THE FLORIDA BAR
STANDING COMMITTEE ON THE
UNLICENSED PRACTICE OF LAW

FAO #2019-4, OUT-OF-STATE ATTORNEY WORKING REMOTELY FROM FLORIDA HOME

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PROPOSED ADVISORY OPINION

This proposed advisory opinion is only an interpretation of the law and does not constitute final court action.

August 17, 2020

INTRODUCTION

This request for a formal advisory opinion is brought pursuant to Rule 10-9.1 of the Rules Regulating The Florida Bar. The Petitioner, Thomas Restaino (hereinafter, "Petitioner"), is an out-of-state licensed attorney who asked whether it would be the unlicensed practice of law for him, a Florida domiciliary employed by a New Jersey law firm (having no place of business or office in Florida), to work remotely from his Florida home solely on matters that concern federal intellectual property (hereinafter, "IP") rights (and not Florida law) and without having or creating a public presence or profile in Florida as an attorney (TAB A).

Pursuant to Rule 10-9.1(f) of the Rules Regulating The Florida Bar, public notice of the hearing was provided on The Florida Bar's website, in The Florida Bar News, and in the Orlando Sentinel. The Standing Committee held a public hearing on February 7, 2020. Testifying at the hearing were the Petitioner and Florida attorney Barry Rigby. In addition to the testimony presented at the hearing (TAB B), the Standing Committee received written testimony from three attorneys, which has been filed with this Court (Tab C).

FACTS

Petitioner set forth the following facts in his request for advisory opinion (TAB A) and in his testimony at the public hearing (TAB B): He is licensed to practice law in New Jersey, New York, and before the United States Patent and

Trademark Office (hereinafter "USPTO"). He is not licensed to practice law in Florida. He recently retired from his position as chief IP counsel for a major U.S. Corporation.[1] That position was in New Jersey. He moved from New Jersey to Florida. He started working as an attorney with a New Jersey law firm specializing in federal IP law. The firm has no offices in Florida and has no plans to expand its business to Florida. His professional office will be located at the firm's business address in New Jersey, although he will do most of his work from his Florida home using a personal computer securely connected to the firm's computer network. In the conduct of his employment with the firm, he will not represent any Florida persons or entities and will not solicit any Florida clients. While working remotely from his Florida home, he will have no public presence or profile as an attorney in Florida. Neither he nor his firm will represent to anyone that he is a Florida attorney. Neither he nor his firm will advertise or otherwise inform the public of his remote work presence in Florida. The firm's letterhead and website, and his business cards will list no physical address for him other than the firm's business

[1] In that role, Petitioner was responsible for all IP related advice and counsel to the businesses and divisions of the company. And while he is registered to practice before the USPTO, that was only a small part of the work he had done for the company (TAB B; p. 9, lines 10-17). While the Supreme Court, in *The Florida Bar v. Sperry*, 373 U.S. 397 (1963), held that Florida may not prohibit the representation of clients before the USPTO by USPTO-registered practitioners as the unlicensed practice of law, Petitioner's request does not involve his practice before the USPTO, but other aspects of his work.

address in New Jersey and will identify him as "Of Counsel – Licensed only in NY, NJ and the USPTO." The letterhead, website, and business cards will show that he can be contacted by phone or fax only at the firm's New Jersey phone and fax number.[2] His professional email address will be the firm's domain. His work at the firm will be limited to advice and counsel on federal IP rights issues in which no Florida law is implicated, such as questions of patent infringement and patent invalidity.[3] He will not work on any issues that involve Florida courts or Florida property, and he will not give advice on Florida law.

At the hearing, Petitioner testified "we've tried to set up and utilize the technology in a fashion that essentially places me virtually in New Jersey. But for the fact that I'm physically sitting in a chair in a bedroom in Florida, every other aspect of what I do is no different than where I'm physically sitting in a chair in Eatontown, New Jersey and that's the way I tried to and have structured it so that the public sees a presence in, in Eatontown, New Jersey and no other presence." (TAB B, pp. 27-8; lines 25 – 9).

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[2] Phone calls to his law firm and his extension are routed to his cell phone. While clients do not dial his cell phone number directly, Petitioner's cell phone has a New Jersey area code (TAB B; p. 14, lines 5-9 and 13-17).

[3] Throughout Petitioner's 32-year legal career, he has limited his practice to federal IP rights, generally, with an expertise in patent rights (TAB B; p. 9, lines 2-6). Petitioner testified that most of his law firm's work is for his former corporate employer and that as a practical matter he would be working for his former employer as outside counsel (TAB B; p. 13, lines 12-15).

Petitioner further explained "the firm employs a cloud-based system. All the files are located in New Jersey. It's actually pretty amazing. I didn't have any appreciation for this technology before I started with the firm. . . . [T]he way it works is . . . my computer in Florida is just a keyboard and a mouse and a screen. But the computer doesn't actually – you don't generate documents on the computer. Everything is actually on a computer in New Jersey, server in New Jersey. And you are just simply supplying that computer with mouse clicks and taps on your keyboard. And the document you're creating, . . . like if I were writing an amendment to USPTO office action, is actually being created in New Jersey. It's just the tapping happens in Florida, if you will." (TAB B; pp. 28-9, lines 11 – 3).

DISCUSSION

Rule 4-5.5(b)(1) of the Rules Regulating The Florida Bar provides that a lawyer who is not admitted to practice in Florida may not establish an office or other regular presence in Florida for the practice of law.

It is clear from the facts in Petitioner's request and his testimony at the public hearing that Petitioner and his law firm will not be establishing a law office in Florida. It is equally clear that Petitioner will not be establishing a regular presence in Florida for the practice of law; he will merely be living here.

The facts raised in Petitioner's request, quite simply, do not implicate the unlicensed practice of law in Florida. Petitioner is not practicing Florida law or providing legal services for Florida residents. Nor is he or his law firm holding out to the public as having a Florida presence. As Petitioner testified, "we . . . tr[ied] to make sure that no Florida citizens, no Florida businesses, certainly not the Florida courts, would have any exposure to me or . . . the work I was doing." (TAB B, p. 13; lines 19-23).

All indicia point to Petitioner's practice of law as being in New Jersey, not in Florida. It is the opinion of the Standing Committee that based on the facts set forth in his request and hearing testimony, and since there is no attempt by Petitioner or his firm to create a public presence in Florida, Petitioner does not have a presence in Florida for the practice of law.

As this Court noted in *The Florida Bar v. Moses*, 380 So. 2d 412, 417 (Fla. 1980), "the single most important concern in the Court's defining and regulating the practice of law is the protection of the public from incompetent, unethical, or irresponsible representation." Because Petitioner is not providing legal services to Florida clients, no Floridians are being harmed by Petitioner's activity and there are no interests of Floridians that need to be protected by this Court.[4]

[4] Under Rule 8.5(a) of the New Jersey Rules of Professional Conduct (TAB D), a lawyer admitted to practice in New Jersey is subject to the disciplinary authority of New Jersey regardless of where the lawyer's conduct occurs. Consequently,

In May 2019, the Utah Ethics Advisory Opinion Committee (hereinafter, "UEAOC"), in Opinion No. 19-03, opined that an individual licensed in another state who establishes a home in Utah and practices law for clients from the state where the attorney is licensed and who neither solicits Utah clients nor establishes a public office in Utah is not engaged in the unauthorized practice of law (TAB E). In coming to this conclusion, the UEAOC found no case in any jurisdiction where an attorney was disciplined for practicing law out of a private residence for out-of-state clients located in the state where the attorney is licensed. It also pointed out that the concern [under Utah's version of Rule 4-5.5] is that an attorney not establish an office or public presence in a jurisdiction where the attorney is not admitted, and that concern is based upon the need to protect the interests of potential clients in that jurisdiction. In paragraph 16 of its opinion, the UEAOC posed the following question: "[W]hat interest does the Utah State Bar have in regulating an out-of-state lawyer's practice for out-of-state clients simply because he has a private home in Utah? . . . [T]he answer is . . . none."

Like the UEAOC, the Standing Committee's concern is that the Petitioner does not establish an office or public presence in Florida for the practice of law. As discussed above, neither is occurring here. And in answering the same question

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Petitioner's clients would be protected by the Office of Attorney Ethics, the investigative and prosecutorial arm of the Supreme Court of New Jersey.

posed by the UEAOC, it is the opinion of the Standing Committee that there is no interest that warrants regulating Petitioner's practice for his out-of-state clients under the circumstances described in his request simply because he has a private home in Florida.

In light of the current COVID-19 pandemic, the Standing Committee finds the written testimony of Florida-licensed attorney, Salomé J. Zikakis, to be particularly persuasive:

> I believe the future, if not the present, will involve more and more attorneys and other professionals working remotely, whether from second homes or a primary residence. Technology has enabled this to occur, and this flexibility can contribute to an improved work/life balance. It is not a practice to discourage.
>
> There are areas of the law that do not require being physically present, whether in a courtroom or a law office. Using the attorney's physical presence in Florida as the definitive criteria [sic] is inappropriate. So long as the attorney is not practicing Florida law, is not advertising that he practices Florida law, and creates no public presence or profile as a Florida attorney, then there is no UPL simply because the attorney is physically located in Florida. There is no harm to the public. These facts do not and should not constitute UPL in Florida.

(TAB C).

