ZEALOUSLY REPRESENTING A CLIENT VERSUS COLLEGIALITY [1]

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and

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I. Introduction

37 CFR 10.84, "Representing a client zealously," reads in relevant part at follows:

> (a) A practitioner shall not intentionally:
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> > (1) Fail to seek the lawful objectives of a client through reasonably available means permitted by law and the Disciplinary Rules, except as provided by paragraph (b) on this section. A practitioner does not violate the provisions of this section, however, by acceding to reasonable requests of opposing counsel which do not prejudice the rights of the client, by being punctual in fulfilling all professional commitments, by avoiding offensive tactics, or by treating with courtesy and consideration all persons involved in the legal process. [Emphasis supplied.]
>
> * * *
>
> (b) In representation of a client, a practitioner may:
>
> > (1) Where permissible, exercise professional judgment to waive or fail to assert a right or position of the client. [Emphasis supplied.]
>
> * * *

Zealous representation of our clients is, of course, our stock in trade. However, as suggested by the emphasized language in both 37 CFR 10.84(a)(1) and (b)(1), the law is a learned profession in which, traditionally, a certain amount of collegiality is expected.

As illustrated by the two recent Board opinions discussed herein, considerations of zealous representation and collegiality are sometimes in tension--even in interferences.

Ding v. Singer

We represent Singer.[4] We had bollixed the appendices that were supposed to go with our two oppositions and the declaration of our expert witness. Specifically, when filing them, we had failed to attach one of the appendices either to the appropriate opposition or to the declaration. However, (1) the appendix had been before the expert witness when he signed his declaration and (2) that appendix merely presented in what we thought was clear tabular form arguments made in both the declaration and the opposition.

The Sunday before the Tuesday on which our expert witness was due to be deposed, we discovered our error. At that point, we asked opposing counsel to accept corrected copies of the declaration and the opposition with the appendix attached in the appropriate places.

Opposing counsel refused to do so. Accordingly, we asked for a conference call with the APJ, Judge Medley. During the conference call, each attorney made his pitch, after which Judge Medley ruled as follows:

> Singer requests leave to file a corrected Singer opposition 2 for the sole purpose of attaching the correct appendices to its opposition 2. Singer also requests leave to serve a corrected second declaration of George Barbastathis for the sole purpose of attaching the correct appendices. In preparation for the teleconference, Singer filed and served a copy of Singer Exhibit 1036 "CORRECTED" and "SINGER OPPOSITION 2 - CORRECTED."
>
> Counsel for Ding opposes the request as being unnecessary, since the points made in the appendices are duplicates of what is contained in the opposition 2 and declaration. Counsel for Ding explained that they are prepared to cross examine Barbastathis whether the correct appendices are included or not.

> A late filing will be excused where the Board determines that consideration on the merits would be in the interest of justice. Bd. R. 4(b)(2). Although Singer made a mistake, it appears that the mistake was an innocent one and a minor one at that.
>
> Apparently, and in accordance with representations made by counsel for Ding[5], there is no new information contained in the missing appendices that is not contained elsewhere in Singer opposition 2 and exhibit 1036. If so, then there would be no apparent prejudice to Ding if the correct appendices are included. Moreover, Ding apparently knew that something wasn't quite right about Singer opposition 2, but it did not notify the Board or opposing counsel about the problem. When asked why Ding did not notify Singer of the apparent mistake, counsel for Ding argued that Ding did not realize that they were responsible for proofing their opponent's papers, and weren't even sure that it was a mistake.
>
> Obviously, an opponent need not point out, for example, problems such as legal errors made in a brief. However, pointing out to opposing counsel that a typographical error may exist, or that pages might be missing from opposing counsel's paper[,] is the sort of courtesy and decorum that is expected in the proceeding. Bd.R. 1(c).[6] Ding would undoubtedly expect the same courtesy from the party Singer if the mistake had been theirs, and no less would be expected of Singer.
>
> Here, the Board has determined that it is in the interest of justice to authorize Singer to file a corrected Singer opposition 2 and corrected Singer Exhibit 1036 (SECOND DECLARATION OF GEORGE BARBASTATHIS).[7]

