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The Ethics of Deception: Pretext Investigations in Trademark Cases

Phillip Barengolts

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**THE ETHICS OF DECEPTION:
PRETEXT INVESTIGATIONS IN TRADEMARK CASES**

*Phillip Barengolts**

I. The Problem	2
II. Applicable Rules of Ethics	2
A. Truthful communications.....	3
B. Communicating with adverse parties represented by counsel	3
C. Communicating with parties not represented by counsel	4
D. Deceitful conduct.....	4
E. Using paralegals or other nonlawyer assistants	5
III. Court Decisions and Ethics Opinions.....	6
A. Apple Corps Ltd. v. International Collectors Society	7
B. Gidatex, S.r.L. v. Campaniello Imports, Ltd.	8
C. A.V. By Versace, Inc. v. Gianni Versace, S.p.A.	9
D. Hill v. Shell Oil Co.	9
E. Design Tex Group, Inc. v. U.S. Vinyl Manufacturing Corp.....	10
F. Chloe v. Designersimports.com USA, Inc.....	11
G. Midwest Motor Sports, Inc. v. Arctic Cat Sales, Inc.	11
H. NYCLA Committee On Professional Ethics Formal Opinion No. 737	13
I. Alabama Ethics Opinion No. RO-2007-05.....	13
J. Office of Lawyer Regulation v. Stephen P. Hurley.....	14
K. ABA Formal Opinion 95-396.....	15
IV. Some Suggested Guidelines	15

* Phillip Barengolts is a partner with Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP. His practice focuses on litigation, transactions, and counseling in domestic and international trademark, trade dress, Internet, and copyright law.

I. THE PROBLEM

Your client or your company has learned of an apparent infringement and wants to stop it via a civil action for an injunction and damages. Or, the infringer who was enjoined a year ago seems to be up to its old tricks again. Or, outside the litigation context, you are clearing a new brand and want to know if the registered mark is still in use or has been abandoned.

Before filing suit, you have an ethical obligation under Rule 11¹ to make reasonably sure the facts support your action, so you investigate or ask outside counsel or a private investigator to check out the infringing acts. If the product is mass-produced and sold to consumers, checking availability in retail stores or on the Internet may be an easy and low-risk solution. But if the product or service is not generally sold in such retail channels, and Internet indications are inconclusive, you may need to contact the other party or even visit its place of business.

The investigator says he will proceed using a suitable ruse to mask his identity and the true purpose of the visit. All this seems reasonable and obvious because any infringer would not knowingly talk to a private investigator or a representative of a potential adversary or its counsel.

However, lawyers have been embarrassed, sanctioned, and disciplined, and evidence has been excluded from court on ethical grounds. These proceedings usually include accusations that a lawyer or his or her agents acted deceptively, contacted unrepresented parties without making necessary disclosures, or improperly contacted represented parties of adverse interest without their lawyer's permission. So how do you investigate without running afoul of ethical prohibitions? Does it make a difference whether the lawyer does the investigation himself or herself or uses a paralegal or private investigator? What instructions should you give the investigator?

A thoughtful examination of these questions for bright-line rules and distinctions will probably leave you disappointed, as the answers are heavily fact-dependent and vary with the governing law where your office is located and where the investigation occurs.

II. APPLICABLE RULES OF ETHICS

The ABA Model Rules of Professional Conduct are noted below. Forty-two states have adopted revised rules based on the work of the Ethics 2000 Commission, and forty-nine states have adopted the Model

1. FED. R. CIV. P. 11.

Rules with some variation (only California has not done so).² The Model Rules afford the advantage of extensive accompanying comments that provide more guidance to lawyers than previous statements of rules of ethics. However, the Model Rules and comments do not specifically address the subject at hand.

Pretext investigations of trademark infringement usually implicate one or more of four rules of professional responsibility: truthful communications, communications with adverse parties represented by counsel, communications with parties unrepresented by counsel, and the prohibition of deceptive behavior. There is an additional rule on using paralegals or non-lawyer assistants to do the actual investigation which also comes into play on occasion.

