Ethics Forum:
Issues in Intellectual Property Practice
Friday, October 24, 1997

Giles S. Rich Room
Franklin Pierce Law Center
Concord, New Hampshire

Program Schedule

:PM **Keynote Address**
Speaker: Karen L. Bovard, Esq.
Director, USPTO-OED

)PM **Break**

)PM **Panel Discussion***

Moderator: Professor Dick Hesse, FPLC

Panel Members:
Professor Chris Blank, FPLC
Thomas L. Bohan, Esq., Thomas L. Bohan & Associates, Portland, ME
Karen L. Bovard, Esq., USPTO-OED
Jerry Cohen, Esq., Perkins, Smith & Cohen, Boston, MA

Wine & Cheese Reception — The Jury Box

:e participation is encouraged during the Panel Discussion.

ETHICS IN PATENT PROSECUTION

Karen L. Bovard, Director
Office of Enrollment and Discipline
U.S. Patent and Trademark Office

who file patent and trademark applications before the Patent and Trademark Office
ıe Office) must be familiar with the PTO Code of Professional Responsibility (PTO
ıis paper includes citations to cases for most of the discipline cases decided since 1985,
ılights ethical considerations pertinent particularly to practice before the Patent and
ː Office in patent prosecution. This paper does not purport to present similarities and
s between the PTO Code, the American Bar Association Model Rules or Model Code
ional Responsibility, and the ethics codes or rules of various States or the District of

'PLICABLE CODES OF CONDUCT

Florida ex rel. Florida Bar, 373 U.S. 379 (1963) held that Florida's interest in regulating
e of patent law by a non-attorney before an administrative agency, the PTO, was
by the federal interest in regulating the same practice. The PTO relied on the federal
n in adopting the PTO Code. However, the PTO made every effort to minimize
n of State control over the practice of law. Thus, 37 CFR § 10.1, second sentence,

thing in . . . [these rules] shall be construed to preempt the authority of each
ıte to maintain control over the practice of law, except to the extent necessary
the Patent and Trademark Office to accomplish its federal objectives.

sion is based on the language in *Sperry v. Florida* and makes clear the PTO's intent to
ıly conduct related or relevant to practice before the Office.

state courts have no jurisdiction to prohibit registered practitioners from pursuing their
as patent attorneys, the same courts have found that they have concurrent jurisdiction
ne attorneys for misconduct in their capacity as patent attorneys.[1]

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of Davis, 264 N.W.2d 371 (Minn. 1978).

viduals Entitled To Practice Before The PTO

PTO regulates the recognition of individuals practicing before the Office in patent
:s.[2] Rules pertaining to the recognition of individuals to practice before the Office in
:nt cases are set forth in 37 CFR §§ 10.5, 10.6, 10.7, and 10.8. The individuals must
)f good moral character and repute; possess the legal, scientific and technical
lifications necessary to enable them to render patent applicants valuable service; and
:t take and pass an examination demonstrating that they are competent to advise and
st patent applicants in the presentation and prosecution of their applications before
Office.[3]

:s pertaining to the recognition of individuals to practice before the Office in
emark and other non-patent cases are set forth in 37 CFR § 10.14. Any attorney who
member in good standing with the bar of the Supreme Court of the State may practice
)re the Office in trademark and non-patent cases.[4] Unlike practice in patent cases,
e is no register of attorneys recognized to practice before the Office in trademark
:s.

Office of Enrollment and Discipline

rules for admission to practice before the Office and the PTO Code governing that
:tice are administered by the Office of Enrollment and Discipline (OED). OED is
)onsible for:

1. Preparing, administering and grading the registration examination.

2. Determining the qualifications of individuals applying for registration including moral character, legal, scientific and technical qualifications.

3. Registering individuals to represent patent applicants before the Office and maintaining a roster of registered practitioners.

4. Investigating complaints alleging possible unethical conduct by a practitioner and proceeding with disciplinary action where appropriate.[5]

A. § 500(d) (West 1977); 35 U.S.C.A. §§ 31 and 33 (West 1984).

10.7(a) and (b) (1995).

A. § 500(b) (West 1977).

ier is defined as "(1) an attorney or agent registered to practice before the Office in patent cases or (2) an orized under 5 U.S.C. 500(b) . . . to practice before the Office in trademark cases or other non-patent cases." (r) (1995).

) does not investigate alleged misconduct before another Government agency or ›re a State or Federal court. Nevertheless, the PTO may take disciplinary action :re the individual has been disciplined by another Government agency, or by a State or eral court.

E PTO CODE OF PROFESSIONAL RESPONSIBILITY

ode was promulgated by the Commissioner of Patents and Trademarks in 1985 after ›ublic comment.[6] The PTO Code is found in §§ 10.20 through 10.112 of Title 37 of Federal Regulations. The PTO Code is composed of Canons and Disciplinary Rules. Disciplinary Rules were modeled after the ABA Model Code of Professional lity (Model Code). The most notable departure from the Model Code is Disciplinary (c), which identifies 20 specific acts which the PTO considers to be misconduct.

pe of Application

PTO Disciplinary Rules apply to any practitioner representing persons before the) in patent, trademark, or other non-patent cases. For example, the Rules apply to a -registered attorney representing a PTO employee in a labor matter, or to a non-stered attorney representing a practitioner in a disciplinary investigation or in a iplinary proceeding.

ıflicts with State Disciplinary Rules

ıere is a conflict between a State Disciplinary Rule and a PTO Disciplinary Rule, ›lution of which rule controls will depend on the facts of the case.

ıe alleged misconduct occurs during the immediate or prospective representation of ›ons before the PTO, OED will apply the PTO Disciplinary Rules to the practitioner.

ıe alleged misconduct occurs outside of immediate or prospective representation of ›ons before the PTO, OED will defer such matters to the State or court, as the case / be, and if disciplinary action is taken by a State or court, OED then will consider ng disciplinary action under the PTO Code. For example, a practitioner was ›ended by the PTO following his conviction for income tax evasion and suspension ı State Bar.[7] The PTO suspended another practitioner and stayed the suspension ject to his compliance with imposed conditions after a State Bar sanctioned the :titioner in the same manner for matters totally unrelated to practice before the PTO.[8]

Reg. 10012 (1984); 49 Fed. Reg. 33790 (1984); 50 Fed. Reg. 5158 (1985).

›in H. Crabtree, 1083 Off. Gaz. TM Office 44 (Oct. 27, 1987).

ıg J. Levin, 1115 Off. Gaz. Pat. Office 6 (June 5, 1990).