CONCLUSION

It is the opinion of the Standing Committee that the Petitioner who simply establishes a residence in Florida and continues to provide legal work to out-of-state clients from his private Florida residence under the circumstances described in this request does not establish a regular presence in Florida for the practice of

law. Consequently, it is the opinion of the Standing Committee that it would not be the unlicensed practice of law for Petitioner, a Florida domiciliary employed by a New Jersey law firm (having no place of business or office in Florida), to work remotely from his Florida home solely on matters that concern federal intellectual property rights (and not Florida law) and without having or creating a public presence or profile in Florida as an attorney.

/s/ Susanne McCabe by Jeffrey T. Picker
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Re: Request for Advisory Opinion on Unlicensed Practice of Law (UPL)

Dear members of the UPL Department and Committee:

I am an attorney admitted to practice in New Jersey[1]. I am requesting an advisory opinion on whether the UPL Department of the Florida Bar would consider it the unlicensed practice of law for me, a Florida domiciliary employed by a New Jersey law firm (having no place of business or office in Florida), to work remotely from my Florida home solely on matters that concern Federal Intellectual Property ("IP") rights (and not Florida law) and without having or creating a public presence or profile in Florida as an attorney, as described more fully below.[2]

I am recently retired from my position as Chief IP Counsel for a major US corporation. My prior position was located in New Jersey. Contemporaneously with my retirement, I moved from New Jersey to Florida.[3] Recently, I have accepted an offer of employment as an attorney with the law firm of Tong, Rea, Bentley & Kim, a New Jersey limited liability company located in Eatontown, New Jersey ("Tong, Rea"). Tong, Rea specializes in the practice of Federal IP law. Tong, Rea has no offices in Florida, and has no plans to expand its business presence to Florida. My professional office will be located at Tong, Rea's business address in New Jersey, although I will do the majority of my work from my Florida home using a personal computer securely connected to the Tong, Rea computer network.

In considering this request, please be advised of the following:

- No Florida Clients
  In the conduct of my employment with Tong, Rea, I will not represent any Florida persons or entities, and I will not solicit any Florida clients.

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[1] I was admitted to practice in New Jersey in 1987. I am also admitted to practice in New York and the United States Patent and Trademark Office (USPTO). Each of my admissions is in good standing.

[2] I am aware of the US Supreme Court Opinion in The Florida Bar v. Sperry, 373 US 397 (1963), which held that Florida may not deem the representation of clients before the USPTO by USPTO-registered practitioners to be the unlicensed practice of law. Accordingly, this request does not concern my practice before the USPTO, but rather only *other* aspects of my work.

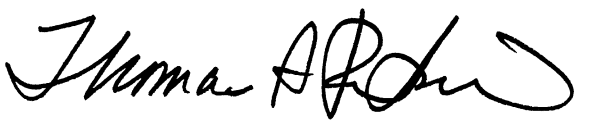
[3] My home address is 4409 Aurora Street, Naples, 34119. Earlier this year I sold my New Jersey home as part of my relocation to Florida.

- No Public Profile in Florida
  While I would be working remotely from my Florida home, I will have no public presence or profile as an attorney in Florida. Neither Tong, Rea nor I will represent to anyone that I am a Florida attorney. Neither Tong, Rea nor I will advertise or otherwise inform the public of my remote work presence in Florida. The Tong, Rea letterhead, my Tong, Rea business cards and the Tong, Rea website will list no physical address for me other than the Tong, Rea business address in New Jersey and will state that I am "Of Counsel – Licensed only in NY, NJ and the USPTO." The letterhead, business cards and website will show that I can be contacted by phone or fax only via New Jersey phone and fax numbers assigned to me by Tong, Rea.[4] My professional email address will be at the Tong, Rea domain.

- No Practice Involving Florida Law, Courts or Property
  My work at Tong, Rea will be limited to advice and counsel on Federal IP rights issues in which no Florida law is implicated, such as questions of patent infringement and patent invalidity. In addition, I will not work on any issues that involve the Florida courts or Florida property.

Please advise on whether my planned practice with Tong, Rea as described above, and so limited, would constitute the unlicensed practice of law in Florida.

Should you require additional information or have any questions, please let me know. Thank you very much for your time and attention to this request.



Thomas A Restaino

4409 Aurora St., Naples FL 34119
Personal email: tomrestaino15@gmail.com
Personal Cell: 908-305-0852

[4] My personal cell phone is also a New Jersey phone number (area code 908), and I have no other telephone number I use for voice calls.

THE FLORIDA BAR

UNLICENSED PRACTICE OF LAW
STANDING COMMITTEE

PUBLIC HEARING

held on

Friday, February 7, 2020

9:13 a.m.

Hyatt Regency Orlando
Room Bayhill 26
9801 International Drive
Orlando, Florida 32819

Reported by:

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I N D E X

MS. McCABE: All right. Good morning. We're ready to get underway.

Welcome to the Florida Bar Standing Committee on the Unlicensed Practice Of Law. Before we get our executive meeting underway, we have a public hearing. And if you'd bear with me for just a minute, I'd like to read several statements.

We do have a court reporter taking down everybody's comments, so it's important that you speak clearly and concisely -- to the best of your ability anyway -- and I'm sure madame court reporter will let us know if you need us to give you any spelling or things of that nature.

I'm going to start with an immunity statement. Just to let everyone know that during the time that this Committee is considering the question raised in this request for an advisory opinion, any information that we learn at the hearing through your testimony won't be deemed an admission or evidence of the unlicensed practice of law. We won't initiate an investigation of the activities of any individual testifying today based solely on that testimony. However, if there are any ongoing investigations, they will continue and if we receive a new unlicensed practice of law complaint on any

person present today, we would open up a file.

If you are involved in an ongoing unlicensed practice of law investigation or we receive an unlicensed practice of law complaint and open a file, your testimony will not be held against you. Your testimony will not be deemed an admission or evidence of the unlicensed practice of law and will not be sent to the Circuit Committee.

The reason for this ruling by the Chair is to encourage full and candid testimony so that the Committee can reach a determination in this area.

As a preliminary statement, this hearing is being held pursuant to Rule 10-9 of the rules regulating the Florida Bar. Pursuant to that rule, notice of this hearing was published in the Orlando Sentinel and the Florida Bar News. And it was also posted on the Florida Bar's website.

The question presented for consideration today is whether it constitutes the unauthorized practice of law for a Florida domiciliary employed by a New Jersey law firm, having no place of business or office in Florida, to work remotely from his Florida home, solely on matters that concern federal intellectual property rights -- not Florida law -- and without having or creating a public presence or

profile in Florida as an attorney.

This hearing came about as a result of our receipt of a written request for a formal advisory opinion from Thomas Restaino. Mr. Restaino, am I pronouncing your name correctly?

MR. RESTAINO: Perfect.

MS. McCABE: Thank you. Our Committee reviewed this request and we voted to hold this hearing. The hearing is the initial action of the Committee and does not guarantee even the issuance of an opinion.

Now, the procedure for the hearing today is Mr. Restaino, as Petitioner, will be the first to testify and we will then take testimony from anyone here who wishes to be heard.

Thereafter, the floor will be open to the Committee members for questions. I'm going to ask you please to identify yourself for the court reporter before you speak. And if you have any written materials with you, they should be given over to Bar counsel, Jeffrey Picker, who is seated to my left.

Your testimony, generally speaking, may be limited to ten minutes or so, but let's see how it goes. If you need a little more time, we will certainly accommodate you in that regard.

I do want to make a statement about a conflict of interest as a preliminary matter. I'm asking the members of the Committee to address the question of conflict of interest. So Rule 10-9.1(e) of the rules regulating the Florida Bar states, "Committee members will not participate in any matter in which they have either a material pecuniary interest that would be affected by an advisory opinion or Committee recommendation or any other conflict of interest that should prevent them from participating. However, no action of the Committee will be invalid where full disclosure has been made and the Committee has not decided that the member's participation was improper.

At this time, I'm going to ask any member of the Committee to indicate if they have anything they want to disclose on the Record or otherwise indicate if they have a conflict.

(No Response)

MS. McCABE: Seeing no Committee members coming forward then, we'd like to proceed with the swearing in of the witness.

Before the first witness testifies, our procedure is to ask each person to be sworn in. It's not mandatory that you be sworn in. If you

don't want to be sworn in, we will still hear your testimony.

Mr. Restaino then, you are welcome to step up and begin your testimony. Would you -- do you object to being sworn in?

MR. RESTAINO: No.

Madame court reporter, will you swear the witness in, please.

(Witness Sworn by the Court Reporter)

MR. RESTAINO: I do.

MS. McCABE: Thank you, sir. You may proceed.

MR. RESTAINO: Thank you.

MS. McCABE: I feel like you ought to use that microphone. I don't know whether your voice is going to carry.

MR. RESTAINO: I'm sure it will. Probably not, not critical.

First of all, I'd like to thank the Committee for considering my request and inviting me here today and holding this proceeding. I didn't know what the process might be, but I prepared just a few remarks, which is sort of supplemental to the letter that I wrote, which was the original request and just to give you a little bit more background about me and the nature of why we made the request; that

sort of thing.

I am a New Jersey attorney. Throughout my 32-year career of practicing law, I've limited my practice to federal intellectual property rights generally and my particular expertise is in patent rights.

In 2018, I retired from my position as chief intellectual property counsel for a major U.S. company and it was a position I had held for the previous 15 years. In that role, I was responsible for all intellectual property related advice of counsel to the businesses and divisions of the company. And while I am registered to practice before the United States Patent and Trademark Office, that makes only a smaller portion of the work that I had done historically for my company as chief IP counsel.

