

# Professional Responsibility at the USPTO



**William R. Covey**

Deputy General Counsel and Director

Office of Enrollment and Discipline

United States Patent and Trademark Office



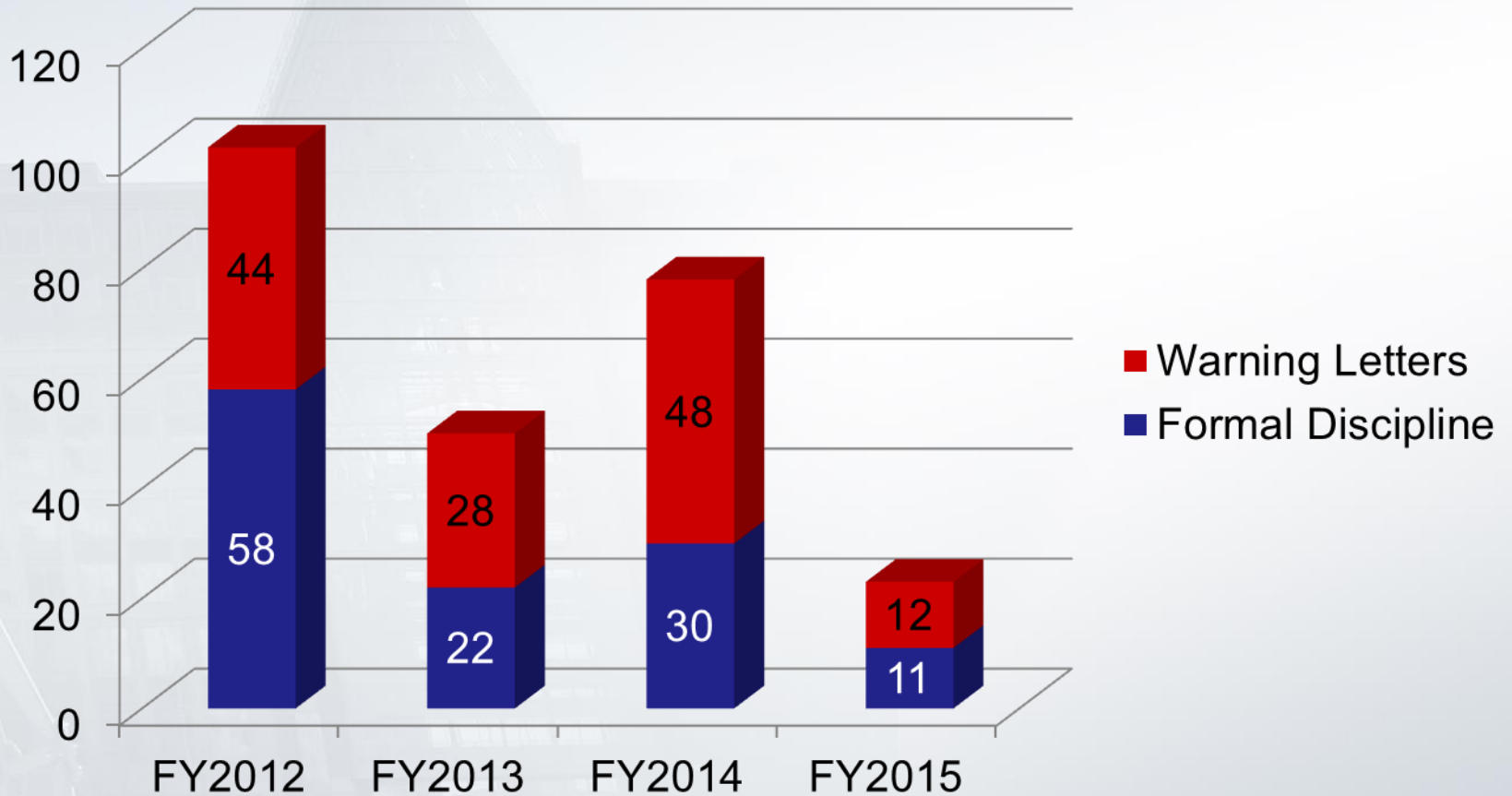
# OED Discipline: Warnings vs. Formal Discipline

- Formal discipline, with a few exceptions, constitutes public discipline.
- Formal disciplinary sanctions include:
  - Exclusion from practice before the Office;
  - Suspension from practice before the Office;
  - Reprimand or censure; or
  - Probation.

