

**IN RE: ROBERT K. TENDLER****NO. BD-2014-044****S.J.C. Order of Term Suspension entered by Justice Hines on September 22, 2014.<sup>†</sup>****(Page Down to View Memorandum of Decision)**

---

<sup>†</sup> The complete Order of the Court is available by contacting the Clerk of the Supreme Judicial Court for Suffolk County.

COMMONWEALTH OF MASSACHUSETTS

SUFFOLK, ss.

SUPREME JUDICIAL COURT  
FOR SUFFOLK COUNTY  
NO. BD-2014-044

IN RE: ROBERT K. TENDLER

MEMORANDUM OF DECISION

Before me is bar counsel's Petition for Reciprocal Discipline pursuant to S.J.C. Rule 4:01, § 16, as appearing in 425 Mass. 1319 (1997), against Robert K. Tandler (respondent). I have reviewed the record, considered the arguments of counsel, and held a hearing. For the reasons set forth below, I conclude that the appropriate discipline is a six-month suspension from the practice of law in the Commonwealth.

1. Background and Procedural History.

On April 14, 2014, the Office of Bar Counsel filed a petition for reciprocal discipline following a Final Order of the United States Patent and Trademark Office (USPTO) suspending the respondent from the practice of law before the USPTO for a period of four years, with the right to petition for reinstatement after two years. This Court issued a show cause order, directing respondent to inform the court why reciprocal discipline was not warranted. The respondent argued that public reprimand was the appropriate

sanction. In response, bar counsel argued that the significance of respondent's conduct required a sanction greater than public reprimand, but reduced its request to a suspension of at least one year.

The facts underlying the USPTO suspension are drawn from the USPTO's Final Order<sup>1</sup> with additional background facts, not material to the outcome, as recited in Intellect Wireless, Inc. v. HTC Corp., 910 F. Supp. 2d 1056 (N.D. Ill. 2012), aff'd 732 F.3d 1339 (Fed. Cir. 2013).<sup>2</sup>

The respondent registered as a patent attorney in 1969.<sup>3</sup> In 2006, Daniel Henderson (client) hired respondent to take over the prosecution of at least twelve related patent applications then pending before the USPTO. In February, 2007, respondent prepared a Rule 131<sup>4</sup> declaration

---

<sup>1</sup>See Matter of Lebbos, 423 Mass. 753, 755 (1996) ("[W]e generally give effect to the disciplinary decisions of another jurisdiction without undertaking the often difficult and protracted task of redoing the inquiry which has already been concluded there").

<sup>2</sup>The disciplinary proceedings against respondent in the USPTO arose from this litigation in which the court indirectly implicated the respondent in a client's "inequitable conduct." Intellect Wireless, Inc. v. HTC Corp., 910 F. Supp. 2d 1056, 1072 (N.D. Ill. 2012), aff'd 732 F.3d 1339 (Fed. Cir. 2013).

<sup>3</sup>The record does not specify when the respondent was admitted to the bar of the Commonwealth.

<sup>4</sup>See 37 C.F.R. § 1.131 (2012), which governs the content of affidavits or sworn declarations of prior invention.

for one of the twelve patent applications, U.S. Patent Application No. 11/055,846 ('846 application) and submitted it to Henderson, who reviewed and signed the document. This Rule 131 declaration was "prepared to antedate a patent that had been cited as prior art against [the client's] '846 application."<sup>5</sup> To establish priority over this earlier patent, the declaration represented that the client "had actually reduced the claimed invention to practice and demonstrated a prototype of the claimed invention in July 1993."<sup>6</sup> Respondent filed the Rule 131 declaration on February 9, 2007. On February 10, 2007, the client reported to respondent that he had not actually reduced the invention to practice as he had stated in the affidavit submitted as part of the Rule 131 declaration filed the day before. Respondent's conduct, following this notice that the Rule 131 declaration was false, did not comply with his obligations as set forth in the USPTO Rules of Professional Conduct. See 37 C.F.R. §§ 11.101 through 11.901.

---

<sup>5</sup> Final Order, para. 8.

<sup>6</sup> Final Order, para. 5.

According to the Final Order, "there are strict requirements imposed on a practitioner who is aware that a false Rule 131 declaration has been submitted in a patent application that the practitioner is prosecuting on behalf of a client,"<sup>7</sup> none of which were met in the aftermath of the notice to respondent. Based on stipulated facts, respondent "did not advise the [USPTO] in writing of the existence of the inaccuracy and untruthfulness in the Rule 131 declaration, did not advise the [USPTO] in writing as to the actual facts concerning the inaccuracy and untruthfulness, and did not fully correct in writing the USPTO written record."<sup>8</sup> Based on the false and uncorrected Rule 131 declaration, the USPTO issued a patent to the client on the '846 application. The respondent stipulated that his conduct violated the USPTO Code of Professional Responsibility provision prohibiting an attorney from engaging in conduct that is prejudicial to the administration of justice.

