

IN THE MATTER OF THE INTELLECTUAL PROPERTY REGULATION BOARD DISCIPLINARY PANEL

BETWEEN:

THE INTELLECTUAL PROPERTY REGULATION BOARD

(Complainant)

- and -

KEITH MCMURRAY BODEN

(Respondent)

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DETERMINATION OF DISCIPLINARY PANEL

09 – 10 MAY 2024

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DISCIPLINARY PANEL MEMBERS:

(PANEL CHAIR): Michael Glickman  
(LAY MEMBER): Mark Stobbs  
(PATENT ATTORNEY): Rhys Williams

LEGAL ADVISOR:

Francesca Keen

PRESENTING OFFICER:

Tim Grey (Counsel - Old Square Chambers)

RESPONDENT:

The Respondent did not attend, nor was he represented.

VENUE:

Heard remotely via video conferencing software

The Allegation (as amended):

*'It is alleged that:*

- 1. On 29 January 2013 you filed Divisional Application EP13153020.6 ("EP-Div 1") on instruction from Westman, Champlin & Koehler ("WCK") on behalf of MSP Corporation and thereafter prosecuted the application through the European Patent Office ("EPO").*
- 2. In your prosecution of EP-Div 1 you failed to:*
  - (a) Report to, or inform, WCK adequately and/or at all of:*

- i. *The totality of the amendments you made to the application in response to the EPO Written Opinion issued 6 March 2013;*
- ii. *The First Office Action issued by the EPO on 10 February 2014;*
- iii. *The Second Office Action issued by the EPO on 6 March 2015;*
- iv. *The Summons to Oral Proceedings issued on 28 February 2019 for proceedings due to be held on 5 July 2019;*
- v. *The Decision to Refuse the application and the Minutes of the Oral Proceedings both issued on 19 July 2019;*
- vi. *The Notice of Appeal you filed at the EPO on 30 September 2019;*
- vii. *The Board of Appeal's ("BoA") Summons to Oral Proceedings issued on 20 February 2020 for proceedings due to be held on 25 May 2020.*

*(b) Seek instructions and/or approval from WCK in relation to:*

- i. *All or some of the amendments you made to the application following receipt of the Written Opinion;*
- ii. *Your requests for an extension or extensions to the deadline set for reply to the first Office Action;*
- iii. *Your decision not to respond to the first Office Action by the extended deadline;*
- iv. *Your decision to rely on Further Processing to extend the deadline for reply to the first Office Action;*
- v. *Your amendments made to the application in response to the first Office Action;*
- vi. *Your request for an extension to the deadline set for reply to the second Office Action;*
- vii. *Your amendments made to the application in response to the second Office Action;*
- viii. *Your decision not to respond and/or provide a full response to the Summons to Oral Proceedings issued on 28 February 2019 for proceedings scheduled for 5 July 2019;*
- ix. *Your submissions of an appeal and/or the content of the Statement of Grounds of Appeal you filed on 29 November 2019;*
- x. *Your decision not to respond to the Preliminary Opinion by the BoA dated 25 February 2020.*

*(c) Acknowledge the summons to oral proceedings issued by EPO on 28 February 2019 and/or attend the oral proceedings held on 5 July 2019.*

*(d) Respond substantively to the Written Opinion accompanying the BoA's summons to oral proceedings due to be held on 25 May 2020.*

3. *On 3 July 2019, you wrote an email to WCK in which you sought to justify your non-attendance at the oral proceedings held in July 2019. In doing so you misrepresented the benefits of oral proceedings in advancing prosecution.*
4. *Your conduct at 3 above was:*
  - (a) Misleading;*
  - (b) Dishonest, in that you knew there were advantages in attending oral proceedings.*
5. *When submitting the Grounds of Appeal you failed to take instructions from WCK regarding amendments to the claims and/or whether to make auxiliary requests.*
6. *On 30 November 2017 you filed Divisional Application EP17204672.4 ("EP-Div 2") on instruction from WCK on behalf of MSP and thereafter prosecuted the application through the EPO.*
7. *In your prosecution of EP-Div 2 you failed to:*
  - (a) Report to, or inform, WCK adequately and/or at all of:*
    - i. Some or all of the amendments you made to the application in response to the EPO Written Opinion issued on or around 05 March 2018;*
    - ii. The change of examiner for the application;*
    - iii. The EPO's first Office Action issued 1 March 2019;*
    - iv. The response you filed in response to the EPO's first Office Action;*
  - (b) Seek instructions and/or approval from WCK in relation to:*
    - i. The amendments you made to the application in response to the EPO's Written Opinion;*
    - ii. Your decision not to respond to the first Office Action by the extended deadline;*
    - iii. Your decision to rely on Further Processing to extend the deadline for reply;*
    - iv. The filing of the response to the first Office Action and/or your amendments and arguments therein;*
8. *You failed to notify or provide payment of a refund you received from EPO to WCK in a reasonable time on the following occasions:*

(a) €1300 refunded on 21 March 2018;

(b) €1575 refunded on 3 May 2018;

(c) €1300 refunded on 16 May 2018.

