

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

In the Matter of

Gerald E. Linden,

Respondent

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Proceeding No. D2022-10

FINAL ORDER

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

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

Jurisdiction

1. At all times relevant hereto, Respondent, a U.S. citizen residing in Romania, has been registered to practice before the USPTO in patent matters (Reg. No. 30,282). Therefore, Respondent is subject to the USPTO Rules of Professional Conduct, which are set forth at 37 C.F.R. §§ 11.101 through 11.901.

2. The USPTO Director has jurisdiction over this matter pursuant to 35 U.S.C. §§ 2(b)(2)(D) and 32 and 37 C.F.R. §§ 11.19, 11.20, and 11.26.

Joint Stipulated Facts

3. At all times relevant hereto, Respondent has been a patent agent registered to practice before the USPTO in patent matters.

4. Company 1 is engaged in the development of metal smartcard technology.

5. Inventor established Company 1 in 2007.
6. Inventor was the chief executive officer (and/or in other leadership roles) for Company 1 until July 2019 when Inventor resigned from Company 1.
7. Company 2 is also engaged in the development of metal smartcard technology.
8. Company 1 and Company 2 are parties to a patent license agreement whereby Company 1 agreed to license some of its patents relating to smartcard technology to Company 2.
9. Inventor has been Chief Technology Officer (“CTO”) for Company 2 since July 2019.
10. Respondent represented Company 1 in its patent matters from 2007 until April 2021.
11. After Inventor resigned from Company 1 in July 2019, Respondent chose to work with Inventor to assist Company 2 in developing a patent portfolio that differentiates from Company 1’s patents that Company 2 had licensed.
12. After Inventor left Company 1, Respondent actively represented Company 1 while simultaneously representing Inventor and Company 2. In August 2019, Respondent was still representing Company 1 in its patent matters.
13. On August 12, 2019, Respondent executed an “Attorney Engagement Letter” in which he agreed to provide patent-related legal services to Company 1. In the engagement letter Respondent represented that he had “no conflicts of interest with other clients of his.”
14. Respondent began filing patent applications on behalf of Inventor and Company 2 by, at least, August 12, 2019. On August 12, 2019, Respondent filed patent application A naming Inventor as the sole inventor. On August 12, 2020, Respondent filed patent application B naming Inventor as an inventor, naming Company 2 as the applicant, and claiming the benefit of the filing date of patent application A pursuant to 35 USC 119(e).

15. From August 12, 2019 to June 24, 2021, in an attempt to assist Company 2 in developing a patent portfolio that defines over patents owned by Company 1, Respondent filed and prosecuted patent applications, on behalf of Company 2, including some claims that were not patentably distinct from inventions disclosed in patent applications that Respondent filed and prosecuted on behalf of Company 1.

16. On August 14, 2020, Respondent filed patent application C naming Inventor as the sole inventor and Company 2 as the applicant. In the specification of patent application C, Respondent distinguishes the invention of patent application C from that disclosed in the publication of Company 1's patent application D. Respondent filed and prosecuted patent application D which eventually matured into a patent issued to Company 1.

17. Respondent continued to prosecute patent application C after the examiner determined that the publication of patent application D was prior art that was material to the patentability of patent application C.

18. Respondent did not obtain the informed consent of Company 1 to represent Inventor or Company 2. Company 1 asserts that had Respondent sought such consent, Company 1 would not have provided it.

19. On April 15, 2021, after learning of Respondent's relationship with Inventor and Company 2, Company 1 terminated its practitioner-client relationship with Respondent.

20. Respondent acknowledged that, at times relevant to this matter, he had no formal procedures in place to appropriately address conflicts of interests between clients.

Additional Considerations

21. Respondent has been a registered practitioner for over forty years and has no prior disciplinary history before the USPTO.

22. Respondent represents that (a) he now fully understands the ethical rules and limitations where a practitioner represents clients with conflicting interests and (b) he has implemented appropriate procedures for identifying and addressing conflicts of interests.

23. Respondent has been cooperative with OED's investigation, including providing timely, complete, and candid responses to requests for information.