A. *Truthful communications*

ABA Model Rule 4.1 Truthfulness In Statements To Others

In the course of representing a client a lawyer shall not knowingly:

- (a) make a false statement of material fact or law to a third person; or
- (b) fail to disclose a material fact to a third person when disclosure is necessary to avoid assisting a criminal or fraudulent act by a client, unless disclosure is prohibited by Rule 1.6.3

B. *Communicating with adverse parties represented by counsel*

ABA Model Rule 4.2 Communication with Person Represented by Counsel

In representing a client, a lawyer shall not communicate about the subject of the representation with a person the lawyer knows to be represented by another lawyer in the matter, unless the lawyer has the consent of the other lawyer or is authorized to do so by law or a court order.⁴

2. *State Adoption of the ABA Model Rules of Professional Conduct (previously the Model Code of Professional Responsibility): Dates of initial adoption*, AMERICAN BAR ASSOCIATION CENTER FOR PROFESSIONAL RESPONSIBILITY (2012), http://www.americanbar.org/groups/professional_responsibility/publications/model_rules_of_professional_conduct/alpha_list_state_adopting_model_rules.html

3. MODEL RULES OF PROF'L CONDUCT R. 4.1 (2007).

4. MODEL RULES OF PROF'L CONDUCT R. 4.2 (2007).

C. Communicating with parties not represented by counsel

ABA Model Rule 4.3 Dealing with Unrepresented Person

In dealing on behalf of a client with a person who is not represented by counsel, a lawyer shall not state or imply that the lawyer is disinterested. When the lawyer knows or reasonably should know that the unrepresented person misunderstands the lawyer's role in the matter, the lawyer shall make reasonable efforts to correct the misunderstanding. The lawyer shall not give legal advice to an unrepresented person, other than the advice to secure counsel, if the lawyer knows or reasonably should know that the interests of such a person are or have a reasonable possibility of being in conflict with the interests of the client.⁵

D. Deceitful conduct

ABA Model Rule 8.4 Misconduct

It is professional misconduct for a lawyer to:

violate or attempt to violate the Rules of Professional Conduct, knowingly assist or induce another to do so, or do so through the acts of another;

commit a criminal act that reflects adversely on the lawyer's honesty, trustworthiness or fitness as a lawyer in other respects;

engage in conduct involving dishonesty, fraud, deceit or misrepresentation;

engage in conduct that is prejudicial to the administration of justice;

state or imply an ability to influence improperly a government agency or official or to achieve results by means that violate the Rules of Professional Conduct or other law; or

knowingly assist a judge or judicial officer in conduct that is a violation of applicable rules of judicial conduct or other law.⁶

5. MODEL RULES OF PROF'L CONDUCT R. 4.3 (2007).

6. MODEL RULES OF PROF'L CONDUCT R. 8.4 (2007).

Oregon Rule 8.4(b)

Notwithstanding paragraphs (a)(1), (3) and (4) and Rule 3.3(a)(1), it shall not be professional misconduct for a lawyer to advise clients or others about or to supervise lawful covert activity in the investigation of violations of civil or criminal law or constitutional rights, provided the lawyer's conduct is otherwise in compliance with these Rules of Professional Conduct. "Covert activity," as used in this rule, means an effort to obtain information on unlawful activity through the use of misrepresentations or other subterfuge. "Covert activity" may be commenced by a lawyer or involve a lawyer as an advisor or supervisor only when the lawyer in good faith believes there is a reasonable possibility that unlawful activity has taken place, is taking place or will take place in the foreseeable future.⁷

This rule was revised to reverse the result in *In re Gatti*.⁸

E. Using paralegals or other nonlawyer assistants

ABA Model Rule 5.3 dealing with supervising nonlawyer assistants.

