

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

In the Matter of )  
 )  
John M. Caracappa, ) Proceeding No. D2014-02  
 )  
Respondent )  
\_\_\_\_\_ )

**FINAL ORDER**

The Director of the Office of Enrollment and Discipline (“OED Director”) for the United States Patent and Trademark Office (“USPTO” or “Office”) and John M. Caracappa (“Respondent”) have submitted a Proposed Settlement Agreement (“Agreement”) to the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (“USPTO Director”) for approval.

The Agreement, which resolves all disciplinary action by the USPTO arising from the stipulated facts set forth below, is hereby approved. This Final Order sets forth the parties’ stipulated facts, legal conclusion, and sanctions.

**Jurisdiction**

1. At all times relevant hereto, Respondent of Washington, D.C., has been a registered patent attorney (Registration Number 43,532) and subject to the USPTO Code of Professional Responsibility set forth at 37 C.F.R. § 10.20 *et seq.*<sup>1</sup>
2. The USPTO Director has jurisdiction over this matter pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 C.F.R. §§ 11.19 and 11.26.

**Stipulated Facts**

**Background**

3. The USPTO registered Respondent as a patent agent on February 16, 1999 and as a patent attorney on September 8, 2006 (Registration Number 43,532).

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<sup>1</sup> The events at issue in this matter occurred prior to May 3, 2013. Therefore, the USPTO Code of Professional Responsibility is applicable. *See* 37 C.F.R. § 10.20 *et seq.* Effective May 3, 2013, the USPTO Rules of Professional Conduct apply to persons who practice before the Office. *See* 37 C.F.R. §§ 11.101 through 11.901.

4. Respondent is counsel of record for Nissan North America, Inc. (“Nissan”) in two *inter partes* review (“IPR”) proceedings, *Nissan North America, Inc., et al. v. Carl B. Collins, et al.*, Case No. IPR2012-00035, regarding U.S. Patent No. 5,411,797; and *Nissan North America, Inc., et al. v. Carl B. Collins, et al.*, Case No. IPR2012-00037, regarding U.S. Patent No. 5,478,650 (referred to collectively as “the Nissan IPR proceedings”).

5. On September 26, 2012, Respondent filed two petitions for *inter partes* review in the Nissan IPR proceedings.

6. On November 1, 2012, Patent Owner’s counsel sent an email to [Trials@uspto.gov](mailto:Trials@uspto.gov) without copying counsel for the petitioner. The petitioner first learned of the email when a clerk from the PTAB forwarded the email to all parties and arranged a conference call with the Board. Both parties were heard during the conference call and following the call, Judge Lane issued an order.

7. On January 2, 2013, counsel for the patent owners filed a preliminary response to each IPR petition (“Response”).

8. On January 8, 2013, counsel for Petitioner contacted the Board asking for guidance on how best to bring a mathematical error in the Response to the Board’s attention.

9. On January 9, Petitioner’s counsel received a voicemail acknowledging the request and explaining that Petitioner should “request a conference call with the judge” and that “the judge would decide if the conference call was necessary or if it was going to happen” and the judge “would decide everything after he heard both sides.”

10. The voicemail did not explain how to request a conference call with the judge. Petitioner’s counsel subsequently contacted the PTAB that day seeking further guidance as to whom the request should be addressed and what it should include.

11. On January 15, 2013, Respondent’s co-counsel sent an email to the Patent Trial and Appeal Board (“PTAB” or “Board”) at [Trials@uspto.gov](mailto:Trials@uspto.gov), in which she stated that she was back-up counsel for Nissan in the IPR proceedings (the “January 15 email”). The email was addressed to “Judge Lane” [PTAB Judge Sally Gardner Lane]. Respondent was copied on this email. Patent Owner’s counsel was not copied on the email. The email explained in three detailed paragraphs the mathematical error in the Response filed by the patent owners, why Respondent contended the error was important, and requested assistance regarding the proper procedure for obtaining judicial notice of the mathematical error.

12. Respondent authorized and had full knowledge of the January 15 email and its contents.

13. Respondent was advised that his co-counsel was not sending a copy of the January 15 email to opposing counsel.

14. After receipt of the January 15 email, the PTAB issued an “Order regarding Conduct of Proceedings under 37 C.F.R. § 42.5” (“Order”), dated January 22, 2013. The Order held that the January 15 email to the PTAB was an improper *ex parte* communication and an improper attempt to file a reply by counsel for Nissan.

