

**BEFORE THE DIRECTOR
OF THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In the Matter of	)	
	)	
Jeremy U. Blackowicz,	)	Proceeding No. D2015-13
	)	
Respondent	)	
_____	)	

FINAL ORDER

The Director of the Office of Enrollment and Discipline (“OED Director”) for the United States Patent and Trademark Office (“USPTO” or “Office”) and Jeremy U. Blackowicz (“Respondent”) have submitted a Proposed Settlement Agreement of Disciplinary Matter Pursuant to 37 C.F.R. § 11.26 (“Agreement”) to the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (“USPTO Director”) for approval.

The Agreement, which resolves all disciplinary action by the USPTO arising from the stipulated facts set forth below, is hereby approved. This Final Order sets forth the parties’ stipulated facts, legal conclusion, and sanctions.

Jurisdiction

1. At all times relevant hereto, Respondent of Boston, Massachusetts, has been an attorney who has practiced before the Office in trademark matters and he is subject to the disciplinary jurisdiction of the USPTO under 37 C.F.R. § 11.19; the USPTO Code of Professional Responsibility, *see* 37 C.F.R. §§ 10.20 through 10.112, and the USPTO Rules of Professional Conduct, *see* 37 C.F.R. §§ 11.101 through 11.901.
2. The USPTO Director has jurisdiction over this matter pursuant to 35 U.S.C. §§ 2(b)(2)(D) and 32 and 37 C.F.R. § 11.19.

Stipulated Facts

3. Respondent of Boston, Massachusetts is an attorney licensed to practice law in Massachusetts and his Massachusetts Board of Overseers number is 650945.
4. As an attorney active and in good standing with the highest court of any State, Respondent may represent others before the Office in trademark and other non-patent matters.
5. Respondent is an associate at Day Pitney, LLP (“Day Pitney”).

6. David Newman, partner at Day Pitney, requested that Respondent provide trademark legal services to two co-owners of a trademark application in February 2013, Client 1 and Client 2.

7. Respondent undertook joint representation of Client 1 and Client 2.

8. At the same time Respondent represented Client 1 and Client 2, he represented Client 2's father, Client 3, and Client 2's uncle, Client 4, who owned a company, Client 5, that was also a client of Respondent.

9. Respondent did not make any disclosures to Client 1 and Client 2 regarding the possible effects of Respondent and Day Pitney representing Client 1 and Client 2 while also representing Respondent's and Day Pitney's long-time clients, Client 3, Client 4, and Client 5 and also did not obtain consent after full disclosure from Client 1.

10. Prior to undertaking representation of Client 1 and Client 2, Respondent did not conduct a conflict of interest check to determine any conflicts between representing Client 1 and Client 2 while also representing Clients 3, 4, and 5.

11. Respondent billed his time to the company - Client 5, a third party, for the work performed for Client 1 and Client 2.

12. Respondent did not make any disclosures to either Client 1 or Client 2 regarding the possible risks or benefits of their joint representation and also did not obtain consent after full disclosure to represent Client 1 and Client 2 jointly.

13. Respondent did not make any disclosures to either Client 1 or Client 2 regarding a third party paying their legal fees.

14. Respondent did not make any disclosures to either Client 1 or Client 2 that he was not permitted to take direction from the third party although the third party was paying the legal fees.

15. Respondent did not make any disclosures regarding a third party receiving or participating in communications between himself and Client 1 and Client 2 regarding their trademark application, the matter for which they were represented.

16. During the prosecution of the trademark application on behalf of Client 1 and Client 2, Respondent learned of a dispute between Client 1 and Client 2 regarding their business enterprise.

17. Beginning on or around December 30, 2013, and continuing into January 2014, Respondent engaged in email communications and met via phone conferences with Client 3, Client 2, and David Newman regarding the trademark application co-owned by Client 1 and Client 2 and the business dispute between Client 1 and Client 2.

18. Respondent engaged in a series of email communications and phone conferences with Client 3, Client 2, and David Newman regarding the filing of an Express Abandonment of the trademark application co-owned by Client 1 and Client 2, and also discussed the filing of two new trademark applications on behalf of Client 3's company, Client 6, seeking registration of the same trademark as that of Client 1 and Client 2's previously filed trademark application.

19. Respondent and David Newman did not include Client 1 in the emails or the phone conferences with Client 3 and Client 2.

