

Michael E. McCabe, Jr.

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LEGAL EXPERIENCE:

Experienced expert in field of Intellectual Property Law including representation of patent and trademark attorneys, law firms, corporate counsel, and federal government employees involving legal ethics matters. Decades of Intellectual Property and commercial litigation experience for multi-national corporate clients in patent and trademark related cases before federal courts in many jurisdictions. Nationally renowned speaker on legal ethics and regulatory compliance, particularly relating to Intellectual Property law. Credited as a leading attorney in matters involving application of rules of professional conduct regarding patent and trademark law.

INTELLECTUAL PROPERTY, ETHICS & LITIGATION:

McCabe Law LLC, Intellectual Property (IP) Ethics Law, Potomac, MD 2017-Present
Principal and Founder

- Founded practice as registered Patent Attorney to better serve IP clients with proactive risk management counsel by ensuring that business and legal affairs are compliant with applicable federal and state Rules of Professional Conduct
- Utilize knowledge as prior Director of large IP Law Firm to assist clients in formulating best practices within their organizations regarding avoidance of conflicts of interest and inequitable conduct, proper documentation, and management oversight
- Expert in representing clients involved in USPTO Ethics Investigations and commended for research and detailed knowledge in unique and complex niche of ethics within IP law
- Represent lawyers and patent agents charged with ethics violations in disciplinary enforcement actions brought by the federal government
- Recognized as dynamic speaker, authoritative commentator, and published author on ethical issues in practice of intellectual property law

Funk & Bolton, PA, General Practice Law Firm 2011-2017
Partner & Attorney Ethics Practice Group Founder

- Created and initiated practice group in Funk & Bolton focused on representation of patent and trademark lawyers in ethics counseling, government investigations, and formal disciplinary proceedings
- Hired by Department of Justice as Special Ethics Counsel to represent a federal government patent attorney accused of unethical conduct
- Publicly commended by prominent legal internet sites for launching first-ever niche-focused blog concentrating on intellectual property and legal ethics, which addresses new developments, interpretations, resources, and best practices in informative and user-friendly format
- Published chapter by American Bar Association in reference book regarding confidentiality and the attorney-client privilege
- Represented institutional clients in patent and other commercial claims before federal courts and administrative agencies

Oblon, Spivak, LLP, Intellectual Property Law, Alexandria, VA 1999-2011
Partner, Director & Risk Management Chair

- Represented domestic and foreign clients in patent litigation involving diverse areas of technology, opinions relating to patent validity and infringement, and drafted and prosecuted patent applications before the USPTO
- Promoted to Chief Legal Compliance Officer to manage firm's functions in legal ethics, professional responsibility, risk management, and malpractice avoidance to ensure PTO and state ethics compliance
- Served as Arbitrator in binding proceeding to resolve ownership dispute of IP rights between competing clients through review of legal briefs, documentary evidence and witness testimony to reach appropriate decision
- Elected to Shareholder and Board of Directors due to trusting reputation for liaison and discretion with strong analytical and communication skills to serve interests of attorneys and firm
- Recognized as Intellectual Property expert through IP published works and speaking engagements in legal and academia communities (see below list)

McDermott, Will & Emery, *Partner*, IP Litigation, Washington, DC 1995-1999
(Merged with Lowe, Price, LeBlanc & Becker)

Shapiro & Olander, *Associate*, General Practice, Baltimore, MD 1992-1995

- Represented corporate and individual clients in litigating patent, trademark, and copyright disputes before federal district courts and the International Trade Commission
- Initiated IP Department (at Shapiro) to represent inventors and companies in patent and trademark clearances, opinions, applications, IP licensing rights, and employer contract protocols for ownership of intellectual property

GOVERNMENT PROFESSIONAL EXPERIENCE:

NASA / Goddard Space Flight Center, Greenbelt, MD 1985-1989
Engineer

- Conducted microgravity testing of new types of heat transfer systems for integration in the NASA Space Station, analyzed performance data, and delivered recommendations to senior management
- Served as Goddard representative in collaboration with U.S. Air Force to develop high-power spacecraft thermal management systems, and authored and presented technical paper on project results at international engineering conference

HONORS/AWARDS:

- Included multiple times in **Washington DC Best Lawyer's List** for patent and intellectual property law, and **Super Lawyers** for professional liability, 2018
- Elected as Baltimore "**Patent Lawyer of the Year**" in 2015 by *Best Lawyers*
- Awarded "**Best Legal Blog of 2016**" for niche and specialty area
- Co-Vice Chair, **ABA-IP Law Section Ethics and Professional Resp. Committee**, 2017-18
- Named as one of **World's Leading IP Strategists** by Intellectual Asset Management, 2018
- Rated "**AV Preeminent Peer Review**" for highest level of professional excellence, 2018

EDUCATION / LICENSING:

University of Baltimore School of Law, Baltimore, MD, Juris Doctor, 1992

Magna cum laude

- Law Review and National Moot Court Competition (Team Captain)
- *American Jurisprudence* book award for highest grade in Civil Procedure, Torts, Criminal Law and Constitutional Law

University of Maryland, College Park, **Bachelor of Science** in Mechanical Engineering – 1985

Professional Admitted Bar Licenses:

- Maryland (1992), District of Columbia (1993) and Virginia (2009)
- U.S. District Courts – Maryland, District of Columbia, E.D. and W.D. Virginia
- U.S. Court of Appeals – First, Fourth, D.C. and Federal Circuits
- U.S. Supreme Court
- USPTO Registered Patent Attorney (No. 37,182, since 1993)

TEACHING / LECTURING EXPERIENCE:

Johns Hopkins University, Baltimore, MD 2014-2018

- *Guest Lecturer* – Patent Law

Antonin Scalia Law School - George Mason University, Arlington, VA 2008-2011

- *Guest Lecturer* – Advanced Patent Law
- *Adjunct Professor* – Design Patent Law

Virginia State Bar Professionalism Course, Arlington, VA 2011-2014

- *Faculty* – Annual all-day ethics course for new Virginia Bar members
- Concentrated on ethics issues for new IP lawyers

SPEECHES / PRESENTATIONS:

- *Ethical Considerations for Teleworking and Multijurisdictional Practice for the IP Lawyer*, presented at **Oregon Patent Law Association (OPLA) – Salishan Patent Law Conference**, Glenden Beach, OR (Apr. 14, 2018)
- *2018 IP Ethics and Risk Management Update*, webinar sponsored by **CNA Intellectual Property / Lawyers Professional Liability Webinar Series** (Mar. 26, 2018)
- *Ethics Before the PTAB*, presented at **2018 PTAB Bar Association Annual Conference**, Washington, DC (Mar. 23, 2018)
- *Risky Business – Ethical Issues & Professional Considerations for Young Lawyers*, webinar sponsored by **ABA-Young Lawyers Action Group (YLAG) and ABA-IP Section Ethics and Professional Responsibility Committee** (Mar. 9, 2018)