I now employed by the law firm of Tong, Rea, Bentley & Kim, a New Jersey firm, and they specialize in federal intellectual property practice. I will like to perform my day-to-day work for the firm from my home in Florida using essentially modern communication technology. The Tong, Rea firm uses a cloud-based network system that enables me to work, if you will, virtually in

New Jersey, although I am physically located in Florida. My work space at home is a converted bedroom. It has a desk, a computer, mouse, printer, the usual kinds of things. I use my cell phone for voice communication and I use the firm's encrypted network connection for other kinds of communication.

I made the request of the Committee for the formal advisory opinion because both the firm and I wanted to make sure that my establishing a remote work location would not be violative of Florida's unlicensed practice of law rules. Although we had some reason to think that the establishment of that kind of remote office wasn't likely going to present any jeopardy for Florida citizens or Florida courts, nevertheless, based on the research, if you call it that, what we did, we just didn't feel that there was enough clarity around that to simply proceed and wanted to seek advice of this Committee for guidance.

I provided that request back in June of 2019 and I'm here today in furtherance of that and to try to answer any questions that the Committee may have of me. With that, I'm happy to respond or -- to any questions.

MS. McCABE: Yeah. I think that's fine. So we

had originally thought about doing questions after all testimony, but I think it's a better idea to invite the Committee to ask questions of the gentleman contemporaneous with your testimony.

MR. RESTAINO: Sure. Please.

MS. McCABE: Does anybody have any questions for the gentleman regarding this matter? Go ahead, sir.

MR. COLLINS: My name is Dick Collins and the only question I would have primarily is, during the course of your interaction in this capacity, do you ever give any advice based on the Florida law?

MR. RESTAINO: No. No. Actually, I don't recall even in the course of my career -- only, largely because my work is focused on U.S. patent statutes, Title 35; sometimes the U.S. copyright statute and things tend to be folded around that statutory regime. State law, typically, is not involved in any way.

MS. McCABE: Sir, please announce your name on the Record.

MR. REDMON: I'm Gregory Redmon from Jacksonville; a member of the Committee.

Sir, I was wondering, what assurance does this Committee have that the Florida public cannot access

you as a patent attorney and try to contact you in any way or utilize your expertise in that area if they had an interest? How can the Florida public be assured that they're not able to reach you?

MR. RESTAINO: And that, I think, is an important issue. What we had thought was, it would be best if we made -- I think Ms. McCabe mentioned earlier in the question presented -- I don't want to create any precedent or profile in Florida, so I don't wish to -- I don't wish to advertise. I don't wish to hang a sign. I don't wish to represent myself as a Florida attorney. I'm not. It's a lot of don't dos. You know, don't do various things that might give anyone the indication that I'm even there, in effect, because I'm working from a converted bedroom.

So I don't -- I suppose to answer your question directly, I would want to state for the Record that we wouldn't do any of those things. If you were to look at the firm's website, it does show me as someone who is of counsel at the firm, but it lists my address as in the firm's New Jersey address. It says I'm admitted in New York and New Jersey and the United States Patent and Trademark Office and some federal courts. But Florida's no where mentioned,

for obvious reasons. And that's, you know, the way we viewed it. We wanted to sort of make it out to be, my presence only in New Jersey -- appearance of presence, if you will, only in New Jersey and do everything we could or probably more correctly, don't do anything that would lead anyone in Florida to know that I was present, you know, among other Florida citizens.

So the firm's practice is, you know, serves other companies, et cetera. I'm not aware of whether any of those companies are located in Florida. I don't think so. Most of what the firm does is work for my former employer. And I would, as a practical matter, be working for my former employer as outside counsel. And the firm has no office here, in any office; has no plans to expand to Florida. It's a relatively small practice. I think it's ten lawyers or less, myself included.

So that's kind of how we looked at it to try to make sure that no Florida citizens, no Florida businesses, certainly not the Florida courts, would have any exposure to me or, you know, the work I was doing.

MS. McCABE: Thank you. Sure. Go ahead, Ms. Press.

MS. PRESS: Jill Press. You mentioned that the address on the law firm is the New Jersey one. How about the phone number for you? How do they -- what do they list as a --

MR. RESTAINO: Yeah. What they list is I'm extension 116 at the New Jersey firm's main phone number. So you dial that number. If you knew I was 116, you could press that. And what happens is it gets routed to my cell phone.

MS. PRESS: Okay.

MR. RESTAINO: So I can answer the phone. I can get messages, receive messages; that sort of thing. But no one dials my cell phone number. My cell phone number is a New Jersey -- it's an area code 908. That's part of New Jersey. But that doesn't appear on the website, either. It's just the firm's phone number and my extension.

MS. PRESS: Thank you.

MS. McCABE: Sure.

MS. LISKER: Gwendolyn Lisker, Fort Lauderdale. How long have you been working out of your home in Florida?

MR. RESTAINO: Just since this past Summer.

MS. LISKER: Okay. And how long have you been coming to Florida?

MR. RESTAINO: Well, good question. My wife and I just moved to Florida after my retirement. I retired at the very end of 2018 and we moved to Florida in January. We owned a home here. We sold our home in New Jersey shortly after I retired. And so, Florida became our only home in Naples.

MS. LISKER: So there's no plans to practice Florida law since this is going to be your permanent home base?

MR. RESTAINO: No practice -- no plans to practice Florida law, no. No, I spent a long career, you know, developing an expertise in this one particular area and that's all I wish to, that's all I wish to practice.

MS. McCABE: Thank you. Yes?

MR. ALBA: Gilbert Alba. While you're practicing federal law located in Florida, what agencies or Bar associations regulate your activity?

MR. RESTAINO: Well, I am active at the New Jersey Bar, so I would be subject to all the rules and requirements of practice by the New Jersey Bar. I provide the New Jersey Bar with the address of the Tong, Rea Law Firm in Eatontown, New Jersey as my address.

MR. ALBA: Do you know if it's their position

that you're subject to their regulation while you're physically practicing federal law in the State of Florida?

MR. RESTAINO: I don't know with certainty. I believe that they do because they have in various places in their rules, they ask about in any way that appears permissive, whether if you're practicing New Jersey law within New Jersey or practicing New Jersey law outside of New Jersey. And then they have different rules for -- for example, I think if you're practicing law outside of New Jersey and you do not have a New Jersey office, you have to register with the Secretary of State for service of process in matters relating to your practice.

So I -- the implication I think would be that, yes, you are -- they permit such practice and I would be subject to their disciplinary rules, their other rules relating to ethics, et cetera.

MR. ALBA: Would that be something you would be certified, for example, you would be subject to those ethical rules.

MR. RESTAINO: Sure. No problem at all.

MS. McCABE: Anyone else have any questions?

MR. COLLINS: I've got one follow up.

MS. McCABE: Sure. Go ahead.

MR. COLLINS: Dick Collins here. What do you to stay current on your continuing legal education and how do you achieve that since you're primarily focused on New Jersey or federal law? How do you do that?

MR. RESTAINO: Right. Well, that's, you know, as an attorney, when I was employed by my former employer, it's relatively easy to do, we had annual meetings every year and a lot of that generated continuing legal education credits both in substantive areas, as well as in legal ethics.

Now it's on me. I've got to do 24 credits of continuing legal education to satisfy my New Jersey requirements every two years. And so, I'm going to have to now attend to complete my credits before the end of this calendar year. So I will be attending -- I have to make arrangements to attend CLE programs on my own. My firm will likely reimburse me for that, but I haven't -- we haven't talked about that just yet. But the answer is, yes, I have to do that. It's something I've done my entire career and I'll continue, have to continue do that.

MS. McCABE: Yes, Mr. Redmon?

MR. REDMON: Yes. Gregory Redmon, follow-up question for you.

MR. RESTAINO: Sure.

MR. REDMON: Is it possible for clients of your firm that know you are associated with the firm in New Jersey, to contact you in Florida and for you to speak to them about their subject matter while you're in Florida?

MR. RESTAINO: Um, well, my former employer knows where I am. That's just an outgrowth of the fact that I receive a pension and have health benefits; that sort of thing. And the person who is my successor in the chief IP counsel role, knows how to contact me. I'm sure he has my cell phone. So that's possible. I don't know that anyone else would have it. So it's just through the personal relationships of people I've worked with at my former employer over the years, who may know that.

MR. REDMON: Are you saying not necessary clients who are clients of the New Jersey firm, contacting you about their case work.

MR. RESTAINO: I don't think so. I can't imagine, I don't know how they would know that.

MR. REDMON: All right. Thank you.

MR. RESTAINO: Yeah.

MS. McCABE: Any other questions? Follow-up? I did have one question, sir, if you don't mind.

MR. RESTAINO: Yes.

MS. McCABE: You talked about practicing in the State of New Jersey.

MR. RESTAINO: Mm-hmm.

MS. McCABE: And it was primarily in federal court?

MR. RESTAINO: Um, generally not in court at all. I was -- my role for the company was, essentially, advising counsel on matters. Sometimes -- most matters may mature to litigation. But generally speaking, they don't. But when they do, that's handled by, at least in my company, it was handled by a separate litigation group that specializes in that practice. Intellectual -- you may know, for example, patent law, obviously, leads to plenty of litigation. However, that's all -- that's the exclusive jurisdiction of the federal courts. And so federal district court is where you bring those cases, the only place you can bring those cases. And appeals to the Court of Appeals to the federal circuit in Washington, D.C. and sometimes to the Supreme Court.

