

2022-1420

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**UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT**

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**KEVIN P. CORRELL,**  
*Plaintiff-Appellant,*

**v.**

**ANDREW HIRSHFELD, PERFORMING THE FUNCTIONS AND  
DUTIES OF THE UNDER SECRETARY OF COMMERCE FOR  
INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED  
STATES PATENT AND TRADEMARK OFFICE,**  
*Defendant-Appellee,*

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Appeal from United States District Court for the Eastern District of Virginia in Case  
No. 1:21cv898, Judge Anthony J. Trenga

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**OPPOSITION TO PLAINTIFF-APPELLANT'S EMERGENCY MOTION  
TO STAY AGENCY ACTION**

## **INTRODUCTION**

Nearly 170 years ago, in the wake of the Civil War, Congress – concerned about skepticism from the Nation about the integrity of the decisions that the federal government made to grant benefits to particular individuals and entities – promulgated a statute that prohibited federal employees from representing others in proceedings before the same government that employed them. Despite knowing of these prohibitions, Kevin Correll violated them approximately 300 times over a span of fifteen years, providing legal representation for a substantial fee in proceedings before the United States Patent and Trademark Office (“USPTO”) to private clients who sought personal patent and trademark protection while employed by the United States Department of the Navy.

After administrative disciplinary proceedings resulted in Correll’s suspension from practice before the USPTO for sixty months, Correll requested Article III judicial review of that suspension. Correll immediately sought a preliminary injunction staying his suspension pending the completion of judicial review. The District Court denied Correll’s request for this form of “extraordinary relief,” holding that Correll was not likely to succeed on his position that the suspension ran afoul of the First Amendment. Correll now asks this Court to enter his sought injunction on an emergency basis.

This Court should deny the motion. Correll cannot come close to bearing his heavy burden of showing that he is ultimately likely to succeed in obtaining reversal of

both the USPTO's disciplinary decision and the District Court's affirmance of the same. As the District Court correctly held, Correll's primary argument is without merit; *i.e.*, that application of the aforementioned conflict of interest statutes to his representation of private clients for a fee in proceedings before the USPTO while employed by the federal government runs afoul of his First Amendment rights. The limitations on Correll's speech and association activity from these statutes are minimal, as he is free to speak on any topic (including patent and trademark regulation), in any form (speeches, journal articles), to any audience (federal courts, state and local government agencies, interest groups) save *one*: the representation of private interests in specific business before the federal Executive Branch. And the government's interest in preventing even the appearance of impropriety is extremely strong.

## **STATEMENT OF THE CASE**

### **I. PROFESSIONAL REGULATION OF PRACTICE BEFORE THE USPTO**

Through two separate statutory provisions, Congress has vested the USPTO with the authority to promulgate regulations “govern[ing] the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Office.” 35 U.S.C. § 2(b)(2)(D); *see also id.* § 32 (providing that the USPTO “may . . . suspend or exclude . . . from further practice before the Patent and Trademark Office, any person, agent, or attorney . . . who does not comply with the regulations established under § 2(b)(2)(D)”). The USPTO has thus promulgated a number of

regulations governing who may engage in practice concerning matters that are before the agency and how that practice is to be undertaken. *See* 37 C.F.R. §§ 10.10-10.112 (2012); 37 C.F.R. §§ 11.101-.901 (2020). Of premier importance here, the USPTO Code and Rules provide that any “practitioner who is a former or current Federal Government employee” may not “engage in any conduct which is contrary to applicable Federal ethics law, including *conflict of interest statutes*.” *Id.* § 11.111 (emphasis added); *see also id.* § 10.10(d) (2002).

For well over a century, Congress has repeatedly expressed – through legislation – its ongoing concern about the appearance of impropriety that arises when an employee of the United States advocates before a federal agency on behalf of a private individual or entity’s interests. First, in 1853, Congress passed a statute that precluded federal employees from assisting private individuals or entities in “prosecuting” claims against the United States. *See Van Ee v. EPA*, 202 F.3d 296, 305 (D.C. Cir. 2000) (discussing former 18 U.S.C. § 283). But after a series of “high-profile procurement scandals” resulted in a significant public outcry, Congress promulgated stronger conflict of interest prohibitions in order to confirm that having a federal employee in one’s proverbial “corner” could not provide any additional assistance in their business with the government. *Id.* at 305-06 & n.10. To this end, in 1864, Congress prohibited federal employees from receiving any “compensation for any services rendered . . . in relation to any proceeding, contract, claim, controversy, charge, accusation, arrest, or other matter or thing” in which the United States had an

interest. *Id.* at 306 & n.11 (discussing former 18 U.S.C. § 281). The essence of this latter proscription has remained in force until the present day.

After the size of the federal government grew, Congress strengthened these statutes, concluding that “recent years ha[d] recorded a growing concern . . . with the ever present and perplexing problem of how best to assure high-ethical standards in the conduct of the Federal Government.” H.R. RPT. 87-748, at 2 (July 20, 1961). Congress specifically explained that it was necessary “to protect the integrity of Government actions by preventing its employees from using actual or supposed influence in support of private causes.” *Id.* at 21.

Congress thus promulgated two new statutes, which were subsequently codified at 18 U.S.C. §§ 203 and 205. Initially, § 203 replaced the former § 281, and generally prohibits federal employees from receiving any compensation “for any representational services . . . rendered” with respect to:

[A]ny proceeding, *application*, request for a ruling or other determination, contract, claim, controversy . . . or other particular matter in which the United States is a party or has a direct and substantial interest, before any department, agency, court, court-martial, officer, or any civil, military, or naval commission.

18 U.S.C. § 203(a)(1) (emphasis added). And in a new statutory section, Congress prohibited federal employees from “act[ing] as agent or attorney for anyone before any department, agency, court, court-martial, officer, or civil, military, or naval commission in connection with any covered matter in which the United States is a party or has a direct and substantial interest,” regardless of whether they receive

compensation. 18 U.S.C. § 205(a). The statute defines “covered action” to include “any judicial or other proceeding, application, request for a ruling or other determination . . . or other particular matter.” *Id.* § 205(h).

The Attorney General of the United States and the Office of Government Ethics have concluded that the USPTO’s examination of an application for a patent or trademark registration fits well within §§ 203 and 205’s prohibitions. *See Government Employees Prosecuting Claims for Patent*, 41 U.S. Op. Atty. Gen. 21, 22 (July 18, 1949); *OGE Advisory Op.*, 2001 WL 34091910, at \*1-2 (Mar. 14, 2001).

## II. FACTUAL BACKGROUND

### A. CORRELL’S FEDERAL EMPLOYMENT & COLLATERAL LEGAL PRACTICE

In 1999 and 2000, respectively, Kevin Correll was admitted to the bar of Massachusetts, and was registered with the USPTO as a patent attorney. Ex31-32.

1. In September 2002, Correll accepted a position of federal employment with the United States Department of the Navy. Ex32. Between 2002 and 2017, Correll served as an electrical engineer with the Naval Undersea Warfare Center (“NUWC”) of the Naval Sea Systems Command, in Newport, Rhode Island. Ex34-35. During most of his Naval employment, one of Correll’s collateral duties was to serve as a voting member of NUWC’s Invention Examination Board (“IAB”). Ex113. In that role, Correll reviewed technologies purportedly created at NUWC, assisted in determining whether the invention in question belonged to the Navy, and made

recommendations as to those technologies on which NUWC should seek patent protection with the USPTO. *Id.*

2. Also in September 2002, at nearly the same time that he accepted and commenced his federal employment with the Navy, Correll started his own private law firm in Rhode Island. Ex35. That firm, which appears active today, provided legal services in patent and trademark matters to the public. Correll received compensation for his legal services. Ex141-42.

Correll continued his paid legal work on behalf of private clients before the USPTO throughout his tenure as a federal employee with the Navy. In fact, between 2002 and October 25, 2017, Correll filed and/or prosecuted 211 patent applications with the USPTO, and 80 trademark registration applications, on behalf of private clients. Ex116-18.

3. In 2003, the USPTO transmitted a survey to all individuals who were, at that time, registered to practice before the agency in patent-related matters. Ex213. The survey provided a reminder that federal statute precluded federal employees from representing private clients before the USPTO:

6. <input checked="" type="checkbox"/> YES <input type="checkbox"/> NO Are you an employee of the United States Government? PLEASE NOTE: U.S. Government employees are not available to accept private clients or to represent clients other than their agency before the United States Patent and Trademark Office. 18 U.S.C. § 205; 37 CFR § 10.10(c) and (d).	
7. <input type="checkbox"/> YES <input checked="" type="checkbox"/> NO Are you a former patent examiner of the United States Patent and Trademark Office?	
FOR UNITED STATES PATENT AND TRADEMARK OFFICE USE ONLY  AGENT: _____  ATTORNEY: _____ 12/12  (See reverse side of form for Privacy Act Statement)	I certify that each and every statement or representation in this Data Sheet is true and accurate (a willfully false certification is a criminal offense and is punishable by law [18 U.S.C. §. 1001]).  <div style="display: flex; justify-content: space-between;"> <div style="width: 60%;">  </div> <div style="width: 35%; text-align: right;">           11/25/03            Date         </div> </div>
Signature of Practitioner	

*Id.* Correll signed the form and returned it to the USPTO. *Id.* But Correll ignored the reminder, and continued to represent private clients before the USPTO during his federal employment; in fact, the vast majority of Correll’s representation of private clients occurred *after* he received this reminder. Nor did Correll seek clarification from the USPTO about the propriety of his representation or present – as he does here – a First Amendment challenge in an Article III court to the application of the federal conflict of interest statutes to his representation of private clients.

## **II. DISCIPLINARY PROCEEDINGS**

At some point in 2016, Correll’s Navy supervisor transmitted an electronic mail message to USPTO’s Office of Enrollment and Discipline (“OED”), informing the agency that Correll was prosecuting applications on behalf of private clients in violation of federal statute. Ex7. Based on this information, on February 9, 2017, OED opened an investigation into Correll’s conduct. *Id.*

1. On January 17, 2018, after the conclusion of its investigation, the OED Director filed a disciplinary complaint against Correll. Ex1-30. The complaint was assigned to an Administrative Law Judge (“ALJ”).

Also in May 2018, OED filed a motion seeking summary judgment. Ex71. On September 28, 2018, the ALJ granted that motion in part, concluding that Correll had engaged in conduct that was in violation of the federal conflict of interest statutes, *see* 18 U.S.C. §§ 203; 205, and thus “ultimately [was in] violation of the [US]PTO Code and [US]PTO Rules.” Ex70-96. The ALJ rejected Correll’s argument that the



application of the federal conflict of interest statutes to his representation of private clients before the USPTO ran afoul of the First Amendment. Ex84-86. Ultimately, the ALJ issued an initial decision, in which she concluded that Correll should be suspended from practice before the USPTO for a period of sixty months. Ex149-187.

2. Correll appealed the ALJ's initial decision to the USPTO Director. Ex188. On February 4, 2021, the USPTO Director issued a detailed final order in Correll's disciplinary proceedings, which affirmed the ALJ's initial decision in full. Ex188-212. After reviewing the factual record of Correll's conduct, the USPTO Director concluded that the First Amendment did not preclude Congress – and the USPTO, in turn – from prohibiting federal employees from representing private interests in matters before federal agencies. Ex203-208. The USPTO Director noted that the proscriptions of §§ 203 and 205 did not place an onerous burden on Correll's protected speech, as he remained free to speak on issues related to patent and trademark regulation, and could represent private interests on a virtually limitless series of legal issues (including patent and trademark law), so long as that representation was not specifically before or against a federal agency. *Id.* And on the other side of the balancing equation, the USPTO Director explained that Congress served several compelling interests in precluding actual and potential conflicts of interest that arise when federal employees represent private interests before the same

government that employs them – *e.g.*, preventing the use of inside information and maintaining the nation’s confidence in the fairness of agency proceedings. *Id.*

3. Correll sought Article III judicial review of the USPTO’s final order of discipline in the District Court pursuant to 35 U.S.C. § 32. R.1. In the District Court, Correll filed what amounted to a motion for a preliminary injunction, seeking a stay of his disciplinary suspension pending the completion of the District Court’s review, R.2-3.

On January 13, 2022, the District Court entered an order denying Correll’s motion. Ex214-218. *First*, the District Court conducted a detailed evaluation of Correll’s claim that his suspension violated the First Amendment and concluded that Correll had “failed to make the required showing that he is likely to succeed on the merits of his claim.” Ex216-217. More specifically, the District Court recognized that under the federal conflict of interest statutes, Correll remained “free to speak on patent and trademark matters . . . in speeches, written blogs, and even representing private clients at the state and local level,” and that in promulgating the conflict of interest statutes, Congress evinced its “concern[] with avoiding even the appearance of impropriety because even this can erode public trust in the integrity and legitimacy of government decision-making.” *Id.* Accordingly, the District Court rejected Correll’s First Amendment argument:

In assessing these various interests, the Court concludes that under the *Pickering* balancing test, [Correll’s] First Amendment rights were not violated because there was no significant burden on [his] First Amendment rights and the

government's interest substantially outweighs whatever burden was placed on [Correll's] First Amendment rights.

Ex.217. *Second*, noting that Correll's ability to make "the required showing that he is likely to suffer irreparable harm in the absence of injunctive relief" was co-extensive with the merit of his First Amendment argument, the District Court similarly denied Correll preliminary injunctive relief on that basis. *Id.*

This appeal ensued. Shortly after noticing his appeal, Correll filed an "Emergency Motion to Stay" the USPTO's suspension.

## **ARGUMENT**

### **I. STANDARD OF REVIEW**

This Court is authorized to issue an injunction pending appeal, even in instances in which the District Court did not do so in the first instance. *See* FED. R. APP. P. 8(a)(2). But this Court has explained that such an injunction is "extraordinary relief." *See, e.g., Duramed Pharms., Inc. v. Watson Labs, Inc.*, 426 Fed. Appx. 905, 906 (Fed. Cir. 2011). To this end, this Court has held that its "determination is governed by four factors, the first two of which are the most critical: (1) whether the stay applicant had made a strong showing that he is likely to succeed on the merits; (2) whether the applicant will be irreparably injured absent relief; (3) whether issuance of the order will substantially injure the other parties interested in the proceeding; and (4) where the public interest lies." *Celsis in Vitro, Inc. v. CellzDirect, Inc.*, 428 Fed. Appx. 987, 987 (Fed. Cir. 2011) (citing *Hilton v. Braunskill*, 481 U.S. 770, 776 (1987)). The

party seeking the stay – here, Correll – bears the heavy burden of demonstrating that these factors weigh in favor of an extraordinary injunction. *Id.*

## II. CORRELL HAS NOT COME CLOSE TO BEARING HIS HEAVY BURDEN TO DEMONSTRATE ENTITLEMENT TO EXTRAORDINARY RELIEF

### A. CORRELL CANNOT DEMONSTRATE A STRONG LIKELIHOOD OF SUCCESS ON THE MERITS

As the District Court correctly concluded, Correll cannot demonstrate any likelihood of success on the merits of his challenge to the USPTO’s suspension (or the District Court’s denial of preliminary injunctive relief), let alone the *strong* likelihood necessary to justify the type of extraordinary relief that he requests here.

1. This Court does not review the USPTO’s suspension decision *de novo*; to the contrary, the Director’s final order can *only* be reversed if it is “arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law.” *Bender*, 490 F.3d at 1365-66. The scope of review under this standard is “narrow” and “a court is not to substitute its judgment for that of the agency.” *Motor Vehicle Mfrs. Ass’n v. State Farm Mut. Auto. Ins. Co.*, 463 U.S. 29, 43 (1983). “If [the USPTO] has considered the relevant evidence of record, drawn plausible inferences and articulated a rational basis for the decision, reversible error will be extremely difficult to demonstrate.” *Cornish v. Dudas*, 715 F. Supp. 2d 56, 63 (D.D.C. 2010) (quoting *Hines on Behalf of Sevier v. Sec’y*, 940 F.2d 1518, 1528 (Fed. Cir. 1991)).

2. Correll concedes that his representation of private individuals and entities before a federal agency for significant fees, while simultaneously working as a federal

employee, violated the prohibitions contained with the federal conflict of interest statutes (*i.e.*, 18 U.S.C. §§ 203; 205). Correll similarly concedes that these statutory violations, in turn, violate the USPTO Code and Rules, and are thus grounds for disciplinary sanction. The only substantive argument that Correll offers in favor of reversal is that applying the federal conflict of interest statutes to his conduct violates the First Amendment. *Motion*, at 4-13. And thus, Correll’s argument – on which he has the burden of making a “strong showing” of likely success – is that a statutory prohibition that has guided the obligations of federal employees for nearly *170 years* is unconstitutional as applied to his desire to continue receiving a federal salary while simultaneously accepting compensation for providing legal representation to private clients with respect to specific applications before a federal agency. Simply to state the proposition is to demonstrate its error.

a. Initially, the Supreme Court has recognized that although federal employees do not forfeit all of their First Amendment protection merely by accepting federal employment, the government can “regulate the speech of its employees” without running afoul of the Constitution in ways it could not “in connection . . . with the speech of the citizenry in general.” *Pickering*, 391 U.S. at 568. When confronted with a constitutional challenge to such restrictions, courts must:

arrive at a balance between the interests of the [employee], as a citizen, in commenting upon matters of public concern and the interest of the [government], as employer, in promoting the efficiency of the public services it performs through its employees.

*Id.*; see also *Briggs v. MSPB*, 331 F.3d 1307, 1314 (Fed. Cir. 2003) (noting that *Pickering* established a “flexible balancing test”). This framework “requires only an appropriate balancing of the pertinent interests, not what courts might consider an optimum balance.” *Briggs*, 331 F.3d at 1316.

i. On the first side of the constitutional ledger, there can be little doubt that the restriction on Correll’s First Amendment activity (or association) occasioned by the application of §§ 203 and 205 to his paid representation of private clients before the USPTO with respect to their own personal patent and trademark applications, while not entirely non-existent, is minimal.<sup>1</sup> In particular, unlike broad bans that courts have rejected under *Pickering*, see *United States v. NTEU*, 513 U.S. 454, 466-69 (1995), the application of §§ 203 and 205 here merely precludes Correll from “speaking” to a single audience (*i.e.*, federal agencies) in one specific context (*i.e.*, representation of private clients). Correll remains free to engage the remaining public at large on patent and trademark issues or any subject whatsoever, including, *inter alia*, giving speeches, writing journal articles or blog posts, or even representing private clients (for a fee or *pro bono*) before courts or state and local government agencies, so long as he is not

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<sup>1</sup>Correll repeatedly notes that his representational efforts are on matters “of public concern.” *Motion*, at 6-7. And although the USPTO concurs with the notion that intellectual property questions present issues of “public concern,” it bears mentioning that Correll seeks here not to debate the academic points of patent and trademark regulation, but to accept paying clients for private representation and advocacy in favor of private intellectual property interests before the USPTO.

doing so in suits involving the USPTO. The proscriptions contained within §§ 203 and 205 – especially as applied to Correll’s conduct – thus do not “impose [the type of] significant burden on the public’s right to read and hear what the employees would otherwise have written and said” that the courts have held to be constitutionally problematic. *Id.* at 470.<sup>2</sup>

ii. On the other side of the ledger, however, the United States’ interests in precluding conflicts of interest – both actual and apparent – is strong. As stated earlier, Congress promulgated §§ 203 and 205 in order to quell rising threats to the integrity of government decisionmaking.

Contrary to Correll’s myopic view, *Motion*, 6-8; 10-13, the government’s interest “in avoiding conflicts of interest, or even the appearance of impropriety, do not appear to require that either an actual or apparent conflict of interest exist in fact in order for restrictions on political activity of public employees to apply consistent with the First Amendment.” *Loftus v. Bolizien*, 848 F.3d 278, 287 (4<sup>th</sup> Cir. 2017). Indeed, the *Pickering* balancing analysis – when potential conflicts of interest are implicated – does not require that the speech in question “actually caused any inefficiencies in the workplace”; instead, “that an adverse effect was ‘reasonably to be apprehended,’”

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<sup>2</sup>Correll criticizes this position, citing to this Court’s decision in *In re Tam*, 808 F.3d 1321 (Fed. Cir. 2015) (en banc), *aff’d*, 137 S. Ct. 1744 (2017). *Motion*, at 8. But *Tam* dealt with a statutory restriction on First Amendment activity that constituted viewpoint discrimination, and thus was subjected to strict scrutiny – an analytical framework a universe away from the *Pickering* balancing analysis applicable here. *See id.* at 1339-40.

such as “the potential for conflict,” is sufficient. *Id.* at 289. Nor is the prospect of a conflict of interest in these circumstance mere conjecture, imagined by the USPTO in response to Correll’s actions. As Congress itself found in enacting §§ 203 and 205, the representation of private interests before federal agencies by those simultaneously employed by the same government leads to an impression that the private individual or entity is obtaining beneficial treatment before a government decisionmaker. *See* H.R. RPT. 87-748, at 21 (July 20, 1961). That impression undeniably weakens public confidence in the legitimacy and integrity of government decisionmaking, which is critical for a working democracy:

If the people are persuaded that public officials use their office unfairly and for personal gain rather than public advantage, [then] government by consent of the governed and voluntary compliance with government orders become virtually unattainable.

Association of the Bar of the City of New York, CONFLICT OF INTEREST AND THE FEDERAL SERVICE 7 (1960). Congress thus has a substantial interest in precluding even the appearance that a private interest can obtain a benefit in their dealings with federal agencies simply by obtaining representation from a federal employee.

c. The only reported decision to analyze thoroughly the First Amendment implications of the federal conflict of interest statutes – to undersigned counsel’s knowledge – is *Van Ee v. EPA*, 55 F. Supp. 2d 1 (1999), *rev’d on other grounds*, 202 F.3d 296 (D.C. Cir. 2000). In *Van Ee*, an EPA employee asserted a First Amendment challenge to the application of § 205 to prevent him from *volunteering* his time to assist



environmental interest groups in making presentations to other federal agencies on broad policy issues. *See id.* at 2-4.

The District Court rejected the challenge, holding that § 205 – even as applied to the employee’s broad volunteer efforts – passed muster under the *Pickering* framework. *See id.* at 8-16. Initially, as the ALJ and the USPTO correctly concluded here, the *Van Ee* district court held that the burden on the employee’s speech was “limited” to “one audience, the federal government”; *i.e.*, “[t]he government is restricting the manner in which plaintiff may speak to *it*, not the rest of the public,” and thus “[p]otential audiences will be deprived of far less insight from plaintiff and other federal employees.” *Id.* at 12-14. Conversely, “[p]rohibiting government employees from representing private individuals and entities in their dealings before the government clearly furthers the government’s interests in avoiding actual and apparent conflicts of interest.” *Id.* at 15. And thus, “[i]n light of the limited impact on the quality and quantity of speech in which plaintiff and others may engage, the government’s stated interests weigh heavily.” *Id.*<sup>3</sup>

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<sup>3</sup>On appeal in *Van Ee*, the District of Columbia Circuit interpreted § 205 – in an application of the constitutional avoidance doctrine – not to preclude the particular type of advocacy in which the employee at issue there wished to engage. *See Van Ee v. EPA*, 202 F.3d 296, 302-03 (D.C. Cir. 2000). The court held that “§ 205 leaves career federal civil servants free to voice the concerns of citizens’ groups of which they are members on *broad policy issues*,” *id.* at 310 (emphasis added), which obviously is in stark contrast to the *particularized private intellectual property interests* for which Correll advocated (in exchange for a fee) before the USPTO while employed by the United States. On this score, the court explained that in enacting § 205, Congress sought to limit the prohibition “to situations in which the federal employee acts as an agent or

\* \* \*

In the end, Correll cannot demonstrate – by any standard, let alone through the “strong showing” necessary here – that the *Pickering* balancing test requires this Court to strike down a 160 year old prohibition on the federal workforce’s paid representation of specific private interests before the same government that employs them. The government’s interest in precluding even the appearance of beneficial treatment of private interests in government decisionmaking well outweighs the rather modest impact on plaintiff’s speech activity.

2. Correll also maintains that the institution of disciplinary proceedings against him should have been barred on statute of limitations grounds, especially insofar as it concerned his representation of private interests in *non-patent* matters before the USPTO. *Motion*, at 11-14. The argument is completely without merit.

Congress recently amended the Patent Act to create a specific limitations period within which OED must file an administrative complaint charging a USPTO practitioner with misconduct and to provide the agency with specific authority to promulgate regulations to that end:

A proceeding under this section shall be commenced not later than the earlier of either the date that is 10 years after the date on which the misconduct forming the basis of the proceeding occurred, or 1 year after the date on which the misconduct forming the basis for the proceeding is made known to an

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attorney,” as Correll repeatedly did here, in order to ensure that the statute implicated conduct that truly caused conflict of interest problems. *Id.* at 308.

officer or employee of the Office *as prescribed in the regulations established under § 2(b)(2)(D)*.

35 U.S.C. § 32 (emphasis added). Correll’s argument in this respect – which is difficult to understand and relies on decisional authority about the USPTO’s regulatory authority issued *before* this congressional amendment that unequivocally authorized the agency to promulgate regulations fleshing out the relevant limitations period – must be rejected.

**B. CORRELL CANNOT MAKE A CLEAR SHOWING ON THE REMAINING PRELIMINARY INJUNCTION ELEMENTS**

**1. CORRELL HAS NOT MADE A CLEAR SHOWING OF IRREPARABLE HARM**

“[P]roving ‘irreparable’ injury is a considerable burden, requiring proof that the movant’s injury is ‘*certain, great and actual*—not theoretical—and *imminent*, creating a clear and present need for extraordinary equitable relief to prevent harm.” *Nat’l Min. Ass’n v. Jackson*, 768 F. Supp. 2d 34, 50 (D.D.C. 2011). The only irreparable harm that Correll articulates that he will suffer without the entry of a preliminary injunction here is the purported loss of his First Amendment rights. Because the deprivation of valid First Amendment protections constitutes irreparable harm, “a plaintiff’s claimed irreparable harm is ‘inseparably linked’ to the likelihood of success on the merits of [his] First Amendment claim.” *WV Ass’n of Club Owners & Fraternal Servs., Inc. v. Musgrave*, 553 F.3d 292, 298 (4<sup>th</sup> Cir. 2009). Because, as the District Court correctly concluded, the USPTO’s suspension of his ability to practice before the agency for his

past behavior does not impair a cognizable First Amendment protection, Correll also cannot make a “clear showing” of irreparable harm.

**2. THE BALANCE OF THE EQUITIES AND PUBLIC INTEREST  
BOTH FAVOR THE GOVERNMENT**

Correll must also demonstrate that this form of extraordinary relief is in the public interest. *See Dewhurst v. Century Aluminum Co.*, 649 F.3d 287, 290 (4<sup>th</sup> Cir. 2011). In this respect, Correll fails to recognize that one of the primary purposes for the discipline of practitioners who violate their professional obligations is to *deter* other individuals from acting similarly. *See, e.g., United States v. Colorado Supreme Ct.*, 189 F.3d 1281, 1289 n.8 (10<sup>th</sup> Cir. 1999). Were the mere fact that a practitioner has since left federal employment sufficient to excuse a violation of the federal conflict of interest statutes – let alone nearly 300 such violations over a period of thirteen *years* – other practitioners would feel no compunction to follow the law. As such, the balance of equities and public interest favor the USPTO.

**CONCLUSION**

For the foregoing reasons, this Court should deny Correll’s motion for an injunction pending appeal.

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Respectfully submitted,

JESSICA D. ABER  
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By: \_\_\_\_\_/s/\_\_\_\_\_

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**CERTIFICATE OF SERVICE**

I hereby certify that on February 28, 2022, I electronically filed the foregoing Defendant-Appellee's Opposition to Emergency Motion to Stay Agency Action using the CM/ECF System, which will send notice of such filing to all registered CM/ECF users.

Date: February 28, 2022

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**EXHIBITS TO OPPOSITION TO EMERGENCY MOTION TO STAY  
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**UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE ADMINISTRATIVE LAW JUDGE  
UNITED STATES ENVIRONMENTAL PROTECTION AGENCY**

In the Matter of:

Kevin P. Correll,

Respondent.

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Proceeding No. D2018-12

**COMPLAINT AND  
NOTICE OF PROCEEDINGS UNDER 35 U.S.C. § 32**

The Director of the Office of Enrollment and Discipline (“OED Director”) for the United States Patent and Trademark Office (“USPTO” or “Office”) hereby gives notice of a disciplinary proceeding and statement of charges against Kevin P. Correll (“Respondent”).

This Complaint and Notice of Proceedings (“Complaint”) is filed pursuant to 37 C.F.R. §§ 11.32 and 11.34. Within thirty days from the date of the filing of this Complaint, Respondent's written answer shall be filed with the U.S. Environmental Protection Agency's Office of Administrative Law Judges, and a copy of the answer shall be served on the OED Director. *See* 37 C.F.R. §§ 11.34(a)(3), 11.36(a), and 11.36(b). The attached Notice of Correspondence Addresses provides the four options for Respondent to file the answer with the U.S. Environmental Protection Agency's Office of Administrative Law Judges and to serve a copy of the answer on the OED Director (*i.e.*, by U.S. Postal Service, courier service or hand-delivery, facsimile transmission, or electronic filing). A decision by default may be entered against Respondent if a written answer is not timely filed. *See* 37 C.F.R. §§ 11.34(a)(4) and 11.36(e). The provisions of 37 C.F.R. § 11.41 govern the filing of papers in this disciplinary proceeding.

### **Jurisdiction**

At all times relevant to this Complaint, Respondent of Newport, Rhode Island, was a patent attorney registered to practice before the USPTO and is subject to the USPTO Code of Professional Responsibility, which is set forth at 37 C.F.R. § 10.20 *et seq.*, and the USPTO Rules of Professional Conduct, which are set forth at 37 C.F.R. §§ 11.101 through 11.901.<sup>1</sup> This Tribunal has jurisdiction over this proceeding pursuant to 35 U.S.C. §§ 2(b)(2)(D) and 32, and 37 C.F.R. §§ 11.19, 11.32, and 11.39.

### **Background**

1. Respondent was registered as a patent attorney with the USPTO on September 12, 2000.
2. Respondent's registration number is 46,641.
3. Respondent was admitted to practice law in Massachusetts on June 14, 1999, (Board of Bar Overseers Number 642278) and is currently an active member in good standing.
4. On December 8, 1999, Respondent signed an "OATH OR AFFIRMATION" in which he swore or affirmed that, if registered by the USPTO, he would, *inter alia*, "observe the laws and rules of practice of the Office."
5. On November 25, 2003, Respondent submitted a signed and dated Survey to the Office of Enrollment and Discipline ("OED"), where he checked the box "YES" to the question:

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<sup>1</sup> Effective May 3, 2013, the USPTO Rules of Professional Conduct apply to practitioners who practice before the Office. *See* 37 C.F.R. §§ 11.101 through 11.901. The USPTO Code of Professional Responsibility applies to misconduct occurring prior to May 3, 2013. *See* 37 C.F.R. §§ 10.20 through 10.112. The allegations of misconduct set forth in this Complaint occurred prior to, on, and after May 3, 2013. Therefore, both the USPTO Code of Professional Responsibility and the USPTO Rules of Professional Conduct apply.

“Are you an employee of the United States Government? **PLEASE NOTE: U.S. Government employees are not available to accept private clients or represent clients other than their agency before the United States Patent and Trademark Office. 18 U.S.C. § 205; 37 C.F.R. § 10.10(c) and (d).**” (Emphasis added.)

6. Since September 16, 2002, Respondent has been employed by the United States as an engineer for the Department of the Navy.

7. At all times relevant to this Complaint, Respondent remains employed by the United States.

8. Respondent’s acts and omissions leading to the alleged violations of the rules set forth in this Complaint were willful.

#### **Count I**

*(Federal employee engaging in conduct contrary to applicable federal ethics law, practicing law in a jurisdiction in violation of the regulation of the legal profession in that jurisdiction; committing an act in violation of criminal statutes reflecting adversely on the practitioner’s fitness to practice; and failure to withdraw from representation of clients when the representation is contrary to the USPTO Code of Professional Responsibility and the USPTO Rules of Professional Conduct)*

9. Paragraphs 1 through 8 above are incorporated by reference.

10. The United States’ criminal conflict of interest statutes, 18 U.S.C. § 203(a)(1)(B) and 18 U.S.C. § 205(a)(2), generally prohibit a federal employee from acting as an attorney before any Government agency in connection with any covered matter in which the United States is a party or has a direct and substantial interest.

11. Specifically, 18 U.S.C. § 203 prohibits a federal employee (other than for the proper discharge of his or her federal employment duties) from, *inter alia*, agreeing to receive compensation for any representational services as an attorney in relation to any application or

proceeding or other particular matter in which the United States is a party or has a direct and substantial interest. *See* 18 U.S.C. § 203(a)(1)(B).

12. 18 U.S.C. § 205 prohibits a federal employee (other than in the proper discharge of his or her federal employment duties) from acting as an attorney for anyone before any agency in connection with any application or proceeding in which the United States is a party or has a direct and substantial interest. *See* 18 U.S.C. §§ 205(a)(2) and 205(h).

13. The United States has a direct and substantial interest in the prosecution of patent applications before the Office.

14. The United States has a direct and substantial interest in the prosecution of trademark applications before the Office.

15. USPTO regulation 37 C.F.R. § 11.10(e) explains that “[p]ractice before the Office by Government employees is subject to any applicable conflict of interest laws, regulations or codes of professional responsibility.”

16. Since September 16, 2002, Respondent has been employed by the Department of the Navy, at the Naval Undersea Warfare Center of the Naval Sea Systems Command, in Newport, Rhode Island.

17. Respondent’s official position description states, in pertinent part:

As a senior electronics engineer, the incumbent supports the Submarine Learning Center, Groton CT in assessing and determining deployment and use of Submarine learning technologies. The incumbent will support N6/N7 in the review and assessments of new and emerging technologies for potential use by SLC as part of classroom instruction and/or submarine deployment and will assist SLC in the assessment, implementation and deployment of virtual work technologies, gaming and gaming modules, video based media and search engines.

The incumbent will conduct assessments of current technologies used by various government and contractor organizations offering training technology delivery products and tools. He/she will identify issues, conduct research, generate reports and provide recommendations. Typical assignment of tasks can range from research, design, prototyping, experimentation, analysis and requirement development. Technical recommendations will be communicated to SLC.

18. Since at least September 4, 2002, Respondent has owned and operated a private law firm, K.P. Correll & Associates, LLC, ("Correll & Associates") offering and providing patent and trademark legal services to the public.

19. Correll & Associates is a domestic limited liability corporation.

20. Correll & Associates was registered with the State of Rhode Island in 2008.

21. Respondent lists 270 Bellevue Avenue, #326, Newport, Rhode Island 02840 as the address for Correll & Associates.

22. An internet search for this address reveals that it is the address for a virtual office, *i.e.* an address without a physical office space.

23. The Correll & Associates website states that clients can meet in person at the following address: Office 407, 56 North Main Street, Fall River, Massachusetts 02720.

24. According to the Rhode Island Department of State website, the address for Correll & Associates is 83 Country Hill Lane, North Kingstown, Rhode Island 02852. This is Respondent's home address.

25. Two fictitious business names have been filed by Respondent that are associated with Correll & Associates: Northeastern Patent Law Associates and Patent Institute.

26. Respondent is the sole member of Correll & Associates.

27. Correll & Associates is associated with USPTO Customer Number 34070.<sup>2</sup>

28. At all times relevant to this Complaint, the website for Correll & Associates, <http://correllpatents.com>, stated: “K.P. Correll and Associates, LLC is an Intellectual Property (IP) Law firm serving corporate and individual clients across the country, and around the world, by protecting their Intellectual Property assets through patents, federal trademarks and federal copyrights.”

29. As of the date of filing this Complaint, Respondent is the only patent attorney listed on the website <http://correllpatents.com>.

30. Respondent has advertised for private clients for his law firm via the internet and in local Rhode Island barbershops.

31. Respondent has also advertised for private clients for his law firm in T.F. Green Airport, located at 2000 Post Road, Warwick, Rhode Island 02886.

32. Respondent acknowledged in his response to OED’s July 18, 2017, Request for Information and Evidence Under 37 C.F.R. § 11.22(f) (“July 18, 2017 RFI”), that he was “paid/compensated for work considered ‘practice before the Office’ pursuant to 37 C.F.R. § 11.5(b) (including subsections (1) and (2)), including, but not limited to, preparing and/or prosecuting patent and/or trademark applications before the USPTO.”

33. From at least June 2007 to 2016, Respondent was a voting member of the Naval Undersea Warfare Center’s Invention Examination Board.

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<sup>2</sup> A Customer Number allows a patent applicant or his or her representative to easily correlate all patent filings and correspondence with a single mailing address, eliminating typographical errors or variations in addresses that can make it difficult to correspond with the USPTO.

34. Mr. James Kasischke, a registered practitioner, and head intellectual property attorney at the Naval Undersea Warfare Center of the Naval Sea Systems Command, Department of the Navy, and an advising member of Naval Undersea Warfare Center's Invention Examination Board, spoke with Respondent a few years ago, after seeing a Correll & Associates advertisement in a local barbershop.

35. More recently, Mr. Kasischke again saw Correll & Associates, advertising in T.F. Green Airport in Rhode Island.

36. Mr. Kasischke confronted Respondent and reminded him that as a Federal Government employee Respondent could not represent private clients before a Federal Government agency.

37. Respondent informed Mr. Kasischke that he was not representing inventors but was referring inventors to other patent attorneys.

38. Upon information and belief, Respondent's representation to Mr. Kasischke was false or misleading.

39. On September 7, 2017, Respondent stated in a response to OED's July 18, 2017 RFI that "I am resigned from the [Naval Undersea Warfare Center] Invention Examination Board. . . ."

40. Respondent did not resign from the Naval Undersea Warfare Center Invention Examination Board. Instead, Respondent was informed by the chairperson of the Board that Respondent could not participate in the Invention Examination Board due to his potential conflicts of interest.

**Impermissible Patent Application Preparation and Prosecution by Respondent  
While Employed By the Department of the Navy**

41. The below-listed 211 patent applications have been filed either with a power of attorney naming Respondent as the attorney of record, or where Respondent signed the application data sheet, and/or the application was prosecuted by Respondent after September 16, 2002.<sup>3</sup>

TABLE 1: Patent Applications Filed and/or Prosecuted by Respondent  
After His Employment Start Date with the Navy

Application No.	Filing Date	Status	Power of Attorney Withdrawn?
09/562,462	5/1/2000	Patented	POA naming Respondent filed 9/4/2015.
10/458,430	6/9/2003	Patented	Change of Address filed on 10/27/2017 to Owner's address
10/619,864	7/14/2003	Patented	No
10/675,184	9/30/2003	Patented	No
10/675,185	9/30/2003	Patented	No
10/696,274	10/29/2003	Patented	Respondent was appointed on 9/5/2006. He remained the attorney of record through issuance.
10/811,006	3/26/2004	Patented	No
10/824,714	4/15/2004	Abandoned	No
10/840,521	5/6/2004	Patented	No
60/581,915	6/22/2004	Expired	No
60/598,657	8/4/2004	Expired	No
10/944,685	9/17/2004	Patented	No
60/629,168	11/18/2004	Expired	No
29/221,068	1/11/2005	Patented	No
11/067,850	2/28/2005	Patented (expired)	No
60/672,415	4/18/2005	Expired	No
60/688,227	6/7/2005	Expired	No
11/181,300	7/14/2005	Abandoned	No
60/699,534	7/15/2005	Expired	No
60/722,820	10/1/2005	Expired	No
11/281,754	11/17/2005	Abandoned	No
60/772,260	2/10/2006	Expired	No
60/783,223	3/17/2006	Expired	No
60/789,864	4/6/2006	Expired	No
60/816,776	6/27/2006	Expired	No
11/487,635	7/17/2006	Patented	No
11/499,417	8/4/2006	Patented (expired)	No

<sup>3</sup> Most of these applications (181) have been filed since 2007.



Application No.	Filing Date	Status	Power of Attorney Withdrawn?
11/551,889	10/23/2006	Abandoned	No
11/551,847	10/23/2006	Abandoned	No
60/865,371	11/10/2006	Expired	No
11/673,593	2/11/2007	Abandoned	Change of Address filed in 2010 to Inventor's address.
11/687,681	3/19/2007	Abandoned	No
60/910,696	4/9/2007	Expired	No
11/766,769	6/21/2007	Abandoned	No
60/945,943	6/24/2007	Expired	No
PCT/US07/75227	8/4/2007	Expired	No
60/954,064	8/6/2007	Expired	No
11/835,342	8/7/2007	Abandoned	No
60/979,816	10/13/2007	Expired	No
12/029,441	2/11/2008	Abandoned	No
61/048,197	4/27/2008	Expired	No
61/054,659	5/20/2008	Expired	No
61/054,627	5/20/2008	Expired	No
61/057,773	5/30/2008	Expired	No
61/074,669	6/22/2008	Expired	No
61/080,924	7/15/2008	Expired	No
12/187,355	8/6/2008	Abandoned	No
61/097,249	9/16/2008	Expired	No
12/249,136	10/10/2008	Patented	No
12/250,441	10/13/2008	Abandoned	No
12/411,182	3/25/2009	Abandoned	No
12/469,584	5/20/2009	Abandoned	No
61/180,867	5/24/2009	Expired	No
12/488,565	6/21/2009	Patented	No
61/245,014	9/23/2009	Expired	No
12/566,797	9/25/2009	Patented	No
PCT/US10/28913	3/26/2010	Expired	No
12/785,466	5/23/2010	Abandoned	No
29/368,884	8/31/2010	Patented	No
29/368,881	8/31/2010	Abandoned	No
12/887,163	9/21/2010	Abandoned	No
61/394,033	10/18/2010	Expired	No
12/908,280	10/20/2010	Patented	No
12/994,264	11/23/2010	Patented	No
13/024,072	2/9/2011	Patented	No
61/445,560	2/23/2011	Expired	No
13/077,768	3/31/2011	Patented	No
61/473,981	4/11/2011	Expired	No
13/097,107	4/29/2011	Patented	No
13/171,522	6/29/2011	Abandoned	Respondent was appointed on 10/13/2013; application abandoned on 12/17/2013.

Application No.	Filing Date	Status	Power of Attorney Withdrawn?
PCT/US11/56089	10/13/2011	Expired	No
13/275,396	10/18/2011	Patented	No
13/276,440	10/19/2011	Abandoned	No
PCT/US11/59479	11/5/2011	Expired	No
29/407,825	12/2/2011	Patented	It appears that the applicant took over the prosecution in August 2013.
61/581,767	12/30/2011	Expired	No
61/589,382	1/22/2012	Expired	No
13/371,460	2/12/2012	Abandoned	No
61/640,738	5/1/2012	Expired	No
61/652,165	5/26/2012	Expired	No
61/674,085	7/20/2012	Expired	No
61/704,456	9/22/2012	Expired	No
29/433,827	10/5/2012	Patented	No
61/722,179	11/4/2012	Expired	No
61/732,299	12/1/2012	Expired	No
13/726,662	12/26/2012	Abandoned	No
61/745,825	12/26/2012	Expired	No
61/773,960	3/7/2013	Expired	No
13/882,737	4/30/2013	Patented	No
13/875,095	5/1/2013	Abandoned	No
61/821,928	5/10/2013	Expired	No
61/824,724	5/17/2013	Expired	No
13/902,834	5/26/2013	Patented	No
13/922,154	6/19/2013	Patented	No
61/842,996	7/4/2013	Expired	No
61/842,998	7/4/2013	Expired	No
61/842,999	7/4/2013	Expired	No
61/860,844	7/31/2013	Expired	No
29/462,206	7/31/2013	Patented	No
29/462,207	7/31/2013	Patented	No
61/860,836	7/31/2013	Expired	No
13/879,404	8/12/2013	Patented	No
29/467,083	9/15/2013	Abandoned	No
29/467,084	9/15/2013	Abandoned	No
29/467,081	9/15/2013	Abandoned	No
14/052,748	10/13/2013	Patented	No
61/890,681	10/14/2013	Expired	No
29/469,886	10/15/2013	Patented	No
29/470,418	10/21/2013	Patented	No
14/071,464	11/4/2013	Pending	No
61/902,370	11/11/2013	Expired	No
61/902,359	11/11/2013	Expired	No

Application No.	Filing Date	Status	Power of Attorney Withdrawn?
29/473,914	11/26/2013	Patented	No
29/473,917	11/26/2013	Patented	No
29/473,918	11/26/2013	Patented	No
14/093,492	12/1/2013	Abandoned	No
61/925,088	1/8/2014	Expired	No
14/163,779	1/24/2014	Patented	No
14/163,825	1/24/2014	Patented	No
29/480,702	1/28/2014	Abandoned	No
14/191,299	2/26/2014	Patented	No
61/945,555	2/27/2014	Expired	No
61/946,752	3/1/2014	Expired	No
14/200,979	3/7/2014	Abandoned	No
PCT/US14/21816	3/7/2014	Expired	No
29/487,174	4/6/2014	Abandoned	No
61/975,873	4/6/2014	Expired	No
14/256,976	4/20/2014	Patented	No
14/262,766	4/27/2014	Patented	No
14/280,890	5/19/2014	Abandoned	No
14/291,192	5/30/2014	Patented	No
14/312,727	6/24/2014	Patented	No
14/333,647	7/17/2014	Patented	No
14/341,827	7/27/2014	Issue Fee Paid	No
62/032,559	8/2/2014	Expired	No
14/452,569	8/6/2014	Abandoned	Respondent was removed as attorney of record on 12/29/2014.
62/037,039	8/13/2014	Expired	No
62/043,746	8/29/2014	Expired	No
62/050,666	9/15/2014	Expired	No
62/050,783	9/16/2014	Expired	No
62/062,847	10/11/2014	Expired	No
29/508,621	11/7/2014	Patented	No
14/535,930	11/7/2014	Patented	No
14/538,365	11/11/2014	Patented	No
14/564,343	12/9/2014	Abandoned	Power of Attorney naming Respondent filed 2/19/2016.
29/512,789	12/23/2014	Patented	No
14/588,240	12/31/2014	Abandoned	No
62/103,013	1/13/2015	Expired	No
14/617,369	2/9/2015	Abandoned	No
14/633,935	2/27/2015	Abandoned	No
14/635,423	3/2/2015	Pending	No
62/129,135	3/6/2015	Expired	No
29/526,326	5/8/2015	Patented	No

Application No.	Filing Date	Status	Power of Attorney Withdrawn?
29/526,327	5/8/2015	Patented	No
62/186,286	6/29/2015	Expired	No
62/188,565	7/3/2015	Expired	No
14/793,993	7/8/2015	Pending	No
14/799,356	7/14/2015	Pending	No
29/534,142	7/27/2015	Abandoned	No
14/816,015	8/2/2015	Abandoned	No
14/824,494	8/12/2015	Pending	No
14/825,532	8/13/2015	Patented	No
14/841,515	8/31/2015	Patented	No
29/538,694	9/7/2015	Pending	No
62/215,963	9/9/2015	Expired	No
14/855,206	9/15/2015	Pending	No
14/855,234	9/15/2015	Pending	No
62/255,411	11/14/2015	Expired	No
62/260,574	11/29/2015	Expired	No
15/063,369	3/7/2016	Pending	No
15/135,424	4/21/2016	Pending	No
15/135,437	4/21/2016	Patented	No
15/201,587	7/4/2016	Pending	No
62/363,569	7/18/2016	Expired	No
15/261,634	9/9/2016	Patented	No
29/583,711	11/8/2016	Pending	No
29/583,739	11/8/2016	Pending	No
29/583,744	11/8/2016	Pending	No
15/350,074	11/13/2016	Pending	No
29/584,253	11/14/2016	Pending	No
15/361,391	11/26/2016	Abandoned	No
15/382,686	12/18/2016	Pending	No
62/437,341	12/21/2016	Pending	No
29/590,158	1/8/2017	Pending	No
29/590,159	1/8/2017	Pending	No
15/405,134	1/12/2017	Pending	No
29/591,036	1/16/2017	Pending	No
29/592,292	1/29/2017	Pending	No
29/592,293	1/29/2017	Pending	No
29/592,294	1/29/2017	Pending	No
15/418,733	1/29/2017	Pending	No
29/594,345	2/17/2017	Pending	No
29/594,521	2/20/2017	Abandoned	No
29/595,165	2/26/2017	Pending	No
29/600,762	4/14/2017	Pending	No
62/485,961	4/16/2017	Pending	No
15/491,900	4/19/2017	Pending	No
62/491,331	4/28/2017	Pending	No

Application No.	Filing Date	Status	Power of Attorney Withdrawn?
15/603,329	5/23/2017	Pending	No
29/606,802	6/7/2017	Pending	No
29/606,809	6/7/2017	Pending	No
29/606,813	6/7/2017	Pending	No
62/519,568	6/14/2017	Pending	No
15/643,293	7/6/2017	Pending	No
29/609,912	7/6/2017	Pending	No
15/652,274	7/18/2017	Pending	No
62/545,497	8/15/2017	Pending	No
29/618,772	9/24/2017	Pending	No
62/563,725	9/27/2017	Pending	No
62/576,825	10/25/2017	Pending	No
62/576,845	10/25/2017	Pending	No

42. Respondent filed twenty patent applications (the shaded areas in Table 1) with the USPTO after OED mailed the February 9, 2017 RFI (the “Initial RFI”) to Respondent which outlined 18 U.S.C. §§ 203 and 205 and 37 C.F.R. § 11.10(e).

43. Respondent was alerted by several sources that he is not permitted to represent private clients before the USPTO in patent applications while employed by the Department of the Navy, including at least: (i) by the OED Survey in November 2003, (ii) by Mr. Kasischke, and (iii) OED’s Initial RFI. Yet Respondent continued to do so.

44. Telephone number 401-295-7377 is associated with Correll & Associates and Respondent’s home address.

45. Massachusetts phone number 508-676-8400 is an alternate phone number for Correll & Associates.

46. Rhode Island phone number 401-954-8183 is Respondent’s cell phone number.

47. In response to the July 18, 2017 RFI, Respondent stated that a regular workweek schedule for him at the Naval Undersea Warfare Center is Monday through Friday from 08:00am-12:00pm and 12:30pm-4:30pm (16:30hrs).

48. According to USPTO records, Respondent conducted approximately twenty-four patent examiner telephone contacts during his working duty hours at the Department of the Navy in the patent applications listed in Table 2 below.

TABLE 2: Patent Examiner Telephone Contacts Conducted During Respondent's Duty Hours

Patent Application Serial No.	Date of Call	Time of Call	Duration (min:sec)	Call Type (outgoing – from USPTO; incoming – from Respondent)	Examiner	Outside Phone Number	State
11/487,635	Thursday, 5/6/2010	15:50 pm	No Data	No Data	Jimmy T. Nguyen	No Data	None
12/887,163	Wednesday, 8/14/2013	15:04:03	0:05	Outgoing	Cynthia Collado	401-295-7377	RI
12/887,163	Wednesday, 8/14/2013	15:09:10	0:05	Outgoing	Cynthia Collado	508-676-8400	MA
13/024,072	Thursday, 11/7/2013	10:47:30	5:45	Outgoing	Marc Carlson	401-295-7377	RI
13/024,072	Thursday, 11/7/2013	12:52:02	2:52	Outgoing	Marc Carlson	401-295-7377	RI
13/275,396	Tuesday, 5/27/2014	14:56:20	6:28	Outgoing	Son T. Nguyen	401-295-7377	RI
13/276,440	Tuesday, 9/1/2015	14:48:55	0:51	Outgoing	Fuming Wu	401-295-7377	RI
13/276,440	Wednesday, 9/2/2015	10:00:41	8:41	Outgoing	Fuming Wu	401-295-7377	RI
13/276,440	Tuesday, 9/1/2015	15:54:57	4:11	Incoming	Fuming Wu	401-954-8183	RI
13/879,404	Friday, 2/26/2016	12:57:00	8:59	Incoming	William R. Alexander	401-954-8183	RI
13/879,404	Friday, 3/11/2016	14:07:43	4:16	Outgoing	William R. Alexander	401-295-7377	RI
13/882,737	Tuesday, 12/20/2016	14:25:21	11:29	Outgoing	Gabriel Agared	401-295-7377	RI
13/882,737	Tuesday, 12/20/2016	15:36:27	2:46	Outgoing	Gabriel Agared	401-954-8183	RI
13/882,737	Tuesday, 12/20/2016	16:14:52	1:02	Outgoing	Gabriel Agared	401-954-8183	RI
13/882,737	Tuesday, 12/20/2016	16:22:43	0:15	Outgoing	Gabriel Agared	401-954-8183	RI
13/882,737	Tuesday, 12/20/2016	15:30:09	0:57	Outgoing	Gabriel Agared	401-954-8183	RI
14/262,766	Friday, 6/16/2017	11:11:46	8:44	Outgoing	Derek S. Chapel	401-295-7377	RI
14/312,727	Friday, 4/22/2016	16:08:47	2:27	Outgoing	Tien Mai	401-295-7377	RI

Patent Application Serial No.	Date of Call	Time of Call	Duration (min:sec)	Call Type (outgoing – from USPTO; incoming – from Respondent)	Examiner	Outside Phone Number	State
14/333,647	Tuesday, 4/4/2017	10:43:27	2:41	Outgoing	Allen Wong	401-295-7377	RI
14/538,365	Thursday, 3/2/2017	12:28:40	2:18	Outgoing	James Hsiao	401-295-7377	RI
14/538,365	Thursday, 3/2/2017	12:03:59	9:10	Outgoing	James Hsiao	401-295-7377	RI
14/841,515	Tuesday, 3/28/2017	11:46:40	2:40	Outgoing	Nigel Plumb	401-295-7377	RI
14/841,515	Tuesday, 3/28/2017	12:16:41	1:16	Outgoing	Nigel Plumb	401-295-7377	RI
29/462,206	Tuesday, 9/16/2014	15:27:32	3:44	No Data	Shawn T. Gingrich	401-295-7377	RI

**Impermissible Trademark Application Preparation and Prosecution by Respondent While Employed by the Department of the Navy**

49. The below-listed eighty trademark applications have been filed with Respondent's name as attorney of record and/or prosecuted by Respondent after September 16, 2002, the Respondent's start date with the Department of the Navy.<sup>4</sup>

TABLE 3: Trademark Applications Filed and/or Prosecuted  
By Respondent While Employed by the Navy

TM Application Number	Applicant	Mark	Filing Date	Status	Power of Attorney Withdrawn
87/368,070	JSI International	JSI CABINETRY	3/12/2017	Registered 11/31/2017	No
87/284,480	MASS Games and Technologies	MIND GAMES	12/29/2016	Notice of Publication mailed 11/1/2017	No
87/382,417	Yomega Corporation	FIREBALL	3/23/2017	Registered 11/01/2017	No
87/382,402	Yomega Corporation	RAIDER	3/23/2017	Registered 10/17/2017	No
87/508,857	FIR Industries, Inc.	Unleash the Athlete Within	6/28/2017	Notice of Publication mailed 11/25/2017	No

<sup>4</sup> Most of these applications (73) have been filed since 2007.

