

## **Michael Edward McCabe, Jr.**

### **McCabe Ali LLP**

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Blog: [www.IPethicsLaw.com](http://www.IPethicsLaw.com)

Website: [www.mccabeali.com](http://www.mccabeali.com)

### **LEGAL EXPERIENCE:**

Experienced counselor, advocate and expert witness in the field of Intellectual Property Law, focused on the representation of patent and trademark attorneys, registered patent agents, IP and General Practice law firms, corporate counsel, and federal government employees involving legal ethics matters and disciplinary proceedings before the U.S. Patent and Trademark Office and in state and federal court proceedings. Represented hundreds of patent and trademark practitioners in confidential ethics investigations or disciplinary proceedings brought by the USPTO Office of Enrollment and Discipline. 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-recognized 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 ethics in the practice of patent and trademark law.

### **INTELLECTUAL PROPERTY ETHICS & USPTO BAR DISCIPLINE DEFENSE:**

<b>McCabe Ali LLP</b> , Intellectual Property (IP) Ethics Law, Potomac, MD	2020 to Present
<b>McCabe Law LLC</b> , Intellectual Property (IP) Ethics Law, Potomac, MD	2017-2020

- Managing Partner and Co-Founder of 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 Officer and Director of multinational IP Law Firm to assist clients, including in-house corporate counsel and law firms, in formulating best practices within their organizations regarding risk management, avoidance of conflicts of interest, proper identification of clients, and management oversight responsibilities
- Expert in representing clients involved in USPTO Ethics Investigations and commended for detailed knowledge in unique and complex niche of ethics within IP law, including prosecution and litigation matters
- Consultant for internal law firm and corporate investigations pertaining to risk management, ethics compliance, and professional liability
- Provide expert witness consulting and testifying services on USPTO ethics rules and practices and procedures before the Office of Enrollment and Discipline (OED)
- Defend lawyers and patent agents charged with ethics violations in disciplinary enforcement actions brought by the USPTO, state and federal courts, including matters involving allegations of breach of fiduciary duty, lack of competency, unauthorized practice of law, conflicts of interest, duties to clients and courts, inequitable conduct and violation of the

duty of candor, Rule 11 violations, sanctions, disqualification motions, litigation misconduct, patent and trademark prosecution misconduct, lawyer mobility issues, personal misconduct and criminal convictions

- Recognized as dynamic speaker, authoritative commentator, and published author on ethical and legal 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 general practice law firm focused on representation of patent and trademark lawyers in ethics counseling, government investigations, and formal disciplinary proceedings against IP practitioners
- Hired by U.S. Department of Justice as Special Ethics Counsel to represent a federal government patent attorney accused by the USPTO of unethical conduct
- Publicly commended by prominent legal commentators for launching first-ever niche-focused law 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 multiple editions of reference book regarding confidentiality and the attorney-client privilege in the practice of IP law
- 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, drafted opinions relating to patent validity and infringement, and prepared and prosecuted patent applications before the USPTO
- Promoted by senior management to Risk Management Committee Chair to manage firm's functions in legal ethics, professional responsibility, risk management, and malpractice avoidance to ensure PTO, federal 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  
(Merged with Lowe, Price, LeBlanc & Becker)

1995-1999

**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

## **ENGINEERING WORK EXPERIENCE:**

**NASA / Goddard Space Flight Center**, Greenbelt, MD

1985-1989

Advanced Development and Flight Experiments Section

*Mechanical Engineer*

- Conducted ground-based and microgravity testing aboard the Space Shuttle of new types of two-phase capillary pump loop heat transfer systems for integration in the International Space Station, analyzed performance data, worked with other NASA centers, and delivered recommendations to senior NASA management
- Served as Goddard representative in collaboration with U.S. Air Force to jointly test and develop high-power spacecraft thermal management systems, and authored and presented technical paper on project results at international engineering conference

