

**The opinion in support of the decision being entered
today is not binding precedent of the Board**

Paper 361

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Filed
11 May 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

W. FRENCH ANDERSON, R. MICHAEL BLAESE
and STEVEN A. ROSENBERG,

Junior Party
(Patent 5,399,346),

v.

DEBORAH A. EPPSTEIN, PHILIP L. FELGNER, THOMAS R. GADEK,
GORDON H. JONES and RICHARD B. ROMAN,

Senior Party
(Application 08/609,702).

Disqualification Case No. 98-1
(Interference 103,708)

Before McKELVEY, Senior Administrative Patent Judge, and
GARDNER-LANE, and MEDLEY, Administrative Patent Judges.

MEDLEY, Administrative Patent Judge.

DECISION ON ANDERSON PETITION TO DISQUALIFY

This is a decision on Anderson's petition to disqualify Paul N. Kokulis, Esq. ("Kokulis"), and the law firm of Pillsbury, Madison and Sutro, LLP (now believed to be Pillsbury Winthrop LLP) ("Pillsbury") from representing Eppstein in Interference 103,708.

During a conference call on April 4, 2001, counsel for Anderson and Eppstein orally waived a hearing, including an evidentiary hearing.¹ For reasons that follow, Anderson's petition is denied.

A. Findings of fact

1. The real party in interest with respect to Anderson is the United States of America, as represented by the Department of Health and Human Services (HHS).

2. The National Institutes of Health (NIH) is an agency within HHS.

3. At all times relevant to any issue raised by Anderson's petition for disqualification, W. French Anderson is believed to have been an employee of NIH.

¹ See 35 U.S.C. § 32, which provides that [t]he Commissioner may, after notice and opportunity for a hearing, *** exclude [i.e., disqualify], either generally or in any particular case an individual from practice before the U.S. Patent and Trademark Office (PTO). A disqualification proceeding is a proceeding under 35 U.S.C. § 32. The panel is designated to conduct the hearing required by § 32.

4. The 07/365,567 (567) application is the first of a series of continuing applications that led to the grant of the Anderson patent involved in Interference 103,708.²

5. Anderson has been accorded the benefit for the purpose of priority of four earlier filed U.S. applications, including the 567 application, filed June 14, 1989, now abandoned.

6. Eppstein was added as a party to Interference 103,708 after it had been declared. (Int. 103,708, Paper 308).

7. On March 18, 1998, counsel for Anderson received a Notice of Lead Counsel filed on behalf of Eppstein, naming Kokulis, of Pillsbury, as lead counsel (Anderson Ex. 6).

8. Anderson alleges that Kokulis and his former firm, Cushman, Darby & Cushman ("Cushman"), now part of Pillsbury, represented Anderson in connection with the preparation and prosecution of 567.

9. Based on the alleged representation, Anderson petitions for disqualification of Kokulis and Pillsbury.

10. It is not disputed that Cushman represented NIH with respect to at least some patent matters from about 1988 until 1995.

² Anderson s involved patent is said to be (1) a continuation of 07/904,662, which is said to be (2) a continuation in part of 07/868,794, which is said to be (3) a continuation in part of 07/807,446, which is said to be (4) a continuation in part of 07/365,567 ('567).

11. A contract between NIH and Cushman is dated June 15, 1988, and was signed by (1) an individual said to be an NIH contracting officer and (2) Watson T. Scott (now deceased) (Scott), then a partner in the former Cushman law firm. (Eppstein Ex. 3).

12. The contract specifies that Cushman is to provide secondary patent legal services for a period of twelve (12) months with two additional option years. (Eppstein Ex. 3 at 2, block 15B).

13. Apparently, the contract sets forth, in generalities, work to be performed by Cushman for NIH. However, individual "task orders" were to be generated for specific work to be performed on individual projects, e.g. the preparation and prosecution of particular patent applications.

14. It is not disputed that Kokulis signed a task order, accepting for Cushman the task of preparing and filing the 567 application. (Anderson Ex. 2 and Eppstein Opp. ¶ 8 at 5).

15. It further is not disputed that Kokulis and several partners of Cushman are listed in a Power of Attorney in 567. (Anderson Pet. ¶ 12 at 3 and Eppstein Opp. at 5).