But I, myself, do not practice before any

courts and while I've been involved in litigations as kind of a support person, I was never making an appearance before a court. I was just part of a team, if you will.

MS. McCABE: Okay. Thank you. Sure.

MR. SIMON: Steve Simon. Does New Jersey have any rules or regulations with regard to their arrangement? Do they consider you to be practicing outside their state, or are they considering you to be practicing within their state?

MR. RESTAINO: I've told them that I'm practicing outside; that I won't be practicing within the state in the sense of physical presence. I've told them that I have an office at 12 Christopher Way, Eatontown, New Jersey, which is where the firm is located, but I've also told them that I'm not physically there, so they know that.

But at this juncture, there hasn't been any discussion with New Jersey about where I'm located specifically and they haven't asked about that or sought any other information. I've just done the usual registration process, every year registration process with New Jersey. In fact, I just completed it and gave them the information that I was an out-of-state person.

MR. ALBA: Just a follow-up of my colleague's question. You said no Florida clients?

MR. RESTAINO: No Florida.

MR. ALBA: No interaction with Florida clients?

MR. RESTAINO: No.

MR. ALBA: So are -- just based on my knowledge of patent law, there's interactions, you're doing the patent prosecution process, the claim rejection process; those kind of things?

MR. RESTAINO: That is part of what I can do. In fact, that's what I've done mostly since this past summer. I've been working on patent prosecution matters for the United States Patent and Trademark Office. And having -- what I've done is I've told my employer, I've actually told the person who succeeded me, that I have made a request of this Committee to provide guidance in my situation so that I didn't want to handle other kinds of matters.

It was my understanding that patent prosecution work, practice before the United States Patent and Trademark Office by a registered practitioner is permitted in Florida. So that's where I've concentrated at this point.

The only other thing I've done is respond to questions from my former employer about what I did

while I was the chief IP counsel in particular matters because they had similar matters that were coming up and they wanted to know, how did I analyze that kind of situation; does this sound like a similar situation. So they kind of wanted historical perspective from me and I thought it was appropriate since I conducted the work and it was done for my former employer while I was in the position of chief IP counsel.

MR. ALBA: Do you interact with clients during the patent prosecution process from time to time?

MR. RESTAINO: It's possible, but it hasn't happened yet.

MR. ALBA: So are you -- if my client lives in the State of Florida, you would then be practicing federal law in the State of Florida communicating with the Florida client?

MR. RESTAINO: Interesting. There haven't been any. And certainly, if it were an issue, if it made a difference, I could certainly not take on any work that involved any of the -- you're referring to who are the inventors, for example --

MR. ALBA: Right.

MR. RESTAINO: -- in a particular patent application. Right.

I could certainly handle only patent application work that didn't involve a Florida inventor. I confess I'm not sure what the meets and bounds of the Supreme Court precedent is on that in terms of whether that's necessary or not, but I'll tell you as a practical matter, that's probably a very unlikely event and wouldn't really limit my ability to do any practice as a real limitation. There's thousands of patent applications that I can work on that perhaps don't have any Florida inventors.

MR. ALBA: Those could be people from all different states.

MR. RESTAINO: They could be from New Jersey, Texas, California, yeah. Because a lot of these people work together -- no surprise, in 2020, a lot of these people work together virtually. So you can have a single team of inventors who are scattered across the country. That does happen.

MR. ALBA: Thank you.

MR. RESTAINO: It used to happen around the lunch table, but now it happens off the virtual lunch table.

MS. McCABE: Any other questions from the Committee members?

MR. COLLINS: One more. Dick Collins here. Do you ever give advice on Florida law as it may impact their applications or anything?

MR. RESTAINO: That, no. That would -- that -- I've never done that and I'm not aware of a --

MR. COLLINS: I don't know if there's any Florida law that impacts it, does it?

MR. RESTAINO: Yeah. It's just a separate -- it's all federal. And so, I'm not aware of a -- of how that might happen. Florida law or the law of other states wouldn't really impact the process, either.

MS. McCABE: Mr. Alba, I missed your comment.

MR. ALBA: Just a question. You're speaking of Florida inventors. Regarding your patent prosecution, even though you're exclusively doing federal law, that's subject to the Florida attorney/client privilege law, would you agree with that?

MR. RESTAINO: Yes. Yes.

MS. McCABE: Okay.

MS. PRESS: Jill Press. You're not dealing with inventors just from just New Jersey, are you?

MR. RESTAINO: No.

MS. PRESS: So have you posed this particular

situation to any other Bar in any other state?

MR. RESTAINO: No. The nature of that practice before the U.S. Patent Office, is essentially a national practice. I'm not aware of any patent attorney that limits the discussion with inventors from different states. It's not a question that I've considered, but it's a very common circumstance to be sure.

So your question is factually pertinent because there are commonly in patent applications, filed with the U.S. Patent Office all the time, inventors from various states and, frankly, countries around the world. But it happens all the time.

MS. McCABE: Mr. Redmon?

MR. REDMON: Another follow-up question, Gregory Redmon.

If I understand the situation before this Committee is that you've always been in New Jersey as a New Jersey lawyer practicing patent law up until this present time.

MR. RESTAINO: Correct.

MR. REDMON: Have you lived in other states where you're a New Jersey lawyer, practicing patent law in other states before now or is this the first time you've been outside of New Jersey as a New

Jersey lawyer practicing?

MR. RESTAINO: Well, I had practiced in the State of New York early in my career.

MR. REDMON: But you're also a member of the Bar there.

MR. RESTAINO: I am a member of the New York Bar. For the succeeding -- after my practice, after I moved from private practice to my immediate former employer, I was there for 27 years, always in New Jersey. So that practice was always there. And I've practiced as a licensed New Jersey attorney. Never in any other state in all that time. This is the first time that I've been in a state where I did not hold a state Bar license for practice.

MS. McCABE: Thank you.

Mr. Rubright?

MR. RUBRIGHT: Brian Rubright. So if I understand correctly, your domiciliary is in Florida.

MR. RESTAINO: Yes.

MR. RUBRIGHT: You work out of New Jersey or your employer is in New Jersey.

MR. RESTAINO: Correct.

MR. RUBRIGHT: Where do you pay taxes? What's your tax location? Do you pay New Jersey state tax?

Do you not pay, since you live in Florida and work in New Jersey? How does that work out?

MR. RESTAINO: I -- this is the first year, so I don't know what the answer to that. It's one of the issues I have to have a discussion with. My sense is that I would be paying New Jersey state income tax since the source of my paychecks, if you will, come from a New Jersey business. That's a question I have for my tax preparer. It's my assumption that that would be the case, but I confess that's something that I haven't -- it's a bridge I haven't even yet addressed.

MS. McCABE: Just as a follow-up, I wanted some clarification. Is it your testimony, sir, that technology is really what permits you to be in Florida and live in Florida, but that what you do is -- where you are is really irrelevant and that your presence in one state or the other really is indistinguishable? That your work is the work that is provided by your New Jersey employment and that Florida doesn't weigh in in any way except you happen to be standing in the state?

MR. RESTAINO: Um, if I followed your question, I think the answer to that is yes. The technology part of this is, I think, critical, because we've

tried to set up and utilize the technology in a fashion that essentially places me virtually in New Jersey. But for the fact that I'm physically sitting in a chair in a bedroom in Florida, every other aspect of what I do is no different than where I'm physically sitting in a chair in Eatontown, New Jersey and that's the way I have tried to and have structured it so that the public sees a presence in, in Eatontown, New Jersey and no other presence.

So you know, with the internet and cloud-based systems -- the firm employs a cloud-based system. All the files are located in New Jersey. It's actually pretty amazing. I didn't have any appreciation for this technology before I started with the firm.

But apparently, the way it works is, your computer -- my computer in Florida is just a keyboard and a mouse and a screen. But the computer doesn't actually -- you don't generate documents on the computer. Everything is actually on a computer in New Jersey, server in New Jersey. And you are just simply supplying that computer with mouse clicks and taps on your keyboard. And the document you're creating, if you're creating a document -- like if I were writing an amendment to USPTO office

action, is actually being created in New Jersey. It's just the tapping happens in Florida, if you will.

So it's gotten to the point where you can have a virtual presence. And it's -- there's no need to appear, to be in Florida, or any other state, for that matter, in order to accomplish what you need to accomplish in practicing law.

So I hope that's responsive to your question. I think the answer is yes, if you can do that.

I think it is important, though, that as counsel, if you're operating under -- you need to be under -- to be operating under a license which is valid and up to date, et cetera. And you need to be under -- be, if you will, exposed to the regulatory regime of that license. The ethic regime of that license. That, I think, is important. But the virtual presence is entirely possible created by 2020 technology.

MS. McCABE: Very good. Any other questions from the Committee members?

MR. COLLINS: I've got one more.

MS. McCABE: Sure. Go ahead.

MR. COLLINS: Dick Collins here. Do you have any legal support staff that is based in Florida

that assists you in any way? Paralegal, legal assistants, whatever? How do you do that?

MR. RESTAINO: All in New Jersey. It's only at the office in New Jersey. There's paralegals and, and other paraprofessionals who are specialists in interacting with, for example, the patent office. Formal filing requirements, document handling, all that --

MR. COLLINS: All your files are maintained up in that server in New Jersey?

MR. RESTAINO: Exactly. Everything is there. You can literally -- it's amazing. You can literally open up a page and see all of the files on a particular matter, you know, in date order, whenever they were created, and retrieve them or store them. And all the support staff. There's no support staff that I have. It's just me. That's it. No one else in Florida. And everything is there. And the firm's filing and all that stuff is.