ıTENT PROSECUTION AND THE PTO CODE OF CONDUCT

ıct of those recognized to practice before the PTO which the Commissioner is authorized
is not limited to conduct in connection with matters involving appearance before the
ınduct subject to disciplinary action includes all aspects of a practitioner's relationships
nt, the PTO, and the public. Although a practitioner must abide by all provisions of the
onduct during the course of his or her representation of an individual in the prosecution
application before the PTO, this paper will highlight certain disciplinary rules which
ːular impact on that prosecution.

ːompetence and Neglect

ıe of the most frequent grounds relied upon by the PTO for disciplining a practitioner is a
ıctitioner's (i) neglect of a client's interest, (ii) prejudice or damage to a client's interest,
(iii) failure to carry out a contract of employment. The obligation to tend to a client's
ːe is set forth in the mandate of Canon 6 of the PTO Code which imposes on a lawyer the
ty to "act competently" for a client.

ıder the PTO Code, 37 CFR § 10.77(a)[10], a practitioner is prohibited from handling a
tent, trademark, or other non-patent law matter when the practitioner knows or should
ow that the matter is outside the practitioner's level of competence, unless the practitioner
ıssociated with another practitioner who is competent to handle the matter. The Code
›vides no guidelines suggesting what to evaluate to ascertain competence. However,
ınon 6 and the below case law indicate that a practitioner must employ subjective and
jective standards in assessing his or her own competence to handle a legal matter.

1. A practitioner will be sanctioned where he or she shows incompetence while representing a patent applicant.

a. A patent agent[11] was sanctioned under 37 CFR § 1.348, the predecessor to the current PTO Code. The agent was charged with general incompetence in handling patent cases by introducing new matter by amendment into several patent applications, by charging an excessive fee to determine the status of an application and thereafter taking no action for six months, by not making of record an interview on the merits he held with the patent examiner during the prosecution of the application, by filing several responses to Office actions which did not satisfy the provisions of 37 CFR §§ 1.111 through 1.123, by failing to file or not properly filing several fees required by 35 U.S.C. § 41(a), and by not properly handling several patent applications which made it necessary to file petitions to revive the applications. The agent admitted that his manner of handling the affairs of his clients showed his incompetence.

· *v. Ladd*, 296 F.2d 420, 131 USPQ 467 (D.D.C. 1961), *aff'd*, 131 USPQ 177 (D.C. Cir. 1961).

'R § 10.77, which titled "Failing to act competently," states:
practitioner shall not:
le a legal matter which the practitioner knows or should know that the practitioner is not competent to
ıout associating with the practitioner another practitioner who is competent to handle it.
le a legal matter without preparation adequate in the circumstances.
ːct a legal matter entrusted to the practitioner."

Vyden, 973 Official Gazette 40 (August 11, 1978).

b. When an application became abandoned for failure to pay an issue fee, and the attorney had impaired vision, he was found to be incompetent to handle legal matters due to the impairment. He also failed to associate himself with someone competent to handle the legal matters. He associated with his son, a lawyer who was not registered to practice before the PTO, and was inexperienced in patent prosecution matters.[12]

2. Under 37 CFR § 10.77(b), a practitioner is prohibited from representing a client "without preparation adequate in the circumstances." The rule provides no guide for ascertaining what constitutes adequate preparation.
Most disciplinary proceedings brought by the Director for neglect arise under 37 CFR § 10.77(c), which simply states that a practitioner shall not "neglect a legal matter entrusted to the practitioner." The PTO Code does not define neglect.

Informal Opinion 1273 of the American Bar Association provides guidance in distinguishing neglect from negligence by stating:

> Neglect involves indifference and a consistent failure to carry out the obligations which the lawyer has assumed to his client or a conscious disregard for the responsibility owed to his client. The concept of ordinary negligence is different. Neglect usually involves more than a single act or omission. Neglect cannot be found if the acts or omissions complained of were inadvertent or the result of an error of judgment made in good faith.[13]

This Informal Opinion requires more than one instance of neglect. However, the comments in the Advance Notice of Proposed Rulemaking in 1041 *Official Gazette* at 20 (April 10, 1984) indicate that under § 10.77(c), neglect could be based on a single instance of neglect.[14]

a. Failure to provide a patentability opinion. An attorney was excluded by a State bar where, *inter alia*, he did not complete work to provide a patentability opinion, and he did not respond to the client's request for information.[15]

b. Failure to timely file or delay in filing a patent or trademark application.

i. The Commissioner found that a practitioner's delay in filing an application was "gross misconduct" and not excused by him

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ard, 20 USPQ2d 1708 (Comm'r Pat. 1991). Inasmuch as no appeal was taken to the Commissioner ision of the ALJ, the ALJ's decision, without further proceedings, became the decision of the er. 37 CFR § 10.154(a).

Comm. on Ethics and Professional Responsibility, Informal Op. 1273 (1973).

vance Notice of Proposed Rulemaking published on March 16, 1984 in the *Federal Register*, 49 F.R. n April 10, 1984, in the Official Gazette, 1041 O.G. 20.

of Overseers of the Bar v. Gould, Docket No. BAR-95-3 (Me. May 10, 1995).

viii. A practitioner was sanctioned when he failed to file an application despite his representation that he would file the application upon receipt of $25.00. He received the money, which left a balance to be paid, and he did not inform the client *ab initio* that no application would be filed until the entire fee was paid.[23]

ix. An attorney was excluded where he did not file an application despite his representation to the inventor that drawings were "being inked and an application will be filed promptly." The maturing of a statutory bar precluded later filing a valid patent application.[24]

x. An attorney was excluded for, *inter alia*, delayed filing of a patent application and non-responsiveness to a client's inquiries.[25]

c. Client's failure to pay a fee. When a client owes the practitioner fees based on contract law, the practitioner nevertheless must attend to the matters entrusted to him or her, including the preparation and filing of an application, and failure to do so is neglect of an entrusted legal matter.

A client's failure to pay a fee, or even a part of a fee, is neither an excuse nor a defense to a charge of neglect.[26] Accordingly, failure to pay a fee is not justification for a practitioner refusing to perform services or for improperly withdrawing from employment, such as doing nothing. Reliance on a policy to do no work unless paid in advance is to no avail inasmuch as the practitioner is not discharged by the client, and he has not withdrawn from employment.[27]

d. Failure to respond to an Office action.

i. An attorney was suspended when his check to pay a filing fee was returned to the PTO unpaid, and despite being notified by the PTO that his check was returned unpaid, he did not make good on the check, he did not pay the required surcharge, and he did not inform his client of the steps which could be taken to avoid abandonment of the application.[28]

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unn, Commissioner's Order No. 3110, 384 Official Gazette 245 (July 9, 1929).

ight, Commissioner's Order No. 5318, 891 Official Gazette 2 (October 5, 1971).

