin Richardson (2023) and  
Robert Ford Richardson (1991)  
*Admittee and father*



# LAWYERS IN THE FAMILY



Harrison Smith (2023) and  
Buddy Smith (1986)  
*Admittee and father*



Meredith Hall (2023) and  
Bruce Hall (1978)  
*Admittee and father*



Carol Graffeo (2023) and  
Tony Graffeo (1995)  
*Admittee and father*



Margaret Garrett Canary (2023) and  
Leura Garrett Canary (1981)  
*Admittee and mother*



Murphy McCullen Barze (2023) and  
R. Bruce Barze, Jr. (1992)  
*Admittee and father*



Robert Yeilding Ezell (2023) and  
Mark Edward Ezell (1980)  
*Admittee and father*



Hunter Ashton Hanks (2023) and  
Judge Jeff T. Brock (ret.) (1991)  
*Admittee and father-in-law*



Jeffery Kyle Kelley (2023) and  
Judge Jeff W. Kelley (1990)  
*Admittee and father*



Griffith Hawk (2023) and  
Judge Howard Griffith Hawk (1983)  
*Admittee and father*





## MEMORIALS

- ▲ Annette Brashier Crain
- ▲ Charles Bennett Long
- ▲ Louis Cooper Rutland, Sr.

### Annette Brashier Crain

Annette Brashier Crain, age 58, passed away on October 16, 2023. She was born in Detroit, Michigan and was raised in Centre, Alabama where she graduated from Cherokee County High School in 1982. Annette received her bachelor's degree from Jacksonville State University and later received her Juris Doctor from the University of Alabama School of Law in the spring of 1988.

As an attorney and longtime partner at Davis & Crain in Tuscaloosa, Annette was well respected by her colleagues and clients. Annette was an extremely intelligent attorney and fierce advocate for her clients. She practiced law for 35 years and was a member of the Alabama State Bar Association, the Tuscaloosa County Bar Association, and the Tuscaloosa County Bankruptcy Bar Section.

Shortly after Annette graduated from law school, she married the love of her life, Darin, and became the proud mother of two children, Darin Jr., and Lauren. She was a loyal mother, wife, friend, and colleague, who always helped those around her. Annette had a quick wit and contagious laugh that unequivocally brightened everyone's day. She loved traveling the world with her family, and, enjoyed reading historical fiction. Annette is survived by her daughter, Lauren Crain.

Annette was a unique person, and she will be dearly missed by all who knew and loved her.

*–Ginger Cockrell, Tuscaloosa*



*Crain*

### Charles Bennett Long

Bennett Long was born October 29, 1978 in Mobile and passed away to heaven on August 27, 2023. Bennett is survived by his wife of 19 years, Janie Donwen Long; his children, Charles Bennett Long, Jr.; William Brooks Long; and Ann Ashford Long; his parents, Betty Ann and Earle Long; his two brothers, Earle W. Long, IV, and John Forrest Long (Ashley); his sister, Elizabeth Long Harrison (Mark); his nieces, Ann Bradley Long, Elizabeth (Libby) Francis Long, Virginia Layton Long, Caroline Benson Harrison, and Laura Elizabeth Harrison; and his nephews, John Simms



*Long*

(Continued from page 95)

Harrison, James Reid Harrison, William Calvert Donwen, and Jon Walter Donwen. He is also survived by his mother-in-law, Renee Fontenot Donwen, and his brother-in-law, Alex Jude Donwen (Angie), as well as by numerous loving aunts, uncles, and cousins.

Bennett was the youngest of four siblings and attended St. Ignatius Catholic School before graduating high school from St. Paul's in 1997. Following high school, Bennett attended the University of Alabama where he was a member of Delta Kappa Epsilon fraternity and graduated with honors in 2001 with a B.A. in business and commerce administration. Bennett then attended Cumberland School of Law, graduating cum laude in 2005. While at Cumberland, Bennett was the associate editor of the *Cumberland Law Review*.

Following law school, Bennett moved home and became president of Orange Beach Marina. During his time at OBM, Bennett obtained his real estate license and formed two real estate companies, Cirrus and Caldwell Banker-Seaside Realty. Bennett stayed busy in the marina and real estate but realized his passion was his knowledge of the law and using it to help others.

While at the marina, Bennett navigated the business through the aftermath of Hurricane Ivan, and it was there his focus on the law turned to commercial and residential insurance. He became an expert in the field of claim negotiations and settlements and gained a reputation along the gulf coast as the best in the business. It was not just Bennett's knowledge that drove his success, it was his compassion and dedication to his clients, to putting in extra time, and to staying involved in the lives of those he represented. He always wanted the best for those he represented. In 2013, Bennett joined the law firm of Long & Waite, and went on to form Long & Long PC with his brother, Earle, in 2015. While there, Bennett's giving heart, motivation, and compassion helped build Long & Long into a highly successful practice.