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.

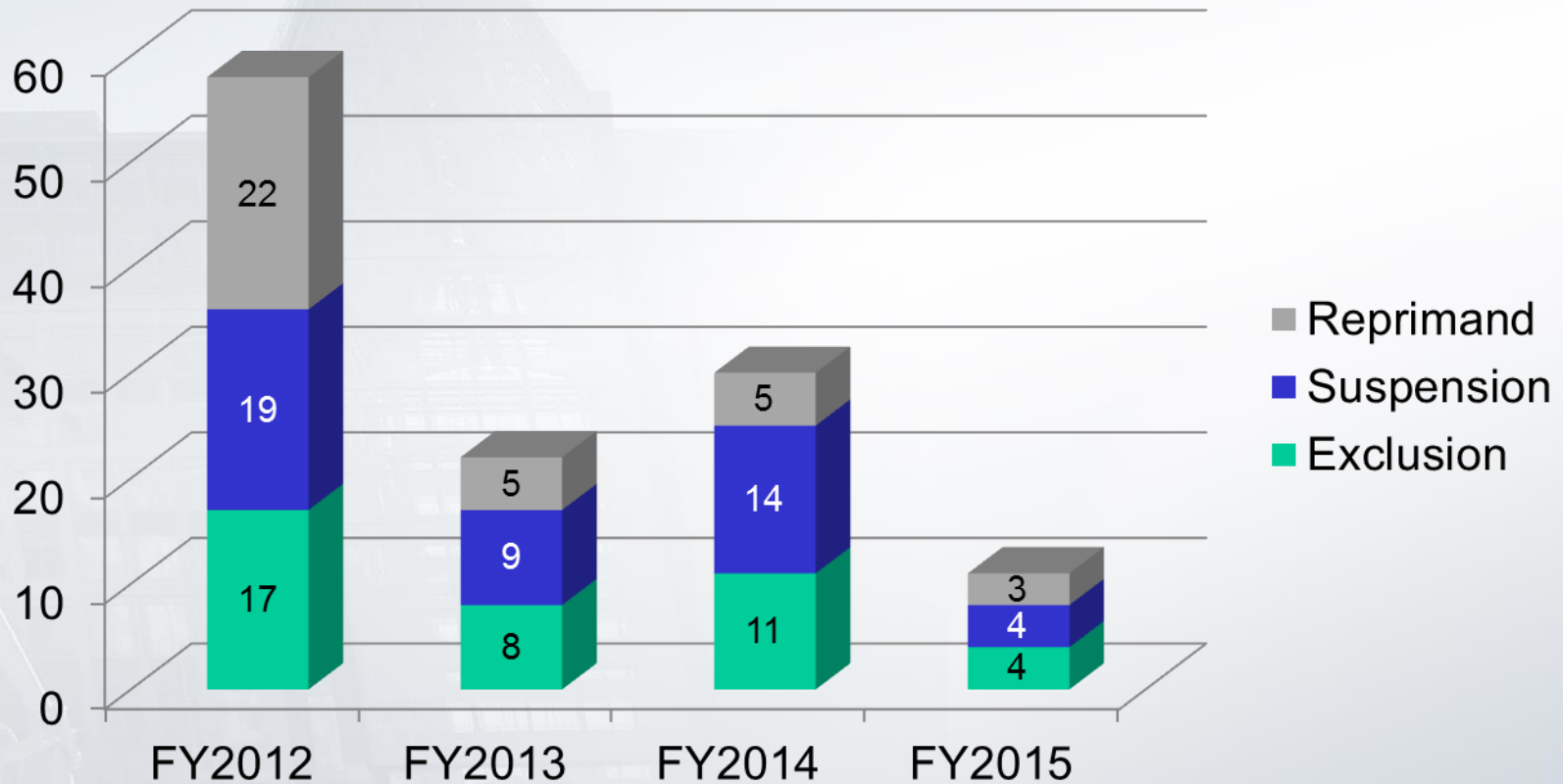


# OED Discipline: Warnings vs. Formal Discipline





# OED Discipline: Types of Discipline





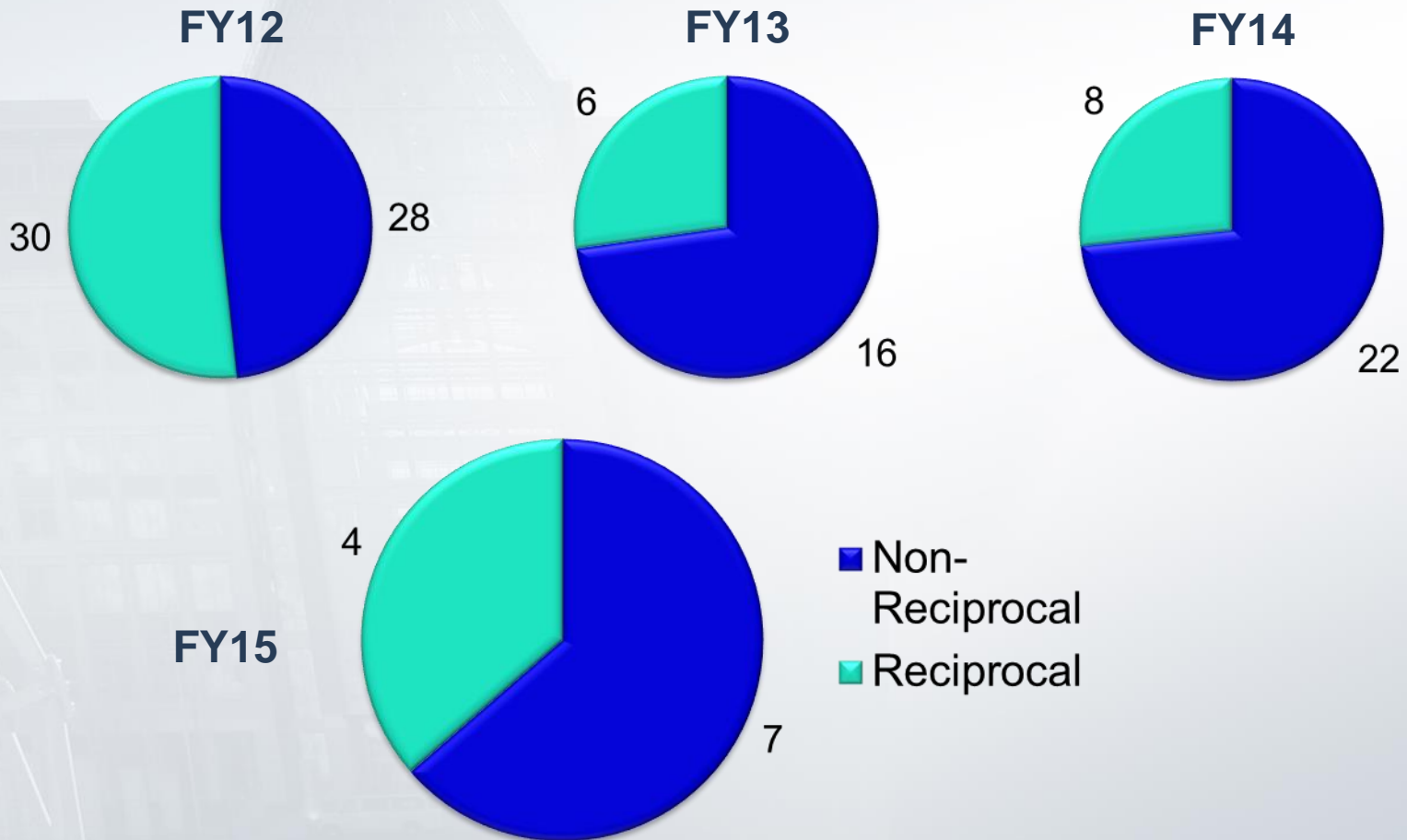
# Other Types of Discipline

- Reciprocal discipline. 37 C.F.R. § 11.24
  - Based on discipline by a state or federal program or agency.
  - Usually conducted on documentary record only.
- Interim suspension based on conviction of a serious crime. 37 C.F.R. § 11.25



