

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

In the Matter of)	
)	
Kevin R. Rosin,)	Proceeding No. D2022-19
)	
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 Mr. Kevin R. Rosin (“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.

This 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’ joint stipulated facts, joint legal conclusions, and agreed upon sanctions found in the Agreement.

JURISDICTION

1. At all times relevant, Respondent of Cedarburg, Wisconsin, has been an attorney registered to practice before the USPTO in patent matters and subject to the USPTO Rules of Professional Conduct (37 CFR §§ 11.101-11.901).

2. The USPTO Director has jurisdiction over this matter pursuant to 35 U.S.C. §§ 2(b)(2)(D) and 32, and 37 CFR §§ 11.19, 11.20, and 11.26.

JOINT STIPULATED FACTS

3. Respondent became registered to practice before the USPTO on February 9, 2004 (Reg. No. 55,584).

4. Respondent was admitted to the practice of law in Wisconsin on May 17, 2004, and assigned State Bar No. 1049918.

5. Respondent specializes in intellectual property law, focusing primarily on the preparation and prosecution of patent applications.

6. Attorneys Timothy Klintworth and David Rozenblat own Klintworth and Rozenblat IP LLP (“K&R”), an intellectual property law firm located in Illinois.

7. K&R employed Respondent as a senior counsel from December 2, 2020, to December 3, 2021.

8. On November 11, 2020, Respondent executed an employment agreement with K&R that provided in pertinent part:

■ DUTIES, TERM, AND COMPENSATION. ... All legal work done by you for [K&R] must be done in the name of [K&R], and billed out through [K&R]. ...

* * *

■ INSURANCE. ... Please note, work done for clients which you do not notify [K&R] of while an employee of [K&R] will result in your immediate termination from the firm.

9. Respondent stated he believed that terms of his employment required him to provide and bill all legal- and patent-related services through K&R.

10. Respondent brought a new client (the “new client”) to K&R on January 25, 2021.

11. Between January 28, 2021 and April 22, 2021, Respondent provided patent legal services to the new client through K&R.

12. On May 3, 2021, Respondent formed his own law firm in Wisconsin (“Respondent’s law firm” or “his own law firm”). At all relevant times, Respondent was the only practitioner associated with Respondent’s law firm.

13. Respondent did not tell K&R that he had formed his own law firm.

14. On or about May 6, 2021, Respondent solicited the new client to become a client of Respondent’s law firm.

15. On May 10, 2021, the new client retained Respondent's law firm. The new client paid Respondent's law firm \$82,501 for patent-related legal services provided by Respondent between May 10, 2021 and November 20, 2021.

16. Respondent did not inform K&R that he was providing legal services to the new client outside K&R.

17. Respondent did not resign his employment immediately after forming his own law firm because he believed it would cause a hardship for his supervising attorney were he not to complete assigned projects. Additionally, Respondent was concerned that he would not be paid by K&R for work he had performed.

18. On November 20, 2021, a former employer of Respondent sent Klintworth and Rozenblat an email asking if they were aware that Respondent was operating his own law firm.

19. On November 20, 2021, Klintworth and Rozenblat called Respondent and asked Respondent about the information provided by Respondent's former employer. Respondent told Klintworth and Rozenblat that he had done consulting work independently of K&R for one client, but Respondent falsely denied having filed patent applications for the client. Respondent told them he was no longer working for the client outside of K&R.

20. On December 1, 2021, Respondent's former employer provided Klintworth and Rozenblat redacted documents showing Respondent's patent application filings on behalf of the new client while Respondent was employed by K&R.

21. On December 1, 2021, Klintworth and Rozenblat confronted Respondent with the information provided by Respondent's former employer. Respondent acknowledged having filed patent applications for the new client through Respondent's law firm.

22. On December 2, 2021, Respondent provided records to Klintworth and Rozenblat showing the legal services he had provided independently of K&R during the duration of his employment with K&R.

23. On December 3, 2021, Respondent paid K&R \$36,914.80, which represented the amount the firm would have earned under Respondent's compensation formula had the work been properly billed through K&R.

24. On December 3, 2021, Respondent resigned from K&R.

JOINT LEGAL CONCLUSION

25. Respondent acknowledges that, based on the above Joint Stipulated Facts, he violated the following provision of the USPTO Rules of Professional Conduct: 37 CFR§ 11.804(c) (engaging in conduct involving dishonesty, fraud, deceit or misrepresentation) by soliciting a client of his employer, not informing his employer of such solicitation, retaining payments by the client that should have been provided to his employer, and falsely denying to his employer that he had provided legal services to the client.

ADDITIONAL CONSIDERATIONS

26. Respondent has not been previously publicly disciplined in more than 19 years of practice.

27. Respondent has accepted responsibility for his actions, understands the seriousness of his misconduct, and is remorseful for his misconduct.