## **HONORS/AWARDS:**

- Seven-time Chair or Vice-Chair, **ABA-IP Law Section Ethics and Professional Resp. Committee** (Chair, 2018-21; Vice Chair, 2016-18 & 2021-23)
- Chair, **ABA-IP Law Section Professional Issues Division** (Aug. 2023-Present)
- Vice Chair, **ABA-IP Law Section Professional Issues Division** (2021-23)
- Chair, Ethics Subcommittee of the **American Intellectual Property Law Association Patent Agents Committee** (2021-2023)
- Appointed by ABA President to **Lawyer Assistance Programs Advisory Commission** (2023-Present)
- Liaison, **ABA Pro Bono Committee**, ABA-IP Law Section (2019-Present)
- Liaison, **SOC Committee on Ethics and Professionalism**, ABA-IP Law Section (2018-19)
- Member, **ABA Working Group** on Resolution 10A (2019)
- Pro Bono Service Honor Roll – **Virginia Access to Justice Commission of Supreme Court of Virginia** (2022-2023; 2023-2024)
- Named as one of **World's Leading IP Strategists** by Intellectual Asset Management (2018)
- Rated **"AV Preeminent Peer Review"** (2018-Present)
- **Maryland Super Lawyers** for Professional Liability: Defense (2018-Present)
- **Washington DC Best Lawyer's List** for patent and intellectual property law and litigation (2014-Present)
- Named Baltimore **"Patent Lawyer of the Year"** by *Best Lawyers* (2015)
- Awarded **"Best Legal Blog of 2016"** for niche and specialty area- *IP Ethics and Insights*

## **EDUCATION / LICENSING:**

**University of Baltimore School of Law**, Baltimore, MD, Juris Doctor, 1992 (evening division)

*Magna cum laude* (top 5%)

- Law Review Staff; U.S. National Moot Court Competition (Team Captain)

- *American Jurisprudence* book award for highest grades in Civil Procedure, Torts, Criminal Law and Constitutional Law

**University of Maryland**, College Park, MD.

Bachelor of Science in Mechanical Engineering – 1985

**Professional Licenses:**

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

**TEACHING / LECTURING EXPERIENCE:**

**Johns Hopkins University**, Baltimore, MD 2014-2020

- *Guest Lecturer* – Introduction to 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* – Appointed by Virginia Supreme Court (three 3-year terms) 2019-Present  
Teach all-day ethics course for new Virginia State Bar members in Northern Virginia. Lead specialty section on ethics in practice of patent and trademark law

**SPEECHES / PRESENTATIONS:**

- *AI in IP Practice: Ethical Considerations and Requirements*, presented at **AIPLA 2025 Spring Meeting**, Minneapolis, MN (May 15, 2025) (moderator)
- *Paragraph IV Disputes: A Scenario Based Discussion on Emerging Ethical Quandries for Hatch-Waxman Practitioners*, presented at **ACI 21<sup>st</sup> Annual Paragraph IV Disputes**, New York, NY (April 30, 2025) (panelist)
- *Innovative Risk Strategies for the Modern IP Landscape*, webinar presented at **CNA Lawyers Professional Responsibility Risk Control** (Mar. 27, 2025) (panelist)
- *Fraud With Errors: Avoiding Both Egregious and Unintentional Ethics Issues*, presented at **Alt Legal 2025 I Love Trademarks Conference**, New York, NY (Mar. 18, 2025) (speaker)
- *Ethics Issues for IP and Other Attorneys: Best Practices for Avoiding Common Mistakes*, webinar presented at **Licensing Executive Society USA & Canada** (Feb. 6, 2025) (speaker)

- *IP Protection for Athletes, Gaming and Sports Betting*, presented at **ABA 2024 Intellectual Property Section & Forum on Entertainment and Sports Industries Joint Meeting**, Las Vegas, NV (Nov. 14, 2024) (moderator and conference coordinator)
- *Latest Developments on Ethics and Discipline for the Licensing Attorney*, presented at **D.C. Chapter of Licensing Executive Society USA & Canada**, Potomac, MD (Nov. 6, 2024) (speaker)
- *Ethics and Malpractice in IP Prosecution and Litigation: Best Practices for Avoiding Trouble*, presented at **Virginia State Bar Intellectual Property Section Annual Meeting**, Richmond, VA (Oct. 18, 2024) (speaker)
- *Ethics for the Hatch-Waxman Practitioner, ACI 10<sup>th</sup> Anniversary Paragraph IV Disputes Master Symposium: The ANDA Litigation Strategy Symposium for Brand Name and Generics*, Chicago, IL (Oct. 16, 2024) (speaker)
- *Ethics Committee Panel on Duty of Candor Before USPTO*, webinar presented at **Boston IP Law Association** (Oct. 4, 2024) (speaker)
- *Ethics Considerations and Trends in Patent and Trademark Matters Before the USPTO*, webinar presented exclusively for **Johnson & Johnson** (Sept. 26, 2024) (speaker)
- **Virginia State Bar Harry L. Carrico Professionalism Course**, faculty and co-leader of IP breakout section for new VSB members, Fairfax, VA (Aug. 14, 2024)
- *Latest Developments in U.S.-China Trademark Ethics and USPTO Discipline*, presented at **Ken Port Memorial Lecture Series, Mitchell Hamline School of Law**, Saint Paul, MN (June 20, 2024) (panelist)
- *Sanctions and Discipline at the USPTO: Best Practices for Staying Out of Trouble*, presented at **2024 IP Owners Annual Spring Summit, Intellectual Property Owners Association**, Washington, D.C. (Mar. 7, 2024) (speaker)
- *The Ethics of Errors & Top 10 Tips*, webinar presented to **Cohen & Gresser LLP** (Nov. 16, 2023) (speaker)
- *Patent Prosecution Malpractice: Minimizing the Risk of Claims*, webinar presented by **Strafford** (Oct. 23, 2023) (speaker)
- *The USPTO's War Against Unauthorized Practice of Patent and Trademark Law by Foreign Associates: Best Practices for Protecting Yourself and Your Clients from Sanctions and Discipline*, presented at **ABA International Law Section Fall Conference 2023**, Yonsei University, Seoul, South Korea (Oct. 11, 2023) (moderator)