Respondent now claims that he attempted to correct the error in oral communications with the USPTO. However, the

---

<sup>7</sup> See Final Order, para. 15(n), Notice of Suspension, citing Rohm and Haas Co. v. Crystal Chemical Co., 722 F.2d 1556, 1572 (Fed. Cir. 1983).

<sup>8</sup> Final Order, para. 10.

Final Order does not reference any such effort which, in any event, would be ineffective to correct the false Rule 131 declaration. The duty of a practitioner in these circumstances is to "expressly advise the [USPTO] of [the] existence [of a misrepresentation,] stating specifically wherein it resides;" and (2) advise the USPTO of the actual facts, "making it clear that further examination in light thereof may be required if any [USPTO] action has been based on the misrepresentation." Rohm and Haas Co. v. Crystal Chemical Co., 722 F.2d 1556, 1572 (Fed. Cir. 1983).

The Final Order also states that a "practitioner has an affirmative obligation to tell the patent examiner if a Rule 131 declaration is false or misleading."

The client's duplicity and respondent's abetting of that conduct came to light after the client brought suit claiming infringement of certain related patents.

Intellect Wireless, 910 F. Supp. at 1057. The defendants filed a counterclaim asserting unenforceability of the client's patents based on "inequitable conduct." Id. After a trial, the court entered judgment for the defendants, ruling that the patents granted to the client are unenforceable. Id. at 1074. The judge found that "[t]he evidence strongly supports the existence of an intent to deceive, rather than truth or an inadvertent

mistake, as the single most reasonable inference to be drawn from the facts." Id. at 1073. The USPTO's disciplinary action against respondent followed the court's opinion implicating him in the client's "inequitable conduct."<sup>9</sup>

2. Appropriate Sanction.

"A final adjudication in another jurisdiction that a lawyer has been guilty of misconduct . . . may be treated as establishing misconduct for purposes of a disciplinary proceeding in the Commonwealth." S.J.C. Rule 4.01, § 16 (5), as appearing in 425 Mass. 1319 (1997). "The judgment of suspension or disbarment shall be conclusive evidence of the misconduct unless . . . the procedure in the other jurisdiction did not provide reasonable notice or opportunity to be heard or there was significant infirmity of proof establishing the misconduct." S.J.C. Rule 4:01, §16 (3). See also Matter of Kersey, 444 Mass. 65, 68 (2005). Respondent claims neither procedural nor substantive errors in the prior discipline. Therefore, the only issue before me is the appropriate discipline to be

---

<sup>9</sup>Although the stipulated facts in the Final Order do not incorporate the court's findings of fact relating to respondent's conduct and I do not include those findings in the determination of the issues before me, I refer to these findings only to provide context for the USPTO's disciplinary action against the respondent.

imposed on the respondent. Bar counsel seeks a one-year suspension, while respondent argues that a public reprimand is all that is warranted.

While generally we defer to a prior finding of misconduct, we consider independently whether reciprocity requires the identical discipline. We may choose not to do so if "the misconduct established does not justify the same discipline in this Commonwealth." S.J.C. Rule 4:01, § 16 (3). Consideration of the appropriate sanction is informed by our rule that disciplinary action against an attorney should not be "markedly disparate from those ordinarily entered by the various single justices in similar cases." Matter of Alter, 389 Mass. 153, 156-158 (1983). The parties do not dispute this general principle, only its application to the facts of this case.

Bar counsel, relying primarily on Matter of Neitlich, 413 Mass. 416, 423 (1992), argues that respondent's conduct should be sanctioned as a misrepresentation to a tribunal for which a one-year suspension is the presumptive sanction. See also Matter of McCarthy, 416 Mass. 423, 431 (1993) ("Absent substantial mitigating factors ... the minimum sanction for [misrepresentation to a tribunal] is a one-year suspension from the practice of law"). In Matter of Neitlich, the court affirmed the imposition of a one-

year suspension where the attorney "perpetrated a fraud on the court and opposing counsel [in a post-divorce proceeding] by actively misrepresenting the terms of his client's pending real estate transaction." Id. at 416. Although respondent's conduct did not involve an intentional misrepresentation of facts, as in Matter of Neitlich, bar counsel submits that Neitlich provides the appropriate standard for discipline in this case. She argues that respondent's failure to fully disclose his client's false declarations is tantamount to an intentional misrepresentation, citing Matter of Griffith, 440 Mass. 500, 508 (2003) (noting that "material omissions, made in the course of affirmative discovery requests, constitute a form of misrepresentation").

