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: 30 Non-Reciprocal, 28 Reciprocal
FY13: 6 Non-Reciprocal, 16 Reciprocal
FY14: 8 Non-Reciprocal, 22 Reciprocal
Total Number of OED Disciplinary Decisions

Breakdown of Disciplinary Decisions by Practitioner Type

- **FY12**
  - Patent Attorneys: 33
  - Patent Agents: 9
  - Trademark Attorneys: 16

- **FY13**
  - Patent Attorneys: 2
  - Patent Agents: 4
  - Trademark Attorneys: 4

- **FY14**
  - Patent Attorneys: 4
  - Patent Agents: 4
  - Trademark Attorneys: 22
OED Disciplinary Decisions

FY12
- Formal Discipline: 58
- Warning: 44
- Exclusion: 17
- Suspension: 19

FY13
- Formal Discipline: 28
- Warning: 22
- Exclusion: 9
- Suspension: 5

FY14
- Formal Discipline: 30
- Warning: 48
- Exclusion: 5
- Suspension: 14
- Reprimand: 11
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.
  – 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    • Appellate brief failed to inform court that a case citation was non-precedential.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](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.
For Informal Inquiries, Contact OED at 571-272-4097

THANK YOU