- **Virginia State Bar Harry L. Carrico Professionalism Course**, faculty and co-leader of IP breakout section for new VSB members, Alexandria, VA (Oct. 4, 2023)
- *Risk, Regulation & Resilience: Sound Strategies for Your IP Practice*, webinar hosted by **Continental Casualty Company Inc. and Herbert L. Jamison and Company, LLC** (June 22, 2023) (speaker)
- *Recent Ethics Enforcement Trends in Patent and Trademark Matters Before the USPTO*, presented at **Boston Intellectual Property Law Association Third Annual Symposium**, Boston, MA (May 4, 2023) (speaker)
- *Signing Away Your License: USPTO's Vigorous Enforcement of "Personal" Signature Rules and Pre-Filing Duties Under 37 C.F.R. 11.18*, webinar presented to **Ledig, Voit & Mayer, Ltd.** (Apr. 13, 2023) (speaker)
- *Managing IP Malpractice Risks*, presented at **2023 ABA-IP Law Section Annual Meeting**, Washington, D.C. (Apr. 12, 2023) (moderator)
- *Mentoring 101: A Guide for IP Practitioners in Any Stage of Your Career*, presented at **2023 ABA-IP Law Section Annual Meeting**, Washington, D.C. (Apr. 11, 2023) (moderator)
- **Virginia State Bar Harry L. Carrico Professionalism Course**, faculty and co-leader of IP breakout section (with Judge Michael Nachmanoff, E.D. Va.) for new VSB members, Alexandria, VA (March 14, 2023)
- *Practicing Law Across Borders: Managing Legal & Ethical Risks of Multijurisdictional Practice*, webinar presented for the **ABA-IPLS Ethics and Professional Responsibility and Law Practice Management Committees and ABA-International Law Section Life Science and Health Committee** (Mar. 13, 2023) (speaker)
- *OED's War Against Rule 11.18 Violations and the Unauthorized Practice of Law: Navigating Ethics Minefields and Avoiding USPTO Discipline*, presented at **IP Summit 2023 - Utah State Bar IP Section**, Salt Lake City, UT (Feb. 24, 2023) (speaker)
- *No Treats for You: Ethics and Malpractice Issues for IP Practitioners and Transactional Attorneys*, webinar presented for the **Licensing Executive Society** (Nov. 2, 2022) (speaker)
- *Creating and Running an Ethical IP Law Firm: A Survival Guide for Patent and Trademark Practitioners: Part I*, webinar presented for the **American Intellectual Property Law Association** (Oct. 6, 2022) (speaker)
- *Current Ethics Issues for Patent and Trademark Practitioners Before the USPTO*, presented at **33<sup>rd</sup> Annual Virginia Intellectual Property Section Seminar 2022**, Richmond, VA (Sept. 30, 2022) (speaker)

