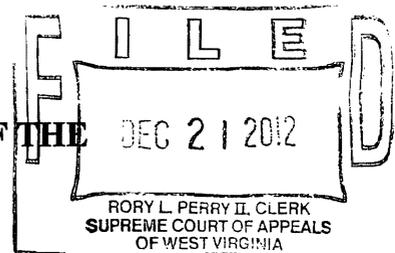


**BEFORE THE SUPREME COURT OF APPEALS OF THE
STATE OF WEST VIRGINIA**



STATE OF WEST VIRGINIA EX REL., OLEN L. YORK, III,

Petitioner,

v.

No. 12-1410

**WEST VIRGINIA OFFICE OF DISCIPLINARY COUNSEL and
WEST VIRGINIA LAWYER DISCIPLINARY BOARD**

Respondents.

**RESPONSE TO PETITIONER'S
PETITION FOR A *WRIT* OF PROHIBITION**

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I. INTRODUCTION

At the request of this Honorable Court, pursuant to Rule 16(g) of the Revised Rules of Appellate Procedure, Renée N. Frymyer, Lawyer Disciplinary Counsel for the Office of Disciplinary Counsel, submits this Response to Petitioner's Petition for a *Writ* of Prohibition on behalf of the West Virginia Office of Lawyer Disciplinary Counsel and the West Virginia Lawyer Disciplinary Board, Respondents herein.

II. QUESTION PRESENTED

Are Respondents without jurisdiction, under Rule 1 of the West Virginia Rules of Lawyer Disciplinary Procedure and under federal preemption principles, to prosecute alleged violations of the West Virginia Rules of Professional Conduct against a lawyer who has not been admitted to the practice of law in West Virginia and never appeared nor prepared pleadings or documents to be filed in any West Virginia court, but who has been admitted to the United States Patent and Trademark Office (USPTO), maintained an office in West Virginia, and represented West Virginia clients?

III. SUMMARY OF ARGUMENT

Respondents have proper jurisdiction to investigate and prosecute violations of the West Virginia Rules of Professional Conduct committed by an individual admitted to the practice of law in another jurisdiction who engages in the practice of law in West Virginia. Lawyer Disciplinary Board v. Allen, 198 W.Va. 18, 479 S.E.2d 317 (1996). The practice of law in West Virginia is not limited to actions that can only be filed before a West Virginia court or tribunal, but encompasses any instance a party provides another with advice or

service under circumstances which imply the possession or use of legal knowledge or skill. W.Va. Court Rules Ann. 961, *W.Va. Definition of the Practice of Law* (Michie 2012).

Because Petitioner was engaged in the practice of law in West Virginia and this Court has the exclusive authority to define, regulate and control the practice of law in West Virginia, Respondents have proper jurisdiction and authority to investigate and prosecute Petitioner for alleged violations of the Rules of Professional Conduct. Such jurisdiction is necessary to protect the public, to reassure the public as to the reliability and integrity of attorneys, to safeguard the public interest in the administration of justice, to deter other attorneys from engaging in similar misconduct, and is not in conflict with or preempted by federal law.

IV. STATEMENT REGARDING ORAL ARGUMENT AND DECISION

Respondents do not object to oral argument in this matter. However, Respondents believe that this Court can properly issue a Decision and Order pursuant to the written arguments submitted by the parties.

V. ARGUMENT

A. An individual who engages in the practice of law in West Virginia is clearly subject to the jurisdiction of Respondents.

Petitioner, a member of the Ohio State Bar and the United States Patent and Trademark Office (“USPTO”), was associated with a law firm based in Huntington, West Virginia, and performed patent and copyright legal services for residents of West Virginia and surrounding states. On or about September 24, 2012, a Statement of Charges was issued

against Petitioner alleging violations of Rules 1.15(a), 1.15(b), 1.15(d), 8.4(c) and 8.4(d) of the Rules of Professional Conduct. It is undisputed that Petitioner provided legal services to two (2) parties referenced in the Statement of Charges, who resided in Poca, West Virginia, and Spencer, West Virginia, respectively, while working out of the Huntington law office.

