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Unauthorized Practice of Law--Practice before the United States Patent Office

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UNAUTHORIZED PRACTICE OF LAW — PRACTICE BEFORE THE UNITED STATES PATENT OFFICE

*State ex rel. Florida Bar v. Sperry, 140 So. 2d 587 (Fla. 1962), cert. granted, 83 Sup. Ct. 148 (1962) (No. 322)**

Respondent, Alexander Sperry, was admitted to practice before the United States Patent Office in 1928. Although not a member of the Florida Bar, he maintained a Tampa office on the door of which appeared the words, "Patent Attorney."[1] From this office he represented Florida clients before the Patent Office, performing such functions as the drafting of applications and amendments to applications for patents filed in the Patent Office in Washington, D.C. Petitioner sought an injunction to prevent Sperry from further performance of these functions. Respondent asserted in defense that he acted within the authority conferred upon him by the Patent Office and that the acts performed by him did not constitute the unauthorized practice of law. The Florida Supreme Court granted the petition enjoining Sperry from practicing before the Patent Office in Florida.

The most significant question raised by the *Sperry* case is whether the respondent, by virtue of his admission to practice before the Patent Office, has the right to perform such functions in Florida without being admitted to the Florida Bar.

Before answering this question, the court had to determine whether the acts of the respondent constituted the practice of law. This was an issue of first impression in Florida. If, of course, practice before the Patent Office, a federal administrative agency, is not the practice of law, the court has no basis for granting the petition.

Generally, a state acting pursuant to its police power has the right to define the practice of law and to determine who is qualified to practice within its borders.[2] This power has been extended to prevent the prac-

* The petition for writ of certiorari was filed in Sperry's behalf by a group of California attorneys, and was supported by amicus curiae briefs of the American Association of Registered Patent Attorneys and Agents and of the Committee for Southern California Patent Practitioners, Not Members of the California Bar (filed Sept. 6, 1962), and the Association of Interstate Commerce Commission Practitioners (filed Sept. 5, 1962).

1. Use of the title "patent attorney" by Sperry is authorized by 37 C.F.R. § 1.341(b) (1960) which provides: "Any citizen of the United States not an attorney at law who fulfills the requirements and complies with the provisions of these rules may be admitted to practice before the Patent Office and have his name entered on the register of agents. Note: All persons registered prior to November 15, 1938, were registered as attorneys, whether they were attorneys at law or not, and such registrations have not been changed."

2. Petition of Florida State Bar Ass'n, 134 Fla. 851, 186 So. 280 (1938); Chicago Bar Ass'n v. Kellogg, 338 Ill. App. 618, 88 N.E.2d 519 (1949); Clark v. Austin, 340 Mo. 467, 101 S.W.2d 977 (1937); *In re* Baker, 8 N.J. 321, 85 A.2d 505 (1951); West Virginia State Bar v. Earley, 109 S.E.2d 420 (W. Va. 1959).

tice of law by those who are not admitted to the state bar since the usefulness of licensed attorneys would be otherwise destroyed.[3]

In the *Sperry* case, the court agreed that federal agencies, such as the Patent Office, are authorized to determine who shall be permitted to practice before them. However, the court did not agree that this authority gives these agencies the power to determine that those licensed by it have the right to practice law, in the particular field involved, in Florida. The Florida Supreme Court had previously held that practice before the Tax Court and the Treasury Department "may constitute the practice of law which may be enjoined if attempted by one not admitted to practice."[4]

In the *Sperry* case, the court concluded that respondent's activities constituted the practice of law,[5] and the fact that the activities were carried out before a federal administrative agency rather than a court did not change the character of the acts from legal to non-legal.[6]

Ohio has taken a different view. The Franklin County Court of Appeals reversed and dismissed two lower court decisions[7] which held that the preparation, filing, and prosecution of patent applications in the Patent Office constituted the unauthorized practice of law.[8] It ruled that the federal government has "pre-empted" the regulation of Patent Office practice, leaving the states no power to superimpose their own requirements.[9]

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3. People *ex rel.* Chicago Bar Ass'n v. Goodman, 366 Ill. 346, 8 N.E.2d 941 (1937); Richmond Ass'n of Credit Men, Inc. v. Bar Ass'n of City of Richmond, 167 Va. 327, 189 S.E. 153 (1937); West Virginia State Bar v. Earley, 109 S.E.2d 420 (W. Va. 1959).

In the *Sperry* case, the Florida Supreme Court adopted the words of the West Virginia court: "It would indeed be an anomaly if the power of the courts to protect the public from the improper or unlawful practice of law were limited to licensed attorneys and did not extend or apply to incompetent and unqualified laymen and lay agencies. Such a limitation of the power of the courts would . . . substantially impair and disrupt the orderly and effective administration of justice by the judicial department of the government; and this the law will not recognize or permit." West Virginia State Bar v. Earley, 109 S.E.2d 420, 440 (W. Va. 1959).

4. Petition of Kearney, 63 So. 2d 630, 630 (Fla. 1953). The court also ruled that one who holds himself out to the practice "in any phase of law" must be a member of the Florida Bar. *Id.* at 631.