- **Virginia State Bar Harry L. Carrico Professionalism Course**, faculty and leader of IP breakout section for 2020-22 new VSB members, Alexandria, VA (Sept. 28, 2022)
- *Hot IP Ethics Issues for Patent and Trademark Lawyers at the USPTO*, presented at **47<sup>th</sup> Annual Intellectual Property Law Institute for The Institute for Continuing Legal Education of the State Bar of Michigan**, Mackinac Island, MI (July 23, 2022) (speaker)
- *Dabbling in Trademark Law: A Primer on Ethics and Malpractice Risks for the Occasional IP Practitioner*, webinar presented for the **American Bar Association Center for Professional Responsibility** (July 18, 2022) (speaker)
- *Five Things You Should Know About Running a Successful Patent Practice*, webinar presented as part of **Harrity & Harrity Minority Firm Incubator 2.0** (July 12, 2022) (speaker)
- *Current Trends in OED Actions*, webinar presented at **2022 Electronic and Computer Patent Law Summit for the American Intellectual Property Law Association** (June 16, 2022) (speaker)
- *Ethical Considerations for Life Sciences Patent Lawyers*, presented at **ACI's 20<sup>th</sup> Advanced Summit on Life Science Patents**, Harvard Club, New York, NY (June 2, 2022) (panelist)
- *Common Ethical Issues in Patent Prosecution: Conflicts and Fee Sharing*, webinar presented for the **American Intellectual Patent Law Association Patent Agents Committee** (February 17, 2022) (speaker)
- *Ethics in Trade Secret Cases and Before the USPTO*, presented at 2021 Annual Meeting of the **American Intellectual Property Law Association**, National Harbor, MD (Oct. 29, 2021) (moderator)
- *Avoiding Discipline at the USPTO: Recent Developments in Patent and Trademark Ethics*, webinar presented by **Lawline** (Oct. 25, 2021) (panelist)
- *Ethics for IP Practitioners Part II: Avoiding Discipline Before the USPTO*, webinar presented to the **22<sup>nd</sup> Annual Virginia Intellectual Property Legal Institute** (Oct. 22, 2021) (speaker)
- *Risk, Regulation & Reality – Best Practices for You and Your IP Firm*, webinar presented to **Schwegman Lundberg Woessner, P.A.** (Oct. 19, 2021) (speaker)
- *Ethics for U.S. IP Counsel Working with Foreign Associates*, webinar presented at **2021 ABA-Intellectual Property Law Section IP Fall Institute** (Sept. 30, 2021) (moderator)
- *Ethics of IP Attorney Marketing and Advertising*, webinar presented to **Alt Legal Connect 2021** (Sept. 13, 2021) (speaker)

- *Conflicts of Interest in Patent Prosecution: Ethical Problems and Their Solutions*, webinar presented to the **Japan Patent Attorney Association – American Intellectual Property Law Association Joint Meeting** (Aug. 19, 2021) (speaker)
- *Entry Into an International World: The Civil Trade Secret Case Morphs into a Criminal Trade Secret Case*, webinar presented to the **Georgia Bar IP Section** (July 13, 2021) (speaker)
- *Trademark Representation Risks: Best Practices for Reducing Malpractice and Ethics Complaints*, webinar presented for **Strafford CLE** (May 6, 2021) (speaker)
- *Current Ethics Issues and Developments for Trademark Attorneys*, webinar presented for **Snell & Wilmer LLP** (May 4, 2021) (speaker)
- *Ethics Traps for Patent Agents: Avoiding USPTO Discipline*, webinar presented for the **American Intellectual Property Law Association** (Jan. 21, 2021) (speaker)
- *Navigating Common Pitfalls in IP Practice*, webinar presented for **Oregon State Bar IP Section** (Nov. 6, 2020) (speaker)
- *Ethics Issues Relating to Working Remotely*, webinar presented for the **American Intellectual Property Law Association** (Nov. 5, 2020) (panelist)
- *Patent Prosecution Malpractice: Minimizing the Risk of Claims*, webinar presented for **Strafford CLE** (July 14, 2020) (speaker)
- *Reducing Stress and Avoiding Mistakes in the Post-COVID-19 Era*, webinar presented for the **ABA-Intellectual Property Law Section Spring CLE** (June 18, 2020) (moderator)
- *The USPTO's Focus on Declarations*, webinar presented for the **2020 ABA-Intellectual Property Law Section Annual Meeting** (June 1, 2020) (moderator)
- *Ethics for IP Lawyers*, presented at **State Bar for Arizona Sixth Annual CLE in the Garden**, Phoenix, AZ (Feb. 25, 2020) (speaker)
- *Harry L. Carrico Virginia State Bar Professionalism Course*, presented on **General Ethics and Intellectual Property Ethics**, McLean, VA (Jan. 8, 2020) (speaker)
- *Recent Developments in Patent and Trademark Ethics*, presented at **2019 Intellectual Property Law and E-Commerce Seminar, Iowa State Bar Association**, Des Moines, IA (Dec. 17, 2019) (speaker)
- *Avoiding Conflicts of Interest and Other Ethical Dilemmas on the IP Bridge*, presented at **Sixth Annual Meeting of the Center for the Protection of Intellectual Property, Antonin Scalia Law School, George Mason University**, Arlington, VA (Oct. 4, 2019) (speaker)

