

Texas Intellectual Property Law Journal
Spring 2000

Symposium: Intellectual Property Litigation in the 21st Century

**INEQUITABLE CONDUCT, FRAUD, AND YOUR LICENSE TO PRACTICE BEFORE THE UNITED STATES
PATENT AND TRADEMARK OFFICE**

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I. Introduction

This paper provides a broad overview of the legal and ethical obligations of the patent practitioner practicing law before the United States Patent and Trademark Office (PTO). Our discussion will refer to patent agents and attorneys as practitioners, because the rules of conduct discussed below apply equally to both. The purpose of this paper is to discuss the concurrent duties and obligations of practitioners to the PTO and other disciplinary bodies. The paper also reviews the procedures followed by the PTO's Office of Enrollment and Discipline (OED) to *300 investigate and prosecute allegations of unethical behavior by members of the Patent Bar.

We begin with a brief discussion of the case law on inequitable conduct as it relates to acts of the practitioner, with an emphasis on Molins PLC v. Textron, Inc.¹ Molins illustrates a practitioner's "continuing" duty of candor to the PTO, and the consequences of failing to uphold the highest standards of the profession. While an in-depth discussion of the inequitable

conduct defense is beyond the scope of this article, a brief discussion is included to point out the consequences of failing to uphold the duty of candor during the prosecution of a patent application.²

Next, we discuss the administrative procedures laid-out in the Code of Federal Regulations (C.F.R.) for disciplining attorneys, including the steps that must be taken by the PTO to bring a charge against a practitioner. Finally, we analyze the few cases that have reported disciplinary actions by the PTO against practitioners, and disturbingly, against those who defend these practitioners before the PTO.

It is initially surprising that the topic of the legal obligations of patent practitioners with regard to their license to practice before the PTO has not been the subject of numerous cases or scholarly discussion. However, after examining the administrative procedures for attorney discipline before the PTO, the lack of reported cases is not surprising. Clearly, these administrative procedures are stacked against the malfeasant practitioner. Nevertheless, a recently reported case, *Lipman v. Dickinson*,³ highlights potential risks to practitioners who represent other potential registrants before the PTO.

II. Concurrent Duties

A practitioner's duties to the PTO are best described by the concurrent duties that a practitioner has before various organizations responsible for ensuring that the highest standards are maintained in the legal profession. Without embarking on an over-expansive review of the myriad of ethical duties a practitioner owes to family, firm, clients, etc., we focus on the duties and ethical obligations of a practitioner before the profession.

All practitioners have legal obligations under the various rules of conduct that apply to the legal profession, such as the Canons of Ethics, the Model Rules of Professional Conduct, and every individual state's Rules of Professional Responsibility. Practitioners must also maintain the highest level of professionalism *301 and conduct before the U.S. court system and administrative agencies (such as the PTO), as well as in their dealings with fellow members of the Bar. These duties must always be balanced with professional obligations, including zealous advocacy on behalf of clients.

Professional duties to the PTO arise from the authority vested in the Commissioner of Patents under 35 U.S.C. § 31.⁴ The PTO regulations created under this statute are found in 37 C.F.R. Part 10, and outline the administrative hierarchy and procedures intended to carry out the mandate of the Patent Code. Finally, some guidance on different topics relating to the examination of patents, enrollment, etc., is found in the Manual for Patent Examining Procedures (M.P.E.P.).

III. Inequitable Conduct by a Practitioner

As a general matter, inequitable conduct is raised as a defense against a charge of infringement. To prove that inequitable conduct occurred during the prosecution of a patent application, the alleged infringer must present evidence that the applicant: (1) made affirmative misrepresentations of a material fact to the patent examiner ("Examiner"); (2) failed to disclose material information; or (3) submitted false material information to the PTO. In addition, the acts or omissions before the Examiner must have been coupled with an intent to deceive.⁵

When faced with a charge of inequitable conduct, a trial court must determine whether the withheld reference meets a threshold level of materiality and whether the evidence shows an intent to mislead the PTO.⁶ A reference is deemed material if there is "a 'substantial likelihood that a reasonable Examiner would consider it important in deciding whether to allow the application to issue as a patent.'" ⁷

***302** The determinations of materiality and intent are reviewed under the clearly erroneous standard.⁸ After determinations of materiality and intent are made, the court is required to compare the level of materiality to the level of intent.⁹ The more material the omission, the less evidence of intent needed to find inequitable conduct.¹⁰ After comparing the relative evidence of materiality and intent, the court must next determine whether the applicant's conduct is so culpable that the patent should be held unenforceable.¹¹ On appeal, district court findings of inequitable conduct are reviewed under an abuse of discretion standard.¹² While the United States Court of Appeals for the Federal Circuit (Federal Circuit) has held that a patentee does not need to cite an otherwise material reference to the PTO if that reference is merely cumulative or is less material than other references already before the Examiner,¹³ an abundance of caution militates for a conservative approach when making the determination to cull references.

A. Molins PLC v. Textron¹⁴

Molins serves to highlight the perils to a practitioner who does not meet the duty of candor before the PTO, and demonstrates that the ultimate enforceability of a patent depends on meeting and fulfilling the duty of candor even after a patent issues. Molins is also a reminder to cite references presented during foreign prosecution to the PTO. Finally, Molins warns all practitioners that an attorney's career and reputation are more important than any single client.

Dennis Whitson and Ivan Hirsh, both Chartered British Patent Agents, were in-house patent attorneys for Molins, and managed Molins' patent department from 1974 through 1981. During that time, Whitson and Hirsh were responsible for the prosecution of all of Molins' patent applications directed to the "batch process" and "System 24" inventions.¹⁵ After Whitson retired in 1981, Hirsh became the manager *303 of Molins' patent department, and assumed responsibility for prosecuting the applications relating to the patents-in-suit, as well as for conducting the litigation involving Molins' patents.

John Coventry Smith, co-appellant in the appeal before the Federal Circuit, served as Molins' primary U.S. counsel from 1966 to the time of appeal.¹⁶ Beginning in 1967, Smith prosecuted the U.S. patent applications leading to the issuance of the batch process and System 24 inventions. Between the fall of 1967 and April 1968, and concurrent with the pendency of the U.S. patent applications, Whitson, "became aware of prior art referred to here as the 'Wagenseil reference.'"¹⁷ Whitson concluded that "it fully anticipated the 'batch process' claims that Molins initially filed in the United Kingdom and in many other countries including the United States."¹⁸ Whitson abandoned all foreign patent applications to the batch process except the applications pending in the U.S., because they contained both batch process and System 24 claims.

During the mid-seventies, although oppositions to the German System 24 patent application cited the Wagenseil reference, Whitson failed to inform Smith of the Wagenseil reference. In 1983, while reviewing all the abandoned foreign patents related to System 24, Hirsh discovered that Whitson had failed to include the Wagenseil reference in correspondence with Smith. Upon this discovery, Molins filed for reexamination of the issued U.S. patent that included claims to System 24, "listing the Wagenseil reference together with all other prior art references that had been cited during the foreign prosecution."¹⁹ During the reexamination, Molins was required to submit English language translations of the foreign language references cited. However, the Examiner's final office action in the reexamination did not cite the Wagenseil reference against any of the claims. The allowed claims issued as Reexamination Certificate B1 4,369,563 on May 13, 1986.

Summarizing the finding of the district court, the Federal Circuit stated:

Whitson, a seasoned patent practitioner, who was aware of the duty to disclose material information to the PTO, knew of a highly material reference but did not cite it, or any other reference, to the PTO during the entire 13 years in which he was involved in prosecuting the U.S. patent applications that led to the '563 patent. During the time the *304 applications were pending, Whitson represented to foreign patent offices that Wagenseil was the closest prior art. Whitson was on several occasions reminded of Wagenseil's materiality through its prominence in the prosecution of several foreign counterpart applications with which Whitson was intimately involved.²⁰ Rejecting Molins' argument that "Whitson had acted in good faith and simply overlooked Wagenseil,"²¹ the Federal Circuit found that the lower court properly inferred that "Whitson made a deliberate decision to withhold a known, material reference."²² In no uncertain terms, the court also stated that a "[f]ailure to cite to the PTO a material reference cited elsewhere in the world justifies a strong inference that the withholding was intentional."²³

While remaining "mindful of the complexities of conducting a worldwide patent prosecution in a crowded art,"²⁴ and the possibility that "[t]hings can 'fall through the floorboards' and not arise from an intent to deceive,"²⁵ the court reprimanded Whitson for not properly citing the Wagenseil reference.²⁶ Wagenseil's known materiality, combined with Whitson's failure to present the reference to the PTO, led the court to find inequitable conduct on the part of Whitson. Finally, the court admonished the Patent Bar that "[t]hose who are not 'up front' with the PTO run the risk that, years later, a fact-finder might conclude that they intended to deceive."²⁷

In her dissent, Judge Nies, who concurred in part and dissented in part, stated that she would have "affirm[ed] the judgment of the district court in its entirety."²⁸ Judge Nies argued that the appellants were "guilty of a pattern of misconduct during the prosecution of the '563 patent, the subsequent reexamination of that patent, and the litigation below, during which documents were destroyed."²⁹ Looking at the entirety of the facts, Judge Nies noted that "[t]hese acts are interrelated and cannot in this

case be isolated from each other.”³⁰

***305 B. Baxter International, Inc. v. McGaw, Inc.³¹**

Next, we examine a recent case that focuses on the scope or reach of a finding of unenforceability due to inequitable conduct. In Baxter International, Inc. v. McGaw, Inc., the Federal Circuit addressed the scope of an earlier case regarding inequitable conduct, Fox Industries, Inc. v. Structural Preservation Systems, Inc.³² Before Baxter, it was common parlance among the Patent Bar that a finding of inequitable conduct in any one of a string of continuing, related applications “tainted” the prosecution history of the entire family of files, thereby rendering all related patents unenforceable.³³ Baxter serves to dispel this misconception.³⁴

In Baxter, defendant McGaw presented evidence that Baxter failed to submit art related to methods for administering intravenous fluids and medications to the PTO during prosecution.³⁵ Baxter initially sued McGaw for infringing three patents directed to solving problems associated with leakage and coring of solid rubber septums when punctured multiple times by large needles during intravenous administration of liquids.³⁶ The art in question included instructions and sales materials provided by Borla S.p.A., an Italian manufacturer of rubber septa and other medical products. The inventors of the three Baxter patents used this art to improve on the solid septum device by adding a slit that permits insertion of a blunt cannula, thereby eliminating problems associated with the need to use sharp needles to puncture the septum.