20. As a result of the email communications and the phone conferences with Client 3, Client 2, and David Newman, Respondent took direction from Client 3 and Client 2 to file an Express Abandonment of the trademark application co-owned by Client 1 and Client 2.

21. As a result of the email communications and the phone conferences with Client 3, Client 2, and David Newman, Respondent also took direction from Client 3 and Client 2 to file two new trademark applications on behalf of Client 3's new company, Client 6.

22. Respondent did not consult with Client 1 regarding the filing of the Express Abandonment of the trademark application for which she was co-owner.

23. Respondent filed an Express Abandonment of the trademark application co-owned by Client 1 and Client 2 without giving Client 1 a reasonable and meaningful amount of time to state her objection.

24. Immediately following the filing of the Express Abandonment of the trademark application co-owned by Client 1 and Client 2, Respondent filed two new trademark applications on behalf of Client 3's company, Client 6, for the same mark previously filed on behalf of Client 1 and Client 2 and also did not obtain consent after full disclosure from Client 1.

25. After Client 1 informed Respondent that he should file a Petition to reinstate the trademark application for which she was co-owner, Respondent filed the Petition, with David Newman's approval, despite the fact that if the Petition was granted it would be directly adverse to the two new applications filed on behalf of Client 3's company, Client 6.

26. Respondent and Day Pitney had an irreconcilable conflict of interest between his clients, Client 1 and Client 6, owned by Client 5.

27. Respondent represents that Day Pitney was originally approached by a long-time client to assist Client 1 and Client 2 with a trademark application. Because the matter arose under the aegis of that client, Respondent did not appreciate Client 1's status as his client, his joint representation of Client 1 and Client 2, and his obligation to advise Client 1 regarding potential conflicts of interest. Respondent sincerely regrets his failure to meet his ethical obligations; this oversight, however, was not motivated by indifference to his ethical duties or malevolence. Respondent understands how the missteps occurred and where the mistakes were made and regrets his conduct.

Joint Legal Conclusions¹

28. Respondent admits that, based on the above stipulated facts, he violated the following provisions of the USPTO Code of Professional Responsibility:

- a. 37 C.F.R. § 10.62(a) (failure to obtain consent after full disclosure from a client to accept employment if the exercise of the practitioner's professional judgment on behalf of the client will be, or reasonably may be, affected by the practitioner's own financial, business, property, or personal interests);
- b. 37 C.F.R. § 10.66(a)-(c) (failure to decline proffered employment if the exercise of the practitioner's independent professional judgment on behalf of a client will be adversely affected or would involve the practitioner in representing differing interests); (continuing employment of multiple clients when the practitioner's independent judgment is likely to be adversely affected by representation of both clients or when continuing representation would be likely to involve the practitioner in representing differing interests); (continuing employment of multiple clients when the practitioner's independent judgment is likely to be adversely affected by representation of both clients or when continuing representation would be likely to involve the practitioner in representing differing interests without obtaining consent after full disclosure of the possible effect of such representation on the exercise of the practitioner's independent professional judgment on behalf of each);
- c. 37 C.F.R. § 10.68(a)(1)-(2) and (b) (without obtaining consent after full disclosure from the client, accepting compensation from one other than the practitioner's client for the practitioner's legal services); (without obtaining consent after full disclosure, accepting from one other than the practitioner's client anything of value related to the practitioner's representation or employment by the client); (allowing a person who pays the practitioner to render legal services for another to direct the practitioner's professional judgment in rendering such legal services).

29. Respondent admits that, based on the above stipulated facts, he violated the following provisions of the USPTO Rules of Professional Conduct:

- a. 37 C.F.R. § 11.102(a) (failing to abide by a client's decisions concerning the objectives of representation and failing to consult with the client as to the means by which the objectives are pursued);
- b. 37 C.F.R. § 11.104(a)(1)-(2) and (b) (failing to promptly inform the client of any decision or circumstance with respect to which the client's informed

¹ Effective May 3, 2013, the USPTO Rules of Professional Conduct apply to persons who practice before the Office. The conduct set forth herein and the Amended Complaint occurred prior to and after May 3, 2013. Therefore, both the USPTO Code of Professional Responsibility and USPTO Rules of Professional Conduct apply.

