



Committee on Professional Ethics

Opinion 929 (8/8/12)

Topic: Designation of Patent Attorney on Business Card; Inactive Status and Designation of Specialty

Digest: An attorney whose registration/admission status before the United States Patent and Trademark Office is “inactive” may not use the designation patent attorney on his business card unless he notes that he is on administrative leave and as such is unable to prosecute matters for others before the USPTO.

Rules: Rule 7.1 a and b, 7.4(b), 7.5 (a), and 8.4(c)

FACTS

[1] The Inquirer, who is admitted to practice in patent matters before the United States Patent and Trademark Office (“USPTO”), has accepted a position as a patent examiner for the USPTO. Once the Inquirer begins working as a patent examiner for the USPTO, the inquirer’s name will remain on the official USPTO register, but his registration status will be changed to “on administrative leave.”

[2] During the period of his employment with the USPTO, the Inquirer will not be able to represent, or prosecute patent applications, for others or otherwise engage in patent practice before the USPTO.

[3] The Inquirer has advised that as a federal government employee he is prohibited from practicing as an attorney for others before any federal agency.

QUESTION

[4] May an attorney, who is admitted to practice before the USPTO continue to use the designation “Patent Attorney” on his business cards when his USPTO admission status changes to “administrative leave”?

OPINION

[5] According to Federal Law, an attorney who has fulfilled the requirements for admission to practice before the USPTO is deemed to be registered as a patent attorney. A patent attorney is able to represent applicants in the preparation and prosecution of patent applications and to

practice before the USPTO in patent matters. See 37 C.F.R. §§ 11.5, 11.6 (a) (1).

[6] Rule 7.4 of the New York Rules of Professional Conduct (the “Rules”) instructs lawyers who wish to identify themselves and their practices in terms of their respective specialties. According to Comment [2] of Rule 7.4, “Paragraph (b) recognizes the long-established policy of the Patent and Trademark Office for the designation of lawyers practicing before the Office.”

[7] Rule 7.4 (b) states as follows:

(b) A lawyer admitted to engage in patent practice before the United States Patent and Trademark Office may use the designation “Patent Attorney” or substantially similar designation.

[8] Rule 7.5 addresses attorneys’ use of professional cards and professional announcement cards, and permits an attorney to use such cards. Rule 7.5 provides:

(a) A lawyer or law firm may use internet web sites, professional cards, professional announcement cards, office signs, letterheads or similar professional notices or devices, provided the same do not violate any statute or court rule and are in accordance with Rule 7.1, including the following:

(1) a professional card of a lawyer identifying the lawyer by name and as a lawyer, and giving addresses, telephone numbers, the name of the law firm, and any information permitted under Rule 7.1(b) or Rule 7.4.

[9] In the instant situation, the Inquirer has advised that while serving as a patent examiner for the USPTO, he will be an employee of the Federal Government. Federal Government employees may not accept private clients or represent clients other than their agency before the USPTO. See 18 U.S.C. § 205; 37 CFR § 11.10(d) and (e) (an employee of the USPTO is prohibited “from prosecuting or aiding in any manner in the prosecution of a patent application for another”). In the instant matter, the Inquirer may not represent others before the USPTO.

[10] In the instant scenario because the Inquirer is unable to represent others before the USPTO while employed by the USPTO, Rule 7.1 is instructive in determining what information the Inquirer may include on his business card.

[11] Rule 7.1 (b) states in part:

(b) Subject to the provisions of paragraph (a), an advertisement may include information as to:

(1) legal and non-legal education, degrees and other scholastic distinctions, dates of admission to any bar; areas or the law in which the lawyer or law firm practices, as authorized by these Rules; public offices and teaching positions held; publications or law related matters authored by the lawyer; memberships in bar associations or others professional societies or organizations, including

offices and committee assignments therein; foreign language fluency; and bona fide professional ratings;”

[12] Rule 7.1(a) (1) and (2) prohibits a lawyer from using or disseminating any advertisement that “contains statements or claims that are false, deceptive or misleading; or violates a Rule.”

[13] Comment [6] of Rule 7.1 states “...all communications by lawyers, whether subject to the special rules governing lawyer advertising or not are governed by the general rule that lawyers not engage in conduct involving dishonesty, fraud, deceit or misrepresentation, or knowingly make a material false statement of fact or law.”

[14] In addition the lawyer must comply with Rule 8.4(c), which provides that a lawyer shall not “engage in conduct involving dishonesty, fraud, deceit or misrepresentation.”

[15] Therefore, it would be misleading for the Inquirer, without further explanation, to maintain the designation “patent attorney” on his business card when the attorney is currently unable to represent others or prepare/prosecute patent applications for submission to and/or presented before the USPTO.

[16] The Inquirer may attempt to prevent any ethical issues from arising when including the patent attorney designation on his business cards by also inserting language that notes that he is currently on administrative leave and is unable to represent others in patent matters before the USPTO.

[17] This conclusion is consistent with prior opinions concerning information to be disclosed on attorneys’ business cards.

[18] In N.Y. State 704 (1998), we concluded that business cards must fairly disclose jurisdictional limitations on practice of named attorneys. In that opinion, we also remarked on the purpose of the contents on letterhead and business cards and noted that “the contents of letterhead and business cards should enhance the public’s ability to recognize the need for counsel and to choose the most appropriate counsel, and should not contain any statement or representation that is false, deceptive or misleading” and the “contents should not violate any statute or court rule.”

[19] In N.Y. State 863 (2011) we concluded that a lawyer not admitted to practice in New York, who is engaged in immigration matters in New York, should “note on...her business cards that she is admitted to practice only in Texas and her practice in New York is limited solely to immigration matters.”

[20] Similarly, in the present inquiry, once the attorney becomes administratively inactive and is unable to practice before the USPTO, it would be misleading to use the designation patent attorney on business cards because it implies that he is able to prosecute patent applications and/or otherwise represent others before the USPTO, when in fact, he is not.

CONCLUSION

[21] It is misleading for an attorney employed as a patent examiner, whose registration status before the USPTO is administratively inactive, to use the designation patent attorney on his business cards during the leave period without inclusion of his status on the USPTO register. The attorney should include on his business card that he is on administrative leave and/or inactive status before the USPTO and is unable to prosecute patent applications and/or otherwise represent others before the USPTO.

(17-12)