The district court held that the two patents at issue before that tribunal were unenforceable because Baxter failed to comply with its duty of candor by not providing the references and sales materials from Borla to the PTO.³⁷ After McGaw moved to add the third patent to the case, the district court held that this patent was unenforceable based on the “infectious unenforceability” created by a finding of inequitable conduct in the two related cases.³⁸ Relying on Fox Industries, Inc. v. Structural Preservation Systems Inc., the district court stated that “the duty of candor *306 extends throughout the patent’s entire prosecution history,”³⁹ and that all descendants of that application, regardless of whether the reference is material to those claims, are also infected and unenforceable due to inequitable conduct in the parent application.⁴⁰

The Federal Circuit reversed this finding.⁴¹ The court began by noting that in Fox, an on-sale bar that occurred before the first application was filed resulted in a finding that all patents at issue were invalid. Stating that “a close reading of Fox reveals that the holding in that case is not so broad as the district court presumes,”⁴² the panel carefully analyzed the case law cited in Fox and by the appellants in Baxter.

Fox involved a series of three continuation applications, as well as the publication of a highly material sales brochure more than one year before the effective filing date of the earliest application. In Fox, the appellant argued that errors committed by its attorney in earlier cases resulting in inequitable conduct should not be held against the patent holder, and that the subsequent patents should remain enforceable despite the earlier breach of the duty of candor. The Federal Circuit concluded that “a breach of the duty of candor early in the prosecution may render unenforceable all claims which eventually issue from the same or a related application.”⁴³

In Baxter II, the Federal Circuit relied on a PTO-issued restriction requirement under 35 U.S.C. § 121 to find that two of the three patents sharing a single lineage were unenforceable because of inequitable conduct.⁴⁴ Stating that the “claims of the [patent] application which resulted in the [enforceable] patent were at all times directed to the structure of the blunt cannula for use with the separately patented injection site,”⁴⁵ the court distinguished Fox and Driscoll from the facts in Baxter II. The court also stated that when “determining inequitable conduct, a trial court may look beyond the final claims to their antecedents.”⁴⁶

***307 According to the Federal Circuit:**

Fox and Driscoll clearly stand for the proposition that cancellation or amendment of a claim “tainted” by inequitable conduct will not excuse the patentee’s intentional failure to disclose material references. It is also settled law that inequitable conduct with respect to one claim renders the entire patent unenforceable. However, where the claims are subsequently separated from those tainted by inequitable conduct through a divisional application, and where the issued claims have no relation to the omitted prior art, the patent issued from the divisional application will not also be unenforceable due to inequitable conduct committed in the parent application.⁴⁷ In the end, Baxter’s third patent did not survive. The court found the “enforceable” patent invalid based on anticipation due to the earlier publication of the PCT

application for the parent case.⁴⁸

C. Practical Problems

Most reported cases regarding inequitable conduct relate to the acts of the inventors, corporate officers, or clients who fail to disclose material information to the PTO. When a practitioner plays a “passive role” during prosecution, the practitioner may be held responsible for failing to educate the client as to the seriousness of the potential fall-out from the client’s acts and for not actively seeking the missing information. To date, neither passivity nor lack of client education has resulted in attorney disbarment. An in-depth analysis of the legal and ethical issues that relate to proceedings before the government is beyond the scope of the present discussion. Instead, the present discussion focuses solely on practitioners who knowingly fail to disclose material information to the PTO.

We begin with a very difficult scenario for the patent practitioner. A case for patent infringement is brought involving a patent that the practitioner drafted and prosecuted before the PTO. After an initial investigation, the party opposing the patent presents a defense that the patent is unenforceable due to inequitable conduct arising from the practitioner’s failure to bring to the Examiner’s attention a reference that is allegedly prior art to the claims of the patent. In fact, the prior publication, which is a patent, is in the practitioner’s files in connection with other work performed for the same client, and the prior patent could arguably meet the standard for materiality under 37 C.F.R. § 1.56.

The complexity of the situation is exacerbated by the fact that the practitioner is not a party and may not be represented by counsel. If the practitioner is a member (or even a partner) of a firm, then the practitioner and the firm must not only cover the expenses of the defense, but also lose billable time. Finally, the effect on the reputation of the practitioner and the firm is also a factor. Even if the practitioner ***308** has an attorney, the practitioner’s role remains that of an ex parte litigant. The third party nature of a practitioner also increases if the practitioner no longer represents the patent holder. If the practitioner continues to represent the patentee, then it is necessary to coordinate a strategy that follows what is best for the client--but which client? In addition, the embarrassment of defending against a charge of inequitable conduct may greatly strain the practitioner’s relationship with existing clients.

Other complexities exacerbate the practitioner’s predicament. Inequitable conduct is proved only when the withheld reference is material and culpable intent is shown.⁴⁹ The two elements of materiality and intent are often interrelated, and similar facts may be used to demonstrate both. While case law indicates that a practitioner may assume that references that are cumulative or less material than those already before the Examiner do not need to be presented,⁵⁰ the better practice is to present the art to the Examiner and allow the Examiner to determine its materiality. In addition, while the letter of the law may indicate that a balancing of the two elements is permitted such that the more material the omission, the less culpable the intent required, and vice versa, during prosecution, the practitioner’s duty of candor should be pre-eminent.⁵¹

One key reason a practitioner should use an abundance of caution and a liberal interpretation of the “materiality” of a prior art reference is that the extent of materiality of a reference will be a primary focus of the party charging inequitable conduct. This party will not focus on the balance or “sliding scale” approach to a prior art reference, but rather will focus on the hindsight reconstruction of the materiality of the reference. Additionally, a practitioner’s expertise in a particular area of practice will be a focus of inquiry. Focusing on the area of expertise is increasingly common as practitioners become more specialized in the different areas of patent art, e.g., mechanical, electrical, chemical, biotech and so forth. If the prior art reference at issue is found in the practitioner’s files and the practitioner is a specialist in the area of art, the burden of meeting the intent prong on the party charging inequitable conduct decreases proportionately.

Since intent is always a difficult element to prove, courts often inquire into the circumstances surrounding the practitioner’s failure to present the prior art reference, including the practitioner’s good faith judgment, to determine if the conduct rises to ***309** the level of an intent to deceive.⁵² In order to best defend his or her actions, the practitioner must be willing to relearn everything about the prosecution of the patent and the cited art. The practitioner must also be able to answer correctly, consistently, and cohesively all questions regarding the technical aspects of the invention, as well as the state of the art at the time of the invention and during prosecution. Finally, the practitioner must be able to explain any aberrations that appear in the prosecution history of the issued patent and related files. The practitioner must always remember that this is no longer an inquiry into anticipation or obviousness.

The practitioner must be the most prepared person at deposition and trial because both the judge and jury expect the practitioner to have the most knowledge of the facts and circumstances surrounding the prosecution of the patent. The practitioner is the expert on the law and the technology. The practitioner must have a detailed, working knowledge of the facts because the determination of inequitable conduct is heavily fact-oriented. In summary, the practitioner:

- (1) is in the best position to know the background from which the charge originated;
- (2) knows the state of the art that existed at the time the application was filed;
- (3) knows the problem that the inventors were attempting to solve; and
- (4) knows what the inventors provided about the state of the art at the time the patent application(s) was filed, as well as the circumstances surrounding the materiality and the practitioner's knowledge of the uncited prior art.

The accused infringer has the burden of proving the charge of inequitable conduct.⁵³ The Federal Circuit has left no doubt that, given the seriousness of the charge of inequitable conduct, the alleged infringer must prove by "clear and convincing evidence" that the prior art at issue was both material and intentionally withheld.⁵⁴ The Federal Circuit has expressed its discontent with how frequently the charge of inequitable is raised; the court has even gone to the extreme of labeling it an "absolute plague."⁵⁵ Recent Federal Circuit decisions also demonstrate an increasing dissatisfaction with lower court findings of inequitable conduct that fail to meet the rigorous evidentiary standard. For example, in *Northern Telecom, Inc. v. *310 Datapoint Corp.*,⁵⁶ the court echoed the requirement for finding culpable intent by clear and convincing evidence.⁵⁷ With regard to patent prosecution, the court stated:

Intent to deceive should be determined in light of the realities of patent practice, and not as a matter of strict liability whatever the nature of the action before the PTO. ... "A patentee's oversights are easily magnified out of proportion by one accused of infringement" Given the ease with which a relatively routine act of patent prosecution can be portrayed as intended to mislead or deceive, clear and convincing evidence of conduct sufficient to support an inference of culpable intent is required.⁵⁸

One significant and helpful position taken by the Federal Circuit is the requirement that the fact finder "should look to the facts and circumstances facing the actor at the time of the prosecution."⁵⁹ While the fact-finder is not permitted to use hindsight reconstruction to find inequitable conduct, often the mosaic of facts presented at trial lead to hindsight reconstruction in the jury room. For this reason it is important that the practitioner deconstruct this mosaic presented by the alleged infringer. To do so, the practitioner must place the jury in the environment and circumstances that existed at the time that the cited reference was first brought to the practitioner's attention and the reasons why it was not presented to the Examiner.

One important way in which the practitioner sways a jury is by having a detailed knowledge of the chronology of events. Specific examples of detailed facts in the chronology include:

- (1) when and under what circumstances the uncited reference was brought to the practitioner's attention;
- (2) when and under what circumstances the patent disclosure was received from the inventors;
- (3) the essential elements of the claims as filed; and
- (4) the reasons why the claims were amended.

The chronology must be presented in a coherent, comprehensive manner, without hesitation and, if possible, without a need to refer to notes.