TM Application Number	Applicant	Mark	Filing Date	Status	Power of Attorney Withdrawn
87/426,475	FIR Industries, Inc.	Tourma	Filed 4/26/17; Correll appointed 9/18/2017	Notice of Publication mailed 10/25/2017	No
87/199,051	Webb, Stanley H.	DONUT FACTORY	10/11/2016	Registered 10/10/2017	No
87/174,842	Nutel Communications, Inc.	SPACE SHOTS	9/18/2016	Notice of Acceptance of Statement of Use mailed 10/7/2017	No
87/284,455	Nutel Communications, Inc.	PeekEZ	12/29/2016	Suspension Letter mailed 10/3/2017	No
87/614,521	Lopes, Paul C.	BURGPHORIA	9/19/2017	Pending	No
87/614,498	Lopes, Paul C.	PORT MUFFINS	9/19/2017	Pending	No
87/612,942	MASS Games & Technologies	BITZ	9/18/2017	Pending	No
87/557,699	Yomega Corporation	MAGNETAR	8/6/2017	Suspension Letter mailed 9/19/2017	No
87/496,278	Yomega Corporation	The Original Auto Return	6/19/2017	Office Action mailed 9/19/2017	No
87/230,538	MASS. GAMES & TECHNOLOGIES, INC	BITZ	11/8/2016	Notice of Abandonment mailed 9/15/2017	No
87/199,045	Webb, Stanley H.	DONUT BANDIT	10/11/2016	Notice of Publication mailed 9/12/2017	No
87/407,615	Stanley Webb	SPEAK EZ	4/11/2017	Notice of Allowance mailed 10/24/2017	No
87/563,914	Stanley H. Webb	SILVA-WEBB	8/10/2017	Notice of Publication mailed 11/29/2017	No
87/563,857	Stanley H. Webb	ENGAGE IN THE EXPERIENCE	8/10/2017	Notice of Publication mailed 11/29/2017	No
87/563,795	Nutel Communications, Inc.	DATAPLUS	8/10/2017	Pending	No
87/563,672	MASS Games and Technologies	SPACEBALLS	8/10/2017	Pending	No
87/563,644	MASS Games and Technologies	SPACEBALLS	8/10/2017	Pending	No
87/413,313	Nutel Communications	You never have to buy anything or pay any money to test your skill abilities with our customer rewards skill challenge games	4/17/2017	Office Action mailed 7/27/2017	No
87/382,410	Yomega Corporation	BRAIN	3/23/2017	Amendment & Suspension Letter mailed 7/11/2017	No



TM Application Number	Applicant	Mark	Filing Date	Status	Power of Attorney Withdrawn
87/372,095	Stanley H. Webb	ANCHORS AWAY	3/15/2017	Notice of Allowance mailed 8/22/2017	No
87/350,019	Stanley H. Webb	THAT'S THE DONUT FACTORY WAY	2/26/2017	Notice of Allowance mailed 8/22/2017	No
87/350,015	Stanley H Webb	SMYTHIES	2/26/2017	Notice of Allowance mailed 8/22/2017	No
87/350,010	Stanley H. Webb	BOXCAR SMYTHIES	2/26/2017	Notice of Allowance mailed 8/22/2017	No
87/350,007	Stanley H. Webb	BOXCAR JOE	2/26/2017	Notice of Allowance mailed 8/22/2017	No
87/130,604	Control Concepts Inc. AKA Control Concepts	Control Concepts	8/8/2016	Notice of Allowance mailed 8/22/2017	No
87/385,820	Paul Messier	UV Innovations	3/26/2017	Office Action mailed 6/19/2017	No
87/382,608	O. C. White Co.	MIC-LITE	3/23/2017	Office Action mailed 6/19/2017	No
87/382,333	O. C. White Co.	ULTIMA	3/23/2017	Office Action mailed 6/19/2017	No
87/130,658	Jose Luis Vela; Joseph M. Gangi	BIOMETRIC WALLET	8/8/2016	Notice of Acceptance of Amendment to Allege Use mailed 6/22/2017	No
87/137,796	Control Concepts, Inc.	DAZIC	8/14/2016	Registered 4/4/2017	No
87/137,785	Control Concepts, Inc.	ACOUSTICLEAN	8/14/2016	Registered 4/4/2017	No
87/137,809	Control Concepts, Inc.	ROTOGUARD	8/14/2016	Registered 3/21/2017	No
87/020,683	O. C. White Co.	ULTIMA	5/1/2016	Notice of Abandonment mailed 3/20/2017	No
87/303,341	BIP Gear LLC	THC TRAY	1/16/2017	Office Action mailed 8/2/2017	No
86/285,089	Tower Manufacturing Corporation	HDCI	5/19/2014	ITU Extension Approval mailed 6/10/2017	No
86/805,386	David J. Snigier	NOT A PENNY MORE	10/30/2015	Registered 5/16/2017	No
86/922,180	Nutel Communications Inc.	OUTER LIMITS	2/27/2016	Notice of Abandonment mailed 4/17/2017	No
86/638,990	Stanley Webb	SPEAK EZ	5/22/2015	Notice of Abandonment mailed 4/10/2017	No
86/900,861	Paul Messier	UV INNOVATIONS	2/8/2016	Notice of Abandonment mailed 4/3/2017	No

TM Application Number	Applicant	Mark	Filing Date	Status	Power of Attorney Withdrawn
86/938,020	Autumn Baseball League	AUTUMN BASEBALL	3/12/2016	Registered 1/24/2017	No
86/907,257	Control Concepts Inc.	(design only)	2/13/2016	Registered 1/10/2017	No
86/863,338	Control Concepts Inc.	FLOWEZE	12/31/2015	Registered 1/10/2017	No
86/863,252	Control Concepts	AIRSWEEP	12/31/2015	Registered 1/3/2017	No
86/955,663	Alliance Paper Company Inc.	ECO CHOICE	3/28/2016	Suspension Letter mailed 9/11/2016	No
86/369,689	Yomega Corp.	ALPHA WING	8/18/2014	Registered 6/30/2015	No
86/639,138	Niche Inc.	CAPE COD UMBRELLA	5/22/2015	Notice of Abandonment mailed 3/31/2016	No
86/719,175	Matthew Hiscock	(design only)	8/9/2015	Registered 3/22/2016	No
86/719,177	Hiscock, Mathew	HISCOCK CONSTRUCTION	8/9/2015	Registered 3/15/2016	No
86/467,355	Paul Messier DBA Paul Messier LLC	UV INNOVATIONS	12/1/2014	Notice of Abandonment mailed 2/16/2016	No
86/541,907	Cliff Wilson	PIRATE SHARK	2/21/2015	Registered 9/22/2015	No
86/407,992	The O. C. White Company	WHITE LIES	9/27/2014	Registered 6/2/2015	No
86/298,885	Murdock Webbing Company, Inc.	MURDOCK WEBBING COMPANY, INC.	6/3/2014	Registered 4/28/2015	No
86/285,111	Tower Manufacturing Corporation	Heat Detecting Circuit Interrupter	5/19/2014	Notice of Abandonment mailed 4/9/2015	No
86/407,978	The O. C. White Company	WHITE LIES	9/27/2014	Registered 3/31/2015	No
86/299,110	Lopes, Paul C.	The 3 Meal Muffin	6/3/2014	Registered 1/20/2015	No
85/256,958	O.C. White Co.	UNIFLEX	3/3/2011; Correll appointed 10/11/2013	Registered 10/4/2011; Correll submitted Section 8 & 15 on 12/4/2016	No
85/256,906	O.C. White Co.	ULTRAFLEX	3/3/2011; Correll appointed 10/11/2013	Registered 10/4/2011; Correll submitted Section 8 & 15 on 12/4/2016	No
85/157,742	O.C. White Co.	ERGO-ZOOM	10/21/2010; Correll appointed on 10/11/2013	Registered May 10, 2011; Correll submitted Section 8 on 9/18/2016	No
85/494,780	Faunce, Allison	LITTLE HERO CAPES	12/14/2011	Notice of Abandonment mailed 4/26/2016	No

TM Application Number	Applicant	Mark	Filing Date	Status	Power of Attorney Withdrawn
85/494,758	Faunce, Allison	LITTLE HERO	12/14/2011	Notice of Abandonment mailed 10/2/2015	No
85/615,304	Messier, Paul DBA Paul Messier, LLC	UV INNOVATIONS	5/3/2012	Notice of Abandonment mailed 12/1/2014	No
85/718,026	The O.C. White Company	O.C. WHITE	8/31/2012	Registered 3/4/2014	No
85/698,045	Murdock Webbing Company, Inc.	MURDOCK WEBBING CO., INC.	8/8/2012	Registered 11/12/2013	No
85/494,806	Faunce, Allison	POWER CUFFS	12/14/2011	Registered 2/19/2013	No
85/411,382	Atlantic Trading Company	CADORIO BRAND SOCIEDADE ULTRAMARINA DE CONSERVAS LDA IMPORTADO DE CABO VERDE	8/31/2011	Notice of Abandonment mailed 3/27/2013	No
85/411,363	Atlantic Trading Company	SABOR DI TERRA	8/31/2011	Notice of Abandonment mailed 1/28/2014	No
78/970,197	The O. C. White Company	PROZOOM	9/8/2006; Correll appointed on 10/11/2013	Correll submitted Section 8 & 9 on 12/4/2016	No
78/969,917	The O. C. White Company	PROBOOM	9/8/2006; Correll appointed on 10/11/2013	Correll submitted Section 8 & 9 on 9/18/2016	No
78/940,102	The O. C. White Company	EZ SWIVEL	7/28/2006; Correll appointed attorney on 10/11/2013	Correll submitted Section 8 & 9 on 9/18/2016	No
78/736,362	The O.C. White Company	O.C. WHITE	10/19/2005; Correll appointed attorney on 10/11/2013	Correll submitted Section 8 & 9 on 1/1/2016	No
78/736,398	The O.C. White Company	EXHAUST-A-LITE	10/19/2005; Correll appointed attorney on 10/11/2013	Correll submitted Section 8 & 9 on 11/1/2015	No
78/529,905	O.C. White Co.	MAGNILITE	12/9/2004; Correll appointed attorney on 10/11/2013	Correll submitted Section 8 & 9 on 6/18/2015	No

TM Application Number	Applicant	Mark	Filing Date	Status	Power of Attorney Withdrawn
77/213,838	White, Scott	Pump Up Your Brand!	6/23/2007	Registered 2/26/2008; Now Dead	No
77/213,836	White, Scott	Brand Identity Guru	6/23/2007	Registered 2/26/2008; Now Dead	No
76/464,909	O.C. WHITE CO.	PROLITE	11/6/2002; Correll appointed attorney on 10/11/2013	Correll submitted Section 8 & 9 on 1/31/2014	No

50. Respondent filed either applications or documents in thirty-four trademark applications (the shaded areas in Table 3) with the USPTO after OED mailed the Initial RFI to the Respondent on February 9, 2017, which outlined 18 U.S.C. §§ 203 and 205 and 37 C.F.R. § 11.10(e).

51. Respondent was alerted by several sources that he is not permitted to represent private clients before the USPTO in trademark applications while employed by the Department of the Navy including at least: (i) by the OED Survey in November 2003, (ii) by Mr. Kasischke, and (iii) by OED's Initial RFI on February 9, 2017. Yet Respondent continued to do so.

52. In the forty-eight trademark applications listed in the Table 4 below, Respondent filed documents with the USPTO during his normal working duty hours at the Department of the Navy.

TABLE 4: Trademark Application Documents Filed by Respondent During Normal Duty Hours

TM Application No.	Document Type	Date/Time Stamp
87/199,045	Application	10/11/16; 09:58:29
87/199,051	Application	10/11/16; 10:05:59
87/563,914	Application	8/10/17; 15:15:24
87/563,857	Application	8/10/17; 14:55:44
87/563,795	Application	8/10/17; 14:34:57
87/563,672	Application	8/10/17; 13:53:08
87/563,644	Application	8/10/17; 13:44:28
87/382,417	Application	3/23/17; 09:53:30
87/382,402	Application	3/23/17; 09:36:47
87/413,313	Application	4/17/17; 09:38:17
87/382,410	Application	3/23/17; 09:45:44

TM Application No.	Document Type	Date/Time Stamp
87/372,095	Application	3/15/17; 14:28:06
87/130,604	Application	8/8/16; 14:08:38
87/382,608	Application	3/23/17; 11:46:55
87/130,658	Application	8/8/16; 14:39:06
87/284,480	Application	12/29/16; 15:59:36
87/284,455	Application	12/29/16; 15:51:52
87/130,767	Application <sup>5</sup>	1/8/17; 15:17:45
86/285,089	Application	5/19/14; 14:27:53
86/805,386	Application Petition to Revive Statement of Use	10/30/15; 17:47:06 1/16/17; 11:11:40 1/16/17; 11:11:40
86/922,180	Express Abandonment	4/7/17; 14:05:53
86/638,990	Application	5/22/15; 11:57:16
86/900,861	Application	2/8/16; 15:14:56
86/938,020	Response to OA	7/8/16; 15:56:02
86/863,338	Application	12/31/15; 15:45:36
86/863,252	Application Amendment	12/31/15; 14:58:14 1/4/16; 09:21:57
86/682,946	Application	7/3/15; 12:25:28
86/682,933	Application	7/3/15; 12:11:22
86/369,689 86/367,072 86/261,270 86/261,231 86/261,180 86/261,141 86/261,125 86/261,105 86/257,947 86/257,620 86/257,563 86/257,527 86/257,004 86/178,697 86/131,342	Power of Attorney	7/22/16; 10:01:26
86/682,954	Application	7/3/15; 12:41:48
86/639,138	Application	5/22/15; 13:10:46
86/719,177	Response to OA	12/17/15; 12:21:14
86/467,355	Application	12/1/14; 09:04:30
86/374,215	Application	8/22/14; 08:58:40

53. Despite being put on notice that his conduct was prohibited, Respondent failed to withdraw from the representation of private clients before the USPTO.

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<sup>5</sup> The mark is for NORTHEASTERN PATENT LAW ASSOCIATES. Correll & Associates owns this mark.

54. By reason of the conduct described above, Respondent has engaged in the following misconduct prior to May 3, 2013:

- a. disreputable or gross misconduct conduct by, *inter alia*:  
(i) consulting with or giving advice to a client in contemplation of filing a patent application or other document with the Office and preparing and prosecuting patent applications before the USPTO while employed by the U.S. Government and (ii) consulting with or giving advice to a client in contemplation of filing a trademark application or other document with the Office and preparing and prosecuting trademark applications before the USPTO while employed by the U.S. Government, in violation of 37 C.F.R. § 10.23(a);
- b. conduct involving dishonesty, fraud, deceit, or misrepresentation by, *inter alia*, (i) consulting with or giving advice to a client in contemplation of filing a patent application or other document with the Office and preparing and prosecuting patent applications before the USPTO while employed by the U.S. Government and (ii) consulting with or giving advice to a client in contemplation of filing a trademark application or other document with the Office and preparing and prosecuting trademark applications before the USPTO while employed by the U.S. Government, (iii) not withdrawing as attorney of record in numerous patent and trademark matters pending before the Office after being notified that he could not represent others before the Office while employed by the U.S. Government; and (iv) receiving compensation for representing others before the Office in violation of federal ethics law while employed by the U.S. Government, in violation of 37 C.F.R. § 10.23(b)(4);
- c. conduct that is prejudicial to the administration of justice by, *inter alia*, (i) consulting with or giving advice to a client in contemplation of filing a patent application or other document with the Office and preparing and prosecuting patent applications before the USPTO while employed by the U.S. Government and (ii) consulting with or giving advice to a client in contemplation of filing a trademark application or other document with the Office and preparing and prosecuting trademark applications before the USPTO while employed by the U.S. Government, (iii) not withdrawing as attorney of record in numerous patent and trademark matters pending before the Office while employed by the U.S. Government; and (iv) receiving compensation for representing others before the Office in violation of federal ethics law while

employed by the U.S. Government, in violation of 37 C.F.R. § 10.23(b)(5);

- d. as a government employee, knowingly practicing contrary to applicable Federal conflict laws, or regulations of the Department, agency, or commission employing the Respondent by, *inter alia*, (i) consulting with or giving advice to a client in contemplation of filing a patent application or other document with the Office and preparing and prosecuting patent applications before the USPTO while employed by the U.S. Government, after being notified repeatedly that doing so violated federal ethics laws, (ii) consulting with or giving advice to a client in contemplation of filing a trademark application or other document with the Office and preparing and prosecuting trademark applications before the USPTO while employed by the U.S. Government, after being notified repeatedly that doing so violated federal ethics laws, (iii) not withdrawing as attorney of record in numerous patent and trademark matters pending before the Office after being notified that he could not represent others before the Office while employed by the U.S. Government, after being notified repeatedly that doing so violated federal ethics laws; and (iv) receiving compensation for representing others before the Office in violation of federal ethics law while employed by the U.S. Government, after being notified repeatedly that doing so violated federal ethics laws, in violation of 37 C.F.R. §§ 10.23(a) and (b) via (c)(20);
- e. failing to withdraw from representing a client before the Office when Respondent knew or it was obvious that Respondent's continued employment would result in violation of a Disciplinary Rule by, *inter alia*, not withdrawing from representing another in patent and trademark matters pending before the Office, in violation of federal law and regulation while employed by the U.S. Government, in violation of 37 C.F.R. § 10.40(b)(2); and/or
- f. engaging in conduct that adversely reflects on the Respondent's fitness to practice before the Office by, *inter alia*, while employed by the U.S. Government engaging in the acts and omissions set forth in the paragraphs a. through e., above, to the extent that such acts and omissions do not otherwise constitute a violation of the above-referenced provisions of the USPTO Code of Professional Responsibility, in violation of 37 C.F.R. § 10.23(b)(6).

68. By reason of the conduct described above, Respondent has engaged in the following misconduct on or after May 3, 2013:

- a. as a practitioner who is a current Federal government employee, engaging in conduct which is contrary to applicable Federal ethics law, including conflict of interest statutes and regulations of the department, agency or commission formerly or currently employing him by, *inter alia*, (i) consulting with or giving advice to a client in contemplation of filing a patent application or other document with the Office and preparing and prosecuting patent applications before the USPTO while employed by the U.S. Government and (ii) consulting with or giving advice to a client in contemplation of filing a trademark application or other document with the Office and preparing and prosecuting trademark applications before the USPTO while employed by the U.S. Government; (iii) not withdrawing as attorney of record in numerous trademark and patent matters pending before the Office while employed by the U.S. Government; and (iv) receiving compensation for representing others before the USPTO in violation of federal ethics law while employed by the U.S. Government, in violation of 37 C.F.R. § 11.111;
- b. engaging in the practice of law in a jurisdiction in violation of the regulation of the legal profession in that jurisdiction by, *inter alia*, (i) consulting with or giving advice to a client in contemplation of filing a patent application or other document with the Office and preparing and prosecuting patent applications before the USPTO while employed by the U.S. Government and (ii) consulting with or giving advice to a client in contemplation of filing a trademark application or other document with the Office and preparing and prosecuting trademark applications before the USPTO while employed by the U.S. Government; (iii) not withdrawing as attorney of record in numerous patent and trademark matters pending before the Office while employed by the U.S. Government; and (iv) receiving compensation for representing others before the Office in violation of federal ethics law while employed by the U.S. Government, in violation of 37 C.F.R. § 11.505;
- c. failing to withdraw from the representation of a client when the representation resulted in a violation of the USPTO Rules of Professional Conduct or other law by, *inter alia*, not withdrawing from representing others in patent and trademark matters pending before the Office in violation of federal ethics law while employed by the U.S. Government, in violation of 37 C.F.R. § 11.116(a)(1);



- d. engaging in professional misconduct by committing a criminal act that reflects adversely on the practitioner's honesty, trustworthiness, or fitness as a practitioner in other respects by, *inter alia*, (i) preparing and prosecuting patent applications before the USPTO while employed by the U.S. Government; (ii) preparing and prosecuting trademark applications before the USPTO while employed by the U.S. Government; (iii) not withdrawing as attorney of record in numerous patent and trademark matters pending before the Office while employed by the U.S. Government; and (iv) receiving compensation for representing others before the Office in violation of federal ethics law while employed by the U.S. Government, in violation of 37 C.F.R. § 11.804(b);
- e. engaging in conduct prejudicial to the administration of justice by, *inter alia*, (i) preparing and prosecuting patent applications before the USPTO while employed by the U.S. Government; (ii) preparing and prosecuting trademark applications before the USPTO while employed by the U.S. Government; (iii) not withdrawing as attorney of record in numerous patent and trademark matters pending before the Office while employed by the U.S. Government; and (iv) receiving compensation for representing others before the Office in violation of federal ethics law while employed by the U.S. Government, in violation of 37 C.F.R. § 11.804(d); and/or
- f. engaging in other conduct that adversely reflects on the practitioner's fitness to practice before the Office by, *inter alia*, engaging in the acts and omissions set forth in paragraphs a. through e., above, to the extent that such acts and omissions do not otherwise constitute a violation of the above referenced provisions of the USPTO Rules of Professional Conduct, in violation of 37 C.F.R. § 11.804(i).

## Count II

*(Engaging in conduct that reflects adversely on a practitioner's fitness to practice before the Office by failing to contact Department of the Navy ethics counsellor for guidance)*

78. Paragraphs 1 through 8 above are incorporated by reference.

79. Under 5 C.F.R. § 2635.107(b), employees are advised to seek ethics advice where there are questions concerning ethics rules:

Employees who have questions about the application of this part or any supplemental agency regulations to particular situations should seek advice from an agency ethics official. Disciplinary action for violating this part or any supplemental agency regulations will not be taken against an employee who has engaged in conduct in good faith reliance upon the advice of any agency ethics official, provided the employee seeking advice, has made full disclosure of relevant circumstances. Where the employee's conduct violates a criminal statute, reliance on the advice of an agency ethics official cannot ensure that the employee will not be prosecuted under the statute.

80. As part of his employment with the Department of the Navy, Respondent was required to complete annual ethics training.

81. Upon information and belief, the trainings included the contact information for the Department of the Navy ethics counselor.

82. Respondent was alerted by several sources that he is not permitted to represent private clients before the USPTO in patent and trademark applications while employed by the Department of the Navy, including at least: (i) by the OED Survey in November 2003, (ii) by Mr. Kasischke, (iii) OED's Initial RFI on February 9, 2017, and (iv) on information and belief, by the Department of the Navy's ethics annual training.

83. At no time did Respondent contact the Department of the Navy ethics counselor to seek advice or inform the ethics counselor of the relevant circumstances, namely that he was representing third-party private clients in patent and trademark applications before the Office.

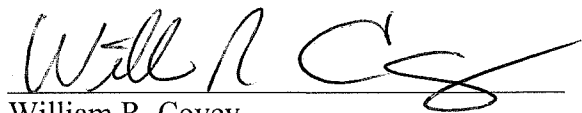
84. By reason of the conduct described above, Respondent has engaged in the following misconduct prior to May 3, 2013: other conduct that adversely reflects on the practitioner's fitness to practice before the Office by not contacting the Department of the Navy ethics counselors to obtain specific guidance after being alerted on numerous occasions that his representation of patent and trademark applicants before the Office was ethically impermissible, in violation of 37 C.F.R. § 10.23(b)(6).

85. By reason of the conduct described above, Respondent has engaged in the following misconduct on or after May 3, 2013: other conduct that adversely reflects on the practitioner's fitness to practice before the Office by not contacting the Department of the Navy ethics counselors to obtain specific guidance after being alerted on numerous occasions by several sources that his representation of patent and trademark applicants before the Office was ethically impermissible, in violation of 37 C.F.R. § 11.804(i).

#### **Request for Relief**

WHEREFORE, for the facts and reasons stated herein, the OED Director requests entry of an Order (1) excluding or suspending Respondent from practice before the USPTO in patent, trademark, and other non-patent matters, and (2) such additional relief as this Tribunal deems reasonable and warranted.

January 16, 2018



William R. Covey  
Deputy General Counsel for Enrollment and Discipline and  
Director of the Office of Enrollment and Discipline

### NOTICE OF CORRESPONDENCE ADDRESSES

Respondent must file an answer to the Complaint in writing with the Administrative Law Judge within thirty (30) days from the date of the filing of the Complaint. Respondent may elect to file his written answer to the Complaint in any one of four ways:

1. By electronically filing via the OALJ E-Filing System accessible on the website of the U.S. Environmental Protection Agency's Office of Administrative Law Judges at <https://yosemite.epa.gov/OA/EAB/EAB-ALJUpload.nsf>. You must visit the OALJ E-Filing System website and register as a new user at least two days prior to attempting to electronically file a document. Electronically filed documents must be in portable document ("PDF") format. The PDF must be signed and contain the contact name, phone number, mailing address, and email address of the filing party or its authorized representative. Electronic files exceeding 10 MB must be separated into files under 10 MB each or submitted on a compact disk ("CD") by mail, courier, or personal delivery. When you are ready to file your document you must log in to the OALJ E-Filing System and select the docket number of your case from a list. Registered users may find more information about electronic filing by visiting the E-Filing instructions page accessible from the OALJ E-Filing System main menu.
2. By U.S. Postal Service, via mail to the following address:

U.S. Environmental Protection Agency  
Office of Administrative Law Judges  
Mailcode 1900R  
1200 Pennsylvania Ave., NW  
Washington, DC 20460
3. By courier service (*e.g.*, UPS, FedEx, DHL) or hand delivery, via delivery to:

U.S. Environmental Protection Agency  
Office of Administrative Law Judges  
Ronald Reagan Building, Room M1200  
1300 Pennsylvania Ave., NW  
Washington, D.C. 20460
4. By facsimile transmission (if less than 20 pages) to the U.S. Environmental Protection Agency's Office of Administrative Law Judges at (202) 565-0044.

Respondent must also serve a copy of the answer on the OED Director, who is represented by Associate Solicitors Elizabeth A. Francis and Elizabeth Ullmer Mendel. A copy of the answer shall be served on the OED Director in any one of four ways:

1. By email, attaching the answer in PDF format, to the email addresses of the two Associate Solicitors named above and to: PTO-OEDcases@uspto.gov.

Elizabeth A. Francis may be contacted by telephone at (571) 272-2985, by facsimile transmission at (571) 273-0373, or by e-mail message at elizabeth.francis@uspto.gov.

Elizabeth Ullmer Mendel may be contacted by telephone at (571) 272-1021, by facsimile transmission at (571) 273-0373, or by e-mail message at elizabeth.mendell@uspto.gov.

2. By U.S. Postal Service, via mail to the following address:

United States Patent and Trademark Office  
Mail Stop 8  
Office of the Solicitor  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

3. By courier service (*e.g.*, UPS, FedEx, DHL) or hand delivery, via delivery to:

United States Patent and Trademark Office  
Office of the Solicitor  
600 Dulany Street – Madison Building West  
Eighth Floor, 8C43-A  
Alexandria, VA 22314

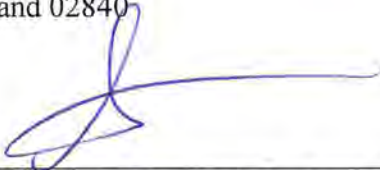
4. By facsimile transmission to the USPTO – Office of the Solicitor at: (571) 273-0373.

### CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing COMPLAINT AND NOTICE OF PROCEEDING UNDER 35 U.S.C. § 32 and NOTICE OF CORRESPONDENCE ADDRESSES was mailed this day via certified mail to Respondent at the last address he provided to the OED Director pursuant to 37 C.F.R. § 11.11:

Mr. Kevin P. Correll  
K.P. Correll & Associates, LLP  
270 Bellevue Avenue  
#326  
Newport, Rhode Island 02840

January 17, 2018



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United States Patent and Trademark Office  
Mail Stop 8  
Office of the Solicitor  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

**UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE ADMINISTRATIVE LAW JUDGE  
UNITED STATES ENVIRONMENTAL PROTECTION AGENCY**

In the Matter of:     )  
                                  )  
Kevin P. Correll,     )  
                                  )  
Respondent.         )  
                                  )  
                                  )  
\_\_\_\_\_                  )

Proceeding No. D2018-12

**ANSWER UNDER 37 CFR 11.36, DEFENSES, AND COUNTER CLAIMS**

COMES NOW the Respondent Kevin P. Correll in answering the allegations of the Complaint on file herein. The Respondent alleges that the complaint reveals an excessive abuse of a U.S. government position; and, comprises intentional fabrications, intentional half-truths, and intentional omissions, all maliciously designed by the OED Complainant to harass, intimidate, and cause further harm to the Respondent. Therefore, unless otherwise indicated herein the Respondent denies each and every element of the complaint.

Complaint 1. Respondent was registered as a patent attorney with the USPTO on September 12,2000.

**Answer 1. Admitted**

Complaint 2. Respondent's registration number is 46,641.

**Answer 2. Admitted**

Complaint 3. Respondent was admitted to practice law in Massachusetts on June 14, 1999, (Board of Bar Overseers Number 642278) and is currently an active member in good standing.

**Answer 3. Admitted**

Complaint 4. On December 8, 1999, Respondent signed an "OATH OR AFFIRMATION" in which he swore or affirmed that, if registered by the USPTO, he would, inter alia, "observe the laws and rules of practice of the Office."

**Answer 4. Admitted**

Complaint 5. On November 25, 2003, Respondent submitted a signed and dated Survey to the Office of Enrollment and Discipline ("OED"), where he checked the box "YES" to the question: "Are you an employee of the United States Government? PLEASE NOTE: U.S. Government employees are not available to accept private clients or represent clients other than their agency before the United States Patent and Trademark Office. 18 U.S.C. § 205; 37 C.F.R. § 10.10(c) and (d)."

**Answer 5. Without sufficient information to form a belief as to the truth of the allegation. Respondent does not recall the specifics of a 14-year-old survey form. Nor has the OED complainant produced said survey.**

Complaint 6. Since September 16, 2002, Respondent has been employed by the United States as an engineer for the Department of the Navy.

**Answer 6. Admitted**

Complaint 7. At all times relevant to this Complaint, Respondent remains employed by the United States.

**Answer 7. Admitted in part. Specifically, the Respondent remains employed by the U.S. Navy Department.**

Complaint 8. Respondent's acts and omissions leading to the alleged violations of the rules set forth in this Complaint were willful.



**Answer 8. Denied and without sufficient information to form a belief as to the truth of the allegation.**

Complaint 9. Paragraphs 1 through 8 above are incorporated by reference.

**Answer 9. Responses to paragraphs 1 through 8 are incorporated by reference.**

Complaint 10. The United States' criminal conflict of interest statutes, 18 U.S.C. § 203(a)(1)(B) and 18 U.S.C § 205(a)(2), generally prohibit a federal employee from acting as an attorney before any Government agency in connection with any covered matter in which the United States is a party or has a direct and substantial interest.

**Answer 10. Denied. Extracting portions of a statute is self-serving and misleading.**

Complaint 11. 18 U.S.C. § 203 prohibits a federal employee (other than for the proper discharge of his or her federal employment duties) from, inter alia, agreeing to receive compensation for any representational services as an attorney in relation to any application or proceeding or other particular matter in which the United States is a party or has a direct and substantial interest.

**Answer 11. Denied. Extracting portions of a statute is self-serving and misleading.**

Complaint 12. 18 U.S.C. § 205 prohibits a federal employee (other than in the proper discharge of his or her federal employment duties) from acting as an attorney for anyone before any agency in connection with any application or proceeding in which the United States is a party or has a direct and substantial interest.

**Answer 12. Denied. Extracting portions of a statute is self-serving and misleading.**

Complaint 13. The United States has a direct and substantial interest in the prosecution of patent applications before the Office.

**Answer 13. Denied. Federal courts have determined that the “direct and substantial interest’ for the American public is reached when a patent has been fraudulently obtained.**

Complaint 14. The United States has a direct and substantial interest in the prosecution of trademark applications before the Office.

**Answer 14. Denied.**

Complaint 15. USPTO regulation 37 C.F.R. § 11.10(e) explains that “[p]ractice before the Office by Government employees is subject to any applicable conflict of interest laws, regulations or codes of professional responsibility.”

**Answer 15. Admitted**

Complaint 16. Since September 16, 2002, Respondent has been employed by the Department of the Navy, at the Naval Undersea Warfare Center of the Naval Sea Systems Command, in Newport, Rhode Island.

**Answer 16. Admitted.**

Complaint 17. Respondent's official position description states, in pertinent part: As a senior electronics engineer, the incumbent supports the Submarine Learning Center, Groton CT in assessing and determining deployment and use of Submarine learning technologies. The incumbent will support N6/N7 in the review and assessments of new and emerging technologies for potential use by SLC as part of classroom instruction and/or submarine deployment and will assist SLC in the assessment, implementation and deployment of virtual work technologies, gaming and gaming modules, video-based media and search engines. The incumbent will conduct assessments of current technologies used by various government and contractor organizations offering training technology delivery products and tools. He/she will identify issues, conduct

research, generate reports and provide recommendations. Typical assignment of tasks can range from research, design, prototyping, experimentation, analysis and requirement development. Technical recommendations will be communicated to SLC.

**Answer 17. Admitted.**

Complaint 18. Since at least September 4, 2002, Respondent has owned and operated a private law firm, K.P. Correll & Associates, LLC, ("Correll & Associates") offering and providing patent and trademark legal services to the public.

**Answer 18. Admitted.**

Complaint 19. Correll & Associates is a domestic limited liability corporation.

**Answer 19. Admitted.**

Complaint 20. Correll & Associates was registered with the State of Rhode Island in 2008.

**Answer 20. Admitted.**

Complaint 21. Respondent lists 270 Bellevue Avenue, #326, Newport, Rhode Island 02840 as the address for Correll & Associates.

**Answer 21. Admitted in part, denied in part. Respondent lists 270 Bellevue Avenue, #326, Newport, Rhode Island 02840 as the mailing address for Correll & Associates.**

Complaint 22. An internet search for this address reveals that it is the address for a virtual office, i. e. an address without a physical office space.

**Answer 22. Denied. 270 Bellevue Avenue, #326, Newport, Rhode Island 02840 is a mailing address.**

Complaint 23. The Correll & Associates website states that clients can meet in person at the following address: Office 407, 56 North Main Street, Fall River, Massachusetts 02720.

**Answer 23. Admitted**

Complaint 24. According to the Rhode Island Department of State website, the address for Correll & Associates is 83 Country Hill Lane, North Kingstown, Rhode Island 02852. This is Respondent's home address.

**Answer 24. Admitted in part, denied in part. the Rhode Island Department of State website identifies 83 Country Hill Lane, North Kingstown, Rhode Island 02852 as the location of the principal office and 270 Bellevue Avenue, #326, Newport, Rhode Island 02840 as the mailing address.**

Complaint 25. Two fictitious business names have been filed by Respondent that are associated with Correll & Associates: Northeastern Patent Law Associates and Patent Institute.

**Answer 25. Admitted**

Complaint 26. Respondent is the sole member of Correll & Associates.

**Answer 26. Admitted. K. P. Correll & Associates is a single member LLC.**

Complaint 27. Correll & Associates is associated with USPTO Customer Number 34070.

**Answer 27. Admitted**

Complaint 28. At all times relevant to this Complaint, the website for Correll & Associates, <http://correllpatents.com>, stated: "K.P. Correll and Associates, LLC is an Intellectual Property (IP) Law firm serving corporate and individual clients across the country, and around the world, by

protecting their Intellectual Property assets through patents, federal trademarks and federal copyrights."

**Answer 28. Admitted**

Complaint 29. As of the date of filing this Complaint, Respondent is the only patent attorney listed on the website <http://correllpatents.com>.

**Answer 29. Admitted**

Complaint 30. Respondent has advertised for private clients for his law firm via the internet and in local Rhode Island barbershops.

**Answer 30. Admitted in part, denied in part. Respondent advertises via internet. Respondent has never been in a local Rhode Island barbershop and therefore is without sufficient information to form a belief as to the truth of the allegation of advertising in Rhode Island barbershops**

Complaint 31. Respondent has also advertised for private clients for his law firm in I.F. Green Airport, located at 2000 Post Road, Warwick, Rhode Island 02886.

**Answer 31. Admitted**

Complaint 32. Respondent acknowledged in his response to OED's July 18, 2017, Request for Information and Evidence Under 37 C.F.R. § 11.22(f) ("July 18, 2017 RFI"), that he was "paid/compensated for work considered 'practice before the Office' pursuant to 37 C.F.R. § 11.S(b) (including subsections (1) and (2)), including, but not limited to, preparing and/or prosecuting patent and/or trademark applications before the USPIO."

**Answer 32. Admitted**

Complaint 33. From at least June 2007 to 2016, Respondent was a voting member of the Naval Undersea Warfare Center's Invention Examination Board.

**Answer 33. Admitted**

Complaint 34. Mr. James Kasischke, a registered practitioner, and head intellectual property attorney at the Naval Undersea Warfare Center of the Naval Sea Systems Command, Department of the Navy, and an advising member of Naval Undersea Warfare Center's Invention Examination Board, spoke with Respondent a few years ago, after seeing a Correll & Associates advertisement in a local barbershop.

**Answer 34. Denied. No such conversation ever occurred.**

Complaint 35. More recently, Mr. Kasischke again saw Correll & Associates, advertising in T.F. Green Airport in Rhode Island.

**Answer 35. Without sufficient information to form a belief as to the truth of the allegation.**

Complaint 36. Mr. Kasischke confronted Respondent and reminded him that as a Federal Government employee Respondent could not represent private clients before a Federal Government agency.

**Answer 36. Denied. No such communication has ever taken place. Respondent has not seen or spoken with Mr. Kasischke in approximately 2 years. And, any communications with Mr. Kasischke were invention examination board related and never included any discussion of Respondent's private practice. Furthermore, Mr. Kasischke is not, nor ever has been, in the Respondent's chain of command.**

Complaint 37. Respondent informed Mr. Kasischke that he was not representing inventors but was referring inventors to other patent attorneys.

**Answer 37. Denied. No such communication has ever taken place.**

Complaint 38. Upon information and belief, Respondent's representation to Mr. Kasischke was false or misleading.

**Answer 38. Denied. Since no such communication has ever taken place there can be no false or misleading representation.**

Complaint 39. On September 7, 2017, Respondent stated in a response to OED's July 18, 2017 RFI that "I am resigned from the [Naval Undersea Warfare Center] Invention Examination Board .... "

**Answer 39. Admitted**

Complaint 40. Respondent did not resign from the Naval Undersea Warfare Center Invention Examination Board. Instead, Respondent was informed by the chairperson of the Board that Respondent could not participate in the Invention Examination Board due to his potential conflicts of interest.

**Answer 40. Denied. No such communication has ever taken place.**

Complaint 41. The below-listed 211 patent applications have been filed either with a power of attorney naming Respondent as the attorney of record, or where Respondent signed the application data sheet, and/or the application was prosecuted by Respondent after September 16,2002.

**Answer 41. Admitted in part, denied in part. Respondent admits patent applications have been filed either with a power of attorney naming Respondent as the attorney of record, or where Respondent signed the application data sheet, and/or the application was prosecuted by Respondent after September 16,2002. Respondent denies patent application preparation and prosecution by Respondent are impermissible. Respondent further notes that 74 of the**

**applications shown in Table 1 are application numbers beginning with 60, 61, or 62 are provisional patent applications which are not examined or prosecuted and are added to Table 1 by the OED complainant to harass, intimidate and needlessly increase the cost of litigation. Furthermore, OGE 00 x 11 Letter to a Federal Employee October 4, 2000 states, “However, [‘205] does not prohibit you from assisting them in preparing their [applications]. Our understanding is that by simply signing another’s [application] as the preparer, you are not acting as an agent but simply stating a fact.”**

Complaint 42. Respondent filed twenty patent applications (the shaded areas in Table 1) with the USPTO after OED mailed the February 9, 2017 RFI (the "Initial RFI") to Respondent which outlined 18 U.S.C. §§ 203 and 205 and 37 C.F.R. § 11.10(e).

**Answer 42. Admitted in part, denied in part. Respondent is preserving the “status quo” until the Respondent’s 5th Amendment Substantive and Procedural Due process counter claims are fully adjudicated. See generally Freedman v. State of Maryland, 380 U.S. 51, 85 S.Ct. 734, 13 L.Ed.2d 649 (1965). If Respondent were to withdraw from patent and trademark practice without judicial adjudication of the issues presented to the OED then the OED complainant could, and most likely would, interpret such withdrawal as admission that the OED complainant position is valid. Respondent makes no such admission. Respondent further admits the initial OED complainant RFI requested a statement of position to which the Respondent provided a Memorandum of Law outlining at least two defensive positions which were not questioned or otherwise contradicted in the OED complainant’s RFI #2, RFI #3, or RFI #4. Respondent further notes that 74 of the applications shown in Table 1 are application numbers beginning with 60, 61, or 62 are provisional patent applications which are not examined or prosecuted and are added to**



**Table 1 by the OED complainant to harass, intimidate and needlessly increase the cost of litigation.**

Complaint 43. Respondent was alerted by several sources that he is not permitted to represent private clients before the USPTO in patent applications while employed by the Department of the Navy, including at least: (i) by the OED Survey in November 2003, (ii) by Mr. Kasischke, and (iii) OED's Initial RFI. Yet Respondent continued to do so.

**Answer 43. (i) Without sufficient information to form a belief as to the truth of the allegation. Respondent does not recall the specifics of a 14-year-old survey form. Nor has the OED director produce said survey form. (ii) Denied, no such communication with Mr. Kasischke has ever taken place. (iii) Denied. The initial RFI stated “[w]ith a small number of exceptions, United States government employees may not represent anyone other than themselves on any matter before the executive branch. See 18 U.S.C. sec. 205.” (Emphasis added.) By making up an unsubstantiated interpretation of 18 U.S.C. 205 the OED incorrectly characterized 18 U.S.C. 205 and its exceptions. The Respondent further admits the initial RFI requested a statement of position to which the Respondent provided a Memorandum of Law outlining at least two defensive positions which were not questioned or otherwise contradicted in RFI #2, RFI #3, or RFI #4.**

Complaint 44. Telephone number 401-295-7377 is associated with Correll & Associates and Respondent's home address.

**Answer 44. Admitted in part. Telephone number 401-295-7377 is a permanent roll through number.**

Complaint 45. Massachusetts phone number 508-676-8400 is an alternate phone number for

Correll & Associates.

**Answer 45. Admitted in part. Telephone number 508-676-8400 is a permanent roll through number.**

Complaint 46. Rhode Island phone number 401-954-8183 is Respondent's cell phone number.

**Answer 46. Admitted**

Complaint 47. In response to the July 18,2017 RFI, Respondent stated that a regular workweek schedule for him at the Naval Undersea Warfare Center is Monday through Friday from 08:00am-12:00pm and 12:30pm-4:30pm (16:30hrs).

**Answer 47. Admit that Respondent stated that nominal workweek schedule is Monday through Friday from 08:00am-12:00pm and 12:30pm-4:30pm and clarified in RFI #4 where Friday's are often 0700-1200 and 1230-1530. Clearly, however, over a period of years a nominal workweek schedule varies due to numerous events: early secure, snow storms, hurricanes, base or building issues, and on and on.**

Complaint 48. According to USPTO records, Respondent conducted approximately twenty-four patent examiner telephone contacts during his working duty hours at the Department of the Navy in the patent applications listed in Table 2 below.

**Answer 48. Denied. Moreover, the Respondent asserts that the OED Complainant is presenting the majority of the twenty-four patent examiner telephone contacts spread over seven (7) years for improper purposes such as to harass, cause unnecessary delay, or needlessly increase the cost of litigation. For example, patent application serial number 11/487,635 listed in OED Complainant's Table 2 has no data with regard to who made the call or call duration. Other frivolous examples include 5-second phone calls made by the**

**USPTO to the Respondent's phone number. The Respondent cannot possibly be held accountable for a 5-second made by the USPTO. Nor does the OED Complainant include time zone of call which is relevant since there are multiple USPTO offices and many examiners telecommute from across the country. Nor does the OED Complainant identify if any of the listed examiner were subjects of the Department of Justice's time card Fraud Investigation of the patent examiner corp.**

Complaint 49. The below-listed eighty trademark applications have been filed with Respondent's name as attorney of record and/or prosecuted by Respondent after September 16, 2002, the Respondent's start date with the Department of the Navy.

**Answer 49. Admitted in part, denied in part. Respondent admits trademark applications have been filed either with a power of attorney naming Respondent as the attorney of record, or where Respondent and/or the application was prosecuted by Respondent after September 16,2002. Respondent denies trademark application preparation and prosecution by Respondent are impermissible.**

Complaint 50. Respondent filed either applications or documents in thirty-four trademark applications (the shaded areas in Table 3) with the USPTO after OED mailed the Initial RFI to the Respondent on February 9, 2017, which outlined 18 U.S.C. §§ 203 and 205 and 37 C.F.R. § 11.10(e).

**Answer 50. Admitted in part, denied in part.. Respondent is preserving the "status quo" until the Respondent's 5th Amendment Substantive Due process claims are fully adjudicated. See generally Freedman v. State of Maryland, 380 U.S. 51, 85 S.Ct. 734, 13 L.Ed.2d 649 (1965) Furthermore, the initial RFI stated "[w]ith a small number of exceptions, United States government employees may not represent anyone other than themselves on any matter**

**before the executive branch. See 18 U.S.C. sec. 205.” (Emphasis added.) By making up an unsubstantiated interpretation of 18 U.S.C. 205 the OED incorrectly characterized 18 U.S.C. 205 and its exceptions. The Respondent further admits the initial RFI requested a statement of position to which the Respondent provided a Memorandum of Law outlining at least two defensive positions which were not questioned or otherwise contradicted in RFI #2, RFI #3, or RFI #4.**

Complaint 51. Respondent was alerted by several sources that he is not permitted to represent private clients before the USPTO in trademark applications while employed by the Department of the Navy including at least: (i) by the OED Survey in November 2003, (ii) by Mr. Kasischke, and (iii) by OED's Initial RFI on February 9, 2017. Yet Respondent continued to do so.

**Answer 51. (i) Without sufficient information to form a belief as to the truth of the allegation. Respondent does not recall the specifics of a 14-year-old survey form. (ii) Denied, no such communication with Mr. Kasischke has ever taken place. (iii) Denied. The initial RFI stated “[w]ith a small number of exceptions, United States government employees may not represent anyone other than themselves on any matter before the executive branch. See 18 U.S.C. sec. 205.” (Emphasis added.) By making up an unsubstantiated interpretation of 18 U.S.C. 205 the OED incorrectly characterized 18 U.S.C. 205 and its exceptions. The Respondent further admits the initial RFI requested a statement of position to which the Respondent provided a Memorandum of Law outlining at least two defensive positions which were not questioned or otherwise contradicted in RFI #2, RFI #3, or RFI #4.**

Complaint 52. In the forty-eight trademark applications listed in the Table 4 below, Respondent filed documents with the USPTO during his normal working duty hours at the Department of the Navy.

**Answer 52. Denied. Moreover, the Respondent asserts that the OED Complainant is presenting the majority of the forty-eight trademark applications listed in table 4 spread over three (3) years for improper purposes such as to harass, cause unnecessary delay, or needlessly increase the cost of litigation. For example, Jan 16, 2016 listed in the Date/Time Stamp column was a federal holiday and by definition not the Respondent's "normal working duty hours". Similarly, July 3, 2015 was a federal holiday. In addition, all transactions on July 22, 2016 were Client submitted Change of Attorney responses to an USPTO generated email. Thus, the Respondent was not involved at the time the Client responded to the USPTO generated email. Moreover, the OED Complainant is well aware of the above since the same responses were provided in RFI #4.**

Complaint 53. Despite being put on notice that his conduct was prohibited, Respondent failed to withdraw from the representation of private clients before the USPTO.

**Answer 53. Denied. Respondent also offered to resign from government service. Respondent is now preserving the "status quo" until the Respondent's 5th Amendment Substantive Due process claims are fully adjudicated. See generally *Freedman v. State of Maryland*, 380 U.S. 51, 85 S.Ct. 734, 13 L.Ed.2d 649 (1965) Furthermore, the initial RFI stated "[w]ith a small number of exceptions, United States government employees may not represent anyone other than themselves on any matter before the executive branch. See 18 U.S.C. sec. 205." (Emphasis added.) By making up an unsubstantiated interpretation of 18 U.S.C. 205 the OED incorrectly characterized 18 U.S.C. 205 and its exceptions. The Respondent further admits the initial RFI requested a statement of position to which the Respondent provided a Memorandum of Law outlining at least two defensive positions which were not questioned or otherwise contradicted in RFI #2, RFI #3, or RFI #4. Respondent also offered to resign from government service.**

Complaint 54. By reason of the conduct described above, Respondent has engaged in the following misconduct prior to May 3, 2013: (a) – (f)

**Answer 54. Denied.**

Complaint numbers 55 – 67

**Answer 55-67 Denied or without sufficient information to form a belief as to the truth of the allegations. Furthermore, the Respondent asserts that the OED Complainant is intentionally increasing the complaint count for improper purposes such as to harass, cause unnecessary delay, or needlessly increase the cost of litigation by adding complaint numbers with no text.**

Complaint 68. By reason of the conduct described above, Respondent has engaged in the following misconduct on or after May 3,2013: (a) – (f)

**Answer 68. Denied.**

Complaint numbers 69 – 77

**Answer 69-77 Denied or without sufficient information to form a belief as to the truth of the allegations. Furthermore, the Respondent asserts that the OED Complainant is intentionally increasing the complaint count for improper purposes such as to harass, cause unnecessary delay, or needlessly increase the cost of litigation by adding complaint numbers with no text.**

Complaint 78. Paragraphs 1 through 8 above are incorporated by reference.

**Answer 78. Responses to paragraphs 1 through 8 are incorporated by reference.**

Complaint 79. Under 5 C.F.R. § 2635.107(b), employees are advised to seek ethics advice where there are questions concerning ethics rules:[ ].

**Answer 79. Admitted 5 C.F.R. § 2635.107(b) advises employees to seek ethics advice where there are questions concerning ethics rules regarding real or apparent misuse or abuse of the employee's government position as listed in 5 C.F.R. § 2635.101(b)**

Complaint 80. As part of his employment with the Department of the Navy, Respondent was required to complete annual ethics training.

**Answer 80. Admitted.**

Complaint 81. Upon information and belief, the trainings included the contact information for the Department of the Navy ethics counselor.

**Answer 81. Without sufficient information to form a belief as to the truth of the allegation. The Respondent does not recall what contact information was provided.**

Complaint 82. Respondent was alerted by several sources that he is not permitted to represent private clients before the USPTO in patent and trademark applications while employed by the Department of the Navy, including at least: (i) by the OED Survey in November 2003, (ii) by Mr. Kasischke, (iii) OED's Initial RFI on February 9, 2017, and (iv) on information and belief, by the Department of the Navy's ethics annual training.

**Answer 82. (i) Without sufficient information to form a belief as to the truth of the allegation. Respondent does not recall the specifics of a 14-year-old survey form. (ii) Denied, no such communication with Mr. Kasischke has ever taken place. (iii) Denied. The initial RFI stated “[w]ith a small number of exceptions, United States government employees may not represent anyone other than themselves on any matter before the executive branch. See 18**

**U.S.C. sec. 205.” (Emphasis added.) By making up an unsubstantiated interpretation of 18 U.S.C. 205 the OED is incorrectly characterizing 18 U.S.C. 205 and its exceptions. Indeed, the OED Complainant is making up its own law. The OED Complainant should not rely upon any description or synopsis of a statutory restriction, but should refer to the statute itself. The Respondent further admits the initial RFI requested a statement of position to which the Respondent provided a Memorandum of Law outlining at least two defensive positions which were not questioned or otherwise contradicted in RFI #2, RFI #3, or RFI #4.**

**(iv) Denied. Nowhere does the Respondent recall the Department of the Navy’s annual ethics training discussing representing private clients before the U.S. Patent and Trademark Office.**

Complaint 83. At no time did Respondent contact the Department of the Navy ethics counselor to seek advice or inform the ethics counselor of the relevant circumstances, namely that he was representing third-party private clients in patent and trademark applications before the Office.

**Answer 83. Admitted. However, Respondent had fiduciary duties to clients, approval from immediate government supervisor and no real or apparent conflict in accordance with the exceptions in 18 U.S.C. 205 and 18 U.S.C. 203; and; when required Respondent also noted on OGE Form 450 any positions, whether or not compensated, held outside the U.S. Government during the reporting period.**

Complaint 84. By reason of the conduct described above, Respondent has engaged in the following misconduct prior to May 3, 2013: other conduct that adversely reflects on the practitioner's fitness to practice before the Office by not contacting the Department of the Navy ethics counselors to obtain specific guidance after being alerted on numerous occasions that his representation of patent



and trademark applicants before the Office was ethically impermissible, in violation of 37 C.F.R. § 10.23(b)(6).

**Answer 84. Denied**

Complaint 85. By reason of the conduct described above, Respondent has engaged in the following misconduct on or after May 3, 2013: other conduct that adversely reflects on the practitioner's fitness to practice before the Office by not contacting the Department of the Navy ethics counselors to obtain specific guidance after being alerted on numerous occasions by several sources that his representation of patent and trademark applicants before the Office was ethically impermissible, in violation of 37 C.F.R. § 11.804(i).

**Answer 85. Denied.**

## **Counter Claims and Defenses**

### **Defense of Statue of Limitations**

86. Respondent realleges and incorporates herein the Answers 1-85.

87. The OED Complainant alleges that a Department of the Navy employee representing clients before the USPTO, not in the course of his official Navy duties, and so removed from any actual or potential conflict of interest, implicates the statutory requirements of 18 U.S.C. 203 and/or 18 U.S.C. 205 to act as a bar to such practice.

88. 18 U.S.C 3282 states that [e]xcept as otherwise expressly provided by law, no person shall be prosecuted, tried, or punished for any offense, not capital, unless the indictment is found or the information is instituted within five years next after such offense shall have been committed.

89. The OED Compliant alleges the Respondent represented clients before the USPTO more than five years prior to the initial Request for Information (RFI) February 10, 2017.

90. The OED Complaint is void for violating 18 U.S.C 3282.

**The OED violated the Respondent's 5<sup>th</sup> Amendment Substantive Due Process right to earn  
a lawful livelihood**

91. Paragraphs 86-90 above are incorporated by reference

92. The OED Complainant has not identified any matters in which the Respondent has participated personally and substantially as a Government employee or special Government employee through decision, approval, disapproval, recommendation, the rendering of advice, investigation, or otherwise, or in those matters which are the subject of the Respondent's official responsibility, and which conflict with the Respondent's representing clients before the USPTO.

93. The OED employee Kimberly C. Weinreich was responsible for the generation of RFI #1, RFI #2, RFI #3, and RFI #4.

94. At least RFI #1 stated “[w]ith a small number of exceptions, United States government employees may not represent anyone other than themselves on any matter before the executive branch. See 18 U.S.C. sec. 205.” (Emphasis added.)

95. The OED employee Kimberly C. Weinreich arbitrarily and capriciously interpreted 18 U.S.C. 205 to include “any matter” (Initial RFI, page 2).

96. The USPTO maintains the Public Application Information Retrieval (PAIR) database for storing and retrieving patent application information.

97. The PAIR database includes all information associated with a patent application, including, but not limited to initial application, USPTO office actions, responses to office actions, telephone interview summaries, notices of allowances, reasons for allowance, notices of abandonment, reasons for abandonment and petitions for various matters associated with the patent application, collectively referred to as the File Wrapper History.

98. Since approximately 2004 the File Wrapper History of any patent application or patent is available via PAIR approximately 18 months after the earliest priority date or at patent publication

99. The PAIR Database is publicly available to anyone anywhere in the world having an internet connection.

100. The OED alleges that the Respondent is using his Navy position or inside information to corrupt or distort a patent examiners patent examination process.

