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Tamara Kurtz
City of Austin
4120 Kachina Drive
Austin, TX 78735
512/974-2526 Fax 512/974-6491

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Attorney at Law
777 Dunlavy, #8105
Houston, TX 77019
713/822-5615

SECRETARY

J. Morgan Broadbuss
Gordon Davis Johnson & Shane P.C.
4695 North Mesa
El Paso, TX 79912
915/545-1133 Fax 915/545-4433

TREASURER

Veronica Jacobs
Houston Volunteer Lawyers Program
PO Box 262872
Houston, TX 77207
713/228-0735 Fax 713/228-5826

NEWSLETTER EDITOR

Marvin W. Jones
Sprouse Shrader Smith PC
701 S. Taylor, Suite 500
Amarillo, TX 79101
806/468-3344

IMMEDIATE PAST CHAIR

Herman Segovia
118 East Ashby Place
San Antonio, TX 78212
210/737-2200 Fax 210/737-2500

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800/204-2222, ext. 1819
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The College Bulletin

News for Members of the College of the State Bar of Texas Summer 2012



Looking Back and Looking Ahead

IT HAS BEEN MY HONOR TO SERVE AS CHAIR of the College of the State Bar of Texas this year and to be part of the proud tradition of this organization.

As you know, the College was established in 1981 by the Texas Supreme Court to improve attorney professionalism and recognize those lawyers who have provided outstanding service. Now, almost 31 years later, for the first time, all of our Texas Supreme Court Justices are members of the College. We are proud that our Justices have chosen to join us in leading the way toward ongoing professional excellence.

Although my term will end at the next College Board of Directors meeting in July, it has also been my honor to work with an outstanding group of individuals who serve as our Board of Directors. Their dedication toward improving the professionalism of Texas lawyers is second to none.

On that note, regarding attorney professionalism, the recipients of the Professionalism Award, the Best Continuing Legal Education Article Award, and the Most CLE Hours Award have been selected (see p. 3 of this *Bulletin*). More information about these awards and recipients is posted on the Texas Bar College website at www.texasbarcollege.com. Secondly, the College is once again providing scholarships to legal aid services attorneys to attend the 14th Annual State Bar College Summer School.

In closing, my best wishes to you for a rewarding year of professional accomplishments. I look forward to seeing you at the annual Summer School seminar.



DO YOU KNOW what "level" of College member you are? It may sound like an odd question to those of you who have belonged to the College for much of your professional career. That's because for

years—nay, decades—there was only one level of membership.

For a small sum (now \$60) per year, you received a host of benefits, including a \$25 discount on most TexasBarCLE live or video courses, as well as a special members-only price on College-sponsored CLE programs (including the popular Summer School program, about to be presented for the 14th year in a row; see pp. 10-11 of this *Bulletin*). These benefits alone could more than pay for one's membership. More recently, a new benefit was added: unlimited free access to TexasBarCLE's Online Library, housing over 15,000 downloadable CLE articles—a free subscription that normally sells for \$295 per year! Thus, for years College "Classic" members have enjoyed benefits that directly parallel their commitment to quality education and professionalism.

This year, we entered a new era! In January two new levels of membership took effect. (See Pat Nester's Executive Director column in the Fall 2011 *Bulletin*.) The "Silver" membership offers all the benefits of the Classic membership, plus unlimited free access to TexasBarCLE's Online Classroom, including live webcasts, for just \$395 per year. For less than the cost of many stand-alone CLE programs, a Silver member gains access to over 1,500 hours of recent programs

From the Chair



Tamara Kurtz



SILVER and GOLD memberships

available as streaming video, streaming audio, or even as downloadable mp3s files for listening on the go. The inclusion of live webcasts means another 100 or more hours per year of up-to-the-minute CLE—delivered right to one's computer or mobile device. And don't forget the written materials for all this CLE—searchable, easily stored, and accessible with the click of a mouse. Suffice it to say that this incredible membership level is garnering attention. In the mere five months that the Silver level of membership has been in effect, about 5% of the College's members have joined or renewed at this level. Why not more of them? Read on...

An even better option became available at the same time. The "Gold" membership offers all the benefits of the Silver level, plus unlimited free attendance at any or all of TexasBarCLE's live or video replay programs, for just \$995 per year. This includes literally hundreds of programs spread over at least 15 locales each year. If you love attending Texas-based CLE, meeting speakers, and networking with your colleagues—while still getting all the online CLE you want—I think it's safe to say there is no better deal on the planet. So far, about 6% of the College's members have joined or renewed at this level.

I'm pleased to report that the feedback among our members for these new levels of membership has been glowing. College Managing Director Merianne Gaston reports that several have said it is "the best thing the Bar has ever done." Others gleefully admit that they feel like a kid in a candy store, picking and choosing courses (live/video or online) that they have an interest in but wouldn't have otherwise spent money on since the courses did not relate directly to in their area of practice. They praise the convenience and ease of access and hope these offerings "will never go away."