28. Respondent has fully cooperated with OED's investigation into his conduct.

AGREED UPON SANCTION

29. Respondent freely and voluntarily agrees, and it is hereby ORDERED that:

- a. Respondent shall be, and hereby is, publicly reprimanded;

- b. Respondent shall serve a two-year probationary period commencing on the date this Final Order is signed;
- c. Respondent shall (i) complete at least four (4) hours of continuing legal education (“CLE”) courses, in which the primary subject is general legal ethics, fiduciary duty, and/or a lawyer’s duty of candor, (ii) file an affidavit with the OED Director attesting to his successful completion of this required CLE, and (iii) provide certificates of completion corroborating the affidavit, all within one year of the date of this Final Order;
- d. In the event the OED Director is of the opinion that Respondent, during Respondent’s probationary period, failed to comply with any provision of the Final Order, or any of the USPTO Rules of Professional Conduct, the OED Director shall:
 - (1) issue to Respondent an Order to Show Cause why the USPTO Director should not order Respondent be immediately suspended for six (6) months for the violation set forth in the Joint Legal Conclusion, above;
 - (2) send the Order to Show Cause to Respondent at the last address of record under 37 CFR § 11.11(a); and
 - (3) grant Respondent fifteen (15) days to respond to the Order to Show Cause; and
 - (4) if, after consideration of any timely filed response by the Respondent, the OED Director continues to be of the opinion that Respondent failed to comply with any provision of the Final Order or any of the USPTO Rules of Professional Conduct, as set forth in the Order to Show Cause, the OED Director shall:
 - (A) deliver to the USPTO Director or her designee: (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 failed to comply with any provision of the Final Order, or any disciplinary rule of the USPTO Rules of Professional Conduct during the probationary period, and
 - (B) request that the USPTO Director immediately suspend Respondent from practice before the USPTO for six (6) months for the violation set forth in the Joint Legal Conclusion, above;
- e. In the event the USPTO Director suspends Respondent pursuant to paragraph “d” 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;

- f. Nothing in this Final Order shall prevent the Office from seeking discipline against Respondent pursuant to 37 CFR §§11.19 through 11.57 for any misconduct engaged in by Respondent prior to, during, or after his probationary period, including that which formed the basis for an Order to Show Cause issued pursuant to the preceding paragraph “d” above, or which led to the imposition of a suspension pursuant to paragraph “d” above;
- g. The OED Director shall electronically publish the Final Order at OED’s electronic FOIA Reading Room, which is publicly accessible at: <https://foiadocuments.uspto.gov/oed/>;
- h. The OED Director shall publish a notice in the *Official Gazette* that is materially consistent with the following:

Notice of Reprimand and Probation

This notice concerns Kevin R. Rosin of Cedarburg, Wisconsin, who is a registered patent practitioner (Registration No. 55,584). In settlement of a disciplinary proceeding, the Director of the United States Patent and Trademark Office (“USPTO” or “Office”) has reprimanded Mr. Rosin, placed him on probation for two years, and imposed a requirement to complete four (4) hours of continuing legal education, for violating 37 CFR § 11.804(c).

While employed by a law firm as an associate, Mr. Rosin solicited a client of his employer, began performing patent legal services for the client without the employer’s knowledge, and later, falsely denied to his employer having provided legal services to the client. When later confronted by his employer with information revealing this arrangement, Mr. Rosin resigned and immediately paid the law firm \$36,914.80, the amount his employer would have earned had Mr. Rosin billed his legal services through the firm.

In reaching this settlement, the OED Director considered that Mr. Rosin has (1) accepted responsibility for his actions; (2) expressed contrition and understands the seriousness of his actions and how his actions violated the USPTO Rules of Professional Conduct; (3) not been previously publicly disciplined in more than 19 years of practice; and (4) fully cooperated with the Office of Enrollment and Discipline during the investigation of this matter.

This action is the result of a settlement agreement between Mr. Rosin and the OED Director pursuant to the provisions of 35 U.S.C. §§ 2(b)(2)(D) and 32, and 37 CFR §§ 11.3, 11.19, 11.20, and 11.26. Disciplinary decisions

involving practitioners are posted for public reading at the OED FOIA Reading Room, available at: <https://foiadocuments.uspto.gov/oed/>.

- i. Nothing in the Agreement or this Final Order shall prevent the Office from considering the record of this disciplinary proceeding, including this Final Order: (1) when addressing any further complaint or evidence of the same or similar misconduct concerning Respondent that should be 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;
- j. Respondent has waived the opportunity: (i) to seek reconsideration of this Final Order under 37 CFR § 11.56 or 11.57, (ii) to have this Final Order reviewed under 37 CFR § 11.57, and (iii) otherwise to appeal or challenge the Final Order in any manner; and
- k. Each party bears their own costs in complying with the terms of this Agreement and any Final Order.

Users,
Shewchuk,
David

 Digitally signed by
Users, Shewchuk, David
Date: 2022.08.23
11:06:31 -04'00'

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

Date

on delegated authority by

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