

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

In the Matter of)	
)	
Robert K. Tendler,)	Proceeding No. D2013-17
)	
Respondent)	
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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 Robert K. Tendler (“Respondent”) have submitted a Proposed Settlement Agreement (“Agreement”) to the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (“USPTO Director”) for approval.

The 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 conclusion, and sanctions.

Jurisdiction

1. At all times relevant hereto, Respondent of Boston, Massachusetts, has been a registered patent attorney (Registration No. 24,581) and subject to the USPTO Code of Professional Responsibility set forth at 37 C.F.R. § 10.20 *et seq.*¹

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. §§ 11.19 and 11.26.

Stipulated Facts

3. Respondent of Boston, Massachusetts, was registered as a patent agent on October 11, 1967, and registered as a patent attorney on June 5, 1969 (Registration No. 24,581).

¹ The events at issue in this matter occurred prior to May 3, 2013. Therefore, the USPTO Code of Professional Responsibility is applicable. *See* 37 C.F.R. § 10.20 *et seq.* Effective May 3, 2013, the USPTO Rules of Professional Conduct apply to persons who practice before the Office. *See* 37 C.F.R. §§ 11.101 through 11.901.

4. In June of 2006, Daniel Henderson hired Respondent to take over the prosecution of at least 12 patent applications pending before the Office. The patent applications were related, and Respondent prosecuted the applications concomitantly.

5. On February 9, 2007, Respondent prepared a Rule 131 declaration for one of the 12 patent applications, namely: U.S. Patent Application No. 11/055,846 (“the ‘846 application”). In part, the Rule 131 declaration stated that Mr. Henderson had actually reduced the claimed invention to practice and demonstrated a prototype of the claimed invention in July 1993.

6. On February 9, 2007, Respondent sent the Rule 131 declaration to Mr. Henderson to review and sign.

7. On February 9, 2007, Mr. Henderson signed the Rule 131 declaration and sent it back to Respondent.

8. On February 9, 2007, Respondent filed the Rule 131 declaration in the ‘846 application with the Office. The Rule 131 declaration was prepared to antedate a patent that had been cited as prior art against the ‘846 application.

9. On February 10, 2007, Mr. Henderson informed Respondent that (i) he (Mr. Henderson) had not reviewed the Rule 131 declaration before signing it and (ii) the device demonstrated in July 1993 did not display a picture on a two line alphanumeric display as represented in the Rule 131 declaration, *i.e.*, that Mr. Henderson had not actually reduced to practice the claimed “picture” feature of the device.

10. After being so informed by Mr. Henderson, Respondent did not advise the Office in writing of the existence of the inaccuracy and untruthfulness in the Rule 131 declaration, did not advise the Office in writing as to the actual facts concerning the inaccuracy and untruthfulness, and did not fully correct in writing the USPTO written record.

11. On August 14, 2007, the USPTO issued U.S. Patent No. 7,257,210 on the ‘846 application.

12. The USPTO issued other patents whose allowance was dependent upon the allowance of the ‘846 application that Respondent was prosecuting on behalf of Mr. Henderson, including U.S. Application No. 10/033,824 (which issued as U.S. Patent No. 7,266,186 on September 4, 2007) and U.S. Application No. 11/045,677 (which issued as U.S. Patent No. 7,310,416 on December 18, 2007).

13. In *Intellect Wireless v. HTC Corp.*, (910 F. Supp. 1056 (N.D. Illinois) (September 6, 2012), the district court held U.S. Patent No. 7,266,186 and U.S. Patent No. 7,310,416 unenforceable due to inequitable conduct. The district court’s finding was predicated, in part, on a finding that the February 9, 2007 Rule 131 declaration filed in the ‘846 application was false. On October 9, 2013, the U.S. Court of Appeals for the Federal Circuit upheld the district court’s findings of inequitable conduct.

Legal Conclusion

14. Respondent acknowledges that, based on the above stipulated facts, he violated 37 C.F.R. § 10.23(b)(5) (proscribing engaging in conduct that is prejudicial to the administration of justice) by not advising the Office in writing of the existence of the inaccuracy and untruthfulness in the Rule 131 declaration filed in the '846 application, not advising the Office in writing as to the actual facts concerning the inaccuracy, and not fully correcting in writing the USPTO written record.

