

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

In the Matter of)
)
 [])
)
Respondent.)
_____)

Proceeding No.: D2006-17

FINAL ORDER

The Director of Enrollment and Discipline (OED Director) of the United States Patent and Trademark Office (USPTO) and [], Respondent, USPTO Registration No. [], have submitted a settlement agreement in the above proceeding. In order to avoid the necessity of an oral hearing, Respondent and the OED Director have agreed to certain stipulated facts, legal conclusions, and discipline.

STIPULATED FACTS

1. On [], 2002, [] filed U.S. Provisional Application No. [] titled, “[].”
2. On [], 2003, [] filed International Application No. PCT/[] (PCT []), which claimed priority to the [] Provisional Application.
3. Also on [], 2003, [] filed U.S. Application No. [] ([] Application), which claimed priority to the [] Provisional Application.
4. On [], 2004, [] filed CIP U.S. Application No. [] ([] Application), which claimed priority to the [] Application.
5. On [], 2005, a Petition for Express Abandonment to Avoid Publication under 37 CFR 1.138(c) was filed in the [] Application. The petition was granted and the [] Application was withdrawn from publication.
6. Also on [], 2005, [] filed U.S. Application No. [] ([] Application), which was a CIP application of the [] Application, which included some newly added figures. [] also filed a “Nonpublication Request under 35 U.S.C. 122(b)(2)(B)(i), which indicated that it was USPTO for[m] PTO/SB/35, and included the OMB information in the header and footer of the form.

7. Compliance with 35 U.S.C. 122(b)(2)(B)(i) requires practitioners to “[certify] that the invention disclosed in the application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing.” 35 U.S.C. 122(b)(2)(B)(i).

8. MPEP 1122 states:

I. REQUIREMENTS PRIOR TO FILING A NONPUBLICATION REQUEST

A nonpublication request is not appropriate unless the person who is signing the nonpublication request has made an actual inquiry consistent with the requirements of 37 CFR 10.18(b) to determine that:

(A) The application under 35 USC 111(a) has not been the subject of a foreign or international application filed in another country, or under a multilateral international agreement, that requires publication of applications eighteen months after filing (e.g., a counterpart PCT application); and

(B) The applicant’s intent at the time the nonpublication request is being filed is that the application will not be the subject of a foreign or international application filed in another country, or under multilateral international agreement, that requires publication or applications at eighteen months after filing.

9. [] admits that she modified the Nonpublication Request to delete “has not and”. The deleted words are required under 35 U.S.C. 122(b)(2)(B)(i) to be in the certified statement requesting nonpublication. [] states that it was her intention to inform the office that the CIP would not be the subject of any future application filed in another country.

LEGAL CONCLUSIONS

10. Based upon the foregoing stipulated facts, Respondent agreed that her conduct violated the Disciplinary Rules of the Code of Professional Responsibility as outlined in 37 C.F.R. § 10.77(b) by handling the Nonpublication Request without adequately determining whether one could be filed under the circumstances.

DISCIPLINE

11. Based upon the foregoing, Respondent agreed and it is ORDERED THAT:

- a. Respondent be privately reprimanded.
- b. The OED Director will publish the following Notice in the Official

Gazette:

Notice of Private Reprimand

A patent attorney has been privately reprimanded by the United States Patent and Trademark Office. The private reprimand is issued pursuant to the provisions of 35 U.S.C. § 32, and 37 C.F.R. § 10.133(g).

April 30, 2007
Date

_____/s/_____
James A. Toupin
General Counsel
United States Patent and Trademark Office

On behalf of Jon W. Dudas
Under Secretary of Commerce For
Intellectual Property and Director of the
United States Patent And Trademark Office

cc: Harry I. Moatz
OED Director

cc: Cameron K. Weiffenbach
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