I'd call this "an experiment that's working," wouldn't you? If this is the first you're hearing about the Silver and Gold levels of membership, I encourage you to consider them fully. What's your commitment to CLE?—to keeping up to date?—to staying connected to others in your area(s) of practice? The College and TexasBarCLE have joined to make those goals more affordable than ever.

For more information, visit texasbarcollege.com and click on "Membership." ■



State Bar College Annual Awards

Each year, the College recognizes three persons who demonstrate an exceptional commitment to education or professionalism.

Jim D. Bowmer Professionalism Award for Outstanding Contributions to the Profession

Awarded annually since 1994, the award is named for Jim D. Bowmer of Temple, the originator of the idea of the State Bar College and a co-founding father of the College. A plaque is given to the recipient and an award of \$1,000 will be given to the Texas Equal Access to Justice Foundation in the name of the recipient.

For 2011 the award has been given to **James Cooper**, Co-Chair of the Policyholder Specialty Practice Group at Gardere Wynne Sewell LLP. Jim received the award at the Annual Banquet for the Garland R. Walker American Inn of Court on May 8 in Houston. "I am honored to receive this very prestigious award," says Jim, whose practice at Gardere focuses on insurance coverage litigation and arbitration, in addition to commercial maritime matters. "I am personally committed to professionalism in my own practice, and have always tried to mentor other lawyers to do the same through my bar-related activities."

Consistently recognized as a "Leading Lawyer for Business" by Chambers USA, Jim regularly appears in the Texas Super Lawyer list based on his work in insurance matters. A former co-chair of the Houston Bar Association's Professionalism Committee, he also serves as an editor of the LexisNexis Texas Annotated Insurance Code and is a Council Member of the State Bar's Insurance Law Section.



JAMES COOPER



JOHN G. BROWNING



UMEKA LEWIS

Franklin Jones, Jr. CLE Article Award for Outstanding Achievement in Continuing Legal Education

The award is named for Franklin Jones, Jr., a co-founding father of the College. A plaque is awarded to an author of an outstanding CLE article presented during the year. (Articles must be submitted by December 1 of each year in order to be considered for the award.)

For 2011 the award goes to **John G. Browning** for his article, "Social Media in the Jury Box," presented at TexasBarCLE's 14th Annual Advanced Civil Trial Course. John is the managing partner of the Dallas office of Lewis Brisbois Bisgaard & Smith, LLP, where he handles civil litigation in state and federal courts in areas ranging from employment and intellectual property to commercial cases and defense of products liability, professional liability, media law, and general negligence matters. He has extensive trial, arbitration, and summary judgment experience and has represented companies in a wide variety of industries throughout Texas and on a pro hac vice basis in other jurisdictions. Some of his honors include being rated "AV," the highest commendation issued by Martindale-Hubbell for legal ability, ethics, and professionalism; selected as a "Super Lawyer" in the field of Civil Litigation Defense; inducted as a Charter Fellow of the Litigation Counsel of America, and elected to the American Law Institute (one of only seven lawyers in Texas elected in 2009).

A noted legal writer and frequent contributor to national and regional legal publications, he writes a respected weekly syndicated newspaper column, "Legally Speaking." His book, *The Lawyer's Guide to Social Networking: Understanding Social Media's Impact on the Law*, was published in December 2010 by Thomson Reuters\ West Publishing. A member of the Texas Association of

Defense Counsel and the International Association of Defense Counsel, he also serves as an adjunct professor at SMU Dedman School of Law, where he teaches "Social Media and the Law." The author of numerous articles on social media-related topics, he has been quoted on the subject by the *New York Times*, *TIME* Magazine, Salon.com, *Inside Counsel* Magazine, *Law 360*, and other publications.

Steve Condos Most CLE Hours Award

The award is named for Steve Condos, an influential and hardworking member of the first College Board for a brief period before his untimely death. It is given annually to the College member who, in his or her initial year of membership, attends the most CLE, with not more than 25 hours counted for any one CLE course.

According to the State Bar's MCLE department, the most hours earned by a new member to the College in 2011 is **Umeka Lewis**, with 230 hours earned. Umeka is a partner at the Escobar Lewis Law Group in Houston. Since her practice handles matters ranging across a fair number of practice areas, including criminal, personal injury, real estate, consumer, immigration, and small business law, Umeka has sought to gain as much continuing legal education as possible. A 2010 graduate of the Thurgood Marshall School of Law at Texas Southern University, she is a member of the National Bar Association, the Houston Lawyers Association, the Harris County Criminal Lawyers Association, the Earl B. Gilliam Bar Association, and the American Bar Association. In an effort to be a role model for her daughter Meisha, Umeka spends many hours assisting the community doing pro bono cases and community education through the Houston Volunteer Lawyers Program.