With respect to a nonlawyer employed or retained by or associated with a lawyer:

(a) a partner, and a lawyer who individually or together with other lawyers possesses comparable managerial authority in a law firm shall make reasonable efforts to ensure that the firm has in effect measures giving reasonable assurance that the person's conduct is compatible with the professional obligations of the lawyer;

(b) a lawyer having direct supervisory authority over the nonlawyer shall make reasonable efforts to ensure that the person's conduct is compatible with the professional obligations of the lawyer; and

(c) a lawyer shall be responsible for conduct of such a person that would be a violation of the Rules of Professional Conduct if engaged in by a lawyer if:

7. OR. CODE OF PROF'L CONDUCT R. 8.4(b) (2010).

8. 8 P.3d 966 (Or. 2000) (the Oregon Supreme Court held there was no "investigatory exception" to the State ethics rules; lawyer had used several false identities to investigate alleged insurance scheme); see Or. Eth. Op. 2003-173, 2003 WL 22397289, at *2 (2003); see also Douglas R. Richmond, *Deceptive Lawyering*, 74 U. CINCINNATI L. REV. 577, 591 (2005).

(1) the lawyer orders or, with the knowledge of the specific conduct, ratifies the conduct involved; or

(2) the lawyer is a partner or has comparable managerial authority in the law firm in which the person is employed, or has direct supervisory authority over the person, and knows of the conduct at a time when its consequences can be avoided or mitigated but fails to take reasonable remedial action.⁹

III. COURT DECISIONS AND ETHICS OPINIONS

Numerous court decisions and ethics opinions have addressed the ethics of pretext investigations with varying results. In *Apple Corps Ltd. v. International Collectors Society*,¹⁰ the court found no violation of the rules of ethics where an attorney had private investigators call the marketer's sales representatives and order infringing goods. In *Gidatex, S.r.L v. Campaniello Imports, Ltd.*,¹¹ investigators secretly recorded conversations with defendant's employees. The court found that the attorney had not violated the disciplinary rules because the investigator only recorded normal business routine. In *A.V. By Versace, Inc. v. Gianni Versace, S.p.A.*,¹² an investigator, who posed as a buyer and recorded video of employees, did not violate rules of ethics. In *Design Tex Group, Inc. v. U.S. Vinyl Manufacturing Corp.*,¹³ the court found no violation of the rules of ethics where the investigator recorded normal business routine rather than interviewing employees or tricking them into statements they otherwise would not have made. In *Chloe v. Designersimports.com USA, Inc.*,¹⁴ the court admitted evidence gathered by an investigator where the investigator ordered a counterfeit bag and sent a check under a pseudonym. However, in *Midwest Motor Sports, Inc. v. Arctic Cat Sales, Inc.*,¹⁵ the court sanctioned counsel for deceptive conduct and interviews under false pretenses.

9. MODEL RULES OF PROF'L CONDUCT R. 5.3 (2007).

10. 15 F. Supp. 2d 456, 458 (D.N.J. 1998).

11. 82 F. Supp. 2d 119, 119-20 (S.D.N.Y. 1999).

12. No. 96 Civ. 9721 PKLTHK, 2002 U.S. Dist. Lexis 16323 (S.D.N.Y. Sept. 3, 2002).

13. No. 04 Civ. 5002 (JSR), 2005 U.S. Dist. LEXIS 2143 (S.D.N.Y. Feb. 14, 2005)

14. No. 07-CV-1791 (CS)(GAY), 2009 U.S. Dist. LEXIS 42351 (S.D.N.Y. Apr. 29, 2009).

15. 347 F.3d 693 (8th Cir. 2003).

A. *Apple Corps Ltd. v. International Collectors Society*¹⁶

A seminal case is *Apple Corps Ltd. v. International Collectors Society*.¹⁷ Owners of THE BEATLES trademarks, including Yoko Ono Lennon, sued a stamp producer to enjoin unauthorized reproductions of likenesses of the Beatles on stamps.¹⁸ A consent injunction was entered, but the plaintiffs later believed it was being violated.¹⁹