9. *Your conduct at 2 to 4 and 7 above was contrary to Rules 5 and 6 of the Rules of Conduct for Patent Attorneys, Trade Mark Attorneys and Other Regulated Persons.*

10. *Your conduct at 5 above was contrary to Rules 4, 5 and 6 of the Rules of Conduct for Patent Attorneys, Trade Mark Attorneys and Other Regulated Persons.*

11. *Your conduct at 8 above was contrary to Rules 5, 6 and 11 of the Rules of Conduct for Patent Attorneys, Trade Mark Attorneys and Other Regulated Persons. '*

**Facts Proved:** Particulars: 1, 2(a)(i)-(v), 2(a)(vii), 2(b)(i)-(ii), 2(b)(iv)-(ix), 2(c), 2(d), 3, 4(a), 4(b), 5, 6, 7(a)(i), 7(a)(iii)-(iv), 7(b)(i), 7(b)(iii)-(iv), 9 and 10 (part-proved).

**Facts Not Proved:** Particulars: 2(a)(vi), 2(b)(iii), 2(b)(x), 7(a)(ii), 7(b)(ii), 8 and 11.

**Grounds:** Misconduct

**Sanction:** Removal

**Costs:** £47,533.12 awarded to IPReg

#### PRELIMINARY MATTERS:

##### Notice of Hearing:

1. The Disciplinary Panel (hereafter 'the Panel') was provided with the following documentation:

- i. statement of case – 3 pages;
- ii. hearing bundle – 456 pages;
- iii. service bundle – 28 pages;
- iv. case management directions – 2 pages;
- v. evidence matrix – 8 pages;
- vi. postponement decision – 2 pages;
- vii. draft costs schedule – 3 pages;
- viii. supplementary service bundle – 6 pages; and
- ix. costs bundle – 15 pages.

2. Mr Grey, appearing on behalf of the Complainant ('IPReg'), made submissions to the Panel that service of the Notice of Hearing (hereafter 'the Notice') had been properly effected.

3. The Panel noted that, from the evidence within the service bundle, the Notice was sent both by Royal Mail special delivery and email to the Respondent's registered address and

email address on 21 March 2024. The Panel also noted that, contained within the service bundle, there was a Royal Mail 'signed for' receipt, signed by 'BODEN', dated 22 March 2024.

4. Further, the Panel also noted, within the supplementary service bundle, an email from the Respondent to IPReg dated 06 May 2024, stating:

*'Your email has been brought to my attention. As made clear at the outset of proceedings (some four years ago), having retired from public practice. I would not be contesting charges (there being no point), or participating in proceedings (including the scheduled hearing). I offered at the outset to be removed from CIPA's register of patent agents, being the ultimate sanction, which had duly happened.*

*The entire process is a unilateral action on your part, which has no necessity given that I was not contesting the charges. I really do not understand why the matter has been analysed in detail, or indeed why a hearing is being scheduled. I presume that any application for costs will be made to the court, and I will challenge any such application'.*

5. The Panel accepted the advice of the Legal Advisor in relation to service of notice.
6. Having regard to: the requirements of Chapter 4, paragraph 3.2 of IPReg's Core Regulatory Framework; paragraphs 46 – 48 of the IPReg Standard Operating Procedure (hereafter 'the SOP'); and all of the information before it in relation to the service of Notice, the Panel was satisfied that the Respondent had been given proper notice of the hearing.

Application to proceed in the Respondent's absence:

7. Mr Grey made an application to proceed in the Respondent's absence. In doing so, Mr Grey referred the Panel to the Respondent's correspondence (outlined above) to IPReg from which it was clear that the Respondent was aware of the hearing and would not be attending.
8. The Panel accepted the advice of the Legal Advisor in relation to proceeding in absence. The Legal Advisor had drawn the Panel's attention to Chapter 4, paragraph 3.3.4 of IPReg's Core Regulatory Framework, which provides the Panel with a discretion to '*conduct the hearing in whatever manner it considers appropriate to ensure the fair and expedient hearing of the case*'. The Legal Advisor also drew the Panel's attention to the cases of: General Medical Council v Adeogba; General Medical Council v Visvardis [2016] EWCA Civ 162; and R v Jones (Anthony) [2003]1 AC 1, HL.