15. Patent Owner was permitted to file a five page reply. In that reply, Patent Owner acknowledged that its Response contained a mathematical error. Patent Owner deleted the statement and arguments from its Response based on this mathematical error.

16. Respondent filed a Request for Rehearing with a supporting memorandum and several declarations.

17. In response, the PTAB issued a Decision on Request for Rehearing under 37 C.F.R. § 42.71 on January 29, 2013. That decision affirmed the PTAB’s holding in its earlier Order that the January 15 email was an improper *ex parte* communication with the PTAB and also stated that the “[b]oard appreciates and accepts Nissan’s statement that it did not intend to have an improper *ex parte* communication with the Judge.”

18. Respondent represents that in their Response, the Patent Owners stated that 0.5 microns is equal to 500 Angstroms and that 0.2 microns is equal to 200 Angstroms. This is not correct and it is a mathematical error. Instead, .2 microns is equal to 2000 Angstroms and .5 microns is equal to 5000 Angstroms.

19. Respondent further represents that the substance of the January 9, 2013 call with PTAB staff was memorialized in an email from a member of Petitioners’ counsel team that same day. The email stated that counsel was told that “[w]hat we need to do is to send an email to trials@uspto.gov, explaining our need for a conference call. We can copy opposing counsel on the email if we want but there is no requirement to do so. From there, the judge will decide if a call is necessary, and if so, send out proposed dates and times for the call.” The email further stated that “there is no documentation for this type of procedure” and that “they are figuring it out as they go.”

### **Joint Legal Conclusion**

20. Respondent acknowledges that, based on the above stipulated facts, he violated 37 C.F.R. § 10.93(b) by communicating in writing with a judge before whom a proceeding is pending in an adversary proceeding on the merits of the case without providing a copy of the writing to opposing counsel.

### **Agreed Upon Sanction**

21. Respondent agrees and it is hereby ORDERED that:
- a. Respondent is hereby publicly reprimanded;

- b. The OED Director shall comply with 37 C.F.R. § 11.59;
- c. The OED Director shall publish the Final Order at the OED's electronic FOIA Reading Room, which is publicly accessible through the Office's website at: <http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>;
- d. The OED Director shall publish the following notice in the *Official Gazette*:

#### **Notice of Reprimand**

This notice regards John M. Caracappa of Washington, D.C., a registered patent attorney (Registration Number 43,532). The United States Patent and Trademark Office ("USPTO" or "Office") has reprimanded Mr. Caracappa for violating 37 C.F.R. § 10.93(b).

Mr. Caracappa authorized and approved of the acts of his co-counsel, an associate attorney whom he supervised, in sending an email to the Patent Trademark and Appeal Board which contained statements explaining a mathematical error contained in Patent Owner's preliminary response in a case pending before the Board, without sending a copy of the email to opposing counsel. The Board subsequently issued an Order finding the email to be an improper *ex parte* communication, and noting that the "Board appreciates and accepts Nissan's statement that it did not intend to have an improper *ex parte* communication with the Judge." This conduct violated 37 C.F.R. § 42.5(d) and the provisions of The Office Patent Trial Practice Guide, 77 Federal Register 48756, 48758 (August 14, 2012). *Ex parte* contact with the Board is prohibited except under extremely limited circumstances as specifically set forth in the Board's rules.

This action is the result of a settlement agreement between Mr. Caracappa and the OED Director pursuant to the provisions of 35 U.S.C. § 2(b)(2)(D) and 37 C.F.R. §§ 11.20, 11.26, and 11.59. Disciplinary decisions involving practitioners are posted at the OED's Reading Room, which is publicly accessible at:  
<http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>.

- e. Nothing in this Agreement or the Final Order shall prevent the Office from considering the record of this disciplinary proceeding, including this Final Order:
  - (1) when addressing any further complaint or evidence of the same or similar misconduct concerning Respondent brought to the attention of the Office; and/or

(2) in any future disciplinary proceeding against Respondent (i) as an aggravating factor to be taken into consideration in determining any discipline to be imposed and/or (ii) to rebut any statement or representation made by or on Respondent's behalf; 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 and any Final Order approving this Agreement.

  
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JAMES O. PAYNE  
Deputy General Counsel for General Law  
United States Patent and Trademark Office

JAN 10 2014

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Date

on behalf of  
Margaret A. Focarino  
Commissioner for Patents  
performing the duties and functions of the  
Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office

cc: Director of the Office of Enrollment and Discipline  
United States Patent and Trademark Office

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