Please join us in congratulating our award winners! ■

Intellectual Property Issues



By Al Harrison

THE MARK “THUMBDRIVE” has recently been granted trademark registration. Trek 2000 International Ltd., a company headquartered in Singapore, has been granted registration on the Principal Register of the United States Patent and Trademark Office. See, *In re Trek 2000 International Ltd.*, 97 U.S.P.Q.2d 1106, 2010 WL 5099653 (Trademark Tr. & App. Bd.). Surely this official recognition of trademark status for a term that has seemingly been incorporated into technology-related vernacular — interchangeably with the term “flash drive” — cannot be. Can it? But, a review of the historical background associated with the use of this term shows that Trek 2000 coined the term “thumbdrive” as early as 2000.

Historical Background

In 2000, Trek 2000 coined the term “thumbdrive” to suggest a unique portable storage device related to its underlying patented technology. THUMBDRIVE has been used continuously since its genesis as a brand. Then, in January 2005, an application was filed for registration of the THUMBDRIVE mark on the Supplemental Register as a trademark for goods identified as:

portable digital electronic devices for recording, organizing, transferring, storing, and reviewing text, data, image, audio and video files; computer software for use in recording, organizing, transferring, storing, and reviewing text, data, image, audio and video files on portable digital electronic devices

in International Class 9. This Supplemental Registration was granted in November 2006. With continuing use of the THUMBDRIVE trademark in commerce, Trek 2000, in February 2007, filed an application to register THUMBDRIVE on the Principal Register in order to attain a plethora of statutory benefits available under the Lanham Act, 15 U.S.C. § 1052.

Registration on the Supplemental Register

Under United States trademark law, the Supplemental Register is the secondary register of trademarks maintained by the United States Patent and Trademark Office. See, Lanham Act, 15 U.S.C. § 1091. Among other reasons for having a secondary register, the Supplemental Register permits registration of marks that do not meet all the requirements for trademark registration on the Principal Register, but that nonetheless are capable of distinguishing goods or services. Unlike registration on the Principal Register, registration on the Supplemental Register confers no rights beyond otherwise available common law rights. Marks registered on the Supplemental Register afford constructive notice of purported use for trademark purposes and may also constitute the basis for filing suit for trademark infringement. With continuous use, usually at least five years, an application may be filed seeking to elevate registration status from the Supplemental Register to the Principal Register (as was ultimately achieved by Trek 2000).

Prosecution of Application for Registration on Principal Register

The trademark attorney examining Trek 2000’s application

on behalf of the Commissioner For Trademarks initially refused registration on the basis that the THUMBDRIVE mark was merely descriptive and the accompanying declaration of acquired distinctiveness was insufficient to establish acquired distinctiveness. After Trek 2000 submitted additional evidence of acquired distinctiveness, this refusal of registration was withdrawn and the application was approved for publication. The application passed the scheduled 30-Day Publication Period without incident (e.g., no opposition filed, etc.) and Trek expected registration to issue in due course — as is the normal Rule of Thumb. Unfortunately for Trek, the examining attorney (after walking through a procedural hoop) refused registration on the basis that the proposed mark was generic and, accordingly, unregistrable.

Trek 2000, after denial of its petition complaining about the examining attorney's behavior, and the examining attorney subsequently issuing a final refusal, filed an appeal to the Trademark Trial and Appeal Board and a simultaneous request for reconsideration by the examiner. Once the examining attorney denied the request for reconsideration, the appeal moved forward.

Appeal of Refusal to Issue Registration on Principal Register

The only issue to be decided by the Trademark Trial and Appeal Board (TTAB) was whether THUMBDRIVE was generic for the enumerated goods. Whether a term is generic and, accordingly, not worthy of serving as either a trademark or service mark, is a question of fact. When a proposed mark is refused registration as being generic, the examining attorney has the burden of proving genericness under a "clear evidence" standard. This issue devolves to whether the record shows that members of the relevant public primarily use or understand the term sought to be registered as referring to the class of goods or services in question. A twofold inquiry is prerequisite for the TTAB to arrive at this determination: (1) What is the genus of goods or services at issue? (2) Is the term sought to be registered understood by the relevant public primarily to refer to that particular genus of goods or services?" It should be noted that such evidence of the public's understanding may be derived from a panoply of competent sources, including testimony, surveys, dictionaries, trade journals, newspapers and other publications, and the Internet.

The TTAB emphasized that, in the course of making this determination, the focus should be to prevent competitive harm. Generic terms, inherently incapable of indicating source, are the antithesis of trademarks, and can never attain trademark status. Citing the Court of Appeals for the Seventh Circuit, the TTAB stated:

To determine that a trademark is generic and thus pitch it into the public domain is a fateful step. It penalizes

the trademark's owner for his success in making the trademark a household name and forces him to scramble to find a new trademark. And it may confuse consumers who continue to associate the trademark with the owner's brand when they encounter what they thought a brand name on another seller's brand. ... The fateful step ordinarily is not taken until the trademark has gone so far toward becoming the exclusive descriptor of the product that sellers of competing brands cannot compete effectively without using the name to designate the product they are selling.