consent is required); (failing to consult with the client about the means by which the client's objectives are to be accomplished); (failing to explain a matter to the extent reasonably necessary to permit the client to make informed decisions regarding the representation);

- c. 37 C.F.R. § 11.107(a)(1)-(2) and (b)(3)-(4) (representing a client when the representation of one client will be directly adverse to another client); (representing a client when the representation of that client may be materially limited by the lawyer's responsibilities to another client); (representing a client when the representation involves the assertion of a claim by one client against another client represented by the practitioner in the same proceeding without obtaining consent after full disclosure);
- d. 37 C.F.R. § 11.108(f)(1)-(3) (representing a client and accepting compensation for representing that client from one other than the client unless the client gives informed consent); (representing a client and accepting compensation for representing that client from one other than the client when there is interference with the practitioner's independence, professional judgment, or with the client-practitioner relationship); (representing a client and accepting compensation for representing that client from one other than the client and failing to protect information relating to representation of the client as required under the confidentiality rule, 37 C.F.R. § 11.106);
- e. 37 C.F.R. § 11.109(a) (representing a former client and thereafter representing another client in the same or substantially related matter in which the interests of that client are materially adverse to the interests of the former client without obtaining informed consent, confirmed in writing, from the former client);
- f. 37 C.F.R. § 11.504(c) (allowing a person who pays the practitioner to render legal services to another to direct or regulate the practitioner's professional judgment in rendering such legal services).

Additional Considerations

30. Respondent recognizes the seriousness of his misconduct and has expressed remorse for it and for its effect on his former client as well as on the reputation of the legal profession.

31. Respondent has attended and successfully completed two Continuing Legal Education ("CLE") classes concerning conflicts of interest on March 16, 2015 and April 2, 2015.

32. Respondent has not been previously disciplined.

Agreed Upon Sanction

33. Respondent agrees, and it is hereby ORDERED that:
- a. Respondent is hereby suspended from practice before the Office in trademark and other non-patent matters for thirty (30) days, which shall commence fourteen (14) days after the Final Order is signed;
 - b. Respondent shall not engage in trademark or other non-patent law as defined by 37 C.F.R. §§ 11.5(b)(1) and 11.5(b)(2) during his thirty (30) day suspension;
 - c. Within one year of the date this Final Order is signed, Respondent (1) shall take the Multi-State Professional Responsibility Examination ("MPRE"), (2) attain a score of 85 or better, and (3) provide a declaration to the OED Director verifying his compliance with this subparagraph;
 - d. Respondent shall serve a thirteen (13) month probation commencing on the date of the Final Order;
 - e. Respondent shall have an attorney in good standing and active status of any state bar serve as a practice monitor during the course of his 13-month probation;
 - f. Respondent shall cause the practice monitor to file four quarterly compliance reports with the OED Director certifying whether Respondent's practice before the Office complies with the USPTO Rules of Professional Conduct;
 - g. Respondent shall cause the practice monitor (1) to file the first compliance report with the OED Director five months after the date of the Final Order, (2) to file the second compliance report with the OED Director eight months after the date of the Final Order, (3) to file the third compliance report with the OED Director eleven months after the date of the Final Order, and (4) to file the fourth compliance report with the OED Director fourteen months after the date of the Final Order;
 - h. Respondent shall cause (1) the practice monitor's first compliance report to cover Respondent's practice before the Office during the ninety (90) days commencing from one month after the date of the Final Order; (2) the practice monitor's second compliance report to cover Respondent's practice before the Office during the ninety (90) days commencing from four months after the date of the Final Order; (3) the practice monitor's third compliance report to cover Respondent's practice before the Office during the ninety (90) days commencing from seven months after the date of the Final Order; and (4) the practice monitor's fourth compliance report to cover Respondent's practice before the Office during the ninety (90) days commencing from ten months after the date of the Final Order;

