

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS

KAREN L. BOVARD,
Director, Office of
Enrollment and Discipline

v.

Respondent.

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) Proceeding D96-01
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FINAL ORDER

(Respondent), being sworn (or affirmed),
deposes and says that he, being fully advised, desires to settle
this disciplinary matter without the need for a hearing.
Respondent, in cooperation with the Director of Enrollment and
Discipline (Director), therefore presents to the Commissioner
this agreed-upon FINAL ORDER as settlement of the above-
identified matter.

A. Respondent is an attorney at law in the State of
registered to practice before the Patent and Trademark
Office (PTO).

B. A Complaint and Notice of Proceedings Under 35 U.S.C.
§ 32 (Complaint) against respondent was approved by the Committee
on Discipline. The Complaint alleged that respondent withheld
required information from the Patent and Trademark Office by
filing an application with claims copied from an issued U.S.

patent of another without identifying the patent as the one from which the claims were copied and the numbering of the patent claims, and by prosecuting such application. This conduct was in violation of 37 C.F.R. § 10.23. The charges against Respondent set forth in the Complaint were as follows:

1. Respondent is the attorney of record in an application that was filed with claims that had been copied from an issued U.S. patent of another without identifying the patent. As later admitted by respondent, in a letter dated _____ I was instructed to include claims copied from the [] patent, specifically claims _____ to preserve [my client's] right to pursue an interference."

2. Respondent filed an "Information Disclosure Statement." The patent containing the copied claims was listed

_____ thereof, and a single sentence explanation of the pertinence was given. Respondent did not bring to the examiner's attention that claims in the application had been copied from that patent.

3. In connection with the filed application, respondent received an Office action which included a rejection of claims _____ over a second U.S. Patent in view of the patent containing the copied claims.

6.

The concluding sentence of the "Remarks" portion, immediately preceding respondent's salutation and signature, states:

7. By failing to inform the examiner that claims of the application had been copied from a U.S. patent, as required by 37 C.F.R. § 1.607(c), and by repeatedly arguing that the copied claims were patentable, respondent engaged in conduct that adversely reflects on his fitness to practice before the Office.

8. The conduct set forth in paragraphs 1 through 8 of the Count constitutes professional misconduct which justifies a reprimand or whatever other action is deemed appropriate under Part 10, Title 37, Code of Federal Regulations, to wit: 37 C.F.R. § 10.23(c)(7).

C. For purposes of settling this disciplinary matter without any determination by the Administrative Law Judge, and without a hearing, the Director and Respondent have agreed as follows:

1. Respondent acknowledges that he is aware of charges alleging that he has violated the PTO Code of Professional Responsibility, as set forth in the Complaint.

2. Respondent further acknowledges that he is entitled to a hearing in this proceeding and that he hereby waives his rights thereto.

3. Respondent further acknowledges that he is freely and voluntarily entering into this settlement and accepts this FINAL ORDER.

4. Respondent further acknowledges that he is not acting under duress or coercion from the PTO.

5. Respondent further acknowledges that he is fully aware of the implications of entering into this settlement and

accepting this FINAL ORDER, and knowingly choosing not to be represented by counsel.

6. Respondent freely and voluntarily accepts a private reprimand for withholding required information from the Patent and Trademark Office, thereby engaging in misconduct in violation of 37 C.F.R. § 10.23.

7. Respondent acknowledges that the following notice will be published in the Official Gazette pursuant to 37 C.F.R. § 10.159(b):

Notice of Private Reprimand

A practitioner, whose identity is not being disclosed, has been privately reprimanded by the Commissioner of Patents and Trademarks for withholding required information from the Patent and Trademark Office. The practitioner engaged in misconduct in violation of 37 C.F.R. § 10.23 by filing an application for U.S. patent with claims copied from an issued U.S. patent of another without identifying the patent as the one from which the claims were copied and the numbering of the patent claims, and by prosecuting such

application. Because of factual circumstances unique to this case, the Commissioner has chosen to issue only a private reprimand for this misconduct.

8. In accordance with 37 C.F.R. § 10.159(c), the Commissioner will maintain a record of this disciplinary proceeding, with all identifying indicia removed, for public inspection.

9. The Director and Respondent request the Commissioner to enter the FINAL ORDER.

10. The Director and Respondent shall bear their own costs.

11. This action is taken pursuant to 35 U.S.C. § 32 and 37 C.F.R. § 10.133(g).

12. The effective date of this FINAL ORDER and the requirements herein is thirty (30) calendar days from the date of signature and acceptance of the FINAL ORDER by the Commissioner.

Agreed to: _____

Date: 20 Aug 97

Respondent

State of _____

County of _____

Subscribed and sworn to, or affirmed before me this 26th day of

August, 1997.

3 (Rev. 11/95)

Commission Expires Jan. 31, 2001

Agreed to: Karen L. Bovard
Karen L. Bovard
Director, Office of
Enrollment and Discipline

Date: Aug 26, 1997

Agreed to: Scott A. Chambers
Scott A. Chambers
Associate Solicitor
Counsel for the Director

Date: Aug 26, 1997

Approved and FINAL ORDER Entered:

Bruce A. Lehman
Bruce A. Lehman
Assistant Secretary of Commerce
and Commissioner of Patents and Trademarks

Date: Aug 28, 1997