
UNITED STATES
PATENT AND TRADEMARK OFFICE
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Professional Responsibility at the USPTO

William R. Covey
Deputy General Counsel and Director
Office of Enrollment and Discipline
United States Patent and Trademark Office

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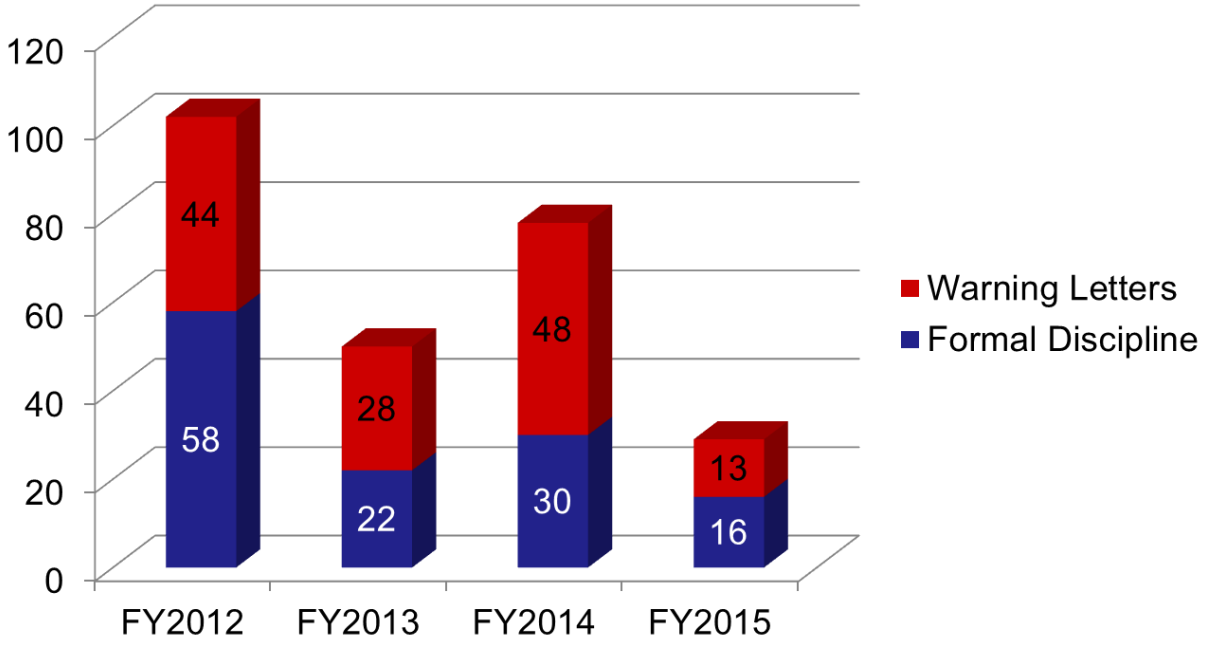
OED Discipline: Warnings vs. Formal Discipline

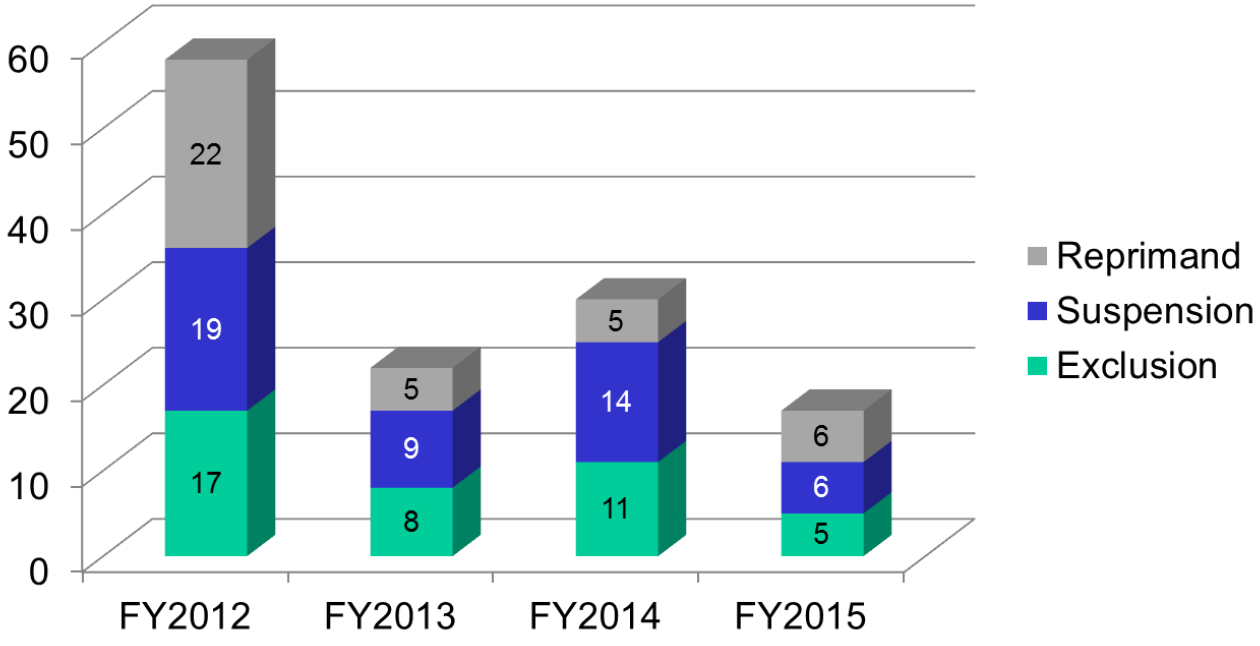
- Generally speaking, "formal discipline" at OED is public discipline.
- Formal disciplinary sanctions include:
  - Exclusion from practice before the Office;
  - Suspension from practice before the Office; or
  - Public reprimand.