Bennett was a member of the Mobile Bar Association, the Alabama Association for Justice, and the Alabama State Bar. He was a member of St. Ignatius Catholic Church and was also involved in numerous civic and social organizations, including multiple Mystic Societies.

Bennett was a passionate outdoorsman and served as a board member for Coastal Conservation Association and the Mobile Big Game Fishing Club, where he was president in 2014. Bennett loved the outdoors, especially hunting and fishing. He raised his two sons, Charlie and Brooks, to not only enjoy being in the woods or on the water, but to protect and conserve it. Bennett spent most of his free time, with his family, at his beloved country home near Arlington.

Most of all, Bennett loved his family. He married the love of his life, Janie, in 2004, while in law school. Bennett adored Janie and their three children. Bennett never boasted about anything, other than his family, and he did so often and with every person he met. He was always there for them; at every event, at any time, they were first and foremost. Bennett and Janie always put their faith first and, in doing so, raised their children in a home filled with Christ, love, and joy.

Bennett was a friend to all and loved by many. He was the favorite uncle of his nieces and nephews, and they affectionately referred to him as "Uncle Sally" because of his infectious spirit, personality, and prank-playing. Bennett was a great husband, father, son, brother, uncle, and friend to all.

## Louis Cooper Rutland, Sr.

Louis Rutland passed away at his home on Friday, January 12, 2024. Louis was a lifetime resident of Bullock County, Alabama, having been born the fourth child of Will David and Rose Rutland of Mitchell Station, Alabama. Growing up in Bullock County he attended school in Union Springs, where he was a three-sport athlete playing quarterback, point guard, and short-stop for the Tigers. When he wasn't excelling on the ballfield, he helped work the family cattle farm until he graduated from Union Springs High School in 1961. He attended Auburn University where he joined Sigma Alpha Epsilon fraternity and was a member of the Naval ROTC. He graduated from Auburn in 1961 and began his Naval career as an ensign serving in the U.S. Navy attaining the rank of lieutenant. After his active duty was complete Louis joined the reserves and enrolled at the University of Alabama where he received his Juris Doctorate degree in 1969.

He began his practice of law in Union Springs in the fall of 1969. Almost immediately, he was appointed as municipal court judge for Union Springs, a position he held for 20 years. He had a private practice beginning as a solo practitioner, then partnering with Bradley Braswell and later adding his son, L. Cooper Rutland, Jr. Louis briefly worked as assistant secretary of the Alabama Senate under then Lt. Governor



Rutland

Jere Beasley. Louis's notable accomplishments included working on the state bar committee to establish standards for the commitment of incompetent persons, state bar commissioner for the 3<sup>rd</sup> Circuit, and, most notably, Louis, along with co-counsel Lynn Jinks, III, secured the first million-dollar jury verdict in Bullock County. He was honored in December 2019 for his 50 years of work in Bullock County and Alabama. Louis was an avid hunter and fisherman, preferring wild turkeys, dove, and quail. He hunted dove in Haiti with dictators and fished for marlin and dorado in Nicaragua. His passion for turkey hunting was unrivaled as evidenced by the hundreds of beards and spurs harvested all over the black-belt. When he wasn't hunting or fishing, you could find Louis on the golf course with his lifelong friends, John Braswell, Wayne Chancey, Robert Owen, Sparky Allen, and his brother, Joe Rutland.

At his retirement in 2019, family, friends, and colleagues spoke fondly of how he had helped them over the past 50

years as an attorney, mentor, counselor, judge, advocate, and adversary, in and out of the courtroom. In accepting the accolades, Louis reminded the attendees of the importance of advocating for their clients. "Always remember to zealously represent your client in the courtroom but remain friends when you get outside of Court." His honest and blunt words were at times harsh, but he spoke with compassion and not cruelty. He cared for his fellow man. He was truly an excellent steward for his Lord; his family; his friends; his nation, county, and community; and his profession.

Mr. Rutland is survived by his wife of 61 years, Judy; his daughter, Lissa R. Rand; his son, Judge L. Cooper Rutland, Jr. and wife Alison D. Rutland; his seven grandchildren, Elizabeth Rand Thomas (Will); MaryRutland Rand Fitts (Ford); Lou Rutland, III; Stewart Rand (Kate); Claudia Ann Rutland (Jack); Edward Rutland; and Thomas Rutland; great-grandson William Price Thomas; and great-granddaughter Florence Elizabeth Fitts. ▲