Joint Legal Conclusions

24. Respondent acknowledges that, based on the information contained in the Joint Stipulated Facts, above, his conduct violated the following provisions of the USPTO Rules of Professional Conduct:

- a. 37 CFR §§ 11.104(a)(1) (a practitioner shall promptly inform the client of any decision or circumstance with respect to which the client's informed consent is required by the USPTO Rules of Professional Conduct); 11.107 (a practitioner shall not represent a client if the representation of one client will be directly adverse to another client or if there is a significant risk that the representation of the client will be materially limited by the practitioner's responsibilities to another client unless, *inter alia*, each affected client gives informed consent, confirmed in writing); and 11.109(a) (a practitioner who has formerly represented a client in a matter shall not thereafter represent another person in the same or substantially related matter in which that person's interests are materially adverse to the interests of the former client unless the former client gives informed consent, confirmed in writing) by, *inter alia*, (i) without obtaining informed consent of Company 1, filing and prosecuting patent applications on behalf of Company 2 containing claims that Respondent knew or reasonably should have known were not patentably distinct from patents issued to Company 1, that Respondent filed and prosecuted on behalf of Company 1 and (ii) in the specification of Company 2's patent application C, distinguishing the invention of patent application C from the invention of Company 1's patent application D, which Respondent filed and prosecuted, without obtaining the informed consent of Company 1; and
- b. 37 CFR § 11.116(a)(1) (practitioner shall not represent a client, or where representation has commenced, shall withdraw from the representation of a client if the representation will result in violation of the USPTO Rules of Professional Conduct or other law) by, *inter alia*, (i) without obtaining the informed consent of Company 1, filing and prosecuting patent applications on behalf of Company 2 containing claims that Respondent knew or reasonably should have known were not patentably distinct from Company 1's patents, which Respondent filed and

prosecuted; (ii) in the specification of Company 2's patent application C, distinguishing the invention of patent application C from the invention of Company 1's patent application D, which Respondent filed and prosecuted, without obtaining the informed consent of Company 1; and (iii) failing to withdraw from representation of Company 2 in patent application C after the USPTO determined that the publication of Company 1's patent application D, filed and prosecuted by Respondent, was material prior art with respect to claims in patent application C.

Agreed-Upon Sanction

25. Respondent freely and voluntarily agrees, and it is hereby ORDERED that:

- a. Respondent shall be reprimanded;
- b. The OED Director shall electronically publish this Final Order at the OED's electronic FOIA Reading Room, which is publicly accessible through the Office's website at: <https://foiadocuments.uspto.gov/oed/>;
- c. The OED Director shall publish a notice in the *Official Gazette* that is materially consistent with the following:

Notice of Reprimand

This notice concerns Gerald E. Linden, a registered practitioner (Reg. No. 30,282) and a U.S. citizen residing in Romania. Mr. Linden has been publicly reprimanded by the Director of the United States Patent & Trademark Office ("USPTO" or "Office") for violating 37 C.F.R. §§ 11.104(a)(1), 11.107, 11.109(a), and 11.116(a)(1).

Mr. Linden prepared and filed patent applications for Company 2, including claims that he knew, or reasonably should have known, were not patentably distinct from inventions in patents he previously obtained for Company 1. Mr. Linden acknowledged that (a) he was engaged by Company 2 to develop a portfolio of patents, some of which would be directed to "improvements" over the underlying patents owned by Company 1 and (b) he did not obtain the informed consent of Company 1 to provide such patent law services to Company 2.

Mr. Linden has been cooperative with OED's investigation, including providing timely, complete, and candid responses to requests for information

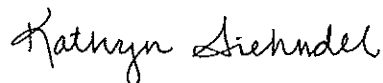
This action is the result of a settlement agreement between Mr. Linden and the OED Director pursuant to the provisions of 35 U.S.C. §§ 2(b)(2)(D) and 32 and 37 C.F.R. §§ 11.19, 11.20, and 11.26. Disciplinary decisions involving practitioners are posted for public reading at the Office of Enrollment and Discipline Reading Room accessible at: <https://foiadocuments.uspto.gov/oed/>;

d. Respondent has agreed to waive all rights to seek reconsideration of the Final Order under 37 C.F.R. § 11.56, waives the right to have the Final Order reviewed under 37 C.F.R. § 11.57, and waives the right otherwise to appeal or challenge the Final Order in any manner; and

e. The parties shall bear their own costs incurred to date and in carrying out the terms of the Agreement and this Final Order.

4/15/2022

Date



Kathryn Siehndel
Acting Deputy General Counsel for General Law
Office of the General Counsel
United States Patent and Trademark Office

on delegated authority by

Katherine K. Vidal
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and
Trademark Office