- i. Respondent shall attend the Continuing Legal Education seminar in June 2015 sponsored by the Massachusetts Board of Bar Overseers, which includes topics such as conflicts of interest and conflicts management;
- j. Respondent shall cooperate with the OED Director in any requests for information or testimony in any disciplinary matter before the USPTO;
- k. Respondent shall comply with 37 C.F.R. § 11.58(a) except to the extent it requires compliance with provisions of 37 C.F.R. §§ 11.58 and 11.60 that are expressly waived by the Agreement pursuant to 37 C.F.R. § 11.3(a)²;
- l. Respondent shall comply with 37 C.F.R. § 11.58(b)(1)(ii) with the exception of notifying clients and the following provisions are waived pursuant to 37 C.F.R. § 11.3(a) : 37 C.F.R. §§ 11.58(b)(1)(i), 11.58(b)(1)(iii)-(vi), and 11.58(b)(1)(vii) solely as it pertains to (b)(1)(iii);
- m. Respondent shall comply with 37 C.F.R. § 11.58(b)(2)(v) and the following provisions are waived pursuant to 37 C.F.R. § 11.3(a): 37 C.F.R. §§ 11.58(b)(2)(i)-(iv) and (vi);
- n. Respondent shall comply with 37 C.F.R. § 11.58(b)(3);
- o. Respondent shall comply with 37 C.F.R. § 11.58(b)(4);
- p. Respondent shall comply with 37 C.F.R. § 11.58(b)(5);
- q. Respondent shall not be granted limited recognition for thirty (30) days under 37 C.F.R. § 11.58(c);
- r. Respondent shall comply with 37 C.F.R. § 11.58(d);
- s. Respondent shall comply with 37 C.F.R. § 11.58(e)-(f);
- t. Respondent shall remain suspended from practice before the Office in trademark and other non-patent matters until the OED Director grants Respondent's petition for reinstatement pursuant to 37 C.F.R. § 11.60, except where certain provisions of 37 C.F.R. § 11.60 are waived by the terms of the Agreement pursuant to 37 C.F.R. § 11.3(a);
- u. Respondent shall comply with 37 C.F.R. § 11.60(a);

² The General Counsel exercises authority under 37 C.F.R. § 11.3(a) pursuant to a delegation of authority from the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office dated September 8, 2004.

- v. Respondent shall comply with 37 C.F.R. § 11.60(b) except where certain provisions of 37 C.F.R. § 11.58 are waived by the terms of the Agreement pursuant to 37 C.F.R. § 11.3(a);
- w. Respondent shall comply with 37 C.F.R. § 11.60(c) by filing a petition for reinstatement accompanied by the fee required by 37 C.F.R. § 1.21(a)(10), with the exception that the provisions of 37 C.F.R. §§ 11.60(c)(1)-(3) are waived pursuant to 37 C.F.R. § 11.3(a), and Respondent must file a petition for reinstatement with the OED Director that attests to his compliance with the relevant provisions of 37 C.F.R. § 11.58 including a sworn declaration that he has complied with 37 C.F.R. § 11.58(a) affirming that he has not engaged in the practice of trademark law or other non-patent matters before the Office during his thirty (30) day suspension;
- x. Respondent shall comply with 37 C.F.R. § 11.60(d)(1) with the exception of where the terms therein are waived by the Agreement;
- y. The provisions of 37 C.F.R. § 11.60(d)(2)(i)-(iii) are waived pursuant to 37 C.F.R. § 11.3(a);
- z. Respondent shall comply with 37 C.F.R. § 11.60(d)(3) as it applies to the fees set forth in 37 C.F.R. § 1.21(a)(10);
- aa. The provisions of 37 C.F.R. § 11.60(e)-(f) apply;
- bb. The provision of 37 C.F.R. § 11.60(g) is waived pursuant to 37 C.F.R. § 11.3(a);
- cc. (1) if the OED Director is of the opinion that Respondent, during Respondent's probationary period, failed to comply with any provision of the Final Order or any provision of the USPTO Rules of Professional Conduct or the USPTO Code of Professional Responsibility, the OED Director shall:
 - (A) issue to Respondent an Order to Show Cause why the USPTO Director should not enter an order immediately suspending Respondent for up to an additional twelve (12) months for the violations set forth in the Joint Legal Conclusions above;
 - (B) send the Order to Show Cause to Respondent at the last address of record Respondent furnished to the Massachusetts Board of Overseers;
 - (C) grant Respondent fifteen (15) days to respond to the Order to Show Cause; and

(2) in the event that after the 15-day period for response and consideration of the response, if any, received from Respondent, the OED Director continues to be of the opinion that Respondent, during Respondent's probationary period, failed to comply with any provision of the Agreement, Final Order, or any provision of the USPTO Rules of Professional Conduct, the OED Director shall:

- (A) deliver to the USPTO Director: (i) the Order to Show Cause; (ii) Respondent's response to the Order to Show Cause, if any; and (iii) argument and evidence causing the OED Director to be of the opinion that Respondent, during Respondent's probationary period, failed to comply with any provision of the Agreement, Final Order, or any provision of the USPTO Rules of Professional Conduct or the USPTO Code of Professional Responsibility; and
- (B) request that the USPTO Director enter an order immediately suspending Respondent for up to an additional twelve (12) months for the violations set forth in the Joint Legal Conclusions above;

- dd. Nothing herein shall prevent the OED Director from seeking discipline for the misconduct leading to Respondent's additional suspension pursuant to the preceding paragraph;
- ee. In the event the USPTO Director suspends Respondent pursuant to paragraph cc, above, and Respondent seeks a review of the suspension, any such review of the suspension shall not operate to postpone or otherwise hold in abeyance the suspension;
- ff. If Respondent successfully completes the period of probation, Respondent shall provide a declaration to the OED Director that he has complied with all the terms of his probation and request that the OED Director confirm in writing Respondent's compliance with the conditions of his probation;
- gg. The OED Director electronically publish the Final Order at OED's electronic FOIA Reading Room, which is publicly accessible at:
<http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>;
- hh. The OED Director shall publish a notice in the *Official Gazette* that is materially consistent with the following:

Notice of Suspension and Probation

This notice regards Jeremy U. Blackowicz of Boston, Massachusetts who has practiced before the United States Patent and Trademark Office ("USPTO" or "Office) in trademark matters. The USPTO has suspended Mr. Blackowicz for thirty (30) days from practice before the Office in trademark and non-patent matters. Mr. Blackowicz shall take and pass the Multi-state Professional Responsibility Exam ("MPRE"). Mr. Blackowicz must meet certain requirements relating to reinstatement. Mr. Blackowicz shall serve a (13) month probation commencing on the date of the Final Order.

Mr. Blackowicz violated USPTO disciplinary rules governing conflicts of interests. As a result of these violations Mr. Blackowicz breached his professional duties owed to a client.

Mr. Blackowicz has expressed contrition and understands how his actions violated the USPTO disciplinary rules. In mitigation, Mr. Blackowicz has agreed to perform the following: (1) he shall take three (3) CLE classes concerning conflicts of interest and other ethical responsibilities; and (2) a practice monitor will oversee Mr. Blackowicz's compliance with the ethics rules during the time of his suspension and subsequent probation.

This action is the result of a settlement agreement between Mr. Blackowicz and the OED Director pursuant to the provisions of 35 U.S.C. §§ 2(b)(2)(D) and 32 and 37 C.F.R. §§ 11.19, 11.20, and 11.26. Disciplinary decisions involving practitioners are posted for public reading at the OED Reading Room, available at: <http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>.

- ii. Nothing in the Agreement or the Final Order shall prevent the Office from considering the record of this disciplinary proceeding, including the Final Order: (1) when addressing any further complaint or evidence of the same or similar misconduct concerning Respondent brought to the attention of the Office; and/or (2) in any future disciplinary proceeding against Respondent (i) as an aggravating factor to be taken into consideration in determining any discipline to be imposed, and/or (ii) to rebut any statement or representation by or on Respondent's behalf; and/or (3) in connection with any request for reconsideration submitted by Respondent pursuant to 37 C.F.R. § 11.60;
- jj. The OED Director shall file a motion with the administrative law judge requesting the dismissal of the pending disciplinary proceedings within fourteen (14) days of the date of the Final Order;

kk. Respondent also understands that he is waiving all rights to seek reconsideration of the Final Order under 37 C.F.R. § 11.56, to have the Final Order reviewed under 37 C.F.R. § 11.57, and otherwise to appeal or challenge the Final Order in any manner;

and

ll. Each party shall bear their own costs in complying with the terms of this Proposed Settlement Agreement and the Final Order.



Sarah Harris
General Counsel
United States Patent and Trademark Office

MAY 11 2015

Date

on behalf of

Michelle K. Lee
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

cc:

Director of the Office of Enrollment and Discipline
U.S. Patent and Trademark Office

Tom Mason
Steve Fredley
Harris, Wiltshire & Grannis
1919 M Street, NW
Eighth Floor
Washington, DC 20036

Robert Stoll
Drinker Biddle & Reath
150 K Street, N.W.
Washington, DC 20005