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New York State Bar Association
Committee on Professional Ethics

Opinion 977 (8/1/13)

Topic: Trial publicity in administrative proceeding; distributing via social media a petition and survey in support of client's pending case

Digest: A lawyer who represents a client in an administrative proceeding may distribute an online petition and survey in support of the client's case unless there is reason to believe that distributing those statements would have a substantial likelihood of materially prejudicing the adjudication.

Rule: 3.6

FACTS

1. The inquiring lawyer is defending a client in a cancellation proceeding before the U.S. Trademark Trial and Appeal Board ("TTAB"). In the pending TTAB proceeding, a third-party petitioner has alleged that the client's registered mark is confusingly similar to the petitioner's registered mark and is seeking cancellation of the client's registration.

2. The client has created an online petition to garner opposition to cancellation. The petition presents the proceeding as a contest between a family business and a big corporation, and asks readers to sign in order to demonstrate that there is no likelihood of confusion between the petitioner's mark and the client's mark. The lawyer asks if there is any ethical prohibition of distributing a link to the client's online petition via social media (specifically, using Facebook and Twitter) if the lawyer will merely tell readers it is there but not ask them to sign it.

3. In addition, the lawyer asks if it is ethically permissible to post online a survey asking questions along the lines of the following: "Do you think Mark X is confusingly similar to Mark Y? Click here to express your opinion."

4. The lawyer does not indicate what he intends to do with the petition or the survey results (*e.g.*, whether he intends to try to present the results as evidence in the proceeding).

QUESTIONS

5. If a client has set up an online petition in support of his case in a trademark cancellation proceeding, may the client's lawyer distribute a link to the petition via social media?

6. May a lawyer in a trademark cancellation proceeding post an online survey asking

readers whether they find two trademarks confusingly similar?

OPINION

7. Rule 3.6(a) of New York's Rules of Professional Conduct (the "Rules") provides that a lawyer who is participating (or has participated) in a criminal or civil matter "shall not make an extrajudicial statement that the lawyer knows or reasonably should know will be disseminated by means of public communication and will have a substantial likelihood of materially prejudicing an adjudicative proceeding in the matter." This provision attempts to balance the public value of informed commentary with a party's right to a fair proceeding.[1] We note that such provisions have been the subject of constitutional challenge,[2] but we are limited to interpreting the rules of legal ethics and do not undertake to assess their validity.

8. The prohibition in Rule 3.6(a) can be divided into a few components: (i) it applies to a lawyer who is participating in "a criminal or civil matter" in which there is or will be an adjudicative proceeding; (ii) it applies when the lawyer "make[s] an extrajudicial statement that the lawyer knows or reasonably should know will be disseminated by means of public communication"; and (iii) it applies to statements "that the lawyer knows or reasonably should know … will have a substantial likelihood of materially prejudicing an adjudicative proceeding in the matter." We consider how each of these components applies to the communications proposed in the inquiry.

9. The first component is clearly satisfied. "Matter" is defined by Rule 1.0(*l*) to include "any … administrative proceeding." A trademark cancellation proceeding is an administrative and adjudicative proceeding.[3] The inquiring lawyer is therefore subject to Rule 3.6(a).

10. As to the second component we start by considering whether distributing a link to the petition would constitute making extrajudicial statements. The petition itself includes extrajudicial statements, as it is a document that is being distributed online and it characterizes

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[1] *See* Rule 3.6, Cmt. [1] (discussing "balance between protecting the right to a fair trial and safeguarding the right of free expression," and noting "vital social interests served by the free dissemination of information about events having legal consequences and about legal proceedings themselves").

[2] *See*, *e.g.*, *Gentile v. State Bar of Nevada*, 501 U.S. 1030, 1063, 1075 (1991) (holding in criminal case that "'substantial likelihood of material prejudice' standard … satisfies the First Amendment" as "it is designed to protect the integrity and fairness of a State's judicial system, and it imposes only narrow and necessary limitations on lawyers' speech"); *Hirschkop v. Snead*, 594 F.2d 356, 373-74 (4th Cir. 1979) (concluding that a rule limiting lawyers' speech on matters pending before administrative tribunals, more restrictive than Rule 3.6, was unconstitutional because overbroad, and noting lack of record evidence "that any administrative decision has been set aside because the comments of lawyers impaired the fairness of the proceedings").