Overseers of the Bar v. Gould, Docket No. BAR-95-3 (Me. May 10, 1995).

v. Mayes, 216 Kan. 38, 531 P.2d 102, 185 USPQ 624 (1975) (a patent attorney is subject to the same onduct as an ordinary attorney The patent attorney cannot evade responsibility for his actions by he was performing services which lawfully could be provided by a non-lawyer, i.e., by a registered *In re Chunn*, Commissioner's Order No. 3110, 384 Official Gazette 245 (July 9, 1929).

v. Mayes, supra.

. *Weiffenbach*, Disciplinary Proceeding No. DP89-1, 1118 Trademark Official Gazette 48 (September

ii. An attorney neglected representation when he knew of a possible "on sale" event, and he filed, over a period of several years, an original and four continuation applications more than one year after the claimed invention had been "on sale" (Count 12).[29]

iii. An attorney was grossly negligent under 37 CFR § 1.56(a) in not disclosing the "on sale" to the Examiner during the prosecution of the application (Count 35).[30]

iv. When, after completing an alcohol rehabilitation program, and upon securing employment as patent counsel in a corporation, an attorney closed his private practice, neglected to respond to Office actions of several clients, failed to communicate or inadequately communicated with clients about outstanding Office actions affecting their patent applications, and abandoned his clients while prosecuting their applications, the attorney was suspended.[31]

v. When an attorney permitted an allowed application to become abandoned by not paying an issue fee, and filed a petition to revive as opposed to a petition to accept delayed payment of the issue fee, the attorney handled legal matters without adequate preparation in the circumstances due to his attempt to revive the allowed application by invoking 37 CFR § 1.137, and he neglected legal matters entrusted to him by failure to pay the issue fee.[32]

vi. An attorney was excluded when, *inter alia*, he was less than diligent in filing an amendment by not responding to an Office action for four months.[33]

vii. An attorney was suspended when, *inter alia*, he neglected to prosecute several applications, failed to promptly communicate with a client about Office actions in each application, and failed to inform clients of abandonment of applications for more than one year from the dates of abandonment.[34]

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[29] *Weiffenbach v. Lett*, Disciplinary Proceeding No. DP87-2, 1101 Official Gazette 59 (April 25, 1989). The PTO does not have regulations for disciplining practitioners whose misconduct is caused by alcoholism, drugs, senility, emotional illness, or medical condition. It was shown that Mr. Lett's alcoholism caused the misconduct, that he had voluntarily begun and continued to be in treatment for his alcoholism, and that he was likely to succeed in that treatment. In a settlement of the proceeding, execution of an exclusion was stayed pending his successful completion of a five year probation under a sobriety monitor and a practice monitor.

[30] *Weiffenbach v. Lett*, Disciplinary Proceeding No. DP87-2, 1101 Official Gazette 59 (April 25, 1989).

[31] *In re Barndt*, 27 USPQ2d 1749 (Comm'r Pat. 1992).

[32] *In re Bard*, 20 USPQ2d 1708 (Comm'r Pat. 1991). Inasmuch as no appeal was taken to the Commissioner from the decision of the ALJ, the ALJ's decision, without further proceedings, became the decision of the Commissioner. 37 CFR § 10.154(a).

[33] *Board of Overseers of the Bar v. Gould*, Docket No. BAR-95-3 (Me. May 10, 1995).

[34] *In re Frater*, 1139 Official Gazette 138 (June 30, 1992).

viii. An attorney's refusal to prepare a response to an Office action until he was paid a fee even though failure to respond would result in abandonment was found to be neglect of a legal matter entrusted to him, and failure to represent a client zealously.[35]

ix. A practitioner's failure to ink drawings, leading to abandonment of a client's application, constituted neglect of a legal matter entrusted to him.[36]

x. A practitioner was charged with failing to submit the fee necessary to correct a drawing. His allegations that he had paid the fee in currency was unsubstantiated by a receipt, and he did not deny that he was advised by someone in the PTO over the telephone that the fee had not been received. The Commissioner found that his explanation for making no inquiry for 18 months regarding why the drawing correction had not been made (preparation of drawings requires considerable time) was "not . . . reasonable."[37]

xi. A practitioner was found to have neglected a legal matter entrusted to him by failing to respond to Office actions and concealing such failure from the applicant thereby causing abandonment of the application; by filing an untimely response due to the omission of a certificate of mailing, and the response was not in compliance with 37 CFR § 1.111 even though he knew or should have known how to file a timely, complete response; and by failing to prevent the lapse of a patent by remitting to the Office the balance issue fee received from the client and by failing to petition for delayed payment of the balance issue fee.[38]

xii. A practitioner neglected entrusted legal matters by failing to respond to an Office action in one case, and by acting directly contrary to a client's implied instructions in failing to submit the issue fee he had timely received from the client one month after the Notice of Allowance and Issue Fee Due.[39]

xiii. A practitioner admitted neglecting a legal matter when, acting as an associate attorney, he failed to respond to an Office action despite the principal attorney's instructions, and by not following the principal attorney's instruction to file a substitute application.[40]

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35 *Kansas v. Mayes*, 216 Kan. 38, 531 P.2d 102, 185 USPQ 624 (1975).

36 *Attorney Grievance Commission of Maryland v. Pattison*, 292 Md. 599, 441 A.2d 328 (1982); Disciplinary Proceeding No. 82-3, 1023 Official Gazette 13 (October 12, 1982).

37 *In re Paxton*, 792 Official Gazette 815 (July 16, 1963).

38 *In re Lowell G. Turner*, 3 USPQ2d 1214 (Dep't Comm. 1985 and 1986), *adopted sub nom.*, *Nakamura v. Turner*, 3 USPQ2d 1222 (Comm'r Pat. 1986).

39 *In re Wright*, Commissioner's Order No. 5318, 891 Official Gazette 2 (October 5, 1971).

40 *Nakamura v. Frank*, Disciplinary Proceeding No. 82-4, 1023 Official Gazette 13 (October 12, 1982).

e. Failure to respond/misuse of a certificate of mailing. Failure to timely respond to an Office action may constitute neglect. The neglect is compounded by backdating a certificate of mailing (37 CFR § 1.8 and 1.10) to falsely indicate timely mailing of a response to prevent the application from becoming abandoned, or to avoid payment for an extension of time. Cases brought under 37 CFR § 1.348,[41] and under the PTO Code,[42] have sought to emphasize the ability of the Office to ferret out this practice which discredits the word of a practitioner.

f. Insufficient funds. Neglect may be inferred from a practitioner's submission of checks drawn on accounts having insufficient funds.