MR. COLLINS: How is your compensation handled? Is it based on a percentage of your actual production and net earnings or how does that work?

MR. RESTAINO: It's a salary plus a bonus structure.

MS. McCABE: Anyone else?

MR. RESTAINO: Volume of work, that sort of thing.

MR. PELTON: I have a question. Paul Pelton.

MR. RESTAINO: Sure.

MR. PELTON: Do you see anybody in your house in Naples that might come down here that needs to meet with you, concerning anything involved with your law practice at all?

MR. RESTAINO: No. It hasn't happened and I wouldn't think it would. If there were client meetings, I would go to the client in Atlanta or Dallas or New Jersey or whoever the client happened to be, for whatever the practice issue was.

MR. PELTON: Thank you.

MS. McCABE: All right. Any other follow-up questions from the committee members, anything else, any comments? Thank you so much, Mr. Restaino. We appreciate your testimony.

We're going to next ask if there are any other individuals who would like to give testimony.

MR. RIGBY: I would like to raise something with the committee.

MS. McCABE: Seeing a gentleman in the back, sir. Did you sign in?

MR. RIGBY: I just signed on that sheet back

there. I added it in here.

MS. McCABE: That works. No worries at all, sir.

MR. RIGBY: You've got my name.

MS. McCABE: Yeah. If you would approach the microphone, please. And if you would, sir, state your name for the Record.

MR. RIGBY: My name is Barry Rigby. I apologize. I'm a little slow because I'm from Missouri, but I'm real happy about the Super Bowl right now, I've just got to say.

I don't practice any type of intellectual property, but in hearing the comments today, what occurred to me is those of us who are not such practitioners, kind of put things under the intellectual property umbrella, that include copyright trademark and I do know enough to know that some of the trademarking gets done at the state level through the Florida Department of State. They have online information, online forms.

It just occurred to me that anybody who read an opinion from this Committee, who did not have the benefit of hearing what was described today in detail, might wonder how this might apply in the trademark context, which is not as cleanly federal

as the patent aspect is.

So I just point that out. There may be several people who have already thought of that, but that certainly occurred to me because I looked into doing a little bit of trademark for myself and used a little bit more than I wanted chew on at the time, so I know there is a state court aspect of it worthy of thinking about.

MS. McCABE: Thank you.

MR. RESTAINO: I can provide some information. He's quite correct.

MS. McCABE: Sure.

MR. RESTAINO: And when I was chief IP counsel, I had a couple of trademark attorneys who were specialists in this and think handled that work for my former employer. But it's quite correct.

Trademark rights are established at common law. So state use of trademarks is material. Registration happens at the federal level and there are certain overarching federal aspects to registration, et cetera. But first and foremost, it happens through use and that's what happens at the state level.

I don't practice trademark law in any way. It's its own specialty. It's not a specialty that

I've developed. And if you know anything about it, it's a little bit -- it's a lot of alchemy and you have to be -- you have to know how to weigh, in a qualitative way, a whole bunch of factors that never made sense to me. So bottom line is, that's not my practice and that's why my expertise is in patent work.

And I probably should add it goes beyond just you know, patent prosecution work for the USPTO. It involves things like providing advice when my former employer is accused of patent infringement, for example, which isn't much to do with the USPTO. It has to do with analyzing the allegation, figuring out whether or not the allegation is correct, and then providing advice and counsel about what to do with it. And so that's not a USPTO matter, but it is a very much a patent centric matter, because you're dealing with patent rights.

MS. McCABE: And just as a point of clarity, your application for an opinion is limited solely on matters that concern federal intellectual property rights.

MR. RESTAINO: Correct.

MS. McCABE: So if you were to start doing trademark work, first of all, that work would not be

work that would, you know, depending on the outcome of the Committee's weighing this matter --

MR. RESTAINO: Right.

MS. McCABE: -- that's not federal -- that's not solely federal intellectual property rights.

MR. RESTAINO: That's correct. It's not solely federal intellectual property rights.

MS. McCABE: And it's your testimony that what you intend to do or what your practice will consist of is solely federal intellectual property rights.

MR. RESTAINO: Correct.

MS. McCABE: Yes, sir?

MR. ALBA: Just a follow-up on that and one other question. The federal trademark, there is a component of federal practice with regard to trademarks, correct?

MR. RESTAINO: Oh, yes. That's the T in USPTO.

MR. ALBA: Okay. So by using the term federal intellectual property, that would, by definition, include that, both the federal component of the trademark side but not the state law component?

MR. RESTAINO: It could. I'm, frankly, going to avoid trademarks entirely, I'll tell you that. It's not something that I've developed any expertise. I think one time early in my career, a

long time ago, I filed one trademark application at the USPTO, but that's been it.

MR. ALBA: Is copyright also federal and state law, sort of mix?

MR. RESTAINO: Not to my knowledge. Copyright is a federal law matter.

MR. ALBA: Okay. Then the other question I had is, from your understanding, would there be any distinction between you and a patent agent who is similarly only providing patent advice under federal law, but who comes from New Jersey and sets up an extension office here?

MR. RESTAINO: There would be.

MR. ALBA: What is that?

MR. RESTAINO: Excellent question. So patent attorneys and patent agents are both admitted to practice before the United States Patent and Trademark Office. They have to have certain qualifications; they sit for the exam; pass the exam.

If you are an attorney, you are termed a patent attorney. If you are not an attorney, if you're not admitted to practice before a state Bar, you are referred to as a patent agent. Both have the same practice before the United States Patent and

Trademark Office. They are both qualified for the very same things.

However, take, for example, the matter I've mentioned a moment ago. Doing an opinion on whether a particular -- let's say my former employer gets accused of patent infringement and wants to know is this a good accusation, a bad accusation, what do I do about this? A patent agent is not, by law, able to offer a view on that because that is a matter of legal opinion and it's outside the scope of practice before the United States Patent and Trademark Office.

It's possible that one of the courses of action that might arise when an opinion such as this is done by an attorney, it is to recommend going back to the United States Patent and Trademark Office and challenging the issuance of that patent or vehicles for doing that. However, short of that, it's an opinion matter that would only be handled by a licensed attorney.

MR. ALBA: Thank you.

MS. McCABE: Very good. Thank you. Anybody else?

Thank you, Mr. Rigby. Appreciate your contribution.

MR. RIGBY: Thanks for letting me speak.

MS. McCABE: Any other questions, comments from the Committee members or from anybody else who like to give testimony today?

(No Response)

MS. McCABE: Seeing as we don't have anybody wishing to come forward, I think what we'll do is keep the public hearing open until 10:30 in case we have anybody that wants to come forward. And then what I'd like to do is maybe take a five-minute break before we start our executive session, is that -- all right.

My mistake then. It's almost 10 o'clock. I think what we're going to do, we're going to keep the public hearing open until 10:30. We'll take a half-hour break and if you Committee members would not get too far away so we can get started promptly at 10:30 on our regular executive --

I'm going to revise my statement again. I promise it will be the last revision. So take a ten-minute break? All right.

We're going to take a ten-minute break and you all can come back and we'll still have some time for public testimony if anybody's interested. All right? Thank you.

(Proceedings recessed at 10:01 a.m.)

(Proceedings resumed at 10:30 a.m.)

MS. McCABE: All right. It's 10:30. So we wanted to make an inquiry. Is there anybody else who wishes to make a public statement this morning? You're welcome to come forward and let me know.

Thank you, Mr. Restaino. Did you have any follow-up comments to make?

MR. RESTAINO: No. I'm good. Thank you.

MS. McCABE: Okay. Well, seeing that there's no further individuals coming forward to make comments then, our public hearing session is concluded at this time.

Thank you so much, Mr. Restaino --

MR. RESTAINO: Thank you very much.

MS. McCABE: -- we appreciate you appearing and thank you again.

MR. RESTAINO: Sure. Happy to. If there's anybody, anybody needs any -- I don't know how the process works, but if you have any need for any other information, please let me know.

MS. McCABE: All right. All right. Thank you so much.

Now, that is going to conclude our public hearing, so we are asking anybody who is not on the

Committee for the unlicensed practice of law, respectfully to leave the room because we're going to go into executive session, which is, obviously, closed to the public.

(Public Proceedings Concluded at 10:35 a.m.)

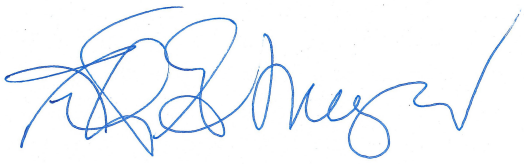
CERTIFICATE OF OATH

STATE OF FLORIDA

COUNTY OF ORANGE:

I, RITA G. MEYER, RDR, CRR, CRC, the undersigned authority, certify that the witnesses personally appeared before me and were duly sworn.

WITNESS my hand and official seal this 17th day of February, 2020.



RITA G. MEYER, RDR, CRR, CRC

My Commission #: GG293751
Expires May 12, 2023

CERTIFICATE OF REPORTER

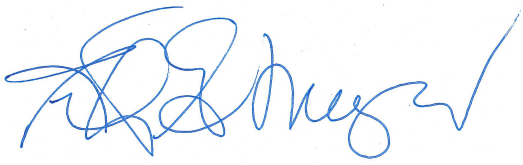
STATE OF FLORIDA:

COUNTY OF ORANGE:

I, RITA G. MEYER, RDR, CRR, CRC, do hereby certify that I was authorized to and did stenographically report the foregoing proceedings and that the foregoing transcript is a true and correct record of my stenographic notes.

