

Legal and Practical Knowledge to Help Attorneys Meet Patent Application Filing Deadlines and Avoid Committing Malpractice

By Rick Neifeld, Neifeld IP Law, PC¹

I. INTRODUCTION

Truth be told, I have been wanting to write this paper for some time. I thank Margaret Polson for asking me to speak on this subject in an AIPLA Webinar, which prompted me to act.

It's a sad but true fact that attorneys belatedly file patent applications. By belatedly file, I mean file after a deadline resulting in loss of either rights to an invention, or rights to priority/benefit to an earlier filing date. Priority/benefit rights refer to the right to the filing date of an earlier filed application for the same invention commonly disclosed in both the earlier filed application and the later filed application. Benefit refers to this right for a United States patent application, as specified in 35 USC 119(e) for provisional applications and as specified in 35 USC 120 for nonprovisional applications. Priority refers to the right to the filing date of an earlier filed foreign application, as specified in 35 USC 119(a).

Scope of Problem

More than two patent applications in every thousand are belatedly filed. This statistic is based upon factual information conveyed to me by Michael Richardson, of the International Bureau ("IB") and by Charles Pearson, of the USPTO. Mr. Richardson identified the number of notices of decisions on requests for restoration of priority in PCT applications issued annually (as indicated by the presence in PCT applications of form PCT/RO/159). Mr. Pearson provided anecdotal evidence of the numbers of petitions filed in the USPTO attempting to recover priority or benefit rights.

The number of requests for restoration of priority in PCT applications is a good indicator of the overall rate of missed filing deadlines. This is because each request for restoration of priority in a PCT application identifies a PCT application in which a deadline for a priority right was missed. Not all PCT applications in which such a filing deadline is missed will result in a request for restoration. Therefore, the number of PCT applications in which such a request is filed sets a minimum on the number of missed filing deadlines for PCT applications.

According to Mr. Richardson, the Receiving Offices (ROs) of China (RO/CN) and the United States (RO/US) are the ROs in which the largest number of requests for restoration are filed. This indicates objectively that United States patent attorneys are not immune to application filing errors.

As I explain herein, despite recent changes in the law, it is still not possible to recover all rights lost by missing a foreign priority deadline. Consequently, knowing how to certainly meet those deadlines is a very important aspect of practice.

Perspective from IB and USPTO Officials

The IB and USPTO officials I spoke with identified the following kinds of errors relating to application filings.

First and foremost are missed deadlines for entitlement to benefit or priority.

Second, are defects upon initial filing. These defects may also result in missed benefit or priority when they are defects in completion of the disclosure or that result in subsequent withdrawal or abandonment of the application.

One initial filing defect is filing incorrect parts of applications, such as the filing of an application with the wrong drawings. One initial filing defect is mis-designation of a US national entry of a PCT application (371 filing) as a United States non-provisional application (111(a) filing), and vice versa. These mis-designations may result in loss of rights, for example when the filed specification includes new matter relative to a prior PCT filing.

Another initial filing defect is failure of the practitioner to properly sign the Application Data Sheet (ADS). Specifically, applications are filed with putative ADSs in which either there is no signature, or there is a defective S signature, such as a signature lacking one or both slashes ("/"). These putative ADS are treated by the USPTO as transmittal letters and do not result in the USPTO recognizing certain data in the putative ADS, such as applicant identity or priority/benefit claims.

Third, are also failures to respond to post filing requirements. One type of failure to respond resulting in withdrawal of a PCT application occurs if a PCT application is filed in the RO/US, but the applicant fails to pay the required fees when filing. In this situation, the RO/US will send notices to the applicant requiring fee payment. If the RO/US receives no response, then it will eventually hold the PCT application withdrawn (aka abandoned). One reason why these abandonments occur may be related to how the RO/US communicates with the applicant. The RO/US communicates with applicants only by postal mail. To avoid doubt, even in if the user identifies a USPTO customer number when filing the PCT application, the RO/US does not use the USPTO's customer number based email notification system to convey notices to the applicant.² If the postal address specified at time of filing a PCT application filed in the RO/US is incorrect, the applicant may not get the follow-up notices and not respond to those notices. When this happens, the RO/US eventually holds the PCT application to be withdrawn.

A "Bad Place" Fact Pattern

I have seen missed filing dates based upon each of the kinds of legal and factual issues I discuss below. By way of example, I copy below the text of an email posted on a patent attorney list service in February, 2017. This email identifies "a bad place" for an IP owner. It is a worse place for the patent practitioner.