- *Brave New World: Technology Advances Create Ethical Risks for IP Attorneys*, presented at **13th Annual Advanced Patent Law Institute – The University of Texas School of Law**, Alexandria, VA (Mar. 1, 2018)
- *IP and Technology: Ethical Risks*, presented at **2018 Utah IP Summit – Intellectual Property Section of the Utah State Bar**, Salt Lake City, UT (Feb. 23, 2018)
- *Conflicts of Interest in IP Law: Ethical Problems & Their Solutions*, in-house ethics seminar presented for Pillsbury Winthrop Shaw Pittman, McLean VA (Feb. 6, 2018)
- *What Every IP Lawyer Should Know About Conflicts of Interest*, in-house ethics seminar presented for Birch Stewart Kolasch Birch, Fairfax, VA (Jan. 31, 2018)
- *Ethics Issues in PTAB Proceedings*, a 90-minute ethics webinar sponsored by the **American Intellectual Property Law Association** (Dec. 13, 2017)
- *Keeping the Lights on and the OED off Your Back: Ethical Conduct in the Practice of IP Law*, a two-hour ethics presented at **2017 Iowa State Bar Association eCommerce & Intellectual Property Seminar**, Des Moines, IA (Dec. 1, 2017)
- *Outsourcing Patent Work: Avoiding Pitfalls*, a webinar sponsored by **Intellectual Property Owners Association (IPO)** (Nov. 16, 2017)
- *Tales from the OED Crypt: Scary (and True) Stories About Ethics & Discipline at the PTO and Ethics Issues in Dealing with Foreign Associates and Foreign Clients*, two speeches presented at **IPRP 2017 Fall Seminar, Washington, D.C. (Nov. 1, 2017)**
- *Advanced Intellectual Property Ethics for the IP Practitioner*, broadcast live by **Lawline**, New York, NY (Oct. 26, 2017)
- *Ethics in the Practice of Patent and Trademark Law*, presented at **2017 American Bar Association IP Law Section IP West Program**, Long Beach, CA (Oct. 12, 2017)
- *An Intellectual Property Ethics Roundtable Discussion*, presented to **Boston Patent Law Association Ethics Committee**, Boston, MA (Oct. 2, 2017)
- *Conflicts of Interest for the IP Practitioner*, presented at **27th All Ohio Annual Institute on Intellectual Property**, Cincinnati, OH (Sept. 13, 2017) and Cleveland, OH (Sept. 14, 2017)
- *Patent Counsel Ethical Engagement and Disengagement Letters*, sponsored by **Strafford Webinars** (July 27, 2017)
- *The Ethics of Working Remotely: Preventing Problems Before They Happen*, a 90-minute webinar sponsored by the **American Intellectual Property Law Association** (June 21, 2017)

- *When Good Lawyers Go Bad: Common Ethics Mistakes by IP Practitioners*, a webinar sponsored by the **Association of Intellectual Property Firms** (June 20, 2017)
- *Identifying and Resolving Ethical Conflicts of Interest in Patent Prosecution*, a webinar sponsored by the **American Bar Association Landslide Webinar Series** (Apr. 18, 2017)
- *IP Ethics Panel Discussion*, presented at the **ABA Section of Intellectual Property Law, 32nd Annual Intellectual Property Law Conference**, Arlington, VA (Apr. 6, 2017)
- *Advice of Counsel Defense in Patent Litigation: Protecting Attorney-Client Privilege*, sponsored by **Strafford Webinars** (Mar. 16, 2017)
- *Surviving the Perfect Protostorm: An Anthology of Recent IP Malpractice Decisions*, presented at **Washington State Bar Association 22nd Annual IP Institute**, Seattle, WA (Mar. 10, 2017)
- *Bringing Home the Bacon: It's All About the Clients*, presented at **Maryland State Bar Association's Law Office Management Assistance** program, Baltimore, MD (Mar. 4, 2017)
- *Mind Your Manners! Or, Ethics and Inequitable Conduct Before the PTAB*, presented at the **PTAB Bar Association Inaugural Conference**, Washington, DC (Mar. 3, 2017)
- *Recent Developments in IP Malpractice Litigation*, presented at the **2017 Utah IP Summit CLE Symposium**, Salt Lake City, UT (Feb. 24, 2017)
- *So You Want to Live in Timbuktu? Ethical Considerations for the IP Practitioner Working in a Virtual Law Office*, presented at the **2017 American Intellectual Property Law Association – Mid-Winter Institute**, Ft. Lauderdale, FL (Feb. 4, 2017)
- *The Dangers of Dabbling: IP Ethics Issues at the USPTO*, presented at the **2016 Iowa State Bar Annual Intellectual Property Law Seminar**, Des Moines, IA (Dec. 2, 2016)
- *Ain't Misbehavin: Avoiding Ethical Problems at the USPTO*, live broadcast presented by **LawLine**, New York, NY (Oct. 28, 2016)
- *Legal Ethics for the Paraprofessional—What You Don't Know Can Hurt You*, presented at **The National Association for Legal Professionals 2016 Education Conference and National Forum**, Nashville, TN (Oct. 7, 2016)
- *Why Me? Ethical Issues in IP Law and Avoiding USPTO Discipline*, presented at **The Carolina Patent, Trademark & Copyright Law Association Fall Meeting**, Kiawah Island, SC (Sept. 23, 2016)

