

# A Summary of Recent Activity at OED



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Deputy General Counsel and Director

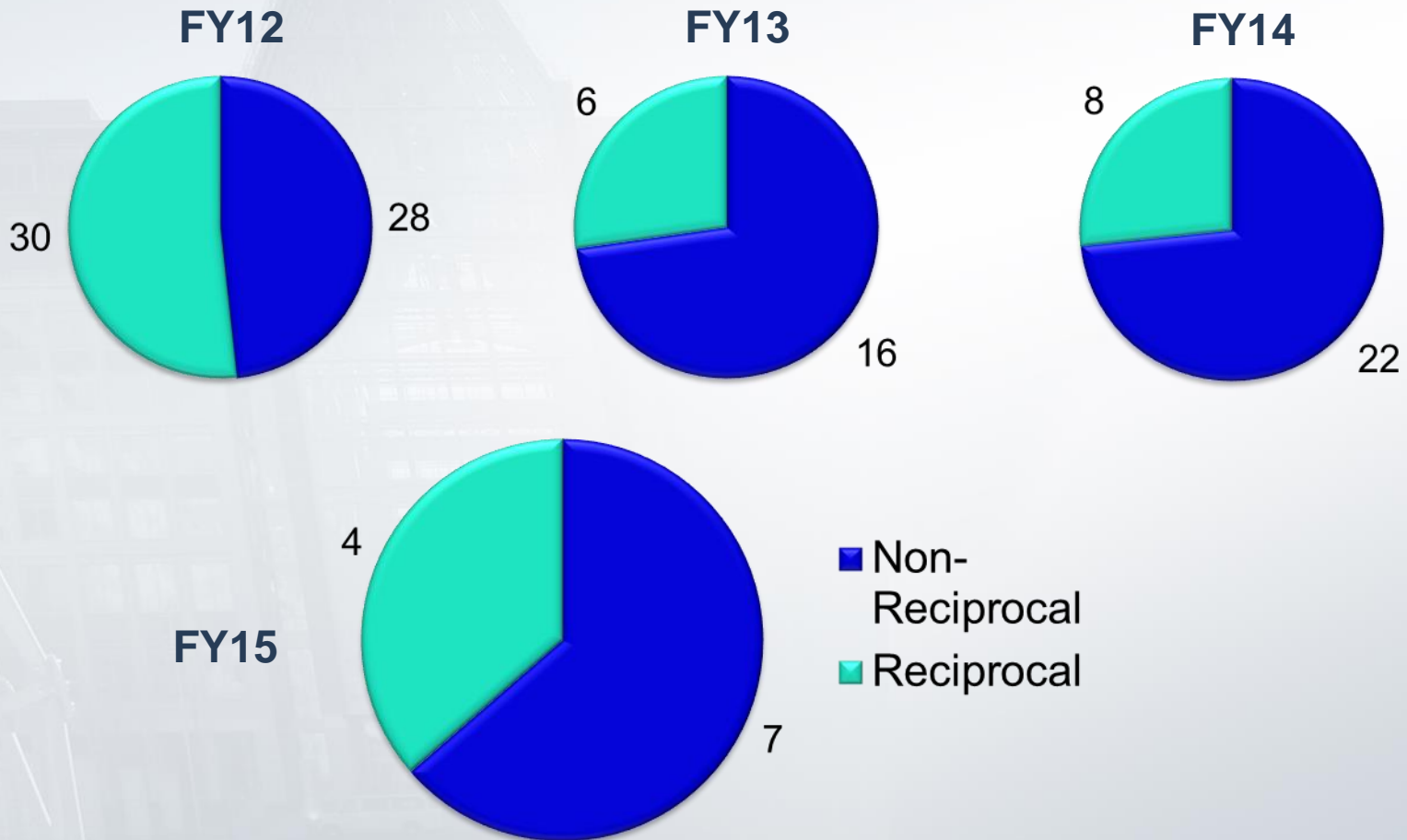
Office of Enrollment and Discipline