The task of gathering and organizing a large volume of facts that may be several years old, and building them into a chronology is staggering. However, a chronology of facts is essential for defending against a charge of inequitable conduct because that is how the charge will be presented. The best way to rebut facts presented in a timeline is to present an alternate and vindicating timeline. The key is *311 to always avoid, whether during deposition or testimony, the answer: "I do not remember."

IV. Other Case Law Regarding Inequitable Conduct

A practitioner defending against a charge of inequitable conduct must also deal with the many areas of uncertainty caused by the conflicting decisions and dicta of the Federal Circuit. A study of the decisions of the Federal Circuit over the last fifteen years does not present a clear and unambiguous statement of the law on inequitable conduct. For example, in *Kingsdown Medical Consultants, Ltd. v. Hollister, Inc.*,⁶⁰ the court, overruling a number of its own decisions, clarified that gross negligence alone is not sufficient to support a finding of an intent to deceive.⁶¹ However, the decision is of limited importance because it only provides an answer to what does not constitute inequitable conduct.

*A.B. Dick Co. v. Burrough's Corp.*⁶² is perhaps the most criticized case in which inequitable conduct was found, because in this case, the reference was considered by the Examiner, and the claims were found to be patentable over the reference.⁶³ Although *A.B. Dick* has never been overruled, it is arguably superseded by the current Rule 56.⁶⁴ However, *A.B. Dick* may still be used as precedent in charging inequitable conduct in patents that were prosecuted prior to the new rule.

A number of Federal Circuit decisions since *A.B. Dick* suggest that when the art is before the Examiner a finding of inequitable conduct is improper, whether the reference came to the Examiner's attention through the Examiner's own search of the prior art "or the applicant's disclosure."⁶⁵ One consolation for practitioners is that no inequitable conduct case since *A.B. Dick* has been so harsh.

Under 37 C.F.R. § 1.56, applicants have a duty to disclose to the PTO all material information they are aware of, regardless of its source or the circumstances under which the information is obtained. This duty extends to any individual connected with the prosecution of the patent application and applies to all relevant art the individual is aware of prior to, at the time of filing, and during the prosecution of the application.

***312** Sources for information may include; co-workers, trade shows, communications from or with competitors, potential infringers or other third parties, related foreign applications, prior or co-pending U.S. patent applications, related litigation, and preliminary examination searches. Applicants and other individuals related to the prosecution of a patent also have a duty to present to the PTO all material prior art or other information cited or brought to their attention in any related foreign applications. A strong inference that this prior art is material attaches when it is the only prior art cited or when it is used to reject the same or similar claims in a foreign application.⁶⁶ As the court stated in *Gemveto Jewelry Co., Inc.*:

Foreign patent attorneys representing applicants for U.S. patents through local correspondent firms surely must be held to the same standards of conduct which apply to their American counterparts; a double standard of accountability would allow foreign attorneys and their clients to escape responsibility for fraud or inequitable conduct merely by withholding from the local correspondent information unfavorable to patentability and claiming ignorance of United States disclosure requirements.⁶⁷ Therefore, applicants cannot assume that the Examiner of a particular application is aware of other art material to the patentability of the application in question, but must instead bring this other art to the attention of the Examiner.⁶⁸

The M.P.E.P. sets forth guidelines that may be used by practitioners for ensuring that they have complied with their duty of candor. Section 2004, "Aids to Compliance With Duty of Disclosure," states:

While it is not appropriate to attempt to set forth procedures by which attorneys, agents, and other individuals may ensure compliance with the duty of disclosure, the items listed below are offered as examples of possible procedures which could help avoid problems with the duty of disclosure. Though compliance with these procedures may not be required, they are presented as helpful suggestions for avoiding duty of disclosure problems.

1. Many attorneys, both corporate and private, are using letters and questionnaires for applicants and others involved with the filing and prosecution of the application and checklists for themselves and applicants to ensure compliance with the duty of disclosure. The letter generally explains the duty of disclosure and what it means to the inventor and assignee. The questionnaire asks the inventor and assignee questions about

- ___ the origin of the invention and its point of departure from what was previously known and in the prior art,
- ___ possible public uses and sales,

*313 ___ prior publication, knowledge, patents, foreign patents, etc.⁶⁹

Practitioners often send letters to clients outlining the duty of candor and the requirements for disclosure to ensure that the client is informed of this duty. From a practical point of view, this type of correspondence demonstrates that the practitioner has inquired whether material prior art is known to the inventors, as well as those in direct decision-making positions within the client's hierarchy. However, the opposite point of view of this correspondence is that it can be viewed as an admission against the interest of the client by its lack of action after the practitioner's reminder.

A separate, but related inquiry concerns inventorship. Generally, a practitioner is best served by asking questions about inventorship at the outset, i.e., during the initial discussion of the invention with the inventor. In academic environments, the practitioner should make it clear to inventors that the requirements of authorship for scientific papers are distinct from those of inventorship. It is also prudent for a practitioner to inquire if there are any disputes or possible disputes about inventorship. All questions regarding inventorship should be resolved before filing the patent application to ensure that the oath and declaration are accurate at the time of filing.

A practitioner should also question the inventor about the best mode at the time of the disclosure, because the best mode must be described in the specification. A lack of disclosure of the best mode can be raised in future litigation.⁷⁰

V. Rules of Practice - 35 U.S.C. § 31

As already mentioned above, 35 U.S.C. § 31 grants the Commissioner of the PTO the authority to regulate patent attorneys and agents. The regulations that serve to carry out this purpose are subject to approval by the Department of Commerce and Congress. The language of 35 U.S.C. § 31 provides that the Commissioner may require applicant's "to show that they are of good moral character and reputation" and that the applicant possess "the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office."⁷¹ Section 32 grants to the Commissioner the power to discipline practitioners.⁷²

Subsumed within the vagueness of the language used in § 31 is the spirit of the ethical standard that is applied to practitioners, namely, a current day societal *314 standard of the moral character of an individual practicing before the PTO. In other words, the code should be interpreted using the objective ethical standards of moral character and reputation.

The regulations, primarily 37 C.F.R. Part 10, outline the requirements, administrative structures, and disciplinary procedures that must be followed by the PTO against those who wish to represent inventors before the PTO. To represent inventors before the PTO, an individual must apply and meet the requirements for registration.⁷³ Practitioners must also meet and conduct themselves according to the rules set forth in 37 C.F.R. Part 10, which is the Code of Conduct to Practice before the PTO.

An analysis of the administrative structures for disciplinary actions is instructive not only for curiosity's sake, but also in order to identify the threshold requirements for initiating such an action. The Committee on Discipline, as outlined in 37 C.F.R. § 10.4, is composed of three employees of the PTO.⁷⁴ Each member of the committee is required to be a member in good standing of the bar of a state.⁷⁵ The committee meets at the request of the Director of the OED on an ad hoc basis.⁷⁶ In disciplinary actions, the committee members review all available evidence and following the review, by majority vote, may begin an investigation or even bring a charge.⁷⁷

As with most administrative procedures and committees, there are varying levels of sanctions that the Committee on Discipline may impose.⁷⁸ The sanction levels include no action whatsoever, reprimands (public and potentially private), suspensions, and exclusions.⁷⁹ The difference between a suspension and an exclusion is that a suspension is temporary, i.e., a suspension lasts for a fixed period of time, upon the expiration of which a petition for reinstatement can be filed.⁸⁰ On the other hand, when a practitioner is excluded, the period of exclusion is of an indeterminate length. However, a practitioner may apply for reinstatement after five years from the commencement of the exclusion.⁸¹ After a practitioner is suspended *315 or excluded, the former practitioner must reapply to the PTO and sit for the patent examination to once again become a

member of the Patent Bar.⁸²

Three basic reasons are used to bring charges against a practitioner: a showing of incompetence or bad reputation, a demonstration of gross misconduct, or a violation of a disciplinary rule.⁸³ If a majority of the Committee on Discipline finds probable cause for any one of the three basic categories of misconduct, the case is referred to an administrative judge of the Department of Commerce, which holds jurisdiction over PTO administrative proceedings.⁸⁴

The PTO procedures state that the Director of the OED may confer with a practitioner concerning possible violations by the practitioner of a disciplinary rule, even if a disciplinary proceeding has not been instituted.⁸⁵ At this point, the practitioner is given the opportunity to resign from the Patent Bar.⁸⁶ Any resignation, however, must be accompanied by a signed statement acknowledging the charges of inequitable conduct (basically a plea of *nolo contendre*) and that the practitioner understands the implications of resignation; that the resignation was not under duress or coercion from the OED; and that the resignation is free and voluntary.⁸⁷

VI. Litigation of Disciplinary Cases

Perhaps the most reasonable explanation for the lack of reported inequitable conduct cases is the ominous nature of the disciplinary proceedings at the PTO. While the practitioner is entitled to and will receive due process, once a charge by the PTO's OED is made that satisfies the standards outlined below, the burden shifts dramatically against the practitioner. Initially, the burden of proof is on the OED to bring a charge and to prove by clear and convincing evidence (not beyond a reasonable doubt) that the practitioner failed to meet the standards for practice.⁸⁸ On the opposite side, the practitioner is required to bring forth and prove all possible defenses by clear and convincing evidence. The clear and convincing evidence standard is used because it is sufficiently high to eliminate most cases of conduct where information is insufficient or missing, but it is not as onerous as the beyond a *316 reasonable doubt standard. This standard is appropriate to the seriousness of the actions and consequences because this is strictly an administrative proceeding.

