

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

In the Matter of)	
)	
John C. Janka,)	Proceeding No. D2011-57
)	
Respondent)	

FINAL ORDER

The Director of the Office of Enrollment and Discipline (“OED Director”) for the United States Patent and Trademark Office (“USPTO” or “Office”) and John C. Janka (“Respondent”) have submitted a Proposed Settlement Agreement to the Under Secretary of Commerce for Intellectual Property and USPTO Director for approval.

The Proposed Settlement Agreement, which resolves all disciplinary action by the USPTO arising from the stipulated facts set forth below, is hereby approved. This Final Order sets forth the parties’ stipulated facts, legal conclusions, and sanctions set forth in the parties’ Proposed Settlement Agreement in order to resolve voluntarily the disciplinary complaint against Respondent.

Jurisdiction

1. At all times relevant hereto, Respondent of Chicago, Illinois, has been an attorney registered to practice before the USPTO 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. Respondent’s registration number is 32,996.
2. The USPTO Director has jurisdiction over this matter pursuant to 35 U.S.C. §§ 2(b)(2)(D) and 32, and 37 C.F.R. §§ 11.20 and 11.26.

Stipulated Facts

Background

3. Respondent of Chicago, Illinois, is an attorney registered to practice patent law before the Office (Registration No. 32,996) and is subject to the USPTO Disciplinary Rules set forth at 37 C.F.R. § 10.20 et seq.
4. Respondent represents that he has been engaged in the practice of law for 24 years. Respondent represents that, prior to earning his J.D. degree from the University of Chicago Law School, he worked in the synthetic fuel industry as a chemical engineer having earned Bachelor of Science and Master of Science degrees in Chemical Engineering.

Respondent represents that, in the course of his technical career he was awarded four U.S. patents (4,701,266; 4,560,547; 4,141,417 and 3,820,964) and published approximately 50 papers in various technical journals, conference proceedings and the like. Respondent represents that, during his 24 years of legal practice, Respondent has never been sanctioned nor subject to any disciplinary proceeding in the U.S. Patent Office or in any State or Federal Court. Respondent represents that he retired from the active practice of law in 2009 and currently limits the scope of his legal practice to "of counsel" status.

5. Telecommunication Systems, Inc. ("TCS") is the assignee of U.S. Patent No. 6,985,748 ("the" '748 Patent").

6. At all relevant times, another registered patent practitioner ("Mr. B.") was the attorney of record for TCS in three pending patent applications related to the '748 Patent and, as discussed below, became the attorney of record for TCS in a reexamination proceeding.

Patent Infringement Suit and Protective Order

7. On July 12, 2006, TCS filed *Telecommunication Systems, Inc. v. Mobile 365, Inc.* (Civil Action No. 06CV485) in the United States District Court for the Eastern District of Virginia, Richmond Division, against Mobile 365, Inc. ("Mobile 365") alleging infringement of the '748 Patent ("the patent infringement suit").

8. Respondent was a member of the litigation team that represented TCS in the patent infringement suit.

9. On December 6, 2006, before Respondent became involved in the patent infringement suit, the district court entered a protective order to facilitate the exchange of confidential documents in the patent infringement suit. At the time the protective order was entered into and at the time of trial, Local Rule 5 of the Eastern District of Virginia provided, in part, that any motion for a protective order providing for the filing of documents under seal must meet certain requirements for sealing the documents. In part, the protective order required documents labeled "CONFIDENTIAL – NON-PROSECUTING ATTORNEY EYES ONLY" to be sealed in accordance with procedures set forth in the protective order. Paragraph 6 of the protective order required that the party submitting a document having confidential designation under the protective order "shall submit it to the Court in a sealed envelope or other appropriate sealed container" with certain markings. Paragraph 7 of the protective order required that during trial, if a designated document was to be revealed in court through testimony or evidence, the offering party "shall give notice to counsel for the party and to the Court prior to any such disclosure so that the Court may make a determination regarding the treatment, handling and manner of disclosure of such information."

10. At all relevant times, Respondent had actual knowledge of the protective order.

11. In part, the protective order required designated discovery materials to be received and used only for purposes directly related to the suit and not for any other purpose. Hence, it prohibited the use of confidential documents in proceedings before the USPTO.

12. In part, the protective order prohibited documents labeled “CONFIDENTIAL — NON-PROSECUTING ATTORNEY EYES ONLY” from being disclosed or communicated in any manner, either directly or indirectly, to more than three specifically designated persons. Because Mr. B. was not so designated, the protective order prohibited the confidential documents from being disclosed to him.