101. The OED alleges that the Respondent’s use of inside Navy information to corrupt or distort a patent examiner’s patent examination process would not be readily and publicly discernable when the File Wrapper History is available via PAIR.

102. patent prosecution is a collaboration between an applicant and a patent examiner to properly identify the scope of the applicant's invention in light of publicly available prior art.

103. Prosecution of a patent application begins when a patent examiner opens prosecution.

104. Prosecution of a patent application stops when a patent examiner closes prosecution.

105. The USPTO maintains the Trademark Electronic Search System (TESS) database for storing and retrieving trademark application information.

106. The TESS database includes all historical and pending information associated with a trademark application, including, but not limited to initial application, USPTO office actions, responses to office actions, telephone interview summaries, notices of allowances, reasons for allowance, notices of abandonment, reasons for abandonment and petitions for various matters associated with the trademark application.

107. The pending and historical information associated with any registered trademark or trademark application is immediately viewable via TESS.

108. The TESS Database is publicly available to anyone anywhere in the world having an internet connection.

109. The OED alleges that the Respondent is using his Navy position or inside information to corrupt or distort a trademark examiner's trademark examination process.

110. The OED alleges that the Respondent's use of inside Navy information to corrupt or distort a trademark examiner's trademark examination process would not be readily and publicly discernable via TESS.

111. The OED arbitrarily and capriciously interprets 18 U.S.C. 205 (e) "any person" to mean only close relatives.

112. 5 CFR 2635.101 explains, in part, "...that each employee should not rely upon and description or synopsis of a statutory restriction, but should refer to the statute itself..."

113. The OED Complainant willfully asserted the Respondent filed documents with the USPTO during his normal working duty hours at the Department of the Navy despite the OED complainant knowing the documents were filed on Saturdays, Sundays, and Federal Holidays.

114. The OED complainant willfully asserted the Respondent conducted telephone interviews with patent examiners during his normal working duty hours at the Department of the Navy even though the outgoing phone calls were initiated by the USPTO examiner and lasted five (5) seconds.

115. The OED complainant willfully asserted the Respondent conducted telephone interviews with patent examiners during his normal working duty hours at the Department of the Navy even though the USPTO has no knowledge of when or where the call was made.

116. USPTO patent examiners telework from around the country.

117. USPTO patent examiners work at various USPTO offices around the country.

118. USPTO trademark examiners telework from around the country.

119. USPTO trademark examiners work at various USPTO offices around the country.

120. The OED complainant failed to identify the time zones associated with the patent interviews listed in complaint number 48, table 2.

121. For each of the patent application numbers listed in complaint number 48, table 2 the OED Complainant failed to identify if the patent interviews were the only calls made on the date shown.

122. An August 2016 report entitled “Investigative Report, U.S. Patent and Trademark Office, Analysis of Patent Examiners’ Time and Attendance, Report Number 14-0990” by the U.S. Department of Commerce, Office of Inspector General, Office of Investigations found 137,622 unsupported hours for one nine-month period for USPTO patent examiners and nearly 180,000 unsupported hours for one 15-month period for USPTO patent examiners.

123. The OIG did not conduct a criminal investigation (or refer the matter to the U.S. Department of Justice for further investigation) and did not recommend that the USPTO pursue administrative action against any of the individual examiners analyzed in the August 2016 report entitled “Investigative Report, U.S. Patent and Trademark Office, Analysis of Patent Examiners’ Time and Attendance, Report Number 14-0990” by the U.S. Department of Commerce, Office of Inspector General, Office of Investigations.

124. The OED Complainant willfully asserted the Respondent filed documents with the USPTO during his normal working duty hours at the Department of the Navy even though the OED Complainant knew, or should have known, that the documents were filed by a client in response to a USPTO generated Change of Attorney email.

125. The OED Complainant has not alleged that the Respondent directly, or indirectly, improperly influenced, attempted to improperly influence, offered or agreed to improperly influence, or attempt to offer or agree to improperly influence an official action of any employee of the USPTO by: (i) Use of threats, false accusations, duress, or coercion, (ii) An offer of any special inducement or promise of advantage, or (iii) Improperly bestowing of any gift, favor, or thing of value.

126. According to the USPTO Code of Professional Responsibility a practitioner has a fiduciary duty of care for clients and prospective clients.

**The OED Complainant arbitrarily and capriciously excluded Respondent from the 18 USC 205 (e) exemption thereby violating the Respondent’s 1st Amendment right to free association.**

127. Paragraphs 86 to 126 are incorporated by reference.

128. Upon information and belief, OED employee Kimberly C. Weinreich arbitrarily and capriciously interpreted excluded Respondent from 18 U.S.C. 205 exceptions and, without a fair and impartial hearing, communicated said interpretation to Naval Undersea Warfare Center personnel, thereby creating a hostile work environment for the Respondent.

**The OED Complainant violated the Respondent's 5<sup>th</sup> Amendment Procedural Due Process right to a fair and impartial hearing**

129. Paragraphs 86 to 128 are incorporated by reference.

130. 5 U.S.C. 557 (d)(1)(B) states "...no member of the body comprising the agency, administrative law judge, or other employee who is or may reasonably be expected to be involved in the decisional process of the proceeding, shall make or knowingly cause to be made to any interested person outside the agency an ex parte communication relevant to the merits of the proceeding..."

131. 37 CFR 11.36 states, in part, "The USPTO Director may affirm, reverse, or modify the initial decision or remand the matter to the hearing officer for such further proceedings as the USPTO Director may deem appropriate. In making a final decision, the USPTO Director shall review the record or the portions of the record designated by the parties. []"

132. Upon information and belief, from December 2016 through January 2018, The USPTO employee Kimberly C. Weinreich did make conclusory ex parte communications relevant to the merits of this proceeding to employees of the Naval Undersea Warfare Center. Upon information and belief, the USPTO employee Kimberly C. Weinreich did make statements to Mr. Kasischke that the Respondent was guilty of violating 18 U.S.C. 203 and 18 U.S.C. 205, or words to that effect.

**The OED Complainant violated the Respondent's Privacy Act Rights**

133. Paragraphs 129 to 133 are incorporated by reference.

134. 5 U.S.C. 552 a (d) (1) explains that “upon request by any individual to gain access to his record or to any information pertaining to him which is contained in the system [ ].”

135. In a response to the OED complainant's RFI #3 the Respondent requested copy of the written information received by the OED complainant on December 19, 2016 as identified in the Tolling Agreement executed August 4, 2016.

136. In a response to the OED complainant's RFI #4 the Respondent requested copy of the written information received by the OED complainant on December 19, 2016 as identified in the Tolling Agreement executed August 4, 2016.

137. The OED complainant refuses to provide the Respondent with requested copy of the written information received by the OED complainant on December 19, 2016 as identified in the Tolling Agreement executed August 4, 2016.

**2<sup>nd</sup> Defense of Statue of Limitations**

138. Paragraphs 86 to 137 are incorporated by reference.

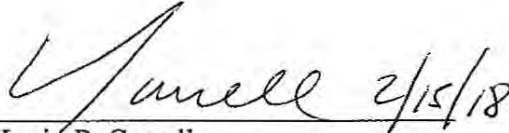
139. 37 CFR 11.34 (d) states “...No complaint shall be filed more than ten years after the date on which the misconduct forming the basis for the proceeding occurred.”

140. OED Complainant knowingly included in OED Complainant's Table 1 alleged misconduct far exceeding ten years for the purpose of harassment and intimidation.



**Request for Relief**

WHEREFORE, for the facts and reasons stated herein, the Respondent requests entry of an Order (1) dismissing the OED complaint, and (2) such additional relief as this Tribunal deems reasonable and warranted.

A handwritten signature in black ink, appearing to read 'Kevin P. Correll', followed by the date '2/15/18'.

Kevin P. Correll  
270 Bellevue Ave., #326  
Newport, RI 02840  
401-954-8183  
correllkp@hotmail.com

**CERTIFICATE OF SERVICE**

1. I hereby certify that a copy of the foregoing **ANSWER UNDER 37 CFR 11.36, DEFENSES, AND COUNTER CLAIMS** was electronically filed this day 15 FEB 2018 on the website of the U.S. Environmental Protection Agency's Office of Administrative Law Judges at <https://yosemite.epa.gov/OA/EAB/EAB-ALJ Upload.nsf>.

2. I hereby certify that a copy of the foregoing **ANSWER UNDER 37 CFR 11.36, DEFENSES, AND COUNTER CLAIMS** was electronically emailed to [elizabeth.francis@uspto.gov](mailto:elizabeth.francis@uspto.gov).

3. I hereby certify that a copy of the foregoing **ANSWER UNDER 37 CFR 11.36, DEFENSES, AND COUNTER CLAIMS** was electronically emailed to [elizabeth.mendell@uspto.gov](mailto:elizabeth.mendell@uspto.gov).

  
Kevin P. Correll  
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Newport, RI 02840  
401-954-8183  
[correllkp@hotmail.com](mailto:correllkp@hotmail.com)

**UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE ADMINISTRATIVE LAW JUDGE**

<b>In the Matter of</b>  <b>Kevin P. Correll,</b>  <b>Respondent.</b>	) ) ) ) )	<b>Proceeding No. D2018-12</b>
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**ORDER ON RESPONDENT’S MOTION TO DISMISS**

On January 17, 2018, the Director of the Office of Enrollment and Discipline (“OED Director”) of the United States Patent and Trademark Office (“PTO” or “Office”) commenced this action by filing a Complaint and Notice of Proceedings under 35 U.S.C. § 32 against Respondent Kevin P. Correll. The Complaint alleges two counts of misconduct under the PTO Code of Professional Responsibility (“PTO Code”) and the PTO Rules of Professional Conduct (“PTO Rules”).<sup>1</sup> The alleged misconduct arises from Respondent’s representation of private parties before the PTO while he was employed by the federal government. *See* Compl., ¶¶ 54, 68, 84-85.<sup>2</sup> For these violations, the OED Director seeks to exclude or suspend Respondent from practice before the PTO in patent, trademark, and other non-patent matters. *See* Compl. at 27.

Respondent filed an Answer, Defenses, and Counterclaims on February 15, 2018. In his Answer, Respondent admits nearly all of the alleged facts that are material to liability in this matter. He also sets forth a range of “Counter Claims and Defenses.” Answer, ¶¶ 86-140. These include two statute of limitations defenses. Answer, ¶¶ 86-90, 138-140.

On May 31, 2018, Respondent filed a Motion to Dismiss based on his statute of limitations defense. *See* Motion to Dismiss Complaint (“MTD”). Thereafter, the OED Director filed his opposition to Respondent’s MTD. *See* OED Director’s Opposition to Respondent’s Motion to Dismiss Complaint (June 15, 2018) (“MTD Opposition”). Respondent submitted a reply to the OED Director’s MTD Opposition on July 2, 2018. *See* Memorandum in Support of Respondent’s Motion to Dismiss (“Reply”).

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<sup>1</sup> As of May 3, 2013, the PTO Rules govern attorney practicing before the Office. *See* 37 C.F.R. §§ 11.101-11.901. The PTO Code applied to misconduct occurring prior to that date. *See* 37 C.F.R. §§ 10.20-10.112 (repealed). The misconduct alleged in the Complaint occurred before and after May 3, 2013, so both the PTO Code and the PTO Rules apply in this proceeding.

<sup>2</sup> The Complaint contains no paragraphs between those numbered 54 and 68.

### Legal Background

Congress authorized the PTO to promulgate regulations governing “the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Office.” 35 U.S.C. § 2(b)(2)(D). If an attorney does not comply with regulations issued under § 2(b)(2)(D), or if he is “shown to be incompetent or disreputable, or guilty of gross misconduct,” the PTO may suspend or exclude the attorney from further practice before the PTO. 35 U.S.C. § 32. *See also Sheinbein v. Dudas*, 465 F.3d 493, 495 (Fed. Cir. 2006). “Under these statutes, the PTO has the exclusive authority to establish qualifications for admitting persons to practice before it, and to suspend or exclude them from practicing before it.” *Kroll v. Finnerty*, 242 F.3d 1359, 1364 (Fed. Cir. 2001).

In 1985, the PTO issued regulations based on the ABA Model Code of Professional Responsibility to govern attorney conduct and practice. *See Practice Before the Patent and Trademark Office*, 50 Fed. Reg. 5158 (Feb. 6, 1985) (Final Rule) (codified at 37 C.F.R. §§ 10.20-10.112). These rules set forth the PTO Code. In May 2013, the PTO replaced the PTO Code with the PTO Rules, which are fashioned on the ABA’s Model Rules of Professional Conduct. *See Changes to Representation of Others Before the United States Patent and Trademark Office*, 78 Fed. Reg. 20180 (April 3, 2013) (Final Rule) (codified at 37 C.F.R. §§ 11.101-11.901).

### Conflicts of Interest Laws

Independent of PTO regulations, federal criminal law sets forth conflicts of interest prohibitions for federal employees. *See* 18 U.S.C. §§ 203, 205. Specifically, an employee of the United States may not directly or indirectly “demand[ ], seek[ ], receive[ ], accept[ ], or agree[ ] to receive or accept any compensation for any representational services, as agent or attorney or otherwise, rendered or to be rendered either personally or by another” in “any proceeding, application, [or] request for a ruling or other determination . . . in which the United States is a party or has a direct and substantial interest[.]” 18 U.S.C. § 203(a)(1)(B). Additionally, “an officer or employee of the United States . . . other than in the proper discharge of his official duties” may not “act[ ] as agent or attorney for anyone before any department [or] agency . . . in connection with any covered matter in which the United States is a party or has a direct and substantial interest[.]” 18 U.S.C. § 205(a)(2).

The PTO Rules specifically incorporate these federal conflicts of interest laws as standards that apply to practitioners: “Practice before the [PTO] by Government employees is subject to any applicable conflict of interest laws, regulations or codes of professional responsibility.” 37 C.F.R. § 11.10(e).

### Relevant Statutes of Limitation

According to the federal statute that governs suspension or exclusion from practice before the PTO:

A proceeding under this section shall be commenced not later than the earlier of either the date that is 10 years after the date on which the misconduct forming the basis for the proceeding occurred, or 1 year after the date on which the misconduct forming the basis for the proceeding is made known to an officer or employee of the Office as prescribed in the regulations established under section 2(b)(2)(D).

35 U.S.C. § 32. The regulations established under 35 U.S.C. § 2(b)(2)(D) provide that “[a] complaint shall be filed within one year after the date on which the OED Director receives a grievance forming the basis of the complaint. No complaint shall be filed more than ten years after the date on which the misconduct forming the basis for the proceeding occurred.” 37 C.F.R. § 11.34(d). A “grievance” is “a written submission from any source received by the OED Director that presents possible grounds for discipline of a specified practitioner.” 37 C.F.R. § 11.1.

Additionally, federal law states that “[e]xcept as otherwise provided by Act of Congress, an action, suit or proceeding for the enforcement of any civil fine, penalty, or forfeiture, pecuniary or otherwise, shall not be entertained unless commenced within five years from the date when the claim first accrued . . . .” 28 U.S.C. § 2462.

### Motion to Dismiss Standard

In this proceeding, the parties may file “all prehearing motions commonly filed under the Federal Rules of Civil Procedure.” 37 C.F.R. § 11.43. The Federal Rules allow a party to move for dismissal of a complaint based on its failure to state a claim upon which relief can be granted, and “[a] motion to dismiss based on the expiration of the statute of limitations is analyzed under Rule 12(b)(6).” *Chapman v. Wal-Mart Stores E., LP*, 2018 U.S. Dist. LEXIS 78630, at \*11 (E.D. Va. May 9, 2018) (quoting *Moseke v. Miller & Smith, Inc.*, 202 F. Supp. 2d 492, 501 (E.D. Va. 2002)); *see also* Fed. R. Civ. P. 12(b)(6).

To survive a motion to dismiss, “[a] plaintiff must assert facts that rise above speculation and conceivability to those stating a claim that is ‘plausible on its face.’” *Taylor v. CVS, Inc.*, 2018 U.S. Dist. LEXIS 114954, at \*1 n.2 (E.D. Va. July 10, 2018) (quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). “A claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged.” *Id.* (quoting *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009)). Further, “a plaintiff’s well-pleaded allegations are taken as true and the complaint is viewed in the light most favorable to the plaintiff.” *Id.* (citing *Mylan Labs., Inc. v. Matkari*, 7 F.3d 1130,

1134 (4th Cir. 1993)).

“A defendant’s claim that an action is time barred is an affirmative defense that it can raise in a motion to dismiss when the ‘face of the complaint includes all necessary facts for the defense to prevail.’” *Chapman*, 2018 U.S. Dist. LEXIS at \*\*11-12 (quoting *Meridian Investments, Inc. v. Fed. Home Loan Mortg. Corp.*, 855 F.3d 573, 577 (4th Cir. 2017)). *See also Olawole v. ActioNet, Inc.*, 258 F. Supp. 3d 694, 703-04 (E.D. Va. 2017) (“A claim should not be dismissed for failure to state a claim based on an affirmative defense, such as statute of limitations, but where the facts necessary to support the defense appear on the face of the complaint, dismissal is appropriate.”).

## Discussion

### Respondent’s Argument

Respondent’s statute of limitations arguments all turn on the date that he contends the OED Director had or should have had notice of his misconduct. According to Respondent, this date is December 2, 2003, when he responded to an OED survey and indicated he was a government employee. *See* MTD at 3, 6, 8.

Thus, Respondent first contends the statute of limitations has run for any misconduct occurring before September 16, 2006. According to Respondent, prior to September 16, 2011, when Congress amended 35 U.S.C. § 32 to include the one- and ten-year limitations, PTO disciplinary investigations were governed by “the general Statute of Limitations (SOL) provision stated in 28 U.S.C. § 2462.” MTD at 5. Consequently, he reasons, “any act by the Respondent before September 16, 2006 is over five years before 35 U.S.C. § 32 was effective” and is outside of the statute of limitations. MTD at 5. Likewise, Respondent further objects to the inclusion of any such conduct as an aggravating factor when determining an appropriate sanction. Reply at 6.

Respondent next argues that 35 U.S.C. § 32 provided “the only operative SOL” before enactment of the regulations implementing the statute of limitations. MTD at 5. Therefore, between September 16, 2011, and August 30, 2012, the date the implementing regulations became effective, Respondent claims the OED Director had a year to file a complaint because the OED Director had known since 2003 that Respondent was a government employee. MTD at 5-6; *see also* Implementation of Statute of Limitations Provisions for Office Disciplinary Proceedings, 77 Fed. Reg. 45247 (July 31, 2012) (Final Rule). In fact, Respondent argues, the OED Director had a duty and necessary resources to discover his misconduct through diligent investigation. Reply at 7-12.

Third, Respondent similarly asserts time has expired for disciplining any misconduct occurring after August 30, 2012, when the regulatory statute of limitations became effective. MTD at 7-9. According to Respondent, because the OED Director knew of Respondent’s misconduct in 2003, the OED Director had a year to file a Complaint starting the day the

regulations became effective. MTD at 8; Reply at 13-14.

### OED Director's Argument

Unlike Respondent's claim that the OED Director was notified of his misconduct in 2003, the OED Director contends that PTO did not receive a "written grievance" under the applicable statute and regulations until December 2016. MTD Opposition at 2. Specifically, the OED Director states, "[i]t was the December 19, 2016 grievance which contained information that Respondent was both a government employee **and** engaging in representational activities before the Office that led to the opening of an investigation by OED." MTD Opposition at 3. It was that investigation that "eventually formed the basis for the Complaint," the OED Director asserts. MTD Opposition at 3. Thus, the OED Director argues that he "timely filed his Complaint within the applicable deadline set by 37 C.F.R. § 11.34(d) that was triggered by the December 19, 2016 grievance."<sup>3</sup> MTD Opposition at 3.

The OED Director further asserts that the 2003 OED survey in which Respondent acknowledges he is a government employee did not put the office on notice of any misconduct. MTD Opposition at 3-4. Indeed, a PTO-licensed attorney who works for the federal government is not generally prohibited from having a law firm or practicing in an area such as family law or construction law where the United States is not likely to be a party or have a substantial interest, the OED Director points out. MTD Opposition at 4.

Considering the OED Director did not know of Respondent's misconduct until December 19, 2016, Respondent's statute of limitations arguments fall away, the OED Director states. MTD Opposition at 4. Regarding misconduct prior to 2006, the OED Director concedes he is prosecuting Respondent only for misconduct that occurred between October 2007 and October 2017, mooted Respondent's 28 U.S.C. § 2462 argument. MTD Opposition at 4-5. Any misconduct prior to 2007 was included in the Complaint only "to provide a complete picture" of the length of Respondent's misconduct, which the OED Director points to as an aggravating factor that must be considered when determining an appropriate sanction. MTD Opposition at 5. As for the period of time between September 16, 2011 and August 30, 2012, the OED Director asserts he did not have actual notice in 2003 of Respondent's misconduct, nor was he

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<sup>3</sup> It is clear that more than one year passed between December 19, 2016, when the written grievance was received, and January 17, 2018, when the Complaint was filed. However, Respondent has never argued that the Complaint was untimely filed in relation to the 2016 written grievance. Additionally, he references in his Answer a tolling agreement executed August 4, 2016, that would have delayed the one-year filing deadline for the Complaint. Answer, ¶¶ 135-137; *see also* 37 C.F.R. 11.34(e) ("The one-year period for filing a complaint under paragraph (d) of this section shall be tolled if the involved practitioner and the OED Director agree in writing to such tolling."). Finally, as no evidence to contrary has been elicited, I accept as true the OED Director's statement that he "timely filed his Complaint" in response to the 2016 written grievance. *See* MTD Opposition at 2, 3.



obligated to “discover” Respondent’s misconduct. MTD Opposition at 5-8. The same is true with respect to misconduct occurring after August 30, 2012, the OED Director adds. MTD Opposition at 9.

### Analysis

Respondent presents insufficient evidence that the Complaint is barred by any statute of limitations, because his 2003 survey response was not a “written grievance” and it did not obligate the OED Director to investigate further.

On November 25, 2003, Respondent submitted a signed and dated response to a survey circulated by the Office of Enrollment and Discipline. Compl., ¶ 5; MSJ, Ex. A.<sup>4</sup> He provided his name as well as the name of his business, “K.P. Correll & Associates LLP,” plus home and business addresses. Compl., ¶ 5; MSJ, Ex. A. He also indicated he was an attorney and member of the Massachusetts state bar. Compl., ¶ 5; MSJ, Ex. A. Question 6 on the survey read as follows:

Are you an employee of the United States Government? *PLEASE NOTE: U.S. Government employees are not available to accept private clients or to represent clients other than their agency before the United States Patent and Trademark Office. 18 U.S.C. § 205; 37 CFR § 10.10(c) and (d).*

Compl., ¶ 5; MSJ, Ex. A. Respondent checked the box “YES” in response to Question 6. Compl., ¶ 5; MSJ, Ex. A. The OED Director received the survey response on December 2, 2003. Compl., ¶ 5; MSJ, Ex. A.

Nothing in Respondent’s survey responses notified the OED Director that Respondent was representing third parties before the PTO while he was a government employee. Consequently, nothing in the responses notified the OED Director that Respondent was potentially committing misconduct. At most, the survey response informed the OED Director that Respondent was a Massachusetts-licensed patent attorney who was employed by the United States Government and operated a private law firm. *See* MTD at 3, 6. This alone is not a violation of 18 U.S.C. §§ 203 or 205 because it does not demonstrate or even suggest that

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<sup>4</sup> On May 24, 2018, the OED Director filed a Motion for Summary Judgment that remains pending in this case. The OED Director attached several exhibits to his motion, including a copy of the survey response that is of central issue to Respondent’s MTD. My consideration of this document when ruling on Respondent’s MTD does not convert his motion to a motion for summary judgment, because the survey response is “‘central to [the OED Director’s] claim, and . . . sufficiently referred to in the Complaint.’” *See Penn v. 1st S. Ins. Servs.*, 2018 U.S. Dist. LEXIS 120382, at \*22-23 (E.D. Va. July 18, 2018) (quoting *Stoney Glen, LLC v. S. Bank & Tr. Co.*, 944 F. Supp. 2d 460, 464 (E.D. Va. 2013)).



Respondent is engaged in legal work “in which the United States is a party or has a direct and substantial interest.” As the OED Director observes, assuming Respondent is in compliance with general outside employment policies, his representation of third-party clients in matters that do not involve the federal government, such as family law, would not violate the federal conflicts of interest statutes and thus would not amount to an ethical violation. OED had no indication from Respondent’s survey response that he was also representing private clients before PTO.

Even so, Respondent contends that “for nearly a decade, the OED Director, even with the resources of the United States government, failed to exercise due diligence which could have prevented this proceeding.” MTD at 6. Respondent cites *Merck & Co. v. Reynolds* to support his contention that the OED Director was legally obligated to discover his misconduct after receiving the survey response. MTD at 6, 8; Reply at 13-14 (citing 559 U.S. 633 (2010)). In *Merck*, the Supreme Court of the United States interpreted a portion of § 804 of the Sarbanes-Oxley Act, 116 Stat. 801, codified at 28 U.S.C. § 1658(b), that stated that “an action based on fraud ‘may be brought not later than the earlier of . . . 2 years *after the discovery of the facts constituting the violation.*’” 559 U.S. at 647. The Court held that the term “‘discovery’ as used in this statute encompasses not only those facts the plaintiff actually knew, but also those facts a reasonably diligent plaintiff would have known.” *Id.* at 648 (emphasis added). Strictly in the context of Sarbanes-Oxley, the Court also rejected an “inquiry notice” standard and held that “the limitations period does not begin to run until the plaintiff thereafter discovers or a reasonably diligent plaintiff would have discovered ‘the facts constituting the violation,’ . . . irrespective of whether the actual plaintiff undertook a reasonably diligent investigation.” *Id.* at 653.

Respondent’s reliance on *Merck* and the application of a “discovery” rule in the context of this proceeding is misplaced. *Merck* interpreted specific language – the word “discovery” – within Sarbanes-Oxley, not the Leahy-Smith America Invents Act, which added the statute of limitations to 35 U.S.C. § 32 in 2011. See P.L. 112-29, § 3(k)(1), 125 Stat. 291. The America Invents Act does not even contain similar language. Rather, it refers only to the misconduct and the date the misconduct “is *made known* to an officer or employee of the Office,” i.e., the date the OED acquires actual knowledge of the misconduct. 35 U.S.C. § 32 (emphasis added). There is no statutory indication that the OED Director is held to a higher standard of discovery that makes him responsible for facts he *might* have discovered with reasonable diligence. Respondent also asserts that “Congress is presumed to legislate with knowledge of existing common law.” Reply at 9.<sup>5</sup> Yet, Congress chose not to include any iteration of the word

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<sup>5</sup> Respondent contends that legislative history “supports an interpretation of ‘made known’ as requiring the exercise of due diligence” because “Congress noted its intent in enacting Section 32 was for the USPTO to act ‘promptly’ in instituting disciplinary proceedings when misconduct ‘reasonably could have been discovered.’” Reply at 9, 14 (citing 157 Cong. Rec. 1372-73 (2011) (statement of Sen. Jon Kyl)). Setting aside the questionable legal value of attributing “Congress[’s] . . . intent” to a single senator’s statement during floor debate, the portion of the record that Respondent quotes actually states that the law attempts to bridge the gap between a statute of limitations that runs from the date a violation occurs and one that runs from the date

“discover” in the AIA statute of limitations. If, as the Supreme Court says, “the word ‘discovery’ is often used as a term of art in connection with the ‘discovery rule,’” then presumably Congress chose to write the AIA so that it did not include that term. *See Merck*, 559 U.S. at 644.

But even if the OED Director *were* charged with exercising reasonable diligence to discover Respondent’s misconduct, the facts Respondent conveyed in his survey response were insufficient to prompt further investigation. Due diligence did not require the OED Director to open an investigation into Respondent based on his survey response alone, because the survey response provided no indication that Respondent was engaged in unethical behavior. Only at the point the OED Director was aware that Respondent was a government employee while he was representing third-parties before the PTO did the OED Director have knowledge of Respondent’s potential misconduct.

Respondent also describes the OED Director as “no ordinary plaintiff” because he heads an investigatory agency of PTO with substantial resources. MTD at 7, 8; Reply at 9. But that status does not obligate the OED Director to discover misconduct about which he has no notice or knowledge, as in this case. To the extent Respondent cites 37 C.F.R. § 11.2(b)(4) as imposing some discovery obligation on the OED Director, Respondent is wrong. Reply at 9, 12. That regulation, under a section describing the various duties of the OED Director, states that “[t]he OED Director shall: . . . Conduct investigations of matters involving possible grounds for discipline of practitioners *coming to the attention of the OED Director*.” 37 C.F.R. § 11.2(b)(4) (emphasis added). Clearly, that regulation is describing the function of the office and what its role is *once notified* of potential misconduct. That is, the regulation refers to the OED Director’s role in matters that “com[e] to the attention of the OED Director;” it does not place some affirmative obligation on the OED Director to go in search of misconduct about which he has no knowledge. Similarly, Respondent claims the regulations impose a low bar for notification because “[a]n investigation may be initiated when the OED Director receives a grievance, information or evidence from any source suggesting possible grounds for discipline.” 37 C.F.R. § 11.22(a);<sup>6</sup> Reply at 9-10, 12. But the survey response did not suggest possible grounds for discipline – it suggests only that Respondent was engaged in ethical conduct. Nothing suggested or implied that Respondent might be engaged in conduct that could be

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the enforcement agency first learned of the violation or reasonably could have learned of it. 157 Cong. Rec. at 1372. Senator Kyl concluded the AIA accomplished this by imposing “an outward limit of 10 years from the occurrence of the misconduct for the initiation of a section 32 proceeding” which “would appear to allow a proceeding for the vast bulk of misconduct that is discovered.” *Id.* at 1372-73. Notably, despite Senator Kyl’s use of “discovered” in debate on the chamber floor, the word does not appear in the AIA.

<sup>6</sup> Respondent in his Reply incorrectly cites 37 C.F.R. § 11.22(c), which was deleted in 2012 because it was “redundant in view of the definition of *grievance* . . . set forth in § 11.1.” *See* Implementation of Statute of Limitations Provisions for Office Disciplinary Proceedings, 77 Fed. Reg. 45247, 45248-45249 (July 31, 2012) (Final Rule).

disciplined.

Further, Respondent complains that the OED Director has “steadfastly refused to provide the ‘written grievance,’” so “there is no way to know what the written grievance contained.” Reply at 10. Consequently, Respondent goes on to speculate, “[t]he written grievance could have been a complaint filed by a disgruntled patent examiner which triggered the OED to finally review the OED survey form and determine, 15 years later, that the OED survey form suggests possible grounds for discipline.” Reply at 10-11. And he adds to this his theory that a subsequent Request for Information (“RFI”) from the OED Director that contained questions similar to and citing the 2003 survey question about government employment demonstrates that it was in fact the survey “that led the OED to question if the Respondent was both engaging in representational activities before the office and a federal government employee. The question that should have been raised by the OED in 2003 if the OED had conducted its due diligence.” Reply at 11. However, Respondent’s speculations are beside the point. If the 2016 written grievance alerted the OED Director to possible grounds for disciplining Respondent, then it is only natural that the OED Director would have reviewed the history of Respondent’s correspondence with the office and posed further questions about Respondent’s government employment. This is particularly true in light of the OED Director’s assertion that “[i]t was the December 19, 2016 grievance which contained information that Respondent was both a government employee **and** engaging in representational activities before the Office that led to the opening of an investigation by OED.” MTD Opposition at 3. There is no evidence from the RFI quoted by Respondent that the OED Director had notice of Respondent’s misconduct prior to December 2016.

But even if the 2003 survey response were a “written grievance” in this case, as a practical matter I would not dismiss the Complaint because the 2016 written grievance remains an actionable document that presents possible grounds for discipline of Respondent. So long as the Complaint was timely filed within the 1-year limitations period, and there is no indication it was not, Respondent may still be disciplined for any misconduct forming the basis of the Complaint that occurred in the preceding 10 years. In this case, the ethical violations of which Respondent is accused did not occur at a single point in time more than 10 years ago and then stop occurring. Rather, they occurred each and every time Respondent interacted with the PTO on behalf of a private client for the 15 years before the Complaint was filed, because for that entire time Respondent was a federal employee. Consequently, all such interactions that occurred in the 10 years prior to when the Complaint was filed, subject to extension by any applicable tolling agreements, may be a proper basis for this disciplinary proceeding.

Because Respondent’s survey response is not the written grievance in this case, his statute of limitations arguments must be rejected. There is no evidence that any other “grievance” exists in this case other than the written grievance that the OED Director asserts was filed in December 2016, and there is no evidence the Complaint was untimely filed relative to that grievance. Thus, all allegations of misconduct that occurred within 10 years prior to the filing of the Complaint have been timely raised under 35 U.S.C. § 32 and 37 C.F.R. § 11.34(d).

Conclusion

For the foregoing reasons, Respondent's Motion to Dismiss Complaint is **DENIED**.

**SO ORDERED.**



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Susan L. Biro  
Chief Administrative Law Judge<sup>7</sup>

Dated: August 16, 2018  
Washington, D.C.

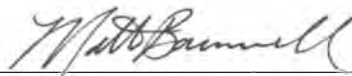
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<sup>7</sup> This Order is issued by the Chief Administrative Law Judge of the United States Environmental Protection Agency. The Administrative Law Judges of the Environmental Protection Agency are authorized to hear cases pending before the United States Department of Commerce, Patent and Trademark Office, pursuant to an Interagency Agreement effective for a period beginning May 15, 2014.

In the Matter of Kevin P. Correll, Respondent  
Proceeding No. D2018-12

**CERTIFICATE OF SERVICE**

I hereby certify that the foregoing **Order on Respondent's Motion to Dismiss**, issued by Chief Administrative Law Judge Susan L. Biro and dated August 16, 2018, was served on this day to the addressees indicated below.



\_\_\_\_\_  
Matt Barnwell  
Attorney Advisor

**Original by Hand Delivery to File:**

U.S. Environmental Protection Agency  
Office of Administrative Law Judges  
Ronald Reagan Building, Room M1200  
1300 Pennsylvania Avenue, NW  
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*Respondent*

Dated: August 16, 2018  
Washington, D.C.

**UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE ADMINISTRATIVE LAW JUDGE**

<b>In the Matter of</b>  <b>Kevin P. Correll,</b>  <b>Respondent.</b>	) ) ) ) )	<b>Proceeding No. D2018-12</b>
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**ORDER ON MOTIONS FOR SUMMARY JUDGMENT**

On January 17, 2018, the Director of the Office of Enrollment and Discipline (“OED Director”) of the United States Patent and Trademark Office (“PTO” or “Office”) commenced this action by filing a Complaint and Notice of Proceedings under 35 U.S.C. § 32 against Respondent Kevin P. Correll. The Complaint alleges two counts of misconduct under the PTO Code of Professional Responsibility (“PTO Code”) and the PTO Rules of Professional Conduct (“PTO Rules”).<sup>1</sup>

In Count I, the OED Director alleges Respondent violated six sections of the PTO Code – 37 C.F.R. §§ 10.23(a), 10.23(a) and (b) via (c)(20), 10.23(b)(4), 10.23(b)(5), 10.23(b)(6), and 10.40(b)(2) – and six PTO Rules – 37 C.F.R. §§ 11.111, 11.116(a)(1), 11.505, 11.804(b), 11.804(d), and 11.804(i). These violations relate to Respondent’s representation of private parties before the PTO while he was employed by the federal government. *See* Compl., ¶¶ 54, 68.<sup>2</sup> Count II asserts one violation of the PTO Code – 37 C.F.R. § 10.23(b)(6) – and one violation of a PTO Rule – 37 C.F.R. § 11.804(i). The violations in Count II stem from Respondent’s failure to consult a Navy ethics counselor for guidance. Compl., ¶¶ 84-85. For these violations, the OED Director seeks to exclude or suspend Respondent from practice before the PTO in patent, trademark, and other non-patent matters. *See* Compl. at 27.

Respondent filed an Answer, Defenses, and Counterclaims on February 15, 2018. In his Answer, Respondent admits nearly all of the alleged facts that are material to liability in this matter. He also sets forth a range of “Counter Claims and Defenses.” Answer, ¶¶ 86-140. These include allegations that the OED Director violated Respondent’s Fifth Amendment substantive due process right “to earn a lawful livelihood”; that the OED Director “arbitrarily and capriciously” violated Respondent’s First Amendment right to free association; that the OED

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<sup>1</sup> As of May 3, 2013, the PTO Rules govern attorneys practicing before the Office. *See* 37 C.F.R. §§ 11.101-11.901. The PTO Code applied to misconduct occurring prior to that date. *See* 37 C.F.R. §§ 10.20-10.112 (repealed). The misconduct alleged in the Complaint occurred before and after May 3, 2013, so both the PTO Code and the PTO Rules apply in this proceeding.

<sup>2</sup> The Complaint contains no paragraphs between those numbered 54 and 68.



Director violated Respondent's Fifth Amendment procedural due process right to a fair and impartial hearing; and that the OED Director violated Respondent's rights under the Privacy Act.<sup>3</sup> Answer, ¶¶ 86-140.

On May 24, 2018, the OED Director filed a Motion for Summary Judgment ("MSJ"). The OED Director seeks summary judgment on both counts in the Complaint, Respondent's affirmative defenses, and Respondent's counter claims.<sup>4</sup> The OED Director further asks for an order suspending Respondent from practice before the PTO for at least 18 months. MSJ at 1.

In response, Respondent submitted his own cross motion for summary judgment and response to the OED Director's MSJ. *See* Motion to Deny OED Director's Motion for Summary Judgment, Cross-Motion for Summary Judgment Dismissing Complaint (June 8, 2018) ("Response and Cross Motion"). On June 25, 2018, the OED Director replied to the Response and Cross Motion. *See* OED Director's Reply to Respondent's June 8, 2018 Motion ("OED Reply"). Finally, on July 9, 2018, Respondent filed a sur-reply in support of his Response and Cross Motion. *See* Respondent's Sur-Reply to OED Director's June 25, 2018 Reply to Respondent's June 8, 2018 Motion ("Sur-Reply").

## **I. LEGAL BACKGROUND**

Congress authorized the PTO to promulgate regulations governing "the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Office." 35 U.S.C. § 2(b)(2)(D). If an attorney does not comply with regulations issued under § 2(b)(2)(D), or if he is "shown to be incompetent or disreputable, or guilty of gross misconduct," the PTO may suspend or exclude the attorney from further practice before the PTO. 35 U.S.C. § 32. *See also* *Sheinbein v. Dudas*, 465 F.3d 493, 495 (Fed. Cir. 2006). "Under these statutes, the PTO has the exclusive authority to establish qualifications for admitting persons to practice before it, and to suspend or exclude them from practicing before it." *Kroll v. Finnerty*, 242 F.3d 1359, 1364 (Fed. Cir. 2001).

In 1985, the PTO issued regulations based on the ABA Model Code of Professional Responsibility to govern attorney conduct and practice. *See* Practice Before the Patent and Trademark Office, 50 Fed. Reg. 5158 (Feb. 6, 1985) (Final Rule) (codified at 37 C.F.R. §§ 10.20-10.112). These rules set forth the PTO Code and "clarif[ied] and modernize[d] the rules

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<sup>3</sup> Respondent also asserted two statutes of limitations defenses. This Tribunal has already considered and rejected those defenses and does not further discuss them in this Order. *See* Order on Respondent's Motion to Dismiss (Aug. 16, 2018).

<sup>4</sup> Then, in a footnote, the OED Director states that its MSJ addresses twelve of the fourteen charges in the Complaint, and that "[i]f summary judgment is grated[sic] in the OED Director's favor, the OED Director will dismiss the last two counts." MSJ at 2 n.2. Yet the OED Director goes on to address the final two charges in its motion. MSJ at 33-34. Consequently, I will construe the MSJ as seeking summary judgment on all charges in the Complaint.

relating to admission to practice and the conduct of disciplinary cases.” *Id.* In May 2013, the PTO replaced the PTO Code with the PTO Rules, which are fashioned on the ABA’s Model Rules of Professional Conduct. *See* Changes to Representation of Others Before the United States Patent and Trademark Office, 78 Fed. Reg. 20180 (April 3, 2013) (Final Rule) (codified at 37 C.F.R. §§ 11.101-11.901). By updating its regulations, the PTO sought to “provid[e] attorneys with consistent professional conduct standards, and large bodies of both case law and opinions written by disciplinary authorities that have adopted the ABA Model Rules.”<sup>5</sup> *Id.* at 20180.

Independent of PTO regulations, federal criminal law sets forth conflict of interest prohibitions for federal employees. *See* 18 U.S.C. §§ 203, 205 (“Conflict of Interest Statutes”). Specifically, an employee of the United States may not directly or indirectly “demand[ ], seek[ ], receive[ ], accept[ ], or agree[ ] to receive or accept any compensation for any representational services, as agent or attorney or otherwise, rendered or to be rendered either personally or by another” in “any proceeding, application, [or] request for a ruling or other determination . . . in which the United States is a party or has a direct and substantial interest[.]” 18 U.S.C. § 203(a)(1)(B). Additionally, “an officer or employee of the United States . . . other than in the proper discharge of his official duties” may not “act[ ] as agent or attorney for anyone before any department [or] agency . . . in connection with any covered matter in which the United States is a party or has a direct and substantial interest[.]” 18 U.S.C. § 205(a)(2). A “covered matter” includes “any judicial or other proceeding, application, request for a ruling or other determination, contract, claim, controversy, investigation, charge, accusation, arrest, or other particular matter.” 18 U.S.C. § 205(h).

With respect to 18 U.S.C. § 205(a)(2), the statute “subject[s] a federal employee to criminal or civil penalties if the employee ‘acts as an agent or attorney for anyone before any department [or] agency . . . in connection with any covered matter in which the United States is a party or has a direct and substantial interest . . . .’” *Van Ee v. EPA*, 202 F.3d 296, 302 (D.C. Cir. 2000) (quoting 18 U.S.C. § 205(a)(2)). As the Court notes, “[a] ‘covered matter’ is defined in § 205(h) as ‘any judicial or other proceeding, application, request for a ruling or other determination, contract, claim, controversy, investigation, charge, accusation, arrest, or other particular matter.’” *Id.* (quoting § 205(h)). Moreover, covered matters are more than “adversarial proceedings or formal legal relationships, for the conflicting interests at which § 205 is aimed could be equally present, for example, were a federal employee to represent a private party in its uncontested application for a broadcast license, *patent*, or other valuable benefit.” *Id.* (emphasis added). Congress desired to criminalize situations in which “a private party seeking a governmental benefit enlists the representational assistance of a federal employee” because that federal employee could “potentially could use confidential information or abuse his

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<sup>5</sup> Thus, useful to understanding the PTO Rules is the PTO Code, the Comments and Annotations to the ABA Model Rules, and disciplinary decisions and opinions issued by state bars. *See* Changes to Representation of Others Before the United States Patent and Trademark Office, 78 Fed. Reg. at 20180.



office or position to assist such a party.” *Id.*

Federal regulations outlining standards of ethical conduct for employees of the executive branch further direct government employees to seek advice from designated ethics officials when the employee has questions about ethics rules:

Employees who have questions about the application of this part or any supplemental agency regulations to particular situations should seek advice from an agency ethics official. Disciplinary action for violating this part or any supplemental agency regulations will not be taken against an employee who has engaged in conduct in good faith reliance upon the advice of an agency ethics official, provided that the employee, in seeking such advice, has made full disclosure of all relevant circumstances. Where the employee's conduct violates a criminal statute, reliance on the advice of an agency ethics official cannot ensure that the employee will not be prosecuted under that statute.

5 C.F.R. § 2635.107(b). The “agency ethics official” referred to in the regulation is the “Designated Agency Ethics Official,” the “officer or employee who is designated by the head of the agency to coordinate and manage the agency’s ethics program” under 5 C.F.R. 2638. *See* 5 C.F.R. §§ 2635.102, 2638.201, 2638.603.

Finally, the PTO Rules specifically incorporate these federal Conflicts of Interest Statutes as standards that apply to practitioners: “Practice before the [PTO] by Government employees is subject to any applicable conflict of interest laws, regulations or codes of professional responsibility.” 37 C.F.R. § 11.10(e).

## **II. SUMMARY JUDGMENT STANDARD**

“A party may move for summary judgment, identifying each claim or defense—or the part of each claim or defense—on which summary judgment is sought.” Fed. R. Civ. P. 56(a).<sup>6</sup> “The court shall grant summary judgment if the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.” *Id.*

“‘[T]he mere existence of some alleged factual dispute between the parties will not defeat an otherwise properly supported motion for summary judgment; the requirement is that there be no genuine issue of material fact.’” *Columbia Gas Transmission v. Grove Ave. Developers*, 2018 U.S. Dist. LEXIS 140492, at \*3 (E.D. Va. Aug. 10, 2018) (quoting *Anderson v. Liberty Lobby Inc.*, 477 U.S. 242, 247-48 (1986)). This Tribunal’s role is not “‘to weigh the evidence and determine the truth of the matter,’” but to “‘determine whether there is a genuine issue for

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<sup>6</sup> The rules governing this proceeding provide that the parties may file “all prehearing motions commonly filed under the Federal Rules of Civil Procedure[.]” 37 C.F.R. § 11.43.

[hearing].” *Id.* (quoting *Tolan v. Cotton*, 134 S. Ct. 1861, 1866 (2014)). Consequently, “[t]he relevant inquiry is whether the evidence presents a sufficient disagreement to require [a hearing] or whether it is so one-sided that one party must prevail as a matter of law.” *Id.* at \*3-4 (quoting *Stewart v. MTR Gaming Grp., Inc.*, 581 F. App’x 245, 247 (4th Cir. 2014)). As I make this determination, I “must view the evidence in the light most favorable to the nonmoving party.” *Id.* at \*4 (quoting *Jacobs v. N.C. Admin. Office of the Courts*, 780 F.3d 562, 569 (4th Cir. 2015)).

In instances where cross-motions for summary judgment have been filed, this Tribunal “must review each motion separately on its own merits to determine whether either of the parties deserves judgment as a matter of law.” *Id.* at \*4 (quoting *Rossignol v. Voorhaar*, 316 F.3d 516, 523 (4th Cir. 2003)). For each motion, factual disputes and “competing rational inferences” are resolved in favor of the non-movant. *Id.*

### **III. BURDEN OF PROOF**

The OED Director must prove alleged violations by “clear and convincing evidence.” 37 C.F.R. § 11.49; *Johnson*, PTO Proceeding No. D2014-12, slip op. at 2 (Dec. 31, 2014) (Initial Decision). Likewise, it is Respondent’s burden to prove any affirmative defense by clear and convincing evidence. 37 C.F.R. § 11.49. This standard “protect[s] particularly important interests . . . where there is a clear liberty interest at stake.” *Johnson*, slip op. at 3 (quoting *Thomas v. Nicholson*, 423 F.3d 1279, 1283 (Fed. Cir. 2005)) (internal quotation marks omitted). “Clear and convincing evidence” requires a level of proof that falls “between a preponderance of the evidence and proof beyond a reasonable doubt.” *Id.* (quoting *Addington v. Texas*, 441 U.S. 418, 424-25 (1979)) (internal quotation marks omitted). The evidence produced must be of such weight so as to “produce[] in the mind of the trier of fact a firm belief or conviction, without hesitancy, as to the truth of the allegations sought to be established.” *Id.* (quoting *Jimenez v. DaimlerChrysler Corp.*, 269 F.3d 439, 450 (4th Cir. 2001)) (internal quotation marks omitted). “Evidence is clear if it is certain, unambiguous, and plain to the understanding, and it is convincing if it is reasonable and persuasive enough to cause the trier of facts to believe it.” *Id.* (quoting *Foster v. Alliedsignal, Inc.*, 293 F.3d 1187, 1194 (10th Cir. 2002)) (internal quotation marks omitted).

### **IV. FACTUAL BACKGROUND**

The facts below are undisputed. Nearly all of them are alleged in the Complaint and admitted by Respondent in his Answer. Any facts not admitted by Respondent were supported, without rebuttal, by exhibits attached to the OED Director’s Motion.<sup>7</sup>

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<sup>7</sup> To the extent Respondent denies any part of the allegations in the Complaint, he generally does not deny the specific facts alleged but rather denies that the facts alleged are impermissible, i.e., he disputes the OED Director’s ability to discipline him for the facts that are alleged.

Respondent was admitted to practice law in Massachusetts on June 14, 1999 and is an active member in good standing of the bar of that state. Compl., ¶ 3; Answer, ¶ 3. On September 12, 2000, Respondent registered as a patent attorney with the USPTO and was assigned registration number 46,641. Compl., ¶¶ 1-2; Answer, ¶¶ 1-2.

Respondent has owned and operated the private law firm K.P. Correll & Associates, LLC (“Correll & Associates”), since September 4, 2002. Through the law firm Respondent offers and provides patent and trademark legal services to the public. Compl., ¶ 18; Answer, ¶ 18. During the time period at issue in this proceeding, the website for Correll & Associates stated: “K.P. Correll and Associates, LLC is an Intellectual Property (IP) Law firm serving corporate and individual clients across the country, and around the world, by protecting their Intellectual Property assets through patents, federal trademarks and federal copyrights.” Compl., ¶ 28; Answer, ¶ 28. Respondent is the sole member of Correll & Associates. Compl., ¶ 26; Answer, ¶ 26.

Additionally, since September 16, 2002, Respondent has been employed by the United States as an engineer for the Department of the Navy at the Naval Undersea Warfare Center of the Naval Sea Systems Command in Newport, Rhode Island. Compl., ¶¶ 6, 16; Answer, ¶¶ 6, 16. There, he works as a senior electronics engineer on submarine learning technologies. Compl., ¶ 17; Answer, ¶ 17. Respondent has remained employed by the Navy during all times relevant to this proceeding. Compl., ¶ 7; Answer, ¶ 7.

On November 25, 2003, Respondent submitted a signed and dated response to a survey circulated by the Office of Enrollment and Discipline. Compl., ¶ 5; MSJ, Ex. A. He provided his name as well as the name of his business, “K.P. Correll & Associates LLP,” plus home and business addresses. Compl., ¶ 5; MSJ, Ex. A. He also indicated he was an attorney and member of the Massachusetts state bar. Compl., ¶ 5; MSJ, Ex. A. Question 6 on the survey read as follows:

Are you an employee of the United States Government? *PLEASE*  
*NOTE: U.S. Government employees are not available to accept*  
*private clients or to represent clients other than their agency before*  
*the United States Patent and Trademark Office. 18 U.S.C. § 205;*  
*37 CFR § 10.10(c) and (d).*

Compl., ¶ 5; MSJ, Ex. A. Respondent checked the box “YES” in response to Question 6. Compl., ¶ 5; MSJ, Ex. A. The OED Director received the survey response on December 2, 2003. Compl., ¶ 5; MSJ, Ex. A.

Despite the notice provided in the survey, during the OED investigation that led to this proceeding Respondent acknowledged “that he was ‘paid/compensated for work considered ‘practice before the Office’ pursuant to 37 C.F.R. § 11.5(b) (including subsections (1) and (2)), including, but not limited to, preparing and/or prosecuting patent and/or trademark applications before the [USPTO].” Compl., ¶ 32; Answer, ¶ 32. Between June 9, 2003 and October 25,

2017, more than 200 patent applications were filed “either with a power of attorney naming Respondent as the attorney of record, or where Respondent signed the application data sheet, and/or the application was prosecuted by Respondent . . . .” Compl., ¶ 41; Answer, ¶ 41. Respondent filed 20 of those applications after the OED Director mailed him a Request for Information that outlined the prohibitions of 18 U.S.C. §§ 203, 205 and 37 C.F.R. § 11.10(e). Compl., ¶ 42; Answer, ¶ 42. Similarly, since November 6, 2002, 80 trademark applications “have been filed with Respondent’s name as attorney of record and/or prosecuted by Respondent . . . .” Compl., ¶ 49; Answer, ¶ 49. Respondent filed 34 of those applications after the OED Director mailed him a Request for Information that outlined the prohibitions of 18 U.S.C. §§ 203, 205 and 37 C.F.R. § 11.10(e). Compl., ¶ 50; Answer, ¶ 50.

Respondent has not withdrawn his representation in any of the patent and trademark applications since the onset of the OED investigation. Compl., ¶¶ 41-42, 49; Answer, ¶¶ 41-42, 49. Further, Respondent has never contacted the ethics counselor for the Navy to seek advice or to inform the counselor that he was representing third-party private clients in patent and trademark applications before the PTO. Compl., ¶ 83; Answer, ¶ 83.

## V. DISCUSSION

### A. Applicable Rules

Respondent is charged with violating 37 C.F.R. §§ 10.23(a), 10.23(a) and (b) via (c)(20), 10.23(b)(4), 10.23(b)(5), 10.23(b)(6), and 10.40(b)(2), as well as 37 C.F.R. §§ 11.111, 11.116(a)(1), 11.505, 11.804(b), 11.804(d), and 11.804(i).

Section 10.23 of the PTO Code provides as follows:

- (a) A practitioner shall not engage in disreputable or gross misconduct.
- (b) A practitioner shall not:
  - \*\*\*
  - (4) Engage in conduct involving dishonesty, fraud, deceit, or misrepresentation.
  - (5) Engage in conduct that is prejudicial to the administration of justice.
  - (6) Engage in any other conduct that adversely reflects on the practitioner’s fitness to practice before the Office.
- (c) Conduct which constitutes a violation of paragraphs (a) and (b) of this section includes, but is not limited to:

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(20) Knowing practice by a Government employee contrary to applicable Federal conflict of interest laws, or regulations of the Department, agency or commission employing said individual.

37 C.F.R. §§ 10.23(a), (b)(4), (b)(5), (b)(6), (c)(20). Section 10.40, addressing mandatory withdrawal, states that “[a] practitioner representing a client before the Office shall withdraw from employment if: . . . The practitioner knows or it is obvious that the practitioner’s continued employment will result in violation of a Disciplinary Rule.” 37 C.F.R. § 10.40(b)(2).

Likewise, according to the PTO Rules at issue in this proceeding:

**§11.111 Former or current Federal Government employees.**

A practitioner who is a former or current Federal Government employee shall not engage in any conduct which is contrary to applicable Federal ethics law, including conflict of interest statutes and regulations of the department, agency or commission formerly or currently employing said practitioner.

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**§11.116 Declining or terminating representation.**

(a) Except as stated in paragraph (c) of this section, a practitioner shall not represent a client, or where representation has commenced, shall withdraw from the representation of a client if:

(1) The representation will result in violation of the USPTO Rules of Professional Conduct or other law.

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**§11.505 Unauthorized practice of law.**

A practitioner shall not practice law in a jurisdiction in violation of the regulation of the legal profession in that jurisdiction, or assist another in doing so.

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**§11.804 Misconduct.**

It is professional misconduct for a practitioner to:

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(b) Commit a criminal act that reflects adversely on the practitioner's honesty, trustworthiness or fitness as a practitioner in other respects;

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(d) Engage in conduct that is prejudicial to the administration of justice; [or]

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(i) Engage in other conduct that adversely reflects on the practitioner's fitness to practice before the Office.