Under the regulations, the rules of evidence are not those of the Federal Rules, State Rules, D.C. rules, or even local rules; rather, the admissibility of evidence is entirely at the judge's discretion.⁸⁹ Depositions may be had, again at the judge's discretion, upon a showing of good cause.⁹⁰ There is also no discovery unless the requesting party shows in a clear and convincing manner that discovery is necessary and relevant.⁹¹ However, discovery is not available solely for impeachment or cross-examination purposes.⁹² Finally, both sides are required to make initial disclosures prior to the administrative hearing, which include a list of exhibits; a proposed witness list; a proposed expert witness (with Expert Report and qualifications); the names of investigators on behalf of the PTO; and copies of all correspondence with the PTO reflecting the practitioner's statements to PTO representatives.⁹³

In fact, even the opportunity for an oral hearing is discretionary. For example, in *Weiffenbach v. Logan*,⁹⁴ in an appeal before the Office of the PTO Commissioner, the panel hearing the appeal held that in a disciplinary proceeding against an attorney charged with unprofessional conduct before a PTO Administrative Law Judge (ALJ), denial of an "evidentiary" hearing did not constitute reversible error.⁹⁵ In *Weiffenbach*, the attorney did not dispute the facts, and since no facts were in dispute, the ALJ did not abuse his discretion in denying the attorney's request for an "oral" hearing on the evidence.⁹⁶

VII. Case Law Regarding Attorney Disbarment

This section begins with a discussion of a series of cases that extend over a period of eight years, in which a long-time patent practitioner was found to have made a systematic practice of backdating certificates of mailing. The four reported cases involving this former practitioner provide the most complete recorded accounting of the disciplinary and appeals process. This section will also discuss several cases that add to the understanding of disciplinary actions as they relate to *317 appeals based on procedural defenses and state law. In addition, this section will discuss both the opinions of the majority and the dissent in *Lipman v. Dickinson*.⁹⁷

On August 20, 1984, a disciplinary proceeding entitled *Nakamura v. Klein* was instituted in the PTO against Mr. Arthur Klein (formerly, Reg. No. 19,102) pursuant to 35 U.S.C. § 32 and 37 C.F.R. § 1.348 (1984).⁹⁸ The first reported case involving Klein began in 1986.⁹⁹ In a disciplinary proceeding, an ALJ found that Klein and his staff members routinely altered the dates on certificates of mailing in order to avoid bar dates and the payment of extension fees.¹⁰⁰ In one case, the

certificate was dated back between 54 and 56 days.¹⁰¹ Furthermore, in written testimony Klein represented to the PTO that responses to the PTO were mailed on certain dates even though Klein knew or should have known that the responses were mailed after the dates represented.¹⁰²

The judge held that Klein mailed, caused, or allowed to be mailed certain responses to the PTO after their due dates, and that Klein supplied false answers to the PTO.¹⁰³ Klein was found to have engaged in dishonesty, fraud, deceit, and misrepresentation in violation of 37 C.F.R. § 1.344, 37 C.F.R. § 1.56, and DR 1-102(A)(4) of the American Bar Association Code of Professional Responsibility.¹⁰⁴ Klein was also found to have neglected legal matters entrusted to him in violation of 37 C.F.R. § 1.344 and DR 6-101(A)(3).¹⁰⁵

Klein appealed the administrative decision on four counts to the PTO Commissioner and presented “mitigating” circumstances for review.¹⁰⁶ The Commissioner found that the grounds for the Bill of Exception presented by Klein were without merit, and suspended Klein from practice before the PTO for seven years.¹⁰⁷ However, the Commissioner’s decision still allowed Klein to be reinstated to practice upon compliance with 37 C.F.R. § 10.160 after two years of suspension, *318 at which point he could apply for readmission to the Patent Bar and serve a five year probation.¹⁰⁸

The Commissioner upheld the ALJ’s finding that Klein had engaged in dishonesty, fraud, deceit, misrepresentation, and neglect of legal matters entrusted to him.¹⁰⁹ More specifically, the sanctions were to run concurrently and the terms of probation were as follows:

(i) Respondent shall comply with all disciplinary rules applicable to patent attorneys and agents practicing before the Patent and Trademark Office.

(ii) document in any patent or trademark application can be filed in the Patent and Trademark Office by or on behalf of Respondent which (a) uses a certificate of mailing under 37 C.F.R. § 1.8, and (b) which indicates on the document that the document was prepared by, worked on, or signed by or on behalf of, Respondent.¹¹⁰ Finally, the Commissioner held that it was within the OED’s discretion whether Klein would be required to take the PTO examination again, but that no application for readmission would be “considered in less than two (2) years from the effective date of this Decision.”¹¹¹

Klein chose to appeal the Commissioner’s decision to the United States District Court for the District of Columbia.¹¹² In his appeal, Klein argued that the disciplinary process was a per se violation of due process because he had been denied access to documents relating to his investigatory files and to complete files of previous PTO disciplinary proceedings.¹¹³ He also appealed on the grounds that the “proceedings were conducted in an arbitrary and capricious manner,” and that “the Solicitor had failed to carry the burden of proving the charges by clear and convincing evidence.”¹¹⁴

The court first responded to Klein’s argument that the proceedings lacked procedural due process:

It is clear that procedural due process is required in attorney discipline cases. Plaintiff contends that the statutes and regulations governing disciplinary proceedings within the PTO are impermissibly vague in that they fail to clearly establish proper procedural safeguards and guidelines, applicable standards of conduct, or standards of proof, and that they are therefore per se violative of due process. But this conclusion is not compelled by precedent, as plaintiff suggests. The Supreme Court has held that administrative agencies *319 should be “free to fashion their own rules of procedure and to pursue methods of inquiry capable of permitting them to discharge their multitudinous duties.” Rather, the question whether plaintiff was deprived of this right to due process must be answered by an examination of the proceedings conducted against him.¹¹⁵ The court went on to state that a “review of the administrative record shows that plaintiff was provided adequate notice of the charges, was able to depose those PTO officers involved with the investigation, [and] was given the right to put on a defense and to confront adverse witnesses.”¹¹⁶

In response to Klein’s argument that he did not have access to certain documents, the court asserted that “parties to agency proceedings are not entitled to pre-hearing discovery.”¹¹⁷ Thus, the court, while acknowledging that “[d]iscovery must be granted only if in the particular situation a refusal to do so would so prejudice a party as to deny him due process[,] ... the adverse rulings of the ALJ regarding discovery did not materially harm plaintiff and no infringement of his due process rights flowed therefrom.”¹¹⁸

Next, the court responded to Klein’s argument that the PTO had failed to prove its case by clear and convincing evidence:

The function of the Court in a case of this nature is not that of a trier of fact. Rather, the responsibility of the Court is “to review what has been done to determine whether or not a fair hearing has been had and whether there is substantial evidence to support the action of the Patent Office.” The scope of review does not contemplate *de novo* analysis of determinations below involving factual disputes; particularly when reviewing questions necessitating an evaluation of witness credibility, the Court will accord great deference to the finder of fact. Judicial review in these types of patent proceedings is limited to determining whether, on the basis of the evidence, the agency had substantial evidence to rule as it did.¹¹⁹ Therefore, the district court in such a case does not function as a trier of fact, but instead the court determines whether or not a fair hearing has been had, and whether there is “substantial evidence to support the action of the PTO.”¹²⁰

The final chapter in the Klein saga involved Klein’s equitable arguments for reinstatement into practice.¹²¹ On September 30, 1990, Klein petitioned for a suspension of the rules of professional conduct. The effective date of Klein’s disbarment after he had exhausted his appeals was on or about March 17, 1989, *320 approximately 5 years after the PTO first brought its complaint against Klein. Therefore, Klein was not entitled to petition for reinstatement until March 27, 1991, because of the two-year period of suspension.

Klein sought “relief from the two year period of suspension, and the five year period of probation[,]” on five grounds:

- (a) the severity of the punishment imposed;
- (b) the devastating effect upon his law practice;
- (c) the hardships which he has endured to date;
- (d) the questionable nature of the evidence upon which he was found to have violated Office regulations; and
- (e) the existence of new evidence, not considered by the Deputy Commissioner or any reviewing court, which, according to petitioner, casts in doubt the evidence which was presented against him before the ALJ.¹²²

Arguing that Klein’s petition was an attempt to circumvent the OED, the Commissioner chastised Klein and his counsel for filing a petition without any factual support or a signed oath. Stating that “argument of counsel is not evidence,” the Commissioner summarily dismissed the petition.¹²³ Unfortunately for Klein, the bad news did not end there. Finding that “hardships” and “devastation” are expected consequences of the sanction of disbarment, the Commissioner indicated that the sanction was fair when considered in light of:

- (1) the public interest, including the need for integrity in PTO’s practice under 37 C.F.R. § 1.8, which relies solely on the word of the individuals mailing material to PTO;
- (2) the seriousness of the petitioner’s conduct;
- (3) deterrent effects deemed necessary;
- (4) the integrity of the profession which practices before the PTO; and
- (5) all extenuating circumstances presented by petitioner during the disciplinary proceeding.¹²⁴ Klein’s actions, including a number of actions not discussed in the previous cases, led the Commissioner to not only deny Klein’s current petition, but to also increase Klein’s punishment by denying any future petition for reinstatement, i.e., basically changing Klein’s suspension to an exclusion from practice before the PTO.

