

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

In the Matter of	)	
	)	
Ilya Zborovsky,	)	
	)	Proceeding No. D09-34
Respondent	)	
_____	)	

**Final Order**

Office of Enrollment and Discipline Director Harry I. Moatz (“OED Director”) and Ilya Zborovsky (“Respondent”) have submitted a Proposed Settlement Agreement to the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (“USPTO Director”) or his designate for approval.

The OED Director and Respondent’s Proposed Settlement Agreement sets forth certain stipulated facts, legal conclusions, and sanctions to which the OED Director and Respondent have agreed in order to resolve voluntarily a disciplinary complaint against Respondent. The Proposed Settlement Agreement, which satisfies the requirements of 37 C.F.R. § 11.26, resolves all disciplinary action by the United States Patent and Trademark Office (“USPTO” or “Office”) arising from the stipulated facts set forth below.

Pursuant to such Proposed Settlement Agreement, this Final Order sets forth the parties’ stipulated facts, legal conclusions, and agreed upon discipline.

**Jurisdiction**

1. At all times relevant hereto, Respondent of Dix Hills, New York, has been an agent registered to practice before the USPTO (Registration Number 28,563) 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.* 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. §§ 11.20(a)(3), 11.26 and 11.59

**Stipulated Facts**

Filing of ‘890 application

2. On October 15, 2001, Boris Kesil, David Margulis, and Elik Gershenzon signed and filed U.S. Patent Application No. 09/976,890 (the “‘890 application”) in the USPTO for the invention, “Method and Apparatus for Preventing Transfer of an Object Having Wrong Dimensions or Orientation.”

3. Kesil, Gershenzon, and Margulis were identified as the first, second, and third inventors respectively in the ‘890 application. No other inventors were named in the

application. Kesil, Gershenzon, and Margulis signed the '890 application as the inventors of the claimed invention.

4. The '890 application directed the USPTO to send correspondence and make telephone calls to "Boris Kesil, MultiMetrix, LLC, 1059 Di Giulio Avenue, Santa Clara, CA 95050 Tel. 408-727-8955."

5. According to Respondent, Alexander Shkolnik prepared the '890 application and sent it to Respondent to review prior to it being filed in the USPTO.

6. Respondent reviewed the '890 application—which readily identified Kesil, Gershenzon, and Margulis as the three inventors— prior to the application being filed. Respondent did not sign or file it as the attorney of record.

#### Death of Margulis

7. Margulis died on October 10, 2002, during the prosecution of the '890 application.

8. Respondent did not learn of Margulis's death until 2008.

#### Margulis's Forged Signature on Response to Office Action

9. On June 4, 2003, a response to an Office Action in the '890 application was filed in the USPTO.

10. The response was signed by Kesil and Gershenzon and bore Margulis's purported signature. Margulis's purported signature was forged.

11. According to Respondent, Shkolnik prepared the June 4 response and sent it to Respondent to review prior to it being filed in the USPTO.

12. Respondent reviewed the response—which readily identified Kesil, Gershenzon, and Margulis as the three inventors— prior to the response being filed. Respondent did not sign or file the June 4 response as the attorney of record.

#### Notice of Allowance and Abandonment of the '890 application

13. On November 3, 2003, the USPTO mailed a "Notice of Allowance and Fee(s) Due" on the '890 application stating that the issue fee must be paid within three months (i.e., February 3, 2004) or the application shall be regarded as abandoned. The notice was mailed to "MultiMetrix, LLC, 1059 Di Giulio Avenue, Santa Clara, CA 95050."

14. The issue fee was not paid and, on March 8, 2004, the USPTO mailed a Notice of Abandonment on the '890 application to "MultiMetrix, LLC, 1059 Di Giulio Avenue, Santa Clara, CA 95050."

### Petition to Revive

15. After the '890 application became abandoned, Respondent was formally retained to respond to the Notice of Abandonment.

16. Respondent prepared and signed a "Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 C.F.R. § 1.137 (b)," a transmittal fee form, and a cover letter that accompanied the formal drawings.

17. According to Respondent, Shkolnik prepared the drawings and a "Combined Declaration and Power of Attorney," which was dated May 11, 2004.

18. On July 23, 2004, Respondent filed in the USPTO the aforementioned petition, transmittal fee form, cover letter, drawings and combined declaration and power of attorney.

### Incomplete Document Filed by Respondent

19. The "Combined Declaration and Power of Attorney" filed by Respondent in the USPTO identified only Kesil and Gershenzon as inventors, and only Kesil and Gershenzon signed it.

20. The "Combined Declaration and Power of Attorney" asserted, under oath, that Kesil was the first inventor and Gershenzon was the second inventor —i.e., it did not identify Margulis as an inventor.

21. The "Combined Declaration and Power of Attorney" authorized Respondent to transact all business with the Office in connection with the '890 application.

### USPTO's Response to Petition to Revive the '890 application

22. On October 21, 2004, the USPTO's Office of Petitions granted Respondent's petition to revive the '890 application. The USPTO, however, did not accept the power of attorney because it had been signed by only two of the three inventors. Moreover, the USPTO's October 21, 2004, decision explained:

*If Ilya Zborovsky desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent, signed by all the inventors, must be submitted. A courtesy copy of this decision is being mailed to petitioner.*

23. The USPTO mailed its October 21, 2004, decision letter to "MultiMetrix, LLX [sic], 1059 Di Giulio Avenue, Santa Clara, CA 95050."

