

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

In the Matter of)
)
Larry M. Jennings)
)
Respondent.)
)

Proceeding No.: D04-12

FINAL ORDER

The Director of Enrollment and Discipline (OED Director) of the United States Patent and Trademark Office (USPTO) and Larry M. Jennings, Respondent, USPTO registration No. 34,191, 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

Count 1

1. Respondent was retained by Promethean Medical Technologies, Inc. (Promethean) and its President and CEO, Allan R. Robinson (Robinson), as its intellectual property attorney in January of 1998, to *inter alia*, compose and prosecute certain patent applications.
2. On February 19, 1998, Respondent filed U.S. patent application No. 09/020,708 ('708 application) on behalf of inventors Robinson and Dennis Risvedt and assignee Promethean for the invention "Disposable Fluid Control Island." Respondent also filed a Power of Attorney in the '708 application authorizing Respondent to prosecute the '708 application and directing all communications to Respondent at Respondent's address set forth in the Power of Attorney.
3. The USPTO issued an Office Action dated September 27, 1999, in the '708 application rejecting all claims in the application and setting a three-month period for reply. The Office Action was mailed to Respondent at Respondent's address set forth in the Power of Attorney, in accordance with the directions in the Power of Attorney. According to Robinson, Respondent acknowledged receipt of the Office Action and indicated that the issues therein would be addressed.
4. The USPTO failed to receive a response to the Office Action and on or about December 28, 1999, the '708 application became abandoned. The USPTO issued a Notice of

Abandonment dated April 24, 2000 in the '708 application. The Notice of Abandonment was mailed to Respondent at Respondent's address set forth in the Power of Attorney. On information and belief, Respondent did not report the Notice of Abandonment to Promethean or Robinson.

5. On April 11, 2000, Respondent wrote to Robinson indicating that the '708 application is pending.
6. On April 25, 2002 Respondent filed with the USPTO a Petition for Revival of Unintentionally Abandoned Application together with amendments to the claims of the '708 application.
7. On May 15, 2002 the USPTO issued a Decision on Respondent's April 25, 2002, petition.

Count 2

8. Above paragraphs 1-7 are incorporated herein by reference.
9. On May 1, 2000, Respondent filed U.S. patent application No. 09/562,064 ('064 application) on behalf of inventor Robinson and assignee Promethean for the invention "Disposable Fluid Control Island." Respondent also filed a Power of Attorney in the '064 application authorizing Respondent to prosecute the '064 application and directing all communications to Respondent at Respondent's address set forth in the Power of Attorney.
10. The '064 application also included a Declaration claiming benefit to the filing date of the '708 application.
11. The USPTO issued an Office Action dated March 1, 2001, in the '064 application rejecting all claims in the application and setting a three-month period for reply. The Office Action was mailed to Respondent at Respondent's address set forth in the Power of Attorney, in accordance with the directions in the Power of Attorney. On information and belief, the Office Action was not reported to Promethean or Robinson.
12. The USPTO failed to receive a response to the Office Action and on or about June 1, 2001, the '064 application became abandoned. The USPTO issued a Notice of Abandonment dated October 1, 2001, in the '064 application. The Notice of Abandonment was mailed to Respondent at Respondent's address set forth in the Power of Attorney. On information and belief, Respondent did not report the Notice of Abandonment to Promethean or Robinson. Respondent asserts that he had no knowledge of receiving said Notice of Abandonment.
13. In July 2002, Respondent provided Promethean with a status letter expressly referencing a "Disposable Fluid Control Island for Hysteroscopy" that was filed on "May 1, 2000,"

(the filing date for the '064 application), and indicating that "it appears likely that patents will issue covering your inventions."

14. On October 21, 2002, Respondent filed with the USPTO a Petition for Revival of Unintentionally Abandoned Application to revive the '064 application.

Count 3

15. Above paragraphs 1-14 are incorporated herein by reference.
16. In April 2001, Respondent agreed to file a Patent Cooperation Treaty (PCT) application for Promethean in order to extend the time for Promethean to decide whether to seek foreign patent rights. The PCT application was to be based on the '064 application (filed May 1, 2000). Respondent placed the funds for the PCT application in his corporate account.
17. On May 3, 2001, Respondent met with Robinson in person at the Promethean offices and there informed Robinson and Promethean that he had prepared the requested PCT application, but that he failed to file the PCT application by the filing deadline (12:00 midnight, May 1, 2001), stating to Robinson that he "had not gotten the Application to the Post Office in time."