In Klein, the court reviewed *Weiffenbach v. Logan*,¹²⁵ a case involving the suspension of an attorney from practice before the PTO for five years.¹²⁶ In *321 *Weiffenbach*, the Commissioner upheld a five-year suspension of an attorney because the attorney had altered documents submitted to the PTO in connection with an office action.¹²⁷ The attorney was also charged with withholding material information known by the attorney and unknown to the client, as well as for failing to timely pay an issue fee.¹²⁸

The only evidence of mitigating circumstances offered by the attorney was that he had been a practitioner for 29 years, he was a graduate of Rensselaer Polytechnic Institute, and he was a former patent examiner.¹²⁹ The attorney also presented evidence that he was well known in the patent community, donated blood, coached little league, gave free legal patent advice to the indigent and minorities, and had been President of the San Diego Bar Association.¹³⁰ In addition, the attorney showed that he was attempting to reimburse the client (in whose case he had altered the documents submitted to the PTO) for all fees paid.¹³¹

One exchange between the attorney and the OED in Weiffenbach demonstrates the latitude and deference given by the court to actions by the PTO. The attorney (in this case Respondent) stated: “Respondent has previously requested an oral hearing and at this time Respondent does not know if an evidentiary hearing would be required. Respondent believes that due to the gravity of the charges against him he should have available to him the option to have an evidentiary hearing.”¹³² The OED responded to the Respondent’s request for an oral hearing as follows: “Respondent has offered nothing in his request for evidentiary hearing as to why such a hearing is necessary in this case. The Director submits that it would be appropriate at this time to set a time for submission of proposed findings and conclusions, pursuant to 37 CFR § 10.153.”¹³³ The ALJ then entered an order providing in part:

Respondent has requested an oral hearing which is opposed by Agency Counsel [counsel for the Director] on the grounds that there are no material facts in issue. In the Order of December 3, 1991, Respondent was solicited to show cause why an evidentiary hearing is appropriate for the adjudication of this proceeding. His response filed on December 19, 1991, makes no such showing. The law does not require a hearing when it can serve no purpose.¹³⁴ *322 The ALJ went on to state that where there are “no material facts at issue, there is simply no purpose to holding an evidentiary hearing.”¹³⁵ While the Respondent requested oral and evidentiary hearings early in the process, the ALJ noted that “[i]n submitting his proposed findings and conclusions, [the Respondent] did not renew a request for a hearing.”¹³⁶ Finally, the ALJ indicated: “Requests for hearings are not lightly rejected. However, ... even when the statute mandates a hearing, when there is no question of fact, neither due process, the statute, nor the [Administrative Procedure Act] requires that the agency hold a meaningless hearing.”¹³⁷

In Weiffenbach, the Commissioner ultimately held that the respondent should be suspended for a period of five years, of which all but six months would be suspended.¹³⁸ The Commissioner also ordered that the case be published, that the respondent comply with all Rules of Professional Conduct, and that the respondent pay restitution to his harmed clients.

An empirical analysis of the roster of patent attorneys involved in severe cases of inequitable conduct shows that most withdraw from the profession without any kind of public disclosure. Such is the case for the patent attorney involved in Molins PLC v. Textron, Inc.¹³⁹ Jaskiewicz v. Mossinghoff¹⁴⁰ suggests that the courts will view the inequitable conduct of a practitioner in a slightly more lenient manner, if the practitioner is likely to withdraw or retire from the Patent Bar. In Jaskiewicz, the Federal Circuit noted that while it was clear that the patent attorney’s filing of application papers with a colloquial translation that had only been verbally ratified by a foreign inventor did not constitute intentional misconduct, it was sufficient for a reprimand.¹⁴¹ The Commissioner suspended the attorney for two years; however, the Federal Circuit, considering that the respondent was “63 years old and has been a solo practitioner for a number of years,” remanded the case to the Commissioner to reduce or suspend the sentence.¹⁴² The court also looked at the attorney’s many years of practice, and his potential inability to re-enter practice.¹⁴³ The court also noted the difficulty of working with a foreign assignee rather than working directly with an inventor.¹⁴⁴

*323 The next section examines the interaction between state bar disciplinary actions and the PTO. In Marinangeli v. Lehman,¹⁴⁵ Marinangeli, a member of the Patent Bar, was contacted as part of a routine PTO inquiry into the status of patent attorneys.¹⁴⁶ By routinely contacting members of the Bar, the PTO may withdraw patent attorneys who are no longer practicing from the roster of patent attorneys. In his response to the PTO, Marinangeli disclosed that he had pleaded guilty to mail theft.¹⁴⁷ Upon further investigation, it was found that both the New York and New Jersey State Bar Associations had disbarred Marinangeli, despite mitigating circumstances involving substance abuse.¹⁴⁸ The district court upheld a two-year suspension over arguments of lack of due process, double jeopardy, and equal protection.¹⁴⁹

The district court stated that the Commissioner “may, after notice and opportunity for a hearing, suspend or exclude ... from further practice before the [PTO], any ... attorney’ shown to be guilty of certain misconduct.”¹⁵⁰ Furthermore, while judicial review of the Commissioner’s final decision imposing sanctions is available at the district court, D.C. Local Rule 213 states: [The] record and proceedings before the Patent Office ... shall constitute the sole basis for the Court’s review. Such review is governed by the APA [[Administrative Procedures Act], which permits reviewing courts to set aside agency decisions that

are “arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law.” “In applying [the arbitrary and capricious] standard, the focal point for judicial review should be the administrative record already in existence.”¹⁵¹

Furthermore, the court stated that the PTO is not bound by the disciplinary sanctions imposed on attorneys by states when determining whether to discipline a patent attorney.¹⁵² Under 37 C.F.R. Part 10, when determining the penalty to be assessed, the judge should consider:

- (1) the public interest;
- (2) the seriousness of the violation;
- *324** (3) the deterrent effects;
- (4) the integrity of the legal profession; and
- (5) any extenuating circumstances.¹⁵³

The court further stated: “The Commissioner must review the penalty based on the record made before the administrative law judge. Both the administrative law judge and the Commissioner considered the applicable factors when arriving at their conclusions.”¹⁵⁴

Finally, regarding Marinangeli’s defenses of double jeopardy (arguing that his state bar disbarment was a criminal sanction) and equal protection, the court clarified that these defenses did not apply to PTO proceedings. The court stated: “The PTO is not bound by the disciplinary sanctions imposed by New York and New Jersey. Even though Marinangeli has already been disciplined in other states, he may still be disciplined by the PTO, or any other court or agency before whom he is admitted to practice.”¹⁵⁵ Thus, just as state bars have an interest in maintaining the standards of the profession, “the Commissioner’s finding that the public interest and the integrity of practice before the PTO is best served by a discipline separate and apart from that imposed by New York is not arbitrary, capricious or an abuse of discretion.”¹⁵⁶

Marinangeli’s claim under the equal protection clause was based on arguments that he was “being sanctioned by the PTO while he is currently a member in good standing of the New York bar,” and that he was “being treated differently from all other attorneys in good standing who are permitted to practice before the PTO.”¹⁵⁷ The court, while expressing its confusion as to the legal basis for Marinangeli’s claim, found these arguments “unconvincing.”¹⁵⁸ The court responded that Marinangeli was not “a member of a suspect class,” and that the PTO’s action had not “affected [Marinangeli’s] fundamental right.”¹⁵⁹ Finally, the court pointed out that the only class Marinangeli could compare himself to were “attorneys sanctioned by the PTO and not, as Marinangeli claims, all attorneys in good standing.”¹⁶⁰

***325** The district court addressed the mitigating circumstances presented by Marinangeli.¹⁶¹ The court upheld the Commissioner’s finding that Marinangeli’s addiction problems “did not excuse or reduce the seriousness of his crime.”¹⁶² The court also found that it was not “arbitrary and capricious or an abuse of discretion” to find that “the evidence in mitigation did not outweigh the seriousness of the crime.”¹⁶³ In fact, the court noted that “many states have considered and rejected alcoholism as warranting a reduction in disciplinary sanctions.”¹⁶⁴

The most disturbing case involving inequitable conduct, *Lipman v. Dickinson*,¹⁶⁵ was decided in 1999. In *Lipman*, a divided panel of the Federal Circuit affirmed a district court finding that patent attorney Lipman violated his duty of candor under 37 C.F.R. § 10.23(b)(4) and (c)(2)(ii) (1996).¹⁶⁶ Lipman represented Ronald Wallace before the PTO, after Wallace’s application for registration to practice before the PTO had been denied. In support of Wallace’s petition to be allowed to practice before the PTO, Lipman drafted a brief with 17 affidavits supporting Wallace’s good character and reputation.¹⁶⁷ The text of the brief as well as the attachments, included affidavits from four attorneys at the law firm of Vinson & Elkins (V&E). Wallace was also employed by V&E at the time.

A time line is instructive for understanding the events that followed. On April 30, 1990, the four V&E attorneys contacted Lipman to inform him that they were withdrawing their affidavits in support of Wallace’s application for registration based on new evidence.¹⁶⁸ Thereafter, Lipman immediately contacted Wallace with the allegations of the V&E attorneys, to which Wallace responded that there were two sides to the story. Eight days later, on May 7, 1990, Lipman filed a petition on behalf

of Wallace that referred to a total of 17 affidavits. While in the interim Lipman had removed all quotes from the V&E affidavits from the text of the brief, the brief did not explicitly state that the V&E affidavits had been withdrawn. On June 29, 1990, the V&E attorneys directly contacted the OED to withdraw their *326 affidavits in support of Wallace. This in turn caused the PTO to initiate a disciplinary action against Lipman.¹⁶⁹

The sanction imposed on Lipman for protecting his client while he investigated the allegations by the V&E attorneys was a public reprimand.¹⁷⁰ Judge Newman's dissent focused on the conflict between Lipman's duty to investigate on behalf of his client and the eight days he had to investigate the extent of the allegations of the V&E attorneys.¹⁷¹ As Judge Newman stated:

The only "mistake" made by Mr. Lipman was in respecting his client's rights for the time needed to investigate the withdrawal of the endorsements by the Vinson & Elkins attorneys, instead of rushing to impeach his client without investigation, as the PTO (and my colleagues on this panel) hold was the necessary behavior. Mr. Lipman acted reasonably, responsibly, and diligently to satisfy both the lawyer's responsibility to his client and the lawyer's responsibility to the PTO. The Commissioner's reprimand was unwarranted, and should not be sustained.¹⁷²

The dissent also pointed out that Lipman had the support of a number of seasoned practitioners and commentators on ethical issues. Former Commissioner of Patents and Trademarks Donald W. Banner declared:

This case should never have been brought against Respondent on the basis of this record. The documented history of Respondent's involvement in informing himself and the PTO of the facts surrounding the incidents about which he is charged show absolutely no intent, reckless disregard or gross misconduct. The record discloses a concerned practitioner who was presented with third party accusations which were unsubstantiated and who made a reasonable effort to determine the truth of those accusations. The allegations contained in the [PTO] complaint indicate that there was no consideration of the totality of the circumstances--including Respondent's duty to his client, the nearly impossible position in which Respondent was placed by [a V&E attorney's] April 27th letter and the time pressure upon Respondent to meet a jurisdictional deadline.¹⁷³

Next, former Commissioner of Patents and Trademarks Donald J. Quigg, who instituted the PTO rules of professional conduct, declared:

[I]t is my opinion that, faced with the situation presented to him, Respondent performed in a reasonable manner under the requirements of the Ethics Rules, including Canons 6 ["A practitioner should represent a client competently"] and 7 ["A practitioner should represent a client zealously within the bounds of the law"].¹⁷⁴ *327 One academic expert on legal ethics, Professor Charles W. Wolfram of the Cornell Law School, who was the Chief Reporter for the Restatement of the Law Governing Lawyers and the author of the treatise on Modern Legal Ethics, observed:

That [an attorney at V&E] forced the Commissioner's hand before Mr. Lipman could complete his planned course of action says nothing about the legitimacy of Mr. Lipman's own actions. That [the V&E attorney] insisted that Mr. Lipman take action prior to May 7 or at some other time prior to August 2 also does not determine Mr. Lipman's responsibilities. That others who fully possessed both the facts and objectivity might have taken or counseled Mr. Lipman to take a different course of action does not in the circumstances impugn what Mr. Lipman did.¹⁷⁵

I would say that if you presented lawyers in this country with this set of facts as a problem, I think, I would hope, that the ones I would consider to be noble practitioners would behave exactly the way [Lipman] did. I regard this as a case study in the way to handle a problem ... and it's a horrible thing to have to say to him from the witness stand in a case in which he is the defendant, but I think he ought to be proud of what he did.¹⁷⁶

Two former United States Attorneys for the District of Columbia with extensive experience in legal ethics, Earl J. Silbert and Charles F.C. Ruff,¹⁷⁷ also supported Lipman. Ruff stated in support of Lipman: "[O]n the raw information provided to Respondent in the April 27th letter, it would not have been reasonable to have revealed the April 27th letter to the PTO. ... On the basis of the factual record in this case, this disciplinary proceeding never should have been brought."¹⁷⁸ Silbert, also in support of Lipman, stated: "[T]o allege that it was Respondent's duty immediately to inform the PTO of the April 27th letter, without inquiring further into the surrounding circumstances, ignores the complexity of the difficult ethical obligations on Respondent."¹⁷⁹ Finally, Rene D. Tegtmeyer, a former Assistant Commissioner for Patents, who was also a partner at

Lipman's firm, declared: "[I]t is clear to me that Respondent never acted with an intent to deceive the PTO or to misstate any facts of which he had knowledge in his representation of the applicant in [Wallace's] Proceeding"¹⁸⁰

Based on the expert testimony provided to the panel, Judge Newman noted in her dissent that all of the expert witnesses who supported Lipman were: *328 "...experienced in disciplinary issues and in the ethical obligations of attorneys. All agreed, without the slightest qualification, that Mr. Lipman's conduct was appropriate and reasonable in the circumstances, and not a violation of any code or canon or other legal or ethical obligation."¹⁸¹ Judge Newman further noted that "Mr. Lipman was constrained by the 'dual trust ... imposed on attorneys at law [to] act with fidelity both to the courts and to their clients.'"¹⁸² Finally, Judge Newman stated:

Mr. Lipman acted reasonably and responsibly to fulfill that trust, immediately deleting from the brief all references to and quotations from the Vinson & Elkins affidavits, asking both Vinson & Elkins and the client for the true facts, consulting with others in his firm, pursuing the matter diligently, and acting promptly to notify the PTO when it became clear that no resolution was possible.¹⁸³

Perhaps the most disturbing aspect of this case was the manner in which an experienced patent attorney with the highest ethical standards became the subject of a disciplinary proceeding. Lipman also sets a disturbing precedent because even with the support of eminent practitioners and scholars, an impeccable reputation, and years of practice, Lipman was still publicly reprimanded for his conduct. Had Lipman not had support at the highest levels of the practice, there is no telling what his sanction may have been. Interestingly, we note that Lipman had previously represented a number of individuals before the PTO Disciplinary Committee, including the respondent in *In re Klein*.¹⁸⁴

Finally, in *Schindler v. Finnerty*,¹⁸⁵ two registered patent attorneys who were also members of the New York Bar Association (NYBA), sued the NYBA's Grievance Committee ("Grievance Committee"), seeking a declaration that the Grievance Committee lacked jurisdiction to investigate complaints filed by their clients regarding the attorneys' patent prosecution practices.¹⁸⁶

Edwin D. Schindler and Michael I. Kroll appeared separately before the Grievance Committee, and argued that registered patent attorneys were not subject to the disciplinary actions of the Grievance Committee because their PTO licenses pre-empted review by a state Bar.¹⁸⁷ On summary judgment, the United States District Court for the Eastern District of New York held that "even when engaged in patent work, patent attorneys are subject to the rules and regulations governing the *329 professional conduct of New York Attorneys."¹⁸⁸ As with most disciplinary actions, the complaints against Schindler and Kroll arose because of a fee dispute (Kroll) and lack of communication (Schindler) with the client.¹⁸⁹

The court also held that the attorneys lacked standing to protest complaints that the Grievance Committee had dismissed without qualification.¹⁹⁰ On the issue of federal question jurisdiction, the court held that federal law did not preempt the Grievance Committee's authority to conduct its investigation because "the Grievance Committee has, at least, concurrent jurisdiction with the PTO to investigate grievances filed against patent attorneys who are also members of the NYBA."¹⁹¹ In a poignant passage the court unequivocally stated:

The Grievance Committee conducts preliminary investigations to determine if a disciplinary proceeding is warranted in much the same manner as the PTO Committee on Discipline determines whether to bring charges under section 10.132. The goals of these committees are similar; namely, to maintain the high standards of our worthy profession. As such, the Grievance Committee has not created an additional burden on patent attorneys. The Court is of the view, that Regulation of the professional conduct of patent attorneys admitted to the NYBA is well within the province of the state's police powers, and cannot be deemed to frustrate the necessary scope of practice before the PTO. In fact, the Commissioner of the PTO has mandated the same degree of required professional conduct. Accordingly, the Court holds that 35 U.S.C. §§ 31-32 does not preclude the Grievance Committee from regulating the conduct of patent attorneys who are also admitted to the NYBA.¹⁹² Since the grievances against the practitioners were dismissed, it is not known how state Grievance Committees will treat these types of disciplinary actions in future cases. Importantly, the Schindler/Kroll cases demonstrate that concurrent jurisdiction exists for disciplinary actions against members of a state bar and the PTO.

VIII. Conclusion

This paper has provided a broad overview of the legal and ethical obligations of the patent practitioner to the PTO, as well as reviewed both the case law and the standards that relate to findings of inequitable conduct during litigation. Molins serves as a reminder of the “continuing” duty of candor a practitioner has, and the consequences of failing to uphold the highest standards in the profession. It also highlights the lack of enforcement by the PTO against practitioners found to have engaged in inequitable conduct. The few reported cases that have found a patent ***330** practitioner responsible for the act or acts of inequitable conduct have not led to the immediate dismissal of the practitioner from the Patent Bar. Rather, it is likely that these practitioners will either withdraw voluntarily from the Bar or retire.

This paper has also discussed the administrative procedures set forth in the Code of Federal Regulations for discipline of attorneys, including the steps that must be taken by the PTO to bring a charge of inequitable conduct against a practitioner. It is clear that the OED must meet a high threshold to bring a charge. From a structural point of view, it is reasonable that the threshold needed to initiate an action is high, given the limited resources of the OED and the large number of members who comprise the Patent Bar. Once the determination to proceed with a disciplinary action is made by the OED, however, the patent practitioner should reflect long and hard on whether to become involved. Furthermore, once an action begins against a practitioner, the regulations and implementation of regulations before administrative law bodies will comply with due process guarantees, minimally and strictly.

This paper has analyzed most of the reported cases involving disciplinary actions against practitioners. Three conclusions may be reached from this analysis: first, disciplinary actions by the OED are rare; second, most disciplinary actions do not result in a reported case unless the practitioner decides to appeal the Commissioner’s decision; and third, patent practitioners who draft and prosecute patents, as well as those who defend other patent practitioners before the PTO, are subject to disciplinary actions by the PTO.

On a final note, while a number of reported cases discuss the interface between state grievance committees and the OED in actions involving attorneys registered to practice before the PTO, there is no equivalent interface for patent agents--i.e., practitioners who are registered to practice before the PTO but who do not possess a law degree. The OED is the only office that supervises patent agents. As the number of patent practitioners increases, the OED will likely require additional resources to deal with the growing Patent Bar.

Footnotes

^{a1} Dr. Flores is an associate with the law firm of Gardere & Wynne, L.L.P. in Dallas, Texas.

^{aa1} Mr. Warren is a partner with the law firm of Gardere & Wynne, L.L.P. in Dallas, Texas.

¹ 48 F.3d 1172, 33 U.S.P.Q.2d (BNA) 1823 (Fed. Cir. 1995).

² For a more recent case applying the law of inequitable conduct, see *Elk Corp. of Dallas v. GAF Building Materials Corp.*, 168 F.3d 28, 49 U.S.P.Q.2d (BNA) 1853 (Fed. Cir. 1999) (reviewing and affirming the findings of the District Court for the Northern District of Texas-Dallas Division).

³ 174 F.3d 1363, 50 U.S.P.Q.2d (BNA) 1490 (Fed. Cir. 1999).

⁴ 35 U.S.C. § 31 (1998) states: “The Commissioner, subject to the approval of the Secretary of Commerce, may prescribe regulations governing the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Patent and Trademark Office, and may require them, before being recognized as representatives of applicants or other persons, to show that they are of good moral character and reputation and are possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office.”

⁵ See *Nobelpharma AB v. Implant Innovations, Inc.*, 141 F.3d 1059, 1070, 46 U.S.P.Q.2d (BNA) 1097, 1105-06 (Fed. Cir. 1998)

(citing *Molins PLC v. Textron, Inc.*, 48 F.3d 1172, 1178, 33 U.S.P.Q.2d (BNA) 1823, 1826 (Fed. Cir. 1995)).

⁶ See *Halliburton Co. v. Schlumberger Tech. Corp.*, 925 F.2d 1435, 1439, 17 U.S.P.Q.2d (BNA) 1834, 1838 (Fed. Cir. 1991).