**Glynn Daniel Brown**

Alex City  
Died: February 5, 2024  
Admitted: 1981

**Kellie Lynn Carden**

Tucson, AZ  
Died: May 21, 2023  
Admitted: 2013

**Thomas Neely Carruthers, Jr.**

Birmingham  
Died: November 15, 2023  
Admitted: 1955

**Leo Lawrence Crain**

Daphne  
Died: January 19, 2024  
Admitted: 1953

**Joseph Carl Denison**

Opelika  
Died: December 25, 2023  
Admitted: 1986

**Col. Henry Pope Fowler, Jr. (ret.)**

Wetumpka  
Died: January 26, 2024  
Admitted: 1979

**Jonathan Andrew Huffstutler**

Gadsden  
Died: November 7, 2023  
Admitted: 2011

**James Harold LeMaster**

Florence  
Died: November 26, 2023  
Admitted: 1981

**Cynthia Cargile McMeans**

Daphne  
Died: December 24, 2023  
Admitted: 1980

**Howard Crumpton Oliver**

Greensboro  
Died: June 10, 2023  
Admitted: 1969

**Sandra Louise Rander**

Mobile  
Died: November 30, 2023  
Admitted: 1986

**Samuel Reagan Rumsey**

Sylacauga  
Died: February 5, 2024  
Admitted: 2004

**Christina Lorino Schutt**

Birmingham  
Died: October 5, 2023  
Admitted: 2010

**Phillips Russell Tarver**

Birmingham  
Died: September 23, 2023  
Admitted: 1968

**Susan Jane Walker**

Birmingham  
Died: January 12, 2024  
Admitted: 1988

**Leo Lawrence Crain**

Daphne  
Died: January 19, 2024  
Admitted: 1953





## OPINIONS OF THE GENERAL COUNSEL

Roman A. Shaul  
*roman.shaul@alabar.org*



# Settlement Agreements Cannot Restrict a Lawyer's Ability to Practice

The Office of General Counsel ("OGC") understands some of the very real practical considerations that litigation parties go through when attempting to resolve disputes. In efforts to "wrap up" litigation and limit a particular client's future exposure, parties will often turn their attention to the individual lawyers involved in the lawsuit and attempt to limit a lawyer's ability to bring future cases of a similar nature. Over the years, the OGC has seen a number of creative attempts to prevent the lawyers involved in the settling litigation from getting involved in future cases. Most of those attempts are considered unethical under the Alabama Rules of Professional Conduct.

### The Rule

Rule 5.6(b) of the Alabama Rules of Professional Conduct states that "a lawyer shall not participate in offering or making: ...[a]n agreement in which a restriction on the lawyer's right to practice is part of the settlement of a controversy between private parties." Therefore, as part of settling a client's case, a lawyer may not agree to restrict

his or her own practice of law or propose that opposing counsel restrict his or her practice. *See, e.g.*, ABA Eth. Op. 00-417 (2000); ABA Eth. Op. 95-394 (1995). The obvious example of an impermissible restriction is where a settlement agreement states something such as: “counsel agrees not to represent any person or entity in any related litigation or dispute against this defendant, or its affiliated entities.” This is a clear violation of Rule 5.6(b).

Although this rule is frequently discussed in terms of settlement agreements between private parties, it also applies to litigation involving the government and even disputes that have not yet resulted in litigation. *See, e.g.*, ABA Eth. Op. 95-394 (1995); ABA Eth. Op. 00-417 (2000). Importantly, Rule 5.6(b) does not apply to a lawyer who is acting pro se and/or is a party to the litigation. ABA Eth. Op. 95-394 (1995). For example, a lawyer who alleges that he or she is the injured plaintiff in a matter can ethically agree not to bring any future claims against a particular defendant. Similarly, in the context of a disciplinary matter, a lawyer facing a bar complaint may agree to suspend or limit his or her law practice for a certain period of time or to certain areas.

There are essentially three public policy rationales justifying Rule 5.3. As explained by the American Bar Association (ABA):

The rationale of Model Rule 5.6 is clear. First, permitting such agreements restricts the access of the public to lawyers who, by virtue of their background and experience, might be the very best available talent to represent these individuals. Second, the use of such agreements may provide clients with rewards that bear less relationship to the merits of their claims than they do to the desire of the defendant to “buy off” plaintiff’s counsel. Third, the offering of such restrictive agreements places the plaintiff’s lawyer in a situation where there is conflict between the interests of present clients and those of potential future clients. While the Model Rules generally require that the client’s interests be put first, forcing a lawyer to give up future representations may be asking too much, particularly in light of the strong countervailing policy favoring the public’s unfettered choice of counsel.

ABA Eth. Op. 93-371 (1993).

The subjective intent and desires of the client and the attorney are irrelevant in this context. Although generally the client controls whether, when, and how to settle a dispute, it is well-settled that even if a client wants his or her attorney to offer or accept a settlement provision that imposes a restriction on counsel’s ability to practice law, Rule 5.6(b) prohibits the attorney from doing so. *See, e.g.*, ABA Eth. Op. 93-371 (1993); *see also* ABA Eth. Op. 00-417 (2000). Similarly,

counsel’s willingness to accept a restriction on his or her right to practice law is irrelevant – Rule 5.6(b) prohibits restrictions on an attorney’s right to practice law, even if the restrictions are acceptable to all the attorneys involved. *See* N.C. Eth. Op. 9 (2003).