An attorney was suspended when he submitted to the PTO a check which a bank later dishonored, and he permitted the application to become abandoned without making good on the check.[43] The attorney issued three checks on his "Attorney Account." On the date each check was issued and on the date each check was received in the Office, his account had insufficient funds to cover the amount of the respective checks. He never explained why he issued the checks.

g. A practitioner is responsible for supervising his or her associate practitioners. A practitioner's fiduciary responsibility to a client does not cease, and is not stayed by any personal disability that the practitioner may encounter. If a practitioner is temporarily disabled, e.g., hospitalized for an operation, and intends to continue to represent a client, the practitioner should consider appointing a competent associate. Unless the associate is in the practitioner's law firm, the practitioner must obtain the client's informed consent after full disclosure before any client confidence or secret, e.g., the invention, is revealed to the associate, and before any fee is divided with the associate. *See* 37 CFR §§ 10.37 and 10.57. The disabled practitioner must exercise reasonable supervision or control over the associated practitioner, as well as over paralegals and other employees.

2. Obligation of Zealous Representation

a. Reviving abandoned applications. When an attorney is requested to revive an application which the client did not authorize to be abandoned, a practitioner has a duty to promptly file a petition to revive an abandoned application. When requested by the client's new counsel to file an affidavit explaining why the application became abandoned, he has a

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41 *Dula v. Nakamura*, 1030 *Official Gazette* 20 (May 17, 1983), 27 PTCJ 133 (December 8, 1983); *In re Klein*, 6 USPQ2d 1528 (Dep't Comm. 1986), *adopted and modified,* 6 USPQ2d 1547 (Comm'r Pat. 1987), *aff'd sub nom., Klein v. Peterson*, 696 F. Supp. 695, 8 USPQ2d 1434 (D.D.C. 1988), *aff'd,* 866 F.2d 412, 9 USPQ2d 1558 (Fed Cir. 1989).

42 *Small v. Weiffenbach*, 10 USPQ2d 1881 (Dep't Comm. 1988), *adopted*, 10 USPQ2d 1898 (Comm'r Pat. 1989).

43 *Maxon v. Weiffenbach*, Disciplinary Proceeding No. DP89-1, 1118 *Trademark Official Gazette* 48 (September 25, 1990).

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duty to promptly file such affidavit.[44] A registered practitioner should know that a terminal disclaimer is generally required to revive applications under 37 CFR § 1.137(a) which have been abandoned for more than six months. A practitioner's delay, after being requested to petition to revive or to assist in petitioning to revive an application, increases the potential for prejudice to the applicant.

i. A practitioner was sanctioned for repeated failure, over about a two year period, to provide new counsel with an affidavit explaining why an application became abandoned. The ALJ found that the practitioner's conduct manifested an intent to prejudice or damage the former client.[45]

ii. A practitioner was charged with failing to zealously represent a client by failing to promptly file a petition to revive the client's patent application, and failing to assist new counsel in an effort to revive the application despite the new counsel's urgings. The failure resulted in the loss of at least 27 months of a patent's 17 year term.[46]

g. Turning over files to a new attorney or the client.

When a practitioner failed to return files to clients after the clients terminated the practitioner's service, and the practitioner failed to turn over files to new counsel, as requested by the clients, the court concluded that the practitioner had violated the disciplinary rules prohibiting neglect and causing prejudice to a client. The practitioner had abandoned his offices, and left behind most files, bank accounts, etc.[47]

3. Duty to communicate with a client. The PTO Code, like the American Bar Association (ABA) Model Code of Professional Responsibility, does not have a specific provision requiring practitioners to communicate with client. However, the ABA Model Code has been construed to require that practitioners communicate with their clients. The PTO Code is modeled upon the 1980 ABA Model Code. Sections 10.77(c), 10.23(b)(4) and 10.112(c)(1) of 37 CFR are modeled upon DR 6-101(A)(3), DR 1-102(A)(4) and DR 9-102(B)(1) of the ABA Model Code, respectively. State disciplinary authorities, in non-patent contexts, have employed the provisions of DR 9-102(B)(1) (duty to notify client of receipt of funds or

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[44] *In re Robert L. Slater*, 231 USPQ 497 (Comm'r Pat. 1985), *aff'd sub nom., Slater v. Quigg*, 230 USPQ 708 (D.D.C. 1986); *Accord, In re Paxton,* Commissioner's Order No. 5315, 792 Official Gazette 537 (July 16, 1963); *In re Redden,* Commissioner's Order No. 5317, 818 Official Gazette 791 (September 21, 1965).

[45] *In re Slater,* 231 USPQ 497 (Comm'r Pat. 1985), *aff'd sub nom., Slater v. Quigg*, 230 USPQ 708 (D.D.C. 1986).

[46] *In re Borenstein*, 20 USPQ2d 1621 (Comm'r Pat. 1991). The administrative law judge found Borenstein in default for failure to timely answer the Complaint brought against him. Inasmuch as no appeal was taken to the Commissioner from the decision of the ALJ, the ALJ's decision, without further proceedings, became the decision of the Commissioner. 37 CFR § 10.154(a).

[47] *Attorney Grievance Commission of Maryland v. Harper*, 300 Md. 193, 477 A.2d 756 (Md. 1984); *Nakamura v. Harper*, Disciplinary Proceeding No. 84-2, 1062 Official Gazette 433 (January 28, 1986).

property), DR 6-101(A)(3) (neglect),[48] and DR 1-102(A)(4) (proscribing dishonest representations)[49] to charge attorneys with professional misconduct when attorneys had failed to communicate with clients.

A practitioner has a duty to communicate with a client about the status of the legal services he or she was retained and paid to provide.

a. An attorney was excluded when, *inter alia*, he failed to promptly notify a client of a final rejection of a patent application, and never informed the client of his appeal options.[50]

b. When an attorney provided a client with two drafts of a patent application and with drawings containing errors, and the attorney received, but did not respond to, the client's written request to return file documents by certified mail, the attorney was found to have engaged in conduct reflecting adversely on his fitness and/or to have neglected legal matters.[51]

c. The duty to communicate with a client requires a practitioner to keep the client advised of the lack of progress in providing a patent application after the passage of several months.[52]

d. A patent attorney has a "duty to respond to his client's inquiries, make himself available to the client, and keep the client advised as to the status of an application."[53] The practitioner must promptly respond to a client's inquiry about the status of an application.[54] Failing for three years to ascertain the abandoned status of a client's application despite the client's repeated requests to determine the status of the application was one of several grounds for sanctioning an attorney.[55]

e. Section 10.23(c)(8) of the PTO Code places an affirmative duty on practitioners to notify the client or former client of the receipt of

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[48] *In re Craven*, 271 Ind. 67, 390 N.E.2d 163 (1979); *Attorney Grievance Commission v. Montgomery*, 460 A.2d 597 (Md. 1983).