- *IP Ethics Panel*, presented at the **American Conference Institute Paragraph IV Master Disputes Symposium**, Chicago, IL (Sept. 20, 2016)
- *Hack This: Cyber Security Practices and Ethical Duties for IP Law Firms and Risky Business: Ethical Challenges Facing IP Law Firm Management*, two speeches presented at the **Association of Legal Administrators 2016 Intellectual Property Conference for Legal Professionals**, Washington, DC (Sept. 15, 2016)
- *Hot Ethics Topics for the Patent Practitioner*, ethics webinar sponsored by **Iowa State Bar Association** (September 13, 2016)
- *Recent Developments at the USPTO Office of Enrollment and Discipline*, presented at the **Attorneys' Liability Assurance Society Patent Consultation Group Roundtable**, Chicago, IL (August 4, 2016)
- *Legal Ethics and Professional Responsibility: Avoiding Conflicts of Interest, Maintaining Confidentiality, and other Special Concerns for the Biosimilars Space*, presented at the **American Conference Institute Biosimilars Summit**, New York, NY (June 15, 2016)
- *The Ethics of Outsourcing Legal Services and Functions*, presented at the **Practicing Law Institute 10th Annual Patent Law Institute**, San Francisco, CA (May 5, 2016) and New York, NY (Apr. 14, 2016)
- *Conflicts and Ethical Issues in IP Practice*, a two-hour ethics program presented at the **Arizona Bar IP Section Meeting, Second Annual CLE in the Gardens**, Phoenix, AZ (Apr. 8, 2016)
- *Roger Boisjoly and the Ethical Lessons Learned from the Space Shuttle Challenger Disaster*, keynote speech presented at the **2016 University of Maryland Order of the Engineer** induction ceremony, College Park, MD (Mar. 29, 2016)
- *Deja Vu All Over Again – Recurring Ethics Issues in IP Law*, a two-hour ethics CLE presented at the **Washington State Bar Association Spring 2016 IP Institute**, Seattle, WA (Mar. 11, 2016)
- *The Duty of Candor to the Tribunal*, a panel discussion moderated by Michael E. McCabe, Jr. at the George Washington University School of Law for the **Giles S. Rich American Inns of Court**, Washington, DC (Feb. 23, 2016)
- *Conflicts of Interest in Patent Prosecution after Maling v. Finnegan*, a webinar sponsored by the **Intellectual Property Owners Association** (Feb. 10, 2016)

