A Summary of Recent Activity at OED

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Total Number of OED Disciplinary Decisions

Breakdown of Reciprocal vs. Non-Reciprocal Formal Decisions

FY12
- Reciprocal: 30
- Non-Reciprocal: 28

FY13
- Reciprocal: 6
- Non-Reciprocal: 16

FY14
- Reciprocal: 8
- Non-Reciprocal: 22

FY15
- Reciprocal: 4
- Non-Reciprocal: 7
Total Number of OED Disciplinary Decisions

Breakdown of Disciplinary Decisions by Practitioner Type

<table>
<thead>
<tr>
<th>FY12</th>
<th>FY13</th>
<th>FY14</th>
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</thead>
<tbody>
<tr>
<td>Patent Attorneys</td>
<td>33</td>
<td>16</td>
</tr>
<tr>
<td>Patent Agents</td>
<td>9</td>
<td>4</td>
</tr>
<tr>
<td>Trademark Attorneys</td>
<td>16</td>
<td>4</td>
</tr>
</tbody>
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- FY12: 16 Disciplinary Decisions
- FY13: 4 Disciplinary Decisions
- FY14: 4 Disciplinary Decisions
- FY15: 2 Disciplinary Decisions
• 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

- FY2012: 22
  - Reprimand: 19
  - Suspension: 5
  - Exclusion: 17
- FY2013: 22
  - Reprimand: 11
  - Suspension: 8
  - Exclusion: 5
- FY2014: 22
  - Reprimand: 4
  - Suspension: 11
  - Exclusion: 4
- FY2015: 22
  - Reprimand: 3
  - Suspension: 14
  - Exclusion: 4
OED Discipline: Warnings vs. Formal Discipline

- FY2012: Warning Letters 58, Formal Discipline 44
- FY2013: Warning Letters 28, Formal Discipline 22
- FY2014: Warning Letters 48, Formal Discipline 30
- FY2015: Warning Letters 12, Formal Discipline 11
• 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.
Recent Orders
• **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.
• **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.
  – 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 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](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
    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