Gibson v. Sturman

On December 27, 2002, Sturman's counsel asked opposing counsel to agree to a one-day extension of time for filing papers that were due that day on the ground that one of his law partners had died on December 25, 2002 and that a viewing of the deceased was scheduled for December 27th. Gibson's counsel declined to agree to the extension,

but Judge Lee granted the extension, exhibiting choler seldom seen from an administrative patent judge:

> It should be noted that by established procedure in this interference, the parties are permitted to stipulate to extensions of time other than Time Periods 7 and 8 in the preliminary motions period, and a party is not to contact the administrative patent judge unless agreement cannot be reached with the opposing counsel. In this case, counsel for senior party Sturman had contacted the opposing counsel and explained that the need for a one-day extension arose from the death of counsel's law partner on December 25, 2002, in connection with which a viewing of the deceased was scheduled for December 27, 2002, the day the papers were due.
>
> Per 37 CFR § 1.610, the interference rules shall be construed to secure the <u>just</u>, <u>speedy</u>, and <u>inexpensive</u> termination of every interference. Also, 37 CFR § 1.610 provides that the administrative patent judge shall exercise control over the interference such that the pendency of the interference before the Board does not normally exceed two years. Terminating an interference proceeding in a just, speedy, and inexpensive manner, and also within two years[,] is a monumental task that **would require the understanding and cooperation of the parties and their counsel**.
>
> The administrative patent judge can see no reason why counsel for junior party Gibson could not, under the circumstances, agree to the requested one-day extension of time, or could think, under the circumstances, that the client would have reasonable cause for objecting. In my view, the request was so patently reasonable that the failure of counsel for junior party Gibson to cooperate by agreeing to the one-day extension resulted in a waste of the board's resources as well as unnecessarily increased the cost to senior party Sturman. Party Gibson did not reflect a level of cooperation that is expected by the APJ to have this interference proceed in a just, speedy, and inexpensive manner.
>
> Based on the foregoing, the APJ deems [it] necessary to take appropriate measures to modify those

> standing procedures which assume reasonable understanding and cooperation from both parties. It is
>
> **ORDERED** that for an extension of time not longer than one business day, for whatever reason and for all time periods except Time Periods 7 and 8 in the preliminary motions stage and except the "Last Time" in the priority stage, party Sturman need not obtain a stipulated agreement from party Gibson and also need not obtain the prior approval from an administrative patent judge, but need only make reference to this order in the paper making use of the extension;
>
> **FURTHER ORDERED** that since nothing reflects a less than expected level of understanding and cooperation on the part of senior party Sturman, the ability to self-approve a one-day extension of time is made available to senior Sturman only, and not to junior party Gibson; and
>
> **FURTHER ORDERED** that if junior party's lead or backup counsel was without authority to agree or stipulate to a brief extension of time, that situation is unacceptable and either the authority shall be obtained immediately or new lead and backup counsel having that authority shall be appointed, and that if junior party's lead or backup counsel had that authority, then the APJ expects to see a change in the level of understanding and cooperation from such counsel, toward the better, to help achieve a just, speedy, and inexpensive termination of this interference and to make more efficient use of the resources of the board.[8] [Emphasis in the original.]

Amazingly, Gibson's counsel sought reconsideration of Judge Lee's first order--thereby doing more damage to her reputation than she had done before:

> On December 31, 2002, a joint telephone conference was held at approximately 2:30 p.m. wherein counsel for junior party Gibson requested that the APJ reconsider the order transmitted by facsimile earlier that day (Paper No. 42). The APJ was informed that junior party's counsel did respond favorably to senior party's request for a one-day extension, by the sending of an email message. However, it was not known whether Mr. R. Danny Huntington had seen that e-mail message by December 27th when he first made a call to the board.

