

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

In the Matter of	)	
	)	
Jeffrey R. Ramberg,	)	
	)	Proceeding No. D2017-12
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 Jeffrey R. Ramberg ("Respondent"), who is represented by counsel, 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 conclusions, and sanctions found in the Agreement.

**Jurisdiction**

1. At all times relevant hereto, Respondent of Newark, Delaware, has been an attorney registered to practice before the USPTO in patent matters and an attorney licensed by the State Bar of Maryland practicing before the USPTO in trademark matters, and is subject to the USPTO Rules of Professional Conduct.
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.

**Joint Stipulated Facts**

3. At all times relevant hereto, Respondent has been an attorney who has practiced before the Office in patent, trademark, and non-patent matters and is subject to the USPTO Rules of Professional Conduct. Respondent was registered to practice before the USPTO in patent matters on April 15, 1991. Respondent was admitted to practice as an attorney in the State of Maryland in 1996.
4. Respondent is a solo practitioner.

5. Respondent did not enter into a written engagement agreement with clients, Mr. Scott Holland and Dr. James McNaughton.
6. On May 15, 2014, Respondent filed U.S. Provisional Patent Application No. [REDACTED] ("the [REDACTED] application") and undertook the joint representation of Mr. Holland and Dr. McNaughton, who were named as inventors on the U.S. provisional application. i-Lighting, LLC, Mr. Holland's company, was listed as the applicant.
7. Respondent failed to properly explain his role, identify his client(s), and identify the scope his representation as to each client (i.e., Mr. Holland, i-Lighting, LLC, Dr. McNaughton and AHPharma, Inc.) prior to filing the [REDACTED] application.
8. On October 1, 2014, Respondent filed U.S. Trademark Application No. 86/412,439 on behalf of AHPharma, Inc., Dr. McNaughton's company.
9. Respondent did not advise either Mr. Holland or Dr. McNaughton of any potential conflicts of interest and did not obtain informed consent from either client prior to undertaking the trademark representation.
10. On May 15, 2015, Respondent filed U.S. Nonprovisional Patent Application No. [REDACTED] ("the [REDACTED] application"), which claimed priority to the [REDACTED] application and listed Mr. Holland as the sole inventor of application.
11. Respondent knew as of May 15, 2015 that Mr. Holland claimed that Dr. McNaughton had made no inventive contribution to the patent applications. Respondent continued to represent both Mr. Holland and Dr. McNaughton without discussing the actual or potential conflicts of interest and without obtaining informed consent to the representation.
12. Respondent did not inform Dr. McNaughton that he was not named as a co-inventor on the nonprovisional application.
13. Respondent filed a response to the Office action in the trademark application on July 21, 2015.
14. Respondent failed to conduct an independent analysis to determine the inventive entity prior to signing and filing either the provisional or the nonprovisional patent applications.
15. On or about July 2015, Respondent was told by Mr. Holland that i-Lighting, LLC and AHPharma, Inc. were no longer communicating.
16. Respondent filed a power of attorney in the nonprovisional application on July 30, 2015.
17. During September 2015, Dr. McNaughton contacted Respondent to determine the status of the nonprovisional application and ask whether he was included as a co-inventor.

18. On September 24, 2015, Respondent sent Dr. McNaughton a letter which stated that he did not know if Dr. McNaughton is entitled to be named a co-inventor.
19. Respondent sent Dr. McNaughton a power of attorney and draft assignment documents assigning the [REDACTED] application to i-Lighting on September 28, 2015.
20. Dr. McNaughton requested copy of claims filed in the nonprovisional application and did not sign the power of attorney or assignment documents.
21. As a result of the deterioration of the relationship of the parties, *i-Lighting, LLC v. AHPPharma, Inc. et al.*, No. 03 C 15 011550, Circuit Court for Baltimore County was filed on October 22, 2015.
22. On November 2, 2015, Respondent filed a withdrawal as attorney of record from the trademark application. The reason Respondent provided was that AHPPharma, Inc. was legally adverse and hostile to another client.
23. Dr. McNaughton inquired to Respondent about being listed as a co-inventor on the [REDACTED] application. On November 6, 2015, Respondent stated that Dr. McNaughton was a co-inventor.
24. On or about November 16, 2015, Respondent changed his analysis and stated that Dr. McNaughton was not a co-inventor.
25. On February 15, 2016, Respondent stated to Dr. McNaughton that he would not add his name as an inventor of the nonprovisional application.
26. Respondent requested withdrawal of power of attorney from the nonprovisional application on June 3, 2016 and November 28, 2016. The request was granted on December 8, 2016.
27. Respondent did not communicate adequate information and explain about the material risks of, and reasonably available alternatives to, the proposed course of conduct to either Mr. Holland or Dr. McNaughton regarding joint representation and did not obtain informed consent to the representation after full disclosure.

#### **Miscellaneous Factors**

28. Respondent has no prior disciplinary history before the Office or the State Bar of Maryland.
29. Respondent fully cooperated with the Office of Enrollment and Discipline during the investigation and resolution of this matter.