5. The court followed the rule that "if the giving of such advice and performance of such services affect important rights of a person under the law, and if the reasonable protection of the rights and property of those advised and served requires that the persons giving such advice possess legal skill and a knowledge of the law greater than that possessed by the average citizen, then the giving of such advice and the performance of such services . . . constitute the practice of law." 140 So. 2d 587, 591 (Fla. 1962).

6. *Id.* at 591.

7. *In re* Battelle Memorial Institute, 172 N.E.2d 917 (Ohio C.P. 1960); Battelle Memorial Institute v. Green, 172 N.E.2d 201 (Ohio C.P. 1960).

Another decision which was, in effect, overruled by the court of appeals was Marshall v. New Inventors Club, Inc., 117 N.E.2d 737 (Ohio C.P. 1953).

8. Battelle Memorial Institute v. Green, 133 U.S.P.Q. 49 (Ohio Ct. App. 1962).

9. "For the reasons set forth, we conclude that control of practice before the U.S. Patent Office is a superior right vested exclusively by the United States Constitution and by acts of Congress in the Commissioner of Patents, subject to appeal to the federal courts, and the state

In some jurisdictions, the practice of "patent law" is not the "practice of law."[10] Courts in other jurisdictions have adopted the Ohio approach, holding that where a federal agency licenses a layman to practice before it, a state may not prevent the layman from engaging in such practice within the state.[11]

The control of admissions to the practice of law, the discipline of those who are admitted, and the prohibition from practice of those who have not been examined and admitted by the courts is acknowledged to be for the protection of the public.[12] The decision in the *Sperry* case indicates that the court was motivated by this "public service" theory.

While it is true that the preparation and prosecution of a patent application requires legal knowledge and skill in excess of that possessed by the layman,[13] it is also true that these activities may require scientific knowledge and skill in excess of that possessed by the majority of the attorneys who are members of the Bar.[14] It is submitted that member-

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courts, by virtue of Article VI of the United States Constitution, are bound thereby and precluded from interfering." *Id.* at 54.

10. In Zenith Radio Corp. v. Radio Corp. of Am., 121 F. Supp. 792 (D. Del. 1954), the court held that corporate patent department attorneys do not act as lawyers when involved in activities such as those carried out by Sperry. *Accord,* Application of Platamura, 22 Conn. Supp. 213, 166 A.2d 859 (Super. Ct. 1960).

11. In DePass v. B. Harris Wool Co., 346 Mo. 1038, 144 S.W.2d 146 (1940), the court stated that the federal government has the constitutional power to regulate commerce among the several states, that an Act of Congress created the Interstate Commerce Commission and gave it the right to prescribe rules of practice before it (49 U.S.C.A. § 17(1)), that the commissioner adopted rules whereby persons other than attorneys-at-law may be admitted to practice before it, and that since these rules have the force and effect of law, plaintiff must be allowed to make a contract for such practice in Missouri. "To hold otherwise would put us in the untenable position of denying to our own citizens privileges enjoyed by citizens of other states under a valid law of the United States." *Id.* at 1042, 144 S.W.2d at 148.

In Auerbacher v. Wood, 139 N.J. Eq. 599, 53 A.2d 800 (Ch. 1947), the court permitted a non-lawyer to do whatever the National Labor Relations Board allowed, even argue primarily legal questions.

However, in Chicago Bar Ass'n v. Kellogg, 338 Ill. App. 618, 88 N.E.2d 519 (1949), the court enjoined a registered patent attorney, not a member of the Illinois Bar and not an attorney-at-law, from the unauthorized practice of law without prejudice to defendant's rights to advise and assist applicants for patents in presentation and prosecution of applications before the Patent Office.

The court also ruled that defendant had no right to collect fees for legal services wherever rendered.

12. Chicago Bar Ass'n v. United Taxpayers of America, 312 Ill. App. 243, 38 N.E.2d 349 (1941); Lowell Bar Ass'n v. Loeb, 315 Mass. 176, 52 N.E.2d 27 (1943); Auerbacher v. Wood, 139 N.J. Eq. 599, 53 A.2d 800 (1947).

13. State *ex rel.* Florida Bar v. Sperry, 140 So. 2d 587, 592 (Fla. 1962), *cert. granted,* 83 Sup. Ct. 148 (1962) (No. 322).

14. "[I]t may well be time for the lawyer to recognize that non-lawyers who are competently trained in their profession by education and experience (such as C.P.A. in tax field) may be better able to advise on matters concerning rights and obligations under the law than the ordinary attorney who is not a specialist in the field. . . . However, it may be time for the lawyer to recognize that the high degree of specialization in the law today will require either an increase in the number of qualified legal specialists in particular fields or the acceptance of the necessity of permitting non-lawyer specialists to give advice in their fields even if by so doing they are crossing into the lawyers' domain." Schafer, *Attorneys At Law, 1960 Survey of Ohio Law,* 12 W. RES. L. REV. 451, 455 (1961).