⁷ *Id.* at 1440, 17 U.S.P.Q.2d at 1839 (quoting 37 C.F.R. § 1.56 (1989)); see also *J.P. Stevens & Co., Inc. v. Lex Tex Ltd., Inc.*, 747 F.2d 1553, 1559, 223 U.S.P.Q. (BNA) 1089, 1092 (Fed. Cir. 1984).

⁸ See *Kingsdown Med. Consultants, Ltd. v. Hollister, Inc.*, 863 F.2d 867, 872, 9 U.S.P.Q.2d (BNA) 1384, 1389 (Fed. Cir. 1988).

⁹ *Molins*, 48 F.3d at 1178, 33 U.S.P.Q.2d at 1827.

¹⁰ See *N.V. Akzo v. E.I. DuPont de Nemours*, 810 F.2d 1148, 1153, 1 U.S.P.Q.2d (BNA) 1704, 1708 (Fed. Cir. 1987).

¹¹ See *LaBounty Mfg., Inc. v. United States Int'l Trade Comm'n*, 958 F.2d 1066, 1070, 22 U.S.P.Q.2d (BNA) 1025, 1028 (Fed. Cir. 1992).

¹² See *Kolmes v. World Fibers Corp.*, 107 F.3d 1534, 1541, 41 U.S.P.Q.2d (BNA) 1829, 1834 (Fed. Cir. 1997).

¹³ See, e.g., *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1582, 18 U.S.P.Q.2d (BNA) 1001, 1014-15 (Fed. Cir. 1991); see also *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 992, 6 U.S.P.Q.2d (BNA) 1601, 1609 (Fed. Cir. 1988).

¹⁴ 48 F.3d 1172, 33 U.S.P.Q.2d (BNA) 1823 (Fed. Cir. 1995).

¹⁵ The *Molins*' inventions were: "a method for improving batch machining involving a plurality of machine tools arranged to accommodate the manual transport of pallet-mounted workpieces to and from the machine tools" (the "batch process"); and "a fully automated machining system that allows several related families of parts to be machined simultaneously" (the "System 24"). *Id.* at 1175-76, 33 U.S.P.Q.2d at 1824.

¹⁶ Smith retained an interest in the patents because "Molins assigned a one-half interest in the patent applications to Smith in exchange for Smith's agreement to undertake further prosecution at his own expense. In July of 1988, Smith reassigned his interest in the patents to Molins. Smith remained entitled to one-half of all royalty income received by Molins from licenses under the patents entered into prior to July 1, 1988." *Id.* at 1176, 33 U.S.P.Q. 2d at 1825.

¹⁷ *Id.*, 33 U.S.P.Q.2d at 1825.

¹⁸ *Id.* at 1177, 33 U.S.P.Q.2d at 1825.

¹⁹ *Id.*

²⁰ *Id.* at 1181, 33 U.S.P.Q.2d at 1829.

²¹ *Id.*

²² *Id.* at 1181-82, 33 U.S.P.Q.2d at 1829.

²³ Id. at 1182, 33 U.S.P.Q.2d at 1829.

²⁴ Id., 33 U.S.P.Q.2d at 1830.

²⁵ Id.

²⁶ See *id.*

²⁷ Id.

²⁸ Id. at 1187, 33 U.S.P.Q.2d at 1834.

²⁹ Id.

³⁰ Id.

³¹ 149 F.3d 1321, 47 U.S.P.Q.2d (BNA) 1225 (Fed. Cir. 1998) (“Baxter II.”) The district court opinion is reported at 958 F. Supp. 1313 (N.D. Ill. 1997) (“Baxter I”); see *infra* note 37 and accompanying text).

³² 922 F.2d 801, 17 U.S.P.Q.2d (BNA) 1577 (Fed. Cir. 1990).

³³ See *id.* at 803-04, 17 U.S.P.Q.2d at 1581; *Driscoll v. Cebalo*, 731 F.2d 878, 885, 221 U.S.P.Q. (BNA) 745, 751 (Fed. Cir. 1984).

³⁴ Baxter II, 149 F.3d at 1332, 47 U.S.P.Q.2d at 1233.

³⁵ Id. at 1324-25, 47 U.S.P.Q.2d at 1226.

³⁶ Id. at 1325, 47 U.S.P.Q.2d at 1227.

³⁷ See *Baxter Int’l Inc. v. McGaw, Inc.*, 958 F. Supp. 1313 (N.D. Ill. 1997) (“Baxter I”).

³⁸ Id. at 1315-16.

³⁹ Id. at 1316 (citing *Fox Indus., Inc. v. Structural Preservation Sys., Inc.*, 922 F.2d 801, 803, 17 U.S.P.Q.2d (BNA) 1577, 1581 (Fed. Cir. 1990)).

⁴⁰ See *id.* at 1316-17.

⁴¹ Baxter II, 149 F.3d at 1332, 47 U.S.P.Q.2d at 1233.

⁴² *Id.* at 1331, 47 U.S.P.Q.2d at 1232.

⁴³ *Fox*, 922 F.2d at 804, 17 U.S.P.Q.2d at 1581 (emphasis added); see also *Driscoll v. Cebalo*, 731 F.2d 878, 885, 221 U.S.P.Q. (BNA) 745, 751 (Fed. Cir. 1984) (“[A]n applicant who ... has withheld from the PTO prior art material to a claim in a parent application should not be exculpated simply because, by fortuitous circumstances, the PTO has not reached the stage of allowing claims in a continuing application.”).

⁴⁴ *Baxter II*, 149 F.3d at 1331, 47 U.S.P.Q.2d at 1232.

⁴⁵ *Id.*

⁴⁶ *Id.* at 1332, 47 U.S.P.Q.2d at 1233 (citing *Fox*, 922 F.2d at 803, 17 U.S.P.Q.2d at 1581).

⁴⁷ *Id.* (citations omitted).

⁴⁸ See *id.* at 1334, 47 U.S.P.Q. 2d at 1235.

⁴⁹ *J.P. Stevens & Co. Inc. v. Lex Tex Ltd., Inc.*, 747 F.2d 1553, 223 U.S.P.Q. (BNA) 1089 (Fed. Cir. 1984); see also *Tool-O-Matic Inc. v. Proma Produkt-Und Marketing Gesellschaft*, 945 F.2d 1546, 1553, 20 U.S.P.Q.2d (BNA) 1332 (Fed. Cir. 1991).

⁵⁰ See *supra* note 13.

⁵¹ See, e.g., *Halliburton Co. v. Schlumberger Technology Corp.*, 925 F.2d 1435, 1439-40, 17 U.S.P.Q.2d (BNA) 1834, 1841 (Fed. Cir. 1991).

⁵² *Hoffman-La Roche Inc. v. Lemmon Co.*, 906 F.2d 684, 688, 15 U.S.P.Q.2d (BNA) 1363, 1366 (Fed. Cir. 1990).

⁵³ See *Kingsdown Med. Consultants Ltd. v. Hollister Inc.*, 863 F.2d 867, 872, 9 U.S.P.Q.2d (BNA) 1384, 1389 (Fed. Cir. 1988) (en banc).

⁵⁴ See *id.*, 9 U.S.P.Q.2d at 1389.

⁵⁵ *Burlington Indus., Inc. v. Davco Corp.*, 849 F.2d 1418, 1422, 7 U.S.P.Q.2d (BNA) 1158, 1161 (Fed. Cir. 1988).

⁵⁶ 908 F.2d 931, 15 U.S.P.Q.2d (BNA) 1321 (Fed. Cir. 1990).

⁵⁷ *Id.* at 939, 15 U.S.P.Q.2d at 1329.

⁵⁸ *Id.* (citations omitted).

⁵⁹ *Akzo N.V. v. E.I. DuPont de Nemours*, 635 F. Supp. 1336, 1356, 230 U.S.P.Q. (BNA) 263, 278 (E.D. Va. 1986), aff’d, 810 F.2d 1148, 1 U.S.P.Q.2d (BNA) 1704 (Fed. Cir. 1987).

⁶⁰ 863 F.2d 867, 9 U.S.P.Q.2d (BNA) 1384 (Fed. Cir. 1988).

⁶¹ *Id.* at 876, 9 U.S.P.Q.2d at 1389.

⁶² 798 F.2d 1392, 230 U.S.P.Q. (BNA) 849 (Fed. Cir. 1986).

⁶³ *Id.* at 1397-98, 230 U.S.P.Q. at 853-854 (Fed. Cir. 1986).

⁶⁴ See 37 C.F.R. § 1.56 (1999) (effective March 16, 1992).

⁶⁵ *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1582, 18 U.S.P.Q.2d (BNA) 1001, 1015 (Fed. Cir. 1991).

⁶⁶ See *Gemveto Jewelry Company, Inc. v. Lambert Bros., Inc.*, 542 F. Supp. 933, 216 U.S.P.Q. (BNA) 976 (S.D.N.Y. 1982) (patent held invalid or unenforceable because patentee's foreign counsel did not disclose to patentee's U.S. counsel or to the PTO prior art cited by the Dutch Patent Office in connection with the patentee's corresponding Dutch application).

⁶⁷ *Id.* at 943, 216 U.S.P.Q. at 985.

⁶⁸ See *id.* at 939, 216 U.S.P.Q. at 980 (discussing Rule 37 C.F.R. § 1.56).

⁶⁹ M.P.E.P. § 2004 (7th ed., 1998)

⁷⁰ See Dale L. Carlson, *The Best Mode Disclosure Requirement in Patent Practice*, 60 J. Pat. Off. Soc'y 171 (1978).

⁷¹ 35 U.S.C. § 31 (1994) (emphasis added).

⁷² 35 U.S.C. § 32 (1994).

⁷³ 37 C.F.R. § 10.7 (1999).

⁷⁴ 37 C.F.R. § 10.4(a) (1999).

⁷⁵ See *id.*

⁷⁶ 37 C.F.R. § 10.4(b) (1999).

⁷⁷ See *id.*

⁷⁸ 37 C.F.R. §§ 10.130-10.170 (1999).

⁷⁹ 37 C.F.R. § 10.156(b) (1999).