I perfected a U.S. Provisional by filing a PCT on the one-year anniversary (RO = US). Unfortunately, I didn't notice that some of the drawings became completely blacked-out when converted to pdf, so the PCT includes some drawings that look like big black squares. (These drawings were not in the provisional.). *** Should I bother trying to get the correct drawings at this time? Would I have the option of doing so later (such as upon national stage entry, and if so how) if I don't do so now? Do I risk not being able to get them in later if I try to do so now and am denied? If I can't or shouldn't bother trying to submit corrected drawings now, what would be the appropriate way to respond to the invitation?

The problems typified by this communication could have and should have been avoided. They can be partially redressed by appropriate action, but not by the actions proposed in the post. Rather than analyze this fact pattern now, I first discuss useful knowledge to help meet filing deadlines. Then I will return to this fact pattern.

Professionalism, Legal Knowledge and Client Communication

Bar members are supposed to adhere to certain rules of professionalism. I cast the rest of this paper in the context of these rules, because complying with these rules in the practice of application filings will go a long way to avoiding belated application filings.³

II. Relevant Legal Knowledge For the Representation

ABA model rule and VA rule of professional conduct 1.1, and USPTO rule 11.101, require a BAR member to be competent, which includes having legal knowledge necessary for the representation. What I cover in the rest of this section is legal knowledge necessary for representation in patent application filings.

Paris Convention

The Paris Convention for the Protection of Industrial Property ("Paris Convention") is a fundament of international patenting. The Paris Convention provides for the right, in an application filed in a second country, to the filing date of an earlier application for the same subject filed in a different first country. I refer to this right as the Paris priority right. Entitlement to Paris priority right is subject to certain requirements. Other international treaties have incorporated the Paris priority right, including the Patent Cooperation Treaty (PCT) and the Hague Agreement Concerning the International Registration of Industrial Designs (Hague Agreement). These treaties are all now administered by the World Intellectual Property Organization (WIPO).

I cover some of the less well known requirements to be entitled to the Paris priority right.

Who is Entitled to the Paris Priority Right - Paris Article 4(A)(1)

Paris Article 4(A)(1) states that:

Any person who has duly filed an application for a patent, or for the registration of a utility model, or of an industrial design, or of a trademark, in one of the countries of the Union, or his successor in title, shall enjoy, for the purpose of filing in the other countries, a right of priority during the periods hereinafter fixed.

This provision limits the Paris priority right to "Any person... or his successor in title" who duly filed an application. What this means has been adjudicated. See *Edwards Lifesciences AG v. Cook Biotech Inc.*, (UK Patents Court, 2009); EPO BOA T62/05; and EPO BOA T 788/05. These cases stand for the proposition that the priority right is unitary in the applicant. Consequently, a subsequent filing for the same subject matter as the earlier filing is entitled to

the priority right only if the subsequent filing is filed by the applicant who filed the earlier filing, or some combination of legal entities that includes the applicant that filed the earlier application. In addition, these cases stand for the proposition that the right to priority must be vested in the applicant of the later filed application, *at the time the later filed application is filed*. In the case of assignment of rights from the first applicant, the legal transfer of ownership must have occurred prior to when the second application was filed. In other words, an assignment of ownership from the applicant of the first application to the applicant of the second application that transfers title after the second application has been filed does not entitle the second application to the right of priority to the first application.

Resetting the Paris Priority Period - Paris Article 4(C)(4)

Note that the Paris priority period for utility patents (as opposed to industrial designs and trademarks) is 12 months. PCT Article 4(C)(1).

Under certain very limiting conditions the Paris priority right can be reset so that it begins at a date later than the filing date of a first application disclosing an invention. That is, under certain limited conditions, the date of filing of the first application for the invention may no longer be deemed legally the start of the Paris priority period. However you should keep in mind that this is a narrow exception, and that this exception was added to the Paris Convention long after its inception. And that this exception was added to the Paris Convention in order to deal with a specific situation, was contentious and subject to several proposals, and that the final language of Paris article 4(C)(4) should be construed in view of the proposals submitted and rejected, in addition to the ultimate language providing this exception. Paris article 4(C)(4) specifies this exception.⁴

Paris article 4(C)(4) states that:

A subsequent application concerning the same subject as a previous first application within the meaning of paragraph (2), above, filed in the same country of the Union shall be considered as the first application, of which the filing date shall be the starting point of the period of priority, if, at the time of filing the subsequent application, the said previous application has been withdrawn, abandoned, or refused, without having been laid open to public inspection and without leaving any rights outstanding, and if it has not yet served as a basis for claiming a right of priority. The previous application may not thereafter serve as a basis for claiming a right of priority.