- *Inadvertent Disclosure and Waiver of Privilege: Legal and Ethical Dilemmas for the IP Practitioner*, presented at the **American Bar Association IP Law Section Fall Meeting**, San Antonio, TX (Oct. 3, 2019) (speaker)
- *2019 IP Ethics and Risk Management Update, Avoiding Common Conflicts of Interest in IP Law Practice*, webinar sponsored by **CNA Intellectual Property / Lawyers Professional Liability Webinar Series** (June 26, 2019 and Sept. 27, 2019) (speaker)
- *Navigating Conflicts and Other Ethical Dilemmas in IP Law Practice*, in-house CLE presented to **McDonnell Boehnen Hulbert & Berghoff LLP**, Chicago, IL (June 21, 2019) (speaker)
- *Ethics Issues for IP Counsel Working Through Foreign Associates and Intermediaries*, in-house CLE presented to **Loeb & Loeb LLP**, Chicago, IL (June 20, 2019) (speaker)
- *Navigating Conflicts of Interest in Patent and Trademark Law*, webinar presented to the **Virginia State Bar Intellectual Property Law Section** (May 9, 2019) (speaker)
- *Trademark Representation Risks: Best Practices for Reducing Malpractice and Ethics Complaints*, webinar sponsored by **Strafford CLE** (May 8, 2019) (speaker)
- *Intellectual Property Malpractice – The Parade of Horribles*, presented via phone to the **Tennessee Intellectual Property Law Association 2019 Spring Symposium**, Nashville, TN (May 3, 2019) (speaker)
- *Ethics for the IP Practitioner*, presented at the **Washington State Bar Association 24<sup>th</sup> Annual Intellectual Property Institute**, Seattle, WA (Apr. 17, 2019) (speaker)
- *The Rocks and Hard Places for IP Practitioners*, presented at **2019 ABA-IP Law Annual Meeting and 34<sup>th</sup> Annual Intellectual Property Law Conference**, Arlington, VA (Apr. 12, 2019) (moderator)
- *Disqualification: Lessons from Recent Cases*, webinar sponsored by **IPO Chat Channel** (Apr. 10, 2019) (speaker)
- *Introduction to Patent Law*, guest lecture at **Johns Hopkins University – Carey Business School**, Baltimore, MD (Apr. 3, 2019) (speaker)
- *2019 IP Ethics and Risk Management Update, Avoiding Common Conflicts of Interest in IP Law Practice*, webinar sponsored by **CNA Intellectual Property / Lawyers Professional Liability Webinar Series** (Mar. 27, 2019) (speaker)
- *Patent Prosecution Malpractice: Minimizing the Risk of Claims*, webinar sponsored by **Strafford CLE Webinars** (Feb. 21, 2019) (speaker)

- *Attorney Wellness and Competency*, moderator of panel discussion, presented to **the Giles S. Rich American Inns of Court and the George Washington University School of Law**, Washington, D.C. (Feb. 19, 2019) (moderator)
- *Getting Physical: The Ethics of Attorney-Client Sexual Relations*, presented at **2019 AIPLA Mid-Winter Institute**, Tampa, FL (Feb. 2, 2019) (speaker)
- *2018 IP Ethics and Risk Management Update*, webinar sponsored by **CNA Intellectual Property / Lawyers Professional Liability Webinar Series** (Dec. 12, 2018) (speaker)
- *The Ethics of Legal Process Outsourcing for the IP Attorney*, presented to **Cincinnati Intellectual Property Law Association**, Cincinnati, OH (Dec. 11, 2018) (speaker)
- *No Candy for You: Tricky Ethics Issues for IP Lawyers*, presented at **UT Law 23<sup>rd</sup> Annual Advanced Patent Law Institute**, Austin, TX (Nov. 1, 2018) (speaker)
- *Conflicts of Interest in Intellectual Property Law*, presented at **Intellectual Property Owners Association Annual Meeting**, Chicago, IL (Sept. 25, 2018) (speaker)
- *2018 IP Ethics and Risk Management Update*, webinar sponsored by **CNA Intellectual Property / Lawyers Professional Liability Webinar Series** (Sept. 6, 2018) (speaker)
- *The 7 Habits of Highly Ethical IP Lawyers*, presented at **13<sup>th</sup> Annual Door County (Wisconsin) Intellectual Property Academy**, Sturgeon Bay, WI (July 19, 2018) (speaker)
- *Exploring Ethical Requirements When Working Through the Patent and Trademark Practice*, presented at **ACI's 4<sup>th</sup> Annual Post Grant PTO Proceedings**, Washington, D.C. (July 18, 2018) (speaker)
- *Evaluating Ethical Concerns for the Biosimilars Industry*, presented at **ACI's 9<sup>th</sup> Annual Summit on Biosimilars**, New York, NY (June 26, 2018) (speaker)
- *Ethical Issues for IP Lawyers*, in-house ethics seminar presented for **Hauptman Ham, LLP**, Alexandria, VA (May 30, 2018) (speaker)
- *2018 IP Ethics and Risk Management Update*, webinar sponsored by **CNA Intellectual Property / Lawyers Professional Liability Webinar Series** (May 21, 2018) (speaker)
- *Social Media Policies for Law Firms*, presented at the **ABA Section of Taxation 2018 Annual Meeting**, Washington, D.C. (May 12, 2018) (speaker)
- *Multijurisdictional Practice and the Modern IP Attorney*, presented at the **ABA-IP Law Section 33<sup>rd</sup> Annual Intellectual Property Law Conference**, Arlington, VA (Apr. 19, 2018) (speaker)