Plaintiffs' counsel engaged investigators to make pretext contacts to see if defendants were violating the consent decree.²⁰ The investigators asked for and recorded recommendations about which stamps to purchase and about the acceptance of orders for infringing stamps.²¹ No questions were asked about instructions, practices, or policies governing the stamps.²² The investigation revealed violations of the consent decree, and plaintiffs moved for contempt sanctions.²³ Defendants cross-moved for sanctions on grounds that the investigators violated Rule 4.2, prohibited contact with persons known to be represented by counsel.²⁴

The court found no ethical violation.²⁵ New Jersey law extended the protection of Rule 4.2 only to the company's litigation control group.²⁶ The sales clerks did not fall within that group, so the *ex parte* communication was allowable.²⁷

With respect to the anti-deception provisions of Rule 8.4, the court gave no weight to the misrepresentations that were limited to the investigators' identity and their purpose in contacting defendant:

RPC 4.2 cannot apply where lawyers and/or their investigators, seeking to learn about current corporate misconduct, act as member[s] of the general public to engage in ordinary business transactions with low-level employees of a represented corporation. To apply the rule to the investigation which took place here would serve merely to

16. 15 F. Supp. 2d 456, 458 (D.N.J. 1998).

17. *Id.*

18. *Id.*

19. *Id.* at 459.

20. *Id.* at 462.

21. *Id.* at 463-64.

22. *Id.* at 464-65.

23. *Id.*

24. *Id.* at 472.

25. *Id.* at 475.

26. *Id.* at 473.

27. *Id.* at 474.

immunize corporations from liability for unlawful activity, while not effectuating any of the purposes behind the rule.²⁸

*B. Gidatex, S.r.L. v. Campaniello Imports, Ltd.*²⁹

The New Jersey *Apple* Corps decision was followed the next year in New York in *Gidatex, S.r.L. v. Campaniello Imports, Ltd.*³⁰

Plaintiff terminated defendant's license to sell Saporiti Italia brand furniture.³¹ Defendant continued to sell off its stock and to display the Saporiti Italia trademark, while selling customers other brands after they entered the store.³² Plaintiff's counsel hired private investigators to pose as interior designers and tape record incriminating conversations with defendant's sales staff.³³

Defendant filed a motion *in limine* to exclude the evidence on grounds that it was obtained unethically and illegally.³⁴ The court denied the motion on three grounds: the ethical prohibition of contacting adverse parties who are represented by counsel was inapplicable; plaintiff's attorneys had not violated the ethics rules even if they did apply; and exclusion of evidence was not the proper remedy in any event.³⁵

The court reasoned that the purpose of the anti-contact rule was to prevent circumvention of the attorney-client relationship.³⁶ However, the investigators acted like members of the public and did nothing more (other than taping the conversations) than an ordinary consumer would have done in asking the sales staff questions about their products.³⁷ The sales clerks and low-level employees would not have disclosed, or even have known, any information protected by the attorney client privilege.³⁸

The court noted the salutary purposes of pretext investigations in trademark infringement cases: "These rules of ethics should not govern situations where a party is legitimately investigating potential unfair business practices by use of an undercover [investigator] posing as a

28. *Id.* at 474-75.

29. 82 F. Supp. 2d 119, 119-20 (S.D.N.Y. 1999).

30. *Id.*

31. *Id.* at 120.

32. *Id.*

33. *Id.*

34. *Id.* at 119-20.

35. *Id.* at 120.

36. *Id.* at 122.

37. *Id.*

38. *Id.*

member of the general public engaging in ordinary business transactions with the target.”³⁹

C. *A.V. By Versace, Inc. v. Gianni Versace, S.p.A.*⁴⁰

The New York court followed this approach in *A.V. By Versace, Inc. v. Gianni Versace, S.p.A.*⁴¹