This provision specifies that the Paris priority period starts on “**the date of filing of the first application,**” unless “**at the time of filing the subsequent application,**” the first application “has been **withdrawn, abandoned, or refused,**” and has not been “laid open to public inspection and without leaving any rights outstanding, and if it has not yet served as a basis for claiming a right of priority.” Commentators have opined on the meaning of the Paris Convention Article 4(C)(4).⁵

The fact pattern below shows what happens if one fails to realize that the Paris priority deadline normally runs from the filing date of a provisional application even when priority to the provisional application is not claimed. To illustrate the failing, consider the following fact

pattern. The graphic shows a time line of filings in temporal sequence. There is a provisional application, Prov1, a second application, App2, and then a PCT application, PCT3.



PCT3, App2, and Prov1, all disclose the same invention, and that invention is claimed in PCT3. PCT3 is filed with a claim to priority under the Paris Convention, to App2.

The Paris priority claim in PCT3, for the claimed invention, is invalid. This is because the Paris priority period (which is 12 months for patents) started at T=0 date of filing of Prov1, and ended 12 months thereafter, and PCT3 was not filed within 12 months of Prov1. Therefore, PCT3 is not entitled to priority of App2 for its claimed invention. To avoid doubt, the filing date of App2 is not the start of the Paris priority period for the claimed invention. This is *at least* because, when App2 was filed, Prov1 was pending. Therefore, when App2 was filed, Prov1 did not meet the Paris Article 4(C)(4) requirement that Prov1 was "**withdrawn, abandoned, or refused.**" Meeting this requirement is one condition necessary to reset the Paris priority period to start upon the filing of App2.

To avoid doubt, the fact that the PCT application was filed within 12 months of the filing of App2 is not relevant, and the fact that Prov1 was abandoned prior to when the PCT application was filed is not legally relevant.

Restoration of Priority (for Missed Filing Deadlines)

Restoration of priority refers to the concept of being entitled to priority even though a filing date is outside the time period normally entitled to the priority date of a prior filing. The Patent Law Treaty (PLT) which came into existence about twenty years ago provides for restoration of priority under limited circumstances. The concept of restoration is that, if an applicant intends to, but fails to, file within the priority period, the applicant may be entitled to priority, effectively extending the priority period. That is what restoration refers to. The conditions under which the priority period can be restored, as a result of a belated filing, are limited.

In 2012, the United States acceded to the Patent Law Treaty (PLT).⁶ There are now 39 contracting parties to the PLT. PLT Article 3 requires contracting parties to provide for restoration of priority.

Types of Application in Which Priority Can be Restored

PLT Article 3 (1) provides for restoration of priority in national and regional applications for patents for invention, in their divisions, and in PCT applications. PLT Article 3 (1). PLT Article 3 (2) provides for restoration of priority in the corresponding patents.

Time Limits Applicable to Restoration

PLT Articles 13 and 14 provide minimum time limits in which an applicant must act to

restore priority. PLT Article 13(2); rule14(4)(a) require the belatedly filed application to be filed within 2 months of the expiration of the priority period. PLT Article 13(2); rule14(4)(a). PLT Article 13(2)(ii); rule 14(4)(b) (generally) require the request for restoration of priority to be filed within 2 months from expiration of the priority period.

PLT Article 12(1) provides requirements for a request to restore priority.

Office Findings Required For Restoration

PLT Article 12(1)(iii) provides that the request to restore priority must state the reasons for the failure to comply with the Paris time limit.

PLT Article 12(1)(iv) provides that the Office (deciding the request to restore priority) must restore priority if it finds that the failure to comply with the time limit occurred in spite of due care required by the circumstances having been taken.

PLT Article 12(1)(iv) also provides that the Office (deciding the request to restore priority) may restore priority if it finds that any delay was unintentional.

The criteria specified in regulations and the Office's analysis of requests for restoration indicate that the "in spite of due care" finding requires a showing that is equivalent to the showings that used to be required in the USPTO for a finding of unavoidable delay. The criteria for an Office to find the delay was in spite of due care are exacting, and very difficult to meet. On the other hand, a showing that the delay was unintentional is normally very easy to meet.