Ty Inc. v. Softbelly's Inc., 353 F.3d 528, 69 USPQ2d 1213, 1215 (7th Cir. 2003).

The protection of the public interest includes assuring that sellers are not precluded from using a particular term prerequisite to competing effectively in the marketplace. It is well-established that competitors opting to invoke similar words or other terms do not necessarily transform a generic term into trademark-eligibility. But, under circumstances in which the evidence of record fails to show that competitors use the designation in issue, sufficient doubt may be created whether a term primarily refers to a genus of goods such that sellers of competing brands cannot compete effectively without invoking the particular name or term to designate the product being sold.

In support of the refusal of registration, the examining attorney posited several commercial illustrations including: (1) Web page printout from www.google.com defining THUMB DRIVE as "one of many terms used in popular language for USB flash drive"; (2) Web page printout from www.pexagontech.com, an online retailer, with the following display, Web page printout from www.inveo.org "Do you have old thumb drives (otherwise known as USB Memory Sticks) at your office or home that you don't use anymore? We're collecting these drives to share with the organizations we work with."; (3) An article appearing on www.thinkgeek.com displaying a picture of a flash drive that is not from applicant with the following text "This Thumb Drive will self-destruct in 10 seconds... Thumb drives are a convenient and cool way to carry around your data, and with drive sizes in the gigabytes..."; (4) Commentary from ask-leo.com titled "Can a USB thumbdrive 'wear out'?" which includes "Flash memory, the type of memory used in USB thumb drives and other devices, is very, very cool. ... Now, in your case, you're using USB thumbdrive in perhaps the worst possible way for longevity. ... The best use of USB thumb drives and other flash memory based devices is simply copy-to and copyfrom."; (5) Commentary from tech-yahoo.com titled "Create a Thumbdrive Loaded with Portable Apps in One Easy Step" "... I just opened a drawer in my office



to find, literally, a dozen USB thumbdrives just collecting dust.”; (6) An online article from the National Institutes of Health which includes the statement “To minimize the risk of data loss in the event your laptop is stolen, use an encrypted thumb drive to back up sensitive data and keep it separate from your laptop.”; (7) Articles from the “New York Times” Article dated April 24, 2008 (“A Four-Gigabyte Thumb Drive With Two Safety Nets”), and “The Houston Chronicle” dated August 22, 2007 (“But consider this list taken from a back to the U cheat sheet on the web: personal audio player, noise-canceling earphones, USB thumbdrive...”).

The examining attorney contended that the evidence of record was competent and diverse, and also adequately showed the relevant consumers’ understanding of the term THUMBDRIVE as identifying a genus of goods, thereby supporting the finding that the mark was generic for the identified goods. Regarding the prior registration on the Supplemental Register, the examining attorney stated that the term THUMBDRIVE has become generic during the time period elapsed since original examination in 2005. The relentless examiner further noted that “[a] term that was once arbitrary or suggestive may lose its distinguishing and origin-denoting characteristics through use in a descriptive sense over a period of time, and can thus come to be regarded by the purchasing public as nothing more than a descriptive designation.”

To traverse the examining attorney’s refusal, Trek advised the TTAB that the evidentiary burden had not been satisfied and that the prosecution history and prior Supplemental Register Registration, not to mention the evidence of record — collectively demonstrate “doubt” whether the mark is actually generic. Trek relied on the prior determination effectuated on behalf of the Commissioner For Trademarks that led to its registration on the Supplemental Register; and since this registration, Trek had continued to strengthen and protect its mark. In support of its position, the declaration of Trek’s CFO was submitted along with exhibits illustrating domestic

THUMBDRIVE brand sales and uses of THUMBDRIVE on the Internet and on products and product packaging. This declaration stated that between 2002 and 2007 Trek 2000 U.S.

sales of THUMBDRIVE devices totaled over \$4.3 million. Furthermore, Trek submitted evidence that it designs, manufactures and sells a family of THUMBDRIVE branded products, including THUMBDRIVE Touch, THUMBDRIVE Swipe and THUMBDRIVE Tuner portable USB storage devices. The icing on the cake was that there was also proof that Trek authorized other companies to co-brand and domestically sell USB storage devices bearing the THUMBDRIVE trademark — including such reputable companies as Memorex, Creative Technology, Imation, Iomega and TEAC. The TTAB was impressed with Trek actively “policing” its asserted trademark, illustrated by copies of notice/demand letters to and responses from various media outlets, including such significant players as *PC Magazine* and *The New York Times*, whereby agreement was reached to cease and desist from using THUMBDRIVE in a generic manner.

