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

In the Matter of	)	
	)	
Mark Allen Ekse,	)	Proceeding No. D2019-22
	)	
Respondent	)	
	)	

FINAL ORDER

Pursuant to 37 C.F.R. § 11.27(b), the Director of the United States Patent and Trademark Office ("USPTO" or "Office") received for review and approval from the Director of the Office of Enrollment and Discipline ("OED Director") an Affidavit of Resignation Pursuant to 37 C.F.R. § 11.27 executed by Mark Allen Ekse ("Respondent") on February 19, 2019. Respondent submitted the 5-page Affidavit of Resignation to the USPTO for the purpose of being excluded on consent pursuant to 37 C.F.R. § 11.27.

For the reasons set forth herein, Respondent's Affidavit of Resignation shall be approved, and Respondent shall be excluded on consent from practice before the Office in patent, trademark, and other non-patent matters commencing on the date of this Final Order.

Jurisdiction

Respondent of Cedar Rapids, Iowa, is a registered patent attorney (Registration Number 50,130). Respondent is subject to the USPTO Code of Professional Responsibility, 37 C.F.R. § 10.20 *et seq.*, and the USPTO Rules of Professional Conduct, 37 C.F.R. § 11.101 *et seq.* [1]

[1] The USPTO Code of Professional Responsibility applies to a practitioner's conduct that occurred prior to May 3, 2013, while the USPTO Rules of Professional Conduct apply to a practitioner's conduct occurring on or after May 3, 2013.

Pursuant to 35 U.S.C. §§ 2(b)(2)(D) and 32 and 37 C.F.R. § 11.27, the USPTO Director has the authority to approve Respondent's Affidavit of Resignation and to exclude Respondent on consent from the practice of patent, trademark, and other non-patent law before the Office.

Respondent's Affidavit of Resignation

Respondent acknowledges in his February 19, 2019 Affidavit of Resignation that:

1. His consent is freely and voluntarily rendered, and he is not being subjected to coercion or duress.

2. He is aware that, pursuant to 37 C.F.R. § 11.22, the OED Director opened an investigation of allegations that he violated the USPTO Code of Professional Responsibility and USPTO Rules of Professional Conduct, namely: OED File No. [redacted] The investigation delved into and obtained information, *inter alia*, about the following:

a. From May of 2015 through March of 2016, Respondent filed three patent applications on behalf of his client (hereinafter "Client No. 1") with a power of attorney appointing Respondent to prosecute each of the patent applications.

b. During this period, Respondent was the only practitioner at the law firm where he was employed who was registered to practice in patent matters before the USPTO.

c. In each of the three patent applications for Client No. 1, the USPTO issued a notice informing Respondent that he had filed the client's patent application with a declaration that did not comply with 37 C.F.R. § 1.63 because the declaration did not state that the application was made or authorized to be made by the person executing the oath or declaration.

d. Despite having been informed of the defective declaration in Client No. 1's first patent application, Respondent filed a defective declaration in Client No. 1's second patent application. And despite having been informed of the defective declarations in Client No. 1's first patent application and second patent application, Respondent filed a defective declaration in Client No. 1's third patent application.

e. In each of Client No. 1's three patent applications, the USPTO's notice informed Respondent that he had to reply within two months, extendable with an appropriate extension of time, to avoid abandonment. Respondent did not provide these notices to Client No. 1 and did not otherwise inform Client No. 1 about the defective declarations.

f. Each of Client No. 1's patent applications became abandoned for Respondent's failure to reply to the notice. The USPTO issued a Notice of Abandonment in each patent application; however, Respondent did not provide the Notice of Abandonment to Client No. 1 for any of the three patent applications. Respondent did not inform Client No. 1 about the abandonments or Client No. 1's options for pursuing further patent prosecution.