[49] *In re Sheehy*, 454 A.2d 1360 (D.C. 1983).

[50] *Board of Overseers of the Bar v. Gould*, Docket No. BAR-95-3 (Me. May 10, 1995).

[51] *In re Borenstein*, 21 USPQ2d 1072 (Dep't Comm. *1991*).

[52] *Maxon v. Weiffenbach*, Disciplinary Proceeding No. DP89-1, 1118 Trademark Official Gazette 48 (September 25, 1990).

[53] *In re Robert L. Slater*, 231 USPQ 497, 504 (Comm'r Pat. 1985), *aff'd sub nom., Slater v. Quigg*, 230 USPQ 708 (D.D.C. 1986); *Accord*, *In re Wright*, Commissioner's Order No. 5318, 891 Official Gazette 2 (October 5, 1971).

[54] *In re Fries*, Commissioner's Order No. 5314, 787 Official Gazette 436 (February 19, 1963).

[55] *In re Lowell G. Turner*, 3 USPQ2d 1214 (Dep't Comm. 1985 and 1986), *adopted sub nom.*, *Nakamura v. Turner*, 3 USPQ2d 1222 (Comm'r Pat. 1986).

correspondence which could have a significant effect on a pending matter or to notify the Office if the client or former client cannot be notified.[56]

i. When the attorney of record is notified by the Office that a proposed power of attorney substituting a new attorney for the attorney of record is not accepted, the attorney of record must notify the client or new attorney so as to prevent the application from becoming abandoned. Failure by the attorney of record to notify the client of a final rejection, when the response to the rejection was due, or to request an appeal fee was not excused by the client's failure to pay for prior work.[57]

ii. An attorney has a duty to advise a client of the necessity to pay the fee and any surcharge fees required to avoid abandonment of an application, particularly when the attorney is notified that his check for payment of issue fee has been dishonored.[58]

iii. A practitioner, notified of the abandonment of an application, must inform the applicant of the application's abandoned status and the reason for the abandonment.[59] The duty to communicate with the client remains whether the application is for a patent or for registration of a trademark.[60]

iv. A practitioner has a duty to inform clients of any changes of address or telephone number.[61]

4. Candor to the PTO.

The PTO Code mandates that a practitioner shall not "[e]ngage in conduct involving dishonesty, fraud, deceit or misrepresentation."[62] For cases wherein fraud on the Office is alleged, intent is a critical element in proving whether there has been fraud or inequitable conduct. In connection with practice before the Office, a practitioner is charged by Rule 56 with a duty of candor and good faith.

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7 CFR § 10.23(c)(8) states:
g to inform a client or former client or failing to timely notify the Office of an inability to a client or former
f correspondence received from the Office or the client's or former client's opponent in an *inter partes*
ling before the Office when the correspondence (i) could have a significant effect on a matter pending before
ice, (ii) is received by the practitioner on behalf of a client or former client and (iii) is correspondence of
a reasonable practitioner would believe under the circumstances the client or former client should be notified."

re Redden, Commissioner's Order No. 5317, 818 Official Gazette 791 (September 21, 1965).

axon v. Weiffenbach, Disciplinary Proceeding No. DP89-1, 1118 Trademark Official Gazette 48 (September
)0).

re Paxton, Commissioner's Order No. 5315, 792 Official Gazette 537 (July 16, 1963).

torney Grievance Commission of Maryland v. Harper, 300 Md. 193, 477 A.2d 756 (1984); *Nakamura v.*
, Disciplinary Proceeding No. 84-2 (Comm'r Pat. 1985).

re Redden, Commissioner's Order No. 5317, 818 Official Gazette 791 (September 21, 1965).

7 CFR 10.23(b)(4).

This duty is consistent with a holding by the Supreme Court in *Kingsland v. Dorsey*[63] wherein the Court, in affirming a decision of the Commissioner to disbar an attorney from practicing before the Office, stated that "the relationship of attorneys to the Patent Office requires the highest degree of candor and good faith."[64]

a. Withholding material prior art. In 1971, the PTO suspended a registered patent agent for intentionally breaching his duty of candor and good faith by failing to disclose a pertinent prior art reference to the examiner during the prosecution of an application.[65] The Deputy Commissioner, writing for the Commissioner, held that:

> It is in my opinion an abuse of a patent practitioner's professional responsibility to knowingly withhold from the examiner the name and number of any reference which he believes would render certain claims of an application invalid if he were to succeed in getting them allowed ... For the foregoing reasons, the single charge placed against respondent is sustained.[66]

b. Misrepresentations to the PTO. Practitioners have been sanctioned by the Commissioner for a variety of misrepresentations.

i. A practitioner was charged, under the provisions of 37 CFR § 1.344, with providing misleading answers to three questions in a Request for Information from the PTO.[67] The Federal Circuit, relying on *N.V. Akzo v. DuPont de Nemours & Co.*,[68] stated:

> There must be not only a misrepresentation, but also actual knowledge of its falsity or an obligation to know it. Mere negligence is not sufficient to infer fraud or dishonesty though gross negligence may lead (in a proper case) to a finding of inequitable conduct.[69]

ii. In *Jaskiewicz*, the Office had questioned circumstances in which a declaration, filed in the Office, had been signed by the inventor in West Germany. The attorney had received an application to be filed in the PTO which was a literal translation into English of a German application. The application included a declaration signed by the inventor. The attorney

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38 U.S. 318, 83 USPQ 330 (1949).

ngsland v. Dorsey, 338 U.S. at 319, 83 USPQ at 330 (1949).

re Milmore, 196 USPQ 628 (Comm'r Pats. 1977).

., 196 USPQ at 630.

skiewicz v. Mossinghoff, 822 F.2d 1053, 3 USPQ2d 1294 (Fed Cir. 1987).