⁸⁰ See 37 C.F.R. § 10.160(a) (1999).

⁸¹ 37 C.F.R. § 10.160(b) (1999).

⁸² 37 C.F.R. § 10.160(c)(1) (1999).

⁸³ See 37 C.F.R. §§ 10.130-10.170 (1999).

⁸⁴ *Id.*

⁸⁵ 37 C.F.R. § 10.133(a) (1999).

⁸⁶ 37 C.F.R. § 10.133(b) (1999).

⁸⁷ See 37 C.F.R. § 10.133(c) (1999).

⁸⁸ 37 C.F.R. § 10.149 (1999).

⁸⁹ 37 C.F.R. § 10.150(a) (1999).

⁹⁰ 37 C.F.R. § 10.151(a) (1999).

⁹¹ 37 C.F.R. § 10.152(a) (1999).

⁹² 37 C.F.R. § 10.152(b)(1) (1999).

⁹³ 37 C.F.R. § 10.152(e) (1999).

⁹⁴ *Weiffenbach v. Logan*, 27 U.S.P.Q.2d (BNA) 1870 (Comm'r Pat. 1993).

⁹⁵ See *id.* at 1877, 1878.

⁹⁶ *Id.* at 1878.

⁹⁷ 174 F.3d 1363, 50 U.S.P.Q.2d (BNA) 1490 (Fed. Cir. 1999).

⁹⁸ Unreported proceeding.

⁹⁹ In re Klein, 6 U.S.P.Q.2d 1528 (Dept. Comm. A.L.J. 1986).

¹⁰⁰ See *id.* at 1546.

¹⁰¹ See *id.* at 1530.

¹⁰² See *id.* at 1545.

¹⁰³ See *id.* at 1545-46.

¹⁰⁴ See *id.* at 1547.

¹⁰⁵ See *id.*

¹⁰⁶ In re Klein, 6 U.S.P.Q.2d 1547 (Comm'r Pat. 1987).

¹⁰⁷ See *id.* at 1556.

¹⁰⁸ See *id.*

¹⁰⁹ See *id.*

¹¹⁰ *Id.*

¹¹¹ *Id.*

¹¹² Klein v. Peterson, 696 F. Supp. 695, 8 U.S.P.Q.2d (BNA) 1434 (D.D.C. 1988).

¹¹³ See *id.* at 696-97, 8 U.S.P.Q. 2d at 1435.

¹¹⁴ *Id.* at 696, 8 U.S.P.Q.2d at 1435.

¹¹⁵ *Id.* at 697, 8 U.S.P.Q.2d at 1435 (citations omitted).

¹¹⁶ *Id.*

¹¹⁷ *Id.* (citing Silverman v. CFTC, 549 F.2d 28, 33 (7th Cir. 1977)).

¹¹⁸ *Id.* (citing Withrow v. Larkin, 421 U.S. 35, 46 (1975)).

¹¹⁹ Id. at 698, 8.U.S.P.Q.2d at 1436 (citation omitted).

¹²⁰ See *id.*

¹²¹ *In re Klein*, 16 U.S.P.Q.2d 1965 (Comm'r Pat. 1990).

¹²² Id. at 1966.

¹²³ *Id.*

¹²⁴ *Id.*

¹²⁵ 27 U.S.P.Q.2d 1870 (Comm'r Pat. 1989).

¹²⁶ Id. at 1871.

¹²⁷ *Id.* at 1873.

¹²⁸ *Id.* at 1872.

¹²⁹ See *id.* at 1874.

¹³⁰ *Id.*

¹³¹ *Id.*

¹³² *Id.* at 1876.

¹³³ *Id.*

¹³⁴ *Id.*

¹³⁵ *Id.*

¹³⁶ *Id.*

¹³⁷ *Id.* at 1877 (citing *United States v. Cheramie Bo-Truc No. 5, Inc.*, 538 F.2d 696 (5th Cir. 1976)).

¹³⁸ See *id.* at 1880.

¹³⁹ 48 F.3d 1172, 33 U.S.P.Q.2d (BNA) 1823 (Fed. Cir. 1995).

¹⁴⁰ 822 F.2d 1053, 3 U.S.P.Q.2d (BNA) 1294 (Fed. Cir. 1987).

¹⁴¹ *Id.* at 1059-61, 3 U.S.P.Q.2d at 1299-1301.

¹⁴² *Id.* at 1061, 3 U.S.P.Q.2d at 1301.

¹⁴³ See *id.*

¹⁴⁴ *Id.* at 1059, 3 U.S.P.Q.2d at 1299.

¹⁴⁵ 32 F. Supp. 2d 1 (D.D.C. 1998).

¹⁴⁶ *Id.* at 3.

¹⁴⁷ See *id.*

¹⁴⁸ See *id.* at 3-5.

¹⁴⁹ See *id.* at 5, 10.

¹⁵⁰ *Id.* at 5; see also 35 U.S.C. § 32 (1998).

¹⁵¹ Marinangeli, 32 F. Supp. 2d at 5 (citing *Camp v. Pitts*, 411 U.S. 138, 141 (1973) (citation omitted)); see also *Friedman v. Lehman*, 40 U.S.P.Q.2d (BNA) 1206 (D.D.C. 1996) (stating that the standard of review for sanctions imposed by the Commissioner is arbitrary and capricious and is based on an existing administrative record).

¹⁵² See *Marinangeli*, 32 F. Supp. 2d at 6.

¹⁵³ 37 C.F.R. § 10.154(b) (1999).

¹⁵⁴ *Marinangeli*, 32 F. Supp. 2d at 5 (citation omitted).

¹⁵⁵ *Id.* at 6 (citing *In re Ruffalo*, 390 U.S. 544, 546 (1968) (a state disbarment order is not “conclusively binding on the federal courts.”); *Koden v. United States Dep’t of Justice*, 564 F.2d 228, 232 (7th Cir. 1977) (“It is elementary that any court or administrative agency which has the power to admit attorneys to practice has the authority to disbar or discipline attorneys for unprofessional conduct.”)).

¹⁵⁶ *Id.*

¹⁵⁷ *Id.* at 9.

¹⁵⁸ Id.

¹⁵⁹ Id. (citing *Cleburne v. Cleburne Living Center*, 473 U.S. 432, 439, 105 S. Ct. 3249, 87 L.Ed.2d 313 (1985); *Brandon v. District of Columbia Bd. of Parole*, 823 F.2d 644, 650 (D.C. Cir. 1987)).

¹⁶⁰ Id.

¹⁶¹ Id. at 6.

¹⁶² Id.

¹⁶³ Id.

¹⁶⁴ Id. (citing *Florida Bar v. Davis*, 657 So.2d 1135, 1137 (Fla. 1995) (seriousness of crime of accepting bribes by a judicial officer outweighs mitigation of alcoholism); *Ridge v. State Bar of Cal.*, 47 Cal. 3d 952, 254 Cal. Rptr. 803, 766 P.2d 569, 573 (Cal. 1989) (misconduct of trust account funds warrants discipline “notwithstanding petitioner’s alcoholism”); *In re Hopmayer*, 625 A.2d 290, 292 (D.C. 1993) (attorney must be disbarred for crimes involving moral turpitude “regardless of any mitigating factors such as alcoholism”)).

¹⁶⁵ 174 F.3d 1363, 50 U.S.P.Q.2d (BNA) 1490 (Fed. Cir. 1999).

¹⁶⁶ See *id.* at 1365, 50 U.S.P.Q.2d at 1491.

¹⁶⁷ See *id.*

¹⁶⁸ See *id.*, 50 U.S.P.Q.2d at 1492.

¹⁶⁹ See *id.* at 1366, 50 U.S.P.Q.2d at 1492.

¹⁷⁰ See *id.* at 1367, 50 U.S.P.Q.2d at 1493.

¹⁷¹ See *id.* at 1372-73, 50 U.S.P.Q.2d at 1497.

¹⁷² *Id.* at 1372, 50 U.S.P.Q.2d at 1497.

¹⁷³ *Id.* at 1373, 50 U.S.P.Q.2d at 1498.

¹⁷⁴ *Id.*

¹⁷⁵ *Id.* at 1374, 50 U.S.P.Q.2d at 1498.

¹⁷⁶ Id. at 1374-75, 50 U.S.P.Q.2d at 1499.

¹⁷⁷ The opinion points out that “Mr. Ruff, among other distinctions, had been Acting Deputy Attorney General of the United States and Chief Inspector for the Drug Enforcement Administration.” Id. at 1374, 50 U.S.P.Q.2d at 1498. “Mr. Silbert has been Chairman of the Committee of Grievances of the United States District Court for the District of Columbia, Chairman of the Ethics in Government Act of the American Bar Association White Collar Crime Committee, and Chairman of the Hearing Committee for the Board of Professional Responsibility in the District of Columbia.” Id.

¹⁷⁸ Id.

¹⁷⁹ Id.

¹⁸⁰ Id., 50 U.S.P.Q.2d at 1498-99.

¹⁸¹ Id., 50 U.S.P.Q.2d at 1499.

¹⁸² Id. at 1375, 50 U.S.P.Q.2d at 1499 (citing *State v. Jackson*, 162 Conn. 440, 294 A.2d 517, 523 (Conn.1972)).

¹⁸³ Id.

¹⁸⁴ See *supra* note 99 and accompanying text.

¹⁸⁵ 74 F. Supp. 2d 253, 53 U.S.P.Q.2d (BNA) 1021 (E.D.N.Y. 1999).

¹⁸⁶ Id. at 256, 53 U.S.P.Q.2d at 1022.

¹⁸⁷ Id. at 256-57, 53 U.S.P.Q.2d at 1022-23.

¹⁸⁸ Id. at 256, 53 U.S.P.Q.2d at 1022.

¹⁸⁹ See *id.* at 256-57, 53 U.S.P.Q.2d at 1022-23.

¹⁹⁰ See *id.* at 258, 53 U.S.P.Q.2d at 1024.

¹⁹¹ Id. at 260, 53 U.S.P.Q.2d at 1025.

¹⁹² Id. at 261, 53 U.S.P.Q.2d at 1026.