g. In January of 2017, Respondent left his employer. Thereafter, Respondent did not communicate with Client No. 1. Despite having been the only registered practitioner at the firm, he did not change the correspondence address on Client No. 1's patent applications from his former employer's address. At all times relevant herein, Respondent did not take any steps to withdraw as the attorney of record in any of Client No. 1's patent applications.

h. Another client (hereinafter "Client No. 2") hired Respondent to prepare and prosecute a patent application. On August 24, 2009, Client No. 2 delivered $7,000.00 to Respondent. On September 9, 2009, Respondent filed Client No. 2's patent application with a power of attorney appointing him to prosecute the patent application.

i. Around January 26, 2012, Client No. 2 asked Respondent for the status of Client No. 2's patent application because Client No. 2 was concerned that it had been three and one-half years since the filing. Several weeks later, Client No. 2 attempted to contact Respondent to see what information Respondent might have uncovered, and Respondent replied that it was still under review with the USPTO.

j. Regarding Client No. 2's patent application, the USPTO sent Respondent a non-final Office action dated February 15, 2012, rejecting all twenty claims under pre-AIA 35 U.S.C. 102(b) as being clearly anticipated by a video and a public use that were attributed to Client No. 2.

k. Respondent did not inform Client No. 2 about the non-final Office action dated February 15, 2012.

l. Regarding Client No. 2's patent application, the USPTO sent Respondent a Notice of Abandonment dated September 21, 2012, stating that the application had gone abandoned because of applicant's failure to timely file a proper reply to the Office letter mailed on February 15, 2012.

m. Respondent did not inform Client No. 2 of the Notice of Abandonment dated September 21, 2012, or that the application had gone abandoned.

n. Respondent met with Client No. 2 in January of 2013 and suggested filing a "patent acceleration review" spelling out the approximate costs involved including Respondent's fees. Respondent did not inform Client No. 2 that the patent application had gone abandoned based on failure to reply to the Office action of February 15, 2012 that included a rejection of all claims under pre-AIA 35 U.S.C. 102(b) as being anticipated by Client No. 2's own video and also based on Client No. 2's public use or sale.

o. Client No. 2 agreed to move forward with a "patent acceleration review," and delivered funds to Respondent. Respondent reported to Client No. 2 that he had submitted the paperwork for "patent accelerated review" on March 14, 2013; however Respondent did not submit to the USPTO any papers concerning Client No. 2's patent application beyond the filing of the application on September 9, 2009. Respondent did not return to Client No. 2 the funds for the "patent accelerated review."

p. On February 20, 2015, Respondent left a voice mail for Client No. 2 stating he had filed a petition with the USPTO for a determination/decision. When Client No. 2 asked him why that was necessary, Respondent replied that it was just more pressure on the USPTO to get a determination on Client No. 2's patent application. Respondent had not actually filed the petition and the USPTO records show that no such petition was filed.

q. From around February 20, 2015 to December of 2016, Client No. 2 called or came to Respondent's office to check on the status of Client No. 2's patent application and Respondent told him there had been no response yet.

r. On December 10, 2016, Respondent phoned Client No. 2 to set up a meeting and suggested a sports bar after office hours. A few days before Christmas of 2016, he met with Client No. 2 at the sports bar. For the first time, Respondent told Client No. 2 that the patent application had been denied and suggested that Client No. 2 shouldn't bother throwing any more money into patent protection. Respondent did not provide a copy of Client No. 2's file to Client No. 2. Respondent did not explain the reason that the claims had been rejected by the Office action dated February 5, 2012, more than four and one-half years earlier. Respondent did not explain that the USPTO had issued a Notice of Abandonment dated September 21, 2012, more than four years earlier.

s. At all times relevant, Respondent did not file a request to withdraw from representing Client No. 2 regarding Client No. 2's patent application.

