

OED Update: Statistics and Case Law at OED



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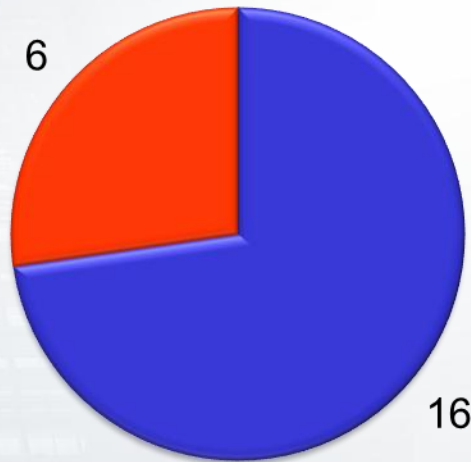
Total Number of OED Disciplinary Decisions

Breakdown of Reciprocal vs. Non-Reciprocal Formal Decisions

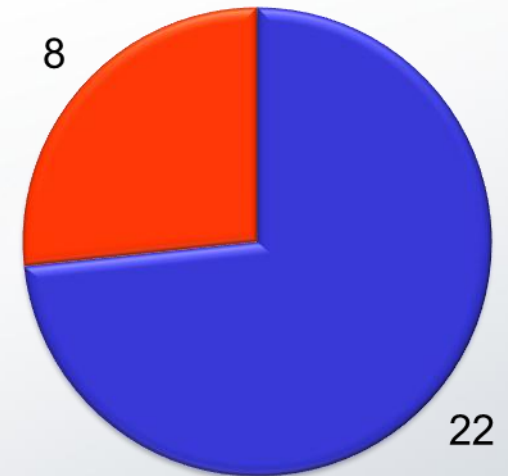
FY12



FY13



FY14

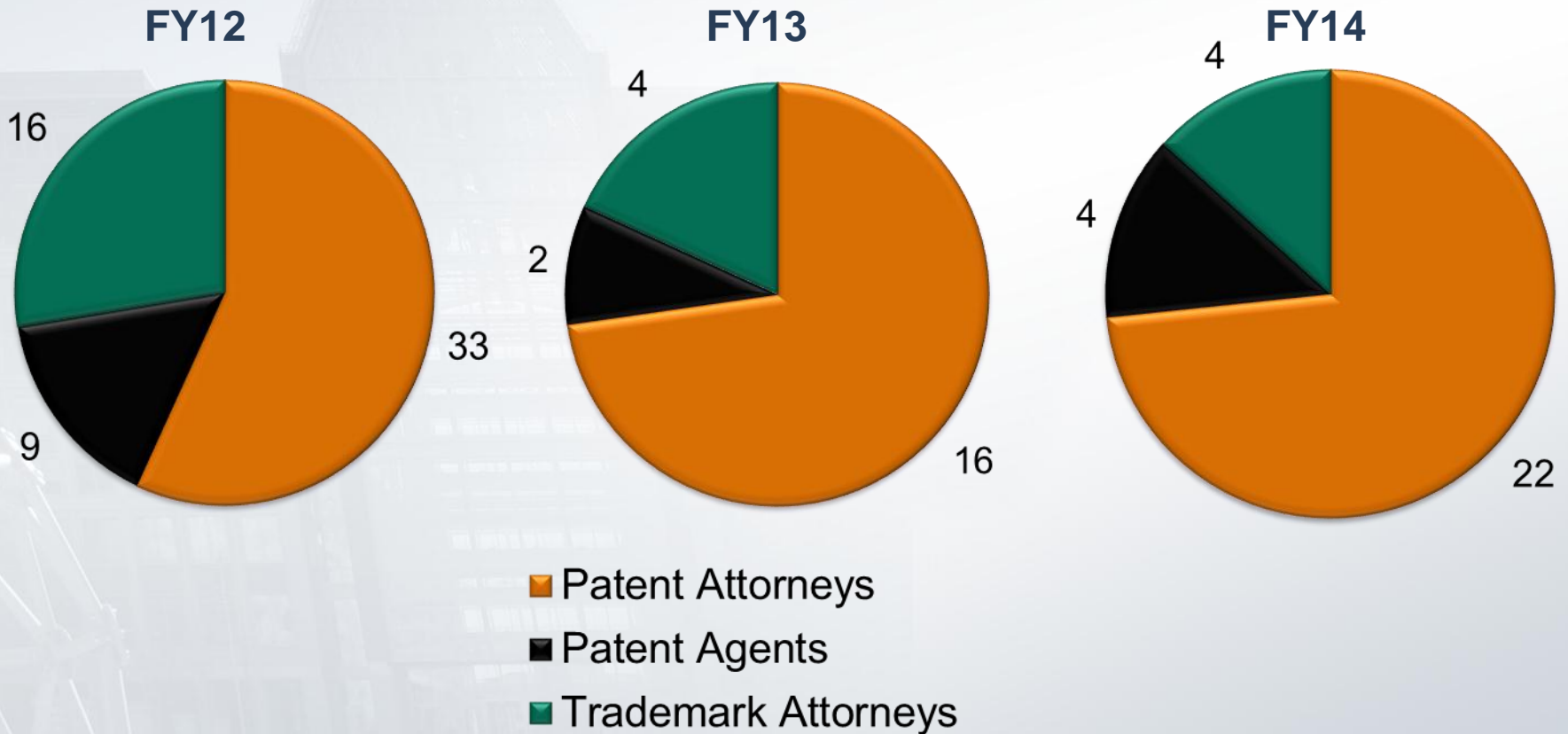


■ Non-Reciprocal ■ Reciprocal



Total Number of OED Disciplinary Decisions

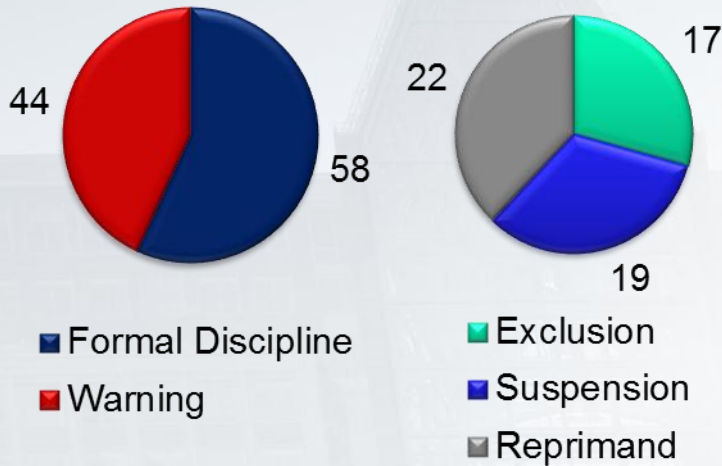
Breakdown of Disciplinary Decisions by Practitioner Type



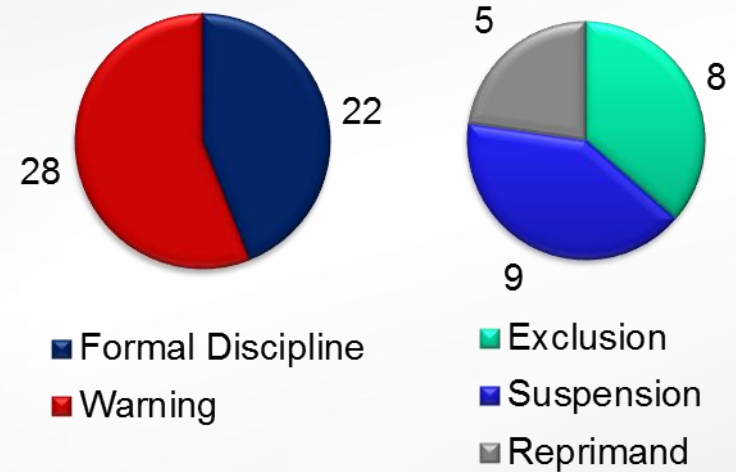


OED Disciplinary Decisions

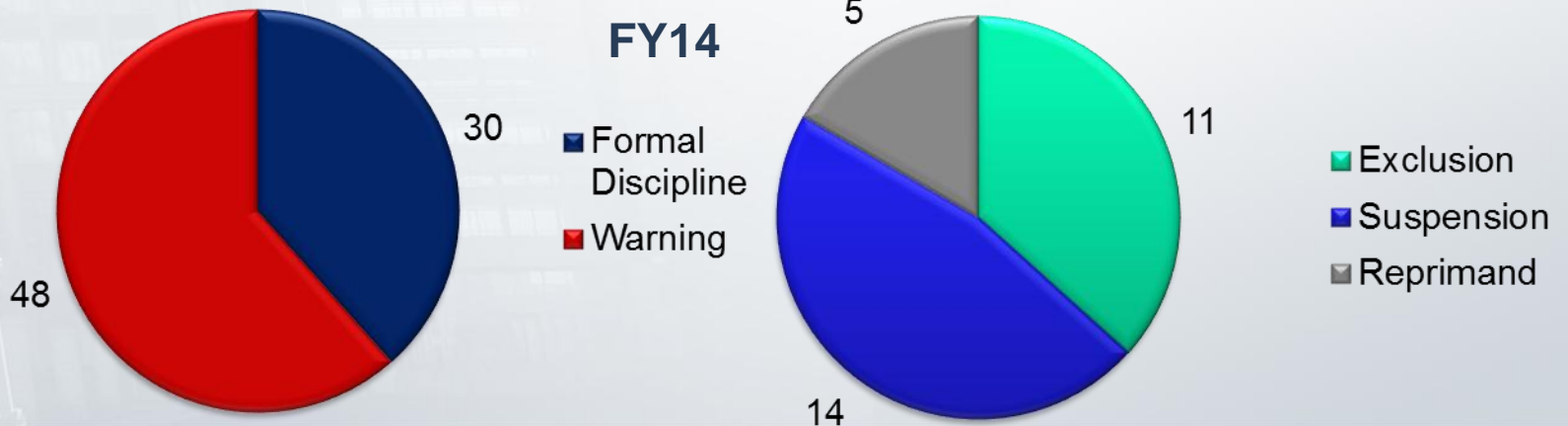
FY12



FY13



FY14





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 - Appellate brief failed to inform court that a case citation was non-precedential.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 Tassan*** (USPTO D2003-10)
 - Registered patent attorney represented client in opposition proceeding before the TTAB.
 - After the TTAB issued Final Decision sustaining opposition to client's trademark application, attorney left voicemail messages for 3 different TTAB Administrative Judges.
 - Each voicemail message contained expletives and abusive language.
 - Attorney apologized with voicemail and floral arrangement.
 - Claimed he was sick and taking strong cough medicine.
 - Attorney had previously engaged in *ex parte* communication with TTAB judges that included inappropriate language.
 - Reprimanded.
 - Prohibited from communications with TTAB judges for 2 years.
 - Ordered to complete anger management course.



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 Tendler*** (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
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