- *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) (speaker)
- *2018 IP Ethics and Risk Management Update*, webinar sponsored by **CNA Intellectual Property / Lawyers Professional Liability Webinar Series** (Mar. 26, 2018) (speaker)
- *Ethics Before the PTAB*, presented at **2018 PTAB Bar Association Annual Conference**, Washington, DC (Mar. 23, 2018) (speaker)
- *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) (speaker)
- *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) (speaker)
- *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) (speaker)
- *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) (speaker)
- *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) (speaker)
- *Ethics Issues in PTAB Proceedings*, a 90-minute ethics webinar sponsored by the **American Intellectual Property Law Association** (Dec. 13, 2017) (speaker)
- *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) (speaker)
- *Outsourcing Patent Work: Avoiding Pitfalls*, a webinar sponsored by **Intellectual Property Owners Association (IPO)** (Nov. 16, 2017) (speaker)
- *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) (speaker)
- *Advanced Intellectual Property Ethics for the IP Practitioner*, broadcast live by **Lawline**, New York, NY (Oct. 26, 2017) (speaker)

- *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) (speaker)
- *An Intellectual Property Ethics Roundtable Discussion*, presented to **Boston Patent Law Association Ethics Committee**, Boston, MA (Oct. 2, 2017) (speaker)
- *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) (speaker)
- *Patent Counsel Ethical Engagement and Disengagement Letters*, sponsored by **Strafford Webinars** (July 27, 2017) (speaker)
- *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) (speaker)
- *When Good Lawyers Go Bad: Common Ethics Mistakes by IP Practitioners*, a webinar sponsored by the **Association of Intellectual Property Firms** (June 20, 2017) (speaker)
- *Identifying and Resolving Ethical Conflicts of Interest in Patent Prosecution*, a webinar sponsored by the **American Bar Association Landslide Webinar Series** (Apr. 18, 2017) (speaker)
- *IP Ethics Panel Discussion*, presented at the **ABA Section of Intellectual Property Law, 32nd Annual Intellectual Property Law Conference**, Arlington, VA (Apr. 6, 2017) (speaker)
- *Advice of Counsel Defense in Patent Litigation: Protecting Attorney-Client Privilege*, sponsored by **Strafford Webinars** (Mar. 16, 2017) (speaker)
- *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) (speaker)
- *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) (speaker)
- *Mind Your Manners! Or, Ethics and Inequitable Conduct Before the PTAB*, presented at the **PTAB Bar Association Inaugural Conference**, Washington, DC (Mar. 3, 2017) (speaker)
- *Recent Developments in IP Malpractice Litigation*, presented at the **2017 Utah IP Summit CLE Symposium**, Salt Lake City, UT (Feb. 24, 2017) (speaker)

- *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) (speaker)
- *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) (speaker)
- *Ain't Misbehavin: Avoiding Ethical Problems at the USPTO*, live broadcast presented by **LawLine**, New York, NY (Oct. 28, 2016) (speaker)
- *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) (speaker)
- *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) (speaker)
- *IP Ethics Panel*, presented at the **American Conference Institute Paragraph IV Master Disputes Symposium**, Chicago, IL (Sept. 20, 2016) (speaker)
- *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) (speaker)
- *Hot Ethics Topics for the Patent Practitioner*, ethics webinar sponsored by **Iowa State Bar Association** (September 13, 2016) (speaker)
- *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) (speaker)
- *Legal Ethics and Professional Responsibility: Avoiding Conflicts of Interest, Maintaining Confidentiality, and other Special Concerns for the Biosimilars Space*, presented at the **ACI Biosimilars Summit**, New York, NY (June 15, 2016) (speaker)
- *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) (speaker)
- *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) (speaker)