Though Matter of Neitlich supports the presumptive one-year suspension as the starting point for determining the appropriate discipline in this case, it is not precisely comparable to the misconduct at issue here. The presumptive sanction may be more or less, depending upon the circumstances of the particular misconduct. Compare Matter of Budnitz, 425 Mass. 1018, 1019 (1997) (disbarring attorney who knowingly lied to grand jury and perpetuated lies in answer to complaint in disciplinary proceeding) with Matter of Finnerty, 418 Mass. 821, 829-830 (1994)

(imposing a six-month suspension for misrepresentation to the court of the value of the lawyer's assets that were filed on a personal financial statement in his own divorce action) and Matter of Mahlowitz, 1 Mass. Att'y Discipline Rep. 189, 193-195 (1979) (ordering public censure of any attorney who failed to disclose the nonexistence of a restraining order, which erroneously led to the judge's denial of an attachment order).

After review of our cases, none of which contain a precisely comparable fact situation, I am persuaded that a six-month suspension is warranted.<sup>10</sup> Respondent's conduct is not as egregious as that in Matter of Neitlich for which the presumptive one-year suspension was imposed but it is clearly more serious than that in Matter of Mahlowitz, supra. Thus, a sanction greater than public reprimand is appropriate where the respondent failed to completely and

---

<sup>10</sup> The only case cited by respondent that involved only a public reprimand, Matter of Kilduff, 27 Mass. Att'y Discipline Rep. 510 (2011), is not persuasive. In Matter of Kilduff, the attorney was disciplined for failure to file his tax returns but was not criminally convicted for such failure. Id. at 518-519. A single justice of this court imposed a public reprimand after determining that the appropriate sanction should be less than that typical for attorneys convicted of willfully failing to file a federal tax return, which "often resulted in six-month suspensions." Id. at 518. Other than the fact that the single justice imposed a public reprimand in Matter of Kilduff, respondent does not suggest how, if at all, the conduct in this case is sufficiently comparable to warrant the same discipline.

properly correct the record after knowing of the falsity in his submission. Having been a patent attorney for several decades, respondent knew or should have known of his obligation to submit a timely and complete correction of the Rule 131 declaration in the particular manner required.<sup>11</sup> It is undisputed that respondent's failure to honor his professional obligations thwarted the course of justice, causing harm that was redressed only after a trial.

The respondent relies on two cases involving discipline imposed by the USPTO, neither of which persuasively supports his argument. In Matter of Powers, 27 Mass. Att'y Discipline Rep. 717 (2011), Powers was suspended for a period of two years (with all but two months suspended) and imposed a probationary period for misrepresentations in connection with her effort to revive an abandoned patent application. Id. at 719, 725-726. In Matter of Massicotte, 29 Mass. Att'y Discipline Rep., No. BD-2012-055 (2013), Massicotte was suspended for a period of two years, but granted a stay as to all except the first two months. Attorney Massicotte unintentionally abandoned a patent application and thereafter misrepresented to the

---

<sup>11</sup> See Final Order "Notice of Suspension", citing Rohm and Haas Co., 722 F.2d at 1572.

USPTO that she never received a notice alerting her to the need for additional information. In both cases, the attorneys stipulated to conduct involving "dishonesty, deceit, fraud or misrepresentation." sanctionable under Mass. R. Prof. Conduct 8.4(c).<sup>12</sup> Matter of Powers, 27 Mass. Att'y Discipline Rep. at 726-727.

Respondent argues that his misconduct was much less egregious than that in Matter of Powers and Matter of Massicotte because his conduct was sanctioned under the federal equivalent of Mass. R. Prof. Conduct 8.4(d), which proscribes conduct "prejudicial to the administration of justice," instead of "dishonesty, fraud, deceit or misrepresentation." This argument is unavailing. As discussed above, respondent's omission is sufficiently serious to warrant the suspension imposed here, regardless of the specific violation cited by the USPTO.

3. Disposition. An order shall enter suspending the respondent from the practice of law in in the Commonwealth for six months.

---

<sup>12</sup>The decisions requiring Powers and Massicotte to serve only two months of their two-year suspensions were based on mitigating circumstances not present in this case.

By the Court

Geraldine S. Hines  
Geraldine S. Hines  
Associate Justice

Entered: September 22 , 2014  
24