# Total Number of OED Disciplinary Decisions

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

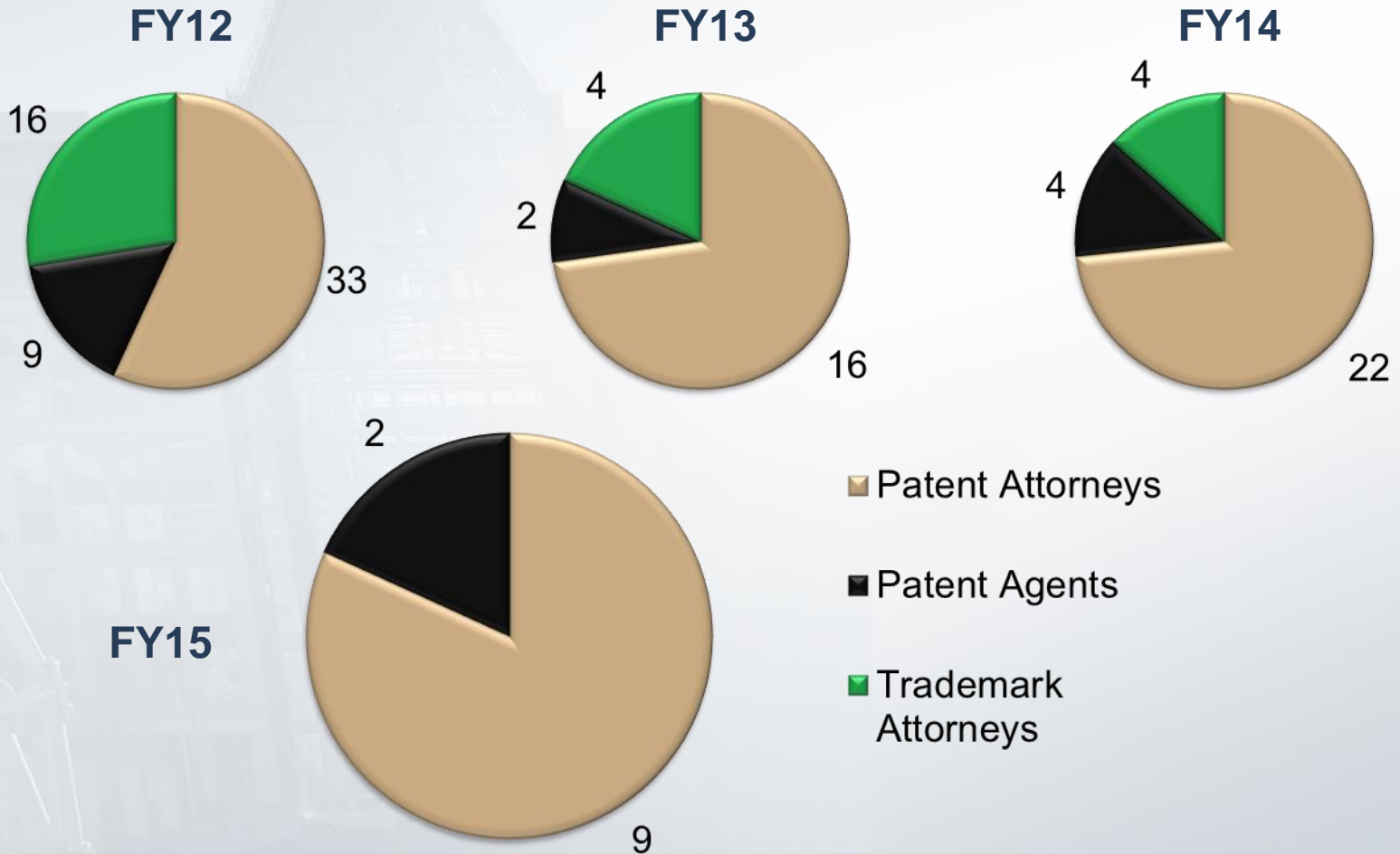






# Total Number of OED Disciplinary Decisions

## Breakdown of Disciplinary Decisions by Practitioner Type





# Office of Enrollment and Discipline

## Recent Case Law at OED





# 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.



# Neglect

- *In re Frantz* (USPTO D2012-32)
  - Patent and trademark attorney; disciplinary complaint alleged:
    - Neglected 33 patent and 19 trademark matters.
    - Allowed applications to go abandoned without informing clients.
  - Excluded from practice before the USPTO.
- *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.



# 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.



# Additional Examples

- *In re Druce* (USPTO D2014-13)
  - Patent Attorney:
    - Attorney's assistant fabricated filings and USPTO communications.
    - Signed attorney's signature to filings with USPTO.
  - Failure to adequately supervise non-lawyer assistant.
  - 2-year stayed suspension and 2-year probation upon reinstatement.
  
- *In re Caracappa* (USPTO 2014-02)
  - Patent Attorney:
    - Authorized subordinate to send email to PTAB judge regarding Inter-Partes Review without copying opposing counsel.
  - Received public reprimand.



# Additional Examples

- *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 the Office in writing of the inaccuracy.
  - 4-year suspension for conduct prejudicial to the administration of justice.
  
- *In re Tassan* (USPTO 2003-10)
  - TM Attorney:
    - Left abusive voicemail messages for 3 different TTAB judges.
  - Received public reprimand and ordered to complete anger management course.





