

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE**

In the Matter of)

Respondent)

Proceeding No: D08-02

FINAL ORDER

Director of the Office of Enrollment and Discipline Harry I. Moatz ("OED Director") and ("Respondent") have submitted a settlement agreement to the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office or his designate ("USPTO Director").

The OED Director and Respondent's settlement agreement sets forth certain stipulated facts, legal conclusions, and sanctions to which the OED Director and Respondent have agreed in order to resolve voluntarily this disciplinary proceeding and obviate an administrative hearing. The settlement agreement, which satisfies the requirements of 37 C.F.R. § 10.133(g), resolves all disciplinary action by the United States Patent and Trademark Office ("USPTO") arising from the evidence previously submitted to the USPTO's Committee on Discipline in connection with this disciplinary proceeding or discussed herein.

Pursuant to such settlement agreement, this Final Order sets forth the parties' stipulated facts, joint legal conclusions, and agreed upon discipline.

Stipulated Facts

1. At all times relevant hereto, Respondent of San Diego, California, has been an agent registered to practice before the USPTO under registration number _____ and is subject to the USPTO Disciplinary Rules set forth at 37 C.F.R. § 10.20 et seq.

Filing of the '327 Application

2. On January 23, 2001, another practitioner filed application number 09/768,327 ("the '327 application") with the USPTO.

3. The '327 application did not contain a nonpublication request.

Filing of PCT Application '391

4. By letter dated, March 23, 2001, the other practitioner recommended to the assignee of the '327 application, Single Chip Systems Corporation ("SCS"), that any foreign counterpart to the '327 application be filed by January 23, 2002.

5. By letter dated December 26, 2001, the other practitioner reminded SCS of the January 23, 2002, deadline and requested instructions from SCS regarding filing a foreign counterpart to the '327 application. The other practitioner's December 26 letter to SCS enclosed a copy of his earlier March 23, 2001, letter to SCS.

6. On or about January 10, 2002, the other practitioner filed a Taiwanese patent application based on the '327 application. The Taiwanese application was published on August 11, 2003.

7. On January 16, 2002, the other practitioner filed Patent Cooperation Treaty application number PCT/US02/01391 ("the '391 PCT application") based on the '327 application.

8. On July 25, 2002, the '327 application was published as U.S. Published Application No. 2002/0097143.

Respondent's Work in Connection with the '327 Application

9. By letter dated July 15, 2003, Respondent, on behalf of SCS, instructed Aoyama & Partners to enter the National Phase in Japan for the '391 PCT application based on the '327 application.

10. By letter dated July 15, 2003, Respondent, on behalf of SCS, instructed Viering, Jentschura & Partner to enter the National Phase in Europe for the '391 PCT application based on the '327 application.

11. On or about July 17, 2003, SCS instructed the other practitioner to send SCS's patent files to Respondent at the firm where Respondent then worked, and, on or about July 22, 2003, the other practitioner transferred the files to Respondent.

12. On September 29, 2003, Respondent spoke with a USPTO patent examiner about the '327 application and authorized changes to the specification, drawings and claims.

Respondent's Filing of the Nonpublication Request

13. On _____, Respondent filed Application No. _____ ("the '610 application") with the USPTO as a continuation of the '327 application.

14. In December 2003, it was Respondent's policy to file nonpublication requests with new patent applications unless the client had provided Respondent with either a foreign filing plan or foreign filing instructions prior to the filing of the new application.

15. In December 2003, it was Respondent's practice to check the parent file to determine whether the application had been filed in the PCT or a foreign jurisdiction before filing a nonpublication request.

16. Respondent asserts that he reviewed the paper file he maintained on the '327 application prior to filing the nonpublication request for the '610 application.

17. Respondent asserts that the paper file for the '327 application contained a copy December 26, 2001, letter to SCS but did not contain a copy of his July 15, 2003, letter to Aoyama & Partners instructing it to enter the National Phase in Japan for the '391 PCT application based on the '327 application nor his July 15, 2003, letter to Viering, Jentschura & Partner instructing it to enter the National Phase in Europe for the '391 PCT application based on the '327 application.

18. Other than searching the '327 application paper file, Respondent did not recall taking other action to determine whether the '610 application had been or would be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication at eighteen months after filing.

19. On December 18, 2003, Respondent filed with the '610 application a nonpublication request.

20. Respondent asserts that the December 18, 2003, nonpublication request for the '610 application was mistakenly filed.

Respondent's Representation to the USPTO

21. In submitting the December 18, 2003, nonpublication request, Respondent represented to the USPTO that the invention disclosed in the '610 application had not been and would not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication at eighteen months after filing.

22. Respondent's representation to the USPTO in connection with the December 18, 2003, nonpublication request was erroneous.