## Indirect Restrictions May Also Violate Rule 5.6(b)

Some regulatory authorities have found that certain settlement provisions can indirectly restrict an attorney’s right to practice law and violate Rule 5.6(b). One example can be confidentiality clauses that are part of a settlement agreement. The American Bar Association’s Ethics Opinion 00-417 concluded that a provision in a settlement agreement that prohibits a lawyer’s future “use” of information learned during the litigation violates Rule 5.6(b), but a provision that prohibits a lawyer’s future “disclosure” of that information may be permissible. ABA Eth. Op. 00-417 (2000). Certain rules governing client confidentiality (e.g. Rule 1.6, Alabama Rules of Professional Conduct) already prohibit a lawyer from disclosing information relating to a client’s representation absent the client’s consent. A settlement provision prohibiting the disclosure of information relating to the litigation therefore is simply duplicative of those rules and, thus, is not an impermissible restriction on the right to practice law. However, with respect to the use of information learned during the representation of a client, the ethical rules generally only prohibit a lawyer from using such information against the client. This means that a settlement agreement that prohibits a lawyer from using information against the opposing party is more than what is required by the ethical rules and, thus, is an undue restriction on the right to practice law. In Alabama, as well as many other jurisdictions, settlement provisions may prohibit a party’s lawyer from disclosing the amount and terms of the settlement (provided that information is not publicly known) because that information is a client secret and, thus, under the applicable ethical rules, already is required to be kept confidential unless the client consents to its disclosure. *See, e.g.*, D.C. Eth. Op. 335 (2006); N.Y. Eth. Op. 730 (2000); N.D. Eth. Op. 97-05 (1997); Col. Eth. Op. 92 (1993); N.M. Eth. Op. 1985-5 (1985).

## Conclusion

Although it appears straightforward on its face, Rule 5.6(b) can present a number of challenges when trying to accomplish all of your client’s litigation goals. If you have any questions about Rule 5.6(b), a particular settlement agreement provision, or any other ethics questions, you can email us at [ethics@alabar.org](mailto:ethics@alabar.org) or call the Alabama State Bar. ▲



Marc A. Starrett

Marc A. Starrett is an assistant attorney general for the State of Alabama and represents the state in criminal appeals and habeas corpus in all state and federal courts. He is a graduate of the University of Alabama School of Law. Starrett served as staff attorney to Justice Kenneth Ingram and Justice Mark Kennedy on the Alabama Supreme Court, and was engaged in civil and criminal practice in Montgomery before appointment to the Office of the Attorney General. Among other cases for the office, Starrett successfully prosecuted Bobby Frank Cherry on appeal from his murder convictions for the 1963 bombing of Birmingham's Sixteenth Street Baptist Church.

## RECENT CRIMINAL DECISIONS

# From the 11<sup>th</sup> Circuit Court Of Appeals

### Terry Stop

***United States v. Johnson*, No. 22-12504 (11<sup>th</sup> Cir. Feb. 1, 2024)**

A police officer had reasonable suspicion – all that is required by *Terry v. Ohio*, 392 U.S. 1 (1968) – to pursue, approach, and search a car he had seen improperly stopped in a street with a suspended registration. Because the suspended registration alone was sufficient to support the stop, the circuit court correctly denied the defendant's motion to suppress evidence found in the car.

### Death Penalty; Nitrogen Hypoxia

***Smith v. Comm., Ala. Dep't. of Corr., et al.*, No. 24-10095 (11<sup>th</sup> Cir. Jan. 24, 2024), cert. denied, *Smith v. Hamm*, 144 S. Ct. 144 (Jan. 25, 2024)**

Acknowledging that "Supreme Court precedent is clear that a new method of execution does not automatically establish a claim for cruel and unusual punishment[.]" the court denied the capital murder petitioner's request to stop his execution by nitrogen hypoxia. It rejected his claims that the method would constitute cruel and unusual punishment because he might vomit during the process or that oxygen might infiltrate the execution mask. The court also denied the petitioner's claim that he would be substantially burdened in his ability to audibly pray by the execution protocol in violation of the *Religious Land Use and Institutionalized Persons Act* (RLUIPA), 42 U.S.C. § 2000cc *et seq.* Finally, it found no error in the district court's admission of expert testimony proffered by the state regarding the nitrogen hypoxia process.

