

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

In the Matter of)	
)	
Kenneth A. Roddy,)	Proceeding No. D2017-31
)	
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 Mr. Kenneth A. Roddy (“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 conclusions, and agreed upon sanction found in the Agreement.

Jurisdiction

1. At all times relevant hereto, Respondent of Houston, Texas, has been a patent agent registered to practice before the Office in patent matters (Registration No. 31,294) and is subject to the USPTO Rules of Professional Conduct, 37 C.F.R. §§ 11.101 through 11.901.
2. 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. §§ 11.19, 11.20, and 11.26.

Joint Stipulated Facts

3. Respondent became registered as a patent agent on June 22, 1984.
4. Respondent’s registration number is 31,294.
5. Respondent was retained by a client to prepare and prosecute two patent applications.
6. Respondent received an Office Action in the first application dated September 9, 2015, and failed to report the Office Action to the client.
7. Respondent also failed to respond to the Office Action prior to the due date, resulting in the first application being abandoned, without the client’s knowledge or consent, for failure to timely respond to the Office Action.

8. A Notice of Abandonment dated April 6, 2016, was mailed to Respondent in the first application, and Respondent failed to report the Notice of Abandonment to the client. Respondent stated that he did not receive the April 6, 2016 Notice of Abandonment and that it was not forwarded to his new office address. However, Respondent did not explain why he did not take steps to follow up with the first application to check the status thereof.

9. Respondent did not take any action to revive the abandoned first application.

10. Respondent received an Office Action in the second application dated July 28, 2015, and failed to report the Office Action to the client.

11. Respondent also failed to respond to the Office Action prior to the due date, resulting in the first application being abandoned, without the client's knowledge or consent, for failure to timely respond to the Office Action.

12. Respondent received a Notice of Abandonment dated February 9, 2016, in the second application and Respondent failed to report the Notice of Abandonment to the client.

13. Respondent did not take any action to revive the abandoned second application.

14. Respondent failed to adequately communicate with his client regarding the patent applications and Office communications received therein, and failed to respond to requests from the client about the applications.

Joint Legal Conclusions

15. Respondent admits that, based on the above stipulated facts, he violated 37 C.F.R. § 11.104(a)(2)-(4) (failing to reasonably consult with the client about the means by which the client's objectives are to be accomplished, failing to keep the client reasonably informed about the status of a matter, and failing to promptly comply with reasonable requests for information from the client) by failing to inform the client about the Office Actions in the applications, failing to communicate with the client regarding responding to the Office Actions, failing to notify the client about the Notices of Abandonment in the applications, failing to consult with the client about taking steps to revive the abandoned applications, and failing to respond to requests from the client about the applications.

16. Respondent admits that, based on the above stipulated facts, he violated 37 C.F.R. § 11.103 (failing to act with reasonable diligence and promptness in representing a client) by failing to notify the client of the Office Actions, failing to communicate with the client regarding responding to the Office Actions, allowing the applications to become abandoned without communicating with the client about responding to the Office Actions, failing to notify the client of the Notices of Abandonment in the applications, and failing to consult with the client about taking steps to revive the abandoned applications.

17. Respondent admits that, based on the above stipulated facts, he violated 37 C.F.R. § 11.804(d) (engaging in conduct that is prejudicial to the administration of justice) by failing to respond to the Office Actions, allowing the applications to become abandoned without the client's consent, and failing to take steps to revive the abandoned applications.

Additional Considerations

18. Respondent has accepted responsibility for his misconduct. Respondent recognizes the seriousness of his misconduct and has expressed remorse for it and for its detrimental effect on his former client as well as on the reputation of the legal profession.

19. Respondent has adopted measures intended to prevent the recurrence of these violations, including a policy of giving his cell phone number to clients for whom he is working on patent applications so that he is more readily accessible to them during prosecutions of their applications.

20. Respondent has obtained a new email program and email service provider that stores all incoming and outgoing email messages on a backup server and also includes a calendar and tickler reminders.

21. Respondent has incorporated a new docketing and tracking system and has set up a backup docketing procedure on his cell phone with notifications.