10 F.2d 1148, 1 USPQ2d 1704 (Fed Cir. 1987).

skiewicz v. Mossinghoff, 822 F.2d at ___, 3 USPQ2d at 1299.

ii. An attorney was found to have altered an Office action to show a different date to hide from his client the lack of response to the Office action and the ensuing abandonment of an application, to have thereby withheld material information from the applicant, and to have participated in the creation and preservation of false evidence in violation of 37 CFR §§ 10.23(b)(4) and 10.85(a)(6).[80]

iii. Practitioners have been sanctioned for falsely advising clients or other practitioners that a petition to revive an application had been filed,[81] and misrepresenting the progress of his work on an application and the existence ("at home") of a nonexistent application.[82]

iv. For three years after an application was signed a practitioner did not file the application, and he then misrepresented to the client that it had been filed. He attempted to justify his actions on the ground that the client's application was confused with another application. The Commissioner considered the justification fanciful and incredible.[83]

v. When an attorney prepared and filed patent applications by virtually copying issued patents and naming as inventors persons he knew not to be the inventors, for the purpose of eliciting the state of the engineering art in a particular discipline, as opposed to obtaining patents, the attorney was reprimanded.[84]

vi. A practitioner was sanctioned when he testified that he understood that it was permissible for an inventor to execute an oath in the absence of a notary if the inventor cannot go to a notary public, and the practitioner testified that he would bring an inventor-signed oath to be notarized.[85] Although the practitioner was not charged with fraud, the Commissioner, in *dicta*, said the practitioner's "impression . . . that an oath may be executed without the presence of a notary calls for this expression of condemnation of any such practice as unlawful and fraudulent."[86]

vii. An attorney misrepresented in a letter to his client that a "hearing concerning the Appeal in this application has been held, and I

'eiffenbach v. Logan, 27 USPQ2d 1870 (Comm'r Pat. 1993), *aff'd sub nom., Logan v. Commissioner of* ', No. 93-0335 (D.D.C. September 23, 1994), *appeal filed*, No. 95-1216 (Fed Cir. 1994).

re Redden, Commissioner's Order No. 5317, 818 Official Gazette 791 (September 21, 1965).

ınsas v. Mayes, 216 Kan. 38, 531 P.2d 102, 185 USPQ 624 (1975).

re McCall, Commissioner's Order No. 4028, 585 *Official Gazette* 173 (April 9, 1946), Disciplinary ı No. 1, 583 Official Gazette 390 (February 19, 1946).

ındas v. Weiffenbach, Disciplinary Proceeding No. DP89-4, 1110 Official Gazette 619 (January 9, 1990).

re McCall, Commissioner's Order No. 4028, 585 Official Gazette 173 (April 9, 1946), Disciplinary No. 1, 583 Official Gazette 390 (February 19, 1946).

, 583 Official Gazette at 390.

appeared to argue it before the Board of Appeals on [a specific date]." He said that he began negotiating at the hearing when, in fact, he had withdrawn the appeal more than one week before the scheduled hearing date. He billed the client for the letter and for his preparation and attendance at the hearing before the Board of Appeals, and conferences with the Examiner which he never attended. Thus, he billed for services not rendered. He made misrepresentations to a client, e.g., the status of the application, communications with the inventors, reasons for extensions of time. He made misrepresentations to the PTO, e.g., the reason for obtaining an extension of time. After the application was abandoned, he billed for conferences with the Examiner, and services rendered in connection with a non-existent appeal, including preparation of a supplementary appeal brief. In connection with trademark matters for a client, the same practitioner billed the client for reviewing "application files and preparation of amendment" when no amendment was due or necessary, and no trademark application had been filed on behalf of the client during the billing period.[87]

viii. When anticipating references are found in a prior art search and a search report to a client refers to the references as the "nearest reference approaching your invention" without advising that the invention is unpatentable due to anticipation, and the report invites the client to pay for a patent application, the letter is deceptive and fraudulent on its face.[88]

ix. When a practitioner engages in a scheme combining patent work with an offer to find a purchaser for the invention by advertisement, and the offer is repeated in favorable patent search reports; the search reports cited an anticipating reference, and the practitioner provided the client with a pamphlet warning against unscrupulous marketing practices which the practitioner is carrying out, the practitioner is guilty of fraud.[89]

x. When a practitioner misrepresents the status of a case, it can be for no other purpose than to deceive the client that his invention is patentable. The misrepresentation raise a client's hopes and confidence so as to accept the practitioner's offer to find a purchaser, and has the same deceptive purpose as an invention developer's sales department, whose chief gave an opinion that the invention was valuable, of special merit, worth such a sum of money, all in an effort to profit the practitioner at whatever cost to the client.[90]

xi. When a practitioner's letter informs a client of a final rejection, that he has tried in vain by amendment and argument to induce the

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[87] *Weiffenbach v. Lett*, Disciplinary Proceeding No. DP87-2, 1101 Official Gazette 59 (April 25, 1989).

[88] *In re Wedderburn*, 1897 Dec. Comm'r Pat. 77, 138-139 (Comm'r Pat. 1897), *aff'd sub nom.*, *Wedderburn v. Bliss*, 1898 Dec. Comm'r Pat. 413 (D.C. Cir. 1898).

[89] *In re Wedderburn*, 1897 Dec. Comm'r Pat. 77 (Comm'r Pat. 1897), *aff'd sub nom.*, *Wedderburn v. Bliss*, 1898 Dec. Comm'r Pat. 413 (D.C. Cir. 1898).

[90] *Id.*

examiner to allow the application, and that the only course left is appeal along with a fee, and the practitioner does not provide information to the client as to the references or reasons for the rejection, the practitioner has concealed the information from the client. Even if the letter does not advise of the right to appeal, it lacks honesty and candor, i.e., it gives no advice in a manner which would be given by an honest and competent attorney.[91]

6. Other misconduct

a. The Commissioner held that a practitioner was unfit to represent applicants before the Office when the practitioner believed a lay intermediary was his client for the preparation and prosecution of patent applications before the Office, and he ignored his duties and obligations to applicants who gave him a power of attorney to act on their behalf before the Office in their applications.[92]

A practitioner urged that a lay intermediary, having a 10% interest in the invention, had absolute and complete control of the invention and corresponding patent application. The Commissioner determined that the practitioner knew or should have known that Rule 32 (i.e., former Patent Rule 32, now 37 CFR § 1.36) permits an assignee of record of the entire interest in a patent application is entitled to conduct the prosecution of the application to the exclusion of the inventor. The Commissioner held that no rule confers that right on a person, including a lay intermediary, having less than the entire interest in the invention. In reaching the foregoing position, the Commissioner stated that a practitioner must learn the terms of an agreement between the applicant and the lay intermediary. Inasmuch as the practitioner asserted that the lay intermediary, not the applicant, is his client, and the practitioner knew the lay agency acted as an intermediary to the applicant, any doubt was resolved against the practitioner as to his knowledge about the relationship between the lay agency and the applicant.[93]

IV. CONCLUSION

Registered practitioners must have familiarity with the PTO Code of Professional Conduct as well as any applicable state code before representing individuals in the course of prosecuting a patent application. As the aforementioned cases indicate, some of the disciplinary rules found in the code are more apt to be the subject of a disciplinary action, but all are vitally important to the best representation that an individual can give the client. Although the Office of Enrollment and Discipline does not give advise under the Code, the cases mentioned here should give guidance in the applicability of the Disciplinary Rules to various situations in which a practitioner may find him or herself.

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91 *Id.*

92 *In re R. W. Hodgson*, Commissioner's Order No. 5306, 721 *Official Gazette* 414 (August 20, 1957).