United States Patent and Trademark Office



# Total Number of OED Disciplinary Decisions

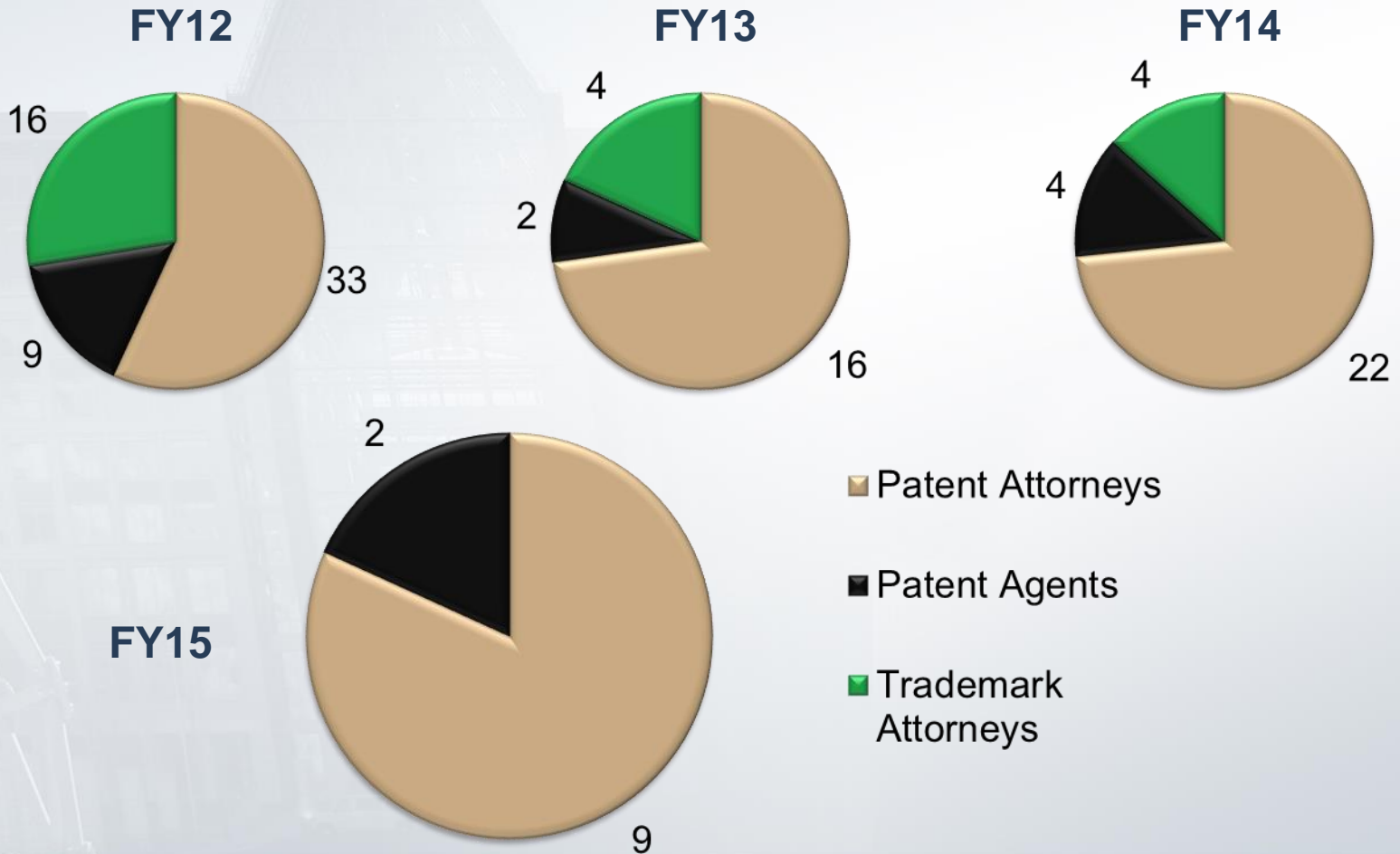
## Breakdown of Reciprocal vs. Non-Reciprocal Formal Decisions





