

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

In the Matter of)
)
Kristin C. Castle,) Proceeding No. D2013-14
)
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 Kristin C. Castle (“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 Piedmont, California has been a registered patent attorney 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.*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. § 11.26.

Stipulated Facts

Background

3. Respondent of Piedmont, California is a registered patent attorney (Registration Number 47,208).

4. The USPTO Director previously warned Respondent concerning neglect of a client’s patent application.

¹ 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. Since the alleged conduct occurred prior to May 3, 2013, the USPTO Code of Professional Responsibility is applicable in this case. *See* 37 C.F.R. §§ 10.20-10.112.

5. Respondent agreed to assist in the drafting of a complete response to a 35 U.S.C. § 103 rejection (“§ 103 rejection”).

6. Respondent neglected to provide her client with a complete response to the § 103 rejection.

7. The response to the Office Action that Respondent prepared and filed was rejected by the Office and the subject of two successive Notices of Non-Compliant Amendment due to first, failing to accurately designate a status identifier and second, failing to indicate amendments to the claims utilizing the strikethrough and underline format.

8. Respondent charged her client for assisting him with the response to the Office Action despite her agreement to assist in preparing the response free of charge.

9. Respondent offered to send a status letter to the examiner as soon as he paid an outstanding invoice.

10. Respondent’s client agreed to her sending a status letter to the examiner and paid the outstanding invoice.

11. Respondent did not send a status letter to the examiner.

12. Respondent recommended to her client that Respondent conduct an examiner interview in order to expedite the examination of her client’s patent application.

13. Respondent’s client agreed to Respondent conducting an examiner interview.

14. Respondent did not conduct the examiner interview.

15. Respondent “cut-and-pasted” certificates of mailing from prior submissions to the Office for new submissions to the Office.

16. Respondent did not update the “cut-and-pasted” certificates of mailing, and as a result, Respondent signed and filed inaccurate certificates of mailing with the Office.

17. Respondent neglected to update the certificates of mailing, resulting in her incorrectly certifying to the Office that the submissions were being filed via EFS Web when in fact they were filed via US mail and/or facsimile.

18. Respondent represents that: on February 2, 2012 Respondent and client initially entered into an agreement wherein Respondent agreed to draft a 35 USC § 103 response free of charge to him, while the client would provide the rest of the response and file the response to the Office Action; Respondent drafted and filed the 35 USC § 103 response to the Office Action free of charge; Respondent determined at the time that the client had been drafting changes to the incorrect claim set; Respondent then corrected the claim set as of the date of the response to the Office Action; Respondent used a prior form document as a template in drafting the responses to

the Office Actions; the prior form document stated that the Certificate of mailing was by “Mail or EFS” in large print; in small print, the certificate of mailing stated that the document was sent via EFS web; Respondent failed to notice the EFS web and change it to mailing, but this was an inadvertent mistake, and not an attempt to mislead; the client agreed to pay Respondent for her work on the office action, which was outside the scope of her agreement to provide free services to him; on May 5, 2012, the client agreed to pay Respondent in exchange for her additional work on the response to the Office Action (other than the 35 USC § 103 response she agreed previously to file without charge); Respondent agreed to call the Examiner and did so, leaving several messages but never getting a return phone call; the client insisted on sending a status inquiry letter and Respondent initially agreed to do so in response to multiple demands, but later recollected from a previous conversation with this Examiner months earlier that he could not respond to status inquiries without first having seen a response; Respondent then made a strategic decision not to send the status letter until the Examiner had the response to the Office Action in possession; as of the date the client requested the status letter, the Examiner could not have received the response to the Office Action because it had just been sent, and thought it would be more prudent for the client at the time to wait until the document could be reviewed; however, the client revoked Respondent’s power of attorney, and Respondent was thus unable to send the letter, as Respondent was no longer attorney of record; the client was never charged for this status letter; Respondent only billed the client for four hours of work, although she had worked over 20 hours of actual time in dealing with the client.

Joint Legal Conclusion

19. Respondent acknowledges that, based on the above stipulated facts, she violated 37 C.F.R. § 10.77(c) by neglecting a legal matter entrusted to her.