16. Anderson relies on the declaration testimony of James C. Haight, Esq. ("Haight"), of the NIH Office of Technology Transfer ("OTT") to establish that certain events occurred.

17. Haight's declaration is dated August 7, 1998.

18. Haight testifies that prior to June 14, 1989, NIH retained Cushman to prepare an Anderson patent application related to a gene therapy invention. (Haight decl. ¶ 6).

19. Haight alleges that Kokulis, as the project director, was personally involved in considering and allocating Cushman law firm professionals to the Anderson engagement. (Haight decl. ¶ 7).

20. Haight further alleges that upon signing the task order for 567, Kokulis certified that there was no conflict between the interests of the Government and any other Cushman clients. (Haight decl. ¶ 7, Anderson Ex. 2).

21. According to Haight, professionals affiliated with Cushman, including Kokulis, acted as attorneys for Anderson (actually NIH) in the preparation and prosecution of 567. (Haight decl. ¶ 10).

22. Haight asserts that in addition to Kokulis and Scott, four other unnamed individuals, who are not listed on the Power of Attorney, also worked on 567. (Haight decl. ¶ 10).

23. Haight further asserts that several of the Cushman partners listed in the Power of Attorney in 567 are currently partners at Pillsbury. (Haight decl. ¶ 12).

24. Haight concedes, however, that he was mostly responsible for overseeing patent prosecution matters at OTT [only] since 1991. (Haight decl. ¶ 1).

25. Nevertheless, Haight purports to testify with respect to certain activities that occurred prior to 1991.

26. Based on Haight's testimony, it is not apparent that (1) Haight was an employee at NIH prior to 1991, or (2) in a position to have had first-hand knowledge of events related to '576 which are said to have occurred prior to 1991.

27. Eppstein relies on the declaration testimony of Kokulis and Howard D. Doescher, Esq. (Doescher) in support of its opposition to the disqualification petition.

28. Doescher testifies that from November 1986 until August 1995, he was "Of Counsel" to Cushman. (Doescher decl. ¶ 2).

29. Doescher states that Cushman merged with Pillsbury in September 1995,³ where he remained "Of Counsel" until December 1997, when he retired. (Doescher decl. ¶ 2).

30. Doescher states that (1) Scott was the Cushman partner responsible for performance of the contract between NIH and Cushman and (2) Scott was responsible for determining who in the Cushman firm would prepare and prosecute NIH patent applications. (Doescher decl. ¶ 4).

31. Doescher states that Scott would generally sign specific task orders, unless he was unavailable, in which case

³ Kokulis indicates that the merger occurred in September 1996. Haight has also indicated that the merger occurred in September 1996. For purposes of the decision, it is irrelevant whether the merger took place in 1995 or 1996.

someone else, e.g., Kokulis might sign the task order. (Doescher decl. ¶ 5).

32. Doescher testifies that (1) information regarding NIH and their records were not made available to all Cushman staff and (2) the availability of such information was limited to Scott and those individuals he designated to assist him in the preparation and prosecution of patent applications. (Doescher decl. ¶ 8).

33. Doescher further testifies that while a Power of Attorney submitted with patent applications prepared and prosecuted by Cushman named all of the Cushman partners, not all of the partners would customarily be involved in the prosecution of the application. (Doescher decl. ¶ 9).

34. Kokulis is now a partner at Pillsbury. (Kokulis decl. ¶ 1).

35. Prior to the merger with Pillsbury, Kokulis was a partner with Cushman. (Kokulis decl. ¶ 2).

36. Kokulis testifies that when he accepted the position of lead counsel for Eppstein, he did not appreciate that Cushman had been involved with an earlier Anderson application. (Kokulis decl. ¶ 3).

37. Kokulis further testifies that Cushman was not involved with any of the latter continuing Anderson applications

that led to the issuance of the Anderson patent involved in Interference 103,708. (Kokulis decl. ¶ 4).

38. Kokulis still further testifies that toward the end of March 1998 he realized that Cushman had worked on the 567 application and informed Eppstein's patent counsel, William Schmonsees, Esq., of the firm of Heller, Ehrman, White & McAuliffe of Palo Alto, California (Heller). (Kokulis decl. ¶ 4 and 5).