The Court rejects Alfredo Versace’s complaint that the use of a private investigator has caused an unfair invasion of his privacy. . . . Gianni Versace’s investigator used a false name and approached L’Abbigliamento posing as a buyer in the fashion industry. . . . The investigator’s actions conformed with those of a business person in the fashion industry, and Alfredo Versace makes no allegation that the private investigator gained access to any non-public part of L’Abbigliamento. . . . Further, courts in the Southern District of New York have frequently admitted evidence, including secretly recorded conversations, gathered by investigators posing as consumers in trademark disputes. *See, e.g.,* *Gidatex, S.r.L. v. Campaniello Imports, Ltd.*, 82 F. Supp. 2d 119, 123-24 (S.D.N.Y. 1999) (permitting introduction of secretly recorded conversations between private investigators and sales people for the defendant in a trademark infringement trial); *Nikon, Inc. v. Ikon Corp.*, 803 F. Supp. 910, 921-22 (S.D.N.Y. 1992), *aff’d*, 987 F.2d 91, 95-96 (2d Cir. 1993) (allowing introduction of investigators’ interviews with non-party sales clerks to demonstrate ‘passing off’ and actual confusion among consumers between Ikon and Nikon cameras); *see also* *Louis Vuitton S.A. v. Spencer Handbags Corp.*, 597 F. Supp. 1186, 1188 (E.D.N.Y. 1984), *aff’d*, 765 F.2d 966 (2d Cir. 1985) (affirming permanent injunction issued after considering secretly recorded videotape of defendants’ principals meeting with undercover investigator hired by plaintiff to discuss counterfeiting scheme).⁴²

D. *Hill v. Shell Oil Co.*⁴³

This was a civil rights case, not a trademark case, and the court endeavored to reconcile *Gidatex*, *Apple Corps*, and the district court opinion in *Midwest Motor Sports* (see discussion *infra*) in the context of

39. *Id.* at 122.

40. No. 96 Civ. 9721 PKLTHK, 2002 U.S. Dist. Lexis 16323 (S.D.N.Y. Sept. 3, 2002).

41. *Id.*

42. *Id.* at *30-31.

43. 209 F. Supp. 2d 876 (N.D. Ill. 2002).

racial discrimination allegations.⁴⁴ Plaintiffs conducted undercover investigations of gas station attendants to prove discriminatory practices.⁴⁵ Defendants moved for a protective order under Rules 4.2 and 4.3.⁴⁶

The court found the employees to be represented by counsel, making Rule 4.2 applicable but Rule 4.3 inapplicable.⁴⁷ Attempting to find the right balance in applying the rules, the court stated:

Lawyers (and investigators) cannot trick protected employees into doing things or saying things they otherwise would not do or say. . . . They probably can employ persons to play the role of customers seeking services on the same basis as the general public. They can videotape protected employees going about their activities in what those employees believe is the normal course.⁴⁸

The court thus found that videotape recordings of the employees' ordinary course of conduct in reacting to customers was proper under Rule 4.2.⁴⁹ The court reserved for trial, however, the admissibility of the substantive conversations, held outside the normal business transaction, between the investigators and the employees.⁵⁰

*E. Design Tex Group, Inc. v. U.S. Vinyl Manufacturing Corp.*⁵¹

The court followed *Gidatex* and denied a motion to exclude evidence on the ground that it was obtained in violation of rules of ethics.⁵²

[I]n response to what purported to be an ordinary purchasing inquiry made by an investigator working for plaintiffs, a U.S. Vinyl employee sent a sample book that included the allegedly [copyright] infringing pattern to a New York City address . . . Defendants argue that this action should not be attributed to the company because it was carried out by a low-level employee who had not received an instruction not to mail out the sample book in question. In the absence of any evidence that the employee was actually disobeying a company directive, there is no case law supporting this proposition. Also rejected is defendants'

44. *Id.* at 877-79.

45. *Id.* at 877.

46. *Id.*

47. *Id.* at 878.

48. *Id.* at 880.