37 C.F.R. §§ 11.111, 11.116(a)(1), 11.505, 11.804(b), (d), (i).

## B. Parties' Arguments

### 1. OED Director

The OED Director concludes that he is entitled to judgment as a matter of law, because Respondent in his Answer admitted nearly all the facts alleged in the Complaint, and there are no material facts in genuine dispute. MSJ at 2-4. In short, the OED Director observes,

Respondent admits in his Answer that while he worked as an engineer for the Department of Navy he represented private clients, advocating on their behalf, in hundreds of patent and trademark applications before the USPTO, that he has received compensation for the representation, that he did and has not withdrawn from the representation, and that he did not seek appropriate guidance or permission regarding the federal government ethics rules on representational activities.

MSJ at 8.

Through this conduct, Respondent violated the PTO Code and PTO Rules cited above because he was not in compliance with government ethical standards related to representational activities outlined in 18 U.S.C. §§ 203 and 205, according to the OED Director. MSJ at 9-10. The Conflict of Interest Statutes specifically apply to Respondent's interaction with the PTO because "the United States has a direct and substantial interest in the prosecution of patent and trademark applications . . . ." MSJ at 10 (citing Office of Gov't Ethics, Letter Opinion 01 x 1 (Mar. 14, 2001); *Kearney & Trecker Corp. v. Giddings & Lewis, Inc.*, 452 F.2d 579, 591 (7th Cir. 1971), *cert denied*, 405 U.S. 1066 (1972)). The OED Director further observes that



although §§ 203 and 205 “provide limited exceptions” to their general prohibitions, none of the exceptions apply to Respondent. MSJ at 14-17.

## 2. Respondent

For his part, Respondent does not dispute the alleged facts. Rather, he contends that the OED Director has misinterpreted and unconstitutionally applied 18 U.S.C. §§ 203 and 205 to his representation before the PTO. Response and Cross Mot. at 5. “[P]reparing and filing patent and trademark applications by a non-attorney government employee, not in the course of his official duties, and so removed from any actual or potential conflict of interest, does not implicate the statutory requirements . . . to act as a bar to such practice,” Respondent claims. Response and Cross Mot. at 6.

Additionally, Respondent claims that enforcing §§ 203 and 205 against him violates his First Amendment rights. Response and Cross Mot. at 6-14; Sur-Reply at 4-8. He also contends that a patent or trademark application is not a “covered matter” as required by the statutes; that the government is not a party to the filing or prosecution of such a patent; and that the government does not have a “direct and substantial interest” in the filing and prosecution of patent applications. Response and Cross Mot. at 15-20. Further, Respondent argues his activity is included within statutory exemptions. Response and Cross Mot. at 21-30; Sur-Reply at 8-10. He additionally states that the OED Director has not identified any actual or potential conflict of interest in his actions. Response and Cross Mot. at 31-34; Sur-Reply at 10-12. Finally, Respondent reasserts the defenses and counter claims raised in his Answer and attempts to raise new defenses in his Sur-Reply. Response and Cross Mot. at 35-39; Sur-Reply at 12-15.

## C. Analysis

### 1. Summary Judgment for the OED Director

Based upon a plain reading of the applicable statutes, the conduct to which Respondent admits in his Answer violates 18 U.S.C. §§ 203(a)(1)(B) and 205(a)(2). He admits he was paid to represent private parties before the USPTO in patent and trademark matters while he was an employee of the United States. That is, Respondent admits that while working as an engineer for the Navy he “receive[d] or accept[ed] . . . compensation for . . . representational services, as agent or attorney or otherwise, rendered . . . personally” in a “proceeding, application, [or] request for a ruling or other determination . . . in which the United States . . . has a direct and substantial interest[,]” namely trademark and patent prosecutions. *See* 18 U.S.C. § 203(a)(1)(B). Likewise, Respondent also admits that while serving as “an . . . employee of the United States” he “act[ed] as agent or attorney for” individuals before the USPTO “in connection with [a] covered matter in which the United States . . . has a direct and substantial interest[,]” namely trademark and patent prosecutions. *See* 18 U.S.C. § 205(a)(2). By admitting this conduct, Respondent has admitted to violating the Conflict of Interest Statutes, which ultimately is a violation of the PTO Code and PTO Rules.

Therefore, with regard to the charges alleged under Count I and as demonstrated by the undisputed facts set forth above:

Respondent “[e]ngage[d] in disreputable or gross misconduct” in violation of 37 C.F.R. § 10.23(a) by consulting with or giving advice to clients in contemplation of filing patent or trademark applications or other documents with the PTO and preparing and prosecuting patent and trademark applications before the PTO while employed by the U.S. Government. *See* Compl., ¶¶ 6-7, 16, 32, 41-42, 49-50, 54a; Answer, ¶¶ 6-7, 16, 32, 41-42, 49-50. “With respect to attorneys or other agents, disreputable conduct has generally included unprofessional conduct . . . to include any conduct violative of the ordinary standard of professional obligation and honor.” *In re Shia*, Proceeding No. D2014-31, at 16 (USPTO April 22, 2015) (Initial Decision) (quoting *In re Lane*, Proceeding No. D2013-07 (USPTO Mar. 11, 2014); *see also Poole v. United States*, CIV. A. 84-0300, 1984 WL 742 (D.D.C. June 29, 1984). Failing to abide by federal conflict of interest laws violates “the ordinary standard of professional obligation and honor” expected of attorneys.

Respondent “[e]ngage[d] in conduct involving dishonesty, fraud, deceit, or misrepresentation” in violation of 37 C.F.R. § 10.23(b)(4) by consulting with or giving advice to clients in contemplation of filing patent or trademark applications or other documents with the PTO and preparing and prosecuting patent or trademark applications before the PTO while employed by the U.S. Government, not withdrawing as attorney of record in numerous patent and trademark matters pending before the PTO after being notified that he could not represent others before the PTO while employed by the U.S. Government, and receiving compensation for representing others before the PTO in violation of federal ethics law while employed by the U.S. Government. *See* Compl., ¶¶ 5-6, 16, 32, 41-42, 49-50, 54b; Answer, ¶¶ 6, 16, 32, 41-42, 49-50; MSJ, Ex. A. That is, Respondent represented to third-party clients and to the PTO that he was authorized to represent them before the PTO, when in fact he was in violation of both federal law and the PTO Code. This conduct was dishonest, deceitful, and misrepresented Respondent’s authority.

Respondent “[e]ngage[d] in conduct that is prejudicial to the administration of justice” in violation of 37 C.F.R. § 10.23(b)(5) by consulting with or giving advice to clients in contemplation of filing patent or trademark applications or other documents with the PTO and preparing and prosecuting patent or trademark applications before the PTO while employed by the U.S. Government, not withdrawing as attorney of record in numerous patent and trademark matters pending before the PTO after being notified that he could not represent others before the PTO while employed by the U.S. Government, and receiving compensation for representing others before the PTO in violation of federal ethics law while employed by the U.S. Government. *See* Compl., ¶¶ 5-6, 16, 32, 41-42, 49-50, 54c; Answer, ¶¶ 6, 16, 32, 41-42, 49-50; MSJ, Ex. A. “‘Generally, an attorney engages in [conduct prejudicial to the administration of justice] when his or her conduct impacts negatively the public’s perception or efficacy of the courts or legal profession.’” *Piccone*, Proceeding No. D2015-06, slip op. at 34 (June 16, 2016) (Initial Decision) (quoting *Schroeder*, PTO Proceeding No. D2014-08 at 9); *see also Attorney Grievance Comm’n of Md. v. Rand*, 981 A.2d 1234, 1242 (Md. 2009). Here, Respondent’s conduct



negatively impacts the public perception of the courts and legal profession because, even though he is an officer of the court, he disregarded federal conflict of interest laws.

Respondent knowingly engaged in “practice by a Government employee contrary to applicable Federal conflict of interest laws, or regulations of the Department, agency or commission employing” him in violation of 37 C.F.R. § 10.23(c)(20) when, after being notified that his actions violated 18 U.S.C. §§ 203(a)(1)(B) and 205(a)(2), Respondent consulted with or gave advice to clients in contemplation of filing patent or trademark applications or other documents with the PTO and prepared and prosecuted patent or trademark applications before the PTO while employed by the U.S. Government, failed to withdraw as attorney of record in numerous patent and trademark matters pending before the PTO after being notified that he could not represent others before the PTO while employed by the U.S. Government, and when he received compensation for representing others before the PTO in violation of federal ethics law while employed by the U.S. Government. *See* Compl., ¶¶ 5-6, 16, 32, 41-42, 49-50, 54d; Answer, ¶¶ 6, 16, 32, 41-42, 49-50; MSJ, Ex. A. Indeed, the PTO Code expressly forbids the exact conduct in which Respondent engaged, and is specifically categorized as “disreputable and gross misconduct.” *See* 37 C.F.R. §§ 10.23(a), (c)(20); *see also In re George E. Kersey*, Proceeding No. 00-07, slip op. at 4-5 (USPTO Oct. 24, 2002) (USPTO Director observing on appeal the ALJ’s finding that respondent’s violation of the Conflict of Interest Statutes violated 37 C.F.R. 10.23(c)(20)).

Respondent, while representing clients before the PTO, failed to withdraw from those clients’ employment when he knew or when it was obvious that his continued employment would result in violation of a Disciplinary Rule, in violation of 37 C.F.R. § 10.40(b)(2). Specifically, even after he was notified of the OED Director’s investigation into his misconduct, Respondent did not withdraw from representing others in patent and trademark matters pending before the PTO in violation of federal ethics law while employed by the U.S. government. *See* Compl., ¶¶ 5-6, 16, 32, 41-42, 49-50, 54e; Answer, ¶¶ 6, 16, 32, 41-42, 49-50; MSJ, Ex. A. His continued representation of those clients resulted in the ongoing violation of the PTO Code.

Respondent, while a federal government employee, “engage[d] in . . . conduct which is contrary to applicable Federal ethics law, including conflict of interest statutes and regulations of the department, agency or commission formerly or currently employing said practitioner,” in violation of 37 C.F.R. § 11.111, by consulting with or giving advice to clients in contemplation of filing patent or trademark applications or other documents with the PTO and preparing and prosecuting patent or trademark applications before the PTO while employed by the U.S. Government, by not withdrawing as attorney of record in numerous patent and trademark matters pending before the PTO after being notified that he could not represent others before the PTO while employed by the U.S. Government, and by receiving compensation for representing others before the PTO in violation of federal ethics law while employed by the U.S. Government. *See* Compl., ¶¶ 5-6, 16, 32, 41-42, 49-50, 68a; Answer, ¶¶ 6, 16, 32, 41-42, 49-50; MSJ, Ex. A. That is, Respondent’s conduct was contrary to the applicable federal ethics law outlined in 18 U.S.C. §§ 203 and 205, the PTO Code, and the PTO Rules.

Respondent failed to withdraw from the representation of clients when it resulted in violation of the PTO Rules or other law, in violation of 37 C.F.R. § 11.116(a)(1). *See* Compl., ¶¶ 5-6, 16, 32, 41-42, 49-50, 68c; Answer, ¶¶ 6, 16, 32, 41-42, 49-50; MSJ, Ex. A. As in Respondent's violation of 37 C.F.R. § 10.40(b)(2), Respondent did not withdraw from representing others in patent and trademark matters pending before the PTO in violation of federal ethics law while employed by the U.S. government. Although he knew his position as a government attorney precluded his representation of private clients before the PTO, his continued representation of those clients resulted in ongoing violations of the PTO Rules.

Respondent "practice[d] law in a jurisdiction in violation of the regulation of the legal profession in that jurisdiction," in violation of 37 C.F.R. § 11.505, by consulting with or giving advice to clients in contemplation of filing patent or trademark applications or other documents with the PTO and preparing and prosecuting patent or trademark applications before the PTO while employed by the U.S. Government, by not withdrawing as attorney of record in numerous patent and trademark matters pending before the PTO after being notified that he could not represent others before the PTO while employed by the U.S. Government, and by receiving compensation for representing others before the PTO in violation of federal ethics law while employed by the U.S. Government. *See* Compl., ¶¶ 5-6, 16, 32, 41-42, 49-50, 68b; Answer, ¶¶ 6, 16, 32, 41-42, 49-50; MSJ, Ex. A. Rule 11.505 "corresponds to ABA Model Rule of Professional Conduct 5.5(a) and 'proscribes practitioners from engaging in or aiding the unauthorized practice of law.'" *Piccone*, Proceeding No. D2015-06, slip op. at 18 (June 16, 2016) (Initial Decision) (quoting *Changes to Representation of Others Before the United States Patent and Trademark Office*, 78 Fed. Reg. 20180, 20186); *see also* 37 C.F.R. § 11.5(b) (defining practice before the PTO); 37 C.F.R. § 11.10(e) (subjecting practice before the PTO to any applicable conflict of interest laws, regulations, or codes of professional responsibility). "The PTO is considered a jurisdiction under this rule." *Id.* at 18-19. *See also In re Peirce*, 128 P.3d 443, 444 (Nev. 2006) (concluding that "another jurisdiction" includes the PTO). In this case, Respondent practiced law before the PTO while in violation of the PTO Rules.

Respondent engaged in conduct that is prejudicial to the administration of justice, in violation of 37 C.F.R. § 11.804(d), by preparing and prosecuting patent or trademark applications before the PTO while employed by the U.S. Government, by not withdrawing as attorney of record in numerous patent and trademark matters pending before the PTO, and by receiving compensation for representing others before the PTO in violation of federal ethics law while employed by the U.S. Government. *See* Compl., ¶¶ 5-6, 16, 32, 41-42, 49-50, 68e; Answer, ¶¶ 6, 16, 32, 41-42, 49-50; MSJ, Ex. A. "Generally, an attorney engages in [conduct prejudicial to the administration of justice] when his or her conduct impacts negatively the public's perception or efficacy of the courts or legal profession." *Piccone*, Proceeding No. D2015-06, slip op. at 34 (June 16, 2016) (Initial Decision) (quoting *Schroeder*, PTO Proceeding No. D2014-08 at 9); *see also Attorney Grievance Comm'n of Md. v. Rand*, 981 A.2d 1234, 1242 (Md. 2009). Here, Respondent's conduct negatively impacts the public perception of the courts and legal profession because, even though he is an officer of the court, he disregarded federal conflict of interest laws.

On the above issues, summary judgment is **GRANTED** to the OED Director and **DENIED** to Respondent.

## 2. Summary Judgment for Respondent

With respect to Respondent's alleged violation of 37 C.F.R. § 11.804(b), summary judgment must be denied to the OED Director and granted to Respondent. That rule states that it is professional misconduct for a practitioner to "[c]ommit a criminal act that reflects adversely on the practitioner's honesty, trustworthiness or fitness as a practitioner[.]" However, while the federal conflict of interest laws at the center of this case are part of the U.S. criminal code, there is no allegation, let alone evidence, that Respondent has been found guilty of a criminal act. *See, e.g., In re Jerry L. Hefner*, Proceeding Nos. D2016-21, D2015-36 (USPTO March 23, 2017) (discipline under § 11.804(b) following criminal conviction); *In re John T. Raffle*, Proceeding No. D2015-07 (USPTO Aug. 31, 2015) (discipline under § 11.804(b) following criminal conviction). Although this Tribunal may determine that Respondent's conduct relative to 18 U.S.C. §§ 203 and 205 violates ethical obligations required of PTO practitioners, it cannot and does not determine that he has committed a criminal act. Therefore, it is appropriate to grant him judgment as a matter of law on the charge that he violated 37 C.F.R. § 11.804(b).

Finally, Respondent did not violate 37 C.F.R. §§ 10.23(b)(6) or 11.804(i) as alleged in the Complaint. Those rules forbid a practitioner from "[e]ngag[ing] in . . . other conduct that adversely reflects on the practitioner's fitness to practice before the Office." However, "[t]he PTO's appellate tribunal has held that to be 'other' conduct within the scope [of] Section 10.23(b)(6), conduct must not be prohibited by Section 10.23(b)(1)-(5).'" *Flindt*, PTO Proceeding No. D2016-04, slip op. at 39 (Aug. 4, 2017) (Initial Decision) (quoting *Kelber*, PTO Proceeding No. D2006-13, slip op. at 47 (Sept. 23, 2008) (Initial Decision)); *see also Moatz v. Colitz*, 68 U.S.P.Q.2d at 1102-03). Moreover, the text of § 10.23(b)(6) is identical to § 11.804(i), and the structure of the Code and the Rule surrounding those provisions are sufficiently similar that the same conclusions about § 10.23(b)(6) are applicable to § 11.804(i). *Flindt*, D2016-04 at 39 n.8 (citing *Changes to Representation of Others Before the United States Patent and Trademark Office*, 78 Fed. Reg. at 20180). Thus, if Respondent's conduct is found to violate other provisions of §§ 10.23 and 11.804, then it cannot violate §§ 10.23(b)(6) or 11.804(i). *Id.*; *Cf. Schroeder*, PTO Proceeding No. D2014-08 at 10 n.11; *Johnson*, PTO Proceeding No. D2014-12 at 6; *Lane*, PTO Proceeding No. 99-04, slip op. at 16 (Dec. 3, 2002) (Final Decision). As discussed above, Respondent's conduct violates 37 C.F.R. §§ 10.23(b)(4), (b)(5), and (c)(20) as well as § 11.804(d). For that reason, with respect to Count I, Respondent's conduct does not violate 37 C.F.R. §§ 10.23(b)(6) or 11.804(i).

As for Count II, Respondent's conduct that is alleged to violate 37 C.F.R. §§ 10.23(b)(6) and 11.804(i) is different from the conduct described in Count I. Therefore, his Count I violations of other provisions of §§ 10.23 and 11.804 do not inherently preclude a finding that the Count II allegations constitute violations of §§ 10.23(b)(6) and 11.804(i). However, I am not persuaded that Respondent's failure to contact the Navy's designated ethics official is a violation of these catch-all provisions of the PTO Code and PTO Rules. Indeed, 5 C.F.R. §

2635.107(b), on which the OED Director relies, does not impose any specific ethical duty on Respondent. It simply suggests an advisable course of action that federal employees like Respondent should take for their own benefit before engaging in conduct that might implicate government ethics laws and regulations. *See, e.g., United States v. Safavian*, 528 F.3d 957, 964 & n.5 (D.C. Cir. 2008) (finding that a government employee's failure to follow advice received from ethics committee did "not in itself constitute an ethical transgression" and that § 2635.107(b) "merely offers the employee protection from disciplinary action"). Perhaps it is true, as the OED Director argues, that "these proceedings would have been unnecessary" had Respondent sought guidance from an ethics official before representing people before the PTO. MSJ at 34. But § 2635.107(b) did not obligate Respondent to request such guidance, even if the consequence of his failure to do so is being borne out in this proceeding.

Consequently, on these issues, summary judgment is **DENIED** to the OED Director and **GRANTED** to Respondent.

### 3. Respondent's Defenses

Respondent asserts a number of "Counter Claims and Defenses" in his Answer and in his Response and Cross Motion. For the reasons outlined below, these defenses do not preclude my finding that he is liable for the offenses discussed above.

#### a. *First Amendment Defense*

Respondent asserts his First Amendment rights are violated by applying the Conflict of Interest Statutes to his representational activities before the PTO. Response and Cross Motion at 8-14; Sur-Reply at 4-8. Respondent complains the OED Director has no compelling interest to enforce the laws and that they have not been tailored narrowly enough to survive strict scrutiny of their application. Response and Cross Motion at 8-14; Sur-Reply at 4-8.

Although Respondent casts his argument in terms of a generalized "government-imposed speaker-burden," because application of the Conflict of Interest Statutes is based on his role as a federal employee, a more appropriate analysis is under the government-employee speech cases originating in *Pickering v. Board of Educ.*, 391 U.S. 563 (1968). *See also, e.g., Connick v. Myers*, 461 U.S. 138 (1983); *Rankin v. McPherson*, 483 U.S. 378 (1987); *United States v. National Treasury Employees Union* ("NTEU"), 513 U.S. 454 (1995); *Garcetti v. Ceballos*, 547 U.S. 410 (2006). Under the *Pickering* standard, "Congress may impose restraints on the job-related speech of public employees that would be plainly unconstitutional if applied to the public at large." *NTEU*, 513 U.S. at 465. Determining whether the restraint is appropriate requires balancing "the interests of the [employee], as a citizen, in commenting upon matters of public concern and the interest of the State, as an employer, in promoting the efficiency of the public services it performs through its employees." *Id.* at 465-66 (quoting *Pickering*, 391 U.S. at 568).

The D.C. District Court considered the free speech implications of 18 U.S.C. § 205 in *Van Ee v. Environmental Protection Agency* and found that the statute does in fact place a

burden on speech and induces employees to curtail their expression. *See* 55 F. Supp. 2d 1, 10 (D.D.C. 1999), *rev'd on other grounds*, 202 F.3d 296 (D.C. Cir. 2000). Consequently, the Court determined that *Pickering* and *NTEU* provided the appropriate standard against which to test the statute. In *Van Ee*, the plaintiff was an EPA employee who wished “to represent organizations before federal agencies about matters unrelated to his work.” *Id.* at 12. The Court found that the harm that § 205 imposed on the plaintiff was “limited” because the statute did not prohibit him “from representing organizations under all circumstances, only before federal agencies.” *Id.* Further, the Court declared that § 205 “makes speech neither more expensive nor less remunerative,” nor does it “impose prohibitive conditions on speech.” *Id.* at 13. Additionally, the Court observed, “the government is restricting the manner in which plaintiff may speak to it, not to the rest of the public,” therefore, the government was the only audience deprived of the plaintiff’s speech. *Id.* at 14. Under § 205, “very little, if any, speech need go unexpressed, because employees remain free to represent their own views to the federal government, and any views they wish to whomever else they choose.” *Id.*

As for the interests of the federal government, the Court in *Van Ee* found that § 205 has at least two underlying purposes: “preventing the use of inside information by government employees to assist private interests, and protecting the integrity of governmental processes.” *Id.* at 15 (citing *United States v. Bailey*, 498 F.2d 677 (D.C. Cir. 1974); *DeMarrias v. United States*, 713 F. Supp. 346 (D.S.D. 1989)). Additionally, the Court noted, “[t]he Supreme Court has recognized the important concerns of avoiding appearances of conflicts and upholding confidence in the integrity of governmental processes,” and “prohibiting government employees from representing private individuals and entities in their dealings before the government clearly furthers the government’s interests in avoiding actual and apparent conflicts of interests.” *Id.* The Court concluded that although § 205 may not be as narrowly drawn as it could be, when weighed “against the interest [the] plaintiff has in representing others before the federal government,” the Court found that “the government’s stated interests weigh heavily” and “[a]fter considering the competing interests, the Court determine[d] that § 205 is a permissible restriction on [the] plaintiff’s conduct.” *Id.* at 15-16.

I find *Van Ee*’s assessment of § 205 persuasive and applicable to the Conflict of Interest Statutes and Respondent in this case. Similar to the plaintiff in *Van Ee*, Respondent seeks to represent patent and trademark applicants before the PTO about matters unrelated to his work for the Navy. Respondent too faces limited harm from the Conflict of Interest Statutes because they do not prohibit him from representing people in other legal contexts – only before federal agencies like the PTO. And he remains free to represent his own views to the federal government and anyone else he chooses. Meanwhile, the government maintains its interest in avoiding actual and apparent conflicts of interest by barring its employees from representing private individuals and entities in their dealings before it. To that end, the Conflict of Interest Statutes are not an unconstitutional restraint on speech. Nor have they been applied in any way that represents a restraint on Respondent’s speech.

To the extent Respondent contends that the OED Director’s application of the Conflict of Interest Statutes to his practice before the PTO violates his First Amendment rights,



Respondent's argument is unpersuasive. Respondent faces discipline not for engaging in protected expression or association but because he has run afoul of the PTO's regulations for practicing law before it by not abiding by its rules of ethics. The PTO has a compelling interest in regulating the attorneys who appear before it, and "[a]ny abridgment of the right to free speech is merely the incidental effect of observing an otherwise legitimate regulation." *Lawline v. American Bar Ass'n*, 956 F.2d 1378, 1386 (7th Cir. 1992) (citing *Ohralik v. Ohio State Bar Association*, 436 U.S. 447, 459, 467-68 (1978)). See also *In re Smith*, 123 F. Supp. 2d 351, 359 (N.D. Tex. 2000) (rejecting attorney's First Amendment argument and holding that Tenth Circuit's "interest in maintaining the integrity of the judicial process" by disciplining its attorneys "outweighs any supposed infringement of First Amendment rights"). As noted above, Congress has empowered the PTO to regulate the attorneys it licenses, and the PTO is carrying out that authority by disciplining Respondent. Respondent is incorrect to characterize the PTO's actions as a deprivation of his First Amendment rights.

Consequently, Respondent's First Amendment rights are not violated by the Conflict of Interest Statutes or their application in this case. On this issue, summary judgment is **GRANTED** to the OED Director and **DENIED** to Respondent.

*b. Statutory Misinterpretation Defense*

Respondent contends that the OED Director has misinterpreted the Conflict of Interest Statutes and that they do not apply to his conduct. Specifically, he alleges that filing and prosecuting a patent or trademark application is not a "covered matter" in which the government is a party or has a direct and substantial interest. Response and Cross Motion at 15-20.

Under 18 U.S.C. § 205, "the term 'covered matter' means any judicial or other proceeding, application, request for a ruling or other determination, contract, claim, controversy, investigation, charge, accusation, arrest, or other particular matter." 18 U.S.C. § 205(h). From that definition, Respondent asserts that only the term "application" might apply in this case, and that even it does not because of a congressional intent that "application" refer to an "application for a license" and not an application for a patent or trademark registration. Response and Cross Motion at 15-16. But this argument is unavailing. The language of the statute clearly states that an "application" is a "covered matter." Given that "the starting point in statutory interpretation is the language of the statute itself," and that there is no limiting phrase to suggest that "application" refers to some applications but not others, there is no reason to further investigate Congressional intent. *District of Columbia Hosp. Ass'n v. District of Columbia*, 224 F.3d 776, 779 (D.C. Cir. 2000); see also *Salinas v. United States*, 522 U.S. 52, 57-58 (1997) ("Courts in applying criminal laws generally must follow the plain and unambiguous meaning of the statutory language. Only the most extraordinary showing of contrary intentions in the legislative history will justify a departure from that language."). Moreover, Respondent's argument as to Congress's "intent" comes not from any legislative history but from the Congressional Quarterly Almanac. See Response and Cross Motion at 15. Meanwhile, the

Office of Government Ethics<sup>8</sup> has specifically opined that providing patent prosecution services to private clients “relate[s] to applications, which are specified as particular matters in the statutory sections.” Office of Government Ethics, Letter Opinion 01 x 1 (March 14, 2001). Clearly, a patent or trademark application is an “application” and therefore a covered matter. Moreover, prosecuting a patent or trademark applications may involve an “other proceeding” or a “request for a ruling or other determination,” among other listed categories of “covered matters.”

Respondent further contends that the United States does not have a “direct and substantial interest” in the filing and prosecution of a patent application. Response and Cross Motion at 17-20. This is false. Reasoning from an Opinion of the Attorney General, addressing whether the United States was “directly or indirectly interested” in patent prosecution proceedings under a predecessor law to the Conflict of Interest Statutes, illustrates why:

The purpose in filing and prosecuting a patent application is to secure a statutory monopoly for the prescribed period through the granting of a patent by the Commissioner of Patents. Through these proceedings the United States grants valuable rights which may be exercised against others, including the United States itself. The granting of a patent is a matter of great public interest. The United States is not only interested in the granting of a patent, but also its interest in patents granted is a continuing one. It may, for example, bring suit to cancel patents obtained by fraud.

Gov’t Emps. Prosecuting Claims for Patents, 41 Op. Att’y Gen. 21 (1949) (citing *Hazel-Atlas Glass Co. v. Hartford-Empire Co.*, 322 U.S. 238, 246, 250 (1944); *United States v. American Bell Telephone Co.*, 128 U.S. 315, 357, 370 (1888), and 159 U.S. 548, 554 (1895); *United States v. Cold Metal Process Co.*, 57 F. Supp. 317, 320 (1944), and 62 F. Supp. 127, 138 (1945); *United States v. Hartford-Empire Co.*, 73 F. Supp. 979 (1947)). Likewise, the Seventh Circuit Court of Appeals, reading similar language in 18 U.S.C. § 207(a), declared that it “is also clear” that due to their impact on the public, patent applications are “in the category of matters in which the United States has a direct and substantial interest.” *Kearney & Trecker Corp. v. Giggings & Lewis, Inc.*, 452 F.2d 579, 591 (7th Cir. 1971). *Kearney* further cites *American Bell Telephone Co.* for the significance of the government’s interest in the patent system:

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<sup>8</sup> “The U.S. Office of Government Ethics (OGE) was established by the Ethics in Government Act of 1978, Public Law 95-521, 92 Stat. 1824 (1978).” 5 C.F.R. § 2600.101(a). Its mission is “to prevent conflicts of interest on the part of executive branch employees and resolve those conflicts of interest that do occur.” *Id.* OGE serves as “the supervising ethics office for all executive branch officers and employees pursuant to the Ethics Reform Act of 1989, Public Law 101-194, 103 Stat. 1716 (1989), as amended by Public Law 101-280, 104 Stat. 149 (1990).” 5 C.F.R. § 2600.101(b). Therefore, I find its opinions and interpretations of federal ethics rules and conflict of interest laws highly persuasive.

The United States, by issuing [a patent], has taken from the public rights of immense value and bestowed them upon the patentee. In this respect the government and its officers are acting as the agents of the people, and have, under the authority of law vested in them, taken from the people this valuable privilege and conferred it as an exclusive right upon the patentee. This is property, property of a value so large that nobody has been able to estimate it.

*American Bell Telephone*, 128 U.S. at 370. Respondent attempts to limit the reach of *Kearney* and *American Bell Telephone*, where the facts involve patents obtained by fraud, by arguing that the government's interest is only direct and substantial when fraud is involved. Response and Cross Motion at 17, 19. His argument is unfounded though, as, for the purpose of evaluating the government's interest in the patent system, these cases are clearly describing patent prosecution broadly and not merely scenarios involving fraudulently-obtained patents. Finally, the Office of Government Ethics also cites to *Kearney* and *American Bell Telephone* when advising that "we see no persuasive reason to suggest that the United States lacks a direct and substantial interest in the prosecution of a patent applications before the Patent and Trademark Office for purposes of [the Conflict of Interest Statutes]." Office of Government Ethics, Letter Opinion 01 x 1 at 2 (March 14, 2001).

The government also maintains a direct and substantial interest in trademark registration through the PTO. A trademark owner may, through the PTO, request registration of its trademark and publication in the Official Gazette of the PTO as well as the Principal Register. See 15 U.S.C. § 1051. "Registration confers several benefits upon the owner of a mark in addition to those available at common law:

(1) constructive notice of the registrant's claim of ownership of the trademark; (2) prima facie evidence of the validity of the registration, of the registrant's ownership of the mark, and of his exclusive right to use the mark in commerce as specified in the certificate; (3) the possibility that, after five years, registration will become [incontestable] and constitute conclusive evidence of the registrant's right to use the mark; (4) the right to request customs officials to bar the importation of goods bearing infringing trademarks; (5) the right to institute trademark actions in federal courts without regard to diversity of citizenship or the amount in controversy; and (6) treble damage actions against infringing trademarks and other remedies.

*Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 454 (E.D. Va. 2015) (quoting *Georator Corp. v. United States*, 485 F.2d 283, 285 (4th Cir. 1973), *abrogated on other grounds by NCNB Corp. v. United States*, 684 F.2d 285 (4th Cir. 1982)). Thus, as with patents, the PTO grants valuable rights to some and excludes the availability of those rights to others through the trademark registration process. The PTO additionally serves an important consumer protection



role by registering trademarks, which are meant to be “used by any person ‘to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.’” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) (quoting 15 U.S.C. § 1127). Given the implications of trademark registration on commerce in the United States, this is clearly an area in which the government maintains a direct and substantial interest.

Consequently, I agree that the prosecution of patent or trademark applications is a “covered matter” in which the government has a direct and substantial interest.<sup>9</sup> On this issue, summary judgment is **GRANTED** to the OED Director and **DENIED** to Respondent.

*c. Statutory Exemption Defense*

Respondent argues that the Conflict of Interest Statutes do not apply to him because he falls under one of their exemptions set forth in 18 U.S.C. §§ 203(d) and 205(e). Response and Cross Motion at 21-30; Sur-Reply at 8-10.

Under 18 U.S.C. § 203(d),

(d) Nothing in this section prevents an officer or employee, including a special Government employee, from acting, with or without compensation, as agent or attorney for or otherwise representing his parents, spouse, child, or any person for whom, or for any estate for which, he is serving as guardian, executor, administrator, trustee, or other personal fiduciary except--

(1) in those matters in which he has participated personally and substantially as a Government employee or as a special Government employer through decision, approval, disapproval, recommendation, the rendering of advice, investigation, or otherwise; or

(2) in those matters that are the subject of his official responsibility, subject to approval by the Government official responsible for appointment to his position.

Under 18 U.S.C. 205(e),

(e) Nothing in subsection (a) or (b) prevents an officer or employee, including a special Government employee, from acting, with or without compensation, as agent or attorney for, or otherwise representing, his parents, spouse, child, or any person for whom, or

---

<sup>9</sup> Respondent additionally points out that the government is not a “party” to the prosecution of a patent or trademark application. Response and Cross Motion at 16-17. But this issue does not appear to be relevant given the government’s direct and substantial interest.

for any estate for which, he is serving as guardian, executor, administrator, trustee, or other personal fiduciary except--

(1) in those matters in which he has participated personally and substantially as a Government employee or special Government employee through decision, approval, disapproval, recommendation, the rendering of advice, investigation, or otherwise, or

(2) in those matters which are the subject of his official responsibility, subject to approval by the Government official responsible for appointment to his position.

Respondent urges multiple interpretations of this statutory language that ultimately all lead to the same point: that as an attorney representing private parties before the PTO, he is serving as a “personal fiduciary” representing “any person,” and therefore the Conflict of Interest Statutes do not prevent him from engaging in this work. Response and Cross Motion at 21-30; Sur-Reply at 8-10.

However, this interpretation cannot stand because it would often render the Conflict of Interest Statutes irrelevant. A government attorney representing a private client could always claim to be a “personal fiduciary” for that client, regardless of the identity of that client, based on the broad fiduciary obligations inherent to an attorney-client relationship. “Personal fiduciary” must mean something different. And to the extent that “any person” or “personal fiduciary” are ambiguous statutory language, their meaning may be determined “[not only] by reference to the language itself, [but as well by] the specific context in which that language is used, and the broader context of the statute as a whole.” *Yates v. United States*, 135 S. Ct. 1074, 1082 (2015) (quoting *Robinson v. Shell Oil Co.*, 519 U.S. 337, 341 (1997)).

In this case, “[t]he words immediately surrounding” “any person” in sections 203(d) and 205(e) – “parents,” “spouse,” and “child” – “also cabin the contextual meaning of that term.” *Id.* at 1085. Moreover, it is appropriate to “rely on the principle of *noscitur a sociis*—a word is known by the company it keeps—to ‘avoid ascribing to one word a meaning so broad that it is inconsistent with its accompanying words, thus giving unintended breadth to the Acts of Congress.’” *Id.* (quoting *Gustafson v. Alloyd Co.*, 513 U.S. 561, 575 (1995)). Here, “any person” is the last in a list of terms that is preceded by “parents,” “spouse,” and “child,” so it must be read to refer not to just *any* person in existence, but to any person who is in a comparatively close relationship to the government employee as a parent, spouse, or child. The doctrine of *ejusdem generis* offers similar counsel: “‘Where general words follow specific words in a statutory enumeration, the general words are [usually] construed to embrace only objects similar in nature to those objects enumerated by the preceding specific words.’” *Id.* at 1086 (quoting *Washington State Dept. of Social and Health Servs. v. Guardianship Estate of Keffeler*, 537 U.S. 371, 384 (2003)). Thus, the enumeration of specific people indicates that “any person” includes only people of similar relation rather than *any* person who a government employee might represent. *Cf. id.* at 1086-87.

Indeed, the Office of Government Ethics also reads section 205(e) as an exception “permitting an employee to represent before the Government persons *with whom he or she has a personal relationship*.” Scope of the Exception for Representation of a Parent or Child before the Government under 18 U.S.C. § 205(e), 2012 OGE LEXIS 10 (Dec. 14, 2012) (emphasis added). The Office of Government Ethics notes that the purpose of § 205(e) “springs from the recognition that government employees will on occasion have family and other personal responsibilities that may be thoroughly proper but would, without special statutory recognition, be prohibited by the broad rules of Section 203 and 205.” *Id.* (quoting BAYLESS MANNING, FEDERAL CONFLICT OF INTEREST LAW 95-96 (1964)). Consequently, the exception may extend to an employee’s representation of a stepparent or stepchild *if* that relationship “invoke[s] the same type of responsibilities that a parent-child relationship creates.” *Id.* Significantly, the stepparent-stepchild relationship must be equivalent to that of a parent and child for the exception to apply – the legal relationship itself would not be sufficient under the Office of Government Ethics reading. *Id.*

In light of the above, I conclude that “any person” in sections 203(d) and 205(e) refers not to *any* person, but to a person in similar relationship to the government employee as a parent, spouse, or child. Likewise, I find it notable that the statutory language reads “*personal* fiduciary,” and not simply “fiduciary,” further underscoring the notion that the exception applies when there is not merely a fiduciary relationship but a *personal* fiduciary relationship. Were sections 203(d) and 205(e) to apply to any fiduciary relationship, the result would be nonsensical, as the exception would swallow the rule. Therefore, I am entirely unpersuaded by Respondent’s argument that his conduct falls under the exemptions because he may have had a general attorney-client fiduciary relationship with the people who he represented before the PTO.<sup>10</sup>

As there is no claim or evidence in the record that Respondent was representing his parent, spouse, child, or person of similar relationship, or that he was serving as a guardian, executor, administrator, or trustee of an estate, his statutory exemption defense fails.

Consequently, this is no defense to Respondent’s liability for his actions. On this issue, summary judgment is **GRANTED** to the OED Director and **DENIED** to Respondent.

*d. Respondent’s Claim that No Conflict of Interest Exists*

Respondent complains that the OED Director “fails to identify” how his conduct has undermined the public’s confidence in the PTO’s neutrality, and therefore failed to identify any actual or potential conflict of interest. Response and Cross Motion at 31-34; Sur-Reply at 10-12. However, this argument is a non-starter, because neither of the Conflict of Interest Statutes

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<sup>10</sup> Additionally, before Respondent could take advantage of this exemption, his conduct would be “subject to approval by the Government official responsible for appointment to his position.” 18 U.S.C. §§ 203(d), 205(e). There is nothing in the record to suggest Respondent obtained such approval.

depend on proof of an actual or potential conflict of interest. The statutes simply prohibit certain behavior. To the extent that it is relevant whether Respondent's behavior created an actual or potential conflict of interest, that issue may be addressed in determining an appropriate sanction for his conduct.

Consequently, this is no defense to Respondent's liability for his actions. On this issue, summary judgment is **GRANTED** to the OED Director and **DENIED** to Respondent.

*e. Substantive Due Process Defense*

In his Answer, Respondent alleges that the OED Director "violated the Respondent's 5<sup>th</sup> Amendment Substantive Due Process right to earn a lawful livelihood." Answer at 20. He then recites a series of facts from which it is difficult to discern a due process argument, as Respondent does not explain how his due process rights have been violated. He also refers, without citing, to 37 C.F.R. § 10.23(c)(4), which is inapplicable to this case. Answer, ¶¶ 91-126. In his Response and Cross Motion, Respondent does little to clarify his argument, but he does assert that the OED Director "wishes to interpret 18 U.S.C. §§ 203 and 205 according to its own whims, whims which are then morphed to the OED's charge of numerous ethics violations . . . but apparently stripped of any of the Constitutional protections inherent to either of the statutes." Response and Cross Motion at 36. That is, Respondent appears merely to disagree with the OED Director's decision to initiate and conduct disciplinary proceedings in this case in the first place.

Substantive due process "specially protects those fundamental rights and liberties which are, objectively, 'deeply rooted in this Nation's history and tradition,' and 'implicit in the concept of ordered liberty,' such that 'neither liberty nor justice would exist if they were sacrificed.'" *Wash. v. Glucksberg*, 521 U.S. 702, 720-21 (1997) (quoting *Moore v. East Cleveland*, 431 U.S. 494, 503 (1977) and *Palko v. Connecticut*, 302 U.S. 319, 325, 326 (1937)). Such rights have been found in the right to marry, have children, direct the education and upbringing of one's children, marital privacy, use contraception, bodily integrity, and have an abortion. *Id.* at 720. Beyond these areas, the Supreme Court has "'always been reluctant to expand the concept of substantive due process'" and in substantive due process cases has "required . . . a careful description of the asserted fundamental liberty interest." *Id.* at 720-21 (quoting *Collins v. Harker Heights*, 503 U.S. 115, 125 (1992)).

Here, Respondent has not offered any evidence or indication that he is asserting a fundamental right or liberty that has traditionally been protected by substantive due process. Nor has he provided "a careful description of the asserted fundamental liberty interest." Certainly, there exists no fundamental right or interest to be a member of the PTO's patent bar, and Congress has authorized the PTO to suspend or exclude from practice before it "any person, agent, or attorney shown to be incompetent or disreputable, or guilty of gross misconduct, or who does not comply with the regulations established under section 2(b)(2)(D)." 35 U.S.C. § 32.

Consequently, Respondent has no cognizable substantive due process defense. On this issue, summary judgment is **GRANTED** to the OED Director and **DENIED** to Respondent.

*f. Procedural Due Process Defense*

Respondent argues that the OED Director violated his Fifth Amendment procedural due process right to a fair and impartial hearing. Answer at 25; Response and Cross Motion at 39. Respondent's argument is sparse, but it appears to be based on his allegation that a PTO employee investigating his misconduct made "conclusory ex parte communications relevant to the merits of this proceeding to employees of the Naval Undersea Warfare Center." Answer at 25.

"The due process clause requires the government to provide sufficient notice and a meaningful opportunity to be heard on the deprivation of a protected liberty or property interest." *Cornish v. Dudas*, 715 F. Supp. 2d 56, 68 (D.D.C. 2010) (quoting *Peavey v. Holder*, 657 F. Supp. 2d 180, 191 (D.D.C. 2009)). However, "when governmental action does not partake of an adjudication, as for example, when a general fact-finding investigation is being conducted, it is not necessary that the full panoply of judicial procedures be used." *Bender v. Dudas*, 490 F. 3d 1361, 1369 (Fed. Cir. 2007) (quoting *Hannah v. Larche*, 363 U.S. 420, 442 (1960)). Thus, Respondent's Fifth Amendment right to procedural due process is not generally violated by the conduct of the OED Director's "nonadjudicative, fact-finding investigation prior to the initiation of any adjudicative proceedings." *Id.*; see also *Georator Corp. v. EEOC*, 592 F.2d 765, 768 (4th Cir. 1979) ("When only investigative powers of an agency are utilized, due process considerations do not attach."). Additionally, in this administrative adjudicative proceeding, Respondent is currently being afforded the full process available to PTO practitioners under the PTO regulations codified at 37 C.F.R. Part 11. To whatever extent Respondent is challenging the adequacy of this process, he may seek review at the appropriate time from the PTO Director or the United States District Court for the Eastern District of Virginia. See 35 U.S.C. § 32; 37 C.F.R. §§ 11.55-11.57.

Consequently, Respondent's procedural due process defense must also fail. On this issue, summary judgment is **GRANTED** to the OED Director and **DENIED** to Respondent.

*g. Privacy Act Defense*

In his Answer, Respondent complains that he asked the OED Director for a copy of the written grievance that sparked the investigation into his activity and that the OED Director "refuses" to provide it to him. Answer at 26. Respondent contends this is a Privacy Act violation that further violates his Fifth Amendment Due Process rights. Response and Cross Motion at 38-39; Sur-Reply at 14-15.

Whether the OED Director violated Respondent's rights under the Privacy Act is a matter outside the scope of this disciplinary proceeding, and Respondent is free to seek remedy in the appropriate forum. To the extent Respondent argues that he has not been afforded due process



because the OED Director has not provided him with the written grievance, he has not explained how this is a deprivation of rights when he has otherwise been afforded “sufficient notice” of his alleged misconduct “and a meaningful opportunity to be heard.” *See Cornish*, 715 F. Supp. 2d at 68. Contrary to Respondent’s assertion, the written grievance is not “the OED charging document . . . .” Sur-Reply at 15. The Complaint that initiated this proceeding contains all of the wrongdoing of which Respondent is accused and for which he faces disciplinary sanction. Further, the allegations in the Complaint subsume any allegations that might appear in the written grievance. Therefore, Respondent’s due process is not diminished by the failure of the OED Director to make the written grievance available to him.

Consequently, Respondent’s Privacy Act defense must be rejected. On this issue, summary judgment is **GRANTED** to the OED Director and **DENIED** to Respondent.

*h. OED’s Alleged Violation of 18 U.S.C. §§ 242 and 245*

In his Sur-Reply, Respondent for the first time contends that the OED Director has violated 18 U.S.C. §§ 242 and 245 willfully deprived him of constitutional rights. Sur-Reply at 12-16. As with Respondent’s Privacy Act claim, whether the OED Director violated Respondent’s constitutional rights is a matter outside the scope of this disciplinary proceeding. Additionally, there is no private right of action under these criminal statutes. *See, e.g., Robinson v. Overseas Military Sales Corp.*, 21 F.3d 502, 511 (2d Cir. 1994); *Dugar v. Coughlin*, 613 F. Supp. 849, 852 n.1 (S.D.N.Y. 1985).

Consequently, Respondent’s counterclaims under 18 U.S.C. §§ 242 and 245 must be rejected. On these issues, summary judgment is **GRANTED** to the OED Director and **DENIED** to Respondent.

*i. Unsupported or Abandoned Defenses*

Finally, Respondent either fails to support or abandons two of the “affirmative defenses” in his Answer.

First, under a defense titled, “The OED Complainant arbitrarily and capriciously excluded Respondent from the 18 USC 205 (e) exemption thereby violating the Respondent’s 1st Amendment right to free association,” Respondent essentially reasserts his claim that he falls under one of the exceptions to the Conflict of Interest Statutes. Answer at 24-25; Response and Cross Motion at 36-38. As discussed above, Respondent’s conduct is not exempt under 18 U.S.C. §§ 203(d) and 205(e). Further, it is unclear how this would violate Respondent’s First Amendment right to free association, and Respondent does not offer any explanation.

Second, under the same defense heading, Respondent refers to an OED employee creating a hostile work environment for Respondent while investigating his misconduct. Answer at 24-25. However, Respondent thereafter expressly abandons that claim. Response and Cross Motion at 38.

Consequently, these defenses fail. On these issues, summary judgment is **GRANTED** to the OED Director and **DENIED** to Respondent.

**VI. RESPONDENT'S SANCTION**

The OED Director argues that Respondent's misconduct warrants an eighteen-month suspension. MSJ at 45-54. However, Respondent has raised sufficient factual disputes related to the gravity of his misconduct as to warrant a hearing on an appropriate sanction. Consequently, with respect to a sanction for Respondent's misconduct, both the OED Director's Motion for Summary Judgment as well as Respondent's Response and Cross Motion are **DENIED**.

**CONCLUSION**

The parties' motions for summary judgment are **GRANTED in part** and **DENIED in part** as outlined above.

A hearing in this matter will be scheduled for the Spring of 2019. Because Respondent's liability has been determined through summary judgment, the hearing shall address only the matter of an appropriate sanction. A forthcoming prehearing order shall set appropriate prehearing deadlines.

**SO ORDERED.**



Susan L. Biro  
Chief Administrative Law Judge<sup>11</sup>

Dated: September 27, 2018  
Washington, D.C.


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<sup>11</sup> This Order is issued by the Chief Administrative Law Judge of the United States Environmental Protection Agency. The Administrative Law Judges of the Environmental Protection Agency are authorized to hear cases pending before the United States Department of Commerce, Patent and Trademark Office, pursuant to an Interagency Agreement effective for a period beginning May 15, 2014.

In the Matter of Kevin P. Correll, Respondent  
Proceeding No. D2018-12

**CERTIFICATE OF SERVICE**

I hereby certify that the foregoing **Order on Motions for Summary Judgment**, issued by Chief Administrative Law Judge Susan L. Biro and dated September 27, 2018, was served on this day to the addressees indicated below.

  
\_\_\_\_\_  
Matt Barnwell  
Attorney Advisor

**Original by Hand Delivery to File:**

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*Respondent*

Dated: September 27, 2018  
Washington, D.C.



UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE ADMINISTRATIVE LAW JUDGE, U.S. ENVIRONMENTAL  
PROTECTION AGENCY

In the Matter of: )  
 )  
KEVIN P. CORRELL, ) Proceeding No. D2018-12  
 )  
Respondent. )  
 )

Courtroom C  
Pastore Building  
Two Exchange Terrace  
Providence, Rhode Island

Tuesday,  
April 16, 2019

The parties met, pursuant to notice of the  
Court, at 8:48 a.m.

BEFORE: HONORABLE SUSAN BIRO  
Chief Administrative Law Judge

APPEARANCES:

For the Government:

ELIZABETH A. FRANCIS, Esquire  
ELIZABETH MENDEL, Esquire  
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For the Respondent:

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(401) 954-8183

Heritage Reporting Corporation  
(202) 628-4888

1 any objection to moving those documents into evidence?

2 MR. CORRELL: No, Your Honor.

3 JUDGE BIRO: Okay. Joint Exhibits 1 through  
4 21 are admitted into the record without objection.

5 (The documents referred to,  
6 previously identified as  
7 Joint Exhibit Nos. 1 through  
8 21, inclusive, were received  
9 in evidence.)

10 JUDGE BIRO: Okay. Now will you call your  
11 first witness?

12 MS. FRANCIS: Now we'll call Mr. Correll to  
13 the stand, please.

14 JUDGE BIRO: Okay. Mr. Correll, could you  
15 please stand and let the court reporter swear you in.

16 Whereupon,

17 KEVIN P. CORRELL

18 having been duly sworn, was called as a  
19 witness and was examined and testified as follows:

20 JUDGE BIRO: Okay. Please proceed.

21 MS. FRANCIS: If it's all right with the  
22 Court, I'm just going to move the podium.

23 DIRECT EXAMINATION

24 BY MS. FRANCIS:

25 Q Good morning, Mr. Correll.

1 A Good morning.

2 Q Where did you go to undergraduate school?

3 A University of Hartford.

4 Q And what did you major in?

5 A Electrical engineering and physics.

6 Q If you'd turn to Joint Exhibit No. 5,  
7 please? Is this an accurate -- No. 5.

8 A Oh, sorry.

9 Q Is this an accurate description of your  
10 background?

11 A Okay, yes. I'm sorry, yes. Do you mean  
12 this other one? Oh, that one, thanks.

13 Q You were admitted to practice law in  
14 Massachusetts by the Massachusetts Bar on June 14,  
15 1999, is that correct?

16 A I believe so.

17 Q You believe so, or is that correct?

18 A Well, I believe it's correct. I mean, I  
19 don't remember the exact date, but that's roughly the  
20 time frame.

21 Q Did you have to take and pass the multistate  
22 professional responsibility exam before you were  
23 admitted to the bar?

24 A Yes.

25 Q Where did you go to law school?

1           A     I started in Western New England Law School  
2     in Springfield, Mass., and I finished at Roger  
3     Williams in Bristol, Rhode Island.

4           Q     You had to take an ethics course to graduate  
5     from law school, didn't you?

6           A     I don't recall if it was a required course  
7     or not.

8           Q     Did you take an ethics course?

9           A     I don't recall.

10          Q     And you graduated in 1999?

11          A     Yes.

12          Q     You were registered as a patent attorney  
13     with the U.S. PTO on September 12, 2000, is that  
14     correct?

15          A     I believe so, yes.

16          Q     If you could turn to Joint Exhibit 1, the  
17     fourth line from the bottom.

18          A     Okay.

19          Q     So were you registered on September 12,  
20     2000?

21          A     I'm not sure. What is this from?

22          Q     This is a data sheet extracted on the U.S.  
23     practitioner providing information such as your  
24     registration recognition number, the date you were  
25     registered.

1 A Oh, okay. Yep, sure. Yes.

2 Q What is your registration number?

3 A 46641.

4 Q On December 8, 1999, you signed an oath or  
5 affirmation in which you swore or affirmed that if  
6 registered to practice before the U.S. PTO, you would,  
7 among other things, observe the laws and rules of  
8 practice of the office. Is that correct?

9 A Correct.

10 Q You were required to take and pass the  
11 patent bar exam, is that correct?

12 A Correct.

13 Q As part of studying for the patent bar exam,  
14 you had to learn about the U.S. PTO code of  
15 professional conduct, is that correct?

16 A I don't recall.

17 Q Please turn to Joint Exhibit 3. This is a  
18 copy of the 2003 survey that you signed and submitted  
19 to the Office of Enrollment and Discipline. Is that  
20 correct?

21 A Correct.

22 Q Is that your signature at the bottom of page  
23 1?

24 A Yes, it is.

25 Q Did you read this document before you signed

1 it?

2 A I don't recall.

3 Q Is that a yes or a no?

4 JUDGE BIRO: He says he doesn't recall.

5 Move on.

6 BY MS. FRANCIS:

7 Q Did you answer the questions on this survey  
8 truthfully when you signed it?

9 A I believe so, yes.

10 Q Question 6 on Joint Exhibit 3 states, "Are  
11 you an employee of the United States Government?" Is  
12 that correct?

13 A Are you asking me -- I'm not sure what your  
14 question is.

15 Q Does Question 6 start with, "Are you an  
16 employee of the United States Government?"?

17 A Correct. That's what the form says.

18 Q And did you answer yes to this question?

19 A I did.

20 Q Can you read the comment that follows  
21 Question 6 that begins with "Please note"?

22 A "Please note U.S. Government employees are  
23 not available to accept private clients or represent  
24 clients other than their agency before the United  
25 States Patent and Trademark Office, 18 U.S.C. 205, 37

1 C.F.R. 10.10(c) and (d)."

2 (The document referred to was  
3 marked for identification as  
4 Government Exhibit No. 38.)

5 BY MS. FRANCIS:

6 Q Can you look at Government Exhibit -- it's  
7 marked as DX Exhibit 38. Have you seen this document  
8 before?

9 A No. Well, what time frame are we talking  
10 about? I saw it two weeks ago when you provided it  
11 as, you know, newly discovered evidence.

12 Q So I provided it to you two weeks ago when I  
13 received it?

14 A Correct.

15 Q Can you specifically look at page 2 of 11?  
16 And this appears to be an email chain between Ken  
17 Nelligan and Harold Watt. Who is Ken Nelligan?

18 A I believe, at the time, he was in the Naval  
19 Undersea Warfare Center legal department.

20 Q And who is Harold Watt?

21 A He was my supervisor at the time.

22 Q Do you see an email from Mr. Watt to Mr.  
23 Nelligan dated March 5, 2014, at 2:36? It starts with  
24 "I provided."

25 A Okay. I see it.

1 Q Can you read that out loud, please?

2 A Excuse me?

3 Q Can you read that paragraph out loud? It  
4 starts with Ken, and then it starts with "I provided."

5 A "Ken, I provided Kevin a hard copy of your  
6 email and document you sent me and had him review them  
7 in my presence. He has told me it does not violate  
8 any of the opinions you provided. If there's anything  
9 else I should do, please let me know."

10 Q Did Mr. Watt provide you with the legal  
11 ethics opinions that are pages 6 and 7 of DX Exhibit  
12 38 and then pages 8 through 11 of DX-38?