22. Respondent cooperated with OED during OED's investigation into his conduct.

Agreed Upon Sanction

23. Respondent agrees, and it is hereby ORDERED that:

- a. Respondent shall be, and hereby is, publicly reprimanded;
- b. Respondent shall serve a twenty-four (24) month probationary period commencing on the date on which this Final Order is signed;
- c. Respondent shall be permitted to practice before the USPTO in patent matters before the USPTO during his probationary period, unless his probation is revoked and he is suspended by order of the USPTO Director or otherwise no longer has the authority to practice before the USPTO;
- d. Respondent, during his probationary period, shall submit a report to the OED Director every 12 months (*i.e.*, 12 months and 24 months) commencing from the date this Final Order is signed and shall report the following:
 - (1) Identify by application number each U.S. utility patent application entrusted to Respondent to prosecute in which, during the probationary period, the Office issued a Notice of Abandonment predicated on the failure to file a timely and/or proper response to any Office communication, including, but not limited to a non-final Office Action, a final Office Action, an Office Advisory, and a Notice of Allowance;
 - (2) State whether, how and when Respondent reported the Office communication to the client prior to the application becoming abandoned;

- (3) Provide documentary evidence that Respondent reported the Office communication to the client prior to the application becoming abandoned (*e.g.*, copies of the correspondence to the client about the Office communication);
 - (4) State whether, how and when Respondent reported the Notice of Abandonment to the client;
 - (5) State whether, how and when Respondent counseled the client about the abandonment of the application, including whether he counseled the client in adequate time to take appropriate action to avoid abandonment;
 - (6) Provide documentary evidence that Respondent reported the Notice of Abandonment to the client and counseled the client about it (*e.g.*, copies of the correspondence to the client about the Notice of Abandonment);
 - (7) For each application where Respondent did not counsel the client about an Office communication in adequate time to take appropriate action to avoid abandonment, identify each application by application number and each client by full name and address and provide a detailed explanation as to why Respondent did not counsel the client about the Office communication in adequate time to take appropriate action to avoid abandonment; and
 - (8) If no applications are reported under paragraph numbers (1)-(7) above in any reporting period, Respondent shall affirmatively report to OED that there are no such applications to report in that period.
- e. (1) If the OED Director is of the opinion that Respondent, during the probationary period, failed to comply with any provision of the Agreement, this Final Order, or any provision of the USPTO Rules of Professional Conduct, the OED Director shall:
- (A) issue to Respondent an Order to Show Cause why the USPTO Director should not enter an order immediately suspending the Respondent for up to twelve (12) months for the violations set forth in the Joint Legal Conclusions, above;
 - (B) send the Order to Show Cause to Respondent at the last address of record Respondent furnished to the OED Director pursuant to 37 C.F.R. § 11.11(a); and
 - (C) grant Respondent fifteen (15) days to respond to the Order to Show Cause;

and

(2) In the event that after the 15-day period for response and consideration of the response, if any, received from Respondent, the OED Director continues to be of the opinion that Respondent, during the probationary period, failed to comply with any provision of the Agreement, Final Order, or any provision of the USPTO Rules of Professional Conduct, the OED Director shall:

(A) deliver to the USPTO Director or his designee: (i) the Order to Show Cause; (ii) Respondent's response to the Order to Show Cause, if any; and (iii) argument and evidence supporting the OED Director's position; and

(B) request that the USPTO Director enter an order suspending Respondent from practice before the USPTO for up to twelve (12) months for the violations set forth in the Joint Legal Conclusions, above;

- f. Nothing herein shall prevent the OED Director from seeking discipline for any misconduct that formed the basis for an Order to Show Cause issued pursuant to the preceding paragraph "e" above;
- g. In the event the Respondent seeks a review of any action taken pursuant to paragraph "e" above, such review shall not operate to postpone or other hold in abeyance such action;
- h. If Respondent is suspended during any portion his twenty-four (24) month probationary period pursuant to the terms of the Final Order, Respondent shall comply with 37 C.F.R. § 11.58;
- i. If Respondent is suspended during any portion his twenty-four (24) month probationary period pursuant to the terms of the Final Order, the OED Director shall comply with 37 C.F.R. § 11.59;
- j. Nothing in the Agreement or this Final Order shall prevent the Office from seeking discipline against Respondent pursuant to 37 C.F.R. §§ 11.19 through 11.57 for any misconduct engaged in by Respondent prior to, during, or after his probationary period including that which led to the imposition of a suspension pursuant to paragraph "e" above;
- k. The record of this disciplinary proceeding, including this Final Order, shall be considered (1) when addressing any further complaint or evidence of the same or similar conduct brought to the attention of the Office, and/or (2) in any further disciplinary proceeding (a) as an aggravating factor to be taken into consideration in determining any discipline to be imposed and/or (b) to rebut any statement or representation by or on Respondent's behalf;
- l. The OED Director shall electronically publish the Final Order at OED's electronic FOIA Reading Room, which is publicly accessible at: <http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>;