39. According to Haight, and Kokulis agrees, the Heller firm contacted counsel for NIH. Counsel for NIH advised that NIH would object to Kokulis serving as counsel for Eppstein. (Haight decl. ¶ 15-16 and Kokulis decl. ¶ 5).

40. Apparently, there were communications between counsel for Anderson and Eppstein regarding consideration of a possible waiver for Kokulis. However, agreement as to a waiver could not be reached. (Haight decl. ¶ 17-19 and Kokulis decl. ¶ 5).

41. On May 13, 1998, a conference call took place between counsel for the parties and Administrative Patent Judge Andrew H. Metz. A summary of that conference call indicates that, at the time Kokulis accepted the position as lead counsel for Eppstein, Kokulis was unaware that Scott or anyone else in his firm had been involved with 567. (Anderson Ex. 11).

42. Anderson asserts that Kokulis made misrepresentations during May 13th conference call; Kokulis is said to have indicated that only Scott (and no one else) was involved in the preparation and prosecution of 567.

43. It was only after Anderson filed its petition that Kokulis became aware of the task order that he had signed in connection with the 567 application. (Kokulis decl. ¶ 6).

44. Kokulis testifies that he (1) has no recollection of signing the task order or the preparation of 567 and (2) now believes he signed the task order in the absence of Scott who was the partner in charge of NIH work. (Kokulis decl. ¶ 6).

45. Kokulis further testifies that while the task order refers to him as the Project Director, the director of the project (567), in fact, was Mr. Scott. (Kokulis decl. ¶ 7).

46. Kokulis still further testifies that he was not involved in the preparation or prosecution of 567. (Kokulis decl. ¶ 7 and 14).

47. Kokulis lastly testifies that he does not recall seeing any disclosures describing 567 or having any discussions with anyone about the subject matter of 567. (Kokulis decl. ¶ 7).

48. With respect to the preparation and prosecution of 567, Kokulis states that (1) he believes that only Scott and

Karen Krupen ("Krupen") recorded time with respect to 567, and (2) records indicate that for the hundreds of hours Cushman attorneys billed time to NIH projects, Kokulis billed one half hour to an unrelated NIH project (i.e. not the 567 application). (Kokulis decl. ¶ 7 and 22, King decl. ¶ 6 and 7).

49. The 567 application was filed, on behalf of NIH, by Scott. A response filed in the PTO, dated March 18, 1991 was signed by Doescher for Scott. (567 application, Kokulis decl. ¶ 9).

50. Kokulis believes that only Scott, Doescher, Krupen and Mary Wilson ("Wilson") (along with a secretary and possibly technical assistant Barbara Gibson ("Gibson")) prepared and prosecuted 567. (Kokulis decl. ¶ 9-11).

51. Scott left Cushman in 1994 and died in 1997.

52. Krupen left Cushman in 1991.

53. Doescher retired from Cushman at the end of 1997.

54. Wilson left Cushman in 1993.

55. Gibson left Cushman a number of years ago.

56. Contrary to assertions by Haight, Kokulis testifies that none of the individuals that prepared and prosecuted 567 are now with Pillsbury. (Kokulis decl. ¶ 9-11, 14 and 20).

57. Kokulis indicates that (1) he did not see an invention disclosure of 567, and (2) he has no recollection of

any information that Anderson (i.e., NIH) made to Scott or Krupen. (Kokulis decl. ¶ 12).

58. Kokulis further indicates that it was standard practice for Cushman to list all partners as having power of attorney in patent applications, and that he believes that is the standard practice of other firms. (Kokulis decl. ¶ 23).

59. The 567 application file that Cushman at one time had in its possession was returned to NIH in 1994. (Anderson Ex. 8).

60. Eppstein submits that Cushman's obligation to certify the absence of a conflict regarding individual task orders was in connection with brief information about a general technical area, such that the task description was generally considered sufficient to determine whether or not there might be a conflict. (Doescher decl. ¶ 7, Eppstein Opp. ¶ 42 at 13, Eppstein Ex. 3, Appendix II).

61. According to the file of Interference 103,708, Anderson does not intend to rely on 567 for purposes of priority in the interference.⁴ (Interference 103,708, Paper 140 and Eppstein Ex. 10).