  37 C.F.R. § 11.20(a).
- The OED Director may conclude an investigation with a warning. *See* 37 C.F.R. § 11.21.
  - A warning is neither public nor a disciplinary sanction.

OED Discipline: Warnings vs. Formal Discipline

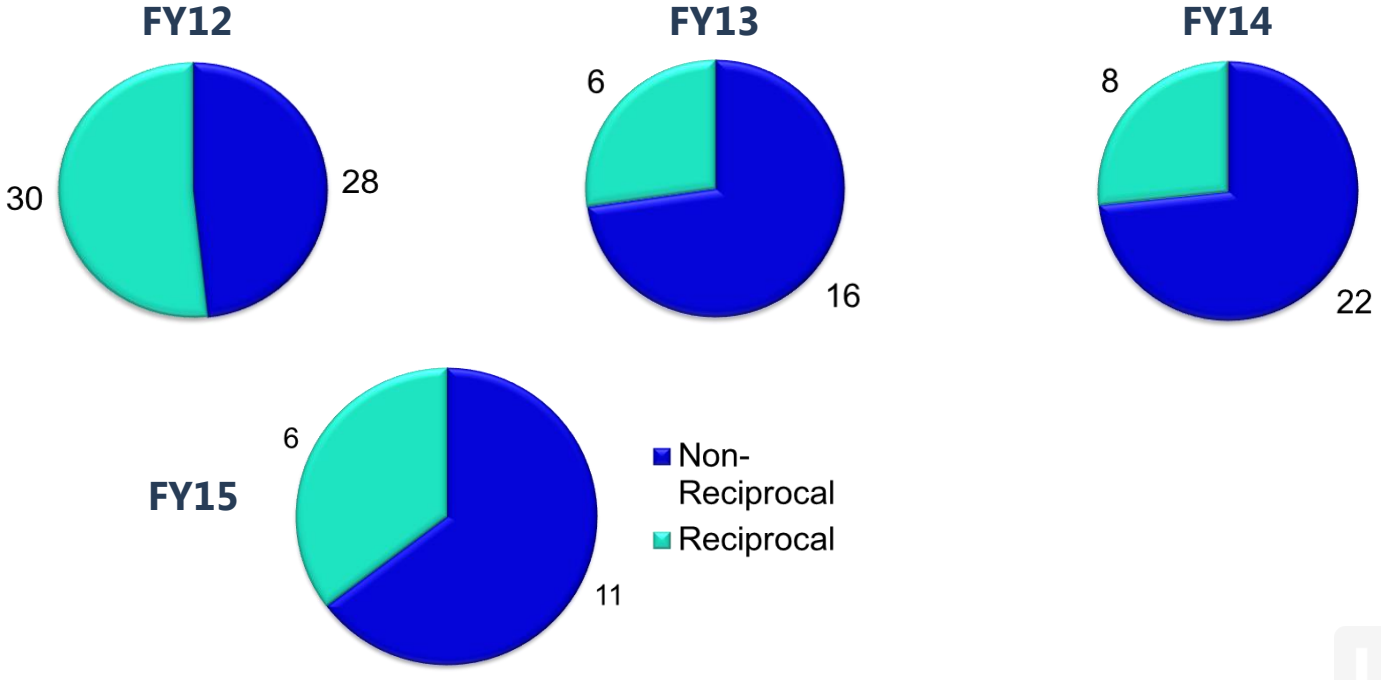


OED Discipline: Types of Discipline



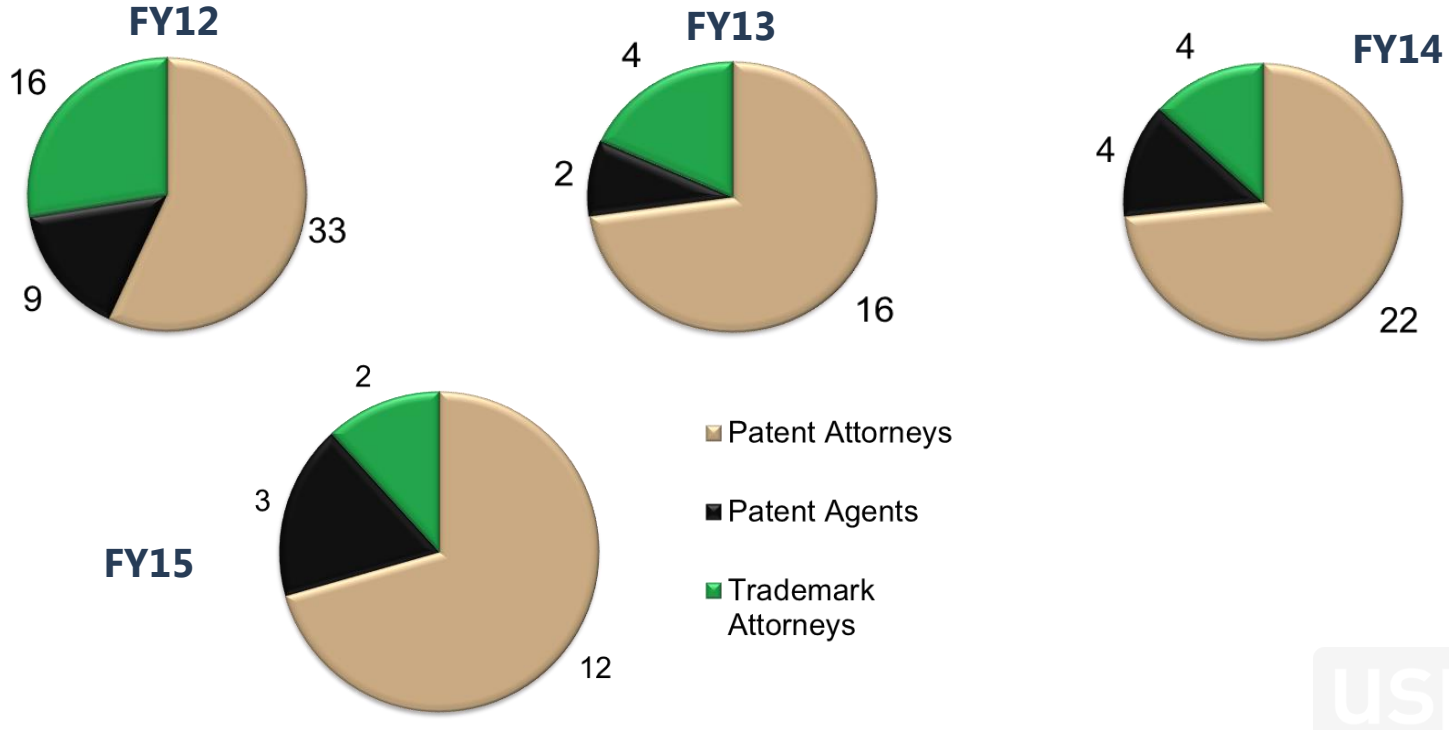
Total Number of OED Disciplinary Decisions

Breakdown of Reciprocal vs. Non-Reciprocal Formal Decisions



Total Number of OED Disciplinary Decisions

Breakdown of Disciplinary Decisions by Practitioner Type



OED Enrollment: Law School Clinic Certification Program

- Allows students in a participating law school's clinic program to practice before the USPTO in under the strict guidance of a Law School Faculty Clinic Supervisor.
- The OED Director grants participating law students limited recognition to practice before the USPTO.
- Recent expansion added 19 schools.
- 42 law schools actively participate:
  - 19 trademark only,
  - 6 patent only,
  - 17 both.
- Signed into law by President Obama on December 16, 2014.

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.

USPTO Rules of Professional Conduct: 37 C.F.R. Part 11

- **Section 1**: Client – Practitioner Relationship §§ 11.101-11.118.
- **Section 2**: Counselor – §§ 11.201, 11.203-204.
- **Section 3**: Advocate – §§ 11.301-11.307, 11.309.
- **Section 4**: Transactions with Persons Other Than Clients §§ 11.401-11.404.
- **Section 5**: Law Firms and Associations – §§ 11.501-11.507.
- **Section 7**: Information About Legal Services §§ 11.701-11.705.
- **Section 8**: Maintaining the Integrity of the Profession §§ 11.801-11.804.
- Savings Clause – § 11.901.