I FURTHER CERTIFY that I am not a relative, employee, attorney or counsel of any of the parties, nor am I a relative or employee of any of the parties, attorneys or counsel connected with the action, nor am I financially interested in the outcome of the action.

DATED this 17th day of February, 2020.



RITA G. MEYER, RDR, CRR, CRC

Picker, Jeffrey T

From: Michael O'Neill <moneill@mainstream-engr.com>
Sent: Thursday, January 09, 2020 8:22 AM
To: Picker, Jeffrey T
Cc: Vickaryous, James G
Subject: Written testimony for UPL Standing Committee to consider re non-FL lawyer and practice IP law

I submit my written testimony for the Committee's consideration during the hearing on Feb. 7, 2020 concerning the practice of federal IP law by a non-FL lawyer in the state of Florida. This testimony is my personal opinion and is not the opinion of my company Mainstream Engineering Corporation. I am using my corporate email address because that is my official email address for the Florida State Bar to contact me. I am copying my Board of Governors representative to inform him that I have made my opinion known. Thank you.

This is my personal opinion concerning the request of the non-Florida lawyer that wishes to practice federal intellectual property law, outside of patent prosecution, in the state of Florida without being licensed in Florida. My opinion is that if you want to practice any law in the state of Florida (except patent prosecution), then become a member of the Florida State Bar. If the UPL Standing Committee were to grant this request, I see a slippery-slope occurring. What is preventing any out of state law firm having a physical location here in Florida and stating that they will not represent any Floridian and limit their practice to federal law? Florida would likely become a "snowbird" get away for outstate attorneys wishing to continue their practice in another state and avoid the cold, and then go back to their northern home state when the summer begins. I don't think this is what is good for the practice of law in Florida and for Florida's economy in general.

Turning to the Request for Advisory Opinion, I think there are two fundamental errors in the analysis. The Request states that the NJ law firm will not have a place of business or office in Florida. That is not correct. Once this lawyer starts to practice law, even if it is out of his home, it becomes a place of business. Does this lawyer plan on not taking the IRS tax deduction for having a "home office"? Secondly, the NJ firm's own website says that it serves "clients nationwide and abroad." Therefore, this firm would take a Floridian if that Floridian entity wished to engage it for a federal IP matter. Thus, the firm itself could expand its business to Florida contrary to the statement made in the request.

Returning to my personal opinion, I, myself, am a newly admitted member of the Florida State Bar. I re-located down to Florida for personal reasons. I have been a member of the Virginia State Bar since 1999. I applied to sit for the Florida Bar exam at my first opportunity and went through the application process. I took the exam and passed. I did not practice law until I was sworn in. Therefore, it is possible to take the Florida Bar exam and pass it after having not taken a bar exam for 19 years. You just have to study hard.

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Picker, Jeffrey T

From: Jim Vickaryous <jim@vickaryous.com>
Sent: Thursday, January 09, 2020 8:39 AM
To: Michael O'Neill; Picker, Jeffrey T
Cc: Stewart, John M; Doyle, Joshua
Subject: Re: Written testimony for UPL Standing Committee to consider re non-FL lawyer and practice IP law

I appreciate your input Mike and agree with you.

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From: Michael O'Neill <moneill@mainstream-engr.com>
Sent: Thursday, January 9, 2020 8:22:16 AM
To: jpicker@floridabar.org <jpicker@floridabar.org>
Cc: Jim Vickaryous <jim@vickaryous.com>
Subject: Written testimony for UPL Standing Committee to consider re non-FL lawyer and practice IP law

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ISO 9001:2015 CERTIFIED

Picker, Jeffrey T

From: Michael O'Neill <moneill@mainstream-engr.com>
Sent: Thursday, January 09, 2020 8:44 AM
To: Vickaryous, James G; Picker, Jeffrey T
Cc: Stewart, John M; Doyle, Joshua
Subject: RE: Written testimony for UPL Standing Committee to consider re non-FL lawyer and practice IP law

I am also a patent attorney just like the gentleman seeking an exception to the rule. I did some digging on this gentleman and the NJ law firm. I see that this NJ law firm basically handles patent work from AT&T in NJ and hires retiring AT&T patent attorneys as "Of-counsel" to keep that work coming into the firm. This is a typical "double-dipping" that goes on in my patent industry.

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From: Jim Vickaryous [mailto:jim@vickaryous.com]
Sent: Thursday, January 09, 2020 8:39 AM
To: Michael O'Neill; jpicker@floridabar.org
Cc: John Stewart; Doyle, Joshua
Subject: Re: Written testimony for UPL Standing Committee to consider re non-FL lawyer and practice IP law

I appreciate your input Mike and agree with you.

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From: Michael O'Neill <moneill@mainstream-engr.com>
Sent: Thursday, January 9, 2020 8:22:16 AM
To: jpicker@floridabar.org <jpicker@floridabar.org>
Cc: Jim Vickaryous <jim@vickaryous.com>
Subject: Written testimony for UPL Standing Committee to consider re non-FL lawyer and practice IP law

I submit my written testimony for the Committee's consideration during the hearing on Feb. 7, 2020 concerning the practice of federal IP law by a non-FL lawyer in the state of Florida. This testimony is my personal opinion and is not the opinion of my company Mainstream Engineering Corporation. I am using my corporate email address because that is my official email address for the Florida State Bar to contact me. I am copying my Board of Governors representative to inform him that I have made my opinion known. Thank you.

This is my personal opinion concerning the request of the non-Florida lawyer that wishes to practice federal intellectual property law, outside of patent prosecution, in the state of Florida without being licensed in Florida. My opinion is that if you want to practice any law in the state of Florida (except patent prosecution), then become a member of the Florida State Bar. If the UPL Standing Committee were to grant this request, I see a slippery-slope occurring. What is preventing any out of state law firm having a physical location here in Florida and stating that they will not represent any Floridian and limit their practice to federal law? Florida would likely become a "snowbird" get away for outstate attorneys wishing to continue their practice in another state and

avoid the cold, and then go back to their northern home state when the summer begins. I don't think this is what is good for the practice of law in Florida and for Florida's economy in general.

Turning to the Request for Advisory Opinion, I think there are two fundamental errors in the analysis. The Request states that the NJ law firm will not have a place of business or office in Florida. That is not correct. Once this lawyer starts to practice law, even if it is out of his home, it becomes a place of business. Does this lawyer plan on not taking the IRS tax deduction for having a "home office"? Secondly, the NJ firm's own website says that it serves "clients nationwide and abroad." Therefore, this firm would take a Floridian if that Floridian entity wished to engage it for a federal IP matter. Thus, the firm itself could expand its business to Florida contrary to the statement made in the request.

Returning to my personal opinion, I, myself, am a newly admitted member of the Florida State Bar. I re-located down to Florida for personal reasons. I have been a member of the Virginia State Bar since 1999. I applied to sit for the Florida Bar exam at my first opportunity and went through the application process. I took the exam and passed. I did not practice law until I was sworn in. Therefore, it is possible to take the Florida Bar exam and pass it after having not taken a bar exam for 19 years. You just have to study hard.

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Please note: Florida has very broad public records laws. Many written communications to or from The Florida Bar regarding Bar business may be considered public records, which must be made available to anyone upon request. Your e-mail communications may therefore be subject to public disclosure.

Picker, Jeffrey T

From: John Stewart <Jstewart@rosswayswan.com>
Sent: Tuesday, January 14, 2020 8:00 AM
To: Vickaryous, James G; Michael O'Neill; Picker, Jeffrey T
Cc: Doyle, Joshua
Subject: RE: Written testimony for UPL Standing Committee to consider re non-FL lawyer and practice IP law

Mr. O'Neill:

As President of The Florida Bar I just want to thank you for taking the time to participate in the process. No matter the ultimate outcome it is Florida lawyers like you who take the time to offer valuable insight that make The Florida Bar the gold standard in the country. You have a great Board of Governors representative in Jim Vickaryous. I have an office in Melbourne. Maybe we will have a chance to cross paths one day. Thanks again.

JMS
John M. Stewart, Esq.

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From: Jim Vickaryous [mailto:jim@vickaryous.com]
Sent: Thursday, January 09, 2020 8:39 AM
To: Michael O'Neill <moneill@mainstream-engr.com>; jpicker@floridabar.org
Cc: John Stewart <Jstewart@rosswayswan.com>; Doyle, Joshua <jdoyle@floridabar.org>
Subject: Re: Written testimony for UPL Standing Committee to consider re non-FL lawyer and practice IP law

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Picker, Jeffrey T

From: Salome Zikakis <szikakis@parziklaw.com>
Sent: Monday, January 20, 2020 5:18 PM
To: Picker, Jeffrey T
Subject: Written testimony for 2/7/2020 UPL hearing

I wish to submit written testimony in connection with the public hearing by the UPL Standing Committee. I believe the future, if not the present, will involve more and more attorneys and other professionals working remotely, whether from second homes or a primary residence. Technology has enabled this to occur, and this flexibility can contribute to an improved work/life balance. It is not a practice to discourage.

There are areas of the law that do not require being physically present, whether in a courtroom or a law office. Using the attorney's physical presence in Florida as the definitive criteria is inappropriate. So long as the attorney is not practicing Florida law, is not advertising that he practices Florida law, and creates no public presence or profile as a Florida attorney, then there is no UPL simply because the attorney is physically located in Florida. There is no harm to the public. These facts do not and should not constitute UPL in Florida.