49. *Id.*

50. *Id.*

51. No. 04 Civ. 5002 (JSR), 2005 U.S. Dist. LEXIS 2143 (S.D.N.Y. Feb. 14, 2005).

52. *Id.* at *2-3.

argument that this evidence should be excluded because plaintiffs' actions violated rules of ethics. It is not "an end-run around the attorney/client privilege" if investigators merely "recorded the normal business routine" rather than interviewing employees or tricking them "into making statements they otherwise would not have made."⁵³

*F. Chloe v. Designersimports.com USA, Inc.*⁵⁴

This case involved the sale of counterfeit CHLOE handbags by defendant.⁵⁵ Plaintiff's private investigator called defendant to order a bag and sent a check under a pseudonym.⁵⁶ She also made a couple follow up calls to defendant's sales clerks under her pseudonym to find out when the bag would be delivered.⁵⁷ Defendant complained about the fraud and duplicity involved in the pretext.⁵⁸

The court rejected the duplicity challenge, stating that courts in the Southern District of New York have frequently admitted evidence gathered by investigators posing as consumers in trademark disputes, citing *Versace* and *Gidatex*.⁵⁹

The court cited and revalidated the broad statement from *Apple Corps.*:

The prevailing understanding in the legal profession is that a public or private lawyer's use of an undercover investigator to detect ongoing violations of the law is not ethically proscribed, especially where it would be difficult to discover the violations by other means. [*Apple Corps.*], 15 F. Supp. 2d 456, 475 (D.N.J. 1998). Indeed it is difficult to imagine that any trademark investigator would announce her true identity and purpose when dealing with a suspected seller of counterfeit goods.⁶⁰

*G. Midwest Motor Sports, Inc. v. Arctic Cat Sales, Inc.*⁶¹

However, the court in *Midwest Motor Sports, Inc. v. Arctic Cat Sales, Inc.*⁶² decided just the opposite. The case arose from the

53. *Id.* at *2-3.

54. No. 07-CV-1791 (CS)(GAY), 2009 U.S. Dist. LEXIS 42351 (S.D.N.Y. Apr. 29, 2009).

55. *Id.* at *7.

56. *Id.* at *7-8.

57. *Id.* at *8.

58. *Id.* at *28.

59. *Id.* at *29-30.

60. *Id.* at *30.

61. 347 F.3d 693 (8th Cir. 2003).

62. *Id.*

discontinuance of the sale of a certain snowmobile line at the plaintiff's store.⁶³ The investigator testified that defendant's lawyers hired him to visit plaintiff's showroom, talk to a salesman about products, to find out which snowmobiles were being recommended, and to look at the equipment.⁶⁴ He recorded his conversation to see if the salesman would say anything about the lawsuit.⁶⁵ He also said he was supposed to get into "financing, promotions, and close-out pricing" with the sales people.⁶⁶ He admitted in his deposition that his purpose was to elicit evidence rather than to reveal evidence of how typical consumers would be treated.⁶⁷

The court analyzed the anti-contact rule, Rule 4.2, by stating its purposes were to prevent getting adverse party statements by circumventing opposing counsel, to protect the attorney-client relationship, to prevent the inadvertent disclosure of privileged information, and to facilitate settlement by channeling disputes through the attorneys.⁶⁸

The court rejected the contention that all corporate employees were within the anti-contact rule and recognized instead a spectrum of categories of employees for purposes of Rule 4.2.⁶⁹ Because the salesman's statements would be imputed to the corporate plaintiff, the court found that salesman to be within the protection of Rule 4.2, distinguishing *Apple Corps.* and similar cases which restricted protection to the control group.⁷⁰

The court found that defendant's counsel, via their investigators, had violated the anti-contact rule of Rule 4.2, would have violated Rule 4.3 even if the salesman had been held to be unrepresented by counsel, and sanctioned counsel for deceptive conduct and interviews under false pretenses.⁷¹

63. *Id.* at 695.

64. *Id.* at 695-96.

65. *Id.*

66. *Midwest Motor Sports, Inc. v. Artic Cat Sales, Inc.*, 144 F. Supp. 2d 1147 (D.S.D. 2001), *aff'd sub nom.*, 347 F.3d 693.

67. *Midwest Motor Sports*, 347 F.3d at 696.

68. *Id.* at 698.

69. *Id.* at 697.

70. *Id.* at 698.

71. *Id.*

H. NYCLA Committee On Professional Ethics Formal Opinion No. 737

The NYCLA Committee On Professional Ethics Formal Opinion No. 737⁷² is one of the small number of ethics opinions specifically directed at the issue.

