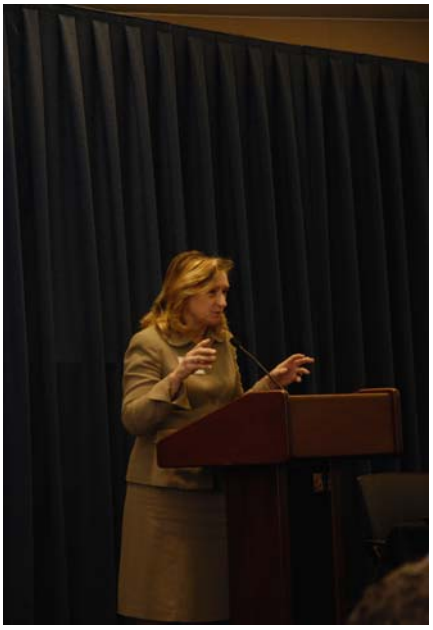
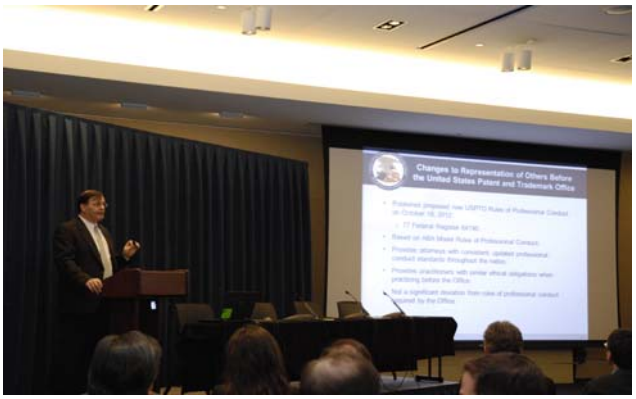
MEETING RECAP
THE PAULINE NEWMAN
IP AMERICAN INN OF COURT
WEDNESDAY, FEBRUARY 20, 2013

The second meeting in 2013 of the Pauline Newman IP American Inn of Court was a joint meeting with the George Mason American Inn of Court, and took place in the Madison Building of the U.S. Patent & Trademark Office. It began with a reception in the lobby outside the Auditorium in the lower level of the Atrium. The program was held in the Auditorium, and the subject was ethics.

Inn President Al Tramposch called the meeting to order, and discussed the Inn's programs for the remainder of the fiscal year. He announced a logo design contest. He introduced USPTO Acting Director Teresa Stanek Rea. She discussed events at the Office. She expects "a bubble of filings" before first-to-file takes effect on March 16, 2013 and new fees take effect on March 19, 2013. New Administrative Patent Judges are being hired, and there should be 200 by the end of the year.



William J. Griffin, Deputy Director, Office of Enrollment and Discipline ("OED"), U.S. Patent & Trademark Office, spoke on professional responsibility for intellectual property practitioners, including the OED's role and responsibilities in handling disciplinary matters against practitioners (including patent and trademark attorneys and patent agents). Practitioners are subject to discipline for not complying with USPTO regulations, regardless of whether their conduct is related to practice before the Office. Proposed new USPTO Rules of Professional Conduct have been published, based on the ABA Model Rules of Professional Conduct, and the comment period has closed. A few changes have been made to adapt the ABA Model Rules to practice



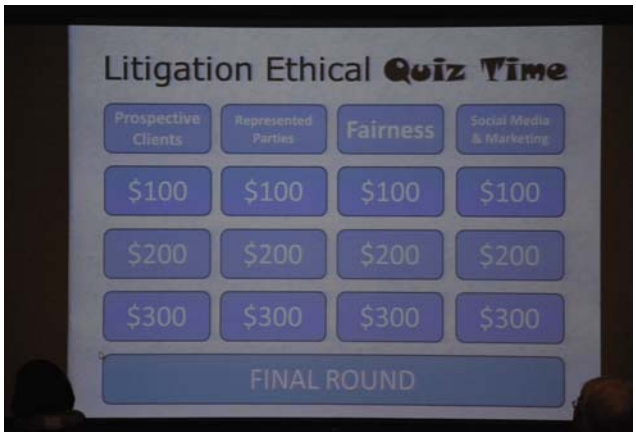
before the USPTO. The Annual Practitioner Maintenance Fee, which was never collected, has been removed. There is no continuing legal education reporting requirement.