Presumably, he did not. Counsel for the junior party further indicated that the e-mail response contained two conditions for her consenting to a one-day extension of time and proceeded to explain what those conditions were, and that it was normal practice to get authorization from the client first as to such matters.

The request for reconsideration is denied. In the circumstances here, an immediate and unconditional consent would have been what the administrative patent judge expects from an attorney with the appropriate level of understanding and cooperation. It should be noted that emergency situations normally occur unexpectedly and when they do occur some deadline is usually just a day or two away. That is the basic character of an emergency as the filing of papers are concerned. There is no time for the opposing counsel to undertake "negotiations," i.e., consult with other counsel or client, come up with a set of desirable conditions, and then get back to the party requesting the one-day extension at some later time to propose a conditional stipulation, to which the first party must then digest, evaluate, and respond.

In emergency situations such as this, the administrative patent judge expects the opposing counsel to give an immediate and unconditional answer, yes or no, so that the party with the emergency would know whether he or she has gotten the one-day extension or he or she needs to arrange a joint conference call with the administrative patent judge immediately. It is inappropriate, in these situations, to hold the party with the emergency in suspense, not knowing when exactly will an answer be forthcoming and whether the answer will contain further conditions which will need to be evaluated and considered. In short, an emergency situation is not a time for the opposing party to begin a negotiation. If the opposing counsel doubts the authenticity of the emergency, he or she is free to withhold consent but should be ready to explain the basis of such doubt if the judge so inquires at some later time.

For the foregoing reasons, it is

ORDERED that junior party Gibson's request for reconsideration is ***denied***; and

> **FURTHER ORDERED** that counsel for the junior party is authorized to file a copy of the e-mail message to senior party's counsel if it is the junior party's desire to have the interference file contain a record of its eventual consent, albeit with conditions, to the senior party's request for a one-day extension of time.[9]

II. What the Courts Have Said In Similar Situations

In the oft-cited case of Paramount Communications, Inc. v. QVC Network, Inc., 637 A.2d 34, 53 (Del. 1994), the court *sua sponte* dealt with "an astonishing lack of professionalism and civility that is worthy of special note." The following deposition excerpt demonstrates the antics of Mr. Jamail, an attorney admitted in Texas who was defending his client Mr. Liedtke in a deposition in Texas taken by Mr. Johnston:

> Q. (By Mr. Johnston [Delaware counsel for QVC]) Okay. Do you have any idea why Mr. Oresman was calling that material to your attention?
>
> MR. JAMAIL: Don't answer that. How would he know what was going on in Mr. Oresman's mind? Don't answer it. Go on to your next question.
>
> MR. JOHNSTON: No, Joe --
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> MR. JAMAIL: He's not going to answer that. Certify it. I'm going to shut it down if you don't go to your next question.
>
> MR. JOHNSTON: No. Joe, Joe --
>
> MR. JAMAIL: Don't "Joe" me, a**hole. You can ask some questions, but get off of that. I'm tired of you. You could gag a maggot off a meat wagon. Now, we've helped you every way we can.
>
> MR. JOHNSTON: Let's just take it easy.
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> MR. JAMAIL: No, we're not going to take it easy. Get done with this.
>
> MR. JOHNSTON: We will go on to the next question.

> MR. JAMAIL: Do it now.
>
> MR. JOHNSTON: We will go on to the next question. We're not trying to excite anyone.
>
> MR. JAMAIL: Come on. Quit talking. Ask the question. Nobody wants to socialize with you.
>
> MR. JOHNSTON: I'm not trying to socialize. We'll go on to another question. We're continuing the deposition.
>
> MR. JAMAIL: Well, go on and shut up.
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> MR. JOHNSTON: Are you finished?
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> MR. JAMAIL: Yeah, you --
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> MR. JOHNSTON: Are you finished?
>
> MR. JAMAIL: I may be and you may be. Now, you want to sit here and talk to me, fine. This deposition is going to be over with. You don't know what you're doing. Obviously someone wrote out a long outline of stuff for you to ask. You have no concept of what you're doing. Now, I've tolerated you for three hours. If you've got another question, get on with it. This is going to stop one hour from now, period. Go.