Petitioner's practice before the USPTO was legitimate, as the Agency Practice Act, 5 U.S.C. § 500(b), provides that any lawyer in good standing in a state bar may practice before any federal agency. The fact that Petitioner was not admitted to practice in West Virginia does not shield him from the jurisdiction of this Court and Respondents, as Petitioner was engaged in the practice of law in West Virginia and has been charged with harming West Virginia clients, the class of those whom this Court and Respondents have a duty to protect.

This Honorable Court has the exclusive authority to define, regulate and control the practice of law in West Virginia. *See Lawyer Disciplinary Board v. Allen*, 198 W.Va. 8, 479 S.E.2d 317 (1996); Syl. pt. 1, *State ex rel. Askin v. Dostert*, 170 W.Va. 562, 295 S.E.2d 271 (1982); *State Bar v. Earley*, 144 W.Va. 504, 109 S.E.2d 420 (1959); W.Va. Code § 51-1-4a.

This Court has defined the practice of law as follows:

In general, one is deemed to be practicing law whenever he or it furnishes to another advice or service under circumstances which imply the possession or use of legal knowledge or skill.

More specifically, but without purporting to formulate a precise and completely comprehensive definition of the practice of law or to prescribe limits to the scope of that activity, one is deemed

to be practicing law whenever (1) one undertakes, with or without compensation and whether or not in connection with another activity, to advise another in any matter involving the application of legal principles to facts, purposes or desires; (2) one undertakes, with or without compensation and whether or not in connection with another activity, to prepare for another legal instruments of any character; or (3) one undertakes, with or without compensation and whether or not in connection with another activity, to represent the interest of another before any judicial tribunal or officer, or to represent the interest of another before any executive or administrative tribunal, agency or officer otherwise than in the presentation of facts, figures or factual conclusions as distinguished from legal conclusions in respect to such facts and figures.

W.Va. Court Rules Ann. 961, *Definition of the Practice of Law* (Michie 2012).

In State ex rel. Frieson v. Isner, 168 W.Va. 758, 285 S.E.2d 641 (1981), this Court observed that:

[T]he practice of law is not limited to the conduct of cases before courts, but also includes the services rendered outside court such as ‘the preparation of pleadings and other papers incident to actions and special proceedings and the management of such actions and proceedings on behalf of clients before judges and courts, and in addition to conveyancing, the preparation of legal instruments of all kinds, and in general all advice to clients and all action taken for them in matters connected with the law.

Id. at 768, 650.

Rule 1 of the Rules of Lawyer Disciplinary Procedure established a Lawyer Disciplinary Board to investigate complaints of violations of the Rules of Professional Conduct of any individual who engages in the practice of law in West Virginia. As this Court has stated, the practice of law is not limited to the context of conduct before a

particular court. Indeed, it embraces the preparation of pleadings and other papers to be filed within a certain tribunal, as Petitioner suggests, but also all advice to clients and all other action taken for them in matters connected to the law. In order to develop an adequate factual record upon which this Court can properly make a finding of a violation of the Rules of Lawyer Disciplinary Procedure, Rule 1 was promulgated by this Court to afford Respondents the jurisdiction to investigate complaints, conduct hearings, and make findings of fact, conclusion of law, and recommendations of lawyer discipline concerning any attorney who engages in the practice of law in West Virginia.

Petitioner was clearly engaged in the practice of law in West Virginia when he was purportedly interviewing potential clients, analyzing, explaining, interpreting, giving an opinion and/or advising his clients on the meaning of legal terms or principles, instructing clients in the matter in which to execute legal documents, preparing instruments and filings requiring knowledge of legal principles not possessed by an ordinary layman, and providing advice and instructions to his clients informing them of their legal rights and obligations. Thus, Respondents have proper jurisdiction in this matter concerning Petitioner's alleged actions of misconduct while engaged in the foregoing.