An investigation may be initiated pursuant to information from any source suggesting possible grounds for discipline. A complaint must be predicated on a "probable cause" determination by the Committee on Discipline ("COD"), after it convenes. The steps that precede the filing of a complaint are: 1. Preliminary screening of allegations. 2. Requesting information from the practitioner. 3. Conducting an investigation after providing the practitioner an opportunity to respond. 4. Submitting a complaint to the COD for "probable cause" determination. Upon completion of the investigation, the OED may: close the investigation without further action; issue a warning; enter into a proposed settlement agreement; or convene the COD to determine whether there is "probable cause" to file a disciplinary action against the practitioner.

Under the America Invents Act, disciplinary proceedings must be commenced not later that the earlier of: ten years after the misconduct occurred, or one year from when the conduct was made known to the USPTO. The OED may impose "reciprocal discipline" after an attorney is disciplined by a state bar. The OED may issue a Warning Letter, which is confidential and non-disciplinary. Frequent causes for grievances include: failure or delay in filing a patent application; failure to reply to Office actions; failure to revive or assist in reviving abandoned applications; failure to turn over files to a new representative; and failure to communicate with the client. Sanctions include reprimand, suspension and exclusion.

The second part of the program was presented by the George Mason Inn, and coordinated by Ronald Stern and John Tran. Ben Dimuro discussed Rule 4.2 of the Virginia Rules of Professional Conduct, and gave a presentation on a one-minute phone call from a party represented by another lawyer, based on a case that he is appealing to the Virginia Supreme Court.

For "Litigation Ethical Quiz Time", the host was Jason V. Morgan. The judges were William Cheng, Donna Banks, Laura Riddlebarger and Melissa Zeller. The contestants were Brian Goodman (Assistant Public Defender in the Fairfax County Office of the Public Defender), Susan Pierce (from Walker Jones, replacing Ed Rosenthal, Managing Partner in Rich Rosenthal Brancefield Manitta Dzubin & Kroeger, LLP) and Cynthia Thaxton (a third year student at the George Mason University School of Law). Contestants could select



questions worth $100, $200 or $300 from four categories: Prospective Clients, Represented Parties, Fairness, and Social Media & Marketing. Answers could be YES, NO or MAYBE. [Often, the correct answer was maybe, yes (probably), or no (probably).] Virginia's Rules of Professional Conduct controlled.

Some points discussed were: Information from a prospective client will conflict out a law firm from representing an adverse party in the same matter, if it is significantly harmful and an effective screen is not possible. But a person who communicates information unilaterally to a lawyer, without any reasonable expectation that the lawyer is willing to discuss the possibility of forming a client-lawyer relationship, is not a prospective client. A lawyer shall not communicate about the subject of the representation with a person the lawyer knows to be represented by another lawyer in the matter, unless the lawyer has the consent of the other lawyer, or is authorized by law to do so. Even if the person initiates the communication, the lawyer must immediately terminate it. The use of "testers" in discrimination cases is not considered to be a communication. Silence may sometimes be considered an act of deception. "Puffery" in negotiations is allowed, but false statements of fact are not. A lawyer may be required to correct a client's misstatement to prevent a fraudulent act. A lawyer is required to disclose all material facts in an *ex parte* proceeding. Use of social media by a lawyer may be considered advertising, for which a disclaimer is required. A client testimonial that is a comparative statement that cannot be factually substantiated may not be used.

Photographs by Michael Lew.

Respectfully submitted,

Stephen Christopher Swift
Secretary-Treasurer