Respondent's Certification to the USPTO

23. Respondent signed the December 18, 2003, nonpublication request and, in so signing, Respondent certified, pursuant to 37 C.F.R. § 10.18, that to the best of his knowledge and belief, formed after the reasonable inquiry under the circumstances, that the factual contentions contained within the request had evidentiary support.

24. Respondent's certification to the USPTO representation in connection with the December 18, 2003, nonpublication request was mistaken.

Rescission of Nonpublication Request

25. On February 10, 2004, a patent issued on the '327 application.

26. On or about January 24, 2005, Respondent changed patent firms and SCS authorized Respondent to take the '327 application file and related files with him to his new firm.

27. Upon changing firms, Respondent reviewed all transferred files, discovered that the '327 application had been the subject of foreign filings filed prior to the filing of the '610 application, and realized that his December 18, 2003, nonpublication request was erroneous.

28. On May 20, 2005, Respondent filed with the USPTO a "Petition for Revival of an Application for Patent Abandoned for Failure to Notify the Office of a Foreign or International Filing" for the '610 application.

29. On July 13, 2005, the USPTO dismissed the May 20, 2005, petition because, *inter alia*, Respondent failed to file a notice of rescission of the December 18, 2003, nonpublication request and failed to submit a copy of the notification of foreign filing(s).

30. On August 22, 2005, Respondent filed with the USPTO a "Renewed Petition under 37 C.F.R. § 1.137(f)" and a "Rescission of Previous Nonpublication Request".

31. On September 1, 2005, the USPTO dismissed the August 22, 2005, petition for being inappropriate. The USPTO based its dismissal on the fact that the '610 application had never been abandoned under 35 U.S.C. § 122(b)(2)(B)(iii).

Respondent's Declarations

32. Respondent represents that, since realizing that he mistakenly filed the December 18, 2003, nonpublication request for the '610 application, he has modified his pre-filing procedures to ensure that such mistake no longer occurs.

33. To the best of his knowledge and belief, Respondent represents that he has not mistakenly filed nonpublication requests since realizing that he mistakenly filed the December 18, 2003, nonpublication request for the '610 application.¹

Legal Conclusions

34. Based upon the foregoing stipulated facts, the Respondent acknowledges that his conduct violated the following Disciplinary Rules of the USPTO Code of Professional Responsibility:

- a. Rules 10.23 (a) and (b), as further defined by 37 C.F.R. § 10.23(c)(15), by signing a paper submitted to OED in violation of the provisions of 37 C.F.R. § 10.18; and

¹ During this disciplinary proceeding, Respondent voluntarily searched his records and uncovered one other non-publication request mistakenly filed in application number 10/791,375 on March 1, 2004. After the discovery, Respondent filed a Rescission of the Previous Request for Non-Publication request with the USPTO and informed the OED Director, through the Solicitor's Office, of the matter.

- b. Rule 10.77 (b) by handling a client matter without preparation adequate under the circumstances presented.

Reprimand

35. Respondent agreed, and it is **ORDERED** that:

- a. Respondent be, and hereby is, privately reprimanded;
- b. the OED Director publish the Final Order in redacted form;
- c. the OED Director to publish the following Notice in the Official Gazette:

Notice of Private Reprimand

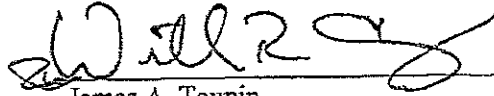
A practitioner has been reprimanded by the United States Patent and Trademark Office for not complying with a) 37 C.F.R. § 10.23(c)(15) by failing to conduct a reasonable inquiry under the circumstances prior to signing and submitting to the Office a request for nonpublication and b) 37 C.F.R. § 10.77(b) by handling a client matter without preparation adequate under the circumstances. This action is taken pursuant to the provisions of 35 U.S.C. § 32 and 37 C.F.R. §§ 10.133(g) and 10.159.

- d. this Final Order (save as ordered in paragraph 35(b), above), the parties' Settlement Agreement, the underlying record, and the private reprimand, itself, be kept confidential, except that the same: 1) may be considered not only in dealing with any further complaint or evidence of the same or similar misconduct which may come to the attention of the USPTO, but also in any disciplinary proceeding occurring in the future as an aggravating factor to be taken into consideration in determining any discipline to be imposed, and 2) may be offered as evidence to rebut any statement or representation by or on Respondent's behalf in any future disciplinary hearing; and
- e. the OED Director and Respondent each bear their own costs incurred to date and in carrying out the terms of this agreement.

[signature page follows]

23 SEP 08

Date



James A. Toupin
General Counsel
United States Patent and Trademark Office

on behalf of

Jon W. Dudas
Under Secretary of Commerce for Intellectual
Property and Director of the United States
Patent and Trademark Office

cc:

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