[3] *See* Trademark Trial and Appeal Board Manual of Procedure §102.02 (3d ed., rev. 2, June 2013) (describing proceedings within jurisdiction of TTAB, including cancellation proceedings); *id*. §102.03 (cancellation proceedings include pleadings, motions and trial). This TTAB Manual is available at http://www.uspto.gov/trademarks/process/appeal/Preface_TBMP.jsp.

the nature and merits of the dispute in particular ways. The fact that it was the client who created and posted the petition does not make the rule inapplicable. The lawyer, by distributing the link, is effectively disseminating the petition – and thus "mak[ing]" the statements it contains – over the internet as a means of public communication.

11. Whether the proposed survey meets this second component is less clear and may depend on a more detailed description of its contents. It may not make any "statement" subject to the Rule if it is limited to posing questions in neutral terms and giving readers the opportunity to express opinions. But if it includes leading questions, they could constitute implied statements subject to the Rule.

12. The final and central element of the prohibition is that the lawyer knows or reasonably should know that the statement "will have a substantial likelihood of materially prejudicing an adjudicative proceeding in the matter."

13. The rule provides some guidance on this final element by identifying certain kinds of statements that are presumptively permissible and other kinds that are presumptively impermissible. *See* Rule 3.6(b) (1) – (6) (listing kinds of statements "ordinarily" deemed likely to be prejudicial; Rule 3.6(c) (1) – (7) (listing kinds of information a lawyer may state, without elaboration, if the statement does not violate the basic prohibition in Rule 3.6(a)). As to the communications in question, however, the rule's presumptions do not apply. Neither the petition nor the survey would be within any of the presumptively permissible categories of information listed in Rule 3.6(c). Nor would either of those communications be presumptively prohibited, because Rule 3.6(b) applies only to certain statements that refer "to a civil matter triable to a jury, a criminal matter or any other proceeding that could result in incarceration." A trademark cancellation proceeding is not triable to a jury.[4] For this inquiry, therefore, the rule's lists of categories give no presumptive answer to the question of likely prejudice.

14. However, the presumptions described above do not exhaust the content of Rule 3.6. Whether or not one of the presumptions applies, the governing standard remains the one found in Rule 3.6(a). We turn to some factors that bear on whether the communications would have a substantial likelihood of materially prejudicing the cancellation proceeding.

15. One factor is the nature of the adjudicative proceeding. Its relevance may be inferred from Rule 3.6(b), because as noted above, the presumptive prohibitions do not apply to civil matters not triable to a jury. Here is a more direct statement of this factor's importance:

> Criminal jury trials will be most sensitive to extrajudicial speech. Civil trials may be less sensitive. Non-jury hearings and arbitration proceedings may be even less affected. The Rule will still place limitations on prejudicial comments in these cases, but the likelihood of prejudice may be different depending on the type of proceeding.

[4] TTAB Manual, note 2 *supra*, §102.03 (decisions on merits of cases are rendered by panels of TTAB judges).

Rule 3.6, Cmt. [6]. Indeed, it has been said that the concern about improperly influencing a factfinder's decisions

> is largely irrelevant in matters to be decided by judges. Judicial officers are expected to be immune from the influences of inadmissible evidence and similar sources of information and from the potentially distorting effects of inflamed public opinion. Thus, media comments by a lawyer outside a nonjury proceeding will pose a significant and direct threat to the administration of justice … only in extreme situations.[5]

16. Another factor is the content of the extrajudicial statements. For example, statements on peripheral issues may carry little risk of prejudice. Statements may be more likely to be prejudicial if they address crucial issues committed to the finder of fact or are expressed in an inflammatory way.

17. The likelihood of prejudice will depend in part on the likelihood that the statements will come to the attention of the finder of fact. Thus the method of disseminating extrajudicial statements may be a relevant factor, and another related one is the statements' timing.[6] Other relevant factors may include the purpose with which the statements were made[7] and whether the information in the statements is otherwise available from public sources.[8] Having listed some of

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[5] Restatement (Third) of The Law Governing Lawyers §109, cmt. b (2000). *But cf.*, *e.g.*, *United States v. Khan*, 538 F.Supp.2d. 929, 932-35 (S.D.N.Y. 2007) (interpreting analogous local rule against statements likely to "prejudice the due administration of justice" to prohibit not only lawyer's statements likely to taint jury pool but also those likely to threaten safety of witnesses).

[6] *See Gentile v. State Bar of Nevada*, 501 U.S. 1030, 1044 (1991) (citing case law and ABA source for proposition that timing of a statement is significant factor in the assessment of the possible threatened prejudice, and giving as problematic example a statement "which reaches the attention of the venire on the eve of *voir dire*"); Restatement (Third) of The Law Governing Lawyers §109, cmt. c (2000) ("statement made long before a jury is to be selected presents less risk than the same statement made in the heat of intense media publicity about an imminent or ongoing proceeding").

