

# OED Update: Statistics and Case Law at OED



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United States Patent and Trademark Office



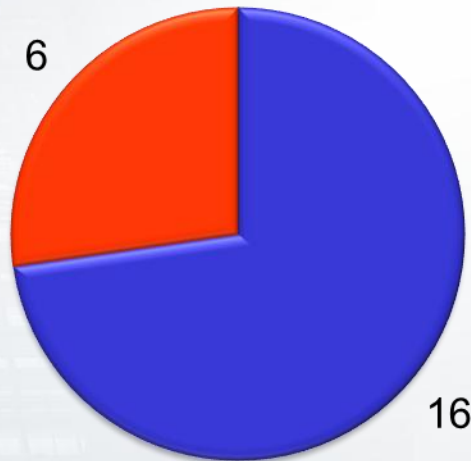
# Total Number of OED Disciplinary Decisions

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

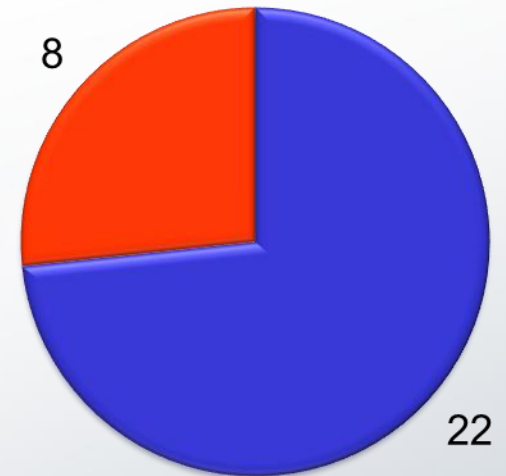
FY12



FY13



FY14

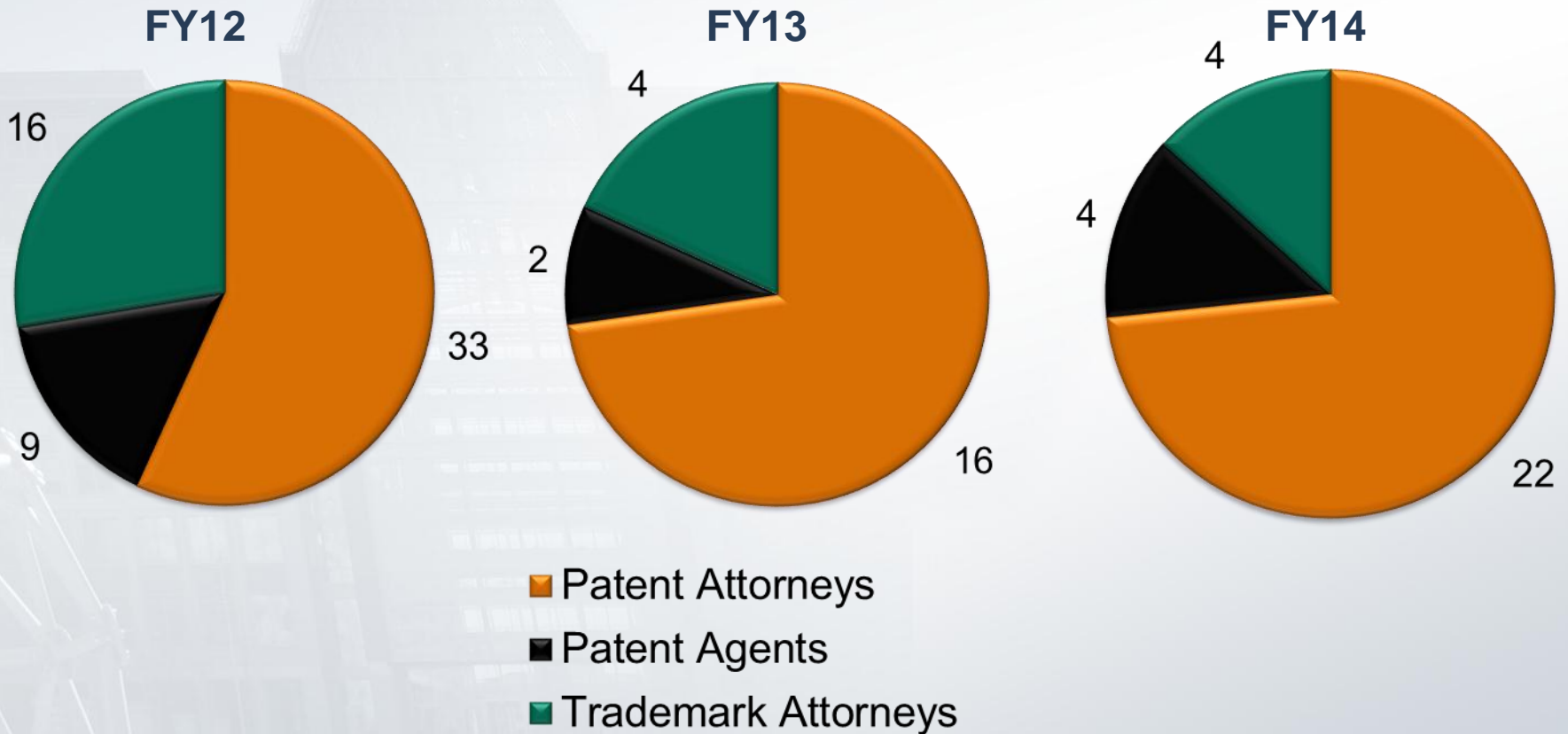


■ Non-Reciprocal ■ Reciprocal



# Total Number of OED Disciplinary Decisions

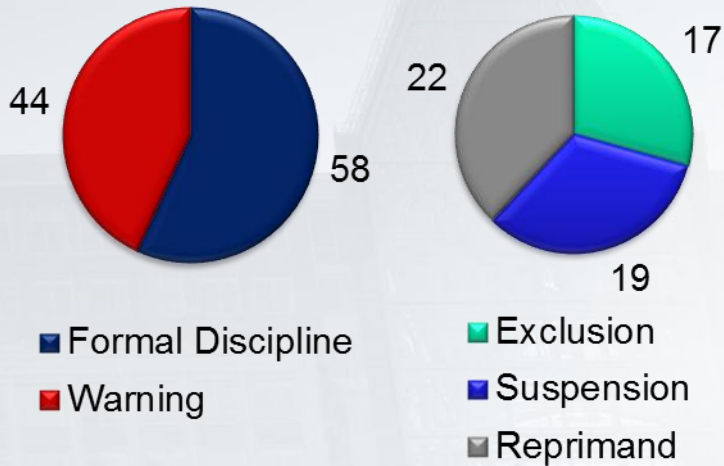
## Breakdown of Disciplinary Decisions by Practitioner Type



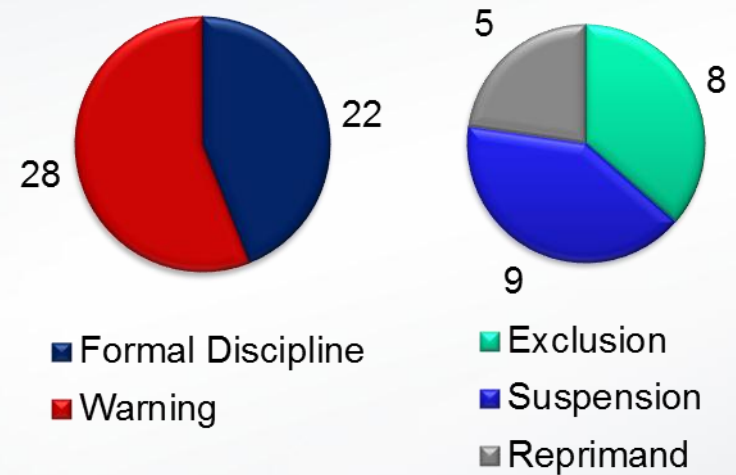


# OED Disciplinary Decisions

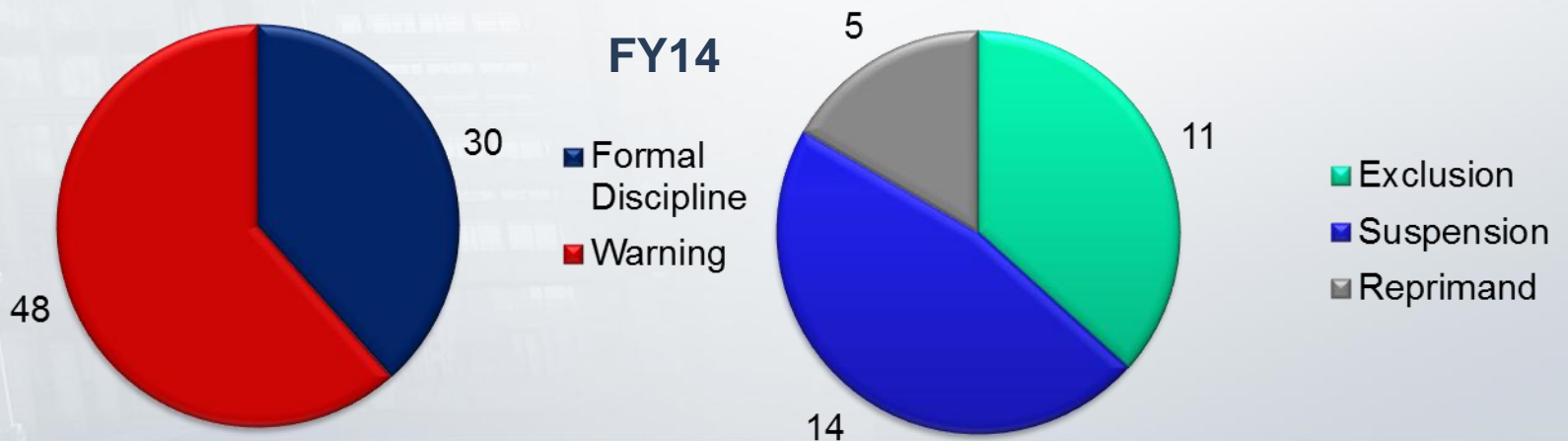
## FY12



## FY13



## FY14





# 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.
    - *Rates Technology v. Mediatix Telecom*, 688 F.3d 742 (2012).
  - 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    - Appellate brief failed to inform court that a case citation was non-precedential.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 a handful of times.
  - Received public reprimand and one-year probation.



# Supervising Non-Lawyer Assistants

- ***In re Druce*** (USPTO D2014-13)
  - 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.
    - Non-lawyer assistant committed these acts without Attorney's knowledge.
  - Attorney acknowledged that he failed to adequately supervise non-lawyer assistant.
  - 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 Tandler*** (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>
  - ▶ 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.



# Contacting OED

For Informal Inquiries, Contact OED at  
571-272-4097

THANK YOU