⁴ Morgan filed a preliminary motion 1 attacking the benefit for the purpose of priority accorded to Anderson in the notice declaring interference as to 567. In its opposition, Anderson states that it does not rely on 567 for purposes of priority and does not intend to oppose Morgan preliminary motion 1.

62. Anderson had a right to cross-examine Kokulis and Doescher; it waived that right.

63. Eppstein had a right to cross-examine Haight; it waived that right.

B. Discussion

Disqualification petitions in PTO proceedings are authorized by 35 U.S.C. § 32 and 37 CFR § 10.130(b). Rule 10.130(b) provides that petitions to disqualify a practitioner ... will be handled on a case-by-case basis under such conditions as the Commissioner deems appropriate. While the PTO has no specific rules which govern disqualification petitions, generally the provisions of the PTO Code of Professional Responsibility, aided by decisions of federal courts, govern resolution of a disqualification.

Petitions to disqualify an attorney are within the discretion of the deciding tribunal, and such rulings will be overturned only upon showing of an abuse of discretion. Telectronics Proprietary, Ltd. v. Medtronic, Inc., 836 F.2d 1332, 1335, 5 USPQ2d 1424, 1427 (Fed. Cir. 1988); Fred Weber, Inc. v. Shell Oil Co., 566 F.2d 602, 608 (8th Cir. 1977), cert. denied, 436 U.S. 905 (1978), overruled on other grounds, In Re Multi-Piece Rim Products Liability Litigation, 612 F.2d 377 (8th Cir. 1980), vacated and remanded, 449 U.S. 368 (1981)

(disqualification is a matter of discretion with the deciding tribunal).

Disqualification is resolved on a case-by-case basis, where the moving party bears a heavy burden of proving facts showing that disqualification is necessary. Evans v. Artek Sys. Corp., 715 F.2d 788, 791 (2d Cir. 1983). See also Government of India v. Cook Industries, Inc., 569 F.2d 737, 739 (2d Cir. 1978).

Further, when determining if disqualification is appropriate, it is necessary to balance the interest of a party's right to retain counsel of its choice versus preserving the integrity of the adversary process. In re ML-Lee Acquisition Fund II, L.P. Litigation, 848 F.Supp. 527, 556 (D. Del. 1994).

Anderson argues that Kokulis has violated Canons 1 and 4 of the PTO Code of Professional Responsibility and should be disqualified. (Anderson Pet. at 11). Specifically, Anderson argues that disqualification of Kokulis and Pillsbury is appropriate under the substantial relationship test applied by the various federal courts.

A practitioner should preserve the confidences and secrets of a client. 37 CFR § 10.56. See also In re Del-Val Financial Corp. Sec. Litig., 158 F.R.D. 270, 273 (S.D.N.Y. 1994). An attorney may be disqualified based on this principle as explained in the seminal case of T.C. Theatre Corp. V. Warner Bros.

Pictures, Inc., 113 F.Supp. 265 (S.D.N.Y. 1953). The holding in T.C. Theatre is as follows, 113 F. Supp at 268-69:

[T]he former client need show no more than that the matters embraced within the pending suit wherein his former attorney appears on behalf of his adversary are substantially related to the matters or cause of action wherein the attorney previously represented him, the former client. The Court will assume that during the course of the former representation confidences were disclosed to the attorney bearing on the subject matter of the representation. It will not inquire into their nature and extent. Only in this manner can the lawyer's duty of absolute fidelity be enforced and the spirit of the rule relating to privileged communications be maintained.

To compel the client to show, in addition to establishing that the subject of the present adverse representation is related to the former, the actual confidential matters previously entrusted to the attorney and their possible value to the present client would tear aside the protective cloak drawn about the lawyer-client relationship.

On some occasions, the term substantially related has been narrowly interpreted to mean identical or essentially the same. New York Marine & General Insurance Co. v. Tradeline and Deepak Fertilizers and Petrochemicals Corp., 186 F.R.D. 317 (S.D.N.Y. 1999). In our view, Anderson must demonstrate that (1) the subject matter of the 567 application is identical or essentially the same as the subject matter in the Anderson patent

involved in Interference 103,708, and (2) the relationship between Kokulis and Anderson is a prior representation within the meaning of the substantial relationship test.