- *Gotcha! Fee-Shifting in IP Litigation Can Trigger OED Ethics Investigation and USPTO Discipline*, presented at the **American Intellectual Property Law Association Mid-Winter Institute**, La Quinta, CA (Jan. 30, 2016)
- *Issues in IP Ethics*, presented at a meeting of the **Houston Intellectual Property Lawyer's Association**, Houston, TX (Nov. 17, 2015)
- *IP Ethics and Risk Management*, presented at **IPRP Fall 2015 Seminar**, New York, NY (Nov. 9, 2015)
- *IP Ethics – Recent Developments*, an in-house firm-wide CLE presented to **McCarter & English, LLP**, Boston, MA (Oct. 16, 2015)
- *Breaking Good—Essentials for the Ethical IP Attorney*, presented at the **American Bar Association IP Law Section Annual Meeting**, Chicago, IL (July 31, 2015)
- *Subject Matter Conflicts in IP Practice*, presented at the **Association of Professional Responsibility Lawyers Annual Meeting**, Chicago, IL (July 31, 2015)
- *Ethics in IP*, presented at a meeting of the **New Jersey Intellectual Property Law Association (NJIPLA)**, Iselin, NJ (Dec. 10, 2014)
- *Ethical Issues in Patent and Trademark Practice: A Practitioner's Guide to the USPTO's New Ethics Rules and Responding to OED Disciplinary Investigations*, presented live and by video at **Virginia CLE**, Charlottesville, VA (Apr. 4, 2013)
- *Recent Developments in Intellectual Property Prosecution and Litigation Ethics*, webinar sponsored by the **Virginia State Bar Intellectual Property Section** (May 10, 2011)
- *Recent Trends in Inducing Infringement and Divided Infringement*, webinar sponsored by **Managing Intellectual Property** (Dec. 2010)
- *The Growing Popularity of the International Trade Commission as a Preferred Forum for Enforcing U.S. Patent Rights*, presented at **Domestic Impact of Intellectual Property in a Global Economy Symposium** sponsored by University of Baltimore School of Law (Mar. 26, 2010)
- *Attorney-Client Privilege in Patent Proceedings - Strategies for Preserving Confidential Communications*, webinar sponsored by **Insurance Law and Litigation Reporter of Strafford Publications** (June 2008)
- *Navigating the Risks of Inequitable Conduct*, keynote speech presented at **CNA's Fourth Forum on Addressing the Risks of Intellectual Property Practice** (May 2007)
- *Understanding the Discovery Process in U.S. Patent Litigation*, presented at **EuroLegal Conference**, London, England (Oct. 1, 2002)

PUBLICATIONS REGARDING INTELLECTUAL PROPERTY / ETHICS:

- *Are Your Firm's Foreign Associate Practice's Ethical?*, Vol. 29, Issue 1, **Michigan IPLS Proceedings**, a quarterly journal published by the Intellectual Property Law Section of the Michigan State Bar (Feb. 2018)
- *Maryland Conflict of Interest Law*, Vol. 27, Issue 2, **DRI Happenings – The Newsletter of the Life, Health and Disability Committee** (June 7, 2016)
- *Representing Clients with Diminished Capacity*, published in **Wealth Management.com** (Oct. 19, 2015)
- *The Rat Rule in IP Litigation—A Threat to Report Another's Unethical Conduct for Strategic Advantage is Unethical and May be Illegal*, Vol. 21, No. 5, **IP Litigator** (Sept./Oct. 2015)
- *USPTO No Safe Haven for Suspended or Disbarred Attorneys*, Vol. 21, No. 4, **IP Litigator** (July/Aug. 2015)
- *Ethics are Not Just for Lawyers – The Legal Duties of Law Firm Paraprofessionals*, published in **@Law, the NALS Magazine for Legal Professionals** (Summer 2015)
- *USPTO is on the Lookout for Ethical Misconduct*, published in **Law360** (May 26, 2015)
- *IP Counsel Who Blindly Follow Client "Instructions" Risk Losing Law License*, published in Vol. 21, No. 3, **IP Litigator** (May/June 2015)
- *USPTO's New Ethics Rocket Docket for Attorney Discipline*, published in **Law360** (Oct. 30, 2013)
- *Attorney-Client Privilege and Work-Product Immunity in Patent Litigation*, chapter 17 in **The Attorney-Client Privilege in Civil Litigation – Protecting and Defending Confidentiality** (5th ed., 2012; 4th ed. 2008) (American Bar Association)
- *Recent Developments in Patent Law and their Impact on the Pharmaceutical and Biotechnology Industries*, Vol. 19, No. 2 **University of Baltimore Intellectual Property Law Journal** (Spring 2011) and speech (March 2011)
- *Richardson v. Stanley Works, Inc.*, **Maryland State Bar Association, Intellectual Property Section** (June 2010 Annual Meeting)
- *Egyptian Goddess Puts Teeth Back in US Industrial Design Rights*, **Intellectual Property Watch** (Nov. 12, 2008)

