

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

In the Matter of)

JOEL N. BOCK,)

Respondent)

Proceeding No. D2007-04

Final Order

After being fully advised, Office of Enrollment and Discipline Director Harry I. Moatz ("OED Director") for the United States Patent and Trademark Office ("USPTO" or "Office") and Joel N. Bock ("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 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 pending disciplinary complaint filed against Respondent before September 15, 2008.¹ The Proposed Settlement Agreement, which satisfies the requirements of 37 C.F.R. § 10.133(g), resolves all disciplinary action by USPTO arising from the stipulated facts set forth below and the allegations set forth in the Complaint.

Jurisdiction

1. 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. §§ 10.133(g) and 10.159.

Stipulated Facts

2. It is the USPTO's position that: An *ex parte* proceeding in the USPTO is not the appropriate forum for the possible extinction of a property right in an application. See Baker Hughes, Inc. v. Kirk, 921 F.Supp. 801 (D.D.C. 1995). Rather, it is well settled that a USPTO patent application proceeding is not the appropriate forum for resolving a dispute concerning ownership of the application, and, as such, the Office will not permit itself to become embroiled in ownership disputes. See Ex Parte Harrison, 1925 Dec. Comm'r Pat. 122, 123 (Comm'r Pat. 1902); In re Moller, 1904 Dec. Comm'r Pat. 70, 71 (Comm'r Pat. 1904); Ex Parte McTammany, 1900 Dec. Comm'r Pat. 168, 171 (Comm'r Pat. 1900); Ex Parte McFarlane, 1896 Dec. Comm'r Pat. 37, 38 (Comm'r Pat. 1896); Ex Parte Gallatin, 1892 Dec. Comm'r Pat. 106, 107-108 (Comm'r Pat. 1892).

¹ Because the Complaint was filed prior to September 15, 2008, Part 10 of title 37 of the Code of Federal Regulations governs this proceeding.

3. It is the USPTO's position that: A third party has no right to intervene in the prosecution of another's patent application. After an application is published, a third party is permitted to submit only patents and publications within two months of the date of publication of the application or prior to the mailing of a notice of allowance, whichever is earlier, and the third party must serve such filing on the attorney of record. See 37 C.F.R. § 1.99. The rules of patent practice do not permit a third party to petition the Office to withdraw an application from issue.

4. The USPTO considers the filing of a petition or other paper on behalf of a party having no standing in an application, and not otherwise authorized by the patent rules of practice, to be a petition or paper presented for an improper purpose. See 37 C.F.R. § 10.18. For example, it is the USPTO's position that the filing of a paper on behalf of a third party to extinguish the applicant's rights in the application, or to intervene in the application, delays the examination and processing of the application, which may cause harm to the applicant or general public.

5. It is the USPTO's position that filings by a third party in published applications other than those expressly permitted under § 1.99 may be referred to OED for appropriate disciplinary action. See "Third Party Attempts to Protest or Otherwise Oppose the Grant of a Published Application," Official Gazette (April 22, 2003) (publicly accessible at <http://www.uspto.gov/go/og/2003/week16/og200316.htm>).

6. At all times relevant hereto, Respondent of Teaneck, New Jersey, has been an attorney registered to practice before the USPTO (Registration Number 36,456) and subject to the disciplinary rules of the USPTO Code of Professional Responsibility set forth at 37 C.F.R. § 10.20 et. seq.²

7. On October 17, 2001, Hiroshi Ishikawa filed provisional U.S. Patent Application No. 60/329,574 (the "'574 patent application"), which described a process for digitizing garment patterns. On April 15, 2004, Mr. Ishikawa filed U.S. Patent Application No. 10/492,722 (the "'722 patent application"), which claimed priority to the '574 patent application, and was published on December 9, 2004.

8. In connection with the '722 patent application, Mr. Ishikawa submitted to the USPTO a "Declaration," in which he declared, under penalty of perjury, that he was the "original, first and sole . . . inventor of the subject matter" described in that application.

