The Supreme Court of Ohio

BOARD OF COMMISSIONERS ON GRIEVANCES AND DISCIPLINE

41 SOUTH HIGH STREET-SUITE 3370, COLUMBUS, OH 43215-6105
(614) 644-5800 FAX: (614) 644-5804

OFFICE OF SECRETARY

OPINION 91-25

Issued December 6, 1991

[Former CJC Opinion-provides advice under the former Ohio Code of Judicial Conduct which is superseded by the Ohio Code of Judicial Conduct, eff. 3/1/2009.]

[Not Current- subsequent rule amendments to Canons 1 through 6, Ohio Code of Judicial Conduct, eff. May 1, 1997]

SYLLABUS: The preparation, filing, and prosecution of patent applications before the U.S. Patent and Trademark office is activity which constitutes the practice of law. Full-time judges of any court of record in Ohio are prohibited from such practice of law, under Canon 5F of the Code of Judicial Conduct and Section 4705.01 of the Ohio Revised Code. This opinion does not purport to prohibit a non-lawyer registered to practice before the U.S. Patent and Trademark Office from performing functions within the scope of federal authority.

OPINION: The question presented is whether it is proper for a full-time judge of a court of record in Ohio to prosecute patent applications before the U.S. Patent and Trademark Office.

In Ohio, Canon 5F of the Code of Judicial Conduct succinctly and unequivocally states that "[f]ull-time judges, including those persons designated as Judges in the Compliance section of this Code, should not practice law." Section 4705.01 of the Ohio Revised Code also states, with more detail, that such practice is prohibited.

> No judge of any court of record in this state shall engage in the practice of law during his term of office, either by appearing in court, by acting as advisory or consulting counsel for attorneys or others, by accepting employment or acting as an attorney, solicitor, collector, or legal advisor for any bank, corporation, or loan or trust company, or by otherwise engaging in the practice of law in this state, in or out of the courts, except as provided in section 1902.1.1 of the Revised Code.

Ohio Rev. Code Ann. § 4705.01 (Baldwin 1991).

Therefore, at issue in this opinion is whether the preparation, filing, and prosecution of patent applications is the practice of law.

By statute, Congress has given the Commissioner of Patents and Trademarks the authority to "prescribe regulations governing the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Patent and Trademark Office." 35 U.S.C. § 31 (1988). By regulation, the Commissioner has explicitly authorized the prosecution of patent applications by both lawyers and non-lawyers: "An applicant for patent may file and prosecute his or her own case, or he or she may be represented by a registered attorney, registered agent, or other individual authorized to practice before the Patent and Trademark Office in patent cases." 37 C.F.R. § 1.31 (1990). However, in order to prosecute patent applications of others before the Patent and Trademark office, both attorneys and non-lawyer agents must be registered with the office. See 37 C.P.R. §§ 10.5 through 10.10 (1990).

Even though non-attorneys may be registered as agents and be granted the authority to file and prosecute patent applications, such activities may still be considered activities which constitute the practice of law. For example, in Sperry v. Florida, the U.S. Supreme Court vacated an order of the Florida Supreme Court which prohibited a non-lawyer registered to practice before the U.S. Patent Office from performing tasks incident to the preparation of prosecution of patent applications before the U.S. Patent Office. 373 U.S. 379, 404 (1963). In doing so, the Supreme Court did not question the determination that under Florida law the preparation and prosecution of patent applications for others constitutes the practice of law, but stated that by virtue of the Supremacy Clause, Florida could not deny the right to perform functions within the scope of the federal authority. Id. at 383-85.

In Ohio, the filing and prosecuting of patent applications by a person not licensed to practice before the United States Patent Office, nor licensed as an attorney in Ohio constitutes the practice of law. In re Cowgill, 37 Ohio App. 2d 121,124, 307 N.E. 2d 919, 921 (Ct. App. 1973). In the District of Columbia, advising investors as to patentability, preparing patent applications, advising of action to take after rejection, and preparing and filing amendments are within the realm of practice of law even if person does not sign correspondence with the Patent Office and disclaims that he/she is a patent attorney. In re Amalgamated Development Co., 375 A 2d. 494, 499 (D.C. Ct. App. 1977) cert. denied, 434 U.S. 924 (1977). In New York, patent agents can prepare applications even though it constitutes the practice of law solely because they are authorized to do so by federal law. People by Lefkowitz v. Lawrence Peska Assoc., 393 N.Y.S. 2d 650, 652 (Sup. Ct. 1977).

In accord, this Board advises that the preparation, filing, and prosecution of patent applications before the U.S. Patent and Trademark office is activity which constitutes the practice of law; therefore, full-time judges of any court of record in Ohio are prohibited from such practice of law, under Canon 5F of the Code of Judicial Conduct and Section 4705.01 of the Ohio Revised Code. This opinion does not purport to prohibit a non-lawyer registered to practice before the U.S. Patent and Trademark Office from performing functions within the scope of federal authority.

Advisory Opinions of the Board of Commissioners on Grievances and Discipline are informal, nonbinding opinions in response to prospective or hypothetical questions regarding the application of the Supreme Court Rules for the Government of the Bar of Ohio, the Supreme Court Rules for the Government of the Judiciary, the Code of Professional Responsibility, the Code of Judicial Conduct, and the Attorney's Oath of Office.