The court was incensed--and vented as follows:

> During the Liedtke deposition, Mr. Jamail abused the privilege of representing a witness in a Delaware proceeding, in that he: (a) improperly directed the witness not to answer certain questions; (b) was extraordinarily rude, uncivil, and vulgar; and (c) obstructed the ability of the questioner to elicit testimony to assist the Court in this matter.[10]

The Court specifically commented on the intersection of zealous representation and professionalism:

> Staunch advocacy on behalf of a client is proper and fully consistent with the finest effectuation of skill and professionalism. Indeed, it is a mark of professionalism, not weakness, for a lawyer zealously and firmly to protect and pursue a client's legitimate interests by a professional,

> courteous, and civil attitude toward all persons involved in the litigation process. A lawyer who engages in the type of behavior exemplified by Mr. Jamail on the record of the Liedtke deposition is not properly representing his client, and the client's cause is not advanced by a lawyer who engages in unprofessional conduct of this nature. It happens that in this case there was no application to the Court, and the parties and the witness do not appear to have been prejudiced by this misconduct.
>
> Nevertheless, the Court finds this unprofessional behavior to be outrageous and unacceptable. If a Delaware lawyer had engaged in the kind of misconduct committed by Mr. Jamail on this record, that lawyer would have been subject to censure or more serious sanctions. While the specter of disciplinary proceedings should not be used by the parties as a litigation tactic, conduct such as that involved here goes to the heart of the trial court proceedings themselves.…Under some circumstances, the use of the trial court's inherent summary contempt powers may be appropriate.
>
> Although busy and overburdened, Delaware trial courts are "but a phone call away" and would be responsive to the plight of a party and its counsel bearing the brunt of such misconduct….We assume that the trial courts of this State would consider protective orders and the sanctions permitted by the discovery rules. Sanctions could include exclusion of obstreperous counsel from attending the deposition (whether or not he or she has been admitted *pro hac vice),* ordering the deposition recessed and reconvened promptly in Delaware, or the appointment of a master to preside at the deposition. Costs and counsel fees should follow.[11]

Despite the court's language, Mr. Jamail emerged relatively unscathed, because, as a Texas lawyer not admitted *pro hac vice* in this case, the Delaware Supreme Court was without authority to sanction Mr. Jamail.[12]

The Second Circuit and the Southern District of New York demonstrate the difficulty of determining what behavior constitutes acceptable or unacceptable zealous representation. The Second Circuit acknowledged:

> We are cognizant of the unique dilemma that sanctions present. On the one hand, a court should discipline those who harass their opponents and waste judicial resources by abusing the legal process. On the other hand, in our adversarial system, we expect a litigant and his or her attorney to pursue a claim zealously within the boundaries of the law and ethical rules. Given these interests, determining whether a case or conduct falls beyond the pale is perhaps one of the most difficult and unenviable tasks for a court.

Schlaifer Nance & Co. v. Estate of Warhol, 194 F.3d 323, 341 (2nd Cir. 1999).

A district court presiding over a fee dispute strongly believed that the conduct of Mr. Judd Burstein, counsel for plaintiff Revson against Revson's former counsel, Cinque & Cinque, went "clearly and unmistakably 'beyond the pale,'" when Mr. Burstein's actions included:

> Writing a letter to Cinque threatening to "tarnish" his reputation and subject him to the "legal equivalent of a proctology exam";
> …
> Publicly accusing Cinque of fraud without any concrete evidence to support the claim;
>
> Threatening to interfere with the Firm's other clients, including (i) conducting an investigation to identify those clients, (ii) contacting one or more of the Firm's former clients, and (iii) seeking permission to send a letter to all the Firm's clients to inquire as to "experiences, good or bad," with the Firm's billing practices;
> …
> Threatening to add a RICO claim;
> …
> Threatening to send a letter to the Court accusing Cinque of criminal conduct if he did not capitulate to Revson's demands;
>
> Making good on his threat to "tarnish" Cinque's reputation by contacting a reporter some weeks before trial, explaining that Revson had sued Cinque for fraudulent billing, and giving the reporter documents as well as names of former clients;

