

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

In the Matter of)
)
John E. Carlson,)
)
Respondent) Proceeding No. D08-27
)
_____)

Final Order

Office of Enrollment and Discipline Director Harry I. Moatz (“OED Director”) and John E. Carlson (“Respondent”) have submitted a Proposed Settlement Agreement to the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (“USPTO Director”) or his designate for approval.

The OED Director and Respondent’s Proposed 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 a disciplinary complaint against Respondent. The Proposed Settlement Agreement, which satisfies the requirements of 37 C.F.R. § 11.26, resolves all disciplinary action by the United States Patent and Trademark Office (“USPTO” or “Office”) arising from the stipulated facts set forth below.

Pursuant to such Proposed Settlement Agreement, this Final Order sets forth the parties’ stipulated facts, legal conclusions, and agreed upon discipline.

Jurisdiction

1. At all times relevant hereto, Respondent of Birmingham, Michigan, has been an attorney registered to practice before the United States Patent and Trademark Office (“USPTO” or “Office”) and is subject to the Disciplinary Rules of the USPTO Code of Professional Responsibility set forth at 37 C.F.R. § 10.20 *et seq.*

2. The USPTO Director has jurisdiction over this matter pursuant to the provisions of 35 U.S.C. §§ 2 and 32 and 37 C.F.R. § 11.26.

Stipulated Facts

3. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, including a duty to disclose to the Office all information known to that individual to be material to patentability. See 37 C.F.R. § 1.56. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. 37 C.F.R. § 1.56(a).

4. Section 2001.06(c) of the Manual of Patent Examining Procedure (MPEP) states, in part:

Where the subject matter for which a patent is being sought is or has been involved in litigation, the existence of such litigation and any other material information arising therefrom must be brought to the attention of the U.S. Patent and Trademark Office.

5. At all times relevant hereto, Respondent of Birmingham, Michigan, has been an attorney registered to practice patent law before the Office (Registration Number 37,794) and is subject to the USPTO Code of Professional Responsibility set forth at 37 C.F.R. § 10.20 *et seq.*

6. Respondent prosecuted two U.S. continuation patent applications on behalf of a client before the Office, namely: U.S. Application Nos. 10/340,926 (“the ‘926 application”) (U.S. Patent Application Publication No. 20030101780) and 10/788,164 (“the ‘164 application”) (U.S. Patent Application Publication No. 20040168489). The ‘926 application is a continuation of U.S. Patent Application No. 08/686,220 (“the ‘220 application”); the ‘164 application is a continuation of the ‘926 application.

7. While prosecuting the ‘926 and ‘164 applications before the Office, Respondent was also litigating *Lawman Armor Corp. v. Simon*, 74 U.S.P.Q.2d 1633 (E.D. Mich. 2005).

8. *Lawman Armor* concerned the enforceability of U.S. Patent No. 6,575,001 (“the ‘001 patent”), which issued from the ‘220 application. Specifically, the district court addressed whether the USPTO had erroneously decided to revive the ‘220 application after it had become abandoned because of the failure to timely respond to an Office action.

9. On March 29, 2005, the district court declared the ‘001 patent to be invalid. *Lawman Armor*, 74 U.S.P.Q.2d at 1638. The district court also declared invalid the U.S. Patent No. 6,766,674, which had been granted on the ‘926 application while the *Lawman Armor* litigation was pending. *Id.*

10. Respondent did not inform the USPTO about the pendency of the *Lawman Armor* litigation while prosecuting the ‘926 application.

11. While the ‘164 application was abandoned on February 14, 2006, Respondent did not inform the USPTO about the pendency of the *Lawman Armor* litigation or the district court’s March 29, 2005, decision in that case while prosecuting the ‘164 application.

Mitigating Factor

12. Respondent represents that he did not act with deceptive intent by not disclosing to the Office the pendency of the *Lawman Armor* litigation or the district court’s March 29, 2005, decision in that case.

Legal Conclusion

13. Based on the information contained in paragraphs 3 through 12, above, Respondent acknowledges that his conduct violated Disciplinary Rule 10.23(b)(5) of the USPTO Code of Professional Responsibility by not informing the USPTO of the pendency of the *Lawman Armor* litigation or the district court's March 29, 2005, decision in that case while prosecuting the two continuation applications before the Office.

Sanction

14. Respondent agreed, and it is ORDERED that:
- a. Respondent be, and hereby is, publicly reprimanded;
 - b. the OED Director shall publish the Final Order;
 - c. the OED Director shall publish the following Notice in the *Official Gazette*:

Notice of Reprimand

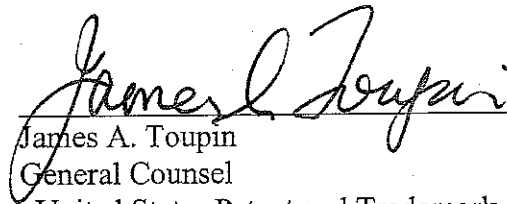
John E. Carlson of Birmingham, Michigan, an attorney whose registration number is 37,794 has been publicly reprimanded by the United States Patent and Trademark Office for violating 37 C.F.R. § 10.23(b)(5) by engaging in conduct prejudicial to the administration of justice by not informing the Office of the pendency of, and final decision in, a federal district court case concerning the enforceability of a U.S. patent. The patent at issue in the district court case was related to two continuation applications that Mr. Carlson was prosecuting before the Office. Mr. Carlson, however, represents that he did not act with deceptive intent by not disclosing such information to the Office. This was an agreed upon resolution of misconduct charges. This action is taken pursuant to the provisions of 35 U.S.C. § 2(b)(2)(D) and 37 C.F.R. §§ 11.20(a)(3), 11.26 and 11.59. Disciplinary decisions regarding practitioners are posted at the Office of Enrollment and Discipline's Reading Room located at: <http://des.uspto.gov/Foia/OEDReadingRoom.jsp>.

- d. in accordance with 37 C.F.R. § 11.59, the OED Director shall give notice of the public discipline and the reasons for the discipline to disciplinary enforcement agencies in the State where the practitioner is admitted to practice, to courts where the practitioner is known to be admitted, and the public; and

- e. the OED Director and Respondent shall bear their own costs incurred to date and in carrying out the terms of this agreement.

JUN 17 2009

Date


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

on behalf of

John J. Doll
Acting Under Secretary of Commerce for
Intellectual Property and Acting Director of the
United States Patent and Trademark Office

cc:

Harry I. Moatz
Director Office of Enrollment and Discipline
U.S. Patent and Trademark Office
Mail Stop OED
P.O. Box 1450
Alexandria, Virginia 22313-1450

John E. Carlson