Restoration Availability and Available Standard

Not all countries provide for restoration of priority. Of those countries that do provide restoration of priority, not all will restore based upon a finding that the delay was unintentional. In other words, restoration of priority is, at best, a partial remedy for a missed priority date. The following chart shows information compiled from WIPO's web site regarding availability of restoration in the RO's of major patenting jurisdictions.

PCT Receiving Office	RO may find failure was "in spite of due care"/grant restoration under this standard	RO may find failure was unintentional/grant restoration under this standard	RO Fee For Request to Restoration
RO/USA	NO	YES	USD 1700
RO/IB	YES	YES	NO
RO/EP	YES	NO	EUR 640
RO/CN	YES	YES	CNY 1000
RO/JP	YES	NO	NO
RO/BR	NO	NO	N/A
RO/IN	NO	NO	N/A
RO/AU	YES	YES	AUD 200
RO/CA	YES	YES	NO
RO/MX	YES	NO	NO

This chart shows that the ROs of India and Brazil do not provide for restoration. The last time I checked with my Indian and Brazilian counterparts, neither country had any provision for restoring priority. On the other hand, this chart shows that the ROs of Australia, Canada, China, and the US will restore priority based upon a finding that the delay in filing was unintentional. However, this chart shows that the EPO, Japan, and Mexico require a finding that the delay meets the higher "due care" standard.

For those Offices that consider both the due care and unintentional standard, and may find that either is satisfied, normally a request for restoration under the due care standard will be deemed a request for restoration under the unintentional standard, if the Office finds that the requirements for due care were not met. This is certainly true for RO/IB.

The USPTO jettisoned its unavoidable standard for petitions years ago, in order to streamline its activities and avoid having the burden of having to decide fact intensive patterns unrelated to patentability. So now the USPTO will only consider procedural matters under an unintentional standard, but normally charges a substantial fee to grant procedural relief. That is the case for a request to restore priority filed in the USPTO. The USPTO will charge a hefty fee to consider a request for restoration. And the USPTO will only find that the delay was unintentional. A substantial drawback to filing a belated PCT in RO/US is that filing in RO/US precludes a finding under the due care standard. Therefore, a restoration granted by RO/US will never be sufficient to restore priority in Offices which require a finding due care, such as the European Patent Office (EPO) and Japan Patent Office (JPO).

If a United States applicant or resident misses a PCT priority filing date, then the best course of action is for them to obtain a foreign filing license for the PCT application, and then ePCT file that application with RO/IB. This has the benefits of avoiding the hefty USPTO fee and entitling the filer to the possibility of RO/IB restoring priority with a finding due care, so that this restoration will be effective in all Offices requiring either that higher standard or the lower unintentional delay standard. (Under PCT rule 48, applicants have another shot at restoring priority in each Designated Office (DO) upon national stage entry, but that would require a request to restore priority in each DO in which the restoration before the RO was insufficient.)

US National Implementation of PLT

The US has implemented the PLT in various statutory sections to cover all utility and design applications, for claims to both foreign priority and benefit of a United States provisional application. Here is a list by application type and corresponding statutory section.

Application Type	35 USC Section providing for restoration
111(a) claim to Paris priority	35 USC 119(a)
111(a) claim to Provisional benefit	35 USC 119(e)(1)
PCT claim to Paris priority	35 USC 365(e)
Design claim to Paris priority	35 USC 171(b)

The Legal Deadline is not The Attorney Deadline

If I had one thing I could change about the practice of every patent practitioner, it would be the misguided view that there is only a legal deadline, ignoring the fact that there are also attorney deadlines. By attorney deadline, I mean a date that the attorney determines, in view of the totality of the circumstances, after which they cannot guarantee meeting a legal deadline. There is at least one attorney deadline. Each attorney should determine what their deadlines are and communicate these deadlines to the client.

A major cause for patent attorneys missing filing deadlines is that they wait until a time too close to the filing deadline, to try to file the application. Knowing the attorney deadlines and communicating the attorney deadlines to the client are critically important to avoiding loss of client rights, and avoiding committing malpractice.

For determining an attorney deadline, consider two things. First attorneys ability to meet the deadline and the factors that are involved in that ability. Second, the time required, after a filing, to discover and correct any critical errors that may have occurred during filing.

Here is a laundry list of factors relevant to meeting the filing deadline which any attorney should consider in determining their attorney deadline: Reliability of electrical power; Internet; filing website; computer; crypto certificates and passwords; printer; transportation; redundancy of any and all of the foregoing.