LEGAL CONCLUSIONS

18. Based upon the foregoing stipulated facts, Respondent agreed that his conduct violated the following Disciplinary Rules of the Code of Professional Responsibility as outlined in Section 10 of 37 C.F.R.:

Count 1

- a. Rule 10.23(b)(4) in that Respondent engaged in conduct involving misrepresentation by representing to Promethean that the '708 application was pending in at least one letter when in fact the '708 application was abandoned;
- b. Rule 10.23(c)(8) in that Respondent failed to inform and/or promptly communicate with his client in failing to notify Promethean and/or Robinson of the Notice of Abandonment in the '708 application; and
- c. Rule 10.77(c) in that Respondent neglected a legal matter entrusted to him in allowing the '708 application to become abandoned, failing to notify Promethean and/or Robinson of the Notice of Abandonment in the '708 application.

Count 2

- d. Rule 10.23(c)(8) in that Respondent failed to inform and or promptly communicate with his client in failing to notify Promethean and/or Robinson of the Notice of Abandonment in the '064 application; and
- e. Rule 10.77(c) in that Respondent neglected a legal matter entrusted to him in allowing the '064 application to become abandoned, failing to notify Promethean and/or Robinson of the Notice of Abandonment in the '064 application.

Count 3

- f. Rule 10.77(c) in that Respondent neglected a legal matter entrusted to him in failing to deliver the PCT application to the U.S. Postal service before the deadline for filing a PCT application based on the '064 application; and
- g. Rule 10.112(a) in that Respondent did not cause Promethean's funds to be deposited in identifiable banks accounts in the United States and separately preserve the identity of Promethean's funds.

DISCIPLINE

19. Respondent agreed, and it is ordered that:

- a. Respondent be suspended for one (1) year from practice of patent, trademark, and other non-patent law before the USPTO starting from the date of a Final Order concerning this matter.
- b. The OED Director will publish the following Notice in the Official Gazette:

Notice of Suspension

Larry M. Jennings, of Minneapolis, MN, a patent attorney, with registration number 34,191, has been suspended for one year from practice before the United States Patent and Trademark Office in patent, trademark, and other non-patent law cases beginning effective as of *the date of the Final Order*. This suspension is made pursuant to the provisions of 35 U.S.C. § 32, and 37 C.F.R. § 10.133(g).

- c. Within 30 days of the date of this Final Order, Respondent shall, in accordance with 37 C.F.R. § 10.158(b)(2), surrender each client's active USPTO case file(s) to (1) each client or (2) another practitioner designated by each client, and shall file proof thereof with the OED Director within the same 30 day period.

d. During the period Respondent is suspended any communication relating to a client matter that is addressed to Respondent and/or received by him shall be immediately forwarded to the client or the practitioner designated by the client, and that Respondent will take no other legal action in the matter, enter any appearance, or provide any legal advice concerning the matter that is the subject of the communication, all in accordance with 37 C.F.R. §§ 10.158(a), (b)(2), (b)(6).

e. Within 30 days of the date of this Final Order, Respondent shall, in accordance with 37 C.F.R. §§ 10.158(b)(8), 10.160(d), return to any client having immediate or prospective business before the Office any unearned legal funds, including any unearned retainer fee, and any securities and property of the client, and shall file a proof thereof with the OED Director no later than filing his petition for reinstatement.

f. After the date of this Final Order, Respondent shall promptly take steps to comply with the provisions of 37 C.F.R. § 10.158(b)(3), (b)(4), (b)(5), (b)(6), and (b)(7), and further, within 30 days of taking steps to comply with § 10.158(b)(4) Respondent shall file with the OED Director an affidavit describing the precise nature of the steps taken, and still further directing that Respondent shall submit proof of compliance with §§ 10.158(b)(3), (b)(5), (b)(6), and (b)(7) with the OED Director upon filing a petition for reinstatement under 37 C.F.R. § 10.160.

g. After the date of this Final Order, Respondent shall promptly take steps to fully comply with the provisions of 37 C.F.R. §§ 10.158(c) and (d).

REINSTATEMENT

20. Respondent agreed, and it is ordered that following the suspension for one (1) year in compliance with the foregoing provisions, Respondent may apply to be reinstated to practice effective upon filing a petition for reinstatement and accompanying affidavit showing compliance with the following conditions:

- a. Respondent demonstrates full compliance with 37 C.F.R. §§ 10.158 and 10.160, and
- b. Respondent provides proof that he continues to participate in all therapy programs or else provides proof that he successfully completed all therapy programs recommended by the licensed consulting psychologist or other mental health professional accepted by the Minnesota Director of the Office of Lawyers Professional Responsibility as required by the

Minnesota Supreme Court in case No. A04-2371. Upon request, Respondent shall provide to the OED Director medical authorizations sufficient to authorize the OED Director to obtain his treatment records and reports and to discuss his treatment with the treatment providers. The information provided pursuant to this section must comply with 37 C.F.R. § 10.160.

10/5/05
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
Office of Enrollment and Discipline
USPTO

Larry M. Jennings