Professional Responsibility at the USPTO

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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

FY2012: 58 Warning Letters, 44 Formal Discipline
FY2013: 28 Warning Letters, 22 Formal Discipline
FY2014: 48 Warning Letters, 30 Formal Discipline
FY2015: 12 Warning Letters, 11 Formal 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

<table>
<thead>
<tr>
<th>Year</th>
<th>Reciprocal</th>
<th>Non-Reciprocal</th>
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<tbody>
<tr>
<td>FY12</td>
<td>30</td>
<td>28</td>
</tr>
<tr>
<td>FY13</td>
<td>6</td>
<td>16</td>
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<tr>
<td>FY14</td>
<td>8</td>
<td>22</td>
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<tr>
<td>FY15</td>
<td>4</td>
<td>7</td>
</tr>
</tbody>
</table>
Total Number of OED Disciplinary Decisions

Breakdown of Disciplinary Decisions by Practitioner Type


Recent Case Law at OED
• *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.
• **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](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.
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.
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