3. Respondent is aware that the OED Director is of the opinion based on this investigation that he violated the following provisions of the USPTO Code of Professional Responsibility: 37 C.F.R. §§ 10.23(b)(5) (A practitioner shall not engage in conduct that is prejudicial to the administration of justice) and (b)(6) (A practitioner shall not engage in other conduct that adversely reflects on the practitioner's fitness to practice before the Office) via 10.23(c)(8) (A practitioner shall not fail to inform a client or former client of correspondence received from the Office that could have a significant effect on a matter pending before the

Office), and 37 C.F.R. § 10.77(c) (A practitioner shall not neglect a legal matter entrusted to the practitioner).

4. Respondent is aware that the OED Director is of the opinion based on this investigation that he also violated the following provisions of the USPTO Rules of Professional Conduct: 37 C.F.R. § 11.102(a) (A practitioner shall abide by a client's decisions concerning the objectives of representation and shall consult with the client as to the means by which they are to be pursued), 37 C.F.R. § 11.103 (A practitioner shall act with reasonable diligence and promptness in representing a client), 37 C.F.R. § 11.104 (A practitioner shall reasonably consult with the client about the means by which the client's objectives are to be accomplished, keep the client reasonably informed about the status of the matter, promptly comply with reasonable requests for information from the client, consult with the client about any relevant limitation on the practitioner's conduct and explain a matter to the extent reasonably necessary to permit the client to make informed decisions regarding the representation), 37 C.F.R. § 11.105(b) (A practitioner shall consult with the client regarding the scope of the representation and the basis or rate of the fee and expenses for which the client will be responsible), 37 C.F.R. § 11.115 (Setting forth a practitioner's duties in safekeeping property of a client), 37 C.F.R. § 11.116 (Setting forth a practitioner's duties in terminating a representation of a client), 37 C.F.R. § 11.804(c) (It is professional misconduct for a practitioner to engage in conduct involving dishonesty, fraud, deceit or misrepresentation), 37 C.F.R. § 11.804(d) (It is professional misconduct for a practitioner to engage in conduct that is prejudicial to the administration of justice), and 37 C.F.R. § 11.804(i) (It is professional misconduct for a practitioner to engage in other conduct that adversely reflects on the practitioner's fitness to practice before the Office).

5. Without admitting to violating any of the disciplinary rules of the USPTO Code of Professional Responsibility and USPTO Rules of Professional Conduct investigated by the OED Director in OED File No. [redacted] Respondent acknowledges that, if and when he applies for reinstatement under 37 C.F.R. § 11.60 to practice before the USPTO in patent, trademark, and/or other non-patent matters, the OED Director will conclusively presume, for the purpose of determining the application for reinstatement, that:

(a) the facts regarding him in OED File No. [redacted] are true, and

(b) he could not have successfully defended himself against the allegations embodied in the opinion of the OED Director that he violated the following provisions of the USPTO Code of Professional Responsibility: 37 C.F.R. §§ 10.23(b)(5) and 10.23(b)(6) via 10.23(c)(8), and 10.77(c); and the following provisions of the USPTO Rules of Professional Conduct: 11.102(a), 11.103, 11.104, 11.105(b), 11.115, 11.116, 11.804(c), 11.804(d), and 11.804(i).

6. He has fully read and understands 37 C.F.R. §§ 11.5(b), 11.27, 11.58, 11.59, and 11.60, and is fully aware of the legal and factual consequences of consenting to exclusion from practice before the USPTO in patent, trademark, and other non-patent matters.

7. He consents to being excluded from practice before the USPTO in patent, trademark, and other non-patent matters.

Exclusion on Consent

Based on the foregoing, the USPTO Director has determined that Respondent's Affidavit of Resignation complies with the requirements of 37 C.F.R. § 11.27(a). Accordingly, it is hereby ORDERED that:

1. Respondent's Affidavit of Resignation shall be, and hereby is, approved;

2. Respondent shall be, and hereby is, excluded on consent from practice before the Office in patent, trademark, and other non-patent matters commencing on the date of this Final Order;

3. The OED Director shall electronically publish the 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;

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

Notice of Exclusion on Consent

This notice concerns Mark Allen Ekse, a registered patent attorney (Registration No. 50,130). The Director of the United States Patent and Trademark Office ("USPTO" or "Office") has accepted Mr. Ekse's affidavit of resignation and ordered his exclusion on consent from practice before the Office in patent, trademark, and non-patent law.