Entitled “Non-government lawyer use of investigator who employs dissemblance,”⁷³ the opinion does not address whether the lawyer himself or herself is ever permitted to make “dissembling statements” directly!

“Dissemblance” is not unauthorized if narrow conditions are satisfied:

Either

The investigation concerns either a civil rights or intellectual property violation which the lawyer in good faith believes is taking place or will take place, or

The dissemblance is expressly authorized by law; and

The evidence sought is not reasonably and readily available through other lawful means; and

The lawyer’s and investigator’s conduct do not otherwise violate The New York Lawyer’s Code of Professional Responsibility or other applicable law; and

The dissemblance does not unlawfully or unethically violate the rights of third parties.⁷⁴

*I. Alabama Ethics Opinion No. RO-2007-05*⁷⁵

“During pre-litigation investigation of suspected infringers of intellectual property rights, a lawyer may employ private investigators to pose as customers under the pretext of seeking services of the suspected infringers on the same basis or in the same manner as a member of the general public.”⁷⁶

72. NYCLA Comm. on Prof’l Ethics, Formal Op. 737 (2007).

73. *Id.* at 1.

74. *Id.* at 5.

75. Ala. Ethics Op. No. RO-2007-05 (2007).

76. *Id.*

*J. Office of Lawyer Regulation v. Stephen P. Hurley*⁷⁷

Attorney Hurley was defending a client, Sussman, being prosecuted for child pornography.⁷⁸ Hurley's defense theory was that the minor, S.B., who was allegedly exposed to the pornography by Sussman, was independently viewing and collecting the same pornography on his own.⁷⁹

Hurley wanted to get S.B.'s computer to see if it contained the pornography.⁸⁰ He hired a private investigator who obtained S.B.'s computer through deceit, saying he was conducting a survey concerning computer usage and would provide a free new computer in return for turnover of S.B.'s existing computer.⁸¹

Hurley instructed the investigator not to contact S.B. unless his mother was present, and to give S.B. an opportunity to remove anything he wanted to from the computer.⁸² The computers were swapped, and a forensic computer specialist found pornography on S.B.'s computer.⁸³

The District Attorney filed a disciplinary complaint against Hurley, alleging misconduct involving making a false statement to a third party, and engaging in conduct involving fraud, dishonesty, deceit, or misrepresentation.⁸⁴

In the hearing, testimony indicated a widespread belief among the Wisconsin bar that Hurley's conduct was permissible, and common practice among prosecutors.⁸⁵ The state supreme court upheld the dismissal of the complaint against Hurley, stating that no Wisconsin statute or rule drew the distinction between prosecutors and private practitioners urged by the District Attorney.⁸⁶ The court also noted Hurley's ethical obligation to zealously defend his client's liberty and essentially gave him the benefit of the doubt.⁸⁷

77. No. 2007AP478-D, 2008 Wisc. LEXIS 1181 (Wis. Feb. 11, 2009), available at http://www.jenner.com/files/tbl_s69NewsDocumentOrder/FileUpload500/6211/Office%20of%20Lawyer%20Regulation%20v.%20Hurley.pdf.

78. *Id.* at 2.

79. *Id.*

80. *Id.*

81. *Id.*

82. *Id.*

83. *Id.* at 3.

84. *Id.*

85. *Id.*

86. *Id.* at 4.

87. *Id.* at 3.

K. *ABA Formal Opinion 95-396*⁸⁸

1. Rule 4.2 attaches when you know the other party is represented by counsel in the matter, whether as a potential adversary, witness, or as an interested party.⁸⁹
2. Representation of a company does not necessarily bar communications with all employees of that organization, but does extend to employees whose actions and statements can be imputed to the company.⁹⁰

IV. SOME SUGGESTED GUIDELINES

This is a thorny area of ethical practice in which the authorities and decisions are in tension if not outright conflict. It is all the more difficult because investigation of facts is necessary and commonplace in trademark clearance and litigation practice. At a minimum, issue awareness and due diligence are essential steps toward staying out of harm's way and complying with legal and ethical obligations.