# Total Number of OED Disciplinary Decisions

## Breakdown of Disciplinary Decisions by Practitioner Type



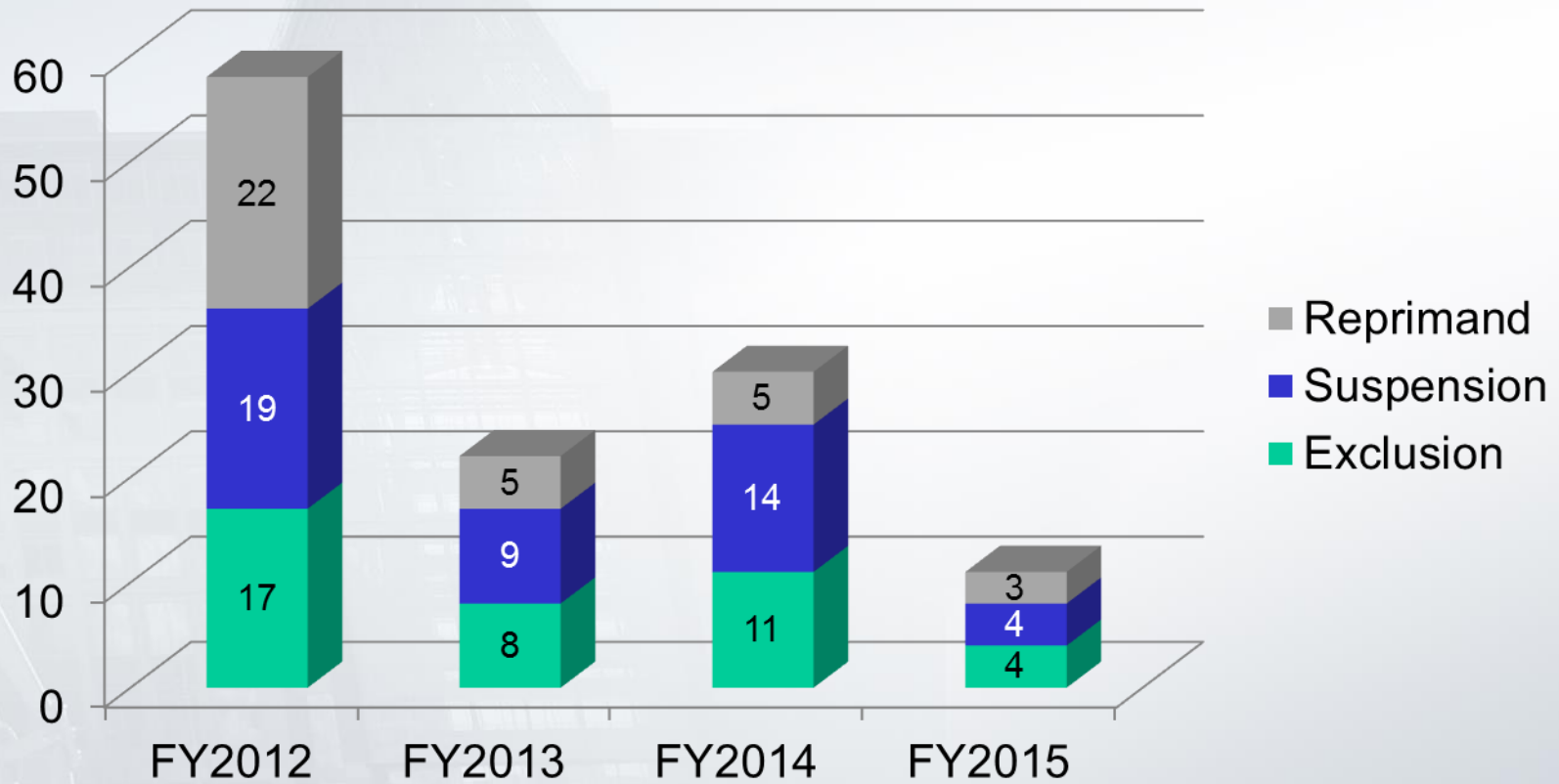


# The USPTO Rules of Professional Conduct

- Final Rules Effective: **May 3, 2013.**
  - 78 Federal Register 20179
- 37 C.F.R. §§ 11.101-901.
- Old rules (37 C.F.R. Part 10) apply to activity prior to effective date.
- Based on 2011 Update to ABA Model Rules.
- Comments and Annotations to ABA Model Rules: non binding, but may be useful information.