Mr. Ekse voluntarily submitted his affidavit at a time when a disciplinary investigation was pending against him. The investigation concerned Mr. Ekse's representation of two different clients before the Office in the prosecution of their respective patent applications. Mr. Ekse acknowledged that the OED Director was of the opinion that his conduct violated the following provisions of the USPTO Code of Professional Responsibility: 37 C.F.R. §§ 10.23(b)(5) (A practitioner shall not engage in conduct that is prejudicial to the administration of justice) and (b)(6) (A practitioner shall not engage in other conduct that adversely reflects on the practitioner's fitness to practice before the Office) via 10.23(c)(8) (A practitioner shall not fail to inform a client or former client of correspondence received from the Office that could have a significant effect on a matter pending before the Office), and 10.77(c) (A practitioner shall not neglect a legal matter entrusted to the practitioner); and the following provisions of the USPTO Rules of Professional Conduct: 11.102(a) (A practitioner shall abide by a client's decisions concerning the objectives of representation and shall consult with the client as to the means by which they are to be pursued), 11.103 (A practitioner shall act with reasonable diligence and promptness in representing a client), 11.104 (A practitioner shall reasonably consult with the client about the means by which the client's objectives are to be accomplished, keep the client reasonably informed about the status of the matter, promptly comply with reasonable requests for information from the client, consult with the client about any relevant limitation on the practitioner's conduct and explain a matter to the extent reasonably

necessary to permit the client to make informed decisions regarding the representation), 11.105(b) (A practitioner shall consult with the client regarding the scope of the representation and the basis or rate of the fee and expenses for which the client will be responsible), 11.115 (Setting forth a practitioner's duties in safekeeping property of a client), 11.116 (Setting forth a practitioner's duties in terminating a representation of a client), 11.804(c) (It is professional misconduct for a practitioner to engage in conduct involving dishonesty, fraud, deceit or misrepresentation), 11.804(d) (It is professional misconduct for a practitioner to engage in conduct that is prejudicial to the administration of justice), and 11.804(i) (It is professional misconduct for a practitioner to engage in other conduct that adversely reflects on the practitioner's fitness to practice before the Office).

Mr. Ekse did not admit to violating any of the disciplinary rules of the USPTO Code of Professional Responsibility and USPTO Rules of Professional Conduct, as alleged in the pending investigation, but he acknowledged that, if and when he applies for reinstatement, the OED Director will conclusively presume, for the limited purpose of determining the application for reinstatement, that (i) the facts set forth in the OED investigation against him are true, and (ii) he could not have successfully defended himself against the allegations embodied in the opinion of the OED Director that he violated the following provisions of the USPTO Code of Professional Responsibility: 37 C.F.R. §§ 10.23(b)(5) and 10.23(b)(6) via 10.23(c)(8), and 10.77(c); and the following provisions of the USPTO Rules of Professional Conduct: 11.102(a), 11.103, 11.104, 11.105(b), 11.115, 11.116, 11.804(c), 11.804(d), and 11.804(i).

This action is taken pursuant to the provisions of 35 U.S.C. §§ 2(b)(2)(D) and 32, and 37 C.F.R. §§ 11.27 and 11.59. 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.

5. Respondent shall comply fully with 37 C.F.R. § 11.58; and

6. Respondent shall comply fully with 37 C.F.R. § 11.60 upon any request for reinstatement.

[Signature on next page]

7 March 2019

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

Date

on delegated authority by

Andrei Iancu
Deputy Under Secretary of Commerce for Intellectual Property and
Deputy Director of the United States Patent and Trademark Office

cc:

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

Mr. Mark Allen Ekse
[redacted]
Respondent