9. Having regard to the correspondence from the Respondent and the documentation contained within the bundles presented to it, the Panel was satisfied that the Respondent had been informed of the date, time and venue of the hearing and had been given sufficient notice and an opportunity to attend the hearing. The Panel determined that it was reasonable and in the public interest to proceed with the hearing for the following reasons:

- i. the Panel noted that from the email, dated 06 May 2024, it was clear that the Respondent was aware of the hearing and would not be attending;
- ii. there had been no application to adjourn and no indication from the Respondent that he would be willing to attend on an alternative date and therefore relisting this hearing would serve no useful purpose;
- iii. in light of the Respondent's email, the Panel was satisfied that it was reasonable to conclude that the Respondent's non-attendance was voluntary and therefore a deliberate waiver of his right to attend and participate in person;
- iv. the Panel recognised that there may be a disadvantage to the Respondent in not being present to challenge the evidence or to make oral submissions. However, the Panel noted that the Respondent had been provided with every opportunity to attend and engage in the hearing and had, in the Panel's view, chosen not to do so;
- v. IPReg had a professional witness present and willing to give evidence and in considering whether to proceed in absence, the Panel had regard to the inconvenience that might be caused to the witness should it adjourn the proceedings to an alternative date; and
- vi. this case had been referred to IPReg in 2020 and there was a public interest in the expeditious consideration of such cases.

10. Taking all of these factors into account, the Panel concluded that it was appropriate to proceed with the hearing in the Respondent's absence.

Application to amend the Allegation:

11. Mr Grey made an application to amend the Allegation, as follows:

- i. Particular 2(a)(vii) – to remove the date '17' and replace it with '20'; and
- ii. Particular 7(a)(i) – to remove the date '23' and replace it with '*on or around 5*'.

12. Mr Grey informed the Panel that the Respondent had been put on notice of IPReg's intention to apply to amend the Allegation in a letter dated 19 April 2024 and that he had not responded to IPReg's letter.
13. The Panel accepted the advice of the Legal Advisor and carefully considered the application to amend the Allegation. The Panel concluded, after reviewing each of the proposed amendments, that it would agree to the Allegation being amended because it considered that the proposed amendments did not seek to widen the scope of the Allegation, nor did they heighten the seriousness of the Allegation in any way. The proposed amendments were to correct dates within each Particular and, in the Panel's view, such amendment would not cause any injustice to the Respondent. The Respondent was put on notice of the proposed amendments on 19 April 2024 and had not objected to them.
14. The Panel therefore granted the application to amend the Allegation in the aforementioned terms.

Previous regulatory history:

15. Mr Grey submitted to the Panel that, further to discussions with the Legal Advisor on the morning of the hearing, it had come to IPReg's attention that reference had been made within the material before the Panel to the Respondent having a previous regulatory finding made against him. Mr Grey submitted, on IPReg's behalf, that this was an error and that this information ought properly to have been redacted from the material before the Panel. Mr Grey also submitted that further to the Panel having sight of this information, it did not preclude the Panel from continuing to hear the case as knowledge of the previous finding could properly be placed from the Panel's mind, when it considered the Allegation before it.
16. The Panel accepted the Legal Advisor's advice, which had, amongst other things, drawn the Panel's attention to the following case law: Porter v Magill [2002] 2 AC 357 and R (Mahfouz) v Professional Conduct Committee of the General Medical Council [2004] EWCA Civ 233.
17. The Panel considered whether it could place knowledge of the Respondent's regulatory history, outlined at pages 420 and 422 of the hearing bundle, from its mind when determining whether the Allegation had been made out by IPReg and determined that it could. Having regard to the information contained within the hearing bundle, the Panel considered that reference to the previous regulatory finding was limited in detail and scope and it noted that the full details of the case were not cited.

18. Furthermore, the Panel also considered that a fair minded and informed observer would not consider the Panel to be biased by knowledge of the information before it. In the Panel's view, a member of the public would be assured that, as an experienced professional regulatory panel, the Panel could place this information from its mind and place no weight upon it in its independent scrutiny of the evidence before it and when determining the Allegation.
19. Consequently, the Panel determined to proceed to hear the case, albeit it also acknowledged that it was less than best practice that the material had not been redacted prior to being provided to the Panel.