Determining critical errors that occurred in a filing is also important because timely identification of those errors may allow a cure before a time bar arises. Many of the fact patterns I have seen involved the attorney recognizing a critical filing error, but recognizing that error after the priority date had passed. That is at a time which is too late to cure the error. I see these post filing errors being identified in two different ways. First, the attorney reviews the documents actually filed and discovers the error from that review. Second, the officials reviewing the filed application identify the error and issue a notice information the attorney of the error. Applications on file are now normally available in PAIR or ePCT in less than one working day. My review of my firm's data shows that RO/IB and RO/US notify PCT filers of filing errors in under 2 weeks, and USPTO notifies 111(a) filers in under 4 weeks.

III. CLIENT COMMUNICATIONS

ABA model rule and VA rule of professional conduct rule 1.4, and USPTO rule 11.104 require BAR members to keep a client reasonably informed; explain a matter to the client to the extent reasonably necessary; and convey to the client facts pertinent to the matter. Fulfilling these duties, by advising clients regarding what they need to do, when they need to do it, why they need to do it, and the consequences of not doing it, as explained below, should go a long way in preventing missed filing deadlines.

Moreover, proper client communications would be a factor in any determining whether the applicable standard of care was met in the context of legal representations involving application filings. A showing that an attorney failed to meet the applicable standard of care is a necessary element of attorney malpractice. Therefore, proper communications with the client, as

outlined below, should reduce the risk of malpractice in case of a missed filing deadline, in addition to substantially reducing the chance of missing such a deadline.⁷

Time-of-Filing Communications

The time to start advising the client regarding subsequent filings is not later than when the application is filed. This is because this is the earliest time when the subsequent deadlines are defined in time, and this is the time when the newly filed application will be docketed and the filing reported to the client. At this time, the attorney should communicate everything required for the client to make informed decisions and plan accordingly. Here is a list of communications to the client that I think should occur when a Paris or domestic benefit right arises:

1	Possible filings and legal deadlines
2	Consequences if the legal deadline is missed
3	Attorney deadlines for client actions and instructions
4	What the attorney requires from the client by each attorney deadline
5	That the attorney cannot guarantee meeting the legal deadline if the client does not meet the attorney deadlines
6	That the client will risks losing priority rights if the client does not meet attorney deadlines, and how this risk increases as the filing deadline approaches.
7	The dates the client should calendar
8	That, if the attorney does not receive instructions by a specified date, the attorney will assume the client has decided not to pursue certain actions
9	That the client should ask the attorney for clarification in case anything is not clear

Follow-up Communications

The attorney should follow up with reminders regarding deadlines.

But at the deadlines, if the client has not fulfilled their obligations, the attorney should communicate that fact to the client. To be clear, if the client fails to meet the deadlines specified in the original communication, when each of those deadlines is missed, the attorney should communicate that fact to the client, and the consequences of the missed deadline.

If the client fails to communicate by time set in the original communication for the attorney to presume an instruction, for example an instruction not to proceed, the attorney should communicate that fact to the client.

Bad Assumptions Regarding Communications to Client

Some clients try to avoid making decisions and avoid communicating with their attorney for various reasons, or avoid communicating clearly. Whatever the reason, an attorney should not make any of the following assumptions about their communications with clients, and plan

accordingly. This is particularly true when potential loss of application rights are at stake.

That the client received your email.

That the client's address has not and will not change.

That the client will timely respond to the attorney's communication.

That the client's response will contain, as requested, an instruction.

That the client's instruction will be unambiguous.

That an attachment the attorney sent to the client, is unchanged when returned by the client. (For example, attachment specifying a list of countries.)

Default Escalation Procedure

One way to minimize the risks of a non-communicative client is to have in place a default escalation procedure. By this term, I mean a procedure in place that triggers different and sequentially more aggressive attempts to contact a non-communicative client. For example, if an email and a reminder email to a client do not result in the client clearly responding, send the communication by facsimile. If the client does not respond to the facsimile, escalate to a telephone call and postal mail.

IV. RETURN TO THE "BAD PLACE" FACT PATTERN

In the "bad place" fact pattern, the attorney filer indicated (s)he converted a provisional "on the one-year anniversary." From the fact pattern we do not know whether the attorney specified reasonable attorney deadlines in advance of the legal filing deadline, provided the client notices of when those deadlines ran, and explained to the client the consequences of missing those attorney deadlines. If the attorney provided those communications, most likely they would have avoided negligence, violations of the rules of professional conduct, and potential malpractice liability.