13 A I do not recall specifically.

14 Q You do not recall?

15 A I do not recall.

16 Q Did you tell Mr. Watt that you were not  
17 violating any of those ethics opinions?

18 A I do not recall that.

19 Q Can you look at page 6, please? Can you  
20 tell me what this document is?

21 A It looks like an OGE advisory opinion.

22 Q It's OEG Advisory Opinion 011 dated  
23 March 14, 2001, is that correct?

24 A Correct.

25 Q This government ethics opinion is responding



1 to questions about whether a federal employee may  
2 prepare patent applications. Is that correct?

3 A I believe so.

4 Q In fact, in the first paragraph, it says,  
5 "In your letter, you questioned the advice given to  
6 you by the ethics official at your agency in response  
7 to you asking whether you, an employee of a  
8 department, may act as compensated agent for private  
9 clients in prosecuting patent applications before the  
10 Patent and Trademark Office of the Department of  
11 Commerce." Did I read that correctly?

12 A I believe so. I don't have my reading  
13 glasses, so some of that's hard for me to follow.

14 Q Did you want to get them on the --

15 A I don't have them with me. Those aren't  
16 reading glasses.

17 Q Okay. On page 7, it says, the last  
18 paragraph, "In sum, your proposed conduct falls  
19 squarely within the terms of 18 U.S.C. 203 and 205.  
20 Accordingly, you are not permitted to act as a  
21 compensated agent for private clients in prosecuting  
22 patent applications before the Patent and Trademark  
23 Office. We concur with the advice given to you by  
24 your ethics official at your agency." Is that  
25 correct?

1 A It looks correct, yes.

2 Q You were given this opinion in 2004?

3 A I do not recall.

4 Q So you knew by 2004 that it was the  
5 government's position that you could not represent  
6 clients before the U.S. PTO while employed by the  
7 federal government, i.e., the Navy, but you did it  
8 anyways?

9 A No, I don't recall that.

10 Q You don't recall filing applications in 2004  
11 and 2000 --

12 A No. I don't recall that my actions were  
13 prohibited by regulations or OGE opinions.

14 Q Do you recall having a conversation with Mr.  
15 Watt?

16 A I recall having some conversation with him  
17 and coming away from that conversation with I didn't  
18 have a conflict, and he was okay with it.

19 Q Did you lie to Mr. Watt, telling him that  
20 you were only referring clients to other attorneys  
21 when prosecution or applications were required?

22 A No.

23 Q Did you tell Mr. Watt that you were only  
24 giving consulting advice and not filing applications  
25 or doing prosecution?

1           A     I don't recall the exact conversation we  
2     had, other than the fact that I walked away with the  
3     assumption that it was okay and that he did not have a  
4     problem as long as there was no conflict.

5           Q     Did Mr. Watt explain the representational  
6     ban to you?

7           A     I don't recall.

8           Q     Please look at Government Exhibit 39, marked  
9     as DX Exhibit 39.

10           MS. FRANCIS: Oh, I'd like to -- sorry,  
11     before we do that, I'd like to move in DX Exhibit 38.

12           JUDGE BIRO: How can you lay a foundation  
13     for this document? How can you authenticate it?

14           MS. FRANCIS: As stated, we believe that  
15     it -- it came from the person that was deposed. We  
16     offered to -- if the Court isn't comfortable with  
17     laying the -- allowing it in at this point, we ask  
18     that the deposition be held open for the limited time  
19     period to get information from the person who was  
20     deposed, Mr. Kasischke, to talk about how this  
21     document was found and where it came from.

22           JUDGE BIRO: In his deposition, I don't  
23     remember, but did he say it came from his government  
24     office records?

25           MS. FRANCIS: He found these after.

1 JUDGE BIRO: Okay. But that's not --

2 MS. FRANCIS: These were found after the  
3 deposition.

4 JUDGE BIRO: My question is not timing. My  
5 question is where they came from.

6 MS. FRANCIS: My understanding is that he  
7 came into the office. There's -- I understand that  
8 there's an audit going on on the base and that they're  
9 cleaning out files, and somebody in his office found  
10 these records and provided to them after --

11 JUDGE BIRO: In their government office,  
12 among their government office records?

13 MS. FRANCIS: That's my understanding, yes.

14 JUDGE BIRO: I'm just looking at your Rule  
15 of Evidence 1150, Section C about government records,  
16 where it says that official documents, records, and  
17 papers of the office, including but not limited to all  
18 papers of a disciplinary investigation -- it doesn't  
19 seem to suggest that it's all government offices, just  
20 the Patent and Trademark Office.

21 MS. FRANCIS: That is true, Your Honor.

22 JUDGE BIRO: Okay. So I will look at his  
23 deposition, and I will rule on their admissibility  
24 after hearing.

25 MS. FRANCIS: Again, we ask that the --

1 JUDGE BIRO: To see if he lays a foundation  
2 for it.

3 MS. FRANCIS: Again, these were found after  
4 the deposition was completed, and that's why we're  
5 asking that the deposition be held open for the  
6 limited purpose of getting evidence on the record on  
7 how it was found. It was provided -- Your Honor, I  
8 understand it was provided to me Thursday after 4  
9 p.m., and we filed a motion as quickly as we could on  
10 Friday.

11 JUDGE BIRO: Yeah. I'll think about that.

12 MS. FRANCIS: Thank you, Your Honor.

13 JUDGE BIRO: And we'll get back to it.

14 (The document referred to was  
15 marked for identification as  
16 Government Exhibit No. 39.)

17 BY MS. FRANCIS:

18 Q Please look at Exhibit DX-39.

19 A DX?

20 Q Uh-huh. It's Government Exhibit 39.

21 A What book is that in?

22 Q The big one on your --

23 A Oh, yeah, here it is. I'm sorry. It's  
24 under -- DX 39, got it.

25 Q Have you seen this document before?

1 A Two weeks ago.

2 Q And this purports to be an email between Mr.  
3 Nelligan and James Kasischke dated March 4, 2004, is  
4 that correct?

5 A Correct.

6 Q The email reads, "This is summarizing my  
7 dealings with Kevin Correll, an NUWC employee who is a  
8 patent attorney. I saw a flyer indicating that Mr.  
9 Correll was practicing intellectual property law in  
10 Newport. I did not review the file in any detail. I  
11 called Mr. Correll and warned him that 18 U.S.C. 205  
12 prevented him from accepting fees for representing  
13 someone before a federal government agency. He  
14 returned my call and left a message indicating that he  
15 was only consulting with clients. He said that he was  
16 aware of 18 U.S.C. 205, and he is associated with  
17 another attorney for patent prosecutions."

18 Did I read that correctly?

19 A As far as I can tell, yes.

20 Q Do you recall having a conversation with Mr.  
21 Kasischke around that time period?

22 A No.

23 Q Do you recall exchanging phone messages with  
24 Mr. Kasischke around that time period?

25 A No.

1 Q Did Mr. Kasischke tell you that he saw a  
2 flyer advertising your services?

3 A I do not recall.

4 Q Did you circulate flyers around that time  
5 period advertising your services?

6 A I did.

7 Q And how did you distribute those flyers?

8 A Mostly by mail.

9 Q Any other way?

10 A I don't believe so, no.

11 Q You didn't provide them to people to deliver  
12 around the neighborhood?

13 A I did not.

14 Q And what did the flyers say?

15 A I don't recall at this point.

16 Q Were they advertising your intellectual  
17 property services?

18 A Sure.

19 MS. FRANCIS: May it please the Court. I  
20 would just like to confer with counsel for a moment.

21 JUDGE BIRO: Of course.

22 (Counsel confer.)

23 MS. FRANCIS: At this time, I'd like to move  
24 in DX-39.

25 JUDGE BIRO: And is this something that you

1 had at the deposition?

2 MS. FRANCIS: It's not. Both of them we did  
3 not have, but Mr. Kasischke did talk about a  
4 conversation that he had with Mr. Correll in the  
5 deposition.

6 JUDGE BIRO: Okay. You know, I think that  
7 you take the deposition at the very last moment, this  
8 is what you get.

9 MS. FRANCIS: Understood.

10 JUDGE BIRO: And I'm not going to admit this  
11 exhibit. I'm not going to leave the record open, and  
12 I'm not going to admit them. That would be Exhibits  
13 38 and 39.

14 (The documents referred to,  
15 previously identified as  
16 Government Exhibit Nos. 38  
17 and 39, were rejected.)

18 (Pause.)

19 BY MS. FRANCIS:

20 Q Between September 16, 2002, and  
21 September 18 -- or September 28, 2018, you were  
22 employed as a civilian electronics engineer by the  
23 Department of Navy's Naval Undersea Warfare Center,  
24 Division Newport, is that correct?

25 A Correct.



1 Q Was this a full-time job?

2 A Yes, it was.

3 Q How many hours of work -- how many hours a  
4 week did you work?

5 A Forty.

6 Q Where was your work located?

7 A Either in Newport, Rhode Island, or Groton,  
8 Connecticut.

9 Q What is the Invention Development Board?

10 A That is a advisory board on whether or not  
11 to proceed forward with invention disclosures.

12 Q And were you a volunteer on this board?

13 A I was a volunteer.

14 Q And what years did you serve on the board?

15 A Roughly 2005, 2004, to -- apparently, I was  
16 removed from it in the 2016 time frame.

17 Q Oh, and just to be clear, the Invention  
18 Evaluation Board is based in the base?

19 A Yes.

20 Q Okay. And when did you set up your private  
21 law firm, K.P. Correll & Associates?

22 A 2002.

23 Q Did you, in fact, have any associates?

24 A I was looking for associates.

25 Q But you've been the sole employee of the law

1 firm?

2 A Sole member, yes.

3 Q Sole member? Does your law firm have an  
4 address?

5 A Yes, it does.

6 Q And where is the address located?

7 A I have a mailing address, 270 Bellevue  
8 Avenue, Number 326, Newport, Rhode Island 02840. I  
9 also have a client office in Fall River,  
10 Massachusetts, 56 North Main Street, 02720.

11 Q And where do you live?

12 A I live in North Kingstown, Rhode Island.

13 Q K.P. Correll & Associates offers some --  
14 provides patent and trademark legal services, isn't  
15 that correct?

16 A Correct.

17 Q And the K.P. Correll & Associates website  
18 states that K.P. Correll & Associates, LLC, is an  
19 intellectual property law firm serving corporate and  
20 individual clients across the country and around the  
21 world by protecting their intellectual property assets  
22 through patents, federal trademarks, and federal  
23 copyrights. Is that correct?

24 A Correct.

25 Q Is K.P. Correll & Associates also known as

1 Northeastern Patent Law Associates?

2 A Yes.

3 Q Is K.P. Correll & Associates also known as  
4 Patent Institute?

5 A Correct.

6 Q Do you read The Official Gazette?

7 A No.

8 Q You are aware that the U.S. PTO adopted new  
9 disciplinary rules in 2013?

10 A I'm vaguely aware they renumbered them.

11 Q Between 2002 and October 5, 2017, when the  
12 complaint was filed, you filed and/or prosecuted 211  
13 patent applications, either provisional or non-  
14 provisional, before the U.S. PTO, is that correct?

15 A Could you repeat that?

16 Q Between 2002 and October 25, 2017, you filed  
17 and/or prosecuted 211 provisional or non-provisional  
18 patent applications before the U.S. PTO?

19 A I believe the complaint was filed January,  
20 wasn't it?

21 Q Correct.

22 A So I'm not hearing something there.

23 Q October 25 is when the investigation  
24 stopped, and we didn't include in between October and  
25 January applications filed.

1           A     Okay. Okay. So -- all right. So now I get  
2     the dates. I'm sorry. Would you repeat that one more  
3     time?

4           Q     Between 2002 and October 25, 2017, you filed  
5     and/or prosecuted 211 provisional or non-provisional  
6     patent applications before the U.S. PTO on behalf of  
7     your clients, is that correct?

8           A     It seems like a big number, but okay.

9           Q     Of the 211 patent applications, 181 of those  
10    were filed between January 2007 and October 25, 2017,  
11    the date the complaint was filed -- no, that's not --  
12    when the investigation ended, is that correct?

13          A     I guess. I don't know. I assume it's  
14    correct if you're looking at the records.

15          Q     OED mailed you a Request For Information on  
16    February 9, 2017, is that correct?

17          A     That's correct.

18          Q     Can you look at Joint Exhibit 7? Can you  
19    tell me what this document is?

20          A     It looks like the first Request For  
21    Information.

22          Q     Sent to you on February 9, 2017?

23          A     Correct.

24          Q     Did you receive this document?

25          A     I did.

1 Q Did you read this document?

2 A I did.

3 Q If you could look at page 2 of Joint Exhibit  
4 7, the last paragraph says, "With a small number of  
5 exceptions, United States Government employees may not  
6 represent anyone other than themselves on any matter  
7 before the executive branch. 18 U.S.C. 205. In  
8 addition, executive branch employees are prohibited  
9 from receiving any form of compensation derived from  
10 representation of another before the executive branch.  
11 See 18 U.S.C. 203." Did I read that correctly?

12 A Apparently so, yes.

13 Q Even after OED told you that it was against  
14 18 U.S.C. 203 and 205 and the U.S. PTO rules to file  
15 applications before the office if you're a government  
16 employee, you continued to do so, is that correct?

17 A Well, OED didn't tell me that. They said  
18 with a small number of exceptions. I felt that I fit  
19 within that small number of exceptions.

20 Q But you continued filing applications?

21 A Yes, according to case law, I was  
22 maintaining the status quo until there was an  
23 adjudication.

24 Q Of the 211 patent applications, 20 were  
25 filed after OED mailed you the initial Request For

1 Information, is that correct?

2 A I presume so, yes.

3 Q Between 2002 and October 25, 2017, you filed  
4 and/or prosecuted 80 trademark applications, is that  
5 correct?

6 A I presume so, yes.

7 Q Of the 80, 73 of those trademark  
8 applications were filed between January 2007 and  
9 October 15, 2017, is that correct?

10 A I presume so, yes.

11 Q Of those 80, 34 of them were filed after OED  
12 mailed you the initial Request For Information on  
13 February 9?

14 A Again, I presume so, yes.

15 Q You continued prosecuting patent -- or  
16 trademark application -- or patent applications that  
17 were pending before the office between October 25,  
18 2018, and September 29, 2019?

19 A I presume so, yes.

20 Q And you considered prosecuting trademark  
21 applications during this time?

22 A Yes.

23 //

24 //

25 //

1 (The documents referred to  
2 were marked for  
3 identification as Government  
4 Exhibit Nos. 23 through 29.)

5 BY MS. FRANCIS:

6 Q In fact, you filed seven new patent  
7 applications between October 26 and September 28. If  
8 you could look at Government Exhibits -- they're  
9 marked DX Exhibits 23 through 29. Are these the  
10 applications that you filed during that time period?  
11 I can direct you to page numbers if that would be  
12 helpful.

13 A So these were apparently filed after I was  
14 no longer a government employee?

15 Q No. Between the end of the investigation  
16 and before you resigned.

17 A Maybe I'm looking at the wrong thing here.  
18 So, I'm sorry, Government Exhibit what?

19 Q 23, sorry.

20 A So Government Exhibit 23. I'm looking at  
21 the first application data sheet, page 5.

22 Q Sorry. September 20.

23 A And that one says I filed this October 1,  
24 2018, which I was no longer a government employee at  
25 that time.

1 Q Correct. What about Government Exhibit 24?

2 A 24? Okay.

3 Q Page 23 might help.

4 A Another one that was filed after I was no  
5 longer a government employee.

6 (Pause.)

7 MS. FRANCIS: Can we take a break, Your  
8 Honor, just two minutes while I just check some dates?

9 JUDGE BIRO: Okay. We'll be in recess for  
10 five minutes.

11 (Whereupon, a brief recess was taken.)

12 JUDGE BIRO: Okay. We can go back on the  
13 record. Please proceed.

14 (The document referred to was  
15 marked for identification as  
16 Government Exhibit No. 32.)

17 BY MS. FRANCIS:

18 Q Can you look at Government Exhibit 32?

19 A 32? Okay, 32.

20 Q And when was this filed?

21 A It looks like 12/21/2017.

22 Q So after the complaint was filed but before  
23 you resigned?

24 A Yes.

25 //



1 (The document referred to was  
2 marked for identification as  
3 Government Exhibit No. 33.)

4 BY MS. FRANCIS:

5 Q Can you look at Government 33, please?

6 A 12/21/2017.

7 Q So after the complaint was filed -- after  
8 the investigation ended on October 26 but before you  
9 resigned, is that correct?

10 A Hold on here. Yes, 2017.

11 (The document referred to was  
12 marked for identification as  
13 Government Exhibit No. 34.)

14 BY MS. FRANCIS:

15 Q And Government 34?

16 A 12/21/2017.

17 (The document referred to was  
18 marked for identification as  
19 Government Exhibit No. 35.)

20 BY MS. FRANCIS:

21 Q And Government 35?

22 A Another trademark to -- this is actually  
23 filed in 06/08/2018.

24 Q But before you retired?

25 A Yes.

1 MS. FRANCIS: I'd like to move in Government  
2 Exhibits 32 through 35.

3 JUDGE BIRO: Are there any objections?

4 THE WITNESS: No.

5 JUDGE BIRO: Okay. Government 32 through 35  
6 are admitted into the record with no objection.

7 (The documents referred to,  
8 previously identified as  
9 Government Exhibit Nos. 32  
10 through 35, inclusive were  
11 received in evidence.)

12 BY MS. FRANCIS:

13 Q You received financial compensation from  
14 your clients for filing and prosecuting the patent and  
15 trademark applications, is that correct?

16 THE WITNESS: I meant to say no, Your Honor.  
17 I'm sorry.

18 JUDGE BIRO: That's all right.

19 THE WITNESS: I'm sorry. Would you repeat  
20 the question?

21 BY MS. FRANCIS:

22 Q You received financial compensation from  
23 your clients for filing and prosecuting the patent and  
24 trademark applications, is that correct?

25 A Correct.

1 Q Did you advertise for clients on the  
2 Internet?

3 A I did.

4 Q Did you advertise for clients at the T.F.  
5 Green Airport located in Warwick, Rhode Island?

6 A I did.

7 Q If you look at Joint Exhibit 6 --

8 A Okay.

9 Q -- is this an accurate representation of an  
10 advertisement you had at the T.F. Green Airport in  
11 2007? Or 2017, excuse me.

12 A Yes.

13 Q How long have you advertised in the airport?

14 A I think I advertised there for two years.

15 Q Starting when?

16 A I believe in January time frame of 2016.

17 Q Did you have any other type of advertising  
18 in the airport?

19 A A similar display in the other part of the  
20 airport.

21 Q Are you still advertising in the airport?

22 A I don't believe so. They should have taken  
23 that down. I don't have access to that part. It's a  
24 secure part of the airport. But I opted out of the  
25 program because it wasn't cost-effective.

1 Q And when did you opt out?

2 A About six months ago.

3 Q What other types of advertising did you use  
4 outside the airport?

5 A Outside the airport?

6 Q Yeah.

7 A None.

8 Q You didn't advertise on the Internet? You  
9 didn't --

10 A Oh, yeah, yes.

11 Q -- distribute flyers?

12 A I thought you meant on the airport grounds.

13 Q I meant off the airport grounds.

14 A No. Well, like we said, Internet. Pretty  
15 much just Internet and this. Oh, I did have Yellow  
16 Book ads.

17 Q Can you turn to Joint Exhibit 18, please?

18 A Okay.

19 Q Do you recognize this document?

20 A I do.

21 Q This is an email you sent to your supervisor  
22 about retiring from the Navy, is that correct?

23 A Yes. It is a personal and confidential  
24 email sent to my supervisor deciding to retire from  
25 the Navy based on external factors, these proceedings

1 for one.

2 Q It says, "I decided to retire by the end of  
3 the month."

4 A Yes.

5 Q On September 4, there was a summary judgment  
6 motion pending, a decision still pending with the  
7 tribunal, is that correct?

8 A There was still a motion pending, yes, but  
9 there was also a -- excuse me, a order that came out  
10 in August, and I based my retirement decision based on  
11 that order, anticipating what the final decision was  
12 going to be. And I explained that also to my then  
13 supervisor, Mr. John Houser, that's the reason I was  
14 retiring.

15 Q Were you fired from the Navy?

16 A I was not.

17 (The document referred to was  
18 marked for identification as  
19 Government Exhibit No. 20.)

20 BY MS. FRANCIS:

21 Q Can you turn to DX Exhibit 20?

22 A Joint or Government?

23 Q Government. Sorry, Government, marked as  
24 DX.

25 A Okay.

1           Q     This is a Notification of Personnel Action,  
2     is that correct?

3           A     Yes.

4           Q     And this -- in Box 5, it says -- in Box 1,  
5     it lists your name, Kevin Correll. In Box 5, it says  
6     Retirement, Voluntary.

7           A     Uh-huh, yes.

8           Q     And the effective date is September 29,  
9     2018?

10          A     Correct.

11          Q     And in Box 45, it says, "Forwarding  
12     address" -- and I won't read it into the record.  
13     "Lump sum payment to be made for any unused annual  
14     leave. Reason for retirement, to obtain retirement  
15     benefits." Is that correct?

16          A     That's what it says.

17                 MS. FRANCIS: I'd like to move in DX-20.

18                 JUDGE BIRO: Is there any objection to this  
19     exhibit, Mr. Correll?

20                 THE WITNESS: I do object on the fact that,  
21     you know, I didn't fill this out. This was filled out  
22     by Human Resources people. So, once you initiate a  
23     retirement action via the email, everything's pretty  
24     much lockstep from that point forward. So the only  
25     thing I object to is that the reason for retirement,

1 to obtain a retirement benefit, clearly, yes. But the  
2 driving reason were these proceedings.

3 JUDGE BIRO: Okay. Well, I'll admit the  
4 exhibit with that caveat. So Government Exhibit 20 is  
5 admitted into the record.

6 (The document referred to,  
7 previously identified as  
8 Government Exhibit No. 20,  
9 was received in evidence.)

10 (The document referred to was  
11 marked for identification as  
12 Government Exhibit No. 19.)

13 BY MS. FRANCIS:

14 Q Can you look at Government Exhibit 19?

15 A Okay.

16 Q And this is an email chain started  
17 September 18, 2018, from Employee Separations, and it  
18 goes to approximately 101 employees, but then it is  
19 between -- it goes on until September 20. It's  
20 between a Catherine Anders and a Daniel Benson. Is  
21 that correct?

22 A It appears to be so, yes.

23 Q Have you seen this email before?

24 A Only as part of your exhibit list.

25 Q Did you see the original email that started

1 on September 18, 2018? It's on page 2.

2 A So what are you asking? There's several  
3 here.

4 Q So I asked you if you'd seen this email, and  
5 I'm now asking if you saw the original email that  
6 started on September 18 at 2:58 p.m.

7 A No.

8 Q It's at the bottom. If you look, it says,  
9 "From Employee Separation." It says the date, and  
10 then it says your name.

11 A So just below the "Dan, As discussed"?

12 Q It's on page 2. It's the last block at the  
13 bottom. It states September 18, 2018, 2:58 p.m.

14 A Okay. From Employee Separations to me, yes.

15 Q So you saw the bottom part?

16 A Yes.

17 Q Who is Catherine Anders?

18 A I don't know her personally. She's just  
19 somebody you call to start the -- she's in our HR  
20 department, I guess.

21 Q And who is Daniel Benson?

22 A I do not know him other than the fact he's  
23 listed here as command evaluation and review.

24 MS. FRANCIS: I'd just like to confer.

25 JUDGE BIRO: Okay.



1 (Counsel confer.)

2 MS. FRANCIS: I'd like to move in Government  
3 Exhibit 19.

4 JUDGE BIRO: Denied. You haven't laid a  
5 foundation for this exhibit. He doesn't recall seeing  
6 it. There's nobody who sent it. There's nobody who  
7 received it. There's no way to authenticate it. Move  
8 on.

9 (The document referred to,  
10 previously identified as  
11 Government Exhibit No. 19,  
12 was rejected.)

13 MS. FRANCIS: I believe that Daniel Benson  
14 is listed in the list of names, 101 of them, that's in  
15 the email, original email that went out and was  
16 provided to Angela Benson regarding the investigation  
17 itself. It's also part of the investigatory file that  
18 we received.

19 JUDGE BIRO: I ruled.

20 MS. FRANCIS: Yes, Your Honor.

21 JUDGE BIRO: Move on.

22 MS. FRANCIS: With that, I close. Thank  
23 you.

24 JUDGE BIRO: Okay. Mr. Correll, would you  
25 like to testify in this matter on your own behalf?

1 THE WITNESS: I would like to make a few  
2 comments, Your Honor.

3 JUDGE BIRO: Okay.

4 THE WITNESS: Thank you.

5 Whereupon,

6 KEVIN P. CORRELL

7 having been previously duly sworn, was  
8 recalled as a witness herein and was examined and  
9 testified further as follows:

10 JUDGE BIRO: You can, you know, testify  
11 narratively, tell me everything you want me to know.  
12 I really want to hear from you, you know, the whole  
13 history, everything that's relevant.

14 DIRECT TESTIMONY

15 THE WITNESS: Yes. So, you know, clearly, I  
16 think, what the evidence does show is I had some  
17 conversations with my supervisor, Harold Watt, at the  
18 time. However, it came out -- and I was going through  
19 a divorce at the time, so I don't remember exactly.  
20 There was custodial issues involved, so it was a very  
21 trying time.

22 But I did come away with the fact that I  
23 believed I was not in conflict and I believed I had,  
24 you know, informal supervisor approval. I mean,  
25 clearly, I was advertising on the island. I was

1 advertising in the airport, you know, where all our  
2 people fly through 10 times a day. I mean, if I was  
3 trying to hide it, I would not be advertising, you  
4 know, with that kind of scope.

5 So I believed I was okay. And then, when I  
6 got the first RFI, I requested that the U.S. PTO  
7 investigate the constitutional issues, and I said, you  
8 know, let's go to court, let's get a ruling. Once I  
9 get a ruling, then, you know, okay, I'll submit, or  
10 I'll resign from one or the other. They decided not  
11 to do that. They decided to file the complaint.

12 Once your August ruling came out, I  
13 suspected that your final ruling would not be for me,  
14 and based on that, then I initiated my retirement. At  
15 no time did I have any conflict of interest, real or  
16 apparent. It was just two separate jobs, and that's  
17 it. That's about all I can say.

18 JUDGE BIRO: Okay, counsel. Would you like  
19 to ask any questions on cross-examination?

20 MS. FRANCIS: No, Your Honor.

21 JUDGE BIRO: Okay. I have a few questions  
22 I'd like to ask to clarify with you. Tell me what  
23 your job exactly was with the Navy.

24 THE WITNESS: I was in the training  
25 department, and what --

1 JUDGE BIRO: And was this the whole time --

2 THE WITNESS: Well --

3 JUDGE BIRO: -- from 2002 to 2000 and --

4 THE WITNESS: Yes.

5 JUDGE BIRO: -- whenever -- when you retired  
6 in 2018?

7 THE WITNESS: Right, yes. So I was in the  
8 training department, and there's various departments  
9 that train. So what does that mean? It's not  
10 actually doing training, but we are involved in  
11 training submarine sailors. And so it might be  
12 developing systems for training, protocol. My last  
13 four years, I guess, I was the chief technology  
14 officer for the Submarine Learning Center in Groton,  
15 Connecticut, and that job was investigating new  
16 educational concepts for better training, faster  
17 training, more economical training. And that's hands-  
18 on training. That's, you know, skills-based,  
19 knowledge-based, that sort of thing.

20 So that was pretty much my career, if you  
21 will, for -- you know, in various levels of it  
22 throughout the, you know, number of years I was with  
23 the government.

24 JUDGE BIRO: So did you have a security  
25 clearance?

1 THE WITNESS: I did.

2 JUDGE BIRO: And what level of security  
3 clearance?

4 THE WITNESS: Secret.

5 JUDGE BIRO: Secret? And you maintained  
6 that the whole time you were on the base?

7 THE WITNESS: I did.

8 JUDGE BIRO: Okay. And did you work in a  
9 secure facility?

10 THE WITNESS: I did.

11 JUDGE BIRO: Okay.

12 THE WITNESS: Well, let me clarify that. It  
13 was sometimes yes, sometimes no. Most of our  
14 information was not classified, but we did have access  
15 to, you know, on a need-to-know basis, of course,  
16 classified information.

17 JUDGE BIRO: Is the training material that  
18 you are designing considered classified?

19 THE WITNESS: Sometimes. Most of the time,  
20 no. It depends on the -- see, I would not be doing  
21 the material per se. I might be developing a system.  
22 But most of the time we try and keep it at the  
23 unclassified level, and it doesn't become classified  
24 until after it moves in to the, you know, actual usage  
25 with actual real data.

1 JUDGE BIRO: Okay. So, when you say a  
2 system, can you clarify what you mean?

3 THE WITNESS: So a system could be a --  
4 let's say a part task trainer. So you're training one  
5 specific aspect of a submarine skill. So it might be  
6 identifying contacts, or it might be, you know, the  
7 audio screens. It might be understanding water -- you  
8 know, sound through water propagation, you know,  
9 education. It might be -- you know, so skills-based  
10 training would be something hands-on so you could  
11 practice the hands-on skill.

12 Knowledge-based training is, you know,  
13 books. And, you know, my job was to investigate how  
14 do we do that better. Do we use VR, do we not use VR?  
15 What are the pros and cons to develop concepts to be  
16 investigated by, let's say, Naval Post-Graduate School  
17 or Naval Education Training Command. And so it was  
18 very broad.

19 JUDGE BIRO: Were you promoted during this  
20 period of time from 2002 to 2018?

21 THE WITNESS: At the last year, I had a  
22 temporary promotion because I was onsite at the  
23 submarine base, but that was it. You know, but you do  
24 get step increases and you get -- in the way this Navy  
25 department works out, it's called this demo program.

1 And so you're not GS-12, 13, or 14. You're like ND-4,  
2 ND-5, ND-6, is the way it worked out.

3 JUDGE BIRO: What does NG stand for?

4 THE WITNESS: ND is --

5 JUDGE BIRO: ND?

6 THE WITNESS: Yeah. I forget what it stands  
7 for. But what they did was they bin together the GS  
8 levels. So you had 12 and 13 were together as a ND-4.  
9 And I was mostly an ND-4 most of my time. So you're  
10 somewhere in that level between a GS-12 and GS-13.  
11 And I maxed out my ND-4 with my GS-13 years ago. So  
12 you get bonuses every year, but you can't get -- you  
13 cannot get salary increases. And I did get bonuses  
14 every year. And the last year, they moved me over to  
15 temporary ND-5, which is a temporary GS-14, before I  
16 retired.

17 JUDGE BIRO: You said VR. You mean Virtual  
18 Reality?

19 THE WITNESS: Virtual Reality, yes.

20 JUDGE BIRO: Okay. Did you have to undergo  
21 background checks for these positions?

22 THE WITNESS: Initially when you sign on,  
23 yes.

24 JUDGE BIRO: But at no subsequent point do  
25 you have to go through a background check?

1 THE WITNESS: I did have a 10-year security  
2 review around the Snowden area -- era. I remember  
3 that because I thought it would be forever getting  
4 through. It actually went through very quickly.

5 JUDGE BIRO: And what year around was that?

6 THE WITNESS: I want to say 2000 -- well,  
7 whenever Snowden was. 2011?

8 JUDGE BIRO: You're referring to James  
9 Snowden and his --

10 THE WITNESS: Yes.

11 JUDGE BIRO: -- notoriety for accessing  
12 government computers?

13 THE WITNESS: Correct.

14 JUDGE BIRO: Okay. And what did that  
15 background check involve?

16 THE WITNESS: I don't recall exactly, but,  
17 you know, you fill out a form and you send it in, and  
18 they rule on it, you know, one way or the other. They  
19 do whatever investigation they do.

20 JUDGE BIRO: Did they come and meet with  
21 you?

22 THE WITNESS: No. I don't recall that.

23 JUDGE BIRO: In filling out those forms, did  
24 you have to disclose -- did you disclose the  
25 information regarding the work you were doing outside



1 the government?

2 THE WITNESS: I did list my patent law firm  
3 on there.

4 JUDGE BIRO: You mentioned Mr. Watt. What  
5 was his job title?

6 THE WITNESS: He was my supervisor. He was  
7 a division head at the time, so he was my direct  
8 supervisor because I was a branch head at the time.

9 JUDGE BIRO: Was he or is he an attorney?

10 THE WITNESS: No.

11 JUDGE BIRO: Did he hold any position in  
12 terms of ethics in your agency?

13 THE WITNESS: Other than being a division  
14 head, no.

15 JUDGE BIRO: So he wasn't a designated  
16 ethics official?

17 THE WITNESS: No, not that I'm aware of. I  
18 mean, we all had collateral duties. I don't believe  
19 that was one of his.

20 JUDGE BIRO: Okay. When you were working  
21 with patent clients or trademark clients, all your  
22 intellectual property private clients, did you advise  
23 them that you were a government employee?

24 THE WITNESS: No.

25 JUDGE BIRO: You mentioned that you

1 continued to provide intellectual property services  
2 after this case was initiated to maintain the status  
3 quo.

4 THE WITNESS: Yes.

5 JUDGE BIRO: Can you tell me what you mean  
6 by that?

7 THE WITNESS: There was case law that  
8 suggested that, you know, if I then stopped  
9 representing clients, that that could be used against  
10 me as an admission of guilt. I'm not making any such  
11 admission.

12 JUDGE BIRO: And what case law are you  
13 referring to?

14 THE WITNESS: I don't recall exactly, but it  
15 is in one of my responses.

16 JUDGE BIRO: To the Requests For  
17 Information?

18 THE WITNESS: RFIs, yes.

19 JUDGE BIRO: When -- did you do any research  
20 before you started your private practice as to whether  
21 it would be ethical to engage in patent law practice?

22 THE WITNESS: No, because I didn't -- you  
23 know, it was just completely separate. It never  
24 occurred to me that it would be a conflict.

25 JUDGE BIRO: What kind of resources do you

1 use for research in your patent law practice?

2 THE WITNESS: As far as data goes?

3 JUDGE BIRO: Do you access Westlaw, Lexis,  
4 books, law books?

5 THE WITNESS: Well, patent law practice is  
6 mostly technical, so it's more technical  
7 documentation, technical books. There's no real --  
8 well, there's some legal analysis. Well, not even --  
9 the MPEP is when you start dealing with the -- the  
10 MPEP is the Manual Practice -- I forget what the MPEP  
11 stands for, but it's the document that controls the  
12 patent examiner. And there's a similar document for  
13 the trademark examiners. So that controls, you know,  
14 the interaction between a practitioner -- because you  
15 don't have to be an attorney to practice in front of  
16 the patent office, just registered according to the  
17 text.

18 So the documents I would reference would be  
19 other existing patents, public -- you know, it all has  
20 to be public, so the documents I would reference would  
21 be all public existing documents, you know, previous  
22 patents, you know, expired or otherwise, anything in  
23 the public domain relevant to that technology.

24 JUDGE BIRO: Did you have access into the  
25 Patent and Trademark's computerized system as a

1 registered patent practitioner?

2 THE WITNESS: The only -- well, I had my own  
3 PAIR database, which is basically my online database  
4 or docket system within PTO. But, as far as  
5 prosecuting any applications, no, I have nothing --  
6 you know, nothing that the average person wouldn't  
7 have.

8 JUDGE BIRO: Did you ever contact any ethics  
9 official during the time that you were privately  
10 practicing to get any input on the appropriate --

11 THE WITNESS: No. As far as, you know, I  
12 filled out OGEs as required, which are the -- I forget  
13 what they stand for, but they're financial disclosure  
14 forms. When those are filled out -- you know, I  
15 filled those out as required. I identified that I had  
16 a law firm. And so I did not -- yeah, I did not  
17 realize that there was a conflict until this  
18 proceeding started.

19 JUDGE BIRO: There was a question regarding  
20 financial compensation. How did you charge your  
21 clients for your services? Was it a flat-fee basis?

22 THE WITNESS: Yes, flat fee. Well, flat fee  
23 for the initial, and then, if there was follow-on,  
24 then I would charge on a per-hour basis.

25 JUDGE BIRO: Okay. So you charged them for

1 initial search, for example, for a patent?

2 THE WITNESS: Initial search and preparation  
3 and filing.

4 JUDGE BIRO: What did you charge for an  
5 initial search?

6 THE WITNESS: Generally, \$750.

7 JUDGE BIRO: And then did you do provisional  
8 applications as well as --

9 THE WITNESS: I'd do provisionals.

10 JUDGE BIRO: -- utility patent applications?

11 THE WITNESS: Correct.

12 JUDGE BIRO: And did you charge a different  
13 fee for provisionals?

14 THE WITNESS: I would charge a different  
15 fee, but I would credit each fee forward. So, for  
16 example, if I had a provisional filing fee of \$1900,  
17 but I did a search for \$750, I would credit that \$750  
18 towards the \$1900. Similarly, if I prepared a  
19 application for a utility application, I would credit  
20 that \$1900 towards that, whatever that fee was for the  
21 utility.

22 JUDGE BIRO: So did you charge a standard  
23 flat fee for utility applications as well?

24 THE WITNESS: Generally, within a range  
25 depending on the complexities of \$4500 to \$5500

1 generally.

2 JUDGE BIRO: How about for the trademark  
3 application? Did you also charge those on a flat-fee  
4 basis?

5 THE WITNESS: Yes. And that would range  
6 anywhere from \$300 to \$400 usually.

7 JUDGE BIRO: Did you do copyright  
8 application?

9 THE WITNESS: Not that -- I've done one  
10 copyright since I've been retired, but normally I  
11 would advise clients to do it themselves because it's  
12 cheap enough to do it online. You don't need an  
13 attorney billing you extra dollars.

14 JUDGE BIRO: Other than what we talked  
15 about, the initial search, provisionals, utility  
16 applications, and trademark applications, what other  
17 type of legal services did you provide?

18 THE WITNESS: Design patent applications.

19 JUDGE BIRO: How many of those did you do  
20 during your practice while you were also a government  
21 employee?

22 THE WITNESS: I don't recall exactly.

23 JUDGE BIRO: Can you give me a range?

24 THE WITNESS: I'm sure they would have it,  
25 but I don't -- some -- there was one client who did a

1 lot of design patents. And other than that, not a  
2 whole lot.

3 JUDGE BIRO: So a lot would be 20 or 50?

4 THE WITNESS: Let's say 50.

5 JUDGE BIRO: And how much did you charge for  
6 those generally?

7 THE WITNESS: I charged a fixed fee of  
8 generally anywhere from \$1500 to \$1900. I started  
9 dropping that fee over the years.

10 JUDGE BIRO: Okay. So I imagine, but tell  
11 me if I'm wrong, that your fees went up over time.

12 THE WITNESS: No. Actually, my fees went  
13 down over time for design patents.

14 JUDGE BIRO: For design patents?

15 THE WITNESS: And for utility patents, they  
16 stayed roughly the same.

17 JUDGE BIRO: Okay. The whole time you were  
18 practicing?

19 THE WITNESS: Pretty much.

20 JUDGE BIRO: Okay. And did you have anybody  
21 else who worked with you, any other attorneys who  
22 worked with you in your practice?

23 THE WITNESS: Not as partners or anything.  
24 You know, I consulted with other attorneys.

25 JUDGE BIRO: Okay. When you say consulted,

1 are these people that you paid, or that paid you for  
2 your services?

3 THE WITNESS: No. I had one client where I  
4 kind of shared with an attorney, but, you know, he was  
5 paid separately, or I would bill the client and then  
6 just -- you know, it was a conduit for me so the  
7 client only had to deal with one person.

8 JUDGE BIRO: You said you advertised your  
9 services through flyers, Internet. I think you also  
10 said the Yellow Pages?

11 THE WITNESS: Yellow Book, yes.

12 JUDGE BIRO: Yellow Book? Did you do that  
13 consistently from when you started your practice in  
14 2002 to --

15 THE WITNESS: I did.

16 JUDGE BIRO: Okay. I was a little confused  
17 by one thing. Are you stating you're unaware that  
18 your diorama is still on exhibit at the airport  
19 currently?

20 THE WITNESS: It's -- yeah. They're  
21 supposed to be taking it down, so I'm not sure if it's  
22 still there or not.

23 JUDGE BIRO: Okay.

24 THE WITNESS: But I don't have access to  
25 that part of the airport unless I get an escort.



1 JUDGE BIRO: Did you pay by the year for  
2 that opportunity to advertise?

3 THE WITNESS: It was by the month, I  
4 believe.

5 JUDGE BIRO: And when did you cease paying  
6 for that?

7 THE WITNESS: I want to say it was  
8 sometime -- I was under a contract when I first did  
9 it. It was a five-year contract with the company that  
10 was in charge at the time. They -- when they moved  
11 their contract -- when the airport took over the  
12 marketing from the company, the contract was void, and  
13 they said at that time -- I said, you know, I don't  
14 want to keep doing this, it's just not cost-effective.  
15 It was, you know, supposedly 3 million people walking  
16 through that airport every day, including all the  
17 people at Newark. It was just -- I maybe got one  
18 phone call, and it was from a science teacher who told  
19 me I had misspelled principle because they -- you  
20 know, I got a big email saying that they liked the  
21 diorama. It was all -- the whole bottom part was all  
22 science-sourced stuff. You know, it was like, you  
23 know, chemical -- this bird that goes up and down.  
24 There was this little globe that goes around.

25 You know, it was all -- I had to reengineer

1 all that to, you know, work in a box, in a closed  
2 system under lights. And, you know, the only reason I  
3 did it on that side of the airport was because a lot  
4 of kids go to the airport, go to Orlando that way.  
5 And this may sound self-serving, but, you know, I  
6 couldn't get my own kids interested in science. I  
7 thought, well, maybe I can get somebody else's kids  
8 interested in science.

9 And I did get emails from, you know,  
10 teachers, like that one who told me I misspelled  
11 principle. And so, you know, it was, you know -- and  
12 I got -- you know, the person who put up my display  
13 said that one gets the most looks at. It was great  
14 for that, but it didn't do any good for business, so I  
15 opted out of it.

16 JUDGE BIRO: Well, did you ever go and take  
17 out your diorama out of the airport?

18 THE WITNESS: They're supposed to be taking  
19 it down if they haven't already.

20 JUDGE BIRO: Somebody else is supposed to go  
21 and take it down?

22 THE WITNESS: Right. It has to be somebody  
23 who can get on the other side of the security line,  
24 because I can't do it myself.

25 JUDGE BIRO: Did you set it up yourself?

1 THE WITNESS: I went with -- I was escorted  
2 in, and we set it up, yes.

3 JUDGE BIRO: Okay. So I'm sorry. When did  
4 you say you stopped paying for it?

5 THE WITNESS: I want to say six, seven  
6 months ago now. When the contract changed over, I was  
7 no longer under contract obligation.

8 JUDGE BIRO: How many applications have you  
9 done since this case was initiated? Patent  
10 applications of any type.

11 THE WITNESS: Since these proceedings right  
12 now?

13 JUDGE BIRO: Yeah. Since January.

14 THE WITNESS: I don't know. I believe  
15 counsel said -- I forget, 80 or something, 50. It  
16 seems high, but --

17 JUDGE BIRO: Okay. Did my questions suggest  
18 any questions you -- or other responses you'd like to  
19 give me?

20 THE WITNESS: No, ma'am.

21 JUDGE BIRO: Okay. Are there any questions  
22 you'd like to ask, counsel?

23 MS. FRANCIS: Just one, please.

24 JUDGE BIRO: Okay.

25 //

1 CROSS-EXAMINATION

2 BY MS. FRANCIS:

3 Q You said on your security clearance that you  
4 informed them of your patent law practice. Did you  
5 explain to them that you practiced patent law, or did  
6 you explain to them that it was K.P. Correll &  
7 Associates, a private law firm?

8 A I don't recall how they asked the question.  
9 I just filled out the form.

10 MS. FRANCIS: One moment, Your Honor, just  
11 to confer with counsel?

12 JUDGE BIRO: Uh-huh.

13 (Counsel confer.)

14 MS. FRANCIS: That's all, Your Honor. Thank  
15 you.

16 JUDGE BIRO: Okay. Mr. Correll, you're  
17 excused.

18 (Witness excused.)

19 JUDGE BIRO: Is there any other witnesses or  
20 exhibits?

21 MS. FRANCIS: No. We're done, Your Honor.

22 JUDGE BIRO: Okay. Everybody rests? We're  
23 all in agreement?

24 MS. FRANCIS: We rest, Your Honor.

25 JUDGE BIRO: Okay.

**UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE ADMINISTRATIVE LAW JUDGE**

<b>In the Matter of</b>	)	
	)	
<b>Kevin P. Correll,</b>	)	<b>Proceeding No. D2018-12</b>
	)	
<b>Respondent.</b>	)	

**INITIAL DECISION**

Before: Susan L. Biro  
Chief Administrative Law Judge, EPA<sup>1</sup>

Issued: October 3, 2019

**Appearances:**

For Complainant:

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For Respondent:

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<sup>1</sup> This Initial Decision is issued by the Chief Administrative Law Judge of the United States Environmental Protection Agency. The Administrative Law Judges of the Environmental Protection Agency are authorized to hear cases pending before the United States Department of Commerce, Patent and Trademark Office, pursuant to an Interagency Agreement effective for a period beginning May 15, 2014.

## I. PROCEDURAL HISTORY

This action was initiated January 17, 2018, when the Director of the Office of Enrollment and Discipline (“OED” or “Director”), United States Patent and Trademark Office (“USPTO”), issued a Complaint and Notice of Proceedings against Respondent Kevin P. Correll under 35 U.S.C. § 2(b)(2)(D), § 32, and 37 C.F.R. §§ 11.32, 11.34, 11.39. The Complaint charged Respondent with two counts of professional misconduct through violations of the USPTO Code of Professional Responsibility (“USPTO Code”), 37 C.F.R. §§ 10.20-10.112, and the USPTO Rules of Professional Conduct (“USPTO Rules”), 37 C.F.R. §§ 11.101 through 11.901.<sup>2</sup> The violations all arise from Respondent’s representation of private parties before the USPTO while he was employed by the federal government. For these violations, the OED Director sought in the Complaint an order excluding or suspending Respondent from practice before the USPTO in patent, trademark, and other non-patent matters, and other relief as warranted.

Respondent filed his “Answer Under 37 CFR 11.36, Defenses and Counter Claims” (“Answer”) on February 15, 2018. In the Answer, Respondent admitted the truth of almost all the factual allegations in the Complaint but raised various affirmative defenses and claims to liability, including some based upon the statute of limitations and the U.S. Constitution. Thereafter, the parties participated in this Tribunal’s alternative dispute resolution process for nearly two months but did not resolve the matter. On April 26, 2018, the undersigned was designated to preside over this proceeding, and on May 1, 2018, I issued an Order Scheduling Prehearing Procedures and Hearing. Shortly thereafter, the OED filed a motion for summary judgment and a motion to stay the prehearing deadlines, and Respondent filed a motion to dismiss and a cross-motion for summary judgment. The OED’s motion to stay the prehearing deadlines was granted on May 31, 2018, and the parties then engaged in extensive briefing on the pending dispositive motions. On August 16, 2018, I issued an order denying Respondent’s motion to dismiss based on his statute of limitations defense.<sup>3</sup> *See* Order on Respondent’s Motion to Dismiss (Aug. 16, 2018).

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<sup>2</sup> As of May 3, 2013, the USPTO Rules govern attorneys practicing before the USPTO. *See* 37 C.F.R. §§ 11.101-11.901. The USPTO Code applied to misconduct occurring prior to that date. *See* 37 C.F.R. §§ 10.20-10.112 (repealed). The misconduct alleged in the Complaint occurred before and after May 3, 2013, so both the USPTO Code and the USPTO Rules apply in this proceeding. Count I alleges a total of six violations of the USPTO Code under 37 C.F.R. §§ 10.23(a), 10.23(b)(4), 10.23(b)(5), 10.23(b)(6), 10.23(c)(20), and 10.40(b)(2), as well as six violations of the USPTO Rules, 37 C.F.R. §§ 11.111, 11.116(a)(1), 11.505, 11.804(b), 11.804(d) and 11.804(i). Count II alleges two additional violations, one under USPTO Code section 37 C.F.R. § 10.23(b)(6), and one under the USPTO Rules, 37 C.F.R. § 11.804(i).

<sup>3</sup> This motion represented the first of two dismissal motions Respondent filed based upon the statute of limitations. The applicable statute of limitations provides that a USPTO disciplinary “proceeding shall . . . commence[ ] not later than the earlier of either the date that is 10 years after the date on which the misconduct forming the basis for the proceeding occurred, or 1 year after the date on which the misconduct forming the basis for the proceeding is made known to an officer or employee of the Office as prescribed in the regulations established under section 2(b)(2)(D).” 35 U.S.C. § 32. The first motion to dismiss argued that the OED Director had received notice of Respondent’s misconduct in 2003 when he responded to an OED survey indicating he was a government employee. Respondent claimed this triggered both the one- and ten-year deadlines. I rejected those arguments and denied Respondent’s motion. *See* Order on Respondent’s Motion to Dismiss (Aug. 16, 2018).

On September 27, 2018, I issued a lengthy order on the parties' cross-motions for summary judgment. *See* Order on Motions for Summary Judgment (Sept. 27, 2018) ("SJ Order"). The SJ Order resolved all issues of liability, finding Respondent liable for certain violations and not liable for others. It also addressed the myriad "Counter Claims and Defenses" to liability raised by Respondent in this action including those based upon the First Amendment to the U.S. Constitution, statutory misinterpretation, statutory exemption, lack of conflict of interest, Fifth Amendment substantive and procedural due process, privacy act provisions, and 18 U.S.C. §§ 242 and 245. SJ Order at 14-27. I rejected all these defenses and counterclaims, as well as two others Respondent raised in his Answer but either failed to support or abandoned during the motions process. SJ Order at 27. In addition, I denied summary judgment as to sanction, finding that Respondent had raised factual disputes related to the gravity of his misconduct to warrant a hearing. SJ Order at 26.

An Order rescheduling hearing and prehearing proceedings was issued on October 12, 2018. Pursuant thereto, the Director and Respondent filed their initial prehearing statements on December 21, 2018 and January 11, 2019, respectively, with the Director updating his exhibit list thereafter.

On December 28, 2018, Respondent filed a second motion to dismiss the complaint based on the statute of limitations.<sup>4</sup> *See* Respondent's Motion to Dismiss Complaint (Dec. 28, 2018). About a week later, on January 7, 2019, Respondent also filed a motion seeking interlocutory review of the SJ Order's holding as to the invalidity of his First Amendment defense. *See* Respondent's Motion for Leave to Motion USPTO Director to Review Tribunal's Interlocutory Order and Motion to Suspend Proceeding Pending USPTO Director's Review (Jan. 7, 2019). Both motions were opposed by the OED, and on February 25, 2019, I issued separate Orders denying both motions. *See* Order on Respondent's Second Motion to Dismiss Complaint (Feb. 25, 2019); Order on Respondent's Motion for Interlocutory Appeal and Stay of Proceedings (Feb. 25, 2019).

Subsequently, on March 4, 2019, the OED filed a motion requesting a new hearing date or permission to subpoena and take the deposition of the grievant, its key witness, James M. Kasischke, Esq., due to his unavailability to personally appear at hearing. Respondent advised the OED of his opposition to the motion but filed no written response thereto. I granted the OED's Motion. *See* Order on OED Director's Motion for New Hearing Date or to Subpoena Witness for Deposition (Mar. 6, 2019). With the participation of the Respondent, the Director took Mr. Kasischke's videotaped deposition on April 2, 2019. *See* OED Director's Notice to Take Deposition of James M. Kasischke (Mar. 26, 2019); OED Director's Notice of Filing Deposition Transcript with the Tribunal (Apr. 12, 2019).

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<sup>4</sup> In this second Motion, Respondent asserted that the OED had received notice of his misconduct on September 28, 2016, when the grievant in the case, James M. Kasischke, Esq., learned of his misconduct, arguing that Mr. Kasischke was an "officer" of the USPTO as contemplated by 35 U.S.C. § 2(b)(2)(D). In denying the Motion, I held that merely being authorized to practice before the USPTO did not make Mr. Kasischke an "officer" or employee of the USPTO and, as such, his knowledge of Respondent's misconduct cannot be attributed to the OED prior to Mr. Kasischke's December 19, 2017 email to the OED. *See* Order on Respondent's Second Motion to Dismiss Complaint (Feb. 25, 2019).

On March 26, 2019, the parties filed Joint Stipulations (“Stips.”). The hearing in this matter was held on April 16, 2019 in Providence, Rhode Island.<sup>5</sup> At hearing, the OED Director elicited the testimony of Respondent and submitted into evidence the written deposition testimony of Mr. Kasischke.<sup>6</sup> Tr. 13-65. The Tribunal also admitted into evidence 20 Joint Exhibits (“JX”) numbered 1-20 as well as five OED Director’s Exhibits (“DX”) nos. 20, 32-35.<sup>7</sup> Tr. 15, 39, 43-44, 67. Respondent narratively testified on his behalf at hearing but submitted no additional testimony or documents. Tr. 47-65.

The undersigned received the hearing transcript on May 2, 2019 and provided copies to the parties on May 7, 2019. The Director’s initial post-hearing brief (“DIB”) was filed on June 28, 2019, and the Respondent’s initial post-hearing brief (“RIB”) was filed on July 12, 2019.<sup>8</sup> Thereafter, reply briefs were filed on August 9, 2019 by the Director (“DRB”) and on August 23, 2019 by the Respondent (“RRB”).<sup>9</sup> The record closed with that last filing.

## II. LEGAL BACKGROUND

Congress has authorized the USPTO to promulgate regulations governing “the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Office[.]” 35 U.S.C. § 2(b)(2)(D). If an attorney does not comply with regulations issued under § 2(b)(2)(D), or if he is “shown to be incompetent or disreputable, or guilty of gross misconduct,” the USPTO may suspend or exclude the attorney from further practice before the USPTO. 35 U.S.C. § 32. *See also Bender v. Dudas*, 490 F.3d 1361, 1365 (Fed. Cir. 2007); *Sheinbein v. Dudas*, 465 F.3d 493, 495 (Fed. Cir. 2006). “Under these statutes, the PTO has the exclusive authority to establish qualifications for admitting persons to practice before it, and to suspend or exclude them from practicing before it.” *Kroll v. Finnerty*, 242 F.3d 1359, 1364 (Fed. Cir. 2001).

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<sup>5</sup> Citation to the hearing transcript will be in the following form: “Tr. \_\_.”

<sup>6</sup> The transcript of Mr. Kasischke’s deposition testimony, along with the exhibits, acknowledgement and errata sheet thereto, were together admitted into evidence as Joint Ex. 21. Tr. 13-15. The videotape of Mr. Kasischke’s testimony was neither offered nor admitted into evidence.

<sup>7</sup> Admission of documentary evidence offered by the Director identified as DX 19, DX 38, and DX 39 was denied based on lack of foundation supporting their authenticity. Tr. 26, 29. Testimonial reference specifically to such documentary evidence is hereby stricken from the record and not considered in reaching the determination made herein. *See* Tr. 20-23, 26-27, 44-46.