13. In part, the protective order prohibited attorneys who were allowed access to confidential documents from substantive involvement in the preparation or prosecution of related patent applications for twelve (12) months after the case’s determination.

14. In part, the protective order required outside counsel of record to be responsible for employing reasonable measures to control the duplication of, access to, and distribution of confidential documents.

15. In part, the protective order required the party responsible for an unauthorized disclosure, as soon as practicable after learning of the disclosure, to: (a) inform the other party in writing of all pertinent facts relating to the disclosure, (b) use its best efforts to retrieve the material or information, and (c) make every effort to prevent further disclosure by the unauthorized person(s).

16. The protective order also stated that the parties are required to move the district court for relief when they are unable to resolve an issue related to a potential violation of the protective order.

Filing of Litigation Information Disclosure Statement in *Inter Partes* Reexamination

17. On May 25, 2007, after a nine-day trial, the jury returned its verdict expressly finding that Mobile 365 willfully infringed fourteen asserted claims of the ‘748 Patent.

18. While post-trial motions were pending, and while the protective order was still in effect, Mobile 365’s parent company, Sybase, Inc. (“Sybase”), initiated an *inter partes* reexamination of the ‘748 patent in the USPTO. The reexamination was assigned Control No. 95/000,353 (“the ‘353 reexamination proceeding”).

19. At all relevant times, Mr. B. was TCS’s attorney of record in the ‘353 reexamination proceeding.

20. Respondent assembled documents and prepared an Information Disclosure Statement pursuant to 37 C.F.R. § 1.933(a) (“IDS”). Respondent represents that he understood that 37 C.F.R. § 1.933(a) and 37 C.F.R. § 1.555(a) both explicitly impose a duty of disclosure upon “each individual associated with the patent owner” in a reexamination. Respondent represents that he believed he was among those “individual[s]” associated with TCS, the patent owner in a reexamination, because he was one of TCS’s trial counsel. Respondent further represents that he was acting on the belief that TCS had an obligation to disclose to the USPTO in the reexamination any potentially material prior art relied upon by the defendant during the lawsuit in order to avoid a situation in which TCS could be charged with inequitable conduct by the defendant.

21. The IDS that Respondent assembled and prepared included fifty-six (56) documents bearing the notation “CONFIDENTIAL — NON-PROSECUTING ATTORNEY EYES ONLY.”

22. Almost a year after the IDS was filed, the Court held that the protective order covered the 56 documents.

23. Respondent represents he believed that none of the documents were properly placed under seal by Mobile 365 pursuant to the protective order before or during trial; Respondent represents that the contents and information in the 56 documents were discussed in open court; Respondent represents that the contents and information in the 56 documents were presented to the jury as evidence; Respondent represents that, in almost all instances, the contents and information in the 56 documents were filed in the district court for use as trial exhibits; Respondent represents that he believed that the contents and information in the 56 documents that were filed in the district court for use as trial exhibits were so filed without following the requirements of the protective order and Local Rule 5(H) for continued confidentiality; Respondent represents that he believed the provisions in paragraphs 6 and 7 of the protective order and Local Rule 5 had not been complied with or followed before or during trial to preserve the confidentiality of the documents; Respondent represents that he believed that the confidentiality of the documents had been waived.

24. Respondent represents that he believes the district court docket sheet shows that the provisions of Local Rule 5 were not followed in entering the protective order at issue since, according to Respondent: (i) no supporting memorandum was filed by Mobile 365 or by TCS, (ii) there was no confidential description of what was to be sealed, (iii) there were no references to supporting case law, and (iv) the protective order entered by the district court did not make any of the findings required by governing case law to support the proposed sealing of any documents.

25. Respondent represents that, because he believed that the confidentiality of the 56 documents had been waived, he did not petition the district court to obtain a determination on the applicability of the protective order to the documents he selected to be submitted to the USPTO in the IDS or seek the Court’s guidance to disclose the documents to the USPTO.

26. Respondent sent the documents and IDS to Mr. B. for filing the ‘353 reexamination proceeding.

27. Mr. B. filed the IDS in the ‘353 reexamination proceeding at the direction of Respondent.

28. In late May 2008, Mr. B. filed the 56 documents with the USPTO in the ‘353 reexamination proceeding without following procedures for filing confidential documents in the Office pursuant to Manual of Patent Examining Procedure (MPEP) § 724.02. Hence, the 56 documents became available for public inspection.