### Interference with Law Enforcement

***United States v. Pugh*, No. 21-13136 (11<sup>th</sup> Cir. Jan. 18, 2024)**

To impede a law enforcement officer during a civil disorder affecting interstate commerce is a violation of 18 U.S.C. § 231(a)(3). Addressing several issues of first impression, the Eleventh Circuit Court of Appeals upheld the constitutionality of 18 U.S.C. § 231(a)(3) and affirmed a conviction under the statute. The conviction arose from the defendant's act of shattering the window of a police car that blocked riotous protesters from walking onto the interstate. Acknowledging that the United States Supreme Court has upheld the constitutionality of 18 U.S.C. § 844's prohibition of arson of "any



building...used...in any activity affecting interstate or foreign commerce[.]” the court found that “Congress has the power to outlaw interference with police as they try to eliminate civil disorders that affect interstate commerce.” The jurisdictional element of interstate commerce is not required to link directly to the criminal act itself, if the object of the act is sufficiently connected to interstate commerce.

## From the Alabama Supreme Court

### “Stand Your Ground” Immunity

**Ex parte Johnson, No. SC-2023-0251 (Ala. Dec. 15, 2023)**

The Alabama Supreme Court granted mandamus relief and ordered the circuit court to award the defendant “Stand Your Ground” pretrial immunity pursuant to Ala. Code § 13A-3-23(d). Section 13A-3-23(b) modified the old common-law standard that required the victim of an attack to make a reasonable attempt to retreat, if possible, before using deadly force in self-defense. The victim may now refuse to retreat if otherwise justified in using physical force under § 13A-3-23(a), is “not engaged in an unlawful activity,” and is in a “place where he or she ha[s] the right to be.” The circuit court erred in denying immunity for the defendant’s fatal shooting of the victim during an argument after the state stipulated that all witnesses would testify that the deceased victim attacked first. The court observed that “an individual does not forfeit his right to defend himself and others merely by starting an argument (or, in [the defendant’s] case, providing moral support to the person who allegedly started an argument).”

### Constructive Possession

**Ex parte Carey, No. SC-2023-0020 (Ala. Dec. 8, 2023)**

The jury could properly determine that the defendant constructively possessed a gun found in a home, regardless that he did not reside there or control the premises, where the gun’s ammunition was found in the pocket of his pants that were also in the home. The gun was in a laundry basket near the pants. The court held that where is a direct evidentiary link between the defendant and the contraband, a finding that he owned or controlled the dwelling is not a requirement for finding constructive possession.

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(Continued from page 101)

# From the Alabama Court of Criminal Appeals

## Death Penalty; Ala. R. Crim. P. 32; Fair Justice Act

***Ex parte State (v. Abernathy, No. CR-2023-0825 (Ala. Crim. App. Jan. 5, 2024)***

Applicable only to capital murder/death penalty cases, the Fair Justice Act, Ala. Code § 13A-5-53, provides that a post-conviction petition under Ala. R. Crim. P. 32 must be filed within 365 days of the filing date of the petitioner's appellant's brief on direct appeal. However, the circuit court can grant up to a 270-day extension for good cause if the petitioner's counsel fails to file a timely petition and new counsel is appointed. Here, the state was entitled to mandamus relief from the circuit court's granting of a 270-day extension because the petitioner's counsel had not failed to file a petition or filed an untimely petition; the filing date for the appellant's brief on direct appeal had not passed.

## Probation Revocation; Hearsay

***Watts v. State, No. CR-2023-0338 (Ala. Crim. App. Dec. 15, 2023)***

The circuit court erred in revoking probation based on the probationer's alleged commission of assault and discharge of a firearm into a vehicle. The rules of evidence do not apply to probation revocation proceedings, *see* Ala. R. Evid. 1101(b)(3), and hearsay is thus admissible; however, the trial court cannot basis its decision to revoke solely on hearsay. Here, an officer testified that he collected shell casings from the alleged crime scene and viewed both the victim's injury and bullet holes in the car windshield, but there was no non-hearsay evidence that connected the probationer to the shooting.

## Ineffective Assistance of Counsel; Split Sentence Act

***Cosper v. State, No. CR-2022-1168 (Ala. Crim. App. Dec. 15, 2023)***

The circuit court did not err in denying the defendant's motion for a new trial that alleged several ineffective assistance of trial counsel claims. Reviewing the claims under the standard of *Strickland v. Washington*, 466 U.S. 668 (1984), the court found that counsel was not ineffective by not objecting to the stalking victim's testimony that the defendant was "hallucinating," "paranoid," and "crazy," because her description was based on her personal observation of his conduct. There was also no ineffectiveness in not presenting cumulative evidence. The defendant's claim that counsel was also ineffective due to a conflict of interest was barred from review because it was not timely presented to the trial court within 30 days of sentencing. While affirming the defendant's convictions, the court remanded for a split sentence in compliance with the Split Sentence Act, Ala. Code § 15-8-8, in effect at the time of the offenses.