Anderson relies on case law to support its position that the subject matter of 567 is substantially related to the subject matter in the interference. (Anderson Pet. at 14). However, in none of the cases relied upon by Anderson are the facts the same as the facts before us. Unlike the facts in the cases Anderson cites, here the Cushman firm prepared and prosecuted only the first of a series of several continuing applications that ultimately led to the granting of the Anderson patent. Most of the applications in the Anderson chain are continuations-in-part of a prior application. The specification in the file of the involved Anderson patent is 37 pages versus the 567 specification which is 21 pages, indicating that the two are not the same. This is not a situation, as in Sun Studs, Inc. v. Applied Theory Associates, Inc., 772 F.2d 1557, 1565 (Fed. Cir. 1985), where the same law firm and attorney prepared and prosecuted the patent application to issuance (from beginning to end).

Anderson further argues that (1) 567 is specifically referenced in the Anderson patent, (2) the disclosure of 567 is incorporated in its entirety into the Anderson patent specification, (3) the 567 figures are the same as several of

the Anderson patented figures, and (4) the examples in 567 are also found in the Anderson patent. (Anderson Pet. at 15).

While there may be some overlap between the Anderson patent disclosure and the 567 disclosure, Anderson has failed to demonstrate, for example, that the 567 application describes or essentially describes the interfering subject matter (i.e., the subject matter of Anderson's claims involved in Interference 103,708). Until that is demonstrated, we decline to find that similar facts and legal issues were involved in the prosecution of '576 and in Interference 103,708.

Anderson directs us to a chart comparing certain Anderson patent claims with certain 567 claims to demonstrate that a substantial relationship exists. Anderson then concludes that since all of the Anderson patent claims have been designated as corresponding to the count, then the subject matter in 567 is substantially related to the Anderson patent. (Anderson Pet. at 16-17). That facially there appears to be some overlap between a few of the 567 claims and a few of the Anderson patent claims does not, without more, demonstrate that 567 is substantially the same or identical to the Anderson patent. Anderson has failed to demonstrate that the claims it compares are identical or essentially the same subject matter. There are at least two noted differences in the claims that Anderson compares. The 567 claim 1 recites enhancing blood cells that are infused in a

patient. The Anderson patented claim 1 recites introducing modified cells into a human. The 567 claim 1 recites inserting the modified cells into the same patient from whom the cells were taken. The Anderson patented claim 1 recites introducing modified cells into a human (not necessarily the same human from whom the cells were taken, but any human).

Anderson provides no explanation of any differences between the two sets of claims in its chart. We further note that Anderson no longer relies on the 567 application for purposes of priority in the interference. (Finding 61). Accordingly, there is an inference that 567 and the Anderson application are not identical or essentially the same. Anderson has failed to overcome the inference.

Further, we will not take up the role of counsel in the first instance and compare 567 with the Anderson patent to ascertain whether the two are essentially the same, i.e. that the interfering subject matter is described in 567. That is the role of counsel. Ernst Haas Studio, Inc. v. Palm Press, Inc., 164 F.3d 110, 112, 49 USPQ2d 1377, 1379 (2d Cir. 1999) (declining invitation to scour record to make out a party's case for it). "Judges are not like pigs, hunting for truffles buried in briefs." United States v. Dunkel, 927 F.2d 955, 956 (7th Cir. 1991).

For the reasons stated above, Anderson has failed to demonstrate that the subject matter in 567 is essentially the same or identical to the subject matter in the Anderson patent.

Anderson arguably could prevail if it could successfully demonstrated that Kokulis actually received confidential information. See, e.g., Original Appalachian Artworks v. May Dept. Stores, 640 F.Supp 751, 756 (N.D. Ill. 1986). Anderson says Kokulis received confidential information, relying on the fact that (1) Kokulis was listed on the Power of Attorney in 567 and (2) Kokulis signed off on the task order for preparing and prosecuting 567. (Findings 13 and 14). Anderson concludes that, for Kokulis to sign his name to the task order certifying that there was no conflict between the interest of the Government and other clients of the firm, Kokulis had to be intimately involved with the subject matter of 567.