Agreed Upon Sanction

15. Respondent agrees, and it is hereby ORDERED that:

a. Respondent shall be, and hereby is, be suspended from practice before the Office in patent, trademark, and other non-patent matters for four years commencing on the date the Final Order is signed;

b. Respondent shall be granted limited recognition to practice before the Office commencing on the date the Final Order is signed and expiring thirty (30) days after the date the Final Order is signed with such limited recognition being granted for the sole purpose of facilitating Respondent's compliance with the provisions of 37 C.F.R. § 11.58(b);

c. Respondent shall comply with 37 C.F.R. § 11.58;

d. The OED Director shall comply with 37 C.F.R. § 11.59;

e. The USPTO shall promptly dissociate Respondent's name from all USPTO Customer Numbers and Public Key Infrastructure ("PKI") certificates;

f. Respondent shall not apply for or obtain a USPTO Customer Number unless and until he is reinstated to practice before the USPTO;

g. At any time after twenty four (24) months from the date the Final Order is signed, Respondent may file a petition for reinstatement pursuant to 37 C.F.R. § 11.60 requesting reinstatement;

h. Respondent shall remain suspended from the practice of patent, trademark, and non-patent law before the USPTO until the OED Director grants a petition reinstating Respondent pursuant to 37 C.F.R. § 11.60(c);

i. Respondent shall serve an eighteen month (18) month period of probation beginning on the date a petition granting Respondent's reinstatement is granted;

j. (1) if the OED Director is of the opinion that Respondent, during Respondent's probationary period, failed to comply with any provision of this Final Order or any provision of the USPTO Rules of Professional Conduct, the OED Director shall:

(A) issue to Respondent an Order to Show Cause why the USPTO Director should not enter an order immediately suspending Respondent for up to an additional eighteen (18) months for the violations set forth in paragraph 14, above;

(B) send the Order to Show Cause to Respondent at the last address of record Respondent furnished to the OED Director pursuant to 37 C.F.R. § 11.11; and

(C) grant Respondent fifteen (15) days to respond to the Order to Show Cause;

and

(2) in the event that after the 15-day period for response and consideration of the response, if any, received from Respondent, the OED Director continues to be of the opinion that Respondent, during Respondent's probationary period, failed to comply with any provision of the Agreement, this Final Order, or any provision of the USPTO Rules of Professional Conduct, the OED Director shall:

(A) deliver to the USPTO Director: (i) the Order to Show Cause; (ii) Respondent's response to the Order to Show Cause, if any; and (iii) argument and evidence causing the OED Director to be of the opinion that Respondent, during Respondent's probationary period, failed to comply with any provision of the Agreement, this Final Order, or any provision of the USPTO Rules of Professional Conduct; and

(B) request that the USPTO Director enter an order immediately suspending Respondent for up to an additional eighteen (18) months for the violations set forth in paragraph 14, above;

k. Nothing herein shall prevent the OED Director from seeking discipline for the misconduct leading to Respondent's additional suspension pursuant to the preceding subparagraph;

l. In the event the USPTO Director suspends Respondent pursuant to subparagraph j, above, and Respondent seeks a review of the suspension, any such review of the suspension shall not operate to postpone or otherwise hold in abeyance the suspension;

m. The OED Director shall electronically publish this Final Order at the Office of Enrollment and Discipline's electronic FOIA Reading Room, which is publicly accessible at: <http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>;

n. The OED Director shall publish a notice in the *Official Gazette* that is materially consistent with the following:

Notice of Suspension

This notice concerns Robert K. Tendler of Boston, Massachusetts, a registered patent attorney (Registration No. 24,581). The United States Patent and Trademark Office ("USPTO" or "Office") has suspended Mr. Tendler from practice before the Office in patent, trademark, and non-patent matters for four years for violating 37 C.F.R. § 10.23(b)(5). Mr. Tendler has the right to seek reinstatement after serving twenty four (24) months of his four-year suspension, and he will serve an eighteen (18) month probationary period upon being reinstated.