<sup>8</sup> Respondent’s initial post-hearing brief, entitled “Reply Brief,” was filed out of time, but nevertheless accepted. *See* Order on OED Director’s Request for Extension of Time (May 10, 2019). The Director then moved to respond to the late-filed brief. The Director’s motion was granted, and Respondent was also given an opportunity to file an additional post-hearing brief. *See* Order on OED Director’s Motion to File a Reply Brief (July 16, 2019). The bulk of Respondent’s reply brief is a regurgitation of his First Amendment argument in defense of his conduct. RRB at 4-12. That issue was ruled upon in the SJ Order, and as Respondent fails to show in his brief that that ruling was clearly erroneous, it is not being reconsidered. SJ Order at 15-17.

<sup>9</sup> In addition to the Joint Stipulations filed by the parties prior to hearing, the Director’s initial brief contained a numbered “Statement of Proposed Facts.” DIB at 1-13. In his two post-hearing briefs, Respondent indicated that he stipulated to the truth of the facts set forth in paragraphs numbered 1-13, 20-33, 35, 37-49, and 52-66 therein. RIB at 3; RRB at 3. The remaining facts Respondent “denied in whole or in part.” RIB at 3. These additional stipulations agreed to by the parties are cited herein as “DIB Stip. \_\_.”



In 1985, the USPTO issued regulations based on the American Bar Association (“ABA”) Model Code of Professional Responsibility to govern attorney conduct and practice. *See Practice Before the Patent and Trademark Office*, 50 Fed. Reg. 5158 (Feb. 6, 1985) (Final Rule) (codified at 37 C.F.R. §§ 10.20-10.112 (1985-2003)). These regulations set forth the USPTO Code of Professional Responsibility (“USPTO Code”) and “clarif[ied] and modernize[d] the rules relating to admission to practice and the conduct of disciplinary cases.” *Id.* They remained in effect through April 2013.<sup>10</sup> That year, recognizing that most state bar organizations had adopted substantive disciplinary rules based on the newer ABA Model Rules of Professional Conduct, the USPTO repealed its Code of Professional Responsibility and replaced it with the Rules of Professional Conduct (“USPTO Rules”) fashioned on the ABA’s Model Rules. *See Changes to Representation of Others Before the United States Patent and Trademark Office*, 78 Fed. Reg. 20180 (Apr. 3, 2013) (Final Rule) (codified at 37 C.F.R. §§ 11.101-11.901). In making this change, the USPTO sought to “provid[e] attorneys with consistent professional conduct standards, and large bodies of both case law and opinions written by disciplinary authorities that have adopted the ABA Model Rules.”<sup>11</sup> *Id.* at 20180.

Both the USPTO Code and the USPTO Rules are relevant in this case. The USPTO Code applies to conduct occurring prior to May 3, 2013, when the USPTO Rules became effective and applicable to conduct occurring after that date. *Id.* The USPTO Code is “mandatory in character and state[s] the minimum level of conduct below which no practitioner can fall without being subjected to disciplinary action.” 37 C.F.R. § 10.20(b); *see Sheinbein*, 465 F.3d at 495-96. The USPTO Rules carry that standard forward. *Changes to Representation of Others Before the United States Patent and Trademark Office*, 78 Fed. Reg. at 20181.

Furthermore, as to federal government employees, both the USPTO Code and USPTO Rules incorporate within them the standards of conduct set forth in federal conflicts of interest laws, regulations and codes of professional responsibility. *See* 37 C.F.R. § 10.10(d)(2000-03) (“Practice before the Office by Government employees is subject to any applicable conflict of interest laws, regulations or codes of professional responsibility.”); 37 C.F.R. § 11.10(e)(2004-present) (same).

Federal conflict of interest statutes impose certain prohibitions upon federal employees. *See* 18 U.S.C. §§ 203, 205 (“Conflict of Interest Statutes”). Generally, an employee of the United States may not “accept any compensation for any representational services, as agent or attorney or otherwise, rendered or to be rendered either personally or by another” in “any proceeding, application, [or] request for a ruling or other determination . . . in which the United States is a party or has a direct and substantial interest[.]” 18 U.S.C. § 203(a)(1)(B). Additionally, “an officer or employee of the United States . . . other than in the proper discharge of his official duties” may not “act[ ] as agent or attorney for anyone before any department [or]

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<sup>10</sup> Certain provisions of the USPTO Code were revised and/or renumbered in 2004. *See Changes to Representation of Others Before the United States Patent and Trademark Office*, 69 Fed. Reg. 354280-01 (Jun. 24, 2004). The date of that interim revision is reflected herein where applicable.

<sup>11</sup> Also useful to understanding the USPTO Code and USPTO Rules are Comments and Annotations to the ABA Model Rules as well as decisions and opinions issued by state bars. *See Changes to Representation of Others Before the United States Patent and Trademark Office*, 78 Fed. Reg. 20180.

agency . . . in connection with any covered matter in which the United States is a party or has a direct and substantial interest[.]”<sup>12</sup> 18 U.S.C. § 205(a)(2). Violators of sections 203 and/or 205 are subject to criminal and civil penalties under 18 U.S.C. § 216, which authorizes imprisonment for not more than one year, or five years if the conduct is deemed willful, and/or a fine of up to \$50,000 for each violation or “the amount of compensation which the person received or offered for the prohibited conduct, whichever amount is greater.”<sup>13</sup> 18 U.S.C. § 216(a), (b).

In 1949, the United States Attorney General issued a formal advisory opinion declaring that -

“[T]he United States is a party or directly or indirectly interested” within the meaning of section 281 of Title 18, United States Code [now codified as 18 U.S.C. § 203], in proceedings involving the filing and prosecution before the United States Patent Office of an application for a patent. This being so, section 281, of course, proscribes the participation in such proceedings of Government employees for compensation on behalf of private parties.

*Gov’t Employees Prosecuting Claims for Patents*, 41 U.S. Op. Atty. Gen. 21, 23, 1949 WL 1637 (1949). *See also Kearney & Trecker Corp. v. Giddings & Lewis, Inc.*, 452 F.2d 579, 591 (7th Cir. 1971), *cert. denied*, 405 U.S. 1066 (1972) (holding that the United States has a direct and substantial interest in the prosecution of a patent application before the Patent and Trademark Office).

In 1991, the United States Office of Government Ethics (“OGE”)<sup>14</sup> issued an opinion reiterating that “in the case of an executive branch employee, [] the prosecution of a patent application for a private party for compensation is generally subject to the prohibition of [Sections 203 and 205].” JX 11 at 36-37.

Almost a decade later, the United States Court of Appeals for the District of Columbia Circuit similarly interpreted 18 U.S.C. § 205, rejecting the claim that covered prohibited matters were limited to adversarial or formal legal proceedings. The Court held that “the conflicting interests at which § 205 is aimed could be equally present, for example, were a federal employee to represent a private party in its uncontested application for a broadcast license, *patent*, or other valuable benefit.” *Van Ee v. E.P.A.*, 202 F.3d 296, 302 (D.C. Cir. 2000) (emphasis added). Shortly thereafter, in response to an inquiry for clarification submitted by a government attorney

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<sup>12</sup> A “covered matter” is defined by the statute as “any judicial or other proceeding, application, request for a ruling or other determination, contract, claim, controversy, investigation, charge, accusation, arrest, or other particular matter.” 18 U.S.C. § 205(h).

<sup>13</sup> The imposition of a civil penalty under section 216 does not preclude any other civil “statutory, common law, or administrative remedy, which is available by law to the United States or any other person.” 18 U.S.C. § 216(b).

<sup>14</sup> “The U.S. Office of Government Ethics (OGE) was established by the Ethics in Government Act of 1978, Public Law 95-521, 92 Stat. 1824 (1978).” 5 C.F.R. § 2600.101(a). Its mission is “to prevent conflicts of interest on the part of executive branch employees and resolve those conflicts of interest that do occur.” *Id.* OGE serves as “the supervising ethics office for all executive branch officers and employees pursuant to the Ethics Reform Act of 1989, Public Law 101-194, 103 Stat. 1716 (1989), as amended by Public Law 101-280, 104 Stat. 149 (1990).” 5 C.F.R. § 2600.101(b).

in light of *Van Ee*, OGE issued yet another opinion explicitly reiterating that for a regular government employee to “act as a compensated agent for private clients in prosecuting patent applications before the Patent and Trademark Office of the Department of Commerce” “would violate 18 U.S.C. § 203 and 18 U.S.C. § 205.” Letter to a Former Employee,<sup>15</sup> OGE Informal Advisory Letter 01 X 1 (O.G.E.), 2001 WL 34091910, at \*1-2 (“OGE Letter”) (“In sum, your proposed conduct falls squarely within the terms of 18 U.S.C. §§ 203 and 205. Accordingly, you are not permitted to act as a compensated agent for private clients in prosecuting patent applications before the Patent and Trademark Office. We concur with the advice given to you by the ethics official at your agency.”).

In addition to the Conflict of Interest Statutes, federal employees are also subject to ethics regulations titled “Standards of Ethical Conduct for Employees of the Executive Branch.” 5 C.F.R. § 2635 *et seq.* Those Standards include prohibitions on outside employment “prohibited by statute or by an agency supplemental regulation” and explicitly reference 18 U.S.C. §§ 203 and 205 as statutes establishing standards to which an employee’s conduct must conform. JX 21, ex. 4; 5 C.F.R. §§ 2635.802(a), 2635.901, 2635.902(c), (d). The Department of Defense (“DOD”), of which the Navy is part, has issued a supplemental ethics regulation requiring its employees who file financial disclosure reports on OGE Form 450 to obtain prior written approval before engaging in outside employment. 5 C.F.R. § 3601.107; JX 10 at 2 (citing DOD 5500.7-R); National Security Act of 1947, Pub. L. No. 80-253, 61 Stat. 495 (making the Department of the Navy part of the DOD). *See also* 5 C.F.R. § 2635.803 (specifically allowing for agencies to issue supplemental regulations requiring their employees to obtain prior approval before engaging in outside employment and requiring those employees to obtain that approval before engaging in outside employment).

### **III. BURDEN OF PROOF**

The OED Director must prove alleged violations by clear and convincing evidence. 37 C.F.R. § 11.49; *Johnson*, PTO Proceeding No. D2014-12, slip op. at 2 (Dec. 31, 2014) (Initial Decision and Order).<sup>16</sup> Likewise, it is Respondent’s burden to prove any affirmative defense by clear and convincing evidence. 37 C.F.R. § 11.49; *Piccone v. United States Patent & Trademark Office*, No. 1:18-cv-00307 (LMB/IDD), 2018 WL 5929631, at \*7 (E.D. Va. Nov. 13, 2018). This standard “protect[s] particularly important interests . . . where there is a clear liberty interest at stake.” *Johnson*, PTO Proceeding No. D2014-12 at 3 (quoting *Thomas v. Nicholson*, 423 F.3d 1279, 1283 (Fed. Cir. 2005)) (quotation marks omitted). “Clear and convincing evidence” requires a level of proof that falls “between a preponderance of the evidence and proof beyond a reasonable doubt.” *Id.* (quoting *Addington v. Texas*, 441 U.S. 418, 424-25 (1979)) (internal quotation marks omitted). The evidence produced must be of such weight so that it “produces in the mind of the trier of fact a firm belief or conviction, without hesitancy, as to the truth of the allegations sought to be established.” *Id.* (quoting *Jimenez v. DaimlerChrysler Corp.*, 269 F.3d

<sup>15</sup> The title of the OGE Letter suggests the employee of the unnamed government “Department” left his position before its issuance. The Letter provides no further information regarding the employee’s job title or responsibilities and suggests that such matters are immaterial to the application of the broad prohibition unless the person qualifies as a “special Government employee.” 2001 WL 34091910.

<sup>16</sup> The PTO case decisions cited here are publicly accessible via the search portal available at: <https://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>.

439, 450 (4th Cir. 2001)) (internal quotation marks omitted). “Evidence is clear if it is certain, unambiguous, and plain to the understanding, and it is convincing if it is reasonable and persuasive enough to cause the trier of facts to believe it.” *Id.* (quoting *Foster v. Alliedsignal, Inc.*, 293 F.3d 1187, 1194 (10th Cir. 2002)) (internal quotation marks omitted).

#### IV. FACTUAL BACKGROUND

Respondent’s undergraduate educational background is in physics and electrical engineering. Tr. 16; JX 5. In 1999, he graduated from Roger Williams University School of Law in Bristol, Rhode Island. Tr. 16-17; JX 5. He was admitted to practice law in Massachusetts on June 14, 1999 and currently remains an active member in good standing of that bar. Stip. 3; Tr. 16; JX 2. On September 12, 2000, Respondent registered as a patent attorney with the USPTO (registration number 46,641). Stips. 1, 2; Tr. 17-18; JX 1. As a condition of registration, Respondent swore an oath to “observe the laws and rules of practice of the [USPTO].” Stip. 4; Tr. 18.

Since September 4, 2002, Respondent has owned and operated a solo law practice under the names “K.P. Correll & Associates, LLC,” “Northeastern Patent Law Associates,” or “Patent Institute.” Tr. 30-32; DIB Stips. 7, 10; JX 10 at 1, 34-37. The “client office” for the practice is in Fall River, Massachusetts, but the business uses a Rhode Island mailing address. Tr. 31; JX 2. Respondent has advertised his law practice via the internet, paper flyers, the yellow book and in two booth diorama displays at the T.F. Green Airport in Warwick, Rhode Island. DIB Stip. 11; Tr. 40-41, 61; JX 6. The practice holds itself out as an “intellectual property law firm serving corporate and individual clients across the country and around the world by protecting their intellectual property assets through patents, federal trademarks, and federal copyrights.” DIB Stips. 7, 12; Tr. 31.

Less than two weeks after establishing his law firm -- that is, beginning on September 16, 2002, and continuing until September 29, 2018 -- Respondent was also employed as a full-time electronics engineer for the United States Department of the Navy, Naval Undersea Warfare Center (“NUWC”) at the Naval Sea Systems Command headquartered in Newport, Rhode Island. Stip. 5; Tr. 29-30; DIB Stip. 6; JX 10 at 1; JX 12 at 3. There, as a “branch head,” he primarily worked on submarine learning technologies, conducting system analyses of submarine training devices and training systems. Tr. 48-52, 54; JX 14 at 1; JX 12 at 3. In his last year with the government, he was temporarily promoted to Chief Technology Officer for the Submarine Learning Center in Groton, Connecticut, an ND 5 (comparable to GS-14) supervisory position and tasked with “investigating new educational concepts for better training, faster training, more economical training.” Tr. 51-52; JX 14 at 1; DX 20. Throughout his government career, Respondent maintained a secret level security clearance, had access to classified information, and worked in a secured facility. Tr. 49-50; JX 12 at 1.

Respondent testified that prior to joining the government “it never occurred to me that it would be a conflict” between continuing his law practice and serving as a federal employee, so he did not inquire into the ethics thereof. Tr. 55. Still, he recalled that shortly after joining the government in 2002, he had a conversation with his then-direct government supervisor, Harold Watt, a division head at NUWC, from which he came away believing that his private law practice did not conflict with his government work and that he had Mr. Watt’s informal, i.e., verbal, approval to continue to engage in such work. Respondent testified that this approval was

never withdrawn. Tr. 23-24, 47-48, 54; JX 8 at 2; JX 10 at 2. Respondent stated that over his career at NUWC he had other supervisors who became aware that he had a law degree and maintained a private law practice, but he never sought from them any type of approval for his outside work activities. JX 10 at 2-3.

Around November 25, 2003, Respondent submitted a signed, dated, certified response to a USPTO Survey. JX 3; Tr. 18-20; DIB Stip. 5. In his response, Respondent hand-marked “YES” to Question 6 on the Survey, which read as follows:

Are you an employee of the United States Government? *PLEASE*  
*NOTE: U.S. Government employees are not available to accept*  
*private clients or to represent clients other than their agency before*  
*the United States Patent and Trademark Office. 18 U.S.C. § 205;*  
*37 CFR § 10.10(c) and (d).*

JX 3 at 1 (italics in original); Tr. 19-20; DIB Stip. 5. Despite this notice, Respondent claimed that even after completing the Survey he remained unaware of the conflict between engaging in both private practice and government work. Tr. 57.

In addition to his regular duties at the NUWC, from approximately 2004 until 2016, Respondent was also a voting member of the base’s Invention Examination Board (“IEB”). Tr. 30; JX 14 at 1; JX 15 at 1; JX 10 at 1-2; JX 21 at 10, 13; DIB Stip. 33. The IEB consists of approximately ten Navy inventors and engineers representing the various technical areas within the Newport laboratory, including sonar, antennas, combat systems, launchers, undersea vehicles, and others. JX 21 at 9-12; JX 14 at 1. The IEB meets several times a year and is overseen by the base’s non-voting Supervising Patent Counsel. JX 21 at 9-10, 12-13, 34; JX 14 at 1. Prior to seeking a patent, all NUWC employees are required to submit disclosures of their inventions to the base’s Patent Counsel’s Office for an initial determination as to whether the invention is owned by the Navy or the employee/inventor, personally. JX 21 at 10-12, 25, 35; JX 14 at 2; JX 15 at 2; JX 17 at 3. If the invention belongs to the Navy, the IEB then reviews it and votes as to whether the Supervising Patent Counsel should seek patent protection for the invention on the Navy’s behalf and the priority thereof. JX 10 at 1-2; JX 14 at 1; JX 21 at 9-11; Tr. 30.

Since 2004, James M. Kasischke, Esq. has been the Supervisory Patent Counsel at the NUWC in Newport, RI. JX 21 at 8-9; JX 14. His position involves overseeing the whole patent program for NUWC laboratory in Newport, including patent applications, patent licensing, patent prosecution, and the IEB. JX 21 at 9-10, 37; JX 14. Mr. Kasischke estimated that since 2004, he has filed more than 500 patents for the government, as he, like Respondent, is a registered PTO patent practitioner. JX 21 at 8, 36. However, other than both being IEB participants, Mr. Kasischke testified his position did not involve working with Respondent. JX 14 at 2; JX 21 at 10.

Sometime around 2005 or 2006, while in a barbershop near NUWC, Mr. Kasischke came across a flyer offering the invention services of Kevin P. Correll or KP Correll Intellectual Property Services. JX 21 at 16; DX 14 at 1. Based upon inquiries he had previously made for himself regarding earning outside income, Mr. Kasischke knew that such outside work activities by Respondent were “wrong” and a “violation.” JX 21 at 16-18, 29-30; JX 14. Explaining that



he “was trying to be a good guy” and recognizing that Respondent “might not have known about the law,” Mr. Kasischke telephoned Respondent and notified him that “you can’t file patent applications if you’re a government employee.” JX 21 at 16-17, 22, 29-30; JX 14. In reply, Respondent reassured Mr. Kasischke that he was aware of the prohibition and that “he wasn’t filing patent applications” but merely “advis[ing] people on what to do with their inventions and advis[ing] them maybe to get somebody else to file the patent applications.” JX 21 at 19; JX 14 at 1. Because he was busy, Mr. Kasischke said he took Respondent at his word and after that “didn’t keep [his] eye on him” or report his outside activities to the USPTO.<sup>17</sup> JX 21 at 26.

Sometime in 2008 or 2009, Respondent filed an OGE Form 450 Financial Disclosure Report for 2008, in which he claims he disclosed his outside work activities.<sup>18</sup> JX 8 at 2; JX 10 at 2, n.6; JX 10 at 3, 21-23; JX 13 at 1, 4 n.5; JX 17 at 4. Respondent had been receiving annual online ethics training from NUWC and was aware that NUWC employees who are required to file OGE 450s must “obtain supervisor’s [written] concurrence before engaging in any business activities outside of their official duties or in any compensated employment.” JX 8 at 2; JX 10 at 2, n.6; JX 10 at 3, 21-23; JX 13 at 1, 4 n.5; JX 17 at 4. Nevertheless, Respondent did not seek or receive written concurrence for his outside work activities either before or after filing the OGE 450 form. Tr. 57.

Mr. Kasischke testified that many years later, around fall 2016, he noticed two large standing glass booths in the Providence, RI airport advertising Respondent’s professional services as Northeastern Patent Associates and another named entity.<sup>19</sup> JX 21 at 14-15; JX 6. Coincidentally, about the same time, some other NUWC employees mentioned the airport advertisements to him as well, as they too recognized them as being connected to Respondent. JX 21 at 14. Among those other employees was the head of the IEB, Dr. Theresa Baus, who advised Mr. Kasischke that “you know, you probably have to do something about that.” JX 21 at 19-20.

In response, Mr. Kasischke testified, he undertook a search to determine for himself whether Respondent had “really been filing patent applications” for private clients with the USPTO and found that he had. JX 21 at 14, 20. He also discovered that Respondent was not then identified as a government employee on the USPTO’s register of attorneys, “when I knew he was.” JX 21 at 29; *see also* JX 1 (USPTO computerized registration data extracted Dec. 5, 2017 identifying Respondent as *not* being a federal employee). Mr. Kasischke became “mad” at Respondent “because I warned him, and he’d gone against my advice.” JX 21 at 26. Mr. Kasischke concluded that it was his “duty as a Navy attorney” to report Respondent, “first, you

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<sup>17</sup> While Respondent claimed at hearing to not recall the conversation and characterizes Mr. Kasischke’s testimony in his post-hearing reply brief as “perjured,” I credit as truthful Mr. Kasischke’s testimony regarding the conversation he had with Respondent in 2005 or 2006. Tr. 20-24, 27-28; RRB at 3. Mr. Kasischke’s testimony about this event was detailed, reasonable, and consistent, and I see no motive for deceit or bias. JX 21 at 16-17, 22, 29-30; JX 4; JX 14.

<sup>18</sup> A copy of Respondent’s 2008 OGE Form 450 is not in the record. *See* JX 10 at 22 (email indicating NUWC deleted forms filed prior to 2011 from its system).

<sup>19</sup> Respondent testified that he installed the airport displays in January 2016 but ceased paying for them after approximately two years because they were not “cost-effective” in that they did not generate any business for him. Tr. 40, 62-64.

know, as far as the ethics violation to the US government [a]nd then as a US PTO bar member, I had to report to the patent bar.” JX 21 at 20, 28. On December 19, 2016, he emailed OED advising that Respondent was filing patents and trademark applications while employed with the Department of Navy in contravention of 18 U.S.C. §§ 203 and 205. JX 4. In addition, Mr. Kasischke testified that he spoke with Dr. Baus and together they decided that it was no longer appropriate for Respondent to be on the IEB “due to conflicts of interest,” and Dr. Baus removed him from the Board. JX 21 at 20; JX 14 at 1; JX 15 at 1; Tr. 30.

Upon receipt of Mr. Kasischke’s email, the OED opened an investigation. JX 7. As part of that investigation, beginning on February 9, 2017, and continuing through November 2017, the Director sent Respondent a series of four Requests for Information (RFI). Each RFI advised Respondent that:

With a small number of exceptions,<sup>20</sup> United States Government employees may not represent anyone other than themselves on any matter before the executive branch. 18 U.S.C. 205. In addition, executive branch employees are prohibited from receiving any form of compensation derived from representation of another before the executive branch. See 18 U.S.C. 203. In addition, 37 C.F.R. § 11.10(e) provides that “[p]ractice before the office by government employees is subject to any applicable conflict of interest laws, regulations or codes of professional responsibility.

JX 7 at 2-3; JX 9 at 3; JX 11 at 5; JX 16 at 5; Tr. 33-34; DIB Stips. at 20, 24, 27, 30.

Respondent submitted written responses to each of the OED’s RFIs. JX 8; JX 10; JX 12; JX 13; JX 17; DIB Stip. 22. Respondent included with his RFI responses lengthy legal memoranda offering his view of the proper statutory interpretation of 18 U.S.C. § 203 and 205 in support of his assertion “that he has been in compliance with the law” and further promising that he would “begin immediate separation from US Government service if OED’s interpretation of 18 USC 205 is averse to the practitioner’s position.”<sup>21</sup> JX 8; JX 10 at 5; JX 13 at 7; DIB Stips. 22, 26, 29.

Despite the advisement in the RFIs, and despite the on-going USPTO investigation, Respondent continued to both work for the NUWC and file USPTO applications for private

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<sup>20</sup> In general, the exceptions are for “special government employees” (defined by 18 U.S.C. § 202(a) as essentially short-term employees); employees serving as personal fiduciaries representing family members or estates; employees acting under a grant; employees testifying under oath; and employees representing others in government personnel or labor proceedings. 18 U.S.C. § 203(c)–(f); 18 U.S.C. § 205(c)–(i). Respondent’s conduct here does not fall within the exceptions. See SJ Order at 20-22. See also, JX 11 at 33 (Informal Advisory Letter 88 x 3 (O.G.E.) (Mar. 2, 1988) (advising that a federal employee should obtain supervisors consent to representation under an exception to 18 U.S.C. § 205 to assure representation is not inconsistent with “the faithful performance of [his] duties”); JX 11 at 36 (Informal Advisory Letter 91 x 11 (O.G.E.) (Apr. 4, 1991) (advising that status of “special government employee” is determined a time of appointment and Agency ethics officials be contacted for “ascertaining the impact of [sections 203 and 205 exceptions] have on your situation”).

<sup>21</sup> In his response to the third RFI, Respondent modified his representation stating that he would begin separation if OED’s contrary opinion is “supported by relevant legal opinions or is finally adjudicated in a court of competent jurisdiction.” JX 13 at 7; DIB Stip. 29. See also Tr. 48 (Respondent stating he told the USPTO “let’s go to court, let’s get a ruling. Once I get a ruling, then . . . I’ll resign from one or the other.”).

clients, professing to believe he “fit within the small number of exceptions” and that “according to case law” he was entitled to “maintain[ ] the status quo until there was an adjudication.” Tr. 34-35; DIB Stips. 43, 44; DX 32-34. At no time before or after the OED’s investigation was initiated did Respondent ever seek guidance from a government ethics official on the propriety of his dual work activities. Tr. 57; DIB Stips. 21, 25, 28, 31; JX 17 at 4.

On January 17, 2018, the OED Director filed the Complaint initiating this disciplinary proceeding seeking Respondent’s exclusion or suspension as a USPTO practitioner based upon his dual work activities.<sup>22</sup> DIB Stip. 55. Still, Respondent continued to engage in both his federal employment and private practice. Stip. 15-18; Tr. 37-38, 54-55; DX 35. However, on September 4, 2018, Respondent notified his supervisor that he would be retiring from the Navy “by the end of the month.” Stip. 9; JX 18; Tr. 41-42; DIB Stip. 60. Respondent’s voluntary separation from the Navy became effective as of September 29, 2018. Stip. 10; DIB Stip. 62; Tr. 43; DX 20. Respondent testified that this proceeding was the driving force in his retirement. Tr. 43-44.

During the time period spanning the violations at issue in this case – between January 17, 2008 (when the statute of limitations began to run) and September 29, 2018 (when Respondent retired) – Respondent filed and/or prosecuted approximately 169 patent applications with the USPTO on behalf of paying clients. JX 19; Stip. 17. According to USPTO records, of those patent applications, Respondent either filed or entered his appearance in approximately 60 provisional applications, 70 non-provisional utility applications, and 40 non-provisional design applications.<sup>23</sup> JX 19; DIB Stip. 41. In addition, during this same period, Respondent filed and/or prosecuted approximately 89 trademark applications.<sup>24</sup> JX 20; Stip. 18; DX 32-35.

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<sup>22</sup> While the factual background regarding Respondent’s overlapping work activities provided here goes back to 2002, the OED Director specified in his Initial Post-Hearing Brief that consistent with the applicable statute of limitations (35 U.S.C. § 32), he seeks discipline only for Respondent’s violative conduct beginning January 17, 2008, ten years prior to the date the Complaint was filed. DIB at 15-16. OED suggests that conduct occurring between September 16, 2002, the date Respondent began working for the federal government, and January 16, 2008, can be considered by this Tribunal as an aggravating factor as to penalty. DIB at 16. The record reflects that Respondent filed approximately 38 patent applications and two trademark applications during that early time period. JX 19 at 1; JX 20 at 7; DIB Stip. 40.

<sup>23</sup> A provisional patent application “provides the means to establish an early effective filing date in a later filed nonprovisional patent application.” It is a non-examined application which allows the term “Patent Pending” to be applied in connection with the description of the invention and lasts no more than 12 months from the date the provisional application is filed. See <https://www.uspto.gov/patents-getting-started/patent-basics/types-patent-applications/provisional-application-patent>. A non-provisional utility patent grants a property right for a period of time to the owner for the exclusive use of the invention. See <https://www.uspto.gov/patents-getting-started/patent-basics/types-patent-applications/nonprovisional-utility-patent#heading-2>. A design application protects the “visual ornamental characteristics embodied in, or applied to, an article of manufacture.” See <https://www.uspto.gov/patents-getting-started/patent-basics/types-patent-applications/design-patent-application-guide#def>. A patent search is a preliminary step involving searching the USPTO database for patents that have been previously filed or issued. See <https://www.uspto.gov/patents-application-process/search-patents>.

<sup>24</sup> A trademark typically protects brand names and logos used on goods and services. See <https://www.uspto.gov/trademarks-getting-started/trademark-process>.



For the services rendered to private clients, Respondent acknowledged at hearing that he charged and received financial compensation mostly on a flat-fee basis, “credit[ing] each fee forward.”<sup>25</sup> Tr. 39, 57; DIB Stips. 47, 48. Specifically, he charged \$750 for an initial patent search, which would be credited against a \$1,900 fee if the client then hired him to prepare and file a provisional application with the USPTO, a fee that in turn could be credited against a total fee of \$4,500-\$5,500 for preparing and filing a utility application, rates that remained the same over the years, Respondent stated. Tr. 58-59; DIB Stips. 49, 52. Respondent’s fee for preparing and filing design applications ranged from \$1,900 down to \$1,500, as his fees decreased over the years. Tr. 59-60; DIB Stip. 52. The flat fee he charged clients for preparing and filing a trademark application was \$300-\$400. Tr. 59; DIB Stip. 53.

## **V. VIOLATIONS FOUND**

The SJ Order granted summary judgment on liability under Count I, in part, to the Director finding the undisputed facts established that Respondent:

(1) “engaged in disreputable or gross misconduct” in violation of 37 C.F.R. § 10.23(a) by consulting with or giving advice to clients in contemplation of filing patent or trademark applications or other documents with the PTO and preparing and prosecuting patent and trademark applications before the PTO while employed by the U.S. Government;

(2) “engaged in conduct involving dishonesty, fraud, deceit, or misrepresentation” in violation of 37 C.F.R. § 10.23(b)(4) by consulting with or giving advice to clients in contemplation of filing patent or trademark applications or other documents with the PTO and preparing and prosecuting patent or trademark applications before the PTO while employed by the U.S. Government, not withdrawing as attorney of record in numerous patent and trademark matters pending before the PTO after being notified that he could not represent others before the PTO while employed by the U.S. Government, and receiving compensation for representing others before the PTO in violation of federal ethics law while employed by the U.S. Government;

(3) “engaged in conduct that is prejudicial to the administration of justice” in violation of 37 C.F.R. § 10.23(b)(5) by consulting with or giving advice to clients in contemplation of filing patent or trademark applications or other documents with the PTO and preparing and prosecuting patent or trademark applications before the PTO while employed by the U.S. Government, not withdrawing as attorney of record in numerous patent and trademark matters pending before the PTO after being notified that he could not represent others before the PTO while employed by the U.S. Government, and receiving compensation for representing others before the PTO in violation of federal ethics law while employed by the U.S. Government;

(4) engaged in “practice by a Government employee contrary to applicable Federal conflict of interest laws, or regulations of the Department, agency or commission employing” him in violation of 37 C.F.R. § 10.23(c)(20) when, after being notified that his actions violated

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<sup>25</sup> Respondent testified that charged a flat fee for the “initial” application plus an hourly fee for any “follow-on” work. Tr. 57; DIB Stip. 48.

18 U.S.C. §§ 203(a)(1)(B) and 205(a)(2), Respondent consulted with or gave advice to clients in contemplation of filing patent or trademark applications or other documents with the PTO and prepared and prosecuted patent or trademark applications before the PTO while employed by the U.S. Government, failed to withdraw as attorney of record in numerous patent and trademark matters pending before the PTO after being notified that he could not represent others before the PTO while employed by the U.S. Government, and when he received compensation for representing others before the PTO in violation of federal ethics law while employed by the U.S. Government;

(5) while representing clients before the PTO, failed to withdraw from those clients' employment when he knew or when it was obvious that his continued employment would result in violation of a Disciplinary Rule, in violation of 37 C.F.R. § 10.40(b)(2);

(6) "engaged in conduct which is contrary to applicable Federal ethics law, including conflict of interest statutes and regulations of the department, agency or commission formerly or currently employing said practitioner," in violation of 37 C.F.R. § 11.111, by consulting with or giving advice to clients in contemplation of filing patent or trademark applications or other documents with the PTO and preparing and prosecuting patent or trademark applications before the PTO while employed by the U.S. Government, by not withdrawing as attorney of record in numerous patent and trademark matters pending before the PTO after being notified that he could not represent others before the PTO while employed by the U.S. Government, and by receiving compensation for representing others before the PTO in violation of federal ethics law while employed by the U.S. Government;

(7) failed to withdraw from the representation of clients when it resulted in violation of the PTO Rules or other law, in violation of 37 C.F.R. § 11.116(a)(1);

(8) "practice[d] law in a jurisdiction in violation of the regulation of the legal profession in that jurisdiction," in violation of 37 C.F.R. § 11.505, by consulting with or giving advice to clients in contemplation of filing patent or trademark applications or other documents with the PTO and preparing and prosecuting patent or trademark applications before the PTO while employed by the U.S. Government, by not withdrawing as attorney of record in numerous patent and trademark matters pending before the PTO after being notified that he could not represent others before the PTO while employed by the U.S. Government, and by receiving compensation for representing others before the PTO in violation of federal ethics law while employed by the U.S. Government; and

(9) engaged in conduct that is prejudicial to the administration of justice, in violation of 37 C.F.R. § 11.804(d), by preparing and prosecuting patent or trademark applications before the PTO while employed by the U.S. Government, by not withdrawing as attorney of record in numerous patent and trademark matters pending before the PTO, and by receiving compensation for representing others before the PTO in violation of federal ethics law while employed by the U.S. Government.

SJ Order at 10-14.

The SJ Order also denied summary judgment to the Director, and granted it to Respondent, in regard to Count I, in part, finding Respondent not liable as to the alleged

violations of 37 C.F.R. § 11.804(b), the rule stating that it is professional misconduct for a practitioner to “[c]ommit a criminal act that reflects adversely on the practitioner’s honesty, trustworthiness or fitness as a practitioner” as well as 37 C.F.R. §§ 10.23(b)(6) or 11.804(i), rules forbidding a practitioner from “[e]ngag[ing] in . . . other conduct that adversely reflects on the practitioner’s fitness to practice before the Office.” SJ Order at 14. Further, Respondent was found not liable at all under Count II, which alleged violations of 37 C.F.R. §§ 10.23(b)(6) and 11.804(i). SJ Order at 14-15.

## VI. PENALTY FACTORS

Having found that Respondent committed violations of the USPTO Code and USPTO Rules, it falls to me to determine an appropriate sanction. 37 C.F.R. § 11.54(a)(2). Four factors must be considered before sanctioning a practitioner: (1) whether the practitioner has violated a duty owed to a client, to the public, to the legal system, or to the profession; (2) whether the practitioner acted intentionally, knowingly, or negligently; (3) the amount of the actual or potential injury caused by the practitioner’s misconduct; and (4) the existence of any aggravating or mitigating factors. 37 C.F.R. § 11.54(b); *Schroeder*, PTO Proceeding No. D2014-08, slip op. at 10 (May 18, 2015) (Initial Decision on Default Judgment). The analysis of these factors is interrelated. *Burmeister*, PTO Proceeding No. D1999-10, slip op. at 10 (Mar. 16, 2004) (Initial Decision). The ABA Standards for Imposing Lawyer Sanctions (1992) (“ABA Standards”)<sup>26</sup> provide guidance as to the existence of aggravating or mitigating factors. *Schroeder*, PTO Proceeding No. D2014-08 at 12; *see also Chae*, PTO Proceeding No. D2013-01, slip op. at 4 (Oct. 21, 2013) (Final Order). According to the ABA Standards, aggravating factors are outlined in black letter rules:

(a) prior disciplinary offenses; (b) dishonest or selfish motive; (c) a pattern of misconduct; (d) multiple offenses; (e) bad faith obstruction of the disciplinary proceeding by intentionally failing to comply with rules or orders of the disciplinary agency; (f) submission of false evidence, false statements, or other deceptive practices during the disciplinary process; (g) refusal to acknowledge wrongful nature of conduct; (h) vulnerability of victim; (i) substantial experience in the practice of law; (j) indifference to making restitution; [and] (k) illegal conduct, including that involving the use of controlled substances.

ABA Standards at 17-18, Rule 9.2. Similarly, mitigating factors are also outlined in black letter rules:

(a) absence of a prior disciplinary record; (b) absence of a dishonest or selfish motive; (c) personal or emotional problems; (d) timely good faith effort to make restitution or to rectify consequences of misconduct; (e) full and free disclosure to disciplinary board or cooperative attitude toward proceedings; (f) inexperience in

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<sup>26</sup> The ABA Standards are available on the ABA’s website at: [https://www.americanbar.org/content/dam/aba/administrative/professional\\_responsibility/sanction\\_standards.pdf](https://www.americanbar.org/content/dam/aba/administrative/professional_responsibility/sanction_standards.pdf). The pages of the ABA Standards are not numbered. Consequently, page numbers in this decision that refer to that document cite the page numbers displayed when the document is viewed in a PDF reader.

the practice of law; (g) character or reputation; (h) physical disability; (i) mental disability or chemical dependency including alcoholism or drug abuse . . . (j) delay in disciplinary proceedings; (k) imposition of other penalties or sanctions; (l) remorse; [and] (m) remoteness of prior offenses.

ABA Standards at 18-19, Rule 9.3. According to the ABA Standards, “[t]he ultimate sanction imposed should at least be consistent with the sanction for the most serious instance of misconduct among a number of violations; it might well be and generally should be greater than the sanction for the most serious misconduct.” ABA Standards at 7.

An important function of disciplinary sanctions is to deter others from similar conduct, and general deterrent effects should be considered when analyzing misconduct. *Hill*, PTO Proceeding No. 2001-06, slip op. at 12 (July 26, 2004) (Final Decision). Indeed, “[w]e start from the premise that protection of the public and bar, not punishment, is the primary purpose of attorney discipline and that we must accordingly consider relevant mitigating and aggravating circumstances.” *Burmeister*, PTO Proceeding No. D1999-10, at 11 (quoting *Coombs v. State Bar of California*, 779 P.2d 298, 306 (Cal. 1989)) (quotation marks omitted). “Honesty and integrity are chief among the virtues the public has a right to expect of lawyers. Any breach of that trust is misconduct of the highest order and warrants severe discipline.” *In re Disciplinary Action Against Peter J. Ruffenach*, 486 N.W.2d 387, 391 (Minn. 1992) (citing *In re Holmay*, 464 N.W.2d 723, 725 (Minn. 1991)). “The ultimate issue to be decided in disbarment proceedings is whether the respondent is fit to practice.” *Id.* (citing *Harary v. Blumenthal*, 555 F.2d 1113, 1116 (2d Cir. 1977) (upholding disbarment of certified public accountant from practice before the Internal Revenue Service)). “Attorneys who practice before the PTO have a duty to represent their clients competently and zealously, and to maintain ‘the integrity and competence of the legal profession.’” *Kang*, PTO Proceeding No. D2012-24, slip op. at 8 (Nov. 26, 2012) (Initial Decision on Default) (citing 37 C.F.R. §§ 10.21, 10.76, 10.83); *see also Robinson*, PTO Proceeding No. D2009-48, slip op. at 12 (May 26, 2010) (Initial Decision). The length of time for which a respondent has engaged in misconduct is also a factor when determining the appropriate severity of a penalty. *Hormann*, PTO Proceeding No. D2008-04, slip op. at 21 (July 8, 2009) (Initial Decision).

## **VII. DIRECTOR’S ARGUMENTS ON PENALTY**

Based upon his evaluation of the four penalty factors, the OED Director suggests in his post-hearing briefs that the appropriate penalty for Respondent’s violations is suspension from practice before the USPTO for 18 months. DIB at 17; DRB at 8.

As to the first factor, the OED Director maintains that Respondent’s “wide-ranging misconduct violated duties he owed to his clients, the public, the legal system, and the profession.” DIB at 20. He recounts that, although prohibited from doing so by virtue of his federal employment, Respondent for compensation consulted with and gave advice to clients in contemplation of filing patent or trademark applications or other documents with the PTO; prepared and prosecuted patent and trademark applications before the PTO; and failed to withdraw as attorney of record in patent and trademark matters pending before the PTO, even after being notified that he could not represent others. DIB at 21, 24. By his actions, Respondent misrepresented to his clients, the public, the legal system, and the profession that he was authorized to engage in such representation, a falsity which also impacts negatively on the

public's perception of attorneys and the legal system, the Director proclaims. DIB at 21-25. Referring to the SJ Order, the Director observes that this Tribunal found that such actions constituted "disreputable or gross misconduct;" "conduct involving dishonesty, fraud, deceit, or misrepresentation;" conduct "prejudicial to the administration of justice;" conduct "contrary to applicable Federal conflict of interest laws" or regulations; a failure to withdraw when required by regulation; and the unauthorized practice of law, in violation of various provisions of the Code and Rules. DIB at 21-25.

Under the second factor, the OED Director designates Respondent as having "knowingly" engaged in the misconduct. DIB at 25-26; DRB at 3, 9. The Director asserts Respondent was placed on notice that he was not permitted to represent private clients as a Federal government employee by the 2003 survey, Mr. Kasischke, the RFIs, and the pleadings in this action. DRB at 3-4. In support, the Director cites the SJ Order's conclusion that Respondent acted "knowingly" when, for compensation, as a government employee, he nevertheless consulted with and gave advice to clients in contemplation of filing patent or trademark applications or other documents with the PTO; prepared and prosecuted patent and trademark applications before the PTO; and failed to withdraw as attorney of record in patent and trademark matters pending before the USPTO, even after being notified that he could not represent others. DIB at 25. Additionally, the Director characterizes Respondent as having "stuck his head in the sand" as he personally undertook no research as to whether it would be ethical to engage in a private practice before the PTO while employed by the Federal government and steadfastly refused to seek ethical guidance from others, even when put on notice that he was violating federal ethics law. DIB at 25-26; DRB at 10.

In contradiction to the rationale offered by Respondent for a good faith belief that his dual activities were permitted, the Director proclaims that a "nexus" between Respondent's government work and his private practice work is not required, stating that "[t]he Office of Government Ethics has made clear that even if a Federal government employee's outside employment is not in direct conflict with his or her government employment, '18 U.S.C. § 205 is very broad in that it applies to all employees regardless of level of responsibility or scope of duties, and to all particular matters regardless of whether those matters are related, or even appear to be related, to the employee's position or duties.'" DRB at 4 (citing Informal Advisory Letter 00 x 11 (O.G.E.), 2000 WL 33943404 at \*1 (Oct. 4, 2000) (An activity "conflicts with an employee's official duties" and is prohibited under federal Standards of Conduct "if it is prohibited by statute or by an agency supplemental regulation") and quoting OGE Report to President and to Congressional Committees on the Conflict of Interest Laws Relating to Executive Branch Employment at 7 (Jan. 2006)).<sup>27</sup> Moreover, the Director argues that no attorney has a first amendment right to represent a client before a tribunal or to file an application or advocate on behalf of someone else. DRB at 7 (citing *Board of Ed. of City of New York v. Nyquist*, 590 F.2d 1241, 1245-46 (2nd Cir. 1979); *In re Primus*, 436 U.S. 412, 422 (1978) (an attorney does not have a First Amendment right to conduct any particular representation); *Mezibov v. Allen*, 411 F.3d 712, 720-21 (6th Cir. 2005) ("For these reasons, we hold that in the context of the courtroom proceedings, an attorney retains no personal First Amendment rights

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<sup>27</sup> OGE Report to President and to Congressional Committees on the Conflict of Interest Laws Relating to Executive Branch Employment (January 2006) is accessible at: [https://oge.gov/Web/oge.nsf/0/2992B018CA57C5B985257E96006A91E8/\\$FILE/Report%20to%20the%20President%20and%20Congress%20on%20Ethics.pdf](https://oge.gov/Web/oge.nsf/0/2992B018CA57C5B985257E96006A91E8/$FILE/Report%20to%20the%20President%20and%20Congress%20on%20Ethics.pdf).<sup>28</sup> *Turner* involved a constitutional challenge to a government regulation on speech, specifically the "must-carry" of local broadcast stations by cable systems. *Turner*, 512 U.S. at 622.



when representing his client in those proceedings. Therefore, Mezibov has failed to allege that he was engaged in constitutionally protected conduct as the precipitating factor for his alleged retaliation, and his claim under 42 U.S.C. § 1983 was properly dismissed.”)). Finally, OED declares that by continuing his private practice after being notified he was in violation, Respondent was “not maintaining status quo” but engaging in a “continuing violation(s).” DRB at 6.

Regarding the third penalty factor, the OED Director concedes that while Respondent violated multiple ethical rules, “it does not appear that his patent and trademark clients were actually harmed by those violations.” DIB at 26. However, the Director minimizes the significance of this, advising that lack of harm is neither a defense to a violation nor grounds for not imposing a penalty. DIB at 26-27.

Under the fourth factor, the OED Director argues the following seven aggravating factors apply here: (a) selfish motive (financial gain); (b) a pattern of misconduct; (c) multiple offenses; (d) false statements during the disciplinary process; (e) refusal to acknowledge wrongful nature of conduct; (f) substantial experience in the practice of law; and (g) illegal conduct. DIB at 29-39; DRB at 11-16. The OED Director also acknowledges the applicability of the mitigating factor of Respondent not having been previously subjected to discipline. DIB at 39. However, he argues that that mitigating factor should be given little weight in that “Respondent has not be[en] disciplined only because he concealed his misconduct for many years. The fact he ‘got away with it’ does not constitute a mitigating factor.” DIB at 39.

## **VIII. RESPONDENT’S ARGUMENTS ON PENALTY**

Respondent’s position is that his violations do not warrant any suspension. RIB at 13. In support, he challenges the Director’s evaluation of each of the four penalty factors.

First, as to OED’s claim that he violated duties owed to the public, the legal system, and the legal profession, Respondent argues that the “OED fails to identify just how the Respondent’s representational activities, while acting as a private citizen before the USPTO, could undermine the public’s confidence in subsequent patent or trademark registrations” or “how any action by the Respondent decreases the public’s confidence in the integrity of the profession of patent practitioners.” “More is needed,” Respondent posits. RIB at 7-8 and RRB at 17 (citing *Turner Broad. Sys., Inc. v. FCC*, 512 U.S. 622 (1994) (“The Government must demonstrate that the recited harms are real, not merely conjectural, and that the regulation will in fact alleviate these harms in a direct and material way.”)).<sup>28</sup>

As to whether he acted intentionally, knowingly, or negligently, Respondent proclaims that at the time he checked the “YES” box on the 2003 survey warning of the prohibition on private practice while a government employee, he had a “good faith reason to believe he was in compliance with the statutes and also had, albeit informal, approval to operate a law practice that was not then in conflict with the Respondent’s official duties as a government engineer.” RIB at 8; RRB at 17-18 (citing Tr. 23). In support of his good faith, he cites his belief that the

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<sup>28</sup> *Turner* involved a constitutional challenge to a government regulation on speech, specifically the “must-carry” of local broadcast stations by cable systems. *Turner*, 512 U.S. at 622.

exceptions to the statutory prohibition applied to him and/or that the prohibition as applied to him by OED violated the First Amendment. RIB at 3; RRB at 12-13. Furthermore, he advises that “the Manual of Patent Examining Procedure (MPEP) and the Trademark Manual of Examining Procedure (TMEP) are the controlling documents for USPTO examiners” and that “[n]owhere in either of these documents is there any mention that the identity of the applicant or the applicant’s representative is a factor in either allowing or not allowing an application.” RIB 8-9; RRB at 18 (citing Tr. 56). As further evidence of his good faith, he cites the promise he made to OED that if his interpretation of the statute was determined to be erroneous, he would begin immediate separation from the government. RIB at 3; RRB at 13. “At no time before the initiation of the present complaint did the OED ever disagree with [his] arguments” as to the inapplicability of the statutory prohibition, Respondent declares. RIB at 3; RRB at 13. Moreover, he avows that his “first inclination” that the issue would be decided against him was the August 16, 2018 order on his motion to dismiss. RIB at 3; RRB at 13. Therefore, on September 4, 2018, “after travel and holidays,” he initiated early retirement from the government, advising his supervisors that he was retiring “due to external factors” and “because of these proceedings.” RIB at 3-4; RRB at 13.

Next, Respondent states he agrees with the OED that his misconduct caused no actual or potential injury. He reiterates his claim that the OED has failed to show how “Respondent’s USPTO representational activity, not associated with his official Navy Department duties, would undermine the public’s confidence in the USPTO’s neutrality” and contends that despite alleging in “inflammatory language” that he represented hundreds of private clients and prosecuted hundreds of applications, “the OED is unable to point to one instance as an actual or potential conflict of interest.” RIB at 9; RRB at 18.

As to factors in aggravation, Respondent offers challenges to most of those identified by the Agency. RIB at 10-12. First, he decries the characterization of the fact that he was paid for his services as evidencing a “selfish motive,” declaring that a “[s]elfish motive is defined as ‘devoted to or caring only for oneself; concerned primarily with one’s own interests, benefits, welfare, etc., regardless of others.’” RIB at 10; RRB at 19. Here, he explains, he was merely compensated for services rendered, extolling that “assisting inventors to prepare and file patent and trademark applications to protect their intellectual property is anything but selfish” and that “[b]y the OED’s interpretation, every single parent working a second job is dishonest and selfish.” RIB at 10; RRB at 19-20.

Second, as to his engaging in a pattern of misconduct and multiple offenses, he points out that in the 2003 OED survey he identified himself as both a “privately practicing patent attorney and a government employee,” explaining he “had no reason to believe at that time that the OED would not have alerted the Respondent if there was an issue.” RIB at 10; RRB at 20. He further justifies his continuing to practice before the USPTO during the pendency of this case as merely an effort to preserve the “status quo” until his “Constitutional counter claims” were “fully adjudicated.” RIB at 10-11, RRB at 20. Respondent predicts that “were [he] to withdraw from patent and trademark practice without some judicial adjudication of the issues presented to the OED then the OED complainant could, and most likely would, interpret such withdrawal as admission that the OED complainant position is valid.” RIB at 11; RRB at 20. He also advises that in response to RFIs, “he provided a Memorandum of Law outlining at least two presumptively valid defensive positions which were not questioned or otherwise contradicted by the OED complainant’s [RFIs].” RIB at 11 (citing JX 9, 11, 16); RRB at 20. Additionally, he

notes that he had also offered to withdraw from government service and received no response from the OED. RIB at 11; RRB at 20.

Third, as to his “refusal to acknowledge the wrongful nature of his conduct,” Respondent proclaims that he “does not yet know for certain that his conduct is wrongful, and won’t really know until the First Amendment issues raised by the Respondent are fully adjudicated in Federal Court.” RIB at 11; RRB at 20. Nevertheless, “in the interim,” he has “separated from government service based upon this Tribunal’s initial interpretation of his defenses,” Respondent adds. RIB at 11; RRB at 20-21. Further, he challenges the Director’s reliance on *Bar v. Germain*, 957 So. 2d 613 (Fla. 2007), stating that the attorney in that case was not relying upon a statute with “exclusion paragraphs” and First Amendment issues. RRB at 21. *See also* DRB at 13-14.

Fourth, Respondent characterizes OED’s designation of his 18 years of experience practicing law as an aggravating factor, as “duplicitousness.” RIB at 11; RRB at 21. “On one hand the OED is claiming pattern of misconduct and multiple offenses spread over years, but then says those same years give rise to sage experience that should have informed the Respondent of his misconduct,” he laments. RIB at 11; RRB at 21. Further, he forcefully challenges OED’s claim that he “concealed his misconduct for many years,” stating “[n]owhere in the record is there any evidence of concealment. In fact, far from it. Advertising in the local airport, online, yellow pages, and flyers, is clearly not the actions of someone trying to conceal their alleged misconduct.” RIB at 12; RRB at 21.

In mitigation, Respondent identifies numerous factors in addition to the absence of a prior disciplinary record. RIB at 12; RRB at 21. Specifically, he states he “cooperated fully during the yearlong OED investigation, responded fully to all RFIs, is in good standing with the Massachusetts Bar, [initiated] self-imposed separation from government service at significant financial loss . . . , [I] has 30 years of government service, in uniform and out, and that at 63 years old an 18-month suspension is effectively an end to the Respondent’s solo patent practice.” RIB at 12; RRB at 22. Moreover, he advises that “as a result of the OED’s collusion with NUWC,” he would be unlikely to obtain a security clearance “which effectively blocks any meaningful government or government contractor employment near the Respondent’s residence.” RIB at 12; RRB at 22. In addition, Respondent suggests that NUWC was “well aware that [he] was practicing before the USPTO” since 2004. RIB at 12; RRB at 22 (citing Tr. 27). “Yet, although obligated by 37 CFR 11.803 to report any suspected misconduct to the OED, the government waited until 2016 to report suspected misconduct. These proceedings could have been avoided or the penalty much less harsh than an 18-month suspension at age 63 if the government had done its duty.” RIB at 12-13; RRB at 22.

In his Post-Hearing Brief, Respondent raises numerous issues regarding his opponent’s integrity, proclaiming first that the Director’s assertion that he made an “intentional misrepresentation” about the reason for his retirement “is contemptable and should be sanctioned.” RIB at 4; RRB at 14. “[T]he OED’s fixation with this allegation is nothing more than a boldfaced attempt to deflect the Tribunal’s attention from the OED’s false and misleading statements,” he decries. RIB at 4; RRB at 14.

“Most notable amongst the OED’s false and misleading statements,” Respondent continues, “is the OED’s failure to inform this Tribunal that [it] colluded with the Respondent’s



former government employer, the Naval Undersea Warfare Center (NUWC), to initiate a corresponding Department of Defense investigation on March 20, 2018, five months before the Respondent separated from government service.” RIB at 4; RRB at 14. Specifically, Respondent alleges, OED provided NUWC with data “only available to the USPTO in apparent violation of the violated the Computer Matching and Privacy Protection Act of 1988 (CMPAA), Pub. L. No. 100-503, 102 Stat. 2507.” RIB at 4-5; RRB at 14. He alleges that the resulting interim report dated April 18, 2019, “is replete with out of context allegations and inaccuracies,” but nonetheless, recommends it be “used negatively in consideration of any future application for a security clearance.” RIB at 5; RRB at 14. Moreover, “the OED has also failed to inform this Tribunal that the OED remains in collusion with NUWC for NUWC to ‘monitor’ the outcome of these proceedings and reporting the outcome to the Respondent’s state bar if the USPTO ultimately determines, for any reason, not to do so,” Respondent alleges. RIB at 5; RRB at 14. Additionally, he avers that the OED has “also attempted to “fluff” up their case and mislead this Tribunal by introducing patent and trademark applications submitted by the Respondent **after** he retired.” RIB at 5; RRB at 15 (citing Tr. 36-37).

Respondent further proclaims that the Director “exhibits bad faith, abuse of position, and contempt for the Tribunal’s judgment in practical matters with its grossly simplified estimates of Respondent’s earnings over 15 years.” RIB at 5; RRB at 15 (citing DIB at 35). He suggests OED’s calculations “grossly” over-inflate his earnings by failing to account for fees “credited forward” and “the expenses of operating a part time business (insurance, leases, taxes, advertising, travel, office expenses, etc[.]),” which did not result in positive earnings for several years. RIB at 5; RRB at 15. Respondent alleges his tax returns reflect his total net income from his private practice, from 2006-2018, amounts to less than \$34,000, stating that this sum is “[h]ardly indicative of massive greed.” RIB at 5; RRB at 15.