We agree with Eppstein that listing all partners in a law firm as having power of attorney is customary and does not properly convey the idea that all of the listed attorneys are actually involved in the preparation and prosecution of an application. We take official notice that it is common knowledge that not every attorney listed as having power of attorney is responsible or even involved in the preparation and prosecution of a patent application. Fed. R. Evid. 201; see also, In re Ahlert, 424 F.2d 1088, 1091, 165 USPQ 418, 420-21 (CCPA 1970)

(PTO tribunals, where it is found necessary, may take notice of facts beyond the record which, while not generally notorious, are capable of such instant and unquestionable demonstration as to defy dispute).

Kokulis testifies that he did not receive any information regarding 567. (Findings 46-48). Kokulis further testifies, along with supporting evidence, that he had no involvement in the preparation or prosecution of 567. (Findings 46 and 48).

Kokulis still further testifies that he believes that he signed the specific task order in the absence of Scott. Both Kokulis and Doescher testify that Scott, not Kokulis, was the project director for all NIH projects. (Findings 30 and 45). Further, there is no indication that Kokulis, upon signing the task order, had to be intimately involved with the subject matter of 567 to signify that there was no conflict of interest. (Finding 60). The record convincingly establishes that the Cushman attorneys that actually worked on the 567 application are no longer affiliated with the Pillsbury law firm. (Findings 50-56).

Eppstein further submits evidence that demonstrates that the 567 file was returned to NIH, indicating that individuals at Pillsbury currently do not have information with respect to 567, apart from that received in Interference 103,708. (Finding 59). The record further establishes that while Cushman was responsible for the preparation and prosecution of the 567 application, it

was not responsible for the preparation and prosecution of any subsequent continuing applications that led to the Anderson patent. (Finding 37).

We find that the declaration testimony of Kokulis and Doescher is highly credible. In this respect, we credit the declaration testimony of Eppstein's witnesses Kokulis and Doescher over the declaration testimony of Anderson's witness Haight whenever there is a conflict.⁵ Cf. Semiconductor Energy Laboratory Co. v. Samsung Electronics Co., 4 F.Supp.2d 477, 483 n.8, 46 USPQ2d 1874, 1879 n.8 (E.D. Va. 1998) ("In this regard, and indeed generally, the Court credits the testimony of Samsung's witnesses Dr. Fonash, Dr. Tsai, and Dr. Meyerson over SEL's witnesses Dr. Lucovsky and Dr. Yamazaki whenever there is a conflict."), aff'd, 204 F.3d 1368, 1376, 54 USPQ2d 1001, 1007 (Fed. Cir. 2000) ("As a generally matter, we first note that the district court found Dr. Yamazaki and SEL's other witnesses to be not credible. Instead, the district court credited the testimony of Samsung's witnesses over that of SEL's whenever there was a conflict.").

⁵ The parties were entitled to an evidentiary hearing in this matter, where witnesses could have been cross-examined and their demeanor observed. As noted earlier, however, both parties waived a hearing and cross-examination. Hence, our credibility determinations are made on the basis of declarations. See Purdue Pharma L.P. v. Boehringer Ingelheim GmbH, 237 F.3d 1359, 1366, 57 USPQ2d 1647, 1651 (Fed. Cir. 2001), where Chief Judge Mayer for the court notes that "[t]he district court credited the testimony via declaration of Robert F. Kaiko, one of the named inventors ***, together with three exhibits that it found demonstrated conception and [actual] reduction to practice" (emphasis added).

Haight testifies to events that occurred prior to his apparent 1991 employment or involvement with NIH. (Finding 24). Haight does not testify as to how he is knowledgeable of the events that took place prior to 1991. Kokulis and Doescher have first-hand knowledge of Cushman practices and their involvement, if any, with respect to 567. Haight, on the other hand, has no knowledge of pre-1991 events and practices at Cushman.

When one lawyer at a firm possesses client confidences gained in the course of a prior representation, it can be presumed that the confidences were shared with other attorneys within the lawyer's firm. However, the presumption is rebuttable. In re Del-Val Financial Corp. Securities Litig., 158 F.R.D. 270, 274 (S.D.N.Y. 1994). Based on the record before us, Eppstein has sufficiently rebutted any presumption that confidences were shared by Scott with Kokulis or any attorney now at Pillsbury.