### **Joint Legal Conclusions**

30. Respondent acknowledges that, based on the information contained in the Joint Stipulated Facts, above, his conduct also violated the following provisions of the USPTO Rules of Professional Conduct:

- a. 37 C.F.R. § 11.107(a) (1)-(2) and (b)(3)-(4): Representing a client when the representation of one client will be directly adverse to another client; representing a client when the representation of that client may be materially limited by the practitioner's responsibilities to another client; representing a client when the representation involves the assertion of the claim by one client against another client represented by the practitioner in the same proceeding without obtaining consent after full disclosure; and
- b. 37 C.F.R. § 11.104 (a)(1)-(5) and (b): a) A practitioner shall: (1) Promptly inform the client of any decision or circumstance with respect to which the client's informed consent is required by the USPTO Rules of Professional Conduct; (2) Reasonably consult with the client about the means by which the client's objectives are to be accomplished; (3) Keep the client reasonably informed about the status of the matter; (4) Promptly comply with reasonable requests for information from the client; and (5) Consult with the client about any relevant limitation on the practitioner's conduct when the practitioner knows that the client expects assistance not permitted by the USPTO Rules of Professional Conduct or other law.  
(b) A practitioner shall explain a matter to the extent reasonably necessary to permit the client to make informed decisions regarding the representation.

### **Agreed Sanction**

31. Respondent agrees and it is hereby ORDERED that:

- a. Respondent shall be and hereby is publicly reprimanded;
- b. Respondent shall attend in person two ethics continuing legal education ("CLE") classes pertaining to conflicts of interest within one year from the date the Agreement was executed;
- c. Respondent shall report attendance of the CLE classes to the OED Director within one year from the date the Agreement was executed;
- d. Respondent shall take and pass the Multistate Professional Responsibility Examination ("MPRE") with a grade of at least 85;

- e. Respondent shall report a passing grade of at least 85 on the MPRE to the OED Director within one year from the date the Agreement was executed;
- f. The OED Director shall comply with 37 C.F.R. § 11.59;
- g. The OED Director shall electronically publish the Final Order at the OED electronic FOIA Reading Room, which is publicly accessible through the Office's website at: <http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>;
- h. The OED Director shall publish a notice materially consistent with the following Notice of Reprimand in the *Official Gazette*:

### **Notice of Reprimand**

This notice concerns Jeffrey R. Ramberg of Newark, Delaware, a registered practitioner (Reg. No. 34,700) who practices before the United States Patent and Trademark Office ("USPTO") in patent and trademark matters. The USPTO has publicly reprimanded Mr. Ramberg for violating the USPTO Rules of Professional Conduct.

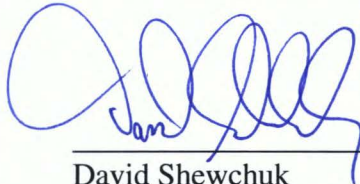
Mr. Ramberg undertook joint representation of two applicants in a patent application. Mr. Ramberg continued to represent both applicants after he became aware of an inventorship dispute without obtaining informed consent from each to continue the representation. Mr. Ramberg named one of the two applicants as the sole inventor on the nonprovisional application that claimed priority to the original application. Mr. Ramberg failed to inform the excluded applicant and continued to represent the first applicant in the matter, despite an actual or potential conflict of interest, and without obtaining informed consent from each. Mr. Ramberg followed the directions of the applicant who paid the legal fees. Mr. Ramberg also represented one of the applicants in a trademark application, which was related to the patent application without obtaining informed consent to the representation. The Director of the United States Patent and Trademark Office has ordered the public reprimand of Mr. Ramberg for violating the following USPTO Rules of Professional Conduct: 37 C.F.R. §§ 11.107(a)(1)-(2) and (b)(3)-(4) (representing a client when the representation of one client will be directly adverse to another client; representing a client when the representation of that client may be materially limited by the lawyer's responsibilities to another client; representing a client when the representation involves the assertion of a claim by one client against another client represented by the practitioner in the same proceeding without obtaining consent after full disclosure); and 11.104(a)(1)-(2) and (b) (failing to inform the client of any decision or circumstances with respect to which the client's informed consent is required; failing to consult with the client about the means by which client's objectives can be accomplished; failing to explain a matter to the extent reasonably necessary to permit the client to make an informed decision).

Factors reflected in the agreed upon resolution of this disciplinary matter include: (i) Mr. Ramberg has no prior disciplinary history before the USPTO; and (ii) Mr. Ramberg fully cooperated with the OED during the investigation and resolution of this matter.

This action is the result of a settlement agreement between Mr. Ramberg 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 and 11.26. Disciplinary decisions involving practitioners are posted for public reading at the OED Reading Room accessible at: <http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>.

- i. Nothing in the Agreement or this 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; (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
- j. The OED Director and Respondent shall each bear their own costs incurred to date and in carrying out the terms of this Agreement and the Final Order.

14 Feb 2017  
Date



David Shewchuk  
Deputy General Counsel for General Law  
United States Patent and Trademark Office

on behalf of

Michelle K. Lee  
Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office

cc: OED Director, USPTO

Mr. Michael E. McCabe, Jr.  
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