- m. The OED Director publish a notice in the *Official Gazette* that is materially consistent with the following:

Notice of Public Reprimand and Probation

This notice concerns Mr. Kenneth A. Roddy of Houston, Texas, who is a registered practitioner (Registration No. 31,294). In settlement of a disciplinary proceeding, Joseph D. Matal, Performing the Functions and Duties of the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (“USPTO” or “Office”) has publicly reprimanded Mr. Roddy and placed him on probation for twenty-four (24) months from the date of the Final Order for violating 37 C.F.R. §§ 11.104(a)(2)-(4) (failing to reasonably consult with the client about the means by which the client’s objectives are to be accomplished, failing to keep the client reasonably informed about the status of a matter, and failing to promptly comply with reasonable requests for information from the client); 11.103 (failing to act with reasonable diligence and promptness in representing a client); and 11.804(d) (engaging in conduct that is prejudicial to the administration of justice).

The public reprimand and probation is predicated upon Mr. Roddy’s violations of provisions of the USPTO Rules of Professional Conduct in connection with his providing patent services for a client. Mr. Roddy was representing a client in the preparation and prosecution of two patent applications. Mr. Roddy failed to notify the client about an Office Action in each of the two patent applications; failed to advise the client regarding responding to the Office Actions; failed to respond to the Office Actions; allowed the two patent applications to become abandoned, without the client’s knowledge or consent, for failure to timely respond to the Office Actions; failed to notify the client of the abandonments of the applications; failed to report the Notice of Abandonment to the client in each of the two applications; failed to advise the client about taking action to revive the abandoned applications; and failed to take any action to revive the abandoned applications. Mr. Roddy also failed to adequately communicate with his client regarding the patent applications and the Office communications, and failed to respond to requests from the client regarding the applications.

In reaching this settlement, the OED Director considered the following: (i) Mr. Roddy has expressed remorse; (ii) Mr. Roddy has adopted measures intended to prevent the recurrence of these violations, including a policy of giving his cell phone number to clients for whom he is working on patent applications so that he is more readily accessible to them during prosecutions of their applications; (iii) Mr. Roddy has obtained a new email program and email service provider that stores all incoming and outgoing email messages on a backup server and also includes a calendar and tickler reminders; (iv) Mr. Roddy has incorporated a new docketing

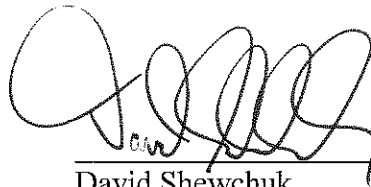
and tracking system and has set up a backup docketing procedure on his cell phone with notifications; and (v) Mr. Roddy has cooperated with the Office of Enrollment and Discipline during the investigation of this matter.

This action is the result of a settlement agreement between Respondent and the OED Director pursuant to the provisions of 35 U.S.C. §§2(b)(2)(D) and 32 and 37 C.F.R. §§11.19, 11.20, and 11.26. Disciplinary decisions involving practitioners are posted for public reading at the OED Reading Room, available at: <http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>.

- n. Nothing in the Agreement or this Final Order shall prevent the Office from considering the record of this disciplinary proceeding, including the 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; (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 by or on Respondent's behalf; and (3) in connection with any request for reconsideration submitted by Respondent pursuant to 37 C.F.R. § 11.60;
- o. Respondent waives all rights to seek reconsideration of the Final Order under 37 C.F.R. § 11.56, waives the right to have the Final Order reviewed under 37 C.F.R. § 11.57, and waives the right otherwise to appeal or challenge the Final Order in any manner; and
- p. Each party shall bear their own costs incurred to date and in carrying out the terms of the Agreement and this Final Order.

9/27/17

Date



David Shewchuk
Deputy General Counsel for General Law
United States Patent and Trademark Office

On behalf of

Joseph D. Matal
Performing the Functions and Duties of the Under
Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

cc: OED Director, USPTO

Mr. Kenneth A. Roddy
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