The TTAB found that the genus of goods at issue was adequately defined by portable digital storage devices and software used in connection therewith. The Board noted that to assess the public’s understanding of the term thumbdrive, the relevant public consisted of the ordinary consumer interested in purchasing flash drives or portable digital storage devices. It was reiterated that the evidentiary burden of establishing that a term is generic rests squarely upon the shoulders of the Commissioner For Trademarks acting for the United States Patent and Trademark Office and that the showing must be based on clear evidence.

While the record showed use of the term THUMBDRIVE to refer to a genus of goods, it also showed the origin of the term as a trademark and extensive use thereof as a trademark. It was not rebutted by the record that Trek coined this term and used it as a brand name in connection with a new product on the market. Moreover, from the outset, Trek used other terminology as the name of the

goods, e.g., “external storage device.” This record also shows that “flash drive” is the commonly used term of art for these portable digital storage devices. The TTAB found that, regarding dictionary definitions, the record showed that mainstream reference works do not have a listing for THUMBDRIVE. While the record included a few examples of online retailers using the term THUMBDRIVE or THUMB DRIVE in a generic manner, it was noticeable that there were no examples of competitors using this term, and applicant submitted excerpts from competitors’ websites showing the absence of that term and the use of “flash drive” as the name of the goods. In other words, the evidence did not “demonstrate a competitive need for others to use” this term.

As noted in *America Online*, the Federal Circuit has addressed a similar case where there was a mixed record on the question of genericity. *America Online*, at 77 USPQ2d at 1623, citing *Merrill Lynch*, 4 USPQ2d at 1143. Similarly, it was found that “the evidence of generic use is offset by applicant’s evidence that shows not only a significant amount of proper trademark use but also trademark recognition” by third parties. Thus, the TTAB declined to conclude that “members of the relevant public primarily use or understand the term sought to be protected to refer to the genus” of the goods. The Board opined that, at a minimum, the record created doubt and that it was constrained to resolve that doubt in favor of *Trek*.

The TTAB reiterated that the ultimate purpose behind the prohibition of registration of generic terms springs from a statute that regulates commerce - not the English language. “By this decision, we are not undermining the well established principle that the availability of other words for competitors to use does not, by itself, transform a generic term into registrable matter, but the complete absence of competitor use after ten years of these products being on the market tends to indicate that THUMBDRIVE has not fully entered the public domain. Today, with

a 24-hour news cycle and 24/7 online global activity, undoubtedly many trademarks are misused repeatedly, perhaps, in part, because there is less time for editing and reflection before news reports or blog posts are released, and, in part, because what was the casual spoken word between people is now the written word posted to the world.”

The TTAB also addressed the examining attorney’s argument that, while certain businesses correctly use the term THUMBDRIVE referencing *Trek 2000*’s goods “does not negate the evidence of record that shows wide and varied use of the term THUMBDRIVE (and/or THUMB DRIVE) in a generic sense such that the relevant consumers

perceive the primary significance of the term as generic for external digital storage devices.” It was stated that, under circumstances in which a coined term used as a trademark is quickly adopted by the public — but not by competitors — and in which the stakes are “the fateful step” of full “eradication” of an applicant’s “commercial rights,” the evidentiary burden on the examining attorney acting for the Commissioner For Trademarks is heavy.

While evidence of competitor use is not required to satisfy this heavy burden, where the record demonstrates both trademark and generic uses, evidence of the lack of competitor use, at a minimum, may create doubt sufficient to tip the balance in favor of registration. Accordingly, it was held that the Commissioner for Trademarks had not met the burden to establish by clear evidence that THUMBDRIVE was generic for the identified goods. Furthermore, since the examining attorney found that, if the term were found not to be generic, then it would be conceded that the evidence showed that THUMBDRIVE had acquired distinctiveness, then it merited registration. The examining attorney’s refusal to register was reversed and the mark in the application proceeded to issue, with registration on the Principal Register granted in due course.



AL HARRISON is a Houston-based patent attorney having a technical background in engineering and computer applications. A past chair of the State Bar Computer & Technology Section, he continues to serve as a council member. He is also past chair of the Computer Law Committee of the State Bar Intellectual Property Law Section and is a member of the Law Practice Management Committee. He has been a board member and committee chair of the Houston Intellectual Property Law Association.

Paralegal Professionalism Through Education

By Susan Wilen, RN
President, State Bar Paralegal Division

IN 1981, A GROUP OF WORKING PARALEGALS in Texas gathered to form the Legal Assistants Division of the State Bar of Texas, the first such Division of any State Bar in the country. The stated purpose of the Division, as adopted, was "to enhance legal assistants' participation in the administration of justice, professional responsibility and public service in cooperation with the State Bar." An additional reason for forming the Division was to provide a state-wide organization for legal assistants which would serve as a central vehicle for effective communication and resolution of matters of mutual concern to legal assistants throughout the State.