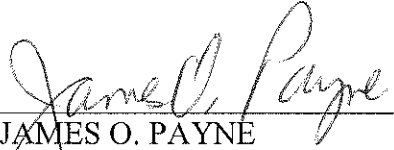
After being informed by his client that a Rule 131 declaration that had been filed in U.S. Patent Application No. 11/055,846 was inaccurate and not true, Mr. Tendler did not advise the Office in writing of the existence of the client's inaccuracy and untruthfulness in the Rule 131 declaration, did not advise the Office in writing as to the actual facts concerning the inaccuracy and untruthfulness, and did not fully correct in writing the USPTO written record. The USPTO subsequently issued a patent in the application where the inaccurate and untrue 131 declaration had been filed. Moreover, the USPTO issued other patents whose allowance was dependent upon the allowance of the application where the inaccurate and untrue Rule 131 application had been filed, including U.S. Application No. 10/033,824 (which issued as U.S. Patent No. 7,266,186 on September 4, 2007) and U.S. Application No. 11/045,677 (which issued as U.S. Patent No. 7,310,416 on December 18, 2007), both of which Mr. Tendler was prosecuting for the client. Thereafter, in *Intellect Wireless v. HTC Corp.*, 910 F. Supp. 1056 (N.D. Ill. September 6, 2012), the district court held U.S. Patent No. 7,266,186 and U.S. Patent No. 7,310,416 unenforceable due to inequitable conduct. The district court's finding was predicated, in part, on a finding that the Rule 131 declaration filed in U.S. Patent Application No. 11/055,846 application was false. On October 9, 2013, the U.S. Court of Appeals for the Federal Circuit upheld the district court's finding of inequitable conduct.

There are strict requirements imposed on a practitioner who is aware that a false Rule 131 declaration has been submitted in a patent application that the practitioner is prosecuting on behalf of a client. "The first requirement to be met by an applicant, aware of misrepresentation in the prosecution of his application and desiring to overcome it, is that he expressly advise the PTO of its existence, stating specifically wherein it resides." *Rohm and Haas Co. v. Crystal Chemical Co.*, 722 F.2d 1556, 1572 (Fed. Cir. 1983). "The second requirement is that, if the misrepresentation is of one or more facts, the PTO be advised what the actual facts are, the applicant making it clear that further examination in light thereof may be required if any PTO action has been based on the misrepresentation." *Id.* The practitioner has an affirmative obligation to tell the patent examiner if a Rule 131 declaration is false or misleading. "It does not suffice that one knowing of misrepresentations in an application or in its prosecution merely supplies the examiner with accurate facts without calling his attention to the untrue or misleading assertions sought to be overcome, leaving him to formulate his own conclusions." *Id.*

This action is the result of a settlement agreement between Mr. Tendler and the OED Director pursuant to the provisions of 35 U.S.C. §§ 2(b)(2)(D) and 32 and 37 C.F.R. §§ 11.19, 11.20, 11.26, and 11.59. In agreeing to the disciplinary sanction set forth above, the OED Director took into consideration Respondent's declining health and his lack of prior USPTO discipline. Disciplinary decisions involving practitioners are posted for public reading at the Office of Enrollment and Discipline Reading Room, available at: <http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>.

o. Nothing in this Agreement or the Final Order shall prevent the Office from considering the record of this disciplinary proceeding, including the Final Order: (1) when addressing any further complaint or evidence of the same or similar misconduct concerning Respondent brought to the attention of the Office; and/or (2) in any future disciplinary proceeding against Respondent (i) as an aggravating factor to be taken into consideration in determining any discipline to be imposed and/or (ii) to rebut any statement or representation by or on Respondent's behalf; and/or (3) in connection with any request for reconsideration submitted by Respondent pursuant to 37 C.F.R. § 11.60; and

p. The OED Director and Respondent shall file a joint motion dismissing the USPTO disciplinary proceeding pending against Respondent.



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

1-8-14
Date

on behalf of
Margaret A. Focarino
Commissioner for Patents
performing the duties and functions of the
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
United States Patent and Trademark Office

Robert K. Tendler