Background:

20. The case concerns work undertaken by the Respondent whilst a partner at Fry, Heath and Spence ('FHS') on behalf of a client in the USA. The client was represented by US patent attorneys Westman, Champlin and Koehler ('WCK') and in particular by Mr Peter Sawicki, a partner in that firm.
21. In March 2011, Mr. Sawicki instructed FHS to file a European patent application in his role as "Instructing Associate." Such a role, as explained by Mr. Sawicki in his witness statement, is common in patent work, where a domestic patent attorney instructs a patent attorney in another jurisdiction to prosecute a patent on behalf of their client. In this case he instructed FHS as the "foreign associate".
22. Initially the filing of the European patent was handled by Michael Downing, a partner at FHS. However, Mr. Downing left FHS in 2012 to set up his own firm and conduct of the prosecution of the patent application was passed to the Respondent.
23. The patent application was thereafter prosecuted as two separate divisional applications coming from a common parent application, both seeking to protect different aspects of the same invention. That invention related to different aspects of an electrical ioniser for aerosol charge conditioning and measurement. The applications were each given European Patent Office ('EPO') reference numbers as follows:
  - i) Parent Application: EP11001982.5;
  - ii) EP131153020.6 (app. 020.6) (EP-Div 1); and
  - iii) EP17204672.4 (app. 672.4) (EP-Div 2).
24. Application 020.6 (EP-Div 1) was prosecuted by the Respondent between 29 January 2013 and August 2020. In its early stages, the patent application proceeded in the normal way. However, after the Respondent took over conduct of the case it is alleged that he ceased



communicating effectively with WCK on the matter. It is also said that throughout March 2013 – May 2020, the Respondent provided almost no information or reporting to WCK of the actions and/or decisions and/or omissions he had taken in prosecuting the divisional application. It is also said, that during this period, the Respondent had no instructions from WCK to act or omit to act as he did.

25. Additionally, it is also alleged that the Respondent failed in his professional duty to the EPO, when he failed to acknowledge a summons to oral proceedings issued by the EPO on 28 February 2019 and in failing to attend the oral proceedings held on 05 July 2019 and that advice that he gave to WCK in respect of the attendance of that hearing on 03 July 2019 was dishonest.
26. It is further alleged by IPReg that the Respondent also failed in his duty to respond substantively to the written opinion accompanying the Board of Appeal ('BoA')'s summons to oral proceedings and that he took no instructions on the point, nor did he report the same in a timely fashion.
27. In respect of patent application 672.4 (EP-Div 2), this was issued on 30 November 2017 and purportedly prosecuted by the Respondent until WCK instructed Mr Holding. It is said that in the initial stages of the prosecution the Respondent appeared to be communicating well with WCK. However, by March 2018 the communication had largely ceased, with no communication of any sort until June 2020.
28. In respect of this patent application, it is said that the Respondent failed to report or inform WCK adequately (and in some cases at all); and that he failed to seek instructions or approval from WCK for those matters outlined in the Allegation.
29. On discovering that the Respondent had been prosecuting this patent application without reference to WCK, and without seeking any input from WCK, Mr Sawicki made the decision to instruct Mr Downing.
30. Following the move of the patent applications to Mr Downing, Mr Downing conducted a full file review, which it is said was hampered by the Respondent's initial failure to provide full files, something that was apparently latterly rectified by Mr Lock, another partner at FHS. However, on undertaking the file review, Mr Downing identified that refunded sums of money paid by EPO to FHS on behalf of WCK had not been paid to WCK. Mr Sawicki ultimately received a total of €3200 in refunded fees. The refunds had been paid to FHS on 21 March 2018, 03 May 2018 and 16 May 2018. These refunds were not paid on to WCK until Mr Downing identified the refunds and asked FHS for repayment. Those payments were only made in July 2020 leaving WCK and ultimately their clients without those funds for over two years.

### Summary of evidence:

31. IPReg relied upon the oral evidence of one expert witness, George Whitten, who was called to give evidence to the Panel.
32. IPReg also relied upon the witness statements and related exhibits of Mr Peter Sawicki and Mr Michael Downing in addition to the other material contained within the bundles presented to the Panel.

### Admissions:

33. The Panel noted that the Respondent, on more than one occasion in his correspondence with IPReg (31 January 2021 and 07 May 2024), had indicated that he did not wish to 'contest' the matters outlined within the Allegation.