- *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) (keynote speaker)
- *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) (speaker)
- *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) (moderator)
- *Conflicts of Interest in Patent Prosecution after Maling v. Finnegan*, a webinar sponsored by the **Intellectual Property Owners Association** (Feb. 10, 2016) (speaker)
- *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) (speaker)
- *Issues in IP Ethics*, presented at a meeting of the **Houston Intellectual Property Lawyer's Association**, Houston, TX (Nov. 17, 2015) (speaker)
- *IP Ethics and Risk Management*, presented at **IPRP Fall 2015 Seminar**, New York, NY (Nov. 9, 2015) (speaker)
- *IP Ethics – Recent Developments*, an in-house firm-wide ethics seminar presented to **McCarter & English, LLP**, Boston, MA (Oct. 16, 2015) (speaker)
- *Breaking Good—Essentials for the Ethical IP Attorney*, presented at the **American Bar Association IP Law Section Annual Meeting**, Chicago, IL (July 31, 2015) (speaker)
- *Subject Matter Conflicts in IP Practice*, presented at the **Association of Professional Responsibility Lawyers Annual Meeting**, Chicago, IL (July 31, 2015) (speaker)
- *Ethics in IP*, presented at a meeting of the **New Jersey Intellectual Property Law Association (NJIPLA)**, Iselin, NJ (Dec. 10, 2014) (speaker)
- *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) (speaker)
- *Recent Developments in Intellectual Property Prosecution and Litigation Ethics*, webinar sponsored by the **Virginia State Bar Intellectual Property Section** (May 10, 2011) (speaker)

- *Recent Trends in Inducing Infringement and Divided Infringement*, webinar sponsored by **Managing Intellectual Property** (Dec. 2010) (speaker)
- *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) (speaker)
- *Attorney-Client Privilege in Patent Proceedings - Strategies for Preserving Confidential Communications*, webinar sponsored by **Insurance Law and Litigation Reporter of Strafford Publications** (June 2008) (speaker)
- *Navigating the Risks of Inequitable Conduct*, keynote speech presented at **CNA's Fourth Forum on Addressing the Risks of Intellectual Property Practice** (May 2007) (keynote speaker)
- *Understanding the Discovery Process in U.S. Patent Litigation*, presented at **EuroLegal Conference**, London, England (Oct. 1, 2002) (speaker)

#### **PUBLICATIONS REGARDING INTELLECTUAL PROPERTY / ETHICS:**

- Michael E. McCabe, Jr., *The Lawyers' Social Contract: The Ethical Ties that Bind the Legal Profession*, Vol. 16, Issue 4, ABA Section of Intellectual Property **Landslide Magazine** (July/Aug 2024)
- Michael E. McCabe, Jr. and Tracy L. Kepler, *Dibble Dabble Double Trouble: Mitigating the Risks of Dabbling in Your Law Practice*, 2023 Issue 3, **In Practice . . . with CNA – A Practitioner's Perspective on Emerging Legal Trends** (June 2023)
- Co-creator of *Creating and Running an Ethical IP Law Firm: A Survival Guide for Patent and Trademark Practitioners*, a monthly webinar series sponsored by the **American Intellectual Property Law Association** (first part presented Oct. 6, 2022)
- Michael E. McCabe, Jr. and Emil J. Ali, *Balancing Newly Divergent State, USPTO Ethics Rules*, co-authored by, published in **Law360** (Sept. 23, 2020)
- Michael E. McCabe, Jr., *Avoiding USPTO Discipline: Five Recommendations for Patent Agents*, Vol. 2, Issue 3, **The Agent**, an AIPLA Patent Agents Committee Publication (Sept. 18, 2020)
- Michael E. McCabe, Jr., *5 Things IP Practitioners Should Do to Avoid U.S. Patent and Trademark Office Discipline*, **NWSidebar**, a publication of the Washington State Bar Association (July 22, 2019)
- Michael E. McCabe, Jr., *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)
- Michael E. McCabe, Jr., *Representing Clients with Diminished Capacity*, published in **Wealth Management.com** (Oct. 19, 2015)
- Michael E. McCabe, Jr., *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)
- Michael E. McCabe, Jr., *USPTO No Safe Haven for Suspended or Disbarred Attorneys*, Vol. 21, No. 4, **IP Litigator** (July/Aug. 2015)
- Michael E. McCabe, Jr., *Ethics are Not Just for Lawyers – The Legal Duties of Law Firm Paraprofessionals*, published in **@Law, the NALS Magazine for Legal Professionals** (Summer 2015)
- Michael E. McCabe, Jr., *USPTO is on the Lookout for Ethical Misconduct*, published in **Law360** (May 26, 2015)
- Michael E. McCabe, Jr., *IP Counsel Who Blindly Follow Client “Instructions” Risk Losing Law License*, published in Vol. 21, No. 3, **IP Litigator** (May/June 2015)
- Michael E. McCabe, Jr., *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; 4<sup>th</sup> 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)
- Michael E. McCabe, Jr., *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)
- **IPethics & INsights**, a law blog published by McCabe Ali LLP and predecessor organizations (2014-present), [www.ipethicslaw.com](http://www.ipethicslaw.com)