Check local ethics rules, disciplinary rulings and opinions, and case law before embarking on a pretext investigation in the states where you are admitted to practice, where the case is pending, and where the investigation will take place. The courts in highly commercial jurisdictions, like New York or New Jersey, that handle a greater volume of trademark infringement, counterfeiting, and deceptive trade practices cases, seem to be more tolerant of pretext investigations than courts that see fewer such cases.⁹¹

The lawyer should not do the pretext investigation himself or herself. It does not necessarily legitimize the investigation to do it through a paralegal or private investigator, but doing the “dissembling” directly seems unnecessarily risky. Even the New York ethics opinion that approves dissembling under certain conditions is expressly qualified not to apply to actions by the lawyer personally.⁹²

88. ABA Comm. On Ethics & Prof'l Responsibility, Formal Op. 95-396 (1995).

89. *Id.* at 1, 4.

90. *Id.* at 1.

91. Compare *Louis Vuitton S.A. v. Spencer Handbags Corp.*, 765 F.2d 966, 968, 973 (2d Cir. 1985) (use of private investigators allowed in counterfeit handbags case), and *Nikon Inc. v. Ikon Corp.*, 803 F. Supp. 910, 921-22 (S.D.N.Y. 1992), *aff'd*, 987 F.2d 91, 92 (2d Cir. 1993) (investigators allowed to provide evidence of passing off), with *Midwest Motor Sports v. Artic Cat Sales Inc.*, 347 F.3d 693, 695 (8th Cir. 2003).

92. New York County Lawyers Ass'n Comm. on Prof'l Ethics, Formal Op. No. 737 (2007), available at http://www.nycla.org/siteFiles/Publications/Publications519_0.pdf.

Distinguish between non-litigation or pre-litigation settings and pending litigation settings. During pending litigation, you are closer to the dangerous end of the spectrum, with the courts likely to apply the rules more stringently against communicating with persons represented by counsel and/or unrepresented persons. Checking to see if current use of a trademark can be found, as a due diligence aspect of routine trademark clearance, is near the safer and more acceptable end of the spectrum as it is within the realm of inquiries that would be made by members of the consuming public who might be looking for the product to purchase.

Checking and documenting business practices and transactions in the ordinary course of business with members of the general public is on the more innocuous and defensible end of the spectrum. It is hard to see how this subverts the attorney-client relationship intended to be protected by the no-contact rules, and characterizations of this type of interchange pervade the decisions holding no violation took place. If the basic interview passes ethical muster, secret audiotaping or videotaping is probably acceptable as well, provided it is lawful under applicable laws on “wiretapping” or taping without permission.

Trying to elicit admissions as to details, decisions, motivations, and effects is on the more dangerous and unacceptable end of the spectrum. Baiting employees to make damaging admissions and reveal damaging details beyond the scope of typical exchanges with members of the general public is more likely to violate rules of ethics.

Consider exactly who is being interviewed. Talking to sale clerks or other “public-facing” employees is on the safer end of the spectrum, as opposed to officers or managers who are more responsible in the corporate hierarchy, who are more likely to interact with counsel and/or bind the company with their statements and actions. However, remember that *Midwest Motor Sports*⁹³ held that sales clerks’ statements would be imputed to the company.

If you use a private investigator, it is probably a good idea to give detailed written instructions including goals. Even with a highly capable investigator who knows the boundaries of legal ethics, it is to your advantage to have a written record of the investigation’s scope and limitations, just in case you have to defend it, yourself, and your investigator. If you have used a particular investigator in the past and are confident of his or her standard operating procedures, there is probably less need for detailed instructions on new assignments.

93. 347 F.3d 693.

Whatever you do, be extra careful if your investigation takes place, or if your case is or would be located in the Eighth Circuit (Arkansas, Iowa, Minnesota, Missouri, Nebraska, North Dakota, South Dakota), the venue of the harsh ruling in the *Midwest Motor Sports* case discussed *supra*.