Anderson further argues that Kokulis has violated PTO Canon 9 and therefore should be disqualified. (Anderson Pet. at 17). It is true that under 37 CFR § 10.110, a practitioner should avoid even an appearance of professional impropriety. However, as we see it, courts generally are loath to utilize Canon 9 for disqualification. Canon 9 "should not be used promiscuously as a convenient tool for disqualification when the facts simply do not fit within the rubric of other specific

ethical and disciplinary rules." Graciano Rocchigiani v. World Boxing Counsel, 82 F.Supp.2d 182, 192 (S.D.N.Y. 2000), citing International Elecs. Corp. v. Flanzer, 527 F.2d 1288, 1295 (2d Cir. 1975).

In the cases Anderson cites to support its position, there was a determination that the current subject matter was substantially related to a prior representation, leading to a conclusion of the appearance of impropriety. In this case, however, Anderson has failed to sufficiently meet its burden to demonstrate that the subject matter described in 567 and the subject matter claimed in the Anderson patent involved in the interference are substantially related. The cases relied upon by Anderson are thus not controlling. Anderson has failed to demonstrate that PTO Canon 9 provides a cogent reason for disqualifying Kokulis.

Anderson lastly argues that Kokulis has violated several PTO and D.C. Bar disciplinary rules⁶ (Anderson Pet. at 18). According to Anderson, those violations include (1) alleged misrepresentations on the part of Kokulis and (2) Kokulis continued representation of Eppstein upon becoming aware of a potential conflict. Eppstein has called our attention to Federal

⁶ The Code of Professional Responsibility of the District of Columbia is not applicable in PTO. 35 U.S.C. § 2(b)(2)(D), formerly 35 U.S.C. § 31. Hence, we decline to address Anderson's reliance on provisions of the D.C. Code, and we express no views whatsoever concerning any alleged violation by Kokulis of that Code.

court decisions which demonstrate that a violation of professional ethics does not automatically result in disqualification of counsel. See, e.g., W.T. Grant Co. v. Haines, 531 F.2d 671, 677 (2d Cir. 1976) ([T]he business of the court is to dispose of litigation and not to act as a general overseer of the ethics of those who practice in the court unless the questioned behavior taints the trial of the cause before it); Professional Services Industries, Inc., v. Kimbrell, 758 F.Supp. 676, 680 (D. Kan. 1991) (courts do not exist to discipline attorneys, but to resolve disputes).

In any event, we have considered Anderson's arguments and conclude, based on the record before us, that Anderson has failed to sufficiently demonstrate that Kokulis or the Pillsbury law firm violated a disciplinary rule. Anderson argues that Kokulis has (1) wrongfully accepted a representation adverse to Anderson, and (2) falsely represented his prior representation in 567 to Administrative Patent Judge Andrew H. Metz and to his client Eppstein. (Anderson Pet. at 19). On this record, the evidence does not sufficiently establish that Kokulis intentionally misled "anyone" about "anything."

Anderson argues that statements by Kokulis during the conference call with Judge Metz (Finding 41) fly in the face of Mr. Kokulis' role as Project Director for Anderson I. (Anderson Pet. at 20). As stated above, the record does not support a

finding that Kokulis was the "director" of any project involving 567 (Anderson I). The record, if anything, establishes that (1) Scott, not Kokulis, was the project director for 567 (and all other NIH projects in which Cushman may have been involved) and (2) Kokulis signed the task order in the absence of Scott. (Findings 30-31 and 45-46). Anderson has failed to establish that Kokulis intentionally misled or made false statements.

Anderson further argues that Kokulis should not have accepted the position of lead counsel in face of a potential conflict. (Anderson Pet. at 22). However, Kokulis declaration indicates that he never thought his representation of Eppstein presented a conflict.