9. In February 2004 -- before Mr. Ishikawa filed the '722 application -- John Amico and Carmelo Sberna filed suit in the U.S. District Court for the Southern District of New York against Mr. Ishikawa and others seeking to add their names as inventors to the '574 patent application, and other patent applications filed regarding this subject matter, and to delete Mr. Ishikawa as an inventor from those applications.

² Joel N. Bock is not to be confused with registered practitioner Joel H. Bock of Chicago, Illinois.

10. In the District Court litigation, Messrs. Amico and Sberna disputed Mr. Ishikawa's assertion that he was the sole inventor of the process for digitizing garment patterns. To the contrary, they contended that they had conceived the process for digitizing garment patterns described in the '574 and '722 patent applications, had hired Mr. Ishikawa to create the source code required to implement that invention, and had directed Mr. Ishikawa's efforts in this regard.

11. Respondent represents that, between February 2004 and July 2005, the parties engaged in extensive and costly motions practice in connection with that litigation. The defendants did not file an answer in that litigation until October 2005.

12. Respondent represents that, in or about July 2005, Messrs. Amico and Sberna decided to retain a new attorney because, although they had spent a considerable sum pursuing their dispute with Mr. Ishikawa, the litigation appeared never-ending.

13. In July 2005, Messrs. Amico and Sberna retained Respondent to represent them in connection with their dispute against Mr. Ishikawa and others. Respondent represents that Messrs. Amico and Sberna advised Respondent that, having spent a significant amount of money pursuing the lawsuit, they were seeking a cost-effective, expeditious resolution that protected their rights.

14. Respondent represents that he reviewed the file to determine the best course of action for Messrs. Amico and Sberna and developed doubts about the prospects of the federal court litigation, because several courts had found that 35 U.S.C. § 116, upon which the lawsuit relied, did not permit federal courts to correct the inventorship in an application. See, e.g., E.I. Du Pont de Nemours & Co. v. Okuley, 344 F.3d 578, 583-84 (6th Cir. 2003).

15. Respondent, therefore, sought to determine what avenues before the USPTO were available to correct the inventorship set forth in the '722 patent application. He was aware that inventorship disputes could be resolved by a declaration of patent interference. However, Respondent decided that such a course of action was not in his clients' best interests because interference proceedings could be very costly, and Messrs. Amico and Sberna wanted to avoid the expense of two simultaneously contested proceedings. Moreover, Respondent believed an interference proceeding would not have given his clients the benefit of the earlier filing date in the '722 application.

16. Respondent's research led him to believe that 35 U.S.C. § 116 allowed the Director to permit amendment of a patent application to add the true inventors. This statute appeared to him to apply to his clients' situation, as his clients had not been named in the '722 patent application, and that "error" had arisen "without any deceptive intention" on their part.

17. Respondent also examined 37 U.S.C. § 1.48(a) and concluded that the conditions described in this section had been met. Respondent concluded that no provision of 37

C.F.R. § 1.48(a) required that Mr. Ishikawa consent to or participate in the filing of a petition to amend.

18. Respondent represents that he sought the opinion of other attorneys in his law firm regarding his interpretation of 35 U.S.C. § 116 and 37 C.F.R. § 1.48(a). Respondent represents that no attorney advised that Respondent's proposed course of action was improper.

19. Believing that his interpretation of § 116 and § 1.48 was reasonable, on August 4, 2005, Respondent filed an "Amendment to Correct Inventorship Under 37 C.F.R. § 1.48" in the '722 patent application. He also filed statements signed by Messrs. Sberna and Amico in which they attested that they were the inventors of the invention covered by the '722 application and had directed the efforts of Mr. Ishikawa as to the invention. And he filed a "Declaration and Power of Attorney" signed by Messrs. Amico and Sberna in which they stated that they were "original, first and joint inventor[s]" of the invention at issue and appointed his law firm to prosecute the application on their behalf. Respondent was not purporting to act on behalf of Mr. Ishikawa, who did not sign the Declaration and Power of Attorney that Respondent submitted. Respondent represents that he knew that a Declaration of Inventorship signed by Mr. Ishikawa claiming that he was the sole inventor already was on file.