- *A Renewed Interest by the Supreme Court in the Field of Patent Law: eBay v. MercExchange and KSR v. Teleflex*, Vol. 44, No. 1 **Computer Law Reporter** (Sept. 2006) and Vol. 7 **Internet Law & Business** (Sept. 2006)
- *Look Again! Capitalizing on IP Assets*, **Trademark World: The Price of IP** (May 2006) (published in Europe)
- *May a Practitioner Both Act as a Counsel in an Interference and Testify as to His or Her Diligence In Preparing an Application?*, Vol. 13, No. 3 **Intellectual Property Today** (Mar. 2006)
- *Back in the Box - Retiring the Adverse Inference Rule*, Issue 168 **Patent World** (Dec. 2004/Jan. 2005) (published in Europe)
- *Impact of the CAFC's Knorr-Bremse Decision and Answers to Japanese Companies' Most Important Questions About Opinions of Counsel in U.S. Patent Litigation*, Vol. 54, No. 13 **Intellectual Property Management** (Dec. 2004) (translated into Japanese/published in Japan)
- *Understanding Discovery in U.S. Patent Litigation*, **Patent World**, a three-part series No. 147 (Nov. 2002); No. 148 (Dec. 2002/Jan. 2003); No. 149 (Feb. 2003/Mar. 2003)
- *Attorney-Client Privilege and Work Product Immunity in Patent Litigation*, book chapter published in Anthony B. Askew and Elizabeth C. Jacobs **2001 Intellectual Property Law Update** (Aspen Law & Business) (Jun. 2001)
- *Ethical and Local Rule Restrictions on Investigations of Potential Jurors and Post-Trial Contact with Jurors*, **ABA-IP Law Section** (Dec. 1995)

QUOTED AS LEGAL EXPERT IN MEDIA:

- *Lawyers Have an Ethical Duty to Safeguard Confidential Information in the Cloud*, **ABA Journal** (April 2018)
- *Legal Combat – When Companies Sue Their Outside Counsel, It Can Be One Brouhaha*, **Corporate Counsel** (Mar. 2018)
- *USPTO Trying Out Diversion for Struggling Practitioners*, **Bloomberg BNA** (Nov. 15, 2017)
- *Patent Office Unveils Program for Attorneys with Addiction Issues*, **Reuters Legal** (Nov. 5, 2017)
- *Did McKool Smith Violate Prosecution Bar in High-Profile Patent Case?*, **The Recorder** (Sept. 15, 2017)

- *Ex L'Oreal Atty Faces Tough Road in Wrongful Firing Case*, **IP Law360** and **Legal Ethics 360** (July 31, 2017)
- *Greenberg Traurig Agrees to Withdraw from Case in Which it was Faced with Conflict of Interest*, **The American Lawyer Daily Business Review** (May 24, 2017)
- *USPTO Suspends Former Niro Junior IP Attorney for 18 Months*, **The American Lawyer** (Mar. 6, 2017)
- *Dispute Between USPTO and Controversial Trademark Filer Ends*, **World Trademark Review** (Feb. 21, 2017)
- *IP Atty-Client Privilege Faces Challenges After Halo*, **Law360** (Jan. 20, 2017)
- *A New Front in the IP Wars*, **The American Lawyer** (Dec. 2016)
- *Is It Disrespectful to Send an Associate to Court? Maybe Not*, **Law.Com** (Sept. 27, 2016)
- *Order Disqualifying Dentons is Vacated, Leaving Verein Conflicts Issue Unresolved*, Vol. 21, No. 8 **ABA/BNA Lawyers' Manual on Professional Conduct** (Apr. 20, 2016)
- *Texas Ruling Sets High Bar for Patent Malpractice Claims*, **Law360** (Mar. 30, 2016)
- *5 Tips to Avoid IP Malpractice Suits*, **Law360** (Nov. 20, 2015)