24. The USPTO mailed a copy of the October 21, 2004, decision letter to Respondent as follows: "Ilya Zborovsky, 6 Schoolhouse Way, Dix Hills, New York 11746."

### Margulis's Forged Signature on Another Document Filed in USPTO

25. On or about November 16, 2004, a document entitled "Supplemental Declaration for Utility or Design Patent Application (37 C.F.R. 1.67)" was filed in the USPTO.

26. The supplemental declaration identifies Kesil, Margulis, and Gershenzon as first, second, and third inventors on the '890 application, respectively.

27. The supplemental declaration was signed by Kesil and Gershenzon and bore Margulis's purported signature. Margulis's purported signature was forged.

28. There is insufficient information to establish that Respondent filed the supplemental declaration.

### Issuance of Patent

29. On December 14, 2004, the USPTO issued U.S. Patent No. 6,831,287 ("the '287 patent") on the '890 application to Kesil, Margulis, and Gershenzon.

30. The USPTO was unaware of the forged documents that had been filed during the prosecution of the '890 application when it issued the '287 patent.

### Finding of Inequitable Conduct

31. On July 22, 2008, the '287 patent was declared unenforceable due to inequitable conduct based on Margulis's forged signatures. See Applied Materials v. Multimetrix, Civil Action No. 06-07372, U.S. District Court for the Northern District of California), 2008 WL 2892453 (July 22, 2008).

### **Legal Conclusions**

32. Prior to signing and filing the documents in the '890 application, Respondent had a duty under 37 C.F.R. § 10.18 to conduct an inquiry reasonable under the circumstances concerning why only two of the three inventors had signed the combined declaration and power of attorney. He did not fulfill that duty.

33. By signing and filing papers in the '890 application without fulfilling his duty to conduct an inquiry reasonable under the circumstances, Respondent acknowledges that his conduct violated the following USPTO Disciplinary Rules:

(a) 37 C.F.R. § 10.23(b)(5) by engaging in conduct that is prejudicial to the administration of justice; and

(b) 37 C.F.R. § 10.77(b) by handling a legal matter without preparation adequate in the circumstances.

## Sanction

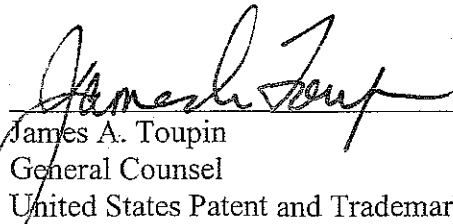
34. Respondent agreed, and it is ORDERED that:
- a. Respondent be, and hereby is, publicly reprimanded;
  - b. the OED Director publish this Final Order;
  - c. the OED Director publish the following Notice in the *Official Gazette*:

### Notice of Reprimand

Ilya Zborovsky of Dix Hills, New York, an agent whose registration number is 28,563 has been publicly reprimanded by the United States Patent and Trademark Office for violating 37 C.F.R. §§ 10.23(b)(5) by engaging in conduct prejudicial to the administration of justice and 10.77(b) by handling a legal matter without preparation adequate in the circumstances. Prior to signing and filing a petition to revive an abandoned utility application, Mr. Zborovsky did not fulfill his duty under 37 C.F.R. § 10.18 to conduct an inquiry reasonable under the circumstances concerning why only two of the three named inventors had signed the combined declaration and power of attorney accompanying the petition to revive. In fact, the third inventor was deceased. The USPTO granted the petition, revived the application, and issued a patent without knowing that two documents bearing the decedent's name and signature had been forged and filed in the Office. The patent was subsequently declared unenforceable by a U.S. district court that found inequitable conduct based on the decedent's forged signatures. One of the forged documents was filed before Mr. Zborovsky filed the petition to revive, and one was filed after. There is insufficient information to establish that Mr. Zborovsky filed the forged documents. Nevertheless, had Mr. Zborovsky conducted an inquiry reasonable under the circumstances he could have uncovered the fraud during the prosecution of the application and alerted the USPTO. This is an agreed upon resolution of misconduct charges. This action is taken pursuant to the provisions of 35 U.S.C. § 2(b)(2)(D) and 37 C.F.R. §§ 11.20(a)(3), 11.26 and 11.59. Disciplinary decisions regarding practitioners are posted at the Office of Enrollment and Discipline's Reading Room located at: <http://des.uspto.gov/Foia/OEDReadingRoom.jsp>.

- d. the OED Director, within 30 days of the date of this Final Order, prepare and file a motion to dismiss the Complaint and Notice of Proceedings Under 35 U.S.C. § 32 pending against Respondent;
- e. in accordance with 37 CFR § 11.59, the OED Director give notice of the public discipline and the reasons for the discipline to disciplinary enforcement agencies in the State where the practitioner is admitted to practice, to courts where the practitioner is known to be admitted, and the public; and
- f. the OED Director and Respondent shall each bear their own costs incurred to date and in carrying out the terms of this agreement.

August 31, 2009  
Date

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

on behalf of

David J. Kappos  
Under Secretary of Commerce for Intellectual  
Property and Director of United States Patent and  
Trademark Office