## Authentication of Video; Preservation of Error in Jury Instruction; Double Jeopardy

***Hooks v. State, No. CR-21-0410 (Ala. Crim. App. Dec. 15, 2023)***

The Alabama Court of Criminal Appeals affirmed the defendant's assault conviction, finding that a jail surveillance video of the assault was properly authenticated through an officer's testimony regarding the reliability and trustworthiness of the surveillance system. The defendant failed to preserve his arguments against the circuit court's oral charge regarding flight and its failure to instruct the jury regarding a lesser-included offense. The circuit court erred, however, in resentencing the defendant to a more severe sentence one day after it imposed its original sentence; the resentencing constituted double jeopardy.

## Municipal Pretrial Appeal of Dismissal; Writ of Mandamus; Recusal

***Town of Brookside v. Hester-Taylor, No. CR-2022-1082 (Ala. Crim. App. Dec. 15, 2023)***

The municipality was authorized to appeal from the municipal court's pretrial dismissal of the defendant's charges under Ala. R. Crim. P. 15.7. That dismissal, based on a pretrial determination of the credibility of the municipality, was erroneous. A court has no authority under Ala. R. Crim. P. 13.5(c)(1) to dismiss charges before trial based on an alleged insufficiency of the evidence or "based purely on a credibility

determination.” However, Rule 15.7 did not authorize a pre-trial appeal from the municipal court’s denial of a motion to recuse. Instead, the municipality could have timely petitioned for a writ of mandamus.

### **Authentication of Text Message; Recorded Recollection; Motion for a New Trial**

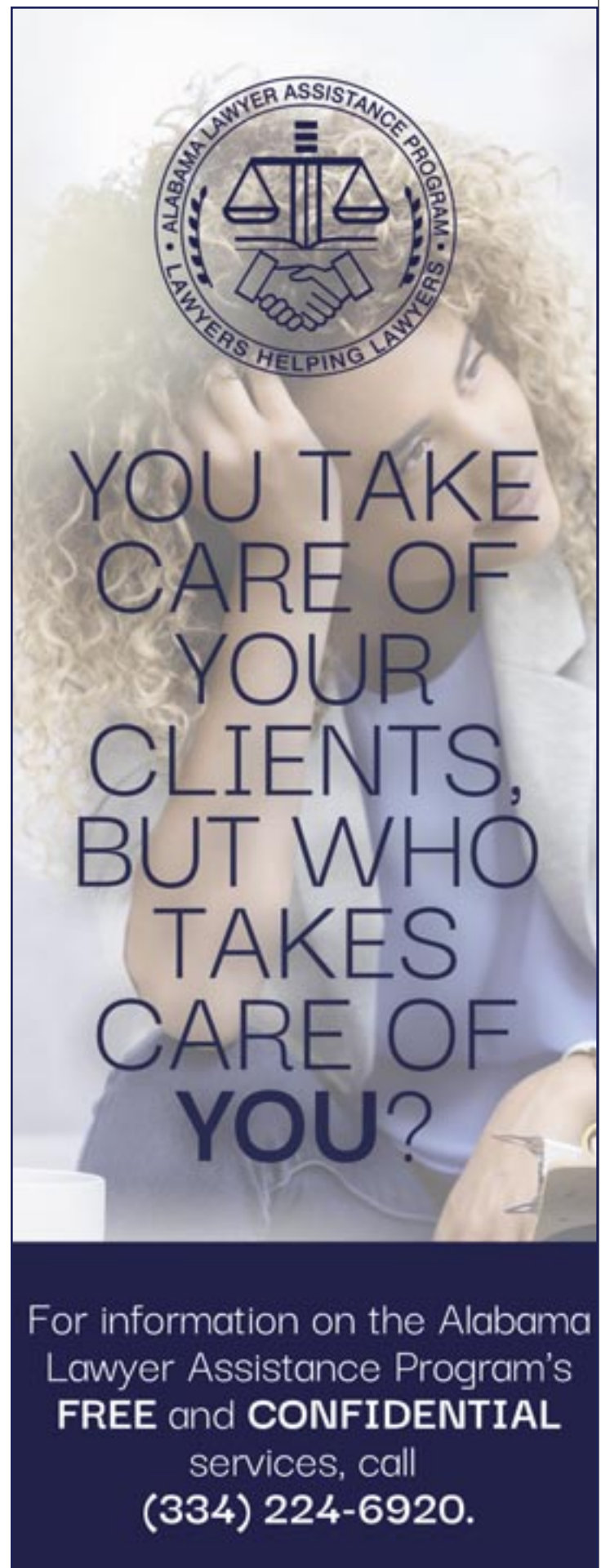
**Berry v. State, No. CR-20-0751 (Ala. Crim. App. Dec. 15, 2023)**

The circuit court did not err in admitting into evidence a photograph of the murder victim that was texted from the defendant’s phone. The recipient of the text testified that the photograph fairly and accurately depicted the messages that the defendant texted to him, and circumstantial evidence is sufficient to show that evidence is what its proponent purports it to be. The circuit court also properly allowed a written statement given to an investigator to be read into evidence as a recorded recollection under Ala. R. Evid. 803(5). Though the witness was unsure that it was his exact words, it could be inferred from his testimony that it reflected the information that he gave to the investigator and was admissible. The court remanded the case for the circuit court to make specific findings of fact regarding a potentially meritorious juror misconduct claim raised in a motion for a new trial that was denied by operation of law.