# 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.





# Panel Discussion

- Moderator:
  - **Will Covey** – Deputy General Counsel for Enrollment and Discipline; Director: Office of Enrollment and Discipline.
- Panelists:
  - **Brian Hanlon** – Director: Office of Patent Legal Administration.
  - **Cynthia Lynch** – Administrator for Trademark Policy and Procedure.
  - **Tim Rooney** – OED Staff Attorney.



# Duty of Disclosure/Candor

- Disclosure of confidential client information that is material to the patentability of pending patent claims.
- Concurrent litigation and prosecution (*e.g.*, reexamination).
  - Protective orders.
- Representations in light of conflicting or incomplete evidence.



# Unauthorized Filings

- Filings made by parties not authorized to act by applicant.
- Trademark Cases:
  - For example:
    - Assignment documents.
    - Express abandonments.
- Patent Cases:
  - For example:
    - Assignment documents.
    - Information disclosure statements.
    - “Correction” of inventorship.



# Communication with Client

- A response due date is fast approaching in a patent or TM application.
  - Client has not explicitly authorized action (or inaction) for the due date.
- The Office receives an incomplete filing in an application.
  - Was response intentionally incomplete?



# Unauthorized Practice of Law

- Examiner calls attorney/agent's office regarding a proposed amendment.
  - Paralegal or assistant takes call.
- Client calls attorney's/agent's paralegal or assistant to discuss an application.
- Paralegal or assistant calls PTO with questions about an application.



# Contact Information

OED: (571) 272-4097

TM Petitions Office: (571) 272-8950  
(press zero; ask for Staff Attorney)

OPLA: (571) 272-7701