Office of Enrollment and Discipline

Recent Case Law at OED

Legal Fees

- ***In re Neeser*** (USPTO D2015-16)
  - Patent Attorney:
    - Formed a partnership w/ nonlawyer practicing patent law.
    - Failed to maintain trust accounts for clients' funds.
    - Neglected applications.
  - Suspended from practice before USPTO for 12 months.
  - Mitigating factors included remorse, cooperation w/ investigation, and no prior discipline.

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.

Prospective Clients

- ***In re Guttenberg*** (USPTO D2015-15)
  - Trademark attorney:
    - Filed post-registration trademark documents on behalf of trademark registrants after sending solicitation letters to registrants who had upcoming renewals due.
    - Solicitation letters were confusing and may have been misconstrued by recipients as being mailed by United States Government.
  - Received public reprimand and two-year probation.

Neglect

- ***In re Tachner*** (USPTO D2012-30)
  - Patent attorney; disciplinary complaint alleged:
    - Failed to report Office communications and docket due dates.
    - Apps. became abandoned; patents expired for failure to pay maint. fees.
    - Used handwritten docket book and "white board" for docketing USPTO due dates; later simple MS Word document was used.
    - Staff was undertrained and underequipped.
  - Suspended from practice before USPTO for 5 years.

- ***In re Kubler*** (USPTO D2012-04)
  - Patent attorney:
    - Lacked uniform system of client communication in his office. Caused inconsistent client communications practices and communications delay.
  - Received Public Reprimand:
    - As part of Reprimand, practitioner agreed to attend practice-management classes.

Dishonesty, Fraud, Deceit or Misrepresentation

- ***In re Hicks*** (USPTO D2013-11)
  - Trademark attorney:
    - Sanctioned by EDNY for non-compliance with discovery orders.
    - Federal Circuit affirmed sanction and found appellate brief to contain "misleading or improper" statements.
  - Received public reprimand and one-year probation.

- ***In re Reardon*** (USPTO D2012-19)
  - Patent agent; president of non-profit organization.
  - Disciplinary complaint alleged:
    - Misappropriated at least $116,894 from non-profit org. for personal use.
    - Used non-profit's credit card for personal use without authorization.
    - Submitted false annual financial reports to conceal his conduct.
  - Excluded from practice before the USPTO.

Dishonesty, Fraud, Deceit or Misrepresentation

- ***In re Goldstein*** (USPTO D2014-10)
  - Patent attorney; disciplinary complaint alleged:
    - Falsely informed clients he filed patent and TM applications on their behalf and that applications were being examined.
    - Created and sent clients fake filing receipts for patent applications.
    - Created fake cease-and-desist letters allegedly sent to potential infringers.
    - Created phony response to fictitious inquiry from patent examiner.
    - Billed clients for services he did not perform and fees he did not pay.
  - Excluded from practice before the USPTO.

Fee-Related Issues

- ***In re York*** (USPTO D2011-35)
  - Patent attorney:
    - Contract attorney to law firm, claimed firm owed him money.
    - *Inter alia*, deposited payments from firm client into personal account without informing firm.
    - Used firm's deposit account in violation of firm policy.
  - Received public reprimand and 2 year probation.
- ***In re Lane*** (USPTO D2013-07)
  - Patent agent:
    - Sent notice of charges for services rendered to client without demand for payment, as parties were working on potential business relationship that would subsume the charges.
    - Later sent an invoice for the charges and added an 18% interest charge from first notice.
    - Because client was unaware that interest was accruing, interest charge was excessive fee and disreputable conduct.
  - 18-month suspension added to earlier discipline.

Unauthorized Practice of Law

- ***In re Pham*** (USTPO D2015-01)
  - Patent Agent (Former Attorney):
    - Represented ex-wife in trademark dispute
    - Signed emails as "Associate General Counsel"
    - Emails contained legal opinions
  - Received public reprimand.

- ***In re Campbell*** (USPTO D2014-11)
  - Patent agent:
    - Represented person in Colorado matter involving DUI charges.
    - Attempted to claim he was "attorney in fact" for driver.
    - Sued City of Colorado Springs in civil court on behalf of driver.
    - Appeared on behalf of driver in license revocation hearing.
  - For this and other misconduct, excluded from practice before the USPTO.

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.

Duty to Supervise

- ***In re Druce*** (USPTO D2014-13)
  - Non-lawyer assistant fabricated filings and office communications
  - Signed patent attorney's signature to filings.
  - Failure to adequately supervise non-lawyer assistant.
- 2-year stayed suspension and 2-year probation upon reinstatement

Inequitable Conduct

- ***In re Tendler*** (USPTO D2013-17)
  - Patent Attorney
    - Filed Rule 131 declaration re: actual reduction to practice.
    - Later learned from client that the facts were not accurate.
    - Did not advise office in writing of inaccuracy.
- 4-year suspension for conduct prejudicial to the administration of justice.

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 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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DEPARTMENT OF COMMERCE