Anderson argues that disqualification of Pillsbury is proper, since the Pillsbury law firm contains at least 15 partners that had an attorney-client relationship with Anderson. (Anderson Pet. at 24). Anderson relies on the testimony of Haight to support its position. Haight asserts that numerous partners now at the Pillsbury firm worked on 567 (apparently solely on the basis that they were listed as having power of attorney in 567). (Finding 23). Haight's "wish" cannot be converted into a finding supported by the record. As stated earlier, the record establishes, and we take official notice that it is customary that not all attorneys listed on a Power of Attorney in a patent application are actually involved in the

patent application. The record further convincingly establishes that (1) no one remaining at Pillsbury worked on 567 (Findings 50-56), (2) no one remaining at Pillsbury received confidential information regarding 567 (Finding 32) and (3) Pillsbury has no files regarding 567 in its possession (Finding 59).

Anderson through counsel has alleged that Kokulis (bold added) :

- (1) made "**misrepresentations**" to an Administrative Patent Judge of this Board (Motion to Disqualify, page 21),
- (2) "sought to **mislead** the APJ" (Motion to Disqualify, page 19),
- (3) made "**false** and **misleading** statements" (Motion to Disqualify, page 18),
- (4) **misrepresented** facts to NIH (Motion to Disqualify, page 20),
- (5) "**falsely** represented his prior representation" (Motion to Disqualify, page 19) and
- (6) "engaged in a course of conduct involving **misrepresentations** to the NIH, PTO and his client, Eppstein" (Motion to Disqualify, page 22).

The real party in interest in this matter is the United States, not a private party. It is true that through some form of a contract arrangement private counsel, not attorneys of the Department of Justice, represents the United States in this particular interference. Cf. 28 CFR § 0.45(f). We believe it is appropriate to remind private counsel that when it represents the United States, it, like all other Government attorneys, is bound by the both the letter and the spirit of an observation made by the Supreme Court in Berger v. United States, 295 U.S. 78, 88 (1935):

The United States Attorney is the representative not of an ordinary party to a controversy, but of a sovereignty whose obligation to govern impartially is as compelling as its obligation to govern at all; and whose interest, therefore, in a criminal prosecution is not that it shall win a case, but that justice shall be done. As such, he is in a peculiar and very definite sense the servant of the law, the twofold aim of which is that guilt shall not escape or innocence suffer. He may prosecute with earnestness and vigor -- indeed, he should do so. But, while he may strike hard blows, he is not at liberty to strike foul ones. It is as much his duty to refrain from improper methods calculated to produce a wrongful conviction as it is to use every legitimate means to bring about a just one.

It is our view that the obligation of attorneys representing the Government applies equally to civil matters, including inter

partes, interference proceedings before the PTO. It is further our view that the assertions of "false" and "misleading" representations alleged to have been made by Kokulis are "foul" blows.

We cannot imagine that an attorney for the Department of Justice, on this skimpy record, would have even considered alleging that Kokulis (1) sought to "mislead" an APJ (which he did not), (2) made misrepresentations to the PTO and others (which he did not) or (3) made "false" statements (which he did not). These unfounded allegations should not have been made by private counsel representing any client, but particularly counsel representing the United States.

The Government, like any other client, is entitled to zealous representation of its interests. However, when it litigates, both before courts and administrative agencies, the Government must not only be fair to its citizens, but it also must appear to be fair. Accordingly, in the future, we expect private counsel, and any NIH employee, representing the United States in this or any related matter, to conduct litigation in the manner in which we know it would have been conducted by the Department of Justice attorneys. To the extent private counsel may see this obligation as constituting having one hand tied behind its back (which it is not), we observe that that is the price an attorney pays for the privilege of representing the

interests of the United States, a sovereign which has a long tradition, and a firm policy, of conducting litigation against its citizens only in a just and fair manner.

C. Order

Upon consideration of Anderson's petition to disqualify Kokulis and Pillsbury, and for the reasons given, it is

ORDERED that the petition is denied.

FURTHER ORDERED that the Clerk shall transmit a copy of this DECISION ON ANDERSON PETITION TO DISQUALIFY to all counsel of record in Interference 103,708.

FURTHER ORDERED that the Clerk shall also transmit a copy of this DECISION ON ANDERSON PETITION TO DISQUALIFY to the Department of Justice at the addresses indicated below.

<u>FRED E. MCKELVEY, Senior</u>)	
Administrative Patent Judge)	
)	
)	
<u>SALLY GARDNER-LANE</u>)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
<u>SALLY C. MEDLEY</u>)	
Administrative Patent Judge)	

103,708
cc (via Federal Express)

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