93 *Id.*

prepared a colloquial English version of the application, and sought to have the inventor execute a declaration for the colloquial version. The attorney dealt with a German agent who, in turn, refused to bother the inventor, and told the attorney to file the signed declaration with the colloquial version of the application. The attorney, through his answers to a Requirement for Information, attempted to show that the inventor had all application papers, including the colloquial version, in front of him when he had signed the declaration. There was clear and convincing evidence that the attorney knew the inventor had signed the declaration in conjunction with the earlier, literal translation of the German claims and, only verbally ratified the later colloquial translation several months later. The Court found the absence of any real details in his responses to questions "is, in itself, a strong factor for finding [the attorney's] responses to have been fraudulent and deliberately lacking in candor."[70]

The Federal Circuit further pointed out that a practitioner who knowingly violates Rule 56 is guilty of "gross misconduct."

iii. Practitioners were sanctioned for making fictitious or false statements in petitions for extensions of time.[71]

iv. A practitioner was suspended for misrepresenting facts about the execution of a patent application filed under 37 CFR § 10.47.[72]

v. An attorney was suspended when he, *inter alia*, prepared and filed an application knowing that the named applicant was not the true inventor, that an improvement had been sold in the United States more than one year before filing, and he notarized and altered the date the application was signed in blank.[73]

vi. A patent agent who prepared and amended a trademark application without authority under the U.S. Code, and without the knowledge or consent of an attorney named in the application, and falsely represented that the application was being handled by the attorney, and thus violated 37 CFR §§ 10.23(c)(2)(i), 10.23(a), 10.23(b)(4), and 10.23(b)(6).[74]

vii. Practitioners have been sanctioned for falsely representing in certificates of mailing under 37 CFR § 1.8, that responses were mailed on certain dates when the practitioners knew or should have

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[70] *Jaskiewicz v. Mossinghoff*, 822 F.2d at __, 3 USPQ2d at 1301.

[71] *Nakamura v. Frank,* Disciplinary Proceeding No. 82-4; 1023 Official Gazette 13 (October 12, 1982); *Nakamura v. Turner,* 3 USPQ2d 1222 (Comm'r Pat. 1986).

[72] *In re Dubno*, 959 Official Gazette 25 (June 21, 1977).

[73] *Cuyahoga County Bar Ass'n v. Whitaker*, 42 Ohio St. 2d 1, 325 N.E.2d 889, 192 USPQ 348 (1975); *In re Whitaker*, 939 Official Gazette 1110 (October 21, 1975).

[74] *Weiffenbach v. Klempay*, 29 USPQ2d 2027 (Dep't Comm. 1993).

known that each response would be mailed after the respective dates in the certificates.[75]

viii. Intent to deceive has been inferred from a practitioner's conduct when the Commissioner found the evidence sufficient to support the inference that an Office action had been altered to conceal from the applicant the due date for response, and the fact that the application was abandoned. The practitioner had given the applicant a copy of an Office action wherein the mailing date of the action had been expunged.[76]

ix. When a practitioner filed a petition to revive an application, and an affidavit explaining why an application became unavoidably abandoned, the practitioner has a duty to include information adverse to the client, such as the practitioner's belief, along with the supporting evidence, that the applicant intended to abandon the application. The concealment or nondisclosure of facts existing when abandonment occurred indicating applicant's intentional abandonment of the application constitutes fraud in violation of 37 CFR § 10.23(b)(4).[77]

x. When an attorney participating in preparing a petition to admit a third party to practice before the PTO, had knowledge that certain affidavits submitted in support of the petition had been withdrawn by the respective affiants, but he nevertheless revised the petition to still reference and rely on the affidavits, he should have recognized his duty to be completely candid with PTO, disclosed the repudiation of the affidavits, and disclosed the alleged conduct by the third party which occasioned affiants to withdraw their affidavits.[78]

5. Candor to Clients

a. Misrepresentations to clients. Practitioners have been sanctioned by the Commissioner or State disciplinary authorities for a variety of misrepresentations.

i. Practitioners have been sanctioned for falsely advising clients that their applications had been filed or were awaiting action by the examiner when the practitioner knew that no application had been filed.[79]

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[75] *In re Klein*, 6 USPQ2d 1528 (Dep't Comm. 1987), *adopted and modified*, 6 USPQ2d 1547 (Comm'r Pat. 1987), *aff'd sub nom., Klein v. Peterson*, 696 F. Supp. 695, 8 USPQ2d 1434 (D.D.C. 1988), *aff'd,* 866 F.2d 412, 9 USPQ2d 1558 (Fed Cir. 1989); *Nakamura v. Dula,* 1030 Official Gazette 21 (May 17, 1983), 27 PTCJ 133 (December 8, 1983); *Small v. Weiffenbach,* 10 USPQ2d 1881 (Dep't Comm. 1988), *adopted*, 10 USPQ2d 1898 (Comm'r Pat. 1989).

[76] *In re Lowell G. Turner*, 3 USPQ2d 1214 (Dep't Comm. 1985 and 1986), *adopted sub nom., Nakamura v. Turner*, 3 USPQ2d 1222 (Comm'r Pat. 1986).

[77] *In re Slater*, 231 USPQ 497 (Comm'r Pat. 1985), *aff'd sub nom., Slater v. Quigg*, 230 USPQ 708 (D.D.C. 1986).

[78] *McCandlish v. Doe*, 22 USPQ2d 1223 (Comm'r Pat. 1992).

[79] *In re Healy*, 706 Official Gazette 977 (May 29, 1956); *In re Chunn*, Commissioner's Order No. 3110, 384 Official Gazette 245 (July 9, 1929).

Panel Question #1) A law firm holds itself out as "specializing" or "concentrating" its practice in intellectual property law, but has no lawyers admitted to practice before the United States Patent and Trademark Office. When clients come to the firm for the filing of patent applications, the firm "farms out" the application work to other firms who have licensed patent/trademark lawyers. It is unknown whether the clients are informed of this practice.

(1) If a firm holds itself out as practicing intellectual property law, should it be capable of providing all legal disciplines embraced by the term, including patent prosecution?

(2) If the clients are not informed that the firm's lawyers are not licensed patent/trademark lawyers, or that the legal work is being "farmed out," is the firm misleading the clients?

Panel Question #2) A registered patent attorney, on behalf of a client, has submitted numerous applications for patents with the Patent and Trademark Office. In connection with a particular patent application, the client has informed the attorney of the existence of a prior reference that, to the attorney, appears relevant to the client's invention. However, the client has stated his belief that because the reference is not directly relevant to the specific field of his invention, he does not want to disclose it to the PTO.