### **Ala. R. Crim. P. 32; Second Attempt at Death Penalty; Nitrogen Hydrogen Hypoxia**

**Smith v. State, No. CR-2023-0594 (Ala. Crim. App. Dec. 8, 2023)**

Relying on *Louisiana ex rel. Francis v. Resweber*, 329 U.S. 459 (1947) and other caselaw, the court found no error in the circuit court’s summary dismissal of the capital murder petitioner’s Ala. R. Crim. P. 32 petition. The first attempt to execute the petitioner was by lethal injection, but it failed because the execution team was unable to insert IV lines. A second attempt to execute the petitioner, this time by nitrogen hypoxia, did not constitute cruel and unusual punishment. Citing *Resweber’s* approval of a second attempt at electrocution after an initial attempt failed, the court observed that, “[i]f it is not cruel and unusual punishment to execute an inmate who has been subjected to a current of electricity in a previous failed execution attempt, then it is certainly not cruel and unusual punishment to execute an inmate after the failure to insert an IV line in a previous failed execution attempt.” ▲



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THE ALABAMA LAWYER





NOTICE

## DISCIPLINARY NOTICES

### ▲ Disciplinary Proceeding

### ▲ Reinstatement

### ▲ Disbarment

### ▲ Suspensions

## Disciplinary Proceeding

- **Darryl Tyrone Blackmon**, who practiced in Mobile and whose whereabouts are unknown, must answer the Alabama State Bar's formal disciplinary charges within 28 days of this publication, or, thereafter, the charges contained therein shall be deemed admitted and appropriate discipline shall be imposed against him in ASB Nos. 2022-1213, 2023-609, and 2023-661 before the Disciplinary Board of the Alabama State Bar. [ASB Nos. 2023-609, 2023-661, and 2022-1089]

Disciplinary Board, Alabama State Bar

## Reinstatement

- **Todd Stephen Strohmeyer**, who formerly practiced in Birmingham, was reinstated to the practice of law in Alabama by order of the Supreme Court of Alabama, effective December 13, 2023. Strohmeyer was previously suspended from the practice of law for failing to comply with the 2020 Mandatory Continuing Legal Education requirements of the Alabama State Bar. [Rule 28, Pet. No. 2023-886]

## Disbarment

- Birmingham attorney **Sandy Eugene Lee** was disbarred from the practice of law in Alabama by order of the Supreme Court of Alabama, effective November 17, 2023. The Supreme Court of Alabama entered its order based upon the November 17, 2023 order of Panel III of the Disciplinary Board of the Alabama State Bar. The Supreme Court of Alabama entered its order based on the Disciplinary Board's acceptance of Lee's consent to disbarment, wherein Lee admitted to inappropriate conduct with a client. [Rule 23(a), Pet. No. 2023-1650; ASB No. 2023-1410]

# Suspensions

- Albertville attorney **Albert Dalton Chandler** was summarily and inter-  
imly suspended from the practice of  
law in Alabama by order of the Disci-  
plinary Commission of the Alabama  
State Bar, effective October 11, 2023.  
The Disciplinary Commission's order  
was based on a petition for sum-  
mary/interim suspension filed by the  
Office of General Counsel of the Ala-  
bama State Bar wherein it was deter-  
mined that Chandler was engaging  
in continuing conduct that was  
causing or likely to cause immediate  
and serious injury to a client or the  
public. The Alabama Supreme Court  
noted Chandler's interim suspension  
effective October 11, 2023. [Rule 20(a);  
Pet. No. 2023-1511]
- Huntsville attorney **Perrar Aquity  
Joseph** was summarily suspended  
from the practice of law in Alabama,  
pursuant to Rule 20(a), Alabama  
Rules of Disciplinary Procedure, by  
order of the Disciplinary Commis-  
sion of the Alabama State Bar, effec-  
tive April 20, 2023. The Disciplinary  
Commission's order was based on a  
petition filed by the Office of Gen-  
eral Counsel that Joseph failed to re-  
spond to requests for information  
during a disciplinary investigation.  
On May 23, 2023, after having ad-  
dressed the underlying disciplinary  
investigation with the Office of Gen-  
eral Counsel, Joseph motioned for  
dissolution of the summary suspen-  
sion. Thus, the summary suspension  
and corresponding restraining order  
were dissolved by order of the Disci-  
plinary Commission of the Alabama  
State Bar, effective May 31, 2023.  
[Rule 20(a); Pet. No. 2023-613] ▲

