

EXHIBIT M

Part 3 of 4

Applicable Ethics Rules

- ▶ 10.23(b)(5) - conduct prejudicial to the administration of justice.
- ▶ 10.23(c)(10) - knowingly violating or causing 37 CFR 1.56 to be violated.
- ▶ 10.23(c)(15) - signing a paper filed in the Office in violation of the provisions of 37 CFR 10.18.
- ▶ 10.77(b) - handling a legal matter without adequate preparation.
- ▶ 10.77(c) - neglect of an entrusted legal matter.
- ▶ 10.85 - requires a practitioner to represent a client within the bounds of the law.
- ▶ 10.85(a)(2) not “Knowingly advance a claim or defense that is unwarranted under existing law, except that a practitioner may advance such claim or defense if it can be supported by good faith argument for an extension, modification, or reversal of existing law.”



Monitoring Compliance – Reasonable Inquiry

- ▶ **Examples of conduct that may be perceived as failure to make reasonable inquiry:**
 - A reference material to patentability is buried among a large number of cumulative references.
 - Buried reference anticipates one or more claims.
 - Reasonable inquiry has not been shown.



Monitoring Compliance – Reasonable Inquiry

- ▶ **Examples of conduct that may be perceived as failure to make reasonable inquiry (continued):**
 - Application filed with claims that are anticipated by at least one publication authored by one of the inventors executing the 37 CFR 1.63 declaration or oath.
 - Reasonable inquiry has not been shown.



Monitoring Compliance – Improper Purpose or Delay

- ▶ **Examples of situations potentially involving improper purpose or delay**
 - Adding undue number of claims with multiple dependent claims.
 - Multiple dependency can add thousands of claims.
 - Each of must be examined for patentability.
 - May implicate violation of Disciplinary Rule 10.85(a)(1), to harass or injure another in reexamination situations.



Monitoring Compliance – Improper Purpose or Delay

- ▶ **Examples of situations potentially involving improper purpose or delay.**
 - **Filing an amendment, petition or other paper without required fee.**
 - **Insufficient funds.**
 - **Stop payment.**
 - **Lack of funds.**



Monitoring Compliance – Improper Purpose or Delay

- ▶ Examples of situations potentially involving improper purpose or delay.
 - Coinventing and claiming the client’s invention as the practitioner’s own invention.

•See *In re Lynt*,
<http://www.uspto.gov/web/offices/com/sol/foia/oed/disc/D05-08.pdf> (USPTO Dir. 2005); *Virginia State Bar v. Lynt*,
http://www.vsb.org/disciplinary_orders/lynt_opinion.pdf (Cir. Ct. Alex. 2004).



Monitoring Compliance – Improper Purpose or Delay

▶ **Examples of situations potentially involving improper purpose or delay.**

–Repeated issuance of bad checks.

- 10.23(b)(3) - illegal conduct involving moral turpitude.
- 10.23(b)(4) - dishonesty, fraud, deceit or misrepresentation.
- 10.23(b)(5) - conduct prejudicial to the administration of justice.
- 10.112(c)(2) - safekeeping of client funds.
- 10.112(a) - commingling of client funds.



Inequitable Conduct



The Duty of Disclosure

➤ 37 CFR 1.56(a) . . . Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section.



Individuals Having The Duty of Disclosure

- 37 CFR 1.56(c) . . . Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:
- (1) Each inventor named in the application.
 - (2) Each attorney or agent who prepares or prosecutes the application.