20. The August 4, 2005 Petition that Respondent filed sought only to add Messrs. Amico and Sberna to the '722 patent application. It did not seek to delete Mr. Ishikawa as an inventor. Respondent did not believe that 37 C.F.R. § 1.48(a) permitted him to do so, absent Mr. Ishikawa's consent. However, Respondent believed that the regulation permitted the addition of omitted inventors in the manner that he pursued.

21. The Declaration and Power of Attorney filed by Respondent in the '722 application did not include Mr. Ishikawa as an inventor. It directed the USPTO to send correspondence and direct telephone calls to Respondent.

22. Respondent did not provide Mr. Ishikawa or Mr. Ishikawa's attorney with a copy of the August 4, 2005, filings contemporaneously with submitting them to the USPTO. Respondent represents that he believed (1) that no statute or regulation required that he do so and (2) that his filing would be posted on the USPTO PAIR websites and thus would be accessible to Mr. Ishikawa and his attorneys.

23. The Manual of Patent Examining Procedure (MPEP) is published to provide USPTO patent examiners, applicants, attorneys, agents, and representatives of applicants with a reference work on the practices and procedures relative to the prosecution of patent applications before the USPTO. It contains instructions to examiners, as well as other material in the nature of information and interpretation, and outlines the current procedures which the examiners are required or authorized to follow in appropriate cases in the normal examination of a patent application. The MPEP does not have the force of law or the force of the rules in Title 37 of the Code of Federal Regulations. MPEP § 402.10 (August 2001) explains that papers giving or revoking a power of attorney will

not be accepted by the Office when signed by less than all the applicants or owners of the application unless they are accompanied by a petition giving good and sufficient reasons as to why such papers should be accepted. The papers filed by Respondent did not include any statement from Ishikawa. Nor were they accompanied by a petition that sought to give good and sufficient reasons for waiving the signature requirement. Respondent admits that he proceeded in a "somewhat different manner" than specified in the MPEP.

24. It is the USPTO's position that: Respondent's conclusion that he was entitled to file papers in the '722 application was incorrect. 35 U.S.C. § 116 does not state or imply that a third party is authorized to file a change in inventorship in another person's application. Moreover, because Mr. Ishikawa did not agree that Messrs. Amico and Sberna were inventors, the means of correcting inventorship set forth in 37 C.F.R. § 1.48 were not available to Respondent and his clients. The August 4, 2005, filings were not authorized by § 116 or § 1.48.

25. On June 24, 2005, the USPTO issued a notice of allowance on the '722 application, and, on July 27, 2005, the USPTO issued a corrected notice of allowance.

26. Respondent represents that: He and his clients were aware of the notice of allowance in the '722 application. He and his clients believed they were in possession of certain material prior art that had been disclosed in U.S. Patent Application No. 10/825,216, but that had not been disclosed in the '722 application. He and his clients were concerned that, if the patent issued in the '722 patent application before they had disclosed this prior art to the USPTO, the patent possibly could be rendered unenforceable on "inequitable conduct" grounds.

27. On November 2, 2005, Respondent filed with the USPTO in the '722 application a "Petition for Withdrawal From Issue — Issue Fee Paid (37 C.F.R §§ 1.313(a) and (c)(2))," along with a Request for Continued Examination and an Information Disclosure Statement.

28. Respondent represents that: Before submitting the November 2, 2005 filings, he spoke with several attorneys in his law firm about that filing. Those attorneys did not disagree with Respondent's conclusion that, having sought to add his clients as inventors to the '722 patent application, they now likely had an obligation to submit prior art of which they were aware that was not yet part of the '722 patent application file. Moreover, Respondent discussed with one or more lawyers in his firm his concern that, if the patent issued before his clients had the opportunity to submit the prior art, his clients might not later be able to avoid a charge of "inequitable conduct" by submitting the prior art in a reissue or reexamination of the '722 patent application.

29. Respondent did not provide Ishikawa or his attorneys with copies of the November 2, 2005, filings contemporaneously with submitting them to the USPTO. Respondent represents that he believed (1) that no statute or regulation required that he

do so and (2) that his filing would be posted on the USPTO PAIR websites and would be accessible to Mr. Ishikawa and his attorneys.