29. Respondent represents that, because he believed that confidentiality of the 56 documents had been waived, he (i) did not inform Mobile 365 prior to the submission of the IDS

in the '353 reexamination proceeding of TCS's purported duty to disclose the confidential documents to the USPTO, (ii) did not make efforts to limit the amount of confidential documents disclosed, and (iii) confirmed the existence of the protective order to the USPTO only after Mobile 365 realized the documents had been potentially made available to the public and objected to the filing of the documents in the '353 reexamination proceeding. It is not known whether a member of the public not covered by the protective order ever viewed the documents prior to the interim sealing of the documents by the USPTO in a decision dated June 18, 2008.

30. On January 28, 2011, the USPTO granted a petition to terminate the '353 reexamination proceeding predicated, in part, upon a finding that TCS provided an adequate showing that the Mobile 365 "could have raised," in the infringement action, the prior art which Mobile 365 later raised in the reexamination proceeding because the infringement action was still ongoing at the time the '353 reexamination proceeding was filed.

Violation of Protective Order and Finding of Contempt of Court

31. Subsequent to the filing of the IDS in the '353 reexamination proceeding, Mobile 365 petitioned the district court in the patent infringement suit to determine the applicability of the protective order to the 56 documents in the IDS assembled by Respondent and filed by Mr. B. in the USPTO.

32. On August 5, 2008, Mobile 365 filed a motion for TCS to be held in contempt for violating the protective orders predicated, in part, on the filing of the 56 documents in the IDS that was assembled and prepared by Respondent, forwarded to Mr. B., and filed in the '353 reexamination proceeding.

33. On March 31, 2009, the district court found that TCS violated the protective order and entered an order granting Mobile 365's motion to hold TCS in contempt. Specifically:

a. The district court found that TCS violated that part of the protective order requiring designated discovery materials to be received and used only for purposes directly related to the suit and not for any other purpose when Mr. B., as TCS's prosecuting attorney, received the confidential documents and filed them on behalf of TCS in the USPTO. Mr. B. filed the confidential documents in the '353 reexamination proceeding at Respondent's direction.

b. The district court found that TCS violated that part of the protective order prohibiting documents labeled "CONFIDENTIAL—NON-PROSECUTING ATTORNEY EYES ONLY" from being disclosed or communicated in any manner, either directly or indirectly, to more than three specifically designated persons by disclosing the confidential documents to Mr. B. Respondent disclosed the confidential documents to Mr. B.

c. The district court found that TCS violated that part of the protective order prohibiting attorneys who were allowed access to confidential documents from substantive involvement in the preparation or prosecution of patent applications for twelve (12) months after the case's determination because Mr. B. represented TCS before the USPTO in the '353 reexamination proceeding and three other patent applications.

d. The district court found that TCS violated that part of the protective order requiring outside counsel of record to be responsible for employing reasonable measures to control the duplication of, access to, and distribution of confidential documents because TCS and its counsel failed to employ reasonable measures to control access to Mobile 365's confidential documents after TCS and its counsel were repeatedly notified of their confidential nature.

e. The district court found that TCS violated that part of the protective order requiring the party responsible for an unauthorized disclosure, as soon as practicable after learning of the disclosure, to (a) inform the other party in writing of all pertinent facts relating to the disclosure, (b) use its best efforts to retrieve the material or information, and (c) make every effort to prevent further disclosure by the unauthorized person(s) by failing to follow those provisions.

34. The district court's March 31, 2009, order did not expressly discuss paragraphs 6 and 7 of the protective order or Local Rule 5 or discuss Respondent's conduct. The order did not expressly hold Respondent in contempt or sanction Respondent, but, as outlined above, Respondent's acts and omissions provided part of the factual predicate for the district court's findings and order. The district court found, *inter alia*, that the protective order prohibited the use of the 56 documents in proceedings before the USPTO.

Legal Conclusions

35. Although Respondent does not believe that he violated any Disciplinary Rule of the USPTO Code of Professional Responsibility, Respondent admits that, based on the information contained in paragraphs 3 through 34, above, there is sufficient evidence for the OED Director to establish that Respondent violated 37 C.F.R. § 10.77(b) (handling a legal matter without preparation adequate in the circumstances) and, therefore, Respondent agrees to the disciplinary sanction imposed below.