[7] *See Gentile v. State Bar of Nevada*, 501 U.S. at 1064-65, 1080 (disciplinary authority considered purpose of statements in assessing likelihood of prejudice); *id*. at 1079 (minority finding it persuasive that lawyer admitted having called press conference to influence venire, because it was "difficult to believe that he went to such trouble, and took such a risk, if there was no substantial likelihood that he would succeed").

[8] *See id*. at 1046 (minority portion of opinion noting that "[m]uch of the information provided by petitioner had been published in one form or another, obviating any potential for prejudice"); Restatement (Third) of The Law Governing Lawyers §109, cmt. c (2000) (if same information "is available to the media from other sources, the lawyer's out-of-court statement alone ordinarily will not cause prejudice," but this factor is not "controlling" and "the information must be both available and likely in the circumstances to be reported by the media"); *In re Sullivan*, 185 A.D.2d 440, 445 (3d Dept. 1992) (dismissing disciplinary charges against criminal defense

the factors relevant to likely prejudice (but without any claim that the list is comprehensive), we consider their application to the inquiry.

18. The nonjury nature of the TTAB proceeding is a consideration counting strongly against likely prejudice. On the other hand, while the inquiry does not fully describe the proposed communications, it appears at least that the statements in the petition, and implied ones in the survey if any, would directly address the merits of the dispute. The inquiry does not reveal the amount of time that would be expected to pass from the making of the statements until the trial.

19. A factor that may assume particular significance on these facts is motive. In this connection it is useful to distinguish between the mere making of the statements and their ultimate intended uses. The inquiry does not specify those uses.

20. It is possible that the lawyer's intent is to use the survey results as evidence that the two marks are not confusingly similar. If so, then the question arises whether such survey evidence would be permissible in a cancellation proceeding. If conducting the survey were an appropriate means of seeking competent evidence, then it would not have a substantial likelihood of "prejudicing" the proceeding. On the other hand, if the survey results would not constitute proper evidence, their dissemination could give rise to additional concerns. *Cf*. Rule 3.6(b)(5) (in jury or criminal context, statement ordinarily likely to be prejudicial if it relates to information the lawyer knows or reasonably should know is "likely to be inadmissible as evidence in a trial and would, if disclosed, create a substantial risk of prejudicing an impartial trial"). Similar questions would apply to possible intended use of the petition in evidence.

21. However, the petition was created by the client and there is no indication of intent to use is as evidence. In the absence of some other explanation, the inquiring lawyer should consider whether the client's goal is to disseminate the petition so broadly as to influence the finders of fact other than through the tribunal's processes. Of course in that instance it would be improper for the lawyer to participate in its dissemination.

22. We have mentioned various relevant facts not contained in the inquiry, and their absence limits our ability to balance the above factors. Even without those facts, however, we can identify an outline of the analysis. The dominant factor in this case may be the nature of the adjudicative proceeding. The fact that the adjudication will be by an administrative tribunal like the TTAB counts heavily in favor of the inquiring lawyer being permitted to disseminate the proposed communications. There could be a different answer if the inquiring lawyer were aware of additional facts indicating that the client seeks to use the petition to exert improper influence, or that prejudice is otherwise likely. But in the absence of such additional facts, it seems unlikely that distribution of the petition or the survey would materially prejudice an adjudicative proceeding to be conducted by a panel of specialized trademark judges.

23. We have addressed only such constraints on the proposed communications as might be imposed by the rules of legal ethics. There could also be legal constraints, but issues of law are

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lawyer whose "television interview was a mere drop in the ocean of publicity" surrounding the trial, when the matters discussed "had been otherwise publicized prior to the interview").

beyond the scope of this Committee. The inquiring lawyer may be well advised to review TTAB rules and other applicable laws and rules before distributing the petition or survey.

CONCLUSION

24. A lawyer representing a client in a trademark cancellation proceeding may use social media to distribute a link to an online petition in support of the client's case, and may post an online survey, where there is no substantial likelihood that the petition or survey would materially prejudice the upcoming administrative adjudication. If the lawyer knew that the client were trying to use the petition to pressure the trademark judges, or the lawyer had other information indicating a likelihood of materially prejudicing the proceeding, then the lawyer should not participate in disseminating those statements. But in the absence of such information, such statements may fairly be considered unlikely to prejudice a proceeding conducted by a panel of administrative judges.

(14-13)