30. It is the USPTO's position that: Respondent's clients were not applicants on the '722 application; they were third parties in relation to that application. The November 2, 2005, filings were not authorized by 35 U.S.C. § 116 or the patent rules.

31. On December 15, 2005, the USPTO issued a decision on Respondent's filings, and, on December 20, 2005, issued a substitute decision as to those filings. The substitute decision dismissed the November 2, 2005, petition and found that the August 4, 2005 Petition to Correct Inventorship was "facially not grantable" because it lacked an appropriate "Oath or Declaration" from Mr. Ishikawa. The examiner quoted section 201.03 of the Manual of Patent Examining Procedure, which provides in part that "An oath or declaration under 37 CFR 1.63 by each actual inventor must be presented." The December 20, 2005, substitute decision also explained that Respondent "will not be permitted to unilaterally, and in an *ex parte* matter, diminish Ishikawa's property rights".

32. On April 18, 2006, the USPTO issued Patent No. 7,031,527 ("527 patent") on the '722 application.

33. The '527 patent, however, identified Respondent's clients as inventors. On January 28, 2009, an attorney representing Mr. Ishikawa filed a petition in the USPTO to correct the inventorship identified in the '527 patent by removing Respondent's clients' names therefrom.

34. Respondent represents that: He did not act with deceptive or dishonest intent by filing the August 4, 2005 "Amendment to Correct Inventorship Under 37 C.F.R. § 1.48" or the November 2, 2005, "Petition for Withdrawal From Issue." Respondent believed that he was acting in furtherance of his clients' best interests and consistent with applicable regulatory and ethical authority that required Respondent zealously to represent his clients within the bounds of the law and to construe all doubts regarding the bounds of the law in their favor. He also believed, after research and consultation, that his actions, while novel, were authorized by the controlling regulations. Although his filings were posted on the USPTO PAIR websites and thus were accessible to Mr. Ishikawa and his attorneys, Respondent now is of the opinion that the better practice would have been to serve Mr. Ishikawa or his attorneys with the filings when he submitted those filings to the USPTO. Respondent is aware that it is the USPTO's position that his filings, even if served, were not authorized by the patent statute or USPTO rules.

Mitigating Factors

35. Respondent, who has been registered as a patent agent beginning in 1993 and as a patent attorney since 1994, represents that he has been actively involved in the practice of patent law for over 15 years and has no prior history of discipline.

Joint Legal Conclusion

36. Based on the information contained in paragraphs 2 through 34, above, Respondent acknowledges that he handled a legal matter without preparation adequate in the circumstances in violation of 37 C.F.R. § 10.77(b).

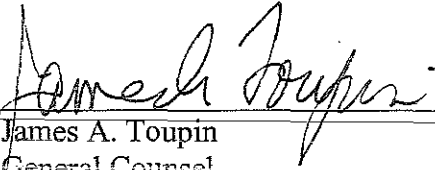
Agreed Upon Sanction

37. 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 attached Notice of Reprimand in the *Official Gazette*;
- d. in accordance with 37 C.F.R. § 11.59, directs the OED Director give notice of the public discipline and the reasons for the discipline to disciplinary enforcement agencies in the States where the practitioner is admitted to practice, to courts where the practitioner is known to be admitted, and the public;
- e. the OED Director within 14 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.
- f. Directs that the OED Director and Respondent bear their own costs incurred to date and in carrying out the terms of this agreement.

OCT 15 2009

Date


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

on behalf of

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

Notice of Reprimand

Joel N. Bock of Teaneck, New Jersey,¹ registered patent attorney (Registration Number 36,456). Mr. Bock has been publicly reprimanded by the United States Patent and Trademark Office ("USPTO" or "Office") for violating 37 C.F.R. § 10.77(b) by handling a legal matter without preparation adequate in the circumstances.