In Lawyer Disciplinary Board v. Allen, this Court found that respondents therein were engaged in the practice of law when they sent letters to West Virginia residents advising the recipients of their rights under the law, even when the contacts were most likely initiated outside of West Virginia and the respondents were not admitted to practice law in this state. 198 W.Va. 8, 35, 479 S.E.2d 317, 334 (1996). Petitioner attempts to distinguish Allen from

the present case by stating that Petitioner never solicited any West Virginia clients regarding any cause of action that would have been filed in West Virginia. However, although the Court did find in Allen that rendering legal advice to West Virginians concerning a prospective legal action cognizable by the courts of this State constituted the practice of law in West Virginia, there is no indication that this Court intended to strictly limit its definition of the practice of law to such. In fact, the “Conclusion” of Allen states simply, “[U]nder Rule 1 of the Rules of Lawyer Disciplinary Procedure, as amended by this Court on December 6, 1994, a lawyer is subject to the discipline in this State for violating the West Virginia Rules of Professional Conduct if he or she engages in the practice of law in this State, whether or not he or she is formally admitted to practice by this Court.” 198 W.Va. at 40, 479 S.E.2d at 339.

In this case, Petitioner analyzed and explained legal rights to West Virginia clients from his law office in West Virginia. Petitioner’s position that his actions did not constitute the practice of law in West Virginia because his legal representation involved patent and trademark proceedings is clearly inconsistent with this Court’s long-held definition of the practice of law and the West Virginia Rules of Lawyer Disciplinary Procedure. Adopting such a narrow definition of the practice of law in West Virginia would fail to properly protect the public from being advised and represented by persons not subject to critical professional regulation and would encourage other unadmitted attorneys to undertake federal practice in this State with impunity for unethical practices.

This Court has also held that the character of the act, and not the place where it is performed, is the decisive factor in determining whether the act constitutes the practice of law. West Virginia State Bar v. Earley, 109 S.E.2d 420, 144 W.Va. 504 (1959). Thus, the mere fact that Petitioner was not preparing documents to be filed in a West Virginia tribunal does not absolve him from the jurisdiction of Respondents. Moreover, this Court clearly has jurisdiction over the protection of its citizens, those whom Petitioner has alleged to have harmed and could continue to harm if not stopped, in order to preserve the public confidence in the ethical standards of the legal profession and in our disciplinary system.

B. Respondents' jurisdiction to prosecute violations of the West Virginia Rules of Professional Conduct and potentially sanction Petitioner is proper and is consistent with the precedent of both state and federal laws.

This Court has proper jurisdiction to make determinations of violations of the West Virginia Rules of Professional Conduct even in the context of federal administrative proceedings. The United States Supreme Court has recognized the broad authority of the states to discipline an attorney who violates his ethical duty under state law. *See, Kroll v. Finnerty*, 242 F.3d 1359 (Fed. Cir. 2001) (a Patent and Trademark Office case wherein the Federal Circuit Court of Appeals noted that the text of 35 U.S.C. § 2(b)(2)(D) and 35 U.S.C. § 32 gave no indication that either statute intended to preempt the authority of states to punish attorneys who violate ethical duties under state law even though the Director was entitled to regulate the conduct of patent attorneys before the Patent and Trademark Office). *See also, Sperry v. Florida ex rel Florida Bar*, 373 U.S. 379 (1963) (an unauthorized practice of law case which held that in the absence of federal legislation to the contrary, the state has

jurisdiction over the protection of its citizens from the practice of law by unauthorized persons).

The United States Supreme Court has long recognized that states have an important interest in regulating attorney conduct:

States traditionally have exercised extensive control over the professional conduct of attorneys. The ultimate objective of such control is the protection of the public, the purification of the bar and the prevention of re-occurrence. The judiciary as well as the public is dependent upon professionally ethical conduct of attorneys and thus has a significant interest in assuring and maintaining high standards of conduct of attorneys engaged in practice.

Middlesex County Ethics Comm. v. Garden State Bar Ass'n, 457 U.S. 423 (1982).

Moreover, federal courts have frequently recognized that state disciplinary bodies have the responsibility of determining whether attorneys engaged in misconduct in federal forums, and routinely refer such matters to the appropriate state disciplinary authorities. *See e.g., County, Mun. Employees', Supervisors' & Foremen's Union Local 1001 v. Laborers' Int'l Union of N. Am.*, 365 F.3d 576, 580 (7th Cir. 1985) (referring conduct of attorneys in matter involving federal labor laws); Lupucki v. Van Wormer, 765 F.2d 86, 89 (7th Cir. 1985) *cert. denied*, 474 U.S. 827 (1985) (referring counsel to state disciplinary bodies because of abuse of the federal judicial process); United States v. Nicholas, 606 F. Supp. 2d 1109, 1121 (C.D. Cal. 2009) (referring counsel to "State Bar for appropriate discipline" for misconduct in representing a client in a matter involving investigations by the federal Securities and Exchange Commission).