Agreed Upon Sanction

20. Respondent agrees, and it is hereby ORDERED that:
- a. Respondent is hereby suspended for thirty days;
 - b. Respondent shall serve a six-month probationary period commencing on the date of her reinstatement to practice before the USPTO;
 - c. Respondent shall be permitted to practice before the USPTO in patent, trademark and other non-patent law before the USPTO during her probationary period, unless her probation is revoked and she is suspended by order of the USPTO Director or otherwise no longer has the authority to practice;
 - d. Respondent be granted limited recognition to practice before the Office commencing on 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), and expiring thirty (30) days after the date the Final Order is signed and accordingly,

Respondent's suspension shall begin thirty (30) days after the date the Final Order is signed;

- e. Respondent shall comply with 37 C.F.R. § 11.58;
- f. The OED Director shall comply with 37 C.F.R. § 11.59;
- g. The USPTO shall promptly to dissociate Respondent's name from all USPTO Customer Numbers and Public Key Infrastructure ("PKI") certificates;
- h. Respondent shall not apply for or obtain a USPTO Customer Number unless and until she is reinstated to practice before the USPTO;
- i. Respondent shall remain suspended from the practice of patent, trademark, and non-patent law before the USPTO until the OED Director grants a petition requesting Respondent's petition for reinstatement pursuant to 37 C.F.R. § 11.60(c);
- j. In the event the OED Director is of the opinion that Respondent, during the probationary period, failed to comply with any provision of the Agreement, this Final Order, or any Disciplinary Rule of the USPTO Rules of Professional Responsibility, the OED Director shall:
 - (i) issue to Respondent an Order to Show Cause why the USPTO Director should not order that Respondent be immediately suspended for up to six months for the violation set forth in the Joint Legal Conclusion, above;
 - (ii) 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(a); and
 - (iii) grant Respondent fifteen (15) days to respond to the Order to Show Cause;
- k. In the event that after the 15-day period for response and after the consideration of the response, if any, received from Respondent, the OED Director continues to be of the opinion that Respondent, during the probationary period, failed to comply with any provision of the Agreement, this Final Order, or any disciplinary rule of the USPTO Rules of Professional Responsibility, the OED Director shall:
 - (i) deliver to the USPTO Director or his designee: (A) the Order to Show Cause; (B) Respondent's response to the Order to Show Cause, if any; and (C) argument and evidence supporting the OED Director's conclusion that Respondent failed to comply with any provision of the Agreement, this Final Order, or any disciplinary rule of the USPTO Rules of Professional Responsibility during the probationary period, and

(ii) request that the USPTO Director immediately suspend Respondent for up to six months for the violations set forth in the Joint Legal Conclusion, above;

- 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 publish the Final Order at the OED's electronic FOIA Reading Room, which is publicly accessible through the Office's website at: <http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>;
- n. The OED Director shall publish the following notice in the *Official Gazette*:

Notice of Suspension and Probation

This notice regards Kristin C. Castle of Piedmont, California, a registered patent attorney (Registration Number 47,208). The United States Patent and Trademark Office ("USPTO" or "Office") has suspended Ms. Castle for thirty days and placed her on probation for six months for violating 37 C.F.R. § 10.77(c).

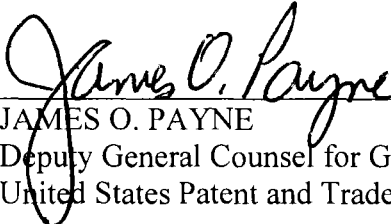
Ms. Castle was warned in a prior disciplinary matter for neglecting a client's patent application. Ms. Castle again neglected the same client's matter. She agreed to assist her client in preparing a response to a 35 U.S.C. § 103 rejection free of charge, but later charged him a fee for her services. Ms. Castle neglected to provide her client with a complete response to a § 103 rejection. The response to the Office Action prepared and filed by Ms. Castle received two successive Notices of Non-Compliant Amendment due to first, failing to accurately designate a status identifier and second, failing to indicate amendments to the claims utilizing the strikethrough and underline format. Additionally, Respondent neglected to send a status letter to the examiner or conduct an examiner interview despite advising her client that she would do so. Finally, Ms. Castle "cut-and-pasted" certificates of mailing from prior submissions to the Office for new submissions to the Office, resulting in the filing of inaccurate certificates of mailing with the Office. Specifically, Ms. Castle certified to the Office that the submissions were being filed via EFS Web when in fact they were filed via US mail and/or facsimile.

This action is the result of a settlement agreement between Ms. Castle and the OED Director pursuant to the provisions of 35 U.S.C. § 2(b)(2)(D) and 37 C.F.R. §§ 11.20, 11.26, and 11.59. Disciplinary decisions involving

practitioners are posted at the Office of Enrollment and Discipline's Reading Room located at:

<http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>.

- o. Nothing in this Agreement or this Final Order prevents the Office from considering the record of this disciplinary proceeding, including the Final Order, (i) when addressing any further complaint or evidence of the same or similar misconduct brought to the attention of the Office, and/or (ii) in any future disciplinary proceeding against Respondent (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;
- p. The OED Director and Respondent shall file a joint motion dismissing the USPTO disciplinary proceeding pending against Respondent within fourteen days after entry of any Final Order approving this Agreement; and
- q. The OED Director and Respondent shall each bear their own costs incurred to date and in carrying out the terms of this Agreement and any Final Order approving this Agreement.



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

JAN - 8 2014

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

Kristin C. Castle
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