#### **QUOTED AS LEGAL AUTHORITY IN MEDIA:**

- “One Firm” or Separate Entities? Vereins’ Growth Bumps into Conflicts, Liability Concerns, **Law.com** (Feb. 23, 2024)
- *Coke’s Quest to Disqualify Paul Hastings Faces Big Hurdles*, **Law.com** (May 3, 2023)
- *IP Ethics Atty Urges Justices to Take Up Standards Case*, **Law360** (Jan. 5, 2021)
- *The Biggest Legal Ethics Moments of 2020*, **Law 360** (Dec. 11, 2020)
- *IP Firm Founders Predict “Onslaught” of Ethics Issues for Lawyers Under Pressure*, **Reuters** (Aug. 12, 2020)
- *Full Fed. Circ. Asked to Rethink Voiding IP in Ethanol MDL*, **Law360** (Apr. 15, 2020)
- *Fed. Cir. Inequitable Conduct Case Alarms IP Ethics Attys*, **Law360** (Mar. 11, 2020)

- *\$32M Dentons Verdict Could Put Vereins in the Crosshairs*, **Law360** (Feb. 25, 2020)
- G. W. Jordan III, *A New Frontier in Patent Bar Ethics*, Vol. 12, No. 2, **ABA Section of Intellectual Property Law Landslide Magazine** (November/December 2019)
- *Patent Lawyer Fights Identity Theft Over Fraudulent USPTO Filings from China*, **Corporate Counsel** (Mar. 4, 2019)
- *How Law Firms Can Avoid Conflicts Involving Corporate Affiliates*, **Law360** (Mar. 1, 2019)
- *Lawyers Warn Employees About Social Media Use*, **Bloomberg Law** (Sept. 11, 2018)
- *Drafting and Implementing Social Media Policies for Law Firms*, **Bloomberg Law** (May 30, 2018)
- *California Adopts Modified ABA Model Rules*, **Bloomberg Law** (May 11, 2018)
- *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)

### **PRIOR TESTIMONY**

Expert Trial Testimony (March 23, 2023); Expert Deposition (June 21, 2022); and Expert Report (June 14, 2022) in **Thomas Ward** v. *Commscope, Inc.*, Case No. 3:21-CV-370-H-DEB, United States District Court for the Southern District of California

Expert Deposition Testimony (Dec. 9, 2022); Supp. Expert Report (Oct. 29, 2022); Expert Report (Jan. 8, 2022) in *Inexian Corporation, f/k/a Plowshare Technologies, Inc. v. Venable LLP*, Case No. 24-C-21-00200, Baltimore City Circuit Court

Expert Declaration in *The Florida Bar v. John H. Faro*, Case No. SC18-1279, Supreme Court of Florida (Dec. 3, 2020)

Trial Testimony (non-expert) in *Attorney Grievance Comm'n of Maryland v. Samuel Sperling et al.*, Misc. Docket AG Nos. 40 & 76, before Judge H. Patrick Stringer, Circuit Court of Baltimore County, Maryland (Aug. 22, 2017), appointed by Maryland Court of Appeals, decision of the Maryland Supreme Court published at 459 Md. 194, 185 A.3d 76 (May 21, 2018)

Deposition Testimony (non-expert) in *Attorney Grievance Comm'n of Maryland v. Samuel Sperling, et al.* Misc. Docket AG Nos. 40 & 76, Circuit Court of Baltimore County, Maryland (April 10, 2017)