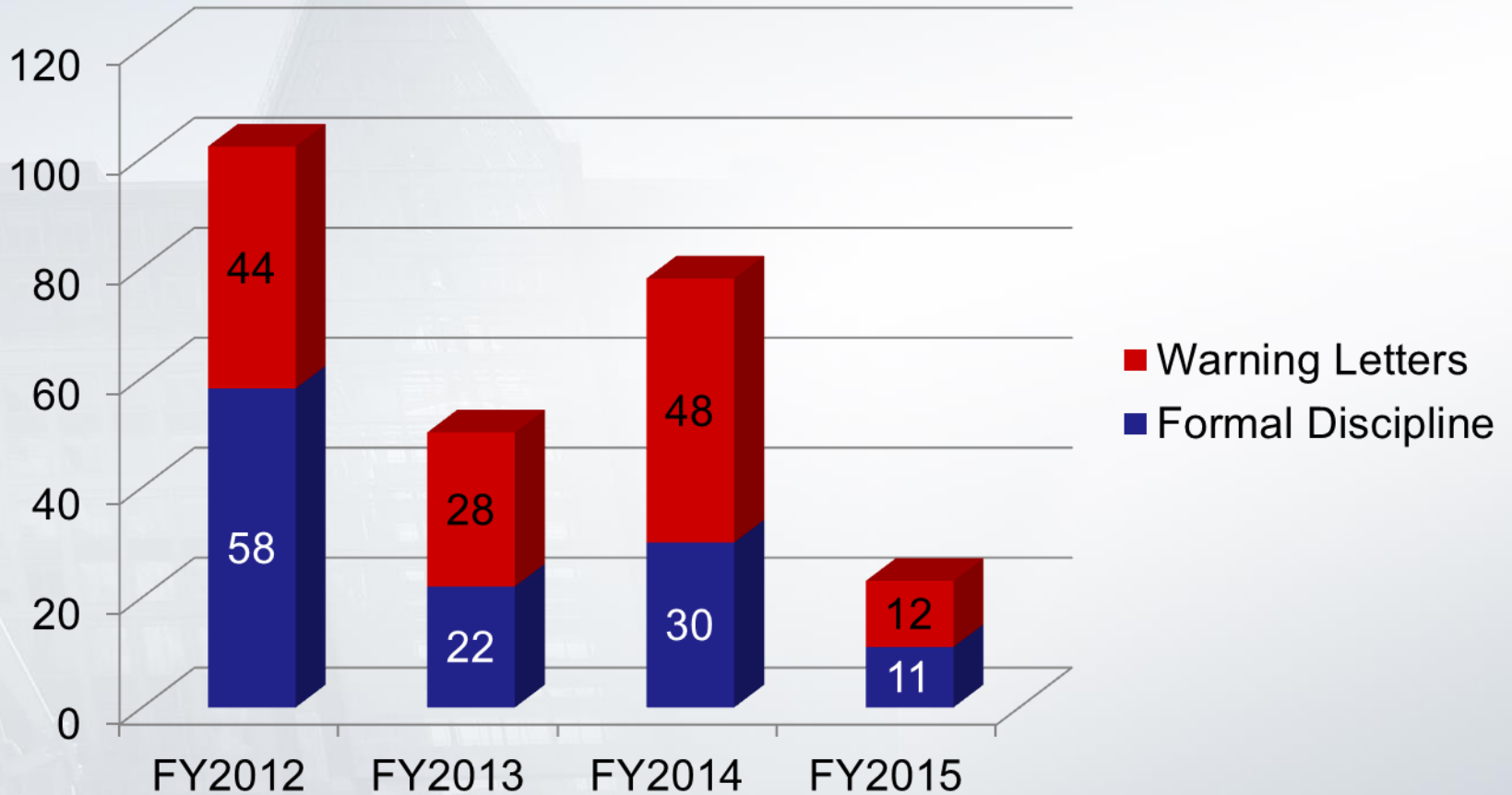


# OED Discipline: Types of Discipline





# OED Discipline: Warnings vs. Formal Discipline





# Poll Question

- True or False: In 2013, the USPTO updated its ethics rules for practitioners before the Office to rules based on the ABA Model Rules of Professional Conduct.