Other states have also disciplined attorneys not admitted to practice in their jurisdiction but provided legal services to their citizens in federal matters. *See e.g., Iowa Supreme Court Attorney Disciplinary Board v. Carpenter*, 781 N.W.2d 263 (Iowa 2010) (Based on their responsibility to protect Iowans from unethical conduct of attorneys who provide services in Iowa, the Iowa Supreme Court disciplined an attorney who maintained offices in Iowa and provided legal services to persons in Iowa on federal immigration matters but who was not admitted to the Iowa State Bar under the Iowa Rules of Professional Conduct regarding trust account violations, client neglect and failure to communicate, failure to respond to disciplinary board inquiries, and conviction of traffic offenses); *The People of the State of Colorado v. Daynel L. Hooker*, Case No. 08PDJ106 (Unpublished Colorado 2009) and *The People of the State of Colorado v. Daynel L. Hooker*, Case No. 10PDJ062 (Unpublished Colorado 2011) (An out-of-state attorney practicing federal immigration, bankruptcy, and intellectual property law in Colorado was disciplined for violations of the Colorado Rules of Professional Conduct).

Petitioner's alleged misconduct should not be condoned and for Respondents to not have jurisdiction in this matter fails to protect the public, fails to reassure the citizens of this state as to the reliability and integrity of attorneys, and fails to adequately safeguard the administration of justice. Jurisdiction is also absolutely essential to deter other lawyers from engaging in similar conduct and to restore the faith of the general public in the integrity of the legal profession. Petitioner's alleged violations of the Rules of Professional Conduct are not entitled to any special protection just because the conduct took place in connection with

federal patent proceedings, as Petitioner argues. Lawyer Disciplinary Board v. Smoot, 228 W.Va. 1, 716 S.E.2d 491 (2010), made clear that lawyer misconduct committed before a federal agency is subject to the authority of the Supreme Court of Appeals.

The West Virginia Rules of Professional Conduct state the minimum level of conduct below which no lawyer can fall without being subject to disciplinary action. Syllabus Pt. 3, *in part*, Committee on Legal Ethics v. Tatterson, 173 W.Va. 613, 319 S.E.2d 381 (1984), *cited in* Committee on Legal Ethics v. Morton, 186 W.Va. 43, 410 S.E.2d 279, 281 (1991). This Court has long recognized that attorney disciplinary proceedings are not designed solely to punish the attorney, but also to protect the public, to reassure the public as to the reliability and integrity of attorneys, and to safeguard its interests in the administration of justice. Lawyer Disciplinary Board v. Taylor, 192 W.Va. 139, 451 S.E.2d 440 (1994). In order to adequately protect these public interests, it is crucial that attorneys who provide services to citizens of this state are subject to the rules governing the practice of law in this state.

C. The investigation and prosecution of Petitioner does not conflict with the Supremacy Clause.

Petitioner asserts that under the Supremacy Clause, Article VI, Section 2 of the United States Constitution, Respondents actions of investigating and prosecuting Petitioner for alleged violations of the West Virginia Rules of Professional Conduct are preempted because Petitioner's actions were taken in connection with his patent law practice. It is generally accepted that the Supremacy Clause of the United States Constitution invalidates state laws that "interfere with, or are contrary to federal law." Hillsborough County, Florida, et al. v.

Automated Medical Laboratories, Inc., 471 U.S. 707, 713 (1985) *citing* Gibbons v. Ogden, 9 Wheat 1, 211, 6 L.Ed. 23 (1824). In addition, under the Supremacy Clause, “state law is nullified to the extent that it actually conflicts with federal law. Such a conflict arises when ‘compliance with both federal and state regulations is a physical impossibility.’” Florida Lime & Avocado Growers, Inc. v. Paul, 373 U.S. 132, 142-143 (1963).