The attorney stated that they had received an "invitation," meaning a notice from RO/US of the lack of drawings in their application. If the attorney had filed at least 2 weeks before the 12 month deadline, they most likely would have had that notice in sufficient time to have refiled a PCT application with proper drawings.

The filer asked "Should I bother trying to get the correct drawings at this time? *** Do I risk not being able to get them in later if I try to do so now and am denied? " Those however are the wrong questions because almost certainly drawings constituting new matter would not be entitled to the existing defective PCT application's filing date. The filer's sole and best option, given the facts, is to refile the PCT application with proper drawings and a request restoration of priority. And preferably by obtaining a foreign filing license and then ePCT filing the new PCT application in RO/IB.

The "bad place" is, likely, very bad for the attorney. Under the professional rules of conduct, the attorney has a duty to communicate that requires the attorney to explain the situation, options, and available partial remedy to the client, so the client can make an informed decision how to proceed. This means that the attorney has a duty to explain their negligence to their client, and to notify the client that the client may have a claim for malpractice against the attorney.⁸

Further, under ABA/VA rule 1.7(a)(2) and USPTO rule 11.107, the attorney may have a conflict of interest in continuing the representation. This rule states a conflict exists when there a “significant risk that the representation ... will be materially limited ... by a personal interest of the lawyer.” The attorney has a personal interest in achieving an outcome in which the attorney has no liability for negligence. Advising the client on issues of patentability, or national stage entry, may reflect that interest.

1. I thank John Pike and Bruce Margulies for providing comments on drafts of this article.

2. A registered PAIR user has the option of associating email addresses with a USPTO customer number, and instructing the USPTO to notify the user by email for applications associated with that customer number. After doing that, the USPTO sends notifications of the existence of new documents for the applications associated with the customer number, to the specified email addresses. The user then may choose to log in to PAIR and download the new documents. The emails have a subject line "Private PAIR Correspondence Notification for Customer Number XXX".

3. This paper is not about the mechanics of docketing, noting client communications to the file, and the like. Those are aspect of practice I assumed that every practitioner was aware of and implemented. However, I discussed those issues with my firm's risk management counselor, Mark Bassingthwaighte, in the context of missing deadlines, while preparing this paper. His response was "Your peers are not doing those things!" Mark indicated that this failure is independent of firm size.

4. Paris Article 4(C)(4) is implemented in US national law, in 35 USC 119(c).

5. See Bodenhausen, "Guide to the Application of the Paris Convention for the Protection of Industrial Property," available at www.wipo.int/publications/en/details.jsp?id=239; and Caine, "When is it safe to refile or update a priority application?" (2012) available at: http://www.davies.com.au/images/uploads/publication_pdfs/When%20is%20it%20safe%20to%20refile%20priority%20application%20V4.pdf

See also the discussion of the assembly leading to Article 4(C)(4), recorded in "Actes De La Conférence De Lisbonne" (1958), at pp 327-349. This document is available from WIPO at: ftp://ftp.wipo.int/pub/library/ebooks/wipopublications/Lisbonne_1958.pdf

6. See "Review of United States Statutory Implementation of the Patent Law Treaty" Rick Neifeld, November 18, 2013, posted on Neifeld.com.

7. Malpractice, that is professional negligence in which there are damages, requires a showing that the professional failed to meet the relevant standard of care.

The elements of an action for professional negligence are the same as those of an ordinary negligence action. "The plaintiff bears the burden of presenting evidence `which establishes the applicable standard of care, demonstrates that this standard has been violated, and develops a causal

relationship between the violation and the harm complained of." *Morrison v. MacNamara*, D.C.App., 407 A.2d 555, 560 (1979) (citations omitted). A uniform standard of care applies in actions for negligence: reasonable care under the circumstances. *Morgan v. District of Columbia*, D.C.App., 449 A.2d 1102, 1108-09 (1982). Inherent in such reasonable care, however, is the requirement "that those with special training and experience adhere to a standard of conduct commensurate with such attributes." *Morrison, supra* at 560. Thus, "a lawyer must exercise that degree of reasonable care and skill expected of lawyers acting under similar circumstances." *Id.* at 561 [*O'Neil v. Bergan*, 81-1034, 452 A.2d 337 (D.C. Cir. 1982).]

For application filings, I know of no malpractice case for a missed filing deadline, in which a patent attorney provided the communications outlined in this section of my paper.

8. See McCauley, "The Duty to Self-Report Malpractice to the Client" available at www.vsb.org/docs/valawyer magazine/vl0814-self-report.pdf.