Regards,

Salomé J. Zikakis, Esq.

Florida Bar Board Certified Real Estate Attorney

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FILE NO:

Via Email

February 4, 2020

Susanne D. McCabe, P.A.
Chair, Unlicensed Practice of Law Committee
900 N. Swallow Tail Dr., Suite 101
Port Orange, FL 32129-6103
sdm@mccabelawyers.com

Dear Ms. McCabe:

This letter is submitted for consideration by your Committee at the public hearing this Friday at which you will consider issues related to an out-of-state licensed lawyer who wishes to live in Florida and continue to serve his out-of-state clients.

I currently represent a multi-state law firm in an UPL matter before the 17th Circuit UPL committee. The issues in that matter bear some relationship to the subject matter of the upcoming hearing. I would like to insure that the committee is aware of two decisions which relate to the continued constitutionality of Florida Bar rule 4-5.5. (and ABA Model Rule 5.5) First and most importantly, is the Ohio Supreme Court decision, *In re Application of Jones* on October 17, 2018, 123 N.E.3d 877 (Ohio 2018). There a lawyer admitted in Kentucky moved to a Cincinnati law firm and continued to practice Kentucky law exclusively. Her application to join the Ohio Bar was denied by the appropriate Ohio Board because it found that she had violated the Ohio version of 5.5 by living in Ohio and practicing in Kentucky. The Court reversed the Board on a finding that her practice was temporary in nature relying on 5.5 (c) (2). The important portion of the decision are the observations of the concurring Justices. Of course, this is dicta but I suggest it is quite compelling. Justice DeWine, writing for the concurrence, first noted that the Board properly read the rule but that "….. as applied here, the rule is irrational and arbitrary and cannot be constitutionally enforced." 123 N.E.3d 877, 882. Thereafter he found that the application of the rule to lawyers not practicing in Ohio does not serve the state's interest in protecting the Ohio public. Then after referencing the internet and electronic communication, he summarizes the concurrence as follows:

> "I would conclude that as applied to an out-of-state attorney who is not practicing in Ohio courts or providing Ohio legal services, Prof.Cond.R. 5-5(b)(1) violates Article I, Section I of the Ohio Constitution [essentially identical to the same provision of the Florida Constitution] and the Due Process clause of the Fourteenth Amendment to the United States Constitution (footnote omitted). As applied to such an attorney, the rule violates Article I, Section I both because it does not "bear a real and substantial relation to the public health, safety, morals or general welfare and because it is "arbitrary" and "unreasonable." (citation omitted). Similarly, applying the rule to such an attorney violates the Fourteenth Amendment because it does not bear a rational relationship to any discernable state interest. (citations omitted)

I contend that this well-reasoned concurrence by a respected sister court could strongly influence the outcome of an attack on 4-5.5 (b)(1) in our Supreme Court.

In Massachusetts, a District Judge found that the certain Massachusetts UPL laws and regulations ran afoul of the so called dormant Commerce Clause, U.S. Const. art. I §8, cl. 3. *Real Estate Bar Ass'n for Mass., Inc. v. National Real Estate Information Services*, 609 F.Supp 135 (D. Mass. 2009). Since this holding was reversed by the First Circuit, 608 F.3d 110 (2010), I do not discuss it in detail but it does reflect that UPL laws are vulnerable to Commerce Clause challenges.

Finally, for a valuable and scholarly discussion of the ongoing debate about 5.5 *see Reforming Lawyer Mobility-Protecting Turf or Serving Clients?*, 30 Geo. J. Legal Ethics 125 (2017).

In conclusion, it is time for a significant review and revision of Florida Bar Rule 4-5.5 and 4-5.5 (b)(1) in particular as it has no rational relationship to protection of Florida citizens and residents.

Cordially yours,

Barry R. Davidson

Barry R. Davidson

RULES OF PROFESSIONAL CONDUCT

(Includes all amendments through those effective September 10, 2019)

Table of Rules

NOTE: These rules shall be referred to as the Rules of Professional Conduct and shall be abbreviated as "RPC."

harm such as inflicting emotional distress or obtaining a tactical advantage and not to cover instances when no harm is intended unless its occurrence is likely regardless of intent, e.g., where discriminatory comments or behavior is repetitive. While obviously the language of the rule cannot explicitly cover every instance of possible discriminatory conduct, the Court believes that, along with existing case law, it sufficiently narrows the breadth of the rule to avoid any suggestion that it is overly broad. See, e.g., *In re Vincenti*, 114 *N.J.* 275 (554 *A.2d* 470) (1989).

Note: Adopted July 12, 1984, to be effective September 10, 1984; paragraph (g) adopted July 18, 1990, to be effective September 4, 1990; paragraph (g) amended May 3, 1994, to be effective September 1, 1994; paragraph (e) amended November 17, 2003 to be effective January 1, 2004.

RPC 8.5 Disciplinary Authority; Choice of Law

(a) Disciplinary Authority. A lawyer admitted to practice in this jurisdiction is subject to the disciplinary authority of this jurisdiction regardless of where the lawyer's conduct occurs. A lawyer not admitted in this jurisdiction is subject also to the disciplinary authority of this jurisdiction if the lawyer provides or offers to provide any legal services in this jurisdiction. A lawyer may be subject to the disciplinary authority of both this jurisdiction and another jurisdiction for the same conduct.

(b) Choice of Law. In the exercise of the disciplinary authority of this jurisdiction, the rules of professional conduct to be applied shall be:

(1) for conduct in connection with a matter pending before a tribunal, the rules of the jurisdiction in which the tribunal sits, unless the rules of the tribunal provide otherwise; and

(2) for any other conduct, the rules of the jurisdiction in which the lawyer's conduct occurred, or, if the predominant effect of the conduct is in a different jurisdiction, the rules of that jurisdiction shall be applied to the conduct. A lawyer shall not be subject to discipline if the lawyer's conduct conforms to the rules of a jurisdiction in which the lawyer reasonably believes the predominant effect of the lawyer's conduct will occur.

Note: Adopted July 12, 1984 to be effective September 10, 1984; caption amended, text amended and redesignated as paragraph (a) with caption added, new paragraph (b) with caption adopted November 17, 2003 to be effective January 1, 2004; subparagraph (b)(2) amended August 1, 2016 to be effective September 1, 2016.

Ethics Advisory Opinion Committee
Opinion No. 19-03
Issued: May 14, 2019

ISSUE

1. If an individual licensed as an active attorney in another state and in good standing in that state establishes a home in Utah and practices law for clients from the state where the attorney is licensed, neither soliciting Utah clients nor establishing a public office in Utah, does the attorney violate the ethical prohibition against the unauthorized practice of law?

OPINION

2. The Utah Rules of Professional Conduct do not prohibit an out-of-state attorney from representing clients from the state where the attorney is licensed even if the out-of-state attorney does so from his private location in Utah. However, in order to avoid engaging in the unauthorized practice of law, the out-of-state attorney who lives in Utah must not establish a public office in Utah or solicit Utah business.

BACKGROUND

3. Today, given electronic means of communication and legal research, attorneys can practice law "virtually" from any location. This can make it possible for attorneys licensed in other states to reside in Utah, but maintain a practice for clients from the states where they are licensed. For example:

- An attorney from New York may decide to semi-retire in St. George, Utah, but wish to continue providing some legal services for his established New York clients.

- An attorney from California may relocate to Utah for family reasons (*e.g.*, a spouse has a job in Utah, a parent is ill and needs care) and wish to continue to handle matters for her California clients.

ANALYSIS

4. Rule 5.5 of the Utah Rules of Professional Conduct (the "**URPC**"), which is based upon the Model Rules of Professional Conduct, defines the "unauthorized practice of law," and Rule 14-802 of the Utah Supreme Court Rules of Professional Practice defines the "practice of law." In the question posed, the Ethics Advisory Opinion Committee (the "**EAOC**") takes it as given that the out-of-state lawyer's activities consist of the "practice of law."

5. Rule 5.5(a) of the Utah Rules of Professional Conduct provides that a "lawyer shall not practice law in a jurisdiction in violation of the regulation of the legal profession in that jurisdiction." Rule 5.5(b) provides:

> A lawyer who is not admitted to practice in this jurisdiction shall not:
>
> (b)(1) except as authorized by these Rules or other law, establish an office or other systematic and continuous presence in this jurisdiction for the practice of law; or
>
> (b)(2) hold out to the public or otherwise represent that the lawyer is admitted to practice law in this jurisdiction.

URPC 5.5(b).

6. THE LAW OF LAWYERING explains the meaning and relationship of these two sections:

> Rule 5.5(b) . . . elaborates on the prohibition against unauthorized practice of law contained in Rule 5.5(a) as it concerns out-of-state lawyers. Rule 5.5(b)(1) broadly prohibits a lawyer from establishing an office or other 'systemic and continuous presence' for practicing law in a jurisdiction in which the lawyer is not licensed.

Geoffrey C. Hazard, Jr., W. William Hodes, Peter R. Jarvis, THE LAW OF LAWYERING § 49.02, at 49-7 (4th ed. 2018).

7. With that as our touchstone, it seems clear that the out-of-state attorney who lives in Utah but continues to handle cases for clients from the state where the attorney is licensed has not established an office or "'other systemic and continuous presence' for practicing law in [Utah] a jurisdiction in which the lawyer is not licensed" and is not in violation of Rule 5.5 of the Utah Rules of Professional Conduct.