The attorney remains concerned that the prior reference may, in fact, be material to the client's invention and should be disclosed. The attorney has not seen the reference and has no way of finding the reference on his own. Thus, the attorney cannot be certain that the reference is material, although the attorney suspects that it is.

Keeping PTO rule 37 C.F.R. s 1.56., which imposes a duty of candor on an inventor and his attorney when a patent is being sought in mind:

(1) Should the attorney continue to represent the client?

(2) Should the attorney mention anything to the PTO?

(3) In general when considering whether or not to disclose pertinent prior art to the PTO, should the patent attorney rule on the side of giving as much as possible?

Panel Question #3) During a patent infringement suit in Federal District Court, it becomes readily apparent to the court that the patent attorney who filed and prosecuted the application for the contested patent knew about a highly pertinent piece of prior art but did not disclose it to the PTO during prosecution of the application. The patent attorney still practices patent law but is not involved in this litigation.

(1) Should the court file refer the apparent Rule 56 violation to the PTO's Office of Enrollment and Discipline?

(2) Should the patent attorneys involved in the litigation refer the apparent Rule 56 violation to the PTO's Office of Enrollment and Discipline?

Panel Question #4) An intellectual property practitioner files numerous patent, trademark, and copyright applications each year. She typically has more than fifty active cases pending in each category and many of her clients have vigorously protected their intellectual property in court. Many times in the past, her files have been the subject of discovery requests. Although she is a thorough attorney, she feels uneasy about much of what she accumulates and keeps in the file during prosecution of the respective patent, trademark, or copyright applications.

(1) Should she maintain separate files during prosecution of discoverable materials and of those materials covered by attorney client privilege which are presumably protected from discovery?

(2) Should she, upon issuance of the patent, trademark, or copyright, "sanitize" the file in order to purge any undesirable material?

Panel Question #5) An intellectual property attorney maintains a long-term docket and sends periodic reminders to past clients

regarding possible need for further action regarding completed matters. Examples of such notices are the reminder to pay maintenance fees for patents, trademarks, and copyrights at regular time intervals and reminders to exercise options to renew licenses or other contracts.

(1) Should the clients to whom the notices are sent be considered "current clients" or "former clients" for purposes of the ABA Model Rules of Professional Conduct?

(2) Should the subject matter make a difference? (i.e., patents, trademarks, or copyrights)

Panel Question #6) An Intellectual Property Litigator is licensed to practice law in Massachusetts, but not in New Hampshire. She has, however, been admitted to practice before the federal trial courts in New Hampshire and she confines her practice to federal matters in New Hampshire. For jurisdictional reasons, she plans to represent a client in a copyright dispute in Federal Court in New Hampshire and relatedly desires to open a New Hampshire office to practice only "federal law."

(1) Although not licensed in New Hampshire but admitted to practice before the United States District Court in New Hampshire, may she bring the copyright action in, or otherwise appear in, that federal court in New Hampshire?

(2) May she set up an office for IP Litigation in New Hampshire without being admitted to practice by the New Hampshire Supreme Court if she limits her practice solely to federal claims and defenses in federal court cases?

Panel Question #7) A Patent Attorney not admitted to practice law in the State of New Hampshire has an office in Hartford, Connecticut and has spent $10,000 on a magnificent web-site that blankets New England with his persuasive marketing jargon. Accordingly, he has clients beating a path to his virtual door. He promotes himself as having offices in every New England state and accomplishes this by agreements with a law firm in each state to use their respective conference room on an as-needed basis. One such

office is here in Concord. He dedicates his practice solely to patent application preparation and prosecution and is currently meeting with a Concord inventor.

(1) Should he advise the client as to the ownership of an invention such as where a question of ownership arises by virtue of employment or other contractual relationship between his client and others?

(2) Should he advise the client as to what the client's rights may be under forms of legal protection available under federal or state law which are alternate to patent protection, such as trade secrets, unfair competition, trade marks, copyrights, and anti-trust law?

(3) Should he advise the client on matters concerning the validity of a patent ?

(4) Should he advise the client on matters concerning the infringement of a patent ?

(5) Should he advise a client in matters concerning the scope of the monopoly granted in a patent not incident to the filing and prosecution of a patent application?

(6) Should he prepare contracts or licenses dealing with patent rights?

(7) Should he prepare assignments of patent rights?

(8) Should he advise the client in matters concerning contracts, licenses or assignments dealing with patent rights?

(9) Should he advise the client respecting litigation in the Courts of the State of New Hampshire, including litigation involving issues rising under patent law?

(10) Should he advise the client concerning rights or liabilities in connection with trademarks

(11) Should he represent the client in the assertion of trademark rights or in defense of liability under trademark rules?

(12) Should he represent the client in the filing and prosecution of applications for registration of trademarks?

Panel Question #8) A trademark attorney has trouble getting in touch with their eccentric entrepreneur. The client spends much of their time traveling. The attorney has several trademark applications pending on behalf of that client.

(1) Should the attorney pay an extension fee authorized by the Patent and Trademark Office (PTO) to postpone a deadline for response, when the attorney has no instructions from the client and the client is delinquent in paying legal fees?

(2) If no further extensions are possible, must the lawyer pursue the trademark application for the client, even if the client has not given necessary instructions?

(3) Assuming that the next date on which a PTO requirement must be met in order to preserve the client's rights is more than two months in the future, should the attorney withdraw from the representation?

Panel Question #9) An inventor with an incredible new type of engine design one hundred times more efficient than any current engines walks into a patent attorney's office seeking patent protection. The inventor is well-educated, credentialed, and has done an extensive search of the prior art himself. The only problem is that he's been an unemployed engineer for two years and has hardly enough money to pay rent let alone the PTO costs and attorney's fees. The attorney and the inventor agree in writing that the attorney's fees and reimbursement of expenses advanced by the attorney will be contingent upon the client's receiving moneys through commercial exploitation of his invention.

(1) Should the attorney be able to enter into such an agreement with the inventor to render legal services in the preparation and prosecution of the patent application?

(2) Should the attorney be able to pay filing fees associated with the application and be reimbursed as per the agreement?

(3) Should the attorney's contingent fee be based on a percentage of the inventor's future profits and/or limited to the attorney's actual fees and costs?

(4) Assuming instead that the inventor holds a prior valid patent that he prosecuted pro se and has a good case against General Motors for infringement. Should the attorney be able to move forward on a contingent basis?

(5) Assuming that the inventor holds a prior valid patent which you, the attorney filed and prosecuted through to issuance, and again the inventor has a good case against General Motors for infringement. Should the attorney also litigate that patent?

Panel Question #10) Should the PTO rules of practice be changed to include the establishment of Continuing Legal Education requirements, such as this Forum, for registered patent practitioners?

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