# OED Decisions

## Recent Orders





# Conflict of Interest

- ***In re Radanovic*** (USPTO D2014-29)
  - Patent attorney:
    - Represented two joint inventors of patent application.
    - No written agreement regarding representation.
    - Attorney became aware of a dispute wherein one inventor alleged that the other did not contribute to allowed claims.
    - Continued to represent both inventors.
    - Expressly abandoned application naming both inventors in favor of continuation naming one.
  - Received public reprimand.
  - Mitigating factors included clean 50-year disciplinary history.



# Conduct Not Involving Practice Before the USPTO

- ***In re Hicks*** (USPTO D2013-11)
  - Attorney was sanctioned by EDNY for failure to comply with discovery orders.
  - On Appeal to the Federal Circuit, the sanction was affirmed.
    - *Rates Technology v. Mediatix Telecom*, 688 F.3d 742 (2012).
  - Federal Circuit also found that the appellate brief contained “misleading or improper” statements.
    - Appellate brief headings misrepresented findings of lower court judges.
    - Appellate brief failed to inform court that a case citation was non-precedential.
  - Mr. Hicks practiced before the USPTO in TM matters.
  - Received public reprimand and one-year probation.



# Supervising Non-Lawyer Assistants

- ***In re Druce*** (USPTO D2014-13)
  - Formerly registered patent attorney, was responsible for the supervision of a non-lawyer assistant at his law firm.
  - Non-Lawyer assistant submitted knowingly false statements to the USPTO in patent applications that Attorney was responsible for prosecuting on behalf of clients.
    - Fabricated communications (e.g., facsimile transmissions, express mail labels, etc.) for papers that were never sent to the Office.
    - Fabricated USPTO receipts / postcard stamps for papers that were never filed with the USPTO.
    - Backdated certificates of mailing.
    - Signed patent attorney's signature to USPTO filings.
  - Attorney acknowledged that he failed to adequately supervise non-lawyer assistant.
  - Upon reinstatement: 2 year stayed suspension and 2 year probation.



# Improper *ex parte* Contact

- ***In re Caracappa*** (USPTO D2014-02).
  - Registered patent attorney was counsel of record in *inter partes* review proceeding.
  - Co-counsel sent an email to PTAB email address, naming a specific judge as the addressee.
  - The email explained a mathematical error in a paper filed by the opposing side.
  - Opposing counsel was not copied on the email.
  - Attorney authorized and had full knowledge of the email, including the fact that opposing counsel was not copied.
  - PTAB held that the email was an improper *ex parte* communication.
  - Received public reprimand.



# Inequitable Conduct

- ***In re Tandler*** (USPTO D2013-17)
  - Registered patent attorney filed Rule 131 declaration re: actual reduction to practice of claimed invention to antedate prior art.
  - Attorney later learned from client that the facts were not accurate.
  - Did not advise office in writing of inaccuracy.
  - USPTO subsequently issued a patent for the invention.
  - Patent found unenforceable due to inequitable conduct.
- ***Intellect Wireless v. HTC Corp.***, (732 F.3d 1339 (Fed. Cir. 2013)).
  - Attorney submitted revised declaration that did not include facts supporting actual reduction to practice.
  - Fed. Cir. noted that an applicant must expressly advise the PTO false statements/misrepresentations, stating specifically where they reside.
- 4 year suspension for conduct prejudicial to the administration of justice (may apply for reinstatement after 2 years).



# Decisions Imposing Public Discipline Available In FOIA Reading Room

- ▶ <http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>
  - ▶ In the field labeled “Decision Type,” select “Discipline” from the drop down menu.
    - To retrieve all discipline cases, click “Get Info” (not the “Retrieve All Decisions” link).
  
- ▶ Official Gazette for Patents
  - [http://www.uspto.gov/news/og/patent\\_og/index.jsp](http://www.uspto.gov/news/og/patent_og/index.jsp)  
Select a published issue from the list, and click on the “Notices” link in the menu on the left side of the web page.



# Contacting OED

For Informal Inquiries, Contact OED at  
571-272-4097

THANK YOU