Agreed-Upon Sanction

36. Respondent agreed, and it is ORDERED that:

- a. Respondent be, and hereby is, publicly reprimanded;
- b. The OED Director shall publish the Final Order at the Office of Enrollment and Discipline's Reading Room electronically located at:
<http://des.uspto.gov/Foia/OEDReadingRoom.jsp>;
- c. The OED Director shall publish a notice the *Official Gazette* materially consistent with the following:

Notice of Public Reprimand

John C. Janka of Chicago, Illinois, an attorney registered to practice before the Office (Registration No. 32,996). The United States Patent and Trademark Office ("USPTO" or "Office") has reprimanded Mr. Janka for handling a legal matter without preparation adequate in the circumstances under 37 C.F.R. § 10.77(b) by preparing and causing to be filed in the Office in an *inter partes* reexamination proceeding an Information Disclosure Statement ("IDS") pursuant to 37 C.F.R. § 1.933(a) containing documents that were later found by a Federal district court to be covered by a protective order issued by the court in a patent infringement case. Mr. Janka sent the IDS and documents to another patent practitioner (the "other practitioner") for filing in the reexamination without first obtaining guidance from the district court regarding the protective order. Mr. Janka asserts that he believed the confidentiality of the documents had been waived.

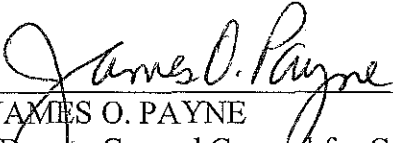
Mr. Janka was a member of the litigation team that represented TCS in *Telecommunication Systems, Inc. v. Mobile 365, Inc.* (Civil Action No. 06CV485) (United States District Court for the Eastern District of Virginia, Richmond Division), a patent infringement suit. The district court held TCS in contempt of court for violating the terms of a protective order that, *inter alia*, required designated discovery materials to be received and used only for purposes directly related to the suit and not for any other purpose. While Mr. Janka was not found in contempt or sanctioned by the district court, the contempt finding was connected, in part, to Mr. Janka having prepared an IDS pursuant to 37 C.F.R. § 1.933(a) and forwarding it to the other practitioner for filing in a USPTO reexamination proceeding. Almost a year after the IDS was filed, the district court found that 56 confidential documents in the IDS were covered by the protective order. The other practitioner filed the IDS in the reexamination proceeding without seeking to protect the confidentiality of the 56 documents by filing the documents pursuant to MPEP § 724.02. Mr. Janka represents that, at the time he prepared the IDS and forwarded it to the other practitioner for filing in the USPTO, he did not believe the 56 documents were covered by the protective order because, according to Mr. Janka, the documents were not sealed according to the procedures required by the protective order and because, according to Mr. Janka, the documents were discussed or filed for use at trial or presented as exhibits in open court. Notwithstanding Mr. Janka's asserted belief as to whether the 56 documents were covered by the protective order, the district court found, *inter alia*, that the protective order

prohibited the use of the 56 documents in proceedings before the USPTO.

This action is the result of a settlement agreement between Mr. Janka and the OED Director pursuant to the provisions of 35 U.S.C. §§ 2(b)(2)(D) and 37 C.F.R. §§ 11.26 and 11.59. Disciplinary decisions involving practitioners are posted at the Office of Enrollment and Discipline's Reading Room located at: <http://des.uspto.gov/Foia/OEDReadingRoom.jsp>.

- d. Nothing in the Proposed Settlement Agreement or this Final Order shall prevent the Office from considering the record of this disciplinary proceeding, including the Final Order, to be considered (1) when addressing any further complaint or evidence of the same or similar misconduct brought to the attention of the Office, and/or (2) in any future disciplinary proceeding (a) as an aggravating factor to be taken into consideration in determining any discipline to be imposed and/or (b) to rebut any statement or representation by or on Respondent's behalf;
- e. Within thirty (30) days of the date on which the Final Order is signed, the OED Director shall file a motion to dismiss the disciplinary proceeding currently pending against Respondent; and
- f. The OED Director and Respondent shall bear their own costs incurred to date and in carrying out the terms of this agreement.

NOV 21 2011
Date



JAMES O. PAYNE
Deputy General Counsel for General Law
United States Patent and Trademark Office

on behalf of

David M. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

cc:

Director of the Office of Enrollment and Discipline
U.S. Patent and Trademark Office

Cameron Weiffenbach
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Notice of Public Reprimand

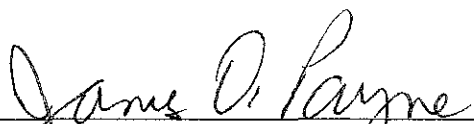
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NOV 21 2011

Date



James O. Payne
Deputy General Counsel for General Law
United States Patent and Trademark Office

on behalf of

David M. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office