Finally, Respondent argues that the limited caselaw available does not support the imposition of an 18-month suspension and is distinguishable from the present case on the basis that “at no time has there been any matter overlap, potential matter overlap, or matter connection, or other nexus between the Respondent’s government position as an engineer for the Navy and the Respondent’s private work as a patent attorney; nor is there any matter connection between the Respondent’s Navy position as an engineer and the USPTO.” RRB at 16; RIB at 6-7 (citing, *inter alia*, *Moatz v. Kersey*, 67 U.S.P.Q.2d 1291, 2002 WL 32056608 (T.T.A.B. 2002)).

## **IX. DISCUSSION, FINDINGS, AND CONCLUSIONS**

After considering the parties’ arguments, this Tribunal concludes that a 60-month suspension is the appropriate penalty to be imposed in this case. The reasons for this penalty are as follows:

Respondent violated duties he owed to his clients, the public, the legal system, and the profession. Lawyers violate the duties owed to clients by failing to show them loyalty, diligence, competence and candor; violate duties owed to the general public by failing to exhibit the “highest standards of honesty and integrity;” violate duties owed to the legal system by operating illegally or improperly as officers of the court; and violate duties owed to the profession by unauthorized practice and failing to maintain the integrity of the profession. ABA Standards at 5-6. The evidence adduced in this case shows that Respondent failed to act with candor towards his clients, failed to exhibit the highest standards of honesty and integrity, operated improperly as

an officer of the court,<sup>29</sup> and engaged in unauthorized practice, thereby diminishing public confidence in the profession and bringing it into disrepute. Specifically, he held himself out to his private clients, the public, and the USPTO as authorized to file patent applications on behalf of private citizens, and he filed such applications despite not being authorized to do so by virtue of the Conflict of Interest Statutes and USPTO Code and Rules. As such, he violated the duties he owed to his clients, the public, the legal system, and the profession. *Quod erat demonstrandum*. See *Ruffenach*, 486 N.W. 2d at 391 (“Honesty and integrity are chief among the virtues the public has a right to expect of lawyers. Any breach of that trust is misconduct of the highest order and warrants severe discipline.”); *In re Lawrence*, 884 So. 2d 561 (La. 2004) (attorney’s false representation violated rule regardless of intent or motive); *State ex rel. Special Counsel v. Shapiro*, 665 N.W.2d 615 (Neb. 2003) (misrepresentation does not require proof of intent to deceive or defraud); *Disciplinary Counsel v. McCord*, 905 N.E.2d 1182 (Ohio 2009) (lawyer’s misleading violated rules even if he did not intend to deceive public); *In re Dann*, 960 P.2d 416 (Wash. 1998) (motive is irrelevant in determining violation; “the question is whether the attorney lied”); *Jaeger*, PTO Proceeding No. D2012-29, slip op. at 13 (Feb. 6, 2013) (Initial Decision) (“Attorneys who practice before the PTO are expected to ‘assist in maintaining the integrity and competence of the legal profession’ and aid in the prevention of the unauthorized practice of law.”); *State Bar of Okl. v. Retail Credit Ass’n*, 37 P.2d 954, 957 (Ok. 1934) (unauthorized practice threatens public confidence and “strongly tends to discredit and bring into disrepute . . . the practice of law and the administration of justice”). In so finding, I reject Respondent’s proposition that the evidence does not establish that he violated duties owed to his clients, the public, the legal system, and the profession because the Agency offered no direct proof that he “undermine[d] the public’s confidence in subsequent patent or trademark registrations” or “decrease[d] the public’s confidence in the integrity of the profession of patent practitioners.” RIB at 7, 8; RRB at 12; *Moatz v. Kersey*, 67 U.S.P.Q.2d 1291 (T.T.A.B. 2002) (holding that “[v]iolations of Federal conflict of interest rules covering all Federal employees . . . negatively impact[s] the integrity of the legal profession” and that direct proof of negative impact is unnecessary).

In addition, I find no merit to Respondent’s defensive claim that he violated no owed duties because he was merely a “private citizen” at the time he submitted the violative filings to the USPTO. RIB at 7. A “private citizen” is defined as “one whose duties are not related to or dependent on one’s official position.” *State v. Laughlin*, 10 Ohio Misc. 219, 223 (Com. Pl. 1966) (holding that because “a prosecuting attorney is charged by law with the performance of certain duties before a Magistrate and in County Courts, he could not be considered a private citizen in regard to any of such duties.”). While it is true that Respondent did not represent the federal government in prosecuting the applications before the USPTO on behalf of private clients, he was registered as a patent attorney before the USPTO, and as such, held a position making him subject to the USPTO Code and Rules. Thus, the remedy for his professional violations fall within the purview of this public disciplinary proceeding, not simply in a private proceeding between citizens. *Renfro v. Jones & Assocs.*, 947 S.W.2d 285, 287 (Tex. App. 1997) (If an attorney’s conduct violates his professional responsibility, the remedy is public, not private); *Matter of Cushing*, 646 N.E.2d 662, 664 (Ind. 1995) (attempted unauthorized practice in jurisdiction violates duty of diligence owed to client).

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<sup>29</sup> As a licensed attorney, registered to practice before the USPTO, Respondent was analogous to an “officer of the court” in a federal or state jurisdiction. *People v. Bode*, 119 P.3d 1098, 1100 (Colo. O.P.D.J. 2005) (for disciplinary purposes, “a federal agency such as the PTO can be considered a ‘jurisdiction’”).

Respondent's violative conduct was intentionally undertaken.<sup>30</sup> Acting "intentionally" occurs "when the lawyer acts with the conscious objective or purpose to accomplish a particular result." ABA Standards at 6. This mental state is to be contrasted with acting "knowingly," which occurs when a lawyer "acts with conscious awareness of the nature or attendant circumstances" of the conduct but "without the conscious objective or purpose to accomplish a particular result," or acting "negligently," which is "when a lawyer fails to be aware of a substantial risk that circumstances exist or that a result will follow, which failure is a deviation from the standard of care that a reasonable lawyer would exercise in the situation." ABA Standards at 6. The Director has characterized Respondent's conduct as knowing, rather than negligent, based largely upon the fact that Respondent was placed on notice that he was not permitted to represent private clients as a federal government employee by the 2003 Survey, Mr. Kasischke, the RFIs, and the pleadings in this action. DRB at 3 (citing JX 3 at 1; JX 21 at 16-17, 22, 29-30). Further, the Director implicitly characterizes Respondent's conduct as knowing rather than intentional by accepting that in response to such notice, Respondent "stuck his head in the sand" and undertook no research himself nor sought guidance from others as to whether it would be ethical for him to engage in private practice before the USPTO while employed by the federal government. DIB at 25-26; DRB at 3-4.

In this proceeding, Respondent suggests his conduct was undertaken innocently, or at most negligently, claiming that "until this proceeding started," "it never occurred to me that it would be a conflict" to continue his private law practice while a federal government employee, explaining that in his mind "at no time did I have a conflict of interest, real or apparent. It was just two separate jobs, and that's it." Tr. 48, 55, 57; DIB Stip. 8. He further suggests that after the OED investigation and/or this litigation began, he was still acting in good faith when he continued his private practice because he believed his conduct was protected by the First Amendment.

I cannot credit Respondent's arguments. First, as the Director observes, the various events, including completion of the 2003 Survey and Mr. Kasischke's warning, seen in the best light possible, should have, at the very least, raised red flags and been inflection points causing Respondent to inquire into the propriety of his actions. Had Respondent, an attorney, undertaken even the most cursory research of the issue by, for example, reviewing 18 U.S.C.A. § 203, he would have found under annotations thereto reference to the 1949 Attorney General Opinion holding that participation in patent proceedings by government employees for compensation on behalf of private parties is prohibited. 18 U.S.C.A. § 203 (Notes of Decisions §17 (citing 1949, 41 Op. Atty. Gen., July 18)). Alternatively, Respondent could have utilized the free ethics counseling available to him as a government employee and USPTO practitioner and received professional and reliable guidance as to the restrictions imposed upon him.

Second, the footings of Respondent's First Amendment argument appear to be mostly girded by his own unique interpretation of the amendment or broad sweeping statements of its import, rather than narrowly drawn potentially binding legal precedent as would be consistent with his legal training and technical acumen. RRB at 4-12. Respondent faces discipline not for

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<sup>30</sup> At times prior to this point in the proceeding, Respondent's mental culpability has been described as "knowing." See, e.g., SJ Order at 12. But having received the benefit of additional evidence at hearing, I find it appropriate for purposes of sanction determination to characterize and treat his actions as "intentional."

engaging in protected expression or association, but because he has run afoul of the USPTO's regulations for practicing law before it by not abiding by its rules of ethics. The USPTO has a compelling interest in regulating the attorneys who appear before it, and "[a]ny abridgment of the right to free speech is merely the incidental effect of observing an otherwise legitimate regulation." *Lawline v. American Bar Ass'n*, 956 F.2d 1378, 1386 (7th Cir. 1992). *See also Ohralik v. Ohio State Bar Ass'n*, 436 U.S. 447, 459, 467-68 (1978) (Professional regulation is not invalid, nor is it subject to first amendment strict scrutiny, merely because it restricts some kinds of speech.); *In re Smith*, 123 F. Supp. 2d 351, 359 (N.D. Tex. 2000) (rejecting attorney's First Amendment argument and holding that Tenth Circuit's "interest in maintaining the integrity of the judicial process" by disciplining its attorneys "outweighs any supposed infringement of First Amendment rights"); *Harris v. Quinn*, 134 S. Ct. 2618 (2014) (public employee speech is unprotected if it is not on a matter of public concern); *Fort Wayne Patrolmen's Ben. Ass'n, Inc. v. City of Fort Wayne*, 625 F. Supp. 722, 728 (N.D. Ind. 1986) (First Amendment right to associate with outside employers in the context of part-time employment is not designed to protect employer-employee relationships); *NAACP v. Alabama*, 357 U.S. 449 (1958) (protected freedom of association involves association for the purpose of expression and belief); *Wolfe v. Barnhart*, 354 F. Supp. 2d 1226, 1243-44 (N.D. Okla. 2004), *aff'd*, 446 F.3d 1096 (10th Cir. 2006) (Agency ethics regulation prohibiting Administrative Law Judge from receiving compensation for writing book related to official duties did not impose an impermissible restriction on First Amendment rights); *Deretich v. Office of Admin. Hearings, State of Minn.*, 798 F.2d 1147, 1152 (8th Cir. 1986) (upholding ethics prohibition on state employees acting as an attorney in any matter pending before the employing agency as not violative of associational freedom); *Decker v. City of Hampton, Va.*, 741 F. Supp. 1223 (E.D. Va. 1990) (upholding city restriction on police officers' off-duty work as rationally related to state's legitimate interests in avoiding conflicts of interest and ensuring that off-duty employment activities of police officers did not bring police department into disrepute); *Gosney v. Sonora Indep. Sch. Dist.*, 603 F.2d 522, 525-26 (5th Cir. 1979) (upholding as constitutional school district policy proscribing all "outside employment" as rationally related to the legitimate state interest in assuring that public school employees devote their professional energies to the education of children) (*citing Williamson v. Lee Optical of Oklahoma*, 348 U.S. 483, 487-88 (1955)); *Matal v. Tam*, 137 S. Ct. 1744 (2017) (owner of trademark holds the first amendment right of free speech, not the attorney who assists the applicant in filing a trademark application; an attorney has no first amendment right to represent a client before a tribunal or to file an application or advocate on behalf of someone else); *In re Primus*, 436 U.S. 412, 422 (1978) (an attorney does not have a First Amendment right to conduct any particular representation); *Mezibov v. Allen*, 411 F.3d 712, 720-21 (6th Cir. 2005) (an attorney has no personal First Amendment rights to represent client in proceedings); *Kersey v. Undersecretary of Commerce for Intellectual Prop.*, No. CIV.A. 02-2331 (GK), 2005 WL 486144, at \*2 (D.D.C. Jan. 31, 2005), *aff'd sub nom. Kersey v. Under Sec'y of Commerce for Intellectual Prop.*, 221 F. App'x 997 (Fed. Cir. 2007) (USPTO Practitioner sanctioned for engaging in private practice while a government employee).

In light of the clearly accessible Attorney General's Opinion and OGE letters interpreting the Conflict of Interest Statutes in a manner unfavorable to Respondent, and given the substantial caselaw undermining Respondent's First Amendment defense, it is apparent that he either willfully blinded himself to the import thereof on his conduct or he knew that they applied to him and consciously ignored them to pursue his private practice. After considering Respondent's testimony at hearing in conjunction with the positions he has taken throughout this proceeding, I



simply do not find credible his claim to genuinely believe that his actions were in accordance with the law.

Moreover, I give no import to Respondent's argument alleging that neither the Manual of Patent Examining Procedure (MPEP) or the Trademark Manual of Examining Procedure (TMPEP) mentions that the identity of the applicant or the applicant's representative is a factor in either allowing or not allowing an application. RIB at 8-9 (citing Tr. 56). Respondent did not offer either of those documents at hearing, nor request this Tribunal take administrative notice of them, and thus no inference can rightfully be drawn here from them. I am also unpersuaded by Respondent's claim that his lack of notice and good faith is proven by his engagement in public advertising. Many people who are engaging in improper conduct do so openly, with the expectation that the impropriety lying discretely beneath the public acts will not be recognized and/or reported to those in authority to act.

I also reject the Director's characterization of Respondent's conduct as merely undertaken "knowingly." As indicated above, acting "knowingly" would require a finding that Respondent acted "without the conscious objective or purpose to accomplish a particular result." The record here does not support such a conclusion. In this case, Respondent was explicitly warned in 2003 by the USPTO Survey, and then a year or two later by Mr. Kasischke, that he was prohibited from filing applications before the USPTO on behalf of private clients while a government employee. JX 3 at 1; JX 21 at 16-19. If Respondent truly believed that the USPTO and/or Mr. Kasischke warnings were in error, he could have challenged the warnings and sought clarification from ethics officials in his own agency, the USPTO, or even OGE, as the employee in the OGE Letter had done. Instead, he ignored the USPTO warning, and then lied to Mr. Kasischke, telling him he had not filed such applications in the past when, in fact, he had, and then proceeded unabated to file applications over the next decade. JX 21 at 19; JX 14; JX 19, 20. Moreover, when Respondent's employee status required him to file an OGE 450 form and mandated that he obtain OGC approval for his outside activities, regardless of whether he thought them prohibited or conflicting with his government position, he did not. To me, this evidences a clear consciousness of guilt. Respondent even continued filing applications after the USPTO started an investigation and again warned him four times in writing that such filings were prohibited. JX 19, 20. And he kept filing after the Complaint was issued and while this Tribunal was rejecting his arguments in defense. Stips. 15-18. All of this is clearly indicative that he acted "with the conscious objective or purpose to accomplish a particular result." Therefore, I find for the purposes of determining the penalty in this case that Respondent acted "intentionally."<sup>31</sup>

Respondent's misconduct caused injury. The parties appear to agree that Respondent's conduct caused no injury, and there is no evidence that any of the applications he drafted and filed with

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<sup>31</sup> Although I find Respondent's conduct to be intentional, I exercise my discretion and reject the Director's suggestion that the factor of "illegal conduct" should be considered in aggravation here. The Respondent advises in his post-hearing brief that presently DOD/NUWC is conducting a "corresponding" investigation into the propriety of his conduct that will likely directly address whether he violated 18 U.S.C. §§ 203 and 205 and whether a referral to the Department of Justice is appropriate. RIB at 4. As such, it is inappropriate for this Tribunal to make a finding as to whether Respondent's conduct rises to the level of criminality on the limited record here while that issue is being investigated and determined by another Agency.

the USPTO were substandard, that any client claimed to be aggrieved by his services, or that there was a specific conflict of interest between the subject matter of a private client and that of the government. RIB at 9. Nevertheless, Respondent admitted at hearing that he never informed any of his private clients that he was a federal government employee, which suggests to me that he deprived them of the opportunity to determine for themselves whether he was prohibited from representing them and charging them for his legal services. Tr. 54; DIB Stip. 54. I find this omission injurious to Respondent's clients as they are entitled to have their interests placed above that of their attorney, with whom they have a fiduciary relationship –

The attorney-client relationship constitutes a fiduciary relationship as a matter of law. As fiduciaries, attorneys owe to their clients “the basic obligations of agency: loyalty and obedience.” When, in the course of his professional dealings with a client, an attorney places personal interests above the interests of the client, the attorney is in breach of his fiduciary duty by reason of the conflict, and this is because, in that scenario, the attorney, as an agent of the client, has violated his/her duty “to act solely for the benefit of the principal in all matters connected with his agency.”

*In re Carr*, 584 B.R. 268, 279 (Bankr. N.D. Ill. 2018) (citations omitted) (*quoting In re Winthrop*, 848 N.E.2d 961 (Ill. 2006)); *see also Horwitz v. Holabird & Root*, 816 N.E.2d 272, 277 (Ill. 2004); RESTATEMENT (SECOND) OF AGENCY § 14N cmt. a, at 80, § 387 (1958); *Doe v. Roe*, 681 N.E.2d 640, 645 (Ill. 1997). Moreover, more tangibly, Respondent's clients arguably wrongly paid him for legal services for which they should not have had to pay, as he was not authorized to provide such services, causing them to suffer financial injury. *Vista Designs, Inc. v. Silverman*, 774 So. 2d 884, 888 (Fla. Dist. Ct. App. 2001) (patent attorney not entitled to fees for services provided in state where he was unlicensed and not involving practice before the USPTO); *Morrison v. West*, 30 So. 3d 561 (Fla. Dist. Ct. App. 2010) (Attorney not licensed to practice law in jurisdiction was not entitled to collect his fee as it violated public policy for a court to award a fee for the unlicensed practice of law); *Bedell v. Marshall*, 508 So.2d 574 (Fla. 4th DCA 1987) (unlicensed real estate agent contract is void and fees may not be collected). Respondent's violative acts also potentially created bases for infringers to challenge the validity of the intellectual property protection his clients obtained by virtue of the applications he filed on their behalf. *See Torrey v. Leesburg Reg'l Med. Ctr.*, 769 So.2d 1040, 1043 (Fla. 2000) (holding pleadings filed by a non-lawyer on behalf of another are a nullity as a product of the policy against the unauthorized practice of law); *Abbott Labs. v. Andrx Pharm., Inc.*, 241 F.R.D. 480, 487 (N.D. Ill. 2007) (inequitable conduct is a defense that may render a patent unenforceable where a patent applicant intentionally breached its “duty of candor and good faith” to the PTO). In addition, Respondent's violative conduct likely caused actual economic injury to other competing registered patent practitioners who were lawfully entitled to provide the same services and charge and collect fees therefor.

#### Applicable Aggravating Factors

I find that there are six aggravating factors to be taken into account in determining the appropriate penalty in this case: (1) a selfish motive (financial gain); (2) a pattern of misconduct; (3) multiple offenses; (4) refusal to acknowledge wrongful nature of conduct; (5) substantial experience in the practice of law; and (6) false statements during the disciplinary process.

*Selfish Motive.* There is no dispute that Respondent charged and received financial compensation from private clients for filing and prosecuting hundreds of applications on their behalf before the USPTO. Tr. 39; DIB Stip. 47. Based upon USPTO records reflecting only the numbers and types of applications filed by Respondent for others and Respondent's testimony at hearing as to the fees he routinely charged for preparing such applications, the Director conservatively calculated that Respondent's gross income resulting from the provision of such services between January 17, 2008, when the statute of limitations began to run, and October 25, 2017, when the Director's investigation ended, as being approximately \$550,000.<sup>32</sup> DIB at 29-32. In retort, Respondent declares in his initial brief that a selfish motive is defined as "devoted to or caring only for oneself; concerned primarily with one's own interests, benefits, welfare, etc., regardless of others." RIB at 10. He insists that he was merely being compensated for services rendered for helping inventors to file applications and that such acts are "anything but selfish." RIB at 10. Moreover, he argues that OED's calculations are erroneous, alleging that he incurred numerous expenses in connection with his part-time business, that his tax records reflect that he suffered net losses in numerous years between 2006 and 2018, and that cumulatively he netted only \$33,000 in taxable income from the business over the 12 years.<sup>33</sup> RIB at 5. He characterizes this amount as "[h]ardly indicative of massive greed." RIB at 5.

Regardless of the actual amount, gross or net, Respondent earned from his private practice, there is no evidence supporting a claim that he was engaged in such business as a philanthropic or pro bono endeavor. To the contrary, Respondent's part-time business activities were clearly a for-profit business, and he was the profiteer. As the Director notes in his reply brief, "[m]ultiple courts have found that respondents had a selfish motive in cases involving lawyers who acted with motivation to secure a financial advantage." DIB at 29 (citing, *inter alia*, *People v. Calvert*, 280 P.3d 1269 (Colo. O.P.D.J. 2011); *Office of Disciplinary Counsel v. Au*, 113 P.3d 203 (Haw. 2005)). I find that Respondent had such a selfish motive for his violative conduct here.

*Pattern of Misconduct.* Again, it is undisputed that over the course of more than a decade, despite multiple intermittent warnings, Respondent filed hundreds of applications for private clients with the USPTO. JX 19, 20; Stips. 13, 14. He even continued such activities after being told by OED he was under investigation for his conduct and after the Complaint was filed in this case. Stips. 15-18; DX 32-35. Respondent attempts to militate against a finding of a pattern of misconduct by suggesting that because he honestly completed the 2003 Survey in

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<sup>32</sup> For this period, which represents less than the full time period at issue in this case, the Director more specifically calculated that Respondent earned from his private practice between \$553,700 and \$655,900. DIB at 39. OED further indicated that these gross income figures did not take into account the following: (1) any services, such as patent searches, Respondent undertook for clients but which did otherwise result in an application being filed by Respondent on the client's behalf; (2) hourly fees charged by Respondent for "follow-on" services; or (3) services provided by Respondent after the OED investigation ended but before his federal retirement occurred approximately one year later. DIB at 29-32; Tr. 57.

<sup>33</sup> As the Director notes in his Reply Brief, Respondent neither offered any tax records into evidence at hearing, nor testified to any business expenses. DRB at 12-13. Moreover, OED observes Respondent withheld from the Director information on his business expenses before the hearing by responding to an inquiry for tax returns in the July 17, 2017 RFI with tax transcripts for only 2013, 2014, 2015, and 2016, with "all financial figures redacted." DRB at 12; JX 12 at 5-24. As such, it is inappropriate, if not impossible, for this Tribunal to give any weight to Respondent's claim as to his net income from his private practice.

which he disclosed he was a federal employee *and* identified his personal business by name and address, he was justified in continuing his activities and relying upon a lack of an alert from the Agency. RIB at 10. However, he fails to delineate how the Agency would be on notice that he was practicing patent law merely from the Survey form, as his business name and address alone, “Correll and Associates LLP,” does not reveal that Respondent could not have been engaged in some other type of part-time business. Furthermore, he also does not cite any authority for the proposition that completing the Survey triggered an obligation on the part of the USPTO to search out and notify practitioners of potential violations. To the extent OED had any duty to warn federal employee practitioners of the of the private practice prohibition, the language of the Survey from question 6 certainly fulfilled that obligation.

I am also not persuaded by Respondent’s argument that he continued to engage in private practice during the pendency of this case merely to preserve the “status quo” until his “Constitutional counter claims” were “fully adjudicated,” as authorized by *Freedman v. Maryland*, 380 U.S. 51 (1965). RIB at 10-11. *Freedman* involved an advance restraint on speech, specifically a state statute requiring submission of a film for review prior to exhibition. 380 U.S. at 51. The Supreme Court held in that case that “[a]ny restraint imposed in advance of a final judicial determination on the merits must similarly be limited to preservation of the status quo for the shortest fixed period compatible with sound judicial resolution” and “the procedure must also assure a prompt final judicial decision, to minimize the deterrent effect of an interim and possibly erroneous denial of a license.” 380 U.S. at 57. Thus, the case held the status quo *prohibiting* the prior restraint on the First Amendment right to free speech was lawfully permitted, not that on-going “speech,” the presentation of the film, could continue through final adjudication of its propriety. As such, *Freedman* does not support Respondent continuing to engage in conduct he claims as protected speech until this case is adjudicated in federal court. Rather, he maintained the status quo of filing applications during the pendency of this case in violation of the USPTO Rules at his own risk.

Moreover, equally hollow is Respondent’s plaintive assertion that “were [he] to withdraw from patent and trademark practice without some judicial adjudication of the issues presented to the OED then the OED complainant could, and most likely would, interpret such withdrawal as admission that the OED complainant position is valid.” RIB at 11. Parties engaged in legal disputes routinely undertake an action with the express caveat that it is being done without an admission of wrongdoing. *See e.g. Wright v. Williams-Sonoma Stores, Inc.*, 2010 WL 8032665 (CA Sup Ct 2010) (parties agreed that neither agreement nor action “may be construed as or may be used as, an admission . . . as to the merits or lack thereof of the claims asserted. . .”). A version of this principle is even enshrined in the Federal Rules of Evidence, which limits the admissibility of evidence that a party has taken steps to correct an identified harm. *See Fed. R. Evid.* 407. But here, Respondent has not shown that he offered to cease filing applications during the litigation of this case with the caveat that he was not admitting wrongdoing and that the OED rejected his offer. Therefore, his claim that he had to continue his misconduct to avoid a legal admission is unsubstantiated.

Based upon all the foregoing, I find the evidence demonstrates repeated instances of similar misconduct, evidencing the aggravating factor of “a pattern of misconduct.” ABA Standards at 17 (§ 9.22(c)); *In re Guttlein*, 378 F. App’x 24, 36 (2d Cir. 2010) (failing to comply with scheduling orders for 3-4 years evidences “pattern of misconduct”); *In re Kestenband*, 366 F. App’x 305, 319 (2d Cir. 2010) (failing to meet deadlines or failing to apply for an extension



before the deadlines have passed is an aggravating circumstance under ABA Standard § 9.22(c)); *People v. Larsen*, 808 P.2d 1265, 1268 (Colo. 1991) (prosecutor failing to report spouse and a friend for drug possession is a “pattern of misconduct”); *In re Gines*, 869 So. 2d 778, 782-83 (La. 2004) (lawyer’s neglect of various client matters demonstrates aggravating factor of pattern of misconduct).

*Multiple offenses.* The record clearly evidences that Respondent’s actions constituted “multiple offenses,” both in terms of the number of different USPTO Code and Rule provisions violated (nine) as well as repeated violations of the same provisions through the number of applications filed with the USPTO in the more than 10 years prior to the Complaint being filed. As such, Respondent’s commission of multiple offenses can be considered an aggravating factor in determining the penalty. *See Ala. State Bar v. Hallett*, 26 So.3d 1127 (Ala. 2009) (lawyer’s multiple violations of professional misconduct rules supported finding of multiple offenses as aggravating factor under ABA standards). Nevertheless, this Tribunal observes that all the violations essentially arise from the same unlawful activity, Respondent’s private practice of law before the USPTO while a government employee. As such, the aggravation impact of this factor is minimal.

*Refusal to Acknowledge Wrongful Nature of Conduct.* Regretfully, throughout this proceeding, Respondent has emphatically refused to acknowledge any wrongdoing. Even after the SJ Order found him liable for most of the alleged violations, Respondent’s position remains that he “does not yet know for certain that his conduct is wrongful, and won’t really know until the First Amendment issues raised by the Respondent are fully adjudicated in Federal Court.” RIB at 11. Respondent’s refusal to accept the error of his ways despite the warnings received, the long-standing and extensive legal authority contradicting his position, and this Tribunal’s decision is very concerning. It reflects arrogance, obstinance, and insolence, and strongly forecasts that Respondent may violate the ethical rules again based solely on his own self-serving interpretation of right and wrong. As such, his refusal to acknowledge his wrongdoing is a strong factor in aggravation of the penalty to be imposed. *See, e.g., In re Stein*, 177 P.3d 513, 529 (N.M. 2008) (disbarment warranted with aggravating factor under ABA Standard 9.22(g) for lawyer who maintained he did nothing wrong but evidence established repeated knowing and intentional misconduct relating to conflicts of interest and misrepresentations; the court noted that “[i]n light of what Respondent knew and what he intentionally did, it is, to say the least, troubling that he steadfastly maintained that he has acted ethically”); *Bar v. Germain*, 957 So. 2d 613, 622 (Fla. 2007) (court approved application of aggravating factor under ABA Standard 9.22(g) when lawyer stipulated to most of the facts yet continued to assert that his actions did not constitute unethical conduct; the court stated that “[t]hese are legal issues. With a minimum of legal research, [respondent] could have discovered that his conduct did constitute unethical conduct and either curtailed his activities or avoided them altogether”). Here, it is indeed troubling that Respondent has maintained that he has done nothing wrong, particularly given the weight of easily discoverable legal precedent that contradicts his position.

*Substantial experience in the practice of law.* Respondent has been a registered practitioner before the USPTO for more than 18 years and a licensed attorney for 20 years. Stips. 1, 3; DIB Stips. 1-3. As the Director observes, a lawyer with such lengthy experience “should know better than to engage in misconduct.” DIB at 37; see also *Flindt*, PTO Proceeding No. D2016-04, slip op. at 55 (Aug. 4, 2017) (Initial Decision) (finding as an aggravating factor practitioner’s substantial experience in the practice of law with 18 years of experience); *In re*

*Disciplinary Proceedings Against Theobald*, 786 N.W.2d 834 (Wis. 2010) (practicing law for 14 years found to be aggravating factor in determining sanction for attorney for failing to act with reasonable diligence and promptness in representing bankruptcy client and failing to communicate with client after dismissal of bankruptcy petition). Respondent's rejoinder characterizes OED's designation of his experience as an aggravating factor as "duplicitousness." RIB at 11. "On one hand the OED is claiming pattern of misconduct and multiple offenses spread over years, but then says those same years give rise to sage experience that should have informed the Respondent of his misconduct," he laments. RIB at 11. However, it is not actually incongruous for an attorney to commit violations even though he is an experienced practitioner who *should know* better. Rather, it is suggestive that the violations were likely knowingly or intentionally committed rather than innocently or negligently, and more negatively reflects on the integrity of the legal profession.

*False statements.* As the last aggravating factor, the Director suggests that Respondent is "not credible" in that he has made "multiple misrepresentations to the public, OED and this Tribunal." DIB at 19-20, 34-36 (citing ABA Standards § 9.22(f); *Idaho State Bar v. Malmin*, 78 P.3d 371 (Idaho 2003) (evidence supported findings that lawyer knowingly made false statement in connection with disciplinary proceeding when she provided state bar with three varying accounts over the course of the investigation to account for delay in filing money judgment papers on behalf of divorce client); *Att'y Grievance Comm'n v. Dominguez*, 47 A.3d 975, 985 (Md. 2012) (lawyer's false statements to disciplinary counsel that she was never assigned to handle a homeless person's expungement case as a volunteer pro bono attorney despite entering into a pro bono retainer agreement with the client "clearly implicates factor (f)" of Standard 9.22); *In re Solny*, 96 A.D.3d 76 (N.Y. App. Div. 2012) (in imposing two year suspension, court considered in aggravation lawyer's false testimony in disciplinary proceeding that he had permission to transfer \$600,000 of his uncle's money just weeks before his uncle's death)). In support of his claim, the Director cites the following evidence:

- 1) In his original and Amended Notice of Proposed Hearing Location, both filed on November 16, 2018, Respondent represented to this Tribunal that he "separate[ed] from government services as a result of the Tribunal's September 27, 2018 order." DIB at 19, 34 (citing DIB Stips. 65, 66). However, Respondent's retirement from the Navy was initiated on September 4, 2018, 23 days *prior to* the Tribunal's Order being issued.<sup>34</sup> DIB at 19-20, 34 (citing DIB Stip. 60);
- 2) Despite calling his firm K.P. Correll & Associates, Respondent has never had an associate, or another lawyer associated with his firm.<sup>35</sup> DIB at 19 (citing Stip. 9; JX 8 at 1; JX 10 at 1; Tr. 30-31; DIB Stip. 9).

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<sup>34</sup> In clarification, Respondent testified at hearing that his retirement was prompted by this Tribunal's Order of August 16, 2018 denying his second motion to dismiss on statute of limitations grounds. Tr. 48. "Once your August ruling came out, I suspected your final ruling would not be for me, and based on that, then I initiated my retirement." Tr. 48. Nevertheless, because of the clear inconsistency between the timeline and the unequivocal statements Respondent made to the Tribunal in his hearing location notices as to the reason for his retirement, I reject Respondent's suggestion that the Director's characterizations made in regard thereto are false and/or represents "contemptable" conduct which should be "sanctioned." RIB at 4.

<sup>35</sup> At hearing, Respondent justified his use of the appellation, stating that "I was looking for associates." Tr. 30.

- 3) Respondent falsely informed Mr. Kasischke that he was not filing patent applications for private clients with the USPTO, when he was filing such applications. DIB at 19 (citing JX 21 at 19; DIB Stips. 16, 40-46);
- 4) Although for many years he served on the IEB, reviewing invention disclosures and voting as to whether NUWC should seek patent protection for them, Respondent represented to the OED that “[a]t no time has there been any overlap between my government position as an engineer for the Navy and my private work as a patent attorney . . . nor is there any connection between my Navy position as an engineer and the USPTO.” DIB at 19 (quoting JX 8 at 1-2 and citing JX 10 at 5; DIB Stips. 23, 33-36);
- 5) Respondent represented to the OED that he had “resigned” from the IEB when in fact he left the Board involuntarily after he had been informed by Dr. Baus that he could no longer participate because he was representing private clients in front of the USPTO while employed by the federal government. DIB at 19 (citing DIB Stips. 36-37; Tr. 30; JX 13 at 5);
- 6) Respondent has consistently argued, both before and after this Tribunal’s September 27, 2018 Order, that he is not violating 18 U.S.C. §§ 203 and 205. DIB at 20 (citing DIB Stips. 22, 26, 29, 32);
- 7) Although Respondent served on the IEB and was aware that base employees must have their inventions pre-evaluated before filing for patent protection to make sure the federal government does not own the invention, Respondent did not submit his own two inventions to the Patent Counsel’s Office and/or the IEB for evaluation.<sup>36</sup> DIB at 20 (citing DIB Stips. 33-35, 38, 39; JX 17 at 3; JX 14 at 2; JX 15 at 2; JX 17 at 3).

It is the responsibility of this Tribunal as the factfinder to determine the credibility of witnesses and weight of the evidence. *United States v. Wright*, 428 F.2d 445, 446 (8th Cir. 1970); *United States v. Libous*, 645 F. App’x 78, 79 (2d Cir. 2016) (citing *United States v. LaSpina*, 299 F.3d 165, 180 (2d Cir. 2002)). In assessing the credibility of a witness, I consider “the appropriate factors for judging credibility,” including the following:

the demeanor of the witnesses, any interests, bias, or prejudice the witnesses may have, the opportunity of the witnesses to see, hear, know or remember the facts or occurrences about which the witnesses testified, whether the testimony of the witnesses is reasonable, and whether the testimony is consistent with all other believable evidence in the case.

*R.S. v. Bd. of Directors of Woods Charter Sch. Co.*, No. 1:16-CV-119, 2019 WL 1025930, at \*5 (M.D.N.C. Mar. 4, 2019). Further, as the fact-finder, I am “free to believe part and disbelieve

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<sup>36</sup> Mr. Kasischke testified that after this matter arose, he reviewed Respondent’s patents and spoke with Respondent’s supervisor and found the inventions to be something the government had no interest in and unrelated to his government work activities. JX 21 at 23-24.

part of a [respondent's] trial testimony.” *Libous*, 645 F. App'x at 79 (citing *United States v. Norman*, 776 F.3d 67, 77 (2d Cir. 2015)).

I agree with the Director that there is a persistent scent of mendacity on the part of Respondent which taints this case. Besides the various points mentioned above, there is also Respondent's incredible assertion that he believed in “good faith” for some 16 years that he was given sufficient authorization by the government to engage in outside work activities via a single brief unprompted conversation with his supervisor, shortly after beginning work, even though his superior was neither an attorney nor a designated ethics officer. Tr. 47-48, 54, 57; RIB at 8. It is noted that Respondent offered no records memorializing this significant conversation nor did he call Mr. Watt as a witness in this proceeding or explain his absence, leaving Respondent's self-serving testimony as to the conversation totally uncorroborated. In addition, Respondent repeatedly claimed at hearing that that he could not recall Mr. Kasischke's subsequent conversation with him about engaging in private practice as a federal employee, after having no trouble recalling the substance of his *prior* conversation with Mr. Watt on the same topic. Tr. 23-24, 27-28. There is also the broad, dubious claim made by Respondent that despite undergoing yearly ethics training, completing an OGE 450 disclosure, sitting on the IEB, as well as receiving specific warnings from the 2003 USPTO Survey and Mr. Kasischke, for 16 years he never once realized that his outside work activities might create a conflict of interest and be prohibited, such that he should perhaps, simply as a matter of caution, inquire of ethics counsel. Tr. 57. Respondent proffered this claim even though he admitted to being aware that filers of OGE 450 forms were required to obtain written permission for outside work activities; that in 2008 he was an OGE 450 filer; and that he did not obtain such permission for his outside activities. Tr. 57; JX 10 at 3 and n.11-12; RIB at 8.

Moreover, Respondent testified that he never advised any of his patent clients that he was a government employee, a persistent withholding of commonly exchanged social information that seems inconsistent with his claim that he felt his private practice was authorized and that he performed his private practice work on nights, weekends, and when he was on leave from his government position. Tr. 54. Respondent cast himself to the OED in his RFI responses as a “low grade GS 13 Engineer,” but at hearing indicated that he started his position under Mr. Watt as a “branch chief,” and by 2017, he was in a supervisor role as Chief Technology Officer, an ND 5, earning over \$133,000. JX 8 at 1-2; Tr. 54; JX 14 at 1; DX 20. Respondent stated in this proceeding that he received no response to the legal memoranda he submitted to OED with his RFIs, or to his offer to resign his government position, but the record evidences that OED did respond and provided him with copies of various relevant case decisions and OGE opinions evidencing the error of his legal analysis. RIB at 11; RRB at 20; JX 11 at 11-37; JX 11 at 4 (OED asks Respondent to square his current position with his acknowledgement on the 2003 Survey that government attorneys may not engage in private practice and the prohibition on accepting compensation as well as whether he has begun terminating his law practice or separating from the government). Finally, there is Respondent's claim in this proceeding, unsupported by any documentation, that he only netted \$34,000 in income from his private practice over 12 years, although the Director conservatively calculated Respondent's *gross* income from filing some 250+ USPTO applications as \$550,000. Such a vast discrepancy is difficult to reconcile based on mere normal business expenses, especially as Respondent had no staff and his offices consisted only of a client meeting room. RIB at 5.

All in all, considering his demeanor as well as the lack of detail and pithy explanations he provided, Respondent's testimony in this proceeding does not seem logical, reasonable or credible. *See United States v. Blagojevich*, 614 F.3d 287, 290 (7th Cir.2010) ("Neither juries nor judges are required to divorce themselves of common sense, but rather should apply to facts which they find proven such reasonable inferences as are justified in light of their experience as to the natural inclinations of human beings."); *see also Jackson v. United States*, 353 F.2d 862, 866 (D.C. Cir. 1965)(A number of other factors often considered in judging credibility must be examined, such as whether the witness was interested in the outcome, his reputation, his degree of recall, the internal inconsistencies in his testimony, and the likelihood of his story); *Kramer v. Am. Bank & Tr. Co., N.A.*, 989 F. Supp. 2d 709, 722 (N.D. Ill. 2013) (A judge need not leave experience and common sense at the courthouse door).

Based upon the foregoing findings, I find that there is a basis for considering "false statements" as a factor in aggravation of the penalty.

#### Applicable Mitigation Factors

*Absence of a prior disciplinary record.* Respondent has no prior disciplinary proceeding over a rather lengthy career. RIB at 12; RRB at 21. This absence further suggests that Respondent's clients were satisfied with the quality of his legal work and conduct in regard thereto. In light of the number of his private clients for whom he did work, while a full-time government employee, this is a substantial factor in mitigation of the penalty.

*Rectifying misconduct/imposition of other sanctions.* Respondent claims that he voluntarily separated from government service "at significant financial loss" in response to this Tribunal's rejection of his defenses in this case. RIB at 12; RRB at 22. However, Mr. Kasischke testified that he reported Respondent to NUWC once he discovered he was engaged in private law practice in contravention of 18 U.S.C. §§ 203 and 205, which are criminal statutes. JX 21 at 20. Further, Respondent admits that prior to his retirement, NUWC investigated the allegations and issued an "interim report" recommending it be "used negatively in consideration of any future application for a security clearance," which was a requirement of employment in his position.<sup>37</sup> RIB at 5; RRB at 15; Tr. at 49-50. Taken together, these facts, plus his age of 63, suggest that Respondent potentially had reasons, other than this Tribunal's orders, for retiring from his federal position. As such, his voluntary retirement cannot be necessarily attributed to Respondent accepting and mitigating the violations. However, the fact that Respondent has already been sanctioned for his conduct by the NUWC, along with his age, can be considered mitigation factors.

*Delay in proceedings.* Respondent observes that Mr. Kasischke/NUWC became aware that he was privately practicing law while a federal employee in 2004 but failed to notify OED until 2016. RIB at 12-13; RRB at 22. "[T]hese proceedings could have been avoided or the penalty much less harsh than an 18-month suspension at age 63 if the government had done its duty," Respondent complains. RIB at 13; RRB at 22. However, the record reflects that, in fact,

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<sup>37</sup> In his Reply Brief, Respondent suggests that he was prevented from entering the interim report into evidence due to it being issued two days after the hearing in this case. RRB at 15. However, Respondent never filed any request to reopen the hearing record to accept such additional evidence. Absent from the record is also any information as to whether a final report of the investigation has been issued and what recommendation, if any, that report made.



Respondent bares all the blame for the delay. In 2004, Mr. Kasischke advised Respondent that patent practice as a government employee was prohibited. JX 21 at 19. Instead of properly acting thereon, Respondent misrepresented his activities to Mr. Kasischke, who then reasonably relied upon the misrepresentation to not report Respondent to OED or NUWC. Tr. 19. Moreover, Respondent had the ability at any time to seek USPTO's opinion about the propriety of his conduct. Any reasonable practitioner acting in good faith would have done so upon receiving the Survey that Respondent received in 2003, when he was younger and much earlier in his career. Instead, the evidence suggests that Respondent hoped to fly under the radar and is now upset that he was caught at this late date. As such, Respondent's complaint regarding the delay will not be heard in this proceeding.<sup>38</sup>

*OED's Deportment.* Respondent claims that OED "grossly simplified estimates of Respondent's earnings over 15 years" and in doing so "exhibit[ed] bad faith, abuse of position, and contempt for the Tribunal's judgment in practical matters . . . ." RIB at 5; RRB at 15. Respondent is correct regarding OED's "simplification" to the extent that its calculations reflect only a rough estimate of Respondent's gross income from his private practice rather than net income. DIB at 29-32. However, the Director fully and forthrightly explained in his brief the methodology used in his calculations, including the fact that he was limited as a result of Respondent unilaterally redacting detailed tax information on business expenses from documents he provided to the OED. DIB at 29-32; DRB at 12; JX 12 at 8, 13, 18, 23. As such, I do not find that the Director's calculations offered as to Respondent's gross income show "bad faith," "abuse of position," or "contempt," nor do they warrant any mitigation in penalty.

*OED's Collusion.* In his post-hearing briefs, Respondent additionally alleges that OED failed to disclose to this Tribunal that it "colluded" with NUWC "to initiate a corresponding Department of Defense investigation on March 20, 2018, five months before [he] separated from government service." RIB at 4; RRB at 14. Further, that OED provided NUWC with "data only available to the USPTO in apparent violation of . . . the Computer Matching and Privacy Protection Act of 1988 (CMPAA), Pub. L. No. 100-503, 102 Stat. 2507." RIB at 4-5; RRB at 14. *But cf.* JX 3 at 2 (USPTO 2003 Survey Privacy Act Advisory Statement). The resulting DOD investigation report, Respondent claims, "is replete with out of context allegations and inaccuracies," but nonetheless, "recommends the report it be used negatively in consideration of any future application for a security clearance." RIB at 5; RRB at 14. As such, he is unlikely to be able "to obtain a security clearance which effectively blocks any meaningful government or government contractor employment near the Respondent's residence." RIB at 12; RRB at 22. Moreover, Respondent suggests OED has also failed to inform this Tribunal that it "remains in collusion with NUWC for that agency to 'monitor' the outcome of these proceedings and report[] the outcome to Respondent's state bar if the USPTO ultimately determines, for any reason, not to do so." RIB at 5; RRB at 14. However, Respondent offered no proof nor argument on these "collusion" claims during the hearing held in this matter, nor has he requested the record be reopened to include supplementary evidence in support of these claims. As such, I cannot and do not credit these arguments as factors in mitigation.

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<sup>38</sup> Colloquially, Respondent's argument that Mr. Kasischke should not have given him the benefit of the doubt and reported him sooner is analogous to the comment that Otter makes to Flounder in the movie *Animal House*: "You f--ed up. You trusted [me]!" NATIONAL LAMPOON'S ANIMAL HOUSE (NBC Universal 1978), *available at* <https://www.youtube.com/watch?v=zOXtWxhlsUg> (last visited Oct. 2, 2019).

*Respondent's Cooperation.* Respondent further offers in mitigation the fact that during the yearlong OED investigation, he responded fully to all the Director's RFIs. RIB at 12; RRB at 22. While it does appear that Respondent did respond to all four lengthy RFIs, there is no evidence that he did more than what was required of him under the duty to cooperate set forth in 37 C.F.R. § 11.801. Thus, at most, his cooperation with the OED during the investigation would be a very modest factor in mitigation.

## **X. PENALTY DETERMINATION**

In support of its proposal of an 18-month suspension as an appropriate penalty in this case, the Agency identifies "four published cases related to professional misconduct associated with violations of 18 U.S.C. " 203 and 205." DIB at 39. Three of those cases reflect settlements OED entered into with practitioners rather than adjudicated decisions. DIB at 39-40 (*citing Ryznic*, PTO Proceeding No. D2001-16, slip op. (Feb. 3, 2003) (Final Order), *Seto*, PTO Proceeding No. D2009-38, slip op. (Oct. 11, 2011) (Final Order), and *Laux*, PTO Proceeding No. D2016-39, slip op. (Mar. 9, 2017) (Final Order)). This Tribunal does not view such settlement orders as authoritative and will not consider them in reaching its decision on penalty in this matter.

The one adjudicative decision cited as analogous by the Agency is *Moatz v. Kersey*, 67 U.S.P.Q.2d 1291, 2002 WL 32056608 (Final Decision) (T.T.A.B. 2002).<sup>39</sup> JX 11 at 16-29; JX 11 at 29-31. In *Kersey*, the practitioner was found to have filed three documents with the USPTO on behalf of private clients while employed for less than a year by the Air Force as a (civilian) Patent Advisor, despite being specifically notified that such activity was a conflict of interest and prohibited. *Kersey*, 2002 WL 32056608, at \*1. He also failed to notify the USPTO of brief state suspensions of his license to practice law. *Id.* at \*1-2. The ALJ who heard the case found the practitioner in violation of two provisions of the USPTO Code and determined that a reprimand was an appropriate sanction. *Id.* at \*3. The USPTO appealed the sanction. *Id.* at \*1. On appeal, the USPTO General Counsel considered a variety of mitigating penalty factors including the practitioner's age (62), length of experience, contributions to the patent system as a patent attorney, brief federal employment (suggesting the violations were not longstanding and not likely to be repeated in the future) and lack of "actual conflict of interest in the traditional sense." *Id.* at \*5. He also considered aggravating factors such as the seriousness of the violations and that the practitioner had ignored the advice of his supervisor, shown a lack of remorse or recognition of the seriousness of the offense, and the need to deter other practitioners from violations. *Id.* at \*6. Based thereon, the General Counsel determined that the appropriate penalty was a six-month suspension. *Id.*

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<sup>39</sup> The Final Decision in *Kersey* was issued by the USPTO's General Counsel, to whom the USPTO Director had delegated such authority pursuant to 35 U.S.C. § 3(b)(3)(B), and who subsequently denied the Respondent's request for reconsideration. JX 11 at 16-29; JX 11 at 29-31. The U.S. District Court for the District of Columbia upheld the Final Decision on appeal. *Kersey v. Undersecretary of Commerce for Intellectual Property, et al.*, No. CIV.A. 02-2331 (GK), 2005 WL 486144 (D.D.C. 2005). Mr. Kersey's challenge to the District Court's decision before the Federal Circuit was initially dismissed for failure to prosecute, 128 Fed. Appx. 771 (Fed. Cir. 2005), but that order was subsequently vacated, 193 Fed. Appx. 965 (Fed. Cir. 2006). Ultimately, his appeal was considered by the Court of Appeals for the Federal Circuit and the decision affirmed. *Kersey*, 221 F. App'x 997, 2007 WL 1107740 (Fed. Cir. 2007).

In his initial brief, Respondent suggests that no suspension is warranted in this case because “at no time has there been any matter overlap, potential matter overlap, or matter connection, or other nexus between the Respondent’s government position as an engineer for the Navy and the Respondent’s private work as a patent attorney; nor is there any matter connection between the Respondent’s Navy position as an engineer and the USPTO.” RIB at 7. He advises that all the cases cited in support of the 18-month suspension involve a “nexus” between the government employee’s official duties and the alleged wrong doing. RIB at 6 (citing *Kersey*; *Brown v. Dep’t of the Navy*, 229 F.3d 1356, 1361 (Fed. Cir. 2000) (Marine base civilian employee having adulterous affair with deployed servicemember’s spouse); *Rueckert v. IRS*, 775 F.2d 208 (7th Cir. 1985) (State revenue employee reprimanded for outside legal employment absent expressly required approval from department director); *Moffer v. Watt*, 690 F.2d 1037, 1040 (D.C. Cir. 1982) (Bureau of Indians Affairs employee dismissed for trading with Indians prohibited by 25 U.S.C. § 68); *Hoover v. United States*, 513 F.2d 603, 646-47 (Ct. Cl. 1975) (Revenue employee dismissed for submitting fraudulent tax returns); *Laux*, PTO Proceeding No. D2016-39 at 1-2 (USPTO employee sanctioned for undertaking representation of relative’s interests before the USPTO); *Seto*, PTO Proceeding No. D2009-38 at 1-2 (USPTO employee suspended for filing patent applications while employed by the USPTO); *Ryznic*, PTO Proceeding No. D2001-16 at 1-2 (USPTO employee suspended for two years for filing patent applications while employed by the USPTO)).

Respondent’s argument here is unpersuasive for two reasons. First, there is no requirement that there be a “nexus” for a sanction to be imposed for violating the USPTO Code and Rules. *See Kersey*, 2002 WL 32056608 at \*5 (“whether there was a direct conflict between Respondent’s work for the Air Force and his work for private individuals before the USPTO” has “no direct bearing on this case.”); *Moatz v. Reynolds*, PTO Proceeding No. D1999-12, slip op. at 23 (Apr. 4, 2001) (Initial Decision) (rejecting lack of nexus argument; practitioner excluded for DWI convictions) (citing *In re Kelly*, 801 P. 2d 1126 (Cal. 1990)).

Second, there *is* a likely a “nexus” between Respondent’s federal employment and his private practice. As a federal employee, Respondent served as a voting member on the IEB which evaluated whether NUWC should seek to patent the inventions of NUWC employees. JX 21 at 10-12; DIB Stip. 33; Tr. 30; JX 17 at 3; JX 14 at 1. If the IEB found the government did not own the invention, then the employee had the right to patent the invention on his or her own. JX 15 at 2; JX 21 at 11-12. Such employee/inventors were arguably part of the pool of potential clients from which Respondent’s private practice drew, although admittedly there is no evidence in the record as to whether any of Respondent’s clients were NUWC employees.

After careful consideration of all the penalty factors and aggravating and mitigating circumstances discussed above, I find the suspension of 18 months requested by the OED Director to be inadequate. Respondent was found to have violated nine different USPTO Code and Rules provisions over a period of more than ten years and involving hundreds of separate unethical acts. *See* SJ Order. “Courts have repeatedly held that attorneys who continuously violate disciplinary rules over a lengthy period of time should receive a substantial suspension if not exclusion.” *Hormann*, PTO Proceeding No. D2008-04, at 21 (citing *In the Matter of McAllister*, 265 Ga. 420, 420-21 (1995) (disbarring attorney engaged in multiple violations of state disciplinary rules over three years, including abandoning legal matters entrusted to him, engaging in conduct involving dishonesty, fraud, deceit, or misrepresentation, and failing to respond to state disciplinary authorities)).



In this case, Respondent's conduct "represents stretching and exceeding the limits of trustworthiness, honesty and candor in several contexts over several years." *Kelber*, PTO Proceeding No. D2006-13, slip op. at 64 (Sept. 23, 2008) (Initial Decision) (practitioner suspended six months for misrepresentation). Respondent was informed by the 2003 USPTO Survey and Mr. Kasischke/NUWC in or around 2005-2006 that he was not allowed to represent private parties in patent matters while a government employee. He ignored both the warnings, and worse yet, misrepresented his activities to Mr. Kasischke. He then failed to seek permission for his outside activities even when required to do so in 2008-2009 in association with filing an OGE 450. Respondent continued his violative activities while under OED investigation although OED notified him they were prohibited and persisted still to violate the law even while this proceeding was pending. Many of his representations to OED and this Tribunal do not ring truthful. To this day, Respondent remains arrogant and unrepentant about his conduct.

While he has no prior history of violations, the record here evidences that Respondent knowingly violated the USPTO Code and Rules and successfully engaged in the private practice of patent law while a government employee, likely for the full 16 years that he worked for the federal government. As such, his present request for leniency to continue to engage in private practice unimpeded post-retirement, when he may finally do so without violating the USPTO Rules incorporating the Conflict of Interest Statutes, falls on deaf ears. *Hormann*, PTO Proceeding No. D2008-04, at 21 ("Serious and willful violations of disciplinary rules, even when an attorney holds a record free of violations, may justify disbarment."); *In the Matter of Shehane*, 276 Ga. 168, 170 (2003) (disbarring attorney and holding that even though "respondent has not been the subject of any prior disciplinary action during his eight-year membership in the State Bar of Georgia, we take very seriously his deliberate, deceitful acts to obfuscate the truth").

Consequently, I find a 60-month suspension is more appropriate considering the factors of 37 C.F.R. § 11.54(b) and the above considerations. This Tribunal finds that the penalty assessed will adequately punish Respondent, while also protecting the public and the profession and deterring future violations. *See Hill*, PTO Proceeding No. 2001-06, at 12 (an important aspect of penalties is deterrence); *Burmeister*, PTO Proceeding No. D1999-10, 11 (it is important when considering penalties to start with the idea that the ethical guidelines are in place to protect the public and the Bar). Moreover, this penalty seems appropriate, if not lenient, compared to *Kersey*, where the federal employee practitioner was suspended for six months for filing with the USPTO just three documents in less than a year. Here, Respondent submitted far more filings to the USPTO over a much longer time period. Approximating six months of suspension for each of ten of those years is entirely reasonable. *See Ruffenach*, 486 N.W.2d at 391 (penalty assessed should be proportionate to the violation committed); *In Re Disciplinary Proceedings Against Kuvara*, 149 Wn.2d 237, 256 (Wash. 2003) (proportionality of a penalty to the violation of ethical rules is a factor to be considered in assessing the penalty).