8. While one could argue that living in Utah while practicing law for out-of-state clients does literally "establish a systematic and continuous presence in this jurisdiction for the practice of law," and that it does not have to be "for the practice of law IN UTAH," that reading finds no support in case law or commentary.

9. In *In re: Discipline of Jardine*, Utah attorney Nathan Jardine had been suspended from the practice of law in Utah for eighteen months. 2015 UT 51, ¶ 1, 353 P.3d 154. He sought reinstatement, but the Office of Professional Conduct argued against reinstatement because he had violated Rule 14-525(e)(1) of the Supreme Court Rules of Professional Practice by engaging in the unauthorized practice of law while he was suspended. 2015 UT 51, ¶¶ 6, 20. The disciplinary order allowed Mr. Jardine "with the consent of the client after full disclosure, [to] wind up or complete any matters pending on the date of entry of the order," but "Mr. Jardine never informed [the client] that he was suspended, nor did he wind up his participation in the matter." *Id.* ¶¶ 8-9 (quotation omitted). Instead, he continued to advise the client and sent a demand letter on the client's behalf, giving his Utah address but indicating California licensure. *Id.* ¶ 9. Mr. Jardine argued that he did not engage in the unauthorized practice of law because this matter was for an Alaska resident and the resulting case was filed in an Idaho court. *Id.* ¶ 22.

Nevertheless, the Utah Supreme Court found that Mr. Jardine engaged in the unauthorized practice of law in Utah, in violation of his disciplinary order, reasoning: "The disciplinary order expressly prohibited Mr. Jardine from 'performing *any* legal services for others' or 'giving legal advice to others' within the State of Utah." *Id.* (emphasis added). All of the work Mr. Jardine performed for the Alaska client was performed in Mr. Jardine's Utah office, Mr. Jardine's text messages were made from Utah, and Mr. Jardine's demand letter listed his Utah address. *Id.*

10. *In re Jardine* does not control the question posed. Not only did the Utah Supreme Court analyze the "unauthorized practice of law" in the context of a suspended Utah attorney violating a disciplinary order that forbid him from performing *any* legal services whatsoever for others, but Mr. Jardine was continuing his legal work out of a Utah office and using a Utah business address. The question posed here to the EAOC deals with attorneys in good standing in other states who simply establish a residence in Utah and continue to provide legal work to out-of-state clients from their private Utah residence.

11. We can find no case where an attorney has been disciplined for practicing law out of a private residence for out-of-state clients located in the state where the attorney is licensed. Indeed, the United States Supreme Court held in *New Hampshire v. Piper*, 470 U.S. 274 (1985), that a New Hampshire Supreme Court rule limiting bar admission to New Hampshire residents violated the rights of a Vermont resident seeking admission under the Privileges and Immunities Clause of the U.S. Constitution. *Id.* at 275-76, 288. Thus, there can be no prohibition on an attorney living in one state and being a member of the bar of the another state and practicing law in that other state.

12. Rather, the concern is that an attorney not establish an office or public presence in a jurisdiction where the attorney is not admitted, and that concern is based upon the need to

protect the interests of potential clients in that jurisdiction. In *Gould v. Harkness*, 470 F. Supp. 2d 1357 (S.D. Fla. 2006), a New York attorney sought to establish an office and advertise his presence in Florida, but advertise "New York Legal Matters Only" or "Federal Administrative Practice." *Id.* at 1358. The case concerned whether his First Amendment right to freedom of commercial speech under the United States Constitution was violated by the Florida Bar's prohibition on such advertisements. *Id.* at 1358-59. The *Gould* court held that the Florida Bar was entitled to prohibit such advertisements in order to protect the interests of the public—the residents of Florida. *Id.* at 1364.

13. Similarly, in *In re Estate of Condon*, 76 Cal. Rptr. 2d 933 (Cal. Ct. App. 1998), the court approved payment of attorney fees to a Colorado attorney who handled a California probate matter for a co-executor who lived in Colorado. *Id.* at 924. The *Condon* court held that the unauthorized practice of law statute "does not proscribe an award of attorney fees to an out-of-state attorney for services rendered on behalf of an out-of-state client regardless of whether the attorney is either physically or virtually present within the state of California." *Id.* at 926. Here, too, the *Condon* court highlighted concern for in-state California clients:

> In the real world of 1998 we do not live or do business in isolation within strict geopolitical boundaries. Social interaction and the conduct of business transcends state and national boundaries; it is truly global. A tension is thus created between the right of a party to have counsel of his or her choice and the right of each geopolitical entity to control the activities of those who practice law within its borders. In resolving the issue ... it is useful to look to the reason underlying the proscription [of the unauthorized practice of law....] [T]he rational is to protect California citizens from incompetent attorneys....

Id. at 927.

14. An interesting Ohio Supreme Court case further supports this Opinion that an out-of-state attorney practicing law for clients from the state where he is licensed should not be seen to violate Rule 5.5 of the Utah Rules of Professional Conduct's prohibition on the unauthorized

practice of law. In *In re Application of Jones*, 2018 WL 5076017 (Ohio Oct. 17, 2018), Alice Jones was admitted to the Kentucky bar and practiced law in Kentucky for six years. *Id.* at *1-2. Her Kentucky firm merged with a firm having an office in Cincinnati, Ohio. *Id.* at *1. For personal reasons, Ms. Jones moved to Cincinnati and transferred to her firm's Cincinnati office. *Id.* at *2. She applied for admission to the Ohio bar the month before she moved. *Id.* While awaiting the Ohio Bar's decision, she practiced law exclusively on matters related to pending or potential proceedings in Kentucky. *Id.* Nevertheless, the Board of Commissioners on Character and Fitness chose to investigate Ms. Jones for the unauthorized practice of law and voted to deny her admission to the Ohio Bar. *Id.*

15. The Ohio Supreme Court unanimously reversed this decision. *Id.* at *4. A majority of the *Jones* court held that Ms. Jones' activities did not run afoul of the unauthorized practice of law provision because Rule 5.5(c)(2) of the Ohio Rules of Professional Conduct permitted her to provide legal services on a "temporary basis" while she awaited admission to the Ohio bar. *Id.* at *3. However, three of the seven Ohio Supreme Court justices concurred on a different basis. *Id.* at *5 (DeWine, J., concurring). They found that denial of Jones' application on these facts would violate the Due Process Clause of the Fourteenth Amendment to the United States Constitution as well as the Ohio Constitution's related provisions. *Id.* at *9 (DeWine, J., concurring). Both constitutions protected one's right to pursue her profession, subject to governmental regulation only to the extent necessary to promote the health, safety, morals, or general welfare of society, provided the legislation is not arbitrary or unreasonable. *Id.* at *7-8 (DeWine, J., concurring). The concurring opinion noted that "the constitutional question here turns on identifying Ohio's interest in prohibiting Jones from representing her Kentucky clients while working in a Cincinnati office. The short answer is that there is none." *Id.* at *8 (DeWine,

J., concurring). Two state interests supported attorney regulation—attorneys' roles in administering justice through the state's court system and "the protection of the public." *Id.* (DeWine, J., concurring).

> But when applied to a lawyer who is not practicing Ohio law or appearing in Ohio courts, Prof.Cond.R. 5.5(b) serves no state interest. Plainly, as applied to such a lawyer, the rule does not further the state's interest in protecting the integrity of our court system. Jones, and others like her, are not practicing in Ohio courts. Nor does application of the rule to such lawyer serve the state's interest in protecting the Ohio public. Jones and others in her situation are not providing services to or holding themselves out as lawyers to the Ohio public. Jones's conduct as a lawyer is regulated by the state of Kentucky—the state in whose forums she appears.

Id. at *9 (DeWine, J., concurring). The three concurring Ohio Supreme Court justices concluded that Rule 5.5(b) of the Ohio Rules of Professional Conduct, as interpreted by the Ohio Board of Commissioners, would be unconstitutional when applied to Jones and others similarly situated. *Id.* (DeWine, J., concurring).

16. The question posed here is just as clear as the question before the Ohio Supreme Court: what interest does the Utah State Bar have in regulating an out-of-state lawyer's practice for out-of-state clients simply because he has a private home in Utah? And the answer is the same—none.

17. Finally, a perusal of various other authorities uncovers no case in which an attorney was disciplined for living in a state where he was not licensed while continuing to practice law for clients from the state where he was licensed. *See* RESTATEMENT (THIRD) OF THE LAW GOVERNING LAWYERS § 3 *Jurisdictional Scope of the Practice of Law by a Lawyer* (2000); ROY D. SIMON, SIMON'S NY RULES OF PROF. COND. § 5.5:6 (Dec. 2018); and *What Constitutes "Unauthorized Practice of Law" by Out-of-State Counsel*, 83 A.L.R. 5th 497 (2000).

CONCLUSION

18. Accordingly, the EAOC interprets Rule 5.5(b) of the Utah Rules of Professional Conduct in a way consistent with the Due Process and Privileges and Immunities Clauses of the Fourteenth Amendment to the United States Constitution; the Privileges and Immunities Clause of Article IV, Section 2 of the United States Constitution; Article 1, Section 7 of the Due Process Clause and Article 1, Section 24 of the Uniform Operation of the Laws Clause of the Utah Constitution; and all commentators and all persuasive authority in support of permitting an out-of-state attorney to establish a private residence in Utah and to practice law from that residence for clients from the state where the attorney is licensed.