In this case, the actions of Respondents pursuant to the West Virginia Rules of Lawyer Disciplinary Procedure and the West Virginia Rules of Professional Conduct do not conflict with any action of the federal courts or federal law. Moreover, the United States Supreme Court has strictly limited application of the federal supremacy doctrine in matters concerning the practice of law: “[T]he State maintains control over the practice of law within its borders except to the limited extent necessary for the accomplishment of the federal objectives.” Sperry v. Florida ex rel Florida Bar, 373 U.S. 379, 402 (1963). Patent matters are not one of the rare statutes which Congress has declared a field of “complete preemption” such as the Employment Retirement Income Security Act (“ERISA”). Thus, Disciplinary Counsel clearly has the authority to investigate and prosecute conduct by a federally registered patent attorney in matters outside the scope of authority granted by federal law.

Moreover, an investigation by Disciplinary Counsel in the underlying matter does not challenge the rules and regulations under the USPTO and a decision issued by the Lawyer Disciplinary Board or the Supreme Court of Appeals would not be deciding an important area of federal law. Respondents have alleged that Petitioner committed violations of the West Virginia Rules of Professional Conduct. Despite Petitioner’s assertion that he was “authorized to take whatever actions [that] were necessary to represent his clients,” no

federal law or regulation permits Petitioner to engage in the conversion and misappropriation of client funds in violation of the Rules of Professional Conduct. Petitioner's alleged misconduct raises a question of his fitness to practice law in the State of West Virginia. A finding of a violation of the Rules of Professional Conduct goes directly to state interests including, but not limited to, the protection of the public and the proper administration of justice.

Additionally, Respondents are not attempting to limit Petitioner's practice before any federal agency and the actions of Respondents have not impacted Petitioner's ability to represent patent clients before the USPTO. Petitioner's right to practice before the USPTO is clearly subject to the jurisdiction USPTO's Office of Enrollment and Discipline and the Disciplinary Rules of the USPTO Code of Professional Responsibility. In this matter, Respondents' investigation and analysis of Petitioner's alleged misconduct is based on the case law and Rules promulgated by the Supreme Court of Appeals governing attorney ethics.

D. ABA Model Rule 5.5

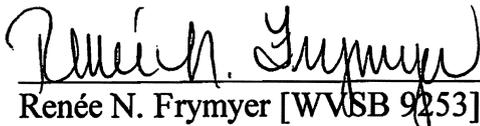
Respondents take no position on Petitioner's argument regarding ABA Model Rule 5.5, "Unauthorized Practice of Law; Multijurisdictional Practice of Law," as Respondents do not dispute that Petitioner was authorized to take actions in West Virginia in connection with his practice before a federal agency. Moreover, Petitioner has not been charged with the unauthorized practice of law in the underlying matter.

VI. CONCLUSION

Accordingly, as Respondents have not exceeded their legitimate powers in this matter, Respondents respectfully request that the *Writ* not be granted but be dismissed and

subsequently be stricken from the Court's docket, and that Respondents proceed with the prosecution of charges against Olen L. York, III, pursuant to the West Virginia Rules of Professional Conduct and the West Virginia Rules of Lawyer Disciplinary Procedure.

Respectfully submitted,
The Office of Disciplinary Counsel,



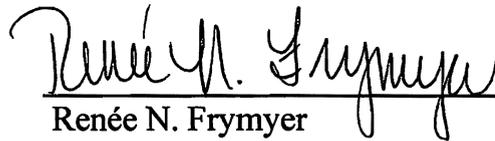
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CERTIFICATE OF SERVICE

This is to certify that I, **Renée N. Frymyer**, Lawyer Disciplinary Counsel for the Office of Disciplinary Counsel, have this day, the 21st day of December, 2012, served a true copy of the foregoing **RESPONSE TO PETITIONER'S PETITION FOR A WRIT OF PROHIBITION** upon Lonnie C. Simmons, Esquire, and Robert B. Kuenzel, II, Esquire, Counsel for Petitioner, Olen L. York, III, by mailing the same, United States Mail with sufficient postage, to the following addresses:

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36 Adams Street
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Renée N. Frymyer