Finally, Respondent asks in his briefs that, in the event a suspension is imposed, that this Tribunal recommend the suspension be stayed while he "seeks judicial review of the First Amendment issues raised earlier in Federal Court, particularly in light of the Supreme Court's rulings in *Matal v. Tam*, 137 S. Ct. 1744 (2017) and *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019)."<sup>40</sup>

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<sup>40</sup> In *Tam*, the Supreme Court held that the disparagement clause under the Lanham Act, 15 U.S.C. § 1052(a), prohibiting registration of trademarks disparaging any person, violated the Free Speech Clause of the First

RIB at 13. The PTO Rules provide that this Tribunal's decision may be initially appealed to the USPTO Director and doing so stays the effective date of sanction order. 37 C.F.R. §§ 11.55, 11.56. In turn, the USPTO Director's decision may be appealed to the U.S. District Court for the Eastern District of Virginia, however "except on proof of exceptional circumstances," such appeal does not stay the order of discipline. 37 C.F.R. §§ 11.57; 35 U.S.C. § 32. As such, it is both premature and not within this Tribunal's purview to determine if exceptional circumstances exist to stay the case in the event of an appeal of the decision to the federal courts.

### **ORDER**

After careful and deliberate consideration of the above facts and conclusions as well as the factors identified in 37 C.F.R. § 11.54(b):

**IT IS HEREBY ORDERED** that Respondent Kevin P. Correll, PTO Registration No. 46,641, is suspended for a period of **60 months** from practice before the Patent and Trademark Office.

Respondent's attention is directed to 37 C.F.R. § 11.58 regarding the duties of excluded practitioners, and 37 C.F.R. § 11.60 concerning petition for reinstatement.

The facts and circumstances of this proceeding shall be fully published in the U.S. Patent and Trademark Office's official publication.

**Under 37 C.F.R. § 11.55, any appeal by Respondent from this Initial Decision, issued pursuant to 35 U.S.C. § 32 and 37 C.F.R. § 11.54, must be filed with the U.S. Patent and Trademark Office at the address provided in 37 C.F.R. § 1.1(a)(3)(ii) within 30 days after the date of this Initial Decision. Such appeal must include exceptions to the Administrative Law Judge's Decision and supporting reasons therefor. Failure to file such an appeal in accordance with 37 C.F.R. § 11.55 will be deemed both an acceptance by Respondent of the Initial Decision and that party's waiver of rights to further administrative and judicial review.**

**SO ORDERED.**



Susan L. Biro  
Chief Administrative Law Judge

Dated: October 3, 2019  
Washington, D.C.

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Amendment, in that trademarks are private, not government speech, and that the statute discriminated based upon viewpoint. In *Brunetti*, the Supreme Court held that the immoral or scandalous clause provision of the Lanham Act, 15 U.S.C. § 1052(a), also violated the First Amendment as it "too disfavors certain ideas." 139 S. Ct. at 2297. Respondent does not enunciate in his brief how his situation is analogous to the facts of these free speech cases and their relevance here is far from self-evident.

In the Matter of Kevin P. Correll, Respondent  
Proceeding No. D2018-12

**CERTIFICATE OF SERVICE**

I hereby certify that the foregoing **Initial Decision**, issued by Chief Administrative Law Judge Susan L. Biro and dated October 3, 2019, was served on this day to the addressees indicated below.



\_\_\_\_\_  
Matt Barnwell  
Attorney Advisor

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Office of Administrative Law Judges  
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*Respondent*

Dated: October 3, 2019  
Washington, D.C.

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

\_\_\_\_\_  
In the Matter of )  
 )  
 )

Kevin P. Correll, )

Proceeding No. D2018-12

Appellant. )  
\_\_\_\_\_)

**FINAL ORDER**

Pursuant to 37 C.F.R. § 11.55, Kevin P. Correll (“Appellant”) has appealed the October 3, 2019 Initial Decision of Administrative Law Judge (“ALJ”) Susan L. Biro to the Director of the United States Patent and Trademark Office (“USPTO” or “Agency”). In that Initial Decision, the ALJ concluded that Appellant violated USPTO’s disciplinary rules<sup>1</sup> and, after considering the relevant factors set forth in 37 C.F.R. § 11.54(b), the ALJ ordered that Appellant be suspended from practice before the USPTO in patent, trademark, and other non-patent matters for 60 months.

For the reasons set forth below, the USPTO Director affirms the ALJ’s Initial Decision.

**I. FINDINGS OF FACT**

Background

1. Appellant was admitted to practice law in Massachusetts on June 14, 1999 and is an active member in good standing of the bar of that state. (A.8; A.45 ¶ 3; A.74 ¶ 3; A.1418, Stip. 3).<sup>2</sup> On September 12, 2000, Appellant registered as a patent attorney with the USPTO

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<sup>1</sup> Effective May 3, 2013, the USPTO Rules of Professional Conduct (“USPTO Rules”), 37 C.F.R. §§ 11.101 through 11.901, apply to persons who practice before the Office. Prior to May 3, 2013, the USPTO Code of Professional Responsibility (“USPTO Code”) applied to persons practicing before the Office. *See* 37 C.F.R. §§ 10.20-10.112. Appellant engaged in misconduct that violated both the USPTO Rules and the USPTO Code.

<sup>2</sup> References to “A.\_\_\_\_” are to specific pages of the Certified Record.

(Registration number 46,641). (A.45 ¶¶ 1-2; A.74 ¶¶ 1-2; A.1418, Stips. 1, 2). As a condition of registration, Appellant swore an oath to “observe the laws and rules of practice of the [USPTO].” (A.8; A.1418, Stip. 4; A.2501) (alteration in original).

2. Appellant has owned and operated a private law firm, K.P. Correll & Associates, LLC (“Correll & Associates”),<sup>3</sup> since September 4, 2002 and through the law firm provides patent and trademark legal services to the public. (A.48 ¶ 18; A.78 ¶ 18). The website for Correll & Associates includes information that: “K.P. Correll and Associates, LLC is an Intellectual Property (IP) Law firm serving corporate and individual clients across the country, and around the world, by protecting their Intellectual Property assets through patents, federal trademarks and federal copyrights.” (A.49 ¶ 28; A.79-80 ¶ 28; A.1542-43 ¶¶ 7, 12; A.1589; A.2514). Appellant is the sole member of Correll & Associates. (A.48 ¶ 26; A.79 ¶ 26). Appellant has advertised his law practice via the internet, paper flyers, the yellow book, and in two booth diorama displays at the T.F. Green Airport in Warwick, Rhode Island. (A.1542 ¶¶ 7, 10; A.1589; A.2299; A.2523-24; A.2544).

3. Beginning on September 16, 2002, Appellant had also been employed by the United States as an engineer for the Department of the Navy at the Naval Undersea Warfare Center (“NUWC”) of the Naval Sea Systems Command in Newport, Rhode Island. (A.46 ¶ 6; A.47 ¶ 16; A.75 ¶ 6; A.77 ¶ 16; A.1418, Stip. 5; A.1542 ¶ 6; A.1589; A.2325; A.2403-04). He worked for NUWC as a senior electronics engineer on submarine learning technologies. (A.47 ¶ 17; A.77-78 ¶ 17). Throughout his government career, Appellant maintained a secret level security clearance, had access to classified information, and worked in a secured facility. (A.2403-04; A.2532-33).

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<sup>3</sup> Appellant’s practice also may have been known as “Northeastern Patent Law Associates,” or “Patent Institute.” (A.1542 ¶¶ 7, 10; A.1589; A.2325; A.2359-60; A.2513-15).

4. From approximately 2004 until 2016, in addition to his regular duties at the NUWC, Appellant was also a voting member of the base's Invention Examination Board ("IEB"). (A.9; A.1458 ¶ 33; A.1474; A.1589; A.2325-26; A.2449; A.2451; A.2513). The IEB consists of approximately ten Navy inventors and engineers representing the various technical areas within the Newport laboratory, including sonar, antennas, combat systems, launchers, undersea vehicles, and others. (A.9; A.1472; A.2449). The IEB meets several times a year and is overseen by the base's non-voting Supervising Patent Counsel. (A.9; A.1470; A.1495; A.2449; A.2452). The IEB receives invention disclosures, which are "engineers' write-ups of their inventions" that are reviewed by the base's Patent Counsel's Office to both ensure the disclosures are complete and for an initial determination as to whether the invention is owned by the Navy or the employee/inventor, personally. (A.9; A.1471-73; A.2450; A.2452). If the invention belongs to the Navy, the IEB then reviews it and votes as to whether the Supervising Patent Counsel should seek patent protection for the invention on the Navy's behalf and the priority thereof. (A.9; A.2325-26; A.2449; A.2513).

5. Prior to his government employment, Appellant never sought ethics advice or clearance for continuing his law practice while simultaneously serving as a federal employee. (A.2538). However, shortly after joining the government in 2002, Appellant had a conversation with his then-direct government supervisor, Harold Watt, a division head at NUWC, from which he came away believing that his private law practice did not conflict with his government work and that he had Mr. Watt's informal, i.e., verbal, approval to continue to engage in such work. Appellant testified that this approval was never withdrawn. (A.8; A.2305; A.2326; A.2430-31; A.2506-07; A.2537). Throughout his career at NUWC, Appellant had other supervisors who became aware

that he had a law degree and maintained a private law practice, but he never sought from them any type of approval for his outside work activities. (A.9; A.2326-27).

6. On or about November 25, 2003, Appellant submitted a signed and dated response to a USPTO Office of Enrollment and Discipline survey. (A.45-46 ¶ 5; A.195-96). He provided his name and the name of his business, “K.P. Correll & Associates LLP,” including his home and business addresses. (*Id.*). At that time, he also indicated he was an attorney and member of the Massachusetts state bar. (A.45-46 ¶¶ 3, 5; A.195-96). Question 6 on the survey read as follows:

Are you an employee of the United States Government? *PLEASE*  
*NOTE: U.S. Government employees are not available to accept*  
*private clients or to represent clients other than their agency*  
*before the United States Patent and Trademark Office. 18 U.S.C. §*  
*205; 37 CFR § 10.10(c) and (d).*

(A.45-46 ¶ 5; A.195-96). Appellant checked the box “YES” in response to Question 6. (*Id.*). The OED Director received the survey response on December 2, 2003. (*Id.*).

7. Sometime in 2008 or 2009, Appellant filed an OGE Form 450 Financial Disclosure Report for 2008, in which he claims he disclosed his outside work activities. (A.10; A.2305; A.2327; A.2427). Appellant was aware that NUWC employees who are required to file OGE 450s must “obtain [his or her] supervisor’s [written] concurrence before engaging in any business activities outside of their official duties or in any compensated employment.” (A.10; A.2326 n.6; A.2430 n.5; A.2464 n.6) (second alteration in original). Nevertheless, Appellant did not seek or receive written concurrence for his outside work activities either before or after filing the OGE 450 form. (A.10; A.2540).

Appellant's legal services

8. Despite the notice provided in the November 25, 2003 survey, Appellant acknowledged in his Answer to the Complaint “that he was ‘paid/compensated for work considered “practice before the Office” pursuant to 37 C.F.R. § 11.5(b) (including subsections (1) and (2)), including, but not limited to, preparing and/or prosecuting patent and/or trademark applications before the USPTO.’” (A.49 ¶ 32; A.80 ¶ 32). Appellant has not withdrawn his representation in any of the patent and trademark applications since the onset of the OED investigation. (A.51-56 ¶¶ 41-42; A.58 ¶ 49; A.82-84 ¶¶ 41-42, A.86-87 ¶¶ 49-50). Appellant has never contacted the ethics counselor for the Navy to seek advice or to inform the counselor of his client representation in patent and trademark applications before the USPTO. (A.69 ¶ 83; A.91 ¶ 83).

9. In return for his legal services, Appellant charged and received financial compensation mostly on a flat-fee basis, “credit[ing] each fee forward.” (A.1551 ¶¶ 47, 48; A.2522; A.2540-41). For example, Appellant charged \$750 for an initial patent search, which would be credited against a \$1,900 fee if the client then hired him to prepare and file a provisional application with the USPTO, a fee that in turn could be credited against a total fee of \$4,500-\$5,500 for preparing and filing a utility application. (A.1551 ¶¶ 49, 52; A.2541-42). Appellant charged fees ranging between \$1,900 and \$1,500, for preparing and filing design applications. (A.1551 ¶ 52; A.2542-43). He charged a flat fee of \$300-\$400 for preparing and filing a trademark application. (A.1551 ¶ 53; A.2542).

10. Despite having been provided notice that continuing his law practice while working as a federal employee was problematic, between January 17, 2008 (when the statute of limitations began to run) and September 29, 2018 (when Appellant retired) — Appellant filed and/or prosecuted patent and trademark applications with the USPTO on behalf of paying clients.



(A.1912-2250; A.2471-82). Appellant admitted that he filed 20 patent applications after the OED Director mailed him a Request for Information that outlined the prohibitions of 18 U.S.C. §§ 203, 205 and 37 C.F.R. § 11.10(e). (A.56 ¶ 42; A.83-84 ¶ 42). Appellant also admitted that he filed 34 trademark applications after the OED Director mailed him a Request for Information that outlined the prohibitions of 18 U.S.C. §§ 203, 205 and 37 C.F.R. § 11.10(e). (A.63 ¶ 50; A.86-87 ¶ 50). Appellant has not withdrawn his representation in any of the patent and trademark applications since the onset of the OED investigation. (A.51-56 ¶¶ 41-42; A.58 ¶ 49; A.82-84 ¶¶ 41-42; A.86-87 ¶¶ 49, 50). Further, Appellant never contacted the ethics counselor for the Navy to seek advice or to inform the counselor of his client representation in patent and trademark applications before the USPTO. (A.69 ¶ 83; A.91 ¶ 83).

Further Notice to Appellant and Referral to OED

11. Since 2004, James M. Kasischke, Esq. has been the Supervisory Patent Counsel at the NUWC in Newport, RI. (A.9; A.1470; A.2449-50). His position involves overseeing the whole patent program for NUWC laboratory in Newport, including patent applications, patent licensing, patent prosecution, and the IEB. (A.9; A.2449-50).

12. Sometime around 2005 or 2006, while in a barbershop near NUWC, Mr. Kasischke came across a flyer offering the invention services of Kevin P. Correll or KP Correll Intellectual Property Services. (A.9; A.1477; A.2449-50). Mr. Kasischke knew that such outside work activities by Appellant were “wrong” and a possible conflict of interest. (A.1477-78; A.2449-50). Accordingly, Mr. Kasischke telephoned Appellant and notified him that, as a government employee, he could not file patent applications. (A.1480; A.2449-50). In reply, Appellant reassured Mr. Kasischke that he was aware of the prohibition and that “he wasn’t filing patent applications” but merely “advis[ing] people on what to do with their inventions and advis[ing]

them maybe to get somebody else to file the patent applications.” (A.10; A.1480; A.2449-50) (alterations in original). After warning Appellant, Mr. Kasischke did not “keep [his] eye on him” due to Appellant’s assurances that he was not filing patent applications. (A.10; A.1487) (alteration in original). He did not report Appellant to OED at that time because he “was trying to be a good guy. [Appellant] might not have known about the law.” (A.10; A.1491).

13. Around fall 2016, Mr. Kasischke noticed two large standing glass booths in the Providence, Rhode Island airport advertising Appellant’s professional services as Northeastern Patent Associates and another named entity. (A.10; A.1476; A.2299). Around the same time, other NUWC employees viewed the airport advertisements and brought them to Mr. Kasischke’s attention. (A.10; A.1475). Among those other employees was the head of the IEB, Dr. Theresa Baus, who advised Mr. Kasischke that “you know, you probably have to do something about that.” (A.10; A.1480-81).

14. At that point, Mr. Kasischke undertook a search to determine for himself whether Appellant had “really been filing patent applications” for private clients with the USPTO and found that he had. (A.10; A.1481). He also discovered that Appellant was not then identified as a government employee on the USPTO’s register of attorneys, “when I knew he was.” (A.10; A.1490); *see also* (A.2293, USPTO computerized registration data extracted Dec. 5, 2017 identifying Appellant as *not* being a federal employee). Mr. Kasischke became “mad” at Appellant “because I warned him, and he’d gone against my advice.” (A.10; A.1487). Mr. Kasischke concluded that it was his “duty as a Navy attorney” to report Appellant, “first, you know, as far as the ethics violation to the US government [a]nd then as a US PTO bar member, I had to report to the patent bar.” (A.10-11; A.1481; A.1489) (alteration in original).

15. On December 19, 2016, Mr. Kasischke emailed OED and informed that office that Appellant was filing patents and trademark applications while employed with the Department of Navy in contravention of 18 U.S.C. §§ 203 and 205. (A.11; A.2297). Mr. Kasischke also spoke with Dr. Baus and together they decided that it was no longer appropriate for Appellant to be on the IEB and Dr. Baus removed Appellant from the IEB sometime in the summer of 2016. (A.11; A.1481-82; A.2449; A.2451).

16. The OED opened an investigation, beginning on February 9, 2017 and continuing through November 2017, and sent Appellant a series of four Requests for Information (RFI). (A.2300-03). Each RFI advised Appellant that:

With a small number of exceptions, United States Government employees may not represent anyone other than themselves on any matter before the executive branch. *See* 18 U.S.C. 205. In addition, executive branch employees are prohibited from receiving any form of compensation derived from representation of another before the executive branch. *See* 18 U.S.C. 203. In addition, 37 C.F.R. § 11.10(e) provides that [p]ractice before the Office by Government employees is subject to any applicable conflict of interest laws, regulations or codes of professional responsibility.

(A.1544-47 ¶¶ 20, 24, 27, 30; A.1589; A.2301-02; A.2322; A.2368; A.2458; A.2516-17) (alteration in original).

17. Despite the advisement in the RFIs, and despite the on-going USPTO investigation, Appellant continued to both work for the NUWC and file USPTO applications for private clients, professing to believe he “fit within the small number of exceptions” and that “according to case law” he was entitled to “maintain[ ] the status quo until there was an adjudication.” (A.11-12; A.1550 ¶¶ 43, 44; A.1589; A.1979-2109; A.2517-18) (alteration in original). At no time before or after the OED’s investigation was initiated did Appellant ever seek guidance from

a government ethics official on the propriety of his dual work activities. (A.12; A.1545-47 ¶¶ 21, 25, 28, 31; A.2540).

18. On January 17, 2018, the OED Director filed the Complaint initiating this disciplinary proceeding seeking Appellant's exclusion or suspension as a USPTO practitioner based upon his dual work activities. (A.12; A.44-73; A.1551 ¶ 55; A.1589). Even after the Complaint was filed, Appellant continued to engage in both his federal employment and private practice. (A.12; A.1420, Stip. 15-18; A.2110-250; A.2520-21; A.2537-38). However, on September 4, 2018, Appellant notified his supervisor that he would be retiring from the Navy "by the end of the month." (A.12; A.1419, Stip. 9; A.1552 ¶ 60; A.1589; A.2470; A.2524-25). Appellant's voluntary separation from the Navy became effective as of September 29, 2018. (A.12; A.1419, Stip. 10; A.1552 ¶ 62; A.1589; A.1659; A.2526). The disciplinary proceedings were the driving force in his retirement. (A.12; A.2526-27).

## **II. OED DISCIPLINARY PROCEEDING**

The OED Director issued a Complaint and Notice of Proceedings against Appellant under 35 U.S.C. §§ 2(b)(2)(D), 32, and 37 C.F.R. §§ 11.32, 11.34, 11.39 on January 17, 2018. (A.44-73). The Complaint charged Appellant with two counts of professional misconduct through violations of the USPTO Code and the USPTO Rules. (*Id.*). The violations stemmed from allegations that Appellant represented private parties before the USPTO while he was employed by the federal government. (*Id.*) The OED Director requested an order excluding or suspending Appellant from practice before the USPTO in patent, trademark, and other non-patent matters. (A.70).

Appellant filed his "Answer Under 37 CFR 11.36, Defenses, and Counter Claims" ("Answer") on February 15, 2018. (A.74-101). Though Appellant admitted most of the factual allegations in the Complaint, he raised various affirmative defenses to the disciplinary proceedings. (*Id.*).

On May 24, 2018, the OED Director filed a motion for summary judgment, and subsequently, Appellant filed a motion to dismiss and a cross-motion for summary judgment. (A.135-258; A.265-78; A.279-326). After pleadings by the parties on the dispositive motions, on August 16, 2018, the ALJ issued an order denying Appellant's motion to dismiss. (A.403-13). On September 27, 2018, the ALJ issued an order on the parties' cross-motions for summary judgment. (A.414-40). That Order found Appellant have violated certain disciplinary rules,<sup>4</sup> but not all of the violations alleged in the Complaint. (*Id.*). The ALJ's September 27, 2018 Order also addressed Appellant's "Counter Claims and Defenses" including, but not limited to, First Amendment claims and Fifth Amendment claims involving substantive and procedural due process. (*Id.*) Appellant's defenses and counterclaims were rejected. (A.428-39). The ALJ denied summary judgment as to sanction. (A.439).

A hearing was held on April 16, 2019 in Providence, Rhode Island. (A.2483). At hearing, the OED Director elicited Appellant's testimony and submitted into evidence the written deposition testimony of Mr. Kasischke. (A.2483-558). The ALJ also admitted into evidence 20 Joint Exhibits, numbered 1-20, as well as five OED Director's Exhibits, nos. 20, 32-35. (*Id.*) Appellant testified on his own behalf at hearing but submitted no additional testimony or documents. (A.2530-48). Both parties submitted post-hearing briefs and the ALJ issued the Initial Decision on the October 3, 2019. (A.1-39).

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<sup>4</sup> The ALJ granted summary judgment to the OED Director on Count I with regard to the violations of the USPTO Code, 37 C.F.R. §§ 37 C.F.R. § 10.23(a), 10.23(b)(4), 10.23(b)(5), 10.23(c)(20), 10.40(b)(2), and the USPTO Rules, 37 C.F.R. §§ 11.111, 11.116(a)(1), 11.505, 11.804(d). (A.414-40). The ALJ denied summary judgment on Count I with regard to the alleged violations of 37 C.F.R. §§ 10.23(b)(6), 11.804(b), and 11.804(i), as well as to all of the allegations in Count II. (*Id.*).

### III. INITIAL DECISION BY ADMINISTRATIVE LAW JUDGE

On October 3, 2019, the ALJ issued the Initial Decision in this matter. (A.1-39). Having already concluded, via the September 27, 2018 summary judgment order, that Appellant violated multiple provisions of the USPTO Code and USPTO rules, the Initial Decision considered the issue of sanction. The ALJ thoroughly, and in great detail, considered the factors under 37 C.F.R. § 11.54(b), and concluded that Appellant should be suspended from practice before the USPTO in patent, trademark, and non-patent matters for 60-months months. (A.38).

Appellant filed an appeal on November 5, 2019, asking the USPTO Director to “dismiss the October 3, 2019 Initial Decision in Proceeding No. D2018-12. . . .”<sup>5</sup> (Appeal at 1). The appeal does not challenge either the ALJ’s conclusions that Appellant violated multiple USPTO disciplinary rules, as stated in the September 27, 2018 summary judgment order. Nor does the appeal challenge the ALJ’s imposition of a 60-month suspension form the practice before the Office. Rather, the appeal rests almost solely on the argument that the Initial Decision should be dismissed or stayed pending final resolution of Appellant’s First Amendment claims. (Appeal at 29). For the reasons set forth below, the appeal is **DENIED**.

### IV. DECISION

#### A. Appellant Engaged in Misconduct That Violated USPTO’s Disciplinary Rules.

Appellant largely admits the facts underlying the ALJ’s conclusion that Appellant violated multiple provisions of both the USPTO Code and the USPTO Rules. It is uncontroverted that

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<sup>5</sup> Although the Appeal states that it is an “Appeal from the Administrative Law Judge’s: Initial Decision (Oct. 3, 2019), Order on Appellant’s Motion to Dismiss (Aug. 16, 2008), and Order on Motions for Summary Judgement (Sep. 27, 2018),” the appeal does not address any of the identified Motions or make specific challenges to those Motions. Thus, for the reasons stated in the OED Director’s response brief, those decisions are affirmed. *See* 37 C.F.R. § 11.55(b) (“Any exception not raised will be deemed to have been waived and will be disregarded by the USPTO Director in reviewing the initial decision.”).

Appellant has been the sole owner and operator of Correll & Associates since September 4, 2002 and, through the law firm, provides patent and trademark legal services to the public. (A.48 ¶¶ 18, 26; A.49 ¶ 28; A.78 ¶18; A.79 ¶ 26; A.79-80 ¶ 28; A.1542-43 ¶¶ 7, 12; A.1589; A.2514). Appellant has advertised his law practice via the internet, paper flyers, the yellow book, and in two booth diorama displays at the T.F. Green Airport in Warwick, Rhode Island. (A.1542 ¶¶ 7, 10; A.1589; A.2299; A.2523-24; A.2544). Appellant charged and received financial compensation mostly on a flat-fee basis, “credit[ing] each fee forward” for his legal services, which included patent searches, and filing patent and trademark applications. (A.1551 ¶¶ 47-49, 51-53; A.2522; A.2540; A.2541-43).

It is also not in dispute that, beginning in September 16, 2002, Appellant began to be employed by the United States as an engineer for NUWC as a senior electronics engineer. (A.46-47 ¶¶ 6, 16; A.47 ¶ 17; A.74-75 ¶ 6; A.77-78 ¶¶ 16-17; A.1418, Stip. 5; A.1542 ¶ 6; A.1589; A.2325; A.2403-04). In addition to his regular duties at the NUWC, from approximately 2004 until 2016, Appellant was also a voting member of the base’s IEB. (A.9; A.1458 ¶ 33; A.1474; A.1589; A.2325-26; A.2449; A.2451; A.2513). The IEB receives invention disclosures that are reviewed by the base’s Patent Counsel’s Office to both ensure the disclosures are complete and for an initial determination as to whether the invention is owned by the Navy or the employee/inventor, personally. (A.9; A.1471-73; A.2450; A.2452). If the invention belongs to the Navy, the IEB then reviews it and votes as to whether the Supervising Patent Counsel should seek patent protection for the invention on the Navy’s behalf and the priority thereof. (A.9; A.2325-26; A.2449; A.2513).

Prior to his government employment, Appellant never sought ethics advice or clearance for continuing his law practice while serving as a federal employee, simultaneously. (A.2538).

However, undisputed facts in the record demonstrate he did have, or should have had, notice that continuing his law practice while working as a federal employee was problematic. This notice includes:

1. On or about November 25, 2003, Appellant submitted a signed and dated response to a USPTO Office of Enrollment and Discipline survey. (A.45-46 ¶ 5; A.195-96). He provided his name, the name of his business, “K.P. Correll & Associates LLP,” and both his home and his business addresses. (*Id.*). Thereon, he also indicated he was an attorney and member of the Massachusetts state bar. (A.45-46 ¶¶ 3, 5; A.195-96). Question 6 on the survey read as follows:

Are you an employee of the United States Government? *PLEASE*  
*NOTE: U.S. Government employees are not available to accept private clients or to represent clients other than their agency before the United States Patent and Trademark Office. 18 U.S.C. § 205; 37 CFR § 10.10(c) and (d).*

(A.45-46 ¶ 5; A.195-96). Appellant checked the box “YES” in response to Question 6. (*Id.*). Despite the notice provided in the survey, Appellant acknowledged in his Answer that he was “paid/compensated for work considered ‘practice before the Office’ pursuant to 37 C.F.R. § 11.5(b) (including subsections (1) and (2)), including, but not limited to, preparing and/or prosecuting patent and/or trademark applications before the USPTO.” (A.49, ¶ 32; A.80 ¶ 32).

2. In 2005 or 2006, after Mr. Kasischke noticed a flyer offering the invention services of Kevin P. Correll or KP Correll Intellectual Property Services, Mr. Kasischke telephoned Appellant and notified him that, as a government employee, he could not file patent applications. (A. 9; A.1477; A.1480; A.2449-50).



3. Sometime in 2008 or 2009, it is undisputed that Appellant filed an OGE Form 450 Financial Disclosure Report for 2008, in which he claims he disclosed his outside work activities. (A.10; A.2305; A.2327; A.2427). Appellant was aware that NUWC employees who are required to file OGE 450s must “obtain [his or her] supervisor’s [written] concurrence before engaging in any business activities outside of their official duties or in any compensated employment.” (A.10; A.2326 n.6; A.2430 n.5; A.2464 n.6) (second alteration in original). Nevertheless, Appellant did not seek or receive written concurrence for his outside work activities either before or after filing the OGE 450 form. (A.10; A.2540).
4. On December 19, 2016, after once again seeing that Appellant was filing patent applications with the USPTO and not identifying himself to OED as a government employee, Mr. Kasischke emailed OED and informed that office that Appellant was filing patents and trademark applications while employed with the Department of Navy in contravention of 18 U.S.C. §§ 203 and 205. (A.10-11; A.1481; A.1490; A.2297); *see also* A.2293 (USPTO computerized registration data extracted Dec. 5, 2017 identifying Appellant as *not* being a federal employee). Appellant was also removed from the IEB sometime in the summer of 2016. (A.11; A.1481-82; A.2449; A.2451). After receiving Mr. Kasischke’s complaint, OED opened an investigation, through which OED sent Appellant a series of four Requests for Information (RFI). (A.2300-03). Each RFI once again advised Appellant that:

With a small number of exceptions, United States Government employees may not represent anyone other than themselves on any matter before the executive branch. *See* 18 U.S.C. 205. In addition, executive branch employees are prohibited from receiving any form of compensation derived from representation of another before the executive branch. *See* 18 U.S.C. 203. In addition, 37 C.F.R. §

11.10(e) provides that [p]ractice before the Office by Government employees is subject to any applicable conflict of interest laws, regulations or codes of professional responsibility.

(A.1544-47, ¶¶ 20, 24, 27, 30; A.1589; A.2301-02; A.2322; A.2368; A.2458; A.2516-17) (alteration in original).

Despite having been provided notice that continuing his law practice while working as a federal employee was problematic, between January 17, 2008 (when the statute of limitations began to run) and September 29, 2018 (when Appellant retired) – Appellant filed and/or prosecuted patent and trademark applications with the USPTO on behalf of paying clients. (A.1912-2250; A.2471-82). Appellant admitted that he filed 20 patent applications after the OED Director mailed him a Request for Information that outlined the prohibitions of 18 U.S.C. §§ 203, 205 and 37 C.F.R. § 11.10(e). (A.56 ¶ 42; A.83-84 ¶ 42). Appellant also admitted that he filed 34 trademark applications after the OED Director mailed him a Request for Information that outlined the prohibitions of 18 U.S.C. §§ 203, 205 and 37 C.F.R. § 11.10(e). (A.63 ¶ 50; A.86-87 ¶ 50). Appellant has not withdrawn his representation in any of the patent and trademark applications since the onset of the OED investigation. (A.51-56 ¶¶ 41-42; A.58 ¶ 49; A.82-84 ¶¶ 41-42; A.86-87 ¶¶ 49, 50). Further, Appellant has never contacted the ethics counselor for the Navy to seek advice regarding the propriety of his dual employment or to inform the counselor of his client representation in patent and trademark applications before the USPTO. (A.12; A.69 ¶ 83; A.91 ¶ 83; A.1545-47 ¶¶ 21, 25, 28, 31; A.2540). Instead, Appellant continued to both work for the NUWC and file USPTO applications for private clients, professing to believe he “fit within the small number of exceptions” and that “according to case law” he was entitled to “maintain[ ] the status quo until there was an adjudication.” (A.11-12; A.1550 ¶¶ 43, 44; A.1589; A.1979-2109; A.2517-18) (alteration in original). Even after the January 17, 2018 Complaint

was filed, Appellant continued to engage in both his federal employment and private practice. (A.12; A.1420, Stips. 15-18; A.2110-250; A.2520-21; A.2537-38).

The facts stated above being beyond dispute, Appellant's only real attempt to challenge the ALJ's legal conclusions and or factual findings is to raise a challenge to facts that are largely irrelevant to the ALJ's findings of misconduct. For example, Appellant raises arguments about what he was required to disclose on his financial disclosure form and he challenges the ALJ's characterization of his position with the Navy. (Appeal at 27-28). However, even if the ALJ was factually incorrect as to these issues, they have no bearing on the ALJ's conclusions. Regardless of what he disclosed or was required to file on his financial disclosure form, and regardless of whether his position with NUWC is more properly characterized as a high or low graded employee, his obligations under the USPTO disciplinary rules and the federal ethics rules remained the same. These facts do not affect, mitigate, or concern in anyway the ALJ's conclusions that he was engaged in practice before the USPTO while employed by the Federal government, in violation of Federal conflict of interest rules, as well as 37 C.F.R. §§ 10.23(a), 10.23(b)(4), 10.23(b)(5), 10.23(c)(20), 10.40(b)(2), 11.111, 11.116(a)(1), 11.505, and 11.804(d). Thus, the appeal is denied on this basis.

#### **B. Appellant's First Amendment Rights Were Not Violated.**

As noted above, Appellant does not present any significant or relevant challenge to the ALJ's findings and conclusions. Nor could he make a sufficient challenged given his admissions, both in his Answer and throughout the disciplinary proceedings. Instead, the vast majority of his appeal rests on an argument that his First Amendment rights were violated by applying the conflict of interest statutes to activities he took in furtherance of his practice before the USPTO. (Appeal at 4-18). Appellant argues that when he engaged in practice before the office he was

acting as a private citizen who is entitled to free speech under the First Amendment to the U.S. Constitution and, further, that USPTO created and controlled designated public forums –PAIR and TESS- and preventing him from accessing these forums is prohibited censorship pursuant to the First Amendment. (Appeal at 5-9, 10-12, 14-17). He further argues that any suspension stemming from the USPTO’s “unconstitutional application of [18 U.S.C. §§ 203 and 205] will violate [his] First Amendment Freedom of Speech and Expressive Association rights,” and “[a]ny restraint imposed in advance of a final judicial determination [in Federal Court] on the [Constitutional] merits must be similarly limited to preservation of the status quo for the shortest fixed period compatible with sound judicial resolution.” (Appeal at 17-18) (fourth and fifth alterations in original) (citation omitted). Appellant bears the burden of proving these arguments by clear and convincing evidence. *See* 37 C.F.R. § 11.49 (A practitioner shall have the burden of proving any affirmative defense by clear and convincing evidence.). Since Appellant cannot sustain this burden with regard to his First Amendment claim, his appeal is denied.

Appellant’s entire argument rests on the premise that he has the unfettered right, under the First Amendment, to represent clients before the USPTO without being subject to the conflict of interest statutes. This is incorrect. Appellant was paid to represent clients before the USPTO while simultaneously working as a government. (A.423). As a result, and as noted in the September 27, 2018 Order on Summary Judgment (A.414-40), the appropriate analysis of Appellant’s arguments are the government-employee speech cases rather than the more general “government-imposed speaker-burden” cases. *See Pickering v. Bd. of Educ.*, 391 U.S. 563 (1968); *Connick v. Myers*, 461 U.S. 138 (1983); *Rankin v. McPherson*, 483 U.S. 378 (1987); *United States v. Nat’l Treasury Emps. Union (“NTEU”)*, 513 U.S. 454 (1995); *Garcetti v. Ceballos*, 547 U.S. 410 (2006); *see also* A.428. This line of cases calls for “a balance between

the interests of the [employee], as a citizen, in commenting upon matters of public concern and the interest of the State, as an employer, in promoting the efficiency of the public services it performs through its employees.” *Rankin*, 483 US at 384 (alteration in original) (quoting *Pickering*, 391 U.S. at 568); *NTEU*, 513 U.S. at 465-66 (quoting *Pickering*, 391 U.S. at 568). “Congress may impose restraints on the job-related speech of public employees that would be plainly unconstitutional if applied to the public at large.” *NTEU*, 513 U.S. at 465; *see also* A.428.

In reaching the conclusion that was not deprived of his First Amendment rights when he was disciplined by the USPTO, the ALJ properly considered *Van Ee v. Envtl. Prot. Agency*, 55 F. Supp. 2d 1, 10 (D.D.C. 1999), *rev’d on other grounds*, 202 F.3d 296 (D.C. Cir. 2000). (A.428-29). In *Van Ee*, the district court held that an EPA employee could not act as a spokesperson for environmental groups of which he has been a long-time member in connection with such groups’ public comments on draft environmental impact statements and similar land-use plans issued by federal agencies other than EPA because doing so would violate a criminal conflict-of-interest statute, 18 U.S.C. § 205. 55 F. Supp. 2d at 16. Van Ee had argued that his communications with other agencies on his own behalf were not a violation of § 205, and alternatively, the statute was unconstitutional. *Id.* at 4.

In reaching its holding, the Court determined that the *Pickering/NTEU* standard was appropriate for reviewing that claim. *Id.* at 12. “The Court must balance plaintiff’s interests in commenting upon matters of public concern, against the government’s interest as employer in promoting the efficiency of its public services.” *Id.* (citing *Pickering*, 391 U.S. at 568). Applying the *Pickering* standard, the Court found that the harm that § 205 imposed on the plaintiff was “limited” because the statute did not prohibit him “from representing organizations under all circumstances, only before federal agencies” and he remained free to represent his own,

individual views to the government and anyone else of his choosing. *Id.* at 12-14. Further, the Court declared that § 205 “makes speech neither more expensive nor less remunerative,” nor does it “impose prohibitive conditions on speech.” *Id.* at 13.

Regarding the government interests, the Court in *Van Ee* noted the dual purposes of § 205—preventing the use of inside information by government employees to assist private interests, and protecting the integrity of governmental processes—the Court held that “prohibiting government employees from representing private individuals and entities in their dealings before the government clearly furthers the government’s interests in avoiding actual and apparent conflicts of interests.” *Id.* at 15 (citing *United States v. Bailey*, 498 F.2d 677 (D.C. Cir. 1974); *DeMarrias v. United States*, 713 F. Supp. 346 (D.S.D. 1989)). Additionally, the Court noted, “[t]he Supreme Court has recognized the important concerns of avoiding appearances of conflicts and upholding confidence in the integrity of governmental processes,” and “[p]rohibiting government employees from representing private individuals and entities in their dealings before the government clearly furthers the government’s interests in avoiding actual and apparent conflicts of interests.” *Id.* Accordingly, the Court found that “the government’s stated interests weigh heavily” and “[a]fter considering the competing interests, the Court determine[d] that § 205 is a permissible restriction on [the] plaintiff’s conduct.” *Id.* at 15-16.

The ALJ properly found *Van Ee* persuasive and the analysis applicable to Appellant’s case. (A.429). As in *Van Ee*, Appellant sought to represent applicants before the USPTO in matters unrelated to his work at another agency, in this case, the Navy. (*Id.*) Appellant’s harm from the conflict of interest statutes was deemed limited as he is not prohibited from representing people in other legal contexts—only before the federal government—and he is free to represent his own views to the federal government and anyone else. (*Id.*) On the other hand, the government has an

interest in avoiding actual and apparent conflicts of interest. (*Id.*) Consequently, the conflict of interest statutes were concluded to not be an unconstitutional restraint on Appellant's free speech. (*Id.*) Appellant faced discipline "not for engaging in protected expression or association but because he has run afoul of the USPTO's regulations for practicing law before it by not abiding by its rules of ethics." (A.430). The ALJ noted USPTO's compelling interest in regulating attorneys who appear before it and "[a]ny abridgment of the right to free speech is merely the incidental effect of observing an otherwise legitimate regulation." (*Id.*) (alteration in original); see *Lawline v. Am. Bar Ass'n*, 956 F.2d 1378, 1386 (7th Cir. 1992) (citing *Ohralik v. Ohio State Bar Ass'n*, 436 U.S. 447, 459, 467-68 (1978)). Noting that Congress empowered USPTO to regulate practitioners before it, the ALJ concluded that USPTO was "carrying out that authority by disciplining [Appellant]." (A.430). Consequently, the ALJ concluded that Appellant was not deprived of his First Amendment rights when he was disciplined by the USPTO.

There is no reason to disturb the ALJ's analysis and, consequently, the ALJ's conclusion are affirmed. Appellant was a government employee at the time that he was representing clients before the USPTO and thus he is subject to the conflict of interest statutes and the USPTO's disciplinary rules. Appellant was not disciplined for the content of his personal speech, which was not affected by the statutes or disciplinary rules here. Rather, his discipline stemmed from a certain subset of speech that violated those statutes and the USPTO's disciplinary rules that it was charged with implementing. Appellant still retained the ability to practice law in other contexts and freely express himself personally. Appellant's argument that his First Amendment rights have been abridged are without any merit or support and amount to nothing more than mere disagreement with the ALJ's Initial Decision. He has not carried his burden of proving his

affirmative defense by clear and convincing evidence and, as a result, the ALJ's conclusions with regard to Appellant's first amendment claims are affirmed.

## V. SANCTION

The ALJ's Initial Decision concluded that Appellant engaged in misconduct that violated multiple disciplinary rules, and imposed a 60-month suspension from the practice before the Office. (A.38). An ALJ initial decision that imposes exclusion or suspension must explain the reason for imposing such a sanction after consideration of the following four factors:

- (1) Whether the practitioner has violated a duty owed to a client, to the public, to the legal system, or to the profession;
- (2) Whether the practitioner acted intentionally, knowingly, or negligently;
- (3) The amount of the actual or potential injury caused by the practitioner's misconduct; and
- (4) The existence of any aggravating or mitigating factors.

37 C.F.R. § 11.54(b)(1)-(4).

The Director of the USPTO reviews an appeal from an ALJ Initial Decision on the record before the ALJ. *See* 37 C.F.R. § 11.55(f); *see also Marinangeli v. Lehman*, 32 F. Supp. 2d 1, 5 (D.D.C. 1998). Appellant does not challenge any aspect of the ALJ's analysis under § 11.54(b), including the ordered sanction. As a result, Appellant has waived any argument as to that analysis and order. *See* 37 C.F.R. § 11.55(b); *see also Impax Labs. Inc. v. Lannett Holdings Inc.*, 893 F.3d 1372, 1377 (Fed. Cir. 2018); *SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1319 (Fed. Cir. 2006).

In addition to Appellant waiving any challenge to the imposed sanction, a review of the ALJ's analysis supports the decision to suspend Appellant from practicing before the USPTO for 60 months. The ALJ conducted a 22-page review and analysis of the four factors set forth in 37



C.F.R. § 11.54(b). (A.15-38). Specifically, the ALJ concluded that Appellant violated the duties he owed to his clients, the public and the legal system, and the profession, found Appellant's misconduct was intentional and caused injury to his clients. (A.21-26). The ALJ identified six (6) aggravating and three (3) mitigating factors. (A.26-35). The ALJ's conclusion that Appellant should be suspended from practicing before the USPTO was thorough, well-supported by the facts, and in line with other similar disciplinary cases. The 60-month suspension from practicing before the USPTO is **AFFIRMED**.<sup>6</sup>

### **ORDER**

Having considered Appellant's appeal under 37 C.F.R. § 11.55 from the October 3, 2019 Initial Decision of the ALJ to suspend Appellant from practice before the Office in patent, trademark and other non-patent matters for 60 months, it is **ORDERED** that the ALJ's initial decision is **AFFIRMED**.

It is further:

**ORDERED** that Appellant is suspended from practice before the USPTO in patent, trademark, and non-patent matters for 60 months. Appellant shall remain suspended from the practice of patent, trademark, and other non-patent law before the USPTO until the OED Director grants a petition requesting Respondent's reinstatement pursuant to 37 C.F.R. § 11.60;

**ORDERED** that the OED Director give notice pursuant to 37 C.F.R. § 11.59 of the public discipline and the reasons for the discipline to disciplinary enforcement agencies in the state(s) where Appellant is admitted to practice, to courts where Appellant is known to be admitted, and to the public;

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<sup>6</sup> To the extent Appellant seeks a stay of discipline that request is denied. An appeal to the USPTO Director stays the effective date of sanction order. 37 C.F.R. §§ 11.55, 11.56. Thus, discipline has not yet been effected. Any appeal of the USPTO Director's decision to the U.S. District Court for the Eastern District of Virginia will not stay this order of discipline "except on proof of exceptional circumstances." 37 C.F.R. § 11.57; 35 U.S.C. § 32.

**ORDERED** that the USPTO shall dissociate Appellant's name from any Customer Number(s) and USPTO verified Electronic System account(s), if any;

**ORDERED** that Appellant shall not apply for a USPTO Customer Number, shall not obtain a USPTO Customer Number, nor shall he have his name added to a USPTO Customer Number, unless and until he is reinstated to practice before the USPTO; and

**ORDERED** that Appellant shall comply with the provisions of 37 C.F.R. § 11.58 governing the duties of disciplined practitioner.

**RECONSIDERATION AND APPEAL RIGHTS**

Any request for reconsideration of this decision must be filed within twenty (20) days from the date of entry of this decision pursuant to 37 C.F.R. § 11.56(c). Any request for reconsideration mailed to the USPTO must be addressed to:

David Berdan  
General Counsel  
United States Patent and Trademark Office  
600 Dulany St.  
P.O. Box 1450  
Alexandria, VA 22313-1450

A copy of the request must also be served on the attorney for the Director of Enrollment and Discipline:

Elizabeth Francis  
Counsel for the Director of Office of Enrollment and Discipline  
600 Dulany St.  
P.O. Box 1450  
Alexandria, VA 22313-1450

Any request hand-delivered to the USPTO must be hand-delivered to the Office of the General Counsel, in which case the service copy for the attorney for the Director shall be hand-delivered to the Office of Enrollment and Discipline.

If a request for reconsideration is not filed, and Appellant desires further review, Appellant is notified that he is entitled to seek judicial review on the record in the U.S. District Court for the Eastern District of Virginia under 35 U.S.C. § 32 “within thirty (30) days after the date of the order recording the Director’s action.” *See* E.D. Va. Local Civil Rule 83.5.

**IT IS SO ORDERED.**

02/04/2021

Date

*David L. Berdan*

David Berdan  
General Counsel  
United States Patent and Trademark Office

on delegated authority by

Andrew Hirshfeld  
Performing the Functions and Duties of the  
Under Secretary of Commerce for Intellectual Property  
and Director of the United States Patent and Trademark Office

**CERTIFICATE OF SERVICE**

I HEREBY CERTIFY that the foregoing Final Order was sent to the parties below, in the manner indicated:

**VIA E-MAIL and FIRST CLASS MAIL, RETURN RECEIPT REQUESTED:**

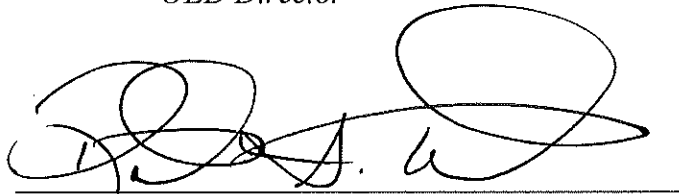
Mr. Kevin Correll  
83 Country Hill Lane  
North Kingston, RI 02852  
correllD201812@outloo.com  
*Respondent*

**VIA E-MAIL:**

Elizabeth Francis  
Elizabeth.Francis@uspto.gov  
SO-OEDcases@uspto.gov

*OED Director*

2/05/2021  
Date

  
United States Patent and Trademark Office

**SURVEY**

Complete and return this form, not a copy

**DATA SHEET - REGISTER OF PATENT ATTORNEYS AND AGENTS**

You must provide a correspondence / business name, address and telephone number given in the block below. Government employees must provide the name and address of the department or government agency in the correspondence/business name, address and telephone number. This will be published in the Government publication **Attorneys and Agents Registered to Practice Before the United States Patent and Trademark Office**. Also provide your home address and telephone number. Only one correspondence address and telephone number will be published. **COMPLETE ALL LINES**

NAME (Last First Middle name or initial)	REGISTRATION NUMBER
Mr. CORRELL KEVIN P	46641
Ms.	

CORRESPONDENCE / BUSINESS NAME (employer, corporation, law firm, or U.S. Government agency, etc.)

K. P. CORRELL + ASSOCIATES LLP

CORRESPONDENCE / BUSINESS ADDRESS (street, building, suite, etc.)

270 BELLEVUE AVE, # 326

CITY NEWPORT	STATE RI	ZIP CODE 02840	CORRESPONDENCE / BUSINESS PHONE AND AREA CODE 401 295 7377
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HOME ADDRESS

83 COUNTRY HILL LANE

CITY NORTH KINGS TOWN	STATE RI	ZIP CODE 02852	HOME PHONE AND AREA CODE 401 295 9046
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1. ☐ YES ☐ NO Do you wish to remain on the register? (If NO, do not complete Items 2 through 7. Sign, date and return this Data Sheet.)

2. Registration Status: ☒ ATTORNEY ☐ AGENT

3. If you are an attorney, please list all States of the United States in which you are a member in good standing of the bar of the highest court of the State:

MASS

4. ☐ YES ☒ NO In the last five (5) years, have you been suspended or disbarred from practice on ethical grounds by any duly constituted authority of a State of the United States, or in the case of a practitioner who resides in a foreign country or is registered under 37 CFR § 10.6(c) by any duly constituted authority of the country in which the practitioner resides? If YES, please attach a statement explaining when, where and the grounds for the disbarment or suspension.

5. ☐ YES ☒ NO In the last five (5) years, have you been convicted of a felony or misdemeanor (other than a traffic violation) by any federal, State or other law enforcement authority? If YES, please attach a statement giving the date, charge, and place of the offense and an explanation of the facts and circumstances leading to the conviction.

6. ☒ YES ☐ NO Are you an employee of the United States Government? PLEASE NOTE: U.S. Government employees are not available to accept private clients or to represent clients other than their agency before the United States Patent and Trademark Office. 18 U.S.C. § 205; 37 CFR § 10.10(c) and (d).

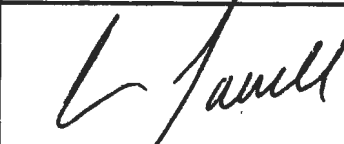
7. ☐ YES ☒ NO Are you a former patent examiner of the United States Patent and Trademark Office?

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AGENT: \_\_\_\_\_

ATTORNEY: \_\_\_\_\_ 12/12

I certify that each and every statement or representation in this Data Sheet is true and accurate (a willfully false certification is a criminal offense and is punishable by law [18 U.S.C. §. 1001]).



Signature of Practitioner

11/25/03

Date

(See reverse side of form for Privacy Act Statement)

Ex213

IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF VIRGINIA  
Alexandria Division

KEVIN P CORRELL,	)	
Petitioner,	)	
v.	)	
	)	Civil Action No.: 1:21-cv-898 (AJT/IDD)
UNDER SECRETARY OF COMMERCE	)	
OF INTELLECTUAL PROPERTY	)	
("DIRECTOR"),	)	
Respondent.	)	
_____	)	

**ORDER**

Petitioner Kevin P. Correll ("Petitioner") has filed two motions in which he seeks a preliminary injunction to postpone his suspension before the United States Patent and Trademark Office (USPTO): a Motion to Postpone Effective Date of Suspension By the Director Pending Final Judicial Review, [Doc. No. 2], and a Motion to Reverse the Director's Order for Suspension and/or Postpone Effective Date of Suspension By the Director Pending Final Judicial Review, [Doc. No. 9], (together the "Motions"). For the following reasons, the Motions are **DENIED**.

**I. BACKGROUND**

In 2002, while working for the United States Department of the Navy as an electrical engineer, [Doc. No. 15] at 11, Petitioner started his private law firm where he received compensation for legal services related to patent, copyright, and trademark matters. Federal employees are prohibited from representing private clients before the USPTO; and while working at both jobs, Petitioner completed a survey that contained a reminder about the prohibition against federal employees representing private clients before the USPTO. *Id.* at 12. Upon receiving written notice of Petitioner's representing private clients before the USPTO, the USPTO's Office of Enrollment and Discipline (OED) launched an investigation on February 9,

Fed. R. Civ. P. 65 authorizes a federal court to issue preliminary injunctions, which are extraordinary remedies “never awarded as of right.” *Winter v. Natural Res. Def. Council, Inc.*, 555 U.S. 7, 24 (2008) (citing *Munaf v. Geren*, 553 U.S. 674, 689–90 (2008)). To receive a preliminary injunction, the moving party must make a clear showing that (1) the plaintiff is likely to succeed on the merits of her case; (2) the plaintiff is likely to suffer irreparable harm in the absence of injunctive relief; (3) the balance of the equities tips in her favor; and (4) an injunction serves the public interest. *Id.* at 22.

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Regarding an employee's interests, the balancing test turns on whether the government employee engaged in a matter of public concern. In this case, intellectual property matters are of public concern and Petitioner retained his rights to speak on those matters. Regarding the government's interest, federal employees are prohibited from receiving compensation for any representation in which the government has a direct and substantial interest. 18 U.S.C. §§ 203(a), 205(a)(2). The government has a direct and substantial interest in patent applications. *See Kearney & Trecker Corp. v. Giddings & Lewis, Inc.*, 452 F.2d 579, 591 (7th Cir. 1971), *cert. denied*, 405 U.S. 1066 (1972). Furthermore, Congress is concerned with avoiding even the appearance of impropriety because even this can erode public trust in the integrity and legitimacy of government decision-making. *See generally Macrariello v. Summer*, 973 F.2d 295, 300 (4th Cir. 1992) (holding that a government employee's speech does not have to actually disrupt efficiency—reasonable fear of an adverse effect is sufficient); *Garcetti v. Ceballos*, 547 U.S. 410, 418 (2006) (highlighting the fact that public employees are often in trusted positions in society).

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when representing private clients in front of the USPTO. Petitioner was free to speak on patent and trademark matters otherwise, including in speeches, written blogs, and even representing private clients at the local and state level.

In assessing these various interests, the Court concludes that under the *Pickering* balancing test, Petitioner's First Amendment rights were not violated because there was no significant burden on Petitioner's First Amendment rights and the government's interest involved substantially outweighs whatever burden was placed on Petitioner's First Amendment rights. For these reasons, Petitioner has not shown that he is likely to succeed on his claims that First Amendment claims.

Petitioner has also failed to show that he is likely to succeed on his statute of limitations defense. In that regard, Petitioner contends the USPTO's institution of disciplinary proceedings against him was barred by the five-year statute of limitations provided in 28 U.S.C. § 2462. [Doc. No. 10] at 28-32. Petitioner is incorrect. 35 U.S.C. § 32 provides a limitations period of either ten years after the date of misconduct or one year after the date on which the misconduct forming the basis of the proceeding is made known to the USPTO. Petitioner's disciplinary proceedings began within one year after the date upon which the misconduct was made known to the USPTO. [Doc. No. 10] at 13-14. For that reason, Petitioner fails to make a showing that he is likely to succeed on the merits of his claim.

Nor had the Petitioner made the required showing that he is likely to suffer irreparable harm in the absence of injunctive relief; the balance of the equities tips in his favor; or an injunction serves the public interest. For the reason discussed above, Petitioner will not suffer any irreparable injury as his First Amendment rights are not violated by his suspension; and the balance of the equities and public interest favor the Government given the importance of the

**ORDERED** that Petitioner Correll’s Motions, [Doc. Nos. 2, 9], be, and the same hereby are, **DENIED**.

  
Anthony J. Trenga  
United States District Judge

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