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Judge Bob Vance\*, Judge Jake Walker\*, Jonathan Lowe

**We welcome Mary Pilcher to our panel of mediators and arbitrators.**



**Mary Pilcher is a Harvard Law School trained mediator with more than 30 years of litigation experience, with a focus on employment, civil rights, and business disputes.**  
Mary is registered on the Alabama State Court Mediator Roster.  
She is a member of the Fairhope law firm of Stein & Pilcher, LLC. Before entering private practice, she interned with Alabama Chief Justice C.C. Torbert and U.S. Senator Richard Shelby and served as a law clerk under U.S. District Court Judge Brevard Hand.



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## ABOUT MEMBERS, AMONG FIRMS

Please email announcements to  
[margaret.murphy@alabar.org](mailto:margaret.murphy@alabar.org).

### About Members

**William H. Robertson, V** announces the opening of the **Robertson Law Firm**, 302 East Broad St., Eufaula 36027. Phone (334) 845-7980.

**Watson & Smith LLC** announces a name change to **William T. Watson Law, LLC** with offices at 1655 McFarland Blvd., N, PMB 190, Tuscaloosa 35406-2212. Phone (205) 344-3013.

### Among Firms

**Badham & Buck** of Birmingham announces that **Christopher Driver** is a partner in the firm.

**Baker Donelson** announces that **Boston Topping** joined as an associate in the Birmingham office.

**Balch & Bingham LLP** announces that **Robert Baxley** is a partner in the Birmingham office.

**Bradley Arant Boult Cummings LLP** announces that **Chandler Combest; Thomas L. Oliver, III; T. Brooks Proctor; and Emily M. Ruzic** were promoted to partner and that **William C. Athanas** joined the Birmingham office as a partner.

**Butler Snow LLP** announces that **Ghada N. Abouhaidar** and **Trent A. Mansfield** joined as associates in the Birmingham office.

**Cory Watson PC** of Birmingham announces that **Andy Jones** and **Mitchell Theodore** are now principal attorneys.

**FarmerPrice LLP** of Dothan announces that **Thomas T. Anderson** joined of counsel.

**F&B Law Firm PC** of Huntsville announces that **Patrick E. Sebesta, II** is a shareholder.

Hill Hill Carter of Montgomery announces that D. Craig Allred has been named a Shareholder of the Firm.

**Hollis, Wright & Clay PC** announces that **Michael Eldridge** and **John Spade** are partners.

**Lanier Ford Shaver & Payne PC** of Huntsville announces that **Chad Ayres, Katie Beasley, Suzanne Currie, Sam Givhan, Ashley Jones, and Elena Moats** are shareholders, and **Adam Woelke** is an associate.

**Lightfoot, Franklin & White LLC** of Birmingham announces that **Amaobi Enyinnia, Benjamin Harmon, and Rachelle Sanchez** are partners.

**Little Mendelson PC** announces that **Patrick Schach** is a shareholder in the Birmingham office.

**Mann & Potter PC** of Birmingham announces that **Steven Cole** and **Courtney Hutchinson Ealy** are equity principals in the firm.

**Phelps Dunbar LLP** announces that **Danielle Mashburn-Myrick** is a partner in the Mobile office.

**Pope, McMeekin & Wood PC** of Birmingham announces that **J. Vincent Swiney, II** is a shareholder, and the new firm name is **Pope, McMeekin, Wood & Swiney PC**.

**Prince Glover Hayes PC** of Tuscaloosa announces that **Coe Baxter** and **Blake Williams** are partners and **Grace Prince** joined the firm.

**Rushton Stakely** announces the opening of a Birmingham office at 1901 6<sup>th</sup> Ave. N., Ste. 1000, 35203 and that **Scott Dickens, Chase Eley, Andy Laird, Katie Marie McEntyre, Phil Piggott, and Jeannie Walston** joined the firm.

**Starnes Davis Florie** of Birmingham announces that **Ben Kearns** joined the Mobile office.

**Swift, Currie, McGhee & Hiers LLP** of Birmingham announces that **Richard Whitaker** joined as an associate.

**Timberlake & League PC** announces that **W. Heath Brooks** is a shareholder, and the firm name is **Timberlake, League & Brooks PC**.

**Truck Wreck Justice** announces that **R. Sean McEvoy** joined as national trucking litigation counsel in the Atlanta office.

**Upchurch Watson White & Max** announces that **Robert Cooper** joined as a neutral in the Birmingham office. ▲



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