

SUPREME JUDICIAL COURT OF MASSACHUSETTS

Ropes & Gray LLP v. Jalbert

454 Mass. 407 (2009) · Decided July 28, 2009

SUMMARY

The Supreme Judicial Court of Massachusetts answered certified questions concerning whether Massachusetts General Laws chapter 221, section 50 creates an attorney's lien on patents and patent applications for patent prosecution services. The court held that the statute applies to such work and that the lien attaches to proceeds from the sale of the patents or applications. The decision interpreted the statute's references to a client's "claim" and "proceeds" as independent bases for the lien.

CASE DETAILS

COURT	Supreme Judicial Court of Massachusetts
WRITING FOR THE COURT	Spina, J.
JURISDICTION	Massachusetts
DECIDED	July 28, 2009
DISPOSITION	other
PROCEDURAL POSTURE	The United States Court of Appeals for the First Circuit certified two questions of Massachusetts law concerning the scope of the Massachusetts attorney's lien statute in connection with patent prosecution work.
STANDARD OF REVIEW	De novo interpretation of a Massachusetts statute in response to certified questions.
PRECEDENTIAL VALUE	Published precedential opinion answering certified questions of Massachusetts law.
PARTIES	Ropes & Gray LLP v. Jalbert

TOPICS

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PRACTICE AREAS

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QUESTIONS PRESENTED

1. Whether G. L. c. 221, § 50, grants a Massachusetts attorney a lien on patents and patent applications for patent-prosecution work performed for a client.
2. Whether, if the statute grants such a lien, the lien attaches to proceeds from the sale of the issued patents or patent applications.

HOLDINGS

1. A Massachusetts attorney who performs patent-prosecution work may assert a lien under G. L. c. 221, § 50, on the client's patent application and on the patent subsequently issued from that application.
2. A lien under G. L. c. 221, § 50, attaches to proceeds derived from the sale of a patent or patent application to which the lien is attached.

KEY QUOTATIONS

“When an attorney files a patent application for a client with the USPTO, that action constitutes appearing in a proceeding before a Federal department.” (413)

“The repetition of the word “upon” in the statute describes three separate and independent bases for the assertion of an attorney’s lien” (414-415)

“The purpose of the lien statute would be eviscerated if an inventor could just sell a valuable property right, one that was obtained by the attorney’s work in the first instance, and pocket the proceeds.” (416-417)

FACTUAL BACKGROUND

Ropes & Gray provided patent-prosecution services to Engage, Inc. and its affiliates before their Chapter 11 filings and was owed approximately \$108,737.11 for that work. The debtors sold patents and patent applications before and after filing for bankruptcy, and the sale proceeds were held in reserve pending resolution of Ropes & Gray's asserted attorney's lien. The bankruptcy and district courts concluded that G. L. c. 221, § 50, did not apply to patent-prosecution work or attach to the patents, applications, or sale proceeds.

PROCEDURAL HISTORY

Engage, Inc. and affiliated debtors filed Chapter 11 bankruptcy petitions. Ropes & Gray asserted a secured claim for unpaid patent-prosecution services, claiming a lien under G. L. c. 221, § 50, on patents, patent applications, and proceeds from their sale. The Bankruptcy Court rejected the lien claim, and the United States District Court for the District of Massachusetts affirmed. After further proceedings and a final disallowance of the secured claim, the District Court again affirmed. On appeal, the First Circuit certified to the Massachusetts Supreme Judicial Court whether the statute creates a lien on patents and patent applications for patent-prosecution work and whether the lien attaches to sale proceeds.

DISPOSITION

other

REMAND INSTRUCTIONS

The court answered both certified questions in the affirmative and directed that attested copies of the opinion be transmitted to the First Circuit. It did not itself remand the underlying bankruptcy matter.

CASES CITED

- In re Engage, Inc., 544 F.3d 50, 51-58 (1st Cir. 2008)
- In re Engage, Inc., 315 B.R. 208, 210-217 (Bankr. D. Mass. 2004)
- In re Engage, Inc., 330 B.R. 5, 5-21 (D. Mass. 2005)
- Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1548 (Fed. Cir. 1983)
- Carl Schenck, A.G. v. Nortron Corp., 713 F.2d 782, 784 (Fed. Cir. 1983)
- Beckman Instruments, Inc. v. Chemtronics, Inc., 439 F.2d 1369, 1378-1379 (5th Cir. 1970)
- Pacific Gas & Elec. Co. v. United States, 69 Fed. Cl. 784, 794-795 (2006)
- Kingsland v. Dorsey, 338 U.S. 318, 319 (1949)
- Charles Pfizer & Co. v. Federal Trade Commission, 401 F.2d 574, 579 (6th Cir. 1968)
- Hanlon v. Rollins, 286 Mass. 444, 447 (1934)
- Sullivan v. Brookline, 435 Mass. 353, 360 (2001)
- Pyle v. School Comm. of S. Hadley, 423 Mass. 283, 285-286 (1996)
- Wolfe v. Gormally, 440 Mass. 699, 704 (2004)
- Bankers Life & Cas. Co. v. Commissioner of Ins., 427 Mass. 136, 140 (1998)
- Commonwealth v. Callahan, 440 Mass. 436, 440-441 (2003)
- Charland v. Muzi Motors, Inc., 417 Mass. 580, 582-583 (1994)
- Boswell v. Zephyr Lines, Inc., 414 Mass. 241, 248 (1993)
- PGR Mgt. Co., Heath Props. v. Credle, 427 Mass. 636, 640 (1998)
- Matter of Heinsheimer, 214 N.Y. 361, 364 (1915)
- Advanced Cardiovascular Sys., Inc. v. C.R. Bard, Inc., 144 F.R.D. 372, 376 (N.D. Cal. 1992)
- Synthetic Plastics Co. v. Ellis-Foster Co., 78 F.2d 847, 848 (3d Cir. 1935)
- Connors v. Boston, 430 Mass. 31, 42-43 (1999)
- Commonwealth v. Jones, 417 Mass. 661, 664 (1994)
- Kourouvacilis v. American Fed'n of State, County & Mun. Employees, 65 Mass. App. Ct. 521, 521 n.1 (2006)
- Nett v. Bellucci, 437 Mass. 630, 648 (2002)