> Repeatedly attacking Cinque in an offensive and demeaning fashion, including calling Cinque "a lawyer who . . . has acted in a manner that shames all of us in the profession," "a disgrace to the legal profession," and an example of "why lawyers are sometimes referred to as snakes," and accusing Cinque of "engaging in the type of mail fraud that has led to the criminal conviction of other attorneys," being so "desperate for money he resorted to . . . extortion," and being "slimy."

Revson v. Cinque & Cinque, P.C., 221 F.3d 71, 79 (2d Cir. 2000), citing Revson v. Cinque & Cinque, P.C., 70 F. Supp. 2d 415, 417 (S.D.N.Y. 1999).

In connection with its imposing sanctions against Mr. Burstein in the amount of $50,000.00, the district court remarked:

> The bar should take note, as this case well shows, that Rambo tactics do not work. Judges and juries do not like them. The tactics employed by Burstein here did not prevent the jury from returning a substantial verdict against Revson and they undoubtedly contributed to the result. There is a lesson to be learned. As one commentator has observed, "It defies all common experience to believe that mean-spiritedness is persuasive. . . . Hardball is bad advocacy." Sayler, supra, 74 A.B.A. J. at 80; see also John G. Koeltl, From the Bench, 23 No. 3 Litig. 3, 3 (1997) ("Incivility is counterproductive. Lawyers should be civil in litigation not only because it is the right way to practice law -- which it is -- but also because lawyers hurt their clients and themselves by being mean-spirited, nasty, rude, and generally uncooperative with their adversaries and the court."); Edward M. Waller, Judicial Activists Wanted, 84 A.B.A. J. 116, 116 (June 1998) ("Experienced counsel know that the lawyer who maintains a professional style is the more effective advocate.").[13]

The Second Circuit stated that sanctions can issue either through the Court's inherent powers or 28 USC 1927 and that, while the elements to satisfy the inherent and statutory authorities differ somewhat, the evidence to support either can be very similar or identical:

> An award of sanctions under the court's inherent power

> requires both "clear evidence that the challenged actions are entirely without color, and [are taken] for reasons of harassment or delay or for other improper purposes[,] and a high degree of specificity in the factual findings of [the] lower courts." Oliveri v. Thompson, 803 F.2d 1265, 1272 (2d Cir. 1986) (internal quotation marks omitted) (emphasis added), cert. denied, 480 U.S. 918 (1987). A claim is colorable "when it has some legal and factual support, considered in light of the reasonable beliefs of the individual making the claim." Nemeroff v. Abelson, 620 F.2d 339, 348 (2d Cir. 1980) (per curiam).
>
> Under § 1927, "any attorney . . . who so multiplies the proceedings in any case unreasonably and vexatiously may be required by the court to satisfy personally the excess costs, expenses, and attorneys' fees reasonably incurred because of such conduct." 28 U.S.C. § 1927. "Bad faith is the touchstone of an award under this statute." United States v. International Brotherhood of Teamsters, 948 F.2d 1338, 1345 (2d Cir. 1991). "Like an award made pursuant to the court's inherent power, an award under § 1927 is proper when the attorney's actions are so completely without merit as to require the conclusion that they must have been undertaken for some improper purpose such as delay." Oliveri v. Thompson, 803 F.2d at 1273 (emphasis added); id. ("An award made under § 1927 must be supported by a finding of bad faith similar to that necessary to invoke the court's inherent power . . . .").
>
> Thus, "to impose sanctions under either authority, the trial court must find clear evidence that (1) the offending party's claims were entirely meritless and (2) the party acted for improper purposes." Agee v. Paramount Communications Inc., 114 F.3d 395, 398 (2d Cir. 1997).[14]