Over time, the Legal Assistants Division transformed into the Paralegal Division of the State Bar of Texas as a way of distinguishing themselves from other legal professionals. In 2005, the State Bar of Texas Board of Directors, and the Paralegal Division of the State Bar of Texas, adopted a new definition for "Paralegal. "A paralegal is a person, qualified through various combinations of education, training, or work experience, who is employed or engaged by a lawyer, law office, governmental agency, or other entity in a capacity or function which involves the performance, under the ultimate direction and supervision of a licensed attorney, of specifically delegated substantive legal work, which work, for the most part, requires a sufficient knowledge of legal principles and procedures that, absent such a person, an attorney would be required to perform the task."

For attorneys to practice law, the educational standard is completion of a three year law school program and passage of the State Bar exam. Membership in the State Bar is mandatory in order to practice in the State of Texas. However, paralegals have many different avenues that prepare them to function in the legal system. Paralegal programs range from certificate programs in "for-profit" business schools to Associate degree, Baccalaureate degree, and Master's degree programs in Paralegal Studies. Membership in the Paralegal Division is voluntary.

In order for a student to qualify for student membership in the Paralegal Division they must attend an ABA approved program of education and training for paralegals that consists of a minimum of sixty (60) semester hours (or equivalent quarter hours) of which fifteen (15) are substantive legal courses; or consists of fifteen (15) semester hours of substan-

tive legal courses. Students who prepare through on-line only programs do not qualify for membership in the Division.

To qualify for Active membership in the Division, an individual must perform substantive legal work 80% of the time, must have worked at least a year as a paralegal, and must either complete a Paralegal Studies program, (with criteria as outlined for student members); have specialty certification through the Texas Board of Legal Specialization (TBLS) or a national paralegal organization such as the National Association of Legal Assistants (NALA) or the National Federation of Paralegal Associations (NFPA); have a Baccalaureate degree in another field of study but working for at least a year as a paralegal; or worked for four years under the direct supervision of an attorney.

On April 21, 2006, the State Bar of Texas Board of Directors approved amending the paralegal definition by including standards which are intended to assist the public in obtaining quality legal services, assist attorneys in their utilization of paralegals, and assist judges in determining whether paralegal work is a reimbursable cost when granting attorney fees.

Attorneys are encouraged to support education, training, and work experience by promoting paralegal attendance at continuing legal education programs, paralegal board certification through the Texas Board of Legal Specialization (TBLS); certification through a national paralegal organization such as the National Association of Legal Assistants (NALA) or the National Federation of Paralegal Associations (NFPA); and membership in the Paralegal Division of the State Bar and/or local paralegal organizations.

In hiring paralegals, attorneys are encouraged to consider the following: the educational program attended by the candidate, whether they have a specialty certification, or whether they have a bachelor's or higher degree in any field combined with a minimum of one (1) year of employment experience performing substantive legal work under the direct supervision of a duly licensed attorney.

Although it is desirable that an employer hire a paralegal who has received legal instruction from a formal education program, the State Bar recognizes that some paralegals are nevertheless qualified if they received their training through previous work experience. In the event an applicant does not

meet the educational criteria, it is suggested that only those applicants who have obtained a minimum of four (4) years previous work experience in performing substantive legal work, as that term is defined below, be considered a paralegal.

“Substantive legal work” includes, but is not limited to, the following: conducting client interviews and maintaining general contact with the client; locating and interviewing witnesses; conducting investigations and statistical and documentary research; drafting documents, correspondence, and pleadings; summarizing depositions, interrogatories, and testimony; and attending executions of wills, real estate closings, depositions, court or administrative hearings, and trials with an attorney.

“Substantive legal work” does not include clerical or administrative work. Accordingly, a court may refuse to provide recovery of paralegal time for such non-substantive work. *Gill Sav. Ass’n v. Int’l Supply Co., Inc.*, 759 S.W.2d 697, 705 (Tex. App. Dallas 1988, writ denied).

Having paralegals that can perform their work in efficient and effective ways can be an extremely important factor on the bottom line of any legal enterprise, but having an informed and professional paralegal can transform a business. In this very competitive legal market, clients are scrutinizing bills in very aggressive ways. They are also scrutinizing the credentials of the paralegals that are billing on their files. Hiring a paralegal with an excellent resume may make the difference in whether fees can and will be recovered.

The Paralegal Division believes that providing CLE is one of its most important responsibilities to its members. As such, each District in the Division is expected to provide a minimum of three hours of CLE each membership year. The Division also sponsors the Texas Advanced Paralegal Seminar (TAPS), a three day seminar with approximately 60 speakers from at least ten different specialty areas of practice. Our members have the opportunity to receive 14 hours of CLE during this seminar, networking with other paralegals from all over the State.