Contrary to USPTO patent rules, Mr. Bock twice signed and filed documents in an application not belonging to his clients and did not provide the applicant with a copy of the filings contemporaneously with submitting them to the USPTO. Mr. Bock's clients were involved in district court litigation with the applicant of a patent application wherein the clients sought to be declared the sole inventors of the invention disclosed in the application. Mr. Bock's clients were not named inventors or applicants with regard to the application; they thus were third parties. While the district court litigation was pending, and after a notice of allowance had been issued by the Office, Mr. Bock signed and filed papers in the applicant's patent application requesting that the Office amend the inventorship to add his clients as co-inventors to the application. Mr. Bock did not submit documents showing that the applicant consented to the change and, as evidenced by the district court case, Mr. Bock knew that the applicant would not agree to the change. Mr. Bock mistakenly believed that 37 C.F.R. § 1.48 permitted his *ex parte* filing. Later, Mr. Bock filed a petition to withdraw the application from issue along with a request for continued examination and an information disclosure statement in order to submit prior art of which his clients were aware. Mr. Bock mistakenly believed that these *ex parte* filings were authorized by 37 C.F.R §§ 1.313(a) and (c)(2). Mr. Bock did not provide the applicant with a copy of the filings contemporaneously with submitting them to the USPTO. Prior to submitting the filings, Respondent solicited advice from members of his law firm and believed that he was acting in furtherance of his clients' best interests and consistent with applicable regulatory authority. In short, Respondent mistakenly believed that the actions he took, while novel, were authorized by existing patent regulations.

It is well settled that the USPTO is not the appropriate forum for resolving a dispute concerning ownership of an application, and, as such, the Office will not permit itself to become embroiled in ownership disputes. See Ex Parte Harrison, 1925 Dec. Comm'r Pat. 122, 123 (Comm'r Pat. 1902); In re Moller, 1904 Dec. Comm'r Pat. 70, 71 (Comm'r Pat. 1904); Ex Parte McTammany, 1900 Dec. Comm'r Pat. 168, 171 (Comm'r Pat. 1900); Ex Parte McFarlane, 1896 Dec. Comm'r Pat. 37, 38 (Comm'r Pat. 1896); Ex Parte Gallatin, 1892 Dec. Comm'r Pat. 106, 107-108 (Comm'r Pat. 1892).

A third party has no right to intervene in the prosecution of another's patent application. After an application is published, a third party is permitted to submit only patents and publications within two months of the date of publication of the application or prior to the mailing of a notice of allowance, whichever is earlier, and the third party must serve such filing on the attorney of record. See 37 C.F.R. § 1.99; 35 U.S.C. § 122(c). The rules of

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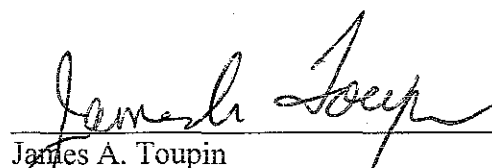
patent practice do not permit a third party to petition the Office to withdraw an application from issue.

The USPTO considers the filing of a petition or other paper on behalf of a party having no standing in an application, and not otherwise authorized by the patent rules of practice, to be a petition or paper presented for an improper purpose. See 37 C.F.R. § 10.18. For example, the filing of a paper on behalf of a third party to extinguish the applicant's rights in the application or the invention claimed in the application or to protect the third party from potential accusations of inequitable conduct delays the examination and processing of the application, which may cause harm to the applicant or general public. Filings by a third party in published applications other than those expressly permitted under § 1.99 may be referred to OED for appropriate disciplinary action. See "Third Party Attempts to Protest or Otherwise Oppose the Grant of a Published Application," Official Gazette (April 22, 2003) (publicly available at <http://www.uspto.gov/go/og/2003/week16/og200316.htm>).

This action is the result of a settlement agreement resolving a disciplinary proceeding filed before September 15, 2008, between Mr. Bock and the OED Director pursuant to the provisions of 35 U.S.C. §§ 2(b)(2)(D) and 32, and 37 C.F.R. §§ 10.133(g) and 10.159. USPTO regulations governing disciplinary proceedings commenced after September 15, 2008, are found at 37 C.F.R. § 11.19 et seq. Disciplinary decisions involving practitioners are posted at the Office of Enrollment and Discipline's Reading Room located at: <http://des.uspto.gov/Foia/OEDReadingRoom.jsp>.

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