The Second Circuit acknowledged that it was reviewing the district court's decision on an abuse of discretion standard and that: "the district court is better situated than the court of appeals to marshal the pertinent facts and apply the fact-dependent legal standard that informs its determination as to whether sanctions are warranted." However, it also stated that "we nevertheless need to ensure that any such decision is made with restraint and discretion."[15]

The Second Circuit proceeded to analyze each of Mr. Burstein's separate acts. After finding that at least some of plaintiff's claims were colorable against the Cinque firm, the court went further and examined, in isolation, each of the types of acts that the district court criticized. The Second Circuit then explained away or excused Mr. Burstein's conduct so as not to find any sanctionable behavior. For example, with regard to Mr. Burstein's letter threatening the "legal equivalent of a proctology exam" the Second Circuit stated that:

> though the reference to proctology was offensive and distinctly lacking in grace and civility, it is, regrettably, reflective of a general decline in the decorum level of even polite public discourse. Although we, like the district court, find the reference to proctology repugnant, and Burstein himself admits it was inappropriate, we cannot conclude that that reference was sanctionable.[16]

With regard to Mr. Burstein's numerous statements that Cinque was a disgrace to the legal profession and a snake, the circuit court commented: "[A]lthough likening an attorney to a member of the animal kingdom may well be opprobrious, such colorful tropes are not necessarily injudicious discourse."[17] The court went even further and distinguished caselaw chastising ad hominem attacks between opposing counsel, since in this case Cinque was representing his own firm, and therefore "his performance as a lawyer was at issue."[18] In sum, the Second Circuit proceeded to reverse the district court's imposition of sanctions on Mr. Burstein.

III. Comments

(1) In partial defense of Ding's counsel, the relationship between the two real parties in interest in that case is unusually acrimonious, and they likely did what they did on instructions from their client. However, as Judge Lee's opinion makes clear, arguing

that one's client has instructed one to behave in a non-collegial manner is unlikely to be perceived as an adequate excuse for doing so.

(2) During our professional career, several Article III judges have stated publicly that the patent bar is unusually well behaved in that it engages in less "Rambo" lawyering than many bars. We have always believed that the interference bar is notable for its civility even relative to the general patent bar. Hopefully, opinions such as Judge Medley's in Ding and Judge Lee's in Gibson will keep it that way.

(3) The sanction imposed by Judge Lee in Gibson was relatively minor. However, in view of the tone of these two opinions, we do not think that one should anticipate such minor sanctions in the future.

(4) Litigations involve a great deal of tit-for-tat, so that "making nice" with opposing counsel, thereby inducing opposing counsel to "make nice" with you, frequently is in the client's best interest in the long run.

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[5] As Mr. Gholz recalls, he initially made those representations, but opposing counsel conceded that they were accurate.

[6] Board Rule 1(c) reads as follows:

> Decorum. Each party must act with courtesy and decorum in all proceedings before the Board, including interactions with other parties.

[7] Interference No. 105,436, Paper No. 36.

[8] Interference No. 105,016, Paper No. 42.

[9] Interference No. 105,016, Paper No. 43; footnote omitted.

[10] Paramount Communications, Inc. v. QVC Network, Inc., 637 A.2d 34, 53 (Del. 1994)

[11] Id. at 54-55; citations and footnotes omitted.

[12] Id. at 56.

[13] Revson, 70 F. Supp. 2d 415, 435-436 (S.D.N.Y. 1999), vacated in part, rev'd in part by, 221 F.3d 71 (2d Cir. 2000);

[14] Revson v. Cinque & Cinque, P.C., 221 F.3d 71, 78-79 (2d Cir. 2000)

[15] Id. at 78, citing Sussman v. Bank of Israel, 56 F.3d 450, 456 (2d Cir.), cert. denied, 516 U.S. 916 (1995), and Schlaifer Nance & Co. v. Estate of Warhol, 194 F.3d 323, 334 (2nd Cir. 1999)

[16] Revson v. Cinque & Cinque, P.C., 221 F.3d at 79

[17] Id. at 82.

[18] Id.