It is with great pride that the Paralegal Division of the State Bar of Texas continues to promote the importance of educational preparation, educational standards, and the need for continuing legal education for its members. It is only through education that we will continue to contribute to the legal profession in a meaningful way.



SUSAN WILEN, RN is a Nurse Paralegal for Brin & Brin, LP in San Antonio, Texas and has been involved in healthcare litigation since 1992. President of the State Bar of Texas Paralegal Division for 2011-2012, she has been a member since 2004.

How I Became a College Member: One Paralegal’s Story

By Nicole D. Gonzalez, CP

Assisted by attorney Amanda Johnson

Last year the Texas Board of Legal Specialization accepted my application to take the Paralegal Certification exam for Estate Planning and Probate Law. I immediately started gathering study materials and calculating my CLE to meet the 30 hour requirement for the certification process.

It wasn’t long before I realized I lacked substantial study resources and CLE hours. I had no choice but to enroll in any available courses that qualified for my exam section and pay the full price that came with it. Although I considered it an “investment” in my career, I would have preferred the benefits members receive as part of The College of the State Bar of Texas – such as the 61% discount from the retail price of video replays of TexasBarCLE advanced courses. The College also offers a free annual subscription to the TexasBarCLE online library with full access to course materials which would have proved priceless to me when studying for the exam.

Now the exam is history and I am a Board Certified Paralegal. A great advantage to preparing for the TBLS exam was increasing my CLE hours last year, thus qualifying for membership to The College. I am truly enjoying the 24/7 access to TexasBarCLE and feel like a kid in a candy store each time I login to the online library. Our law office and clients are already benefiting from the information obtained from the online library. I feel equally proud being a member of The College and Board Certified, as both designations represent professional excellence.

Thank you for the opportunity.

Nicole D. Gonzalez, CP

Board Certified Paralegal,
Estate Planning & Probate Law -
Texas Board of Legal Specialization
Sharpe & Associates, PLLC
Dallas, Texas

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LIVE

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MCLE CREDIT

17.75 HOURS (3 ETHICS)

MCLE COURSE NO: 901241329

Applies to the College of the State Bar of Texas and the Texas Board of Legal Specialization in the following areas and amounts:

Civil Appellate.....	5.75
Civil Trial Law	7.25
Consumer and Commercial.....	7.75
Criminal Law	4.25
Estate Planning and Probate	4.25
Family Law.....	10.25
Immigration and Nationality Law	2.25
Juvenile Law.....	1
Labor and Employment Law.....	7
Personal Injury Trial Law	6.25
Real Estate Law	5.75

Thursday

7.25 hrs including 1.25 hr ethics

8:00 **Registration**
Coffee and Pastries Provided

8:45 **Welcoming Remarks**
Course Director
Chad Baruch, *Rowlett*
Assistant Principal
Yavneh Academy of Dallas
The Law Office of Chad Baruch

UPDATES

8:55 **State Bar College Update**
Hon. Leta S. Parks, *Houston*
Vice-Chair, College of the State Bar of Texas
Attorney at Law

9:00 **State of the State Bar Address**
.25 hr
Buck Files, *Tyler*
President-Elect, State Bar of Texas
Bain, Files, Jarrett, Bain, & Harrison

9:15 **U.S. Supreme Court Update** .5 hr
Daniel Luke Geyser, *Dallas*
Gibson Dunn & Crutcher

9:45 **Texas Supreme Court Update**
.5 hr
Hon. Scott A. Brister, *Austin*
Former Justice
Supreme Court of Texas
Andrews & Kurth

10:15 **Break**

PRE-TRIAL

10:30 **Handling Arbitration** .5 hr
Shannon H. Ratliff, *Austin*
Ratliff Law Firm

Marla Diane Broaddus, *Austin*
Former Staff Attorney
Supreme Court of Texas
Ratliff Law Firm

11:00 **Choosing Your Forum: Where to File Suit** .5 hr
Eliot D. Shavin, *Dallas*
Adjunct Instructor
and Supervising Attorney
SMU Dedman School of Law

11:30 **Discovery** .5 hr
Hon. John K. Dietz, *Austin*
Judge, 250th District Court

12:00 **Luncheon Served**

ETHICS I

12:15 **Luncheon Presentation:
Navigating the Minefield -
Avoiding Malpractice Claims
and Grievances** .75 hr ethics
Moderator
Caren Ka-Pik Lock, *Lewisville*
Regional Vice President and
General Counsel
TIAA-CREF

Randy Johnston, *Dallas*
Johnston ♦ Tobey

William D. Cobb, Jr., *Dallas*
Cobb Martinez Woodward

1:00 **Break**

1:15 **State Bar College Awards
Presentation**

LITIGATION

1:30 **The New Litigation Rules: What You Need to Know**
.5 hr (.25 hr ethics)
Steven C. James, *El Paso*
Attorney at Law

2:00 **Evidence** .5 hr
George 'Tex' Quesada, *Dallas*
Sommerman & Quesada

2:30 **Citations: How the Blue Book Has Changed Since You Graduated** .5 hr
Chad Baruch, *Rowlett*
Assistant Principal
Yavneh Academy of Dallas
The Law Office of Chad Baruch

3:00 **Break**



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Moody Mansion



Coastal Pelican Photo Credit: GICVB Vadim Troshkin

CRIMINAL LAW

- 3:15 **Criminal Law Update** .5 hr
Hon. Maria Salas-Mendoza, *El Paso*
Judge, 120th District Court
- 3:45 **Unforeseen Consequences of Criminal Convictions** .75 hr (.25 ethics)
Randy T. Leavitt, *Austin*
Law Offices of Randy T. Leavitt
- 4:30 **Handling DWI Cases** .5 hr
Katheryn Heather Haywood, *Irving*
Attorney at Law
- 5:00 **Juvenile Law** .5 hr
Hon. Patrick J. Garza, *San Antonio*
Associate Judge
386th District Court
- 5:30 **Adjourn**
- 7:00-9:00 **Party by the Pool**

Friday

8 hrs including 1 hr ethics

- 8:00 **Coffee and Pastries Provided**

CONSUMER LAW

- 8:30 **Debt Collection Practices** .5 hr (.25 ethics)
Manuel H. Newburger, *Austin*
Barron & Newburger
- 9:00 **Defending Consumer Debt Lawsuits** .5 hr
Richard Tomlinson, *Houston*
Director of Litigation/Attorney
Lone Star Legal Aid
- 9:30 **Remedies in Consumer Law Cases** .5 hr
Richard McElvaney, *Houston*
Professor/Director
University of Houston Law Center
- 10:00 **Break**

ESTATE PLANNING

- 10:15 **Basic Estate Planning** .5 hr
Helen Bishop Jenkins, *Missouri City*
Executive Vice President
South Texas College of Law

- 10:45 **Your Non-lawyer Spouse's Rights to Your Law Practice** .75 hr
Jimmy Brill, *Houston*
James E. Brill, P.C.

Warren Cole, *Houston*
Law Office of Warren Cole

- 11:30 **Will and Guardianship Contests** .5 hr
Darlene Payne Smith, *Houston*
Crain, Caton & James

- 12:00 **Luncheon Served**

- 12:15 **Luncheon Presentation: Water Rights and Droughts** .5 hr
Mark McPherson, *Dallas*
McPherson LawFirm

- 12:45 **Break**

REAL ESTATE

- 1:00 **Foreclosures** .5 hr
Tommy Bastian, *Addison*
Barrett Daffin Frappier Turner & Engel
- 1:30 **Residential Construction Claims in the Post-TRCCA Era** .5 hr
Mark S. McQuality, *Dallas*
Shackelford Melton & McKinley
- 2:00 **Overview of 2011 Reform Legislation for Texas Property Owners Associations** .5 hr
Roy D. Hailey, *Houston*
Butler | Hailey

EMPLOYMENT LAW

- 2:30 **Employment Law Update** .75 hr
Katrina Grider, *Cypress*
Attorney at Law
- 3:15 **Covenants Not to Compete** .5 hr
Ann Marie Painter, *Dallas*
Morgan, Lewis & Bockius
- 3:45 **Break**

ETHICS II

- 4:00 **Conflicts of Interests** .5 hr ethics
Sydney McDole, *Dallas*
Jones Day

- 4:30 **Preservation of Error** .5 hr (.25 ethics)
Hon. David E. Keltner, *Fort Worth*
Kelly Hart & Hallman

- 5:00 **Electronic Briefs** .5 hr
Don Cruse, *Austin*
Law Office of Don Cruse

- 5:30 **Adjourn**

Saturday

2.5 hrs including .75 hr ethics

- 8:30 **Coffee and Pastries Provided**

FAMILY LAW

- 9:00 **Electronic Evidence** .5 hr (.25 ethics)
Emily Ann Miskel, *Plano*
Koons Fuller
- 9:30 **The Trial of a Property Case** .5 hr
Warren Cole, *Houston*
The Law Office of Warren Cole
- 10:00 **Child Support and the Special Needs Child** .5 hr (.25 ethics)
Karen L. Marvel, *San Antonio*
Sinkin & Marvel
- 10:30 **Third Party Standing** .5 hr
Wendy S. Burgower, *Houston*
Burgower & Rainwater
- 11:00 **Parentage** .5 hr (.25 ethics)
Joseph Indelicato, Jr., *Houston*
Joseph Indelicato, Jr., P.C.
- 11:30 **Adjourn**

View the course brochure

or register at TexasBarCLE.com. Click on **Seminars**, then search for the keywords "summer school."

If you prefer, call TexasBarCLE during regular business hours at 512-427-1574.

See you on the island!

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