34. The Panel had regard paragraph 47 of the SOP which states:

*'At any point after the formal allegation is served, the respondent may admit some or all of the allegations. Admitted allegations will be deemed proved.'*

35. The Panel considered the wording of the Respondent's correspondence carefully and after receiving and accepting legal advice from the Legal Advisor, the Panel determined that it could not treat the Respondent's correspondence as formal admissions to the Allegation. Having reviewed the statements and correspondence, the Panel was of the view that the Respondent's statements that he did not 'contest' the Allegation could not be considered as the same thing as admitting the underlying conduct contained within the Allegation and the Panel therefore considered that the Respondent's statements amounted to 'equivocal pleas'. The Panel therefore went on to determine whether IPReg had discharged its burden of proving each Particular of the Allegation.

### Second application to amend the Allegation:

36. Prior to the Panel retiring to consider the Allegation, Mr Grey made a further application to amend the Allegation in respect of Particular 8. Further to a Panel member's question, it was highlighted to IPReg that Particular 8 made reference to 'on behalf of MSP', but two of the payments did not appear, on the face of the documentation before the Panel, to relate to MSP, but to another company named Geacom. Consequently, Mr Grey made an application to remove the words 'on behalf of MSP'. He submitted that removal of these words from the Particular would not cause any injustice to the Respondent.

37. The Panel accepted the legal advice provided by the Legal Advisor.

38. The Panel considered the application and in doing so it noted that it had already determined that the Respondent had been put on notice of the hearing and that he had voluntarily absented himself from taking part in the hearing. In doing so, in the Panel's view, the Respondent had relinquished any opportunity that would have been afforded to him to make submissions upon matters which inevitably arise during the course of a regulatory hearing, such as the application made by Mr Grey to amend the Particular.
39. Nevertheless, and notwithstanding this, the Panel considered whether removing the words '*on behalf of MSP*' would widen the scope of the Particular faced by the Respondent, or would cause any injustice to him. In its consideration of the application, the Panel rejected Mr Grey's submission to it that removing the words '*on behalf of MSP*' did not widen the scope of the Particular. In the Panel's view, removal of the words did widen the scope of Particular 8, because it meant that two of the sub-particulars (8(b) and 8(c)), which on the face of the documentation presented to the Panel related to a company called Geacom, may fall outside the wording of the Particular as the wording of Particular 8 made reference only to MSP.
40. However, the Panel also considered that removal of the words '*on behalf of MSP*', would not cause any injustice to the Respondent because the Respondent had been put on notice of the Allegation and he had not sought to contest it. Further, in the Panel's view, whilst removing the words '*on behalf of MSP*' may bring payments to another third party (Geacom) under scrutiny, the nature of the Particular remained the same. Namely, that it was alleged by IPReg that the Respondent had failed to notify or provide a payment of a refund he had received from the EPO to WCK within a reasonable time.
41. Consequently, the Panel determined to allow the second application to amend the Allegation.

#### Findings and reasons on facts

42. The Panel was aware that the burden of proving the facts was on IPReg. The Respondent did not have to prove or disprove anything and the individual particulars of the Allegation could only be found proved if the Panel was satisfied on the balance of probabilities.
43. In reaching its decisions, the Panel took into account the oral and documentary evidence of the expert witness, Mr Whitten, the documentary evidence contained within all of the hearing bundles as well as the oral submissions made by Mr Grey.
44. The Panel accepted the Legal Advisor's advice which had, amongst other things, drawn to the Panel's attention the definition of integrity as set out in the case of *Wingate & Others*

v SRA [2018] 1 WLR 3969 and the test to be applied when considering dishonesty: Ivey v Genting Casinos (UK) LTD [2017] UKSC 67.

45. In its assessment of the evidence before it, the Panel considered that the witness evidence presented to it by IPReg, both oral and written, was credible, consistent and supported by numerous pieces of documentary evidence. In its consideration of the material before it, the Panel also noted that the Respondent had not sought to contest or challenge any of the material presented by IPReg.

Particular 1- PROVED

1. *On 29 January 2013 you filed Divisional Application EP13153020.6 (“EP-Div 1”) on instruction from Westman, Champlin & Koehler (“WCK”) on behalf of MSP Corporation and thereafter prosecuted the application through the European Patent Office (“EPO”).*

46. The Panel noted that it had before it documentary evidence, in the form of a letter from FHS to WCK dated 29 January 2013, which confirmed that Divisional Application EP13153020.6 was filed with the European Patent office, on ‘instructions’ from WCK. The Panel also noted that whilst this letter had been signed by an individual named Stuart Arnott of FHS, the Respondent had been ‘cc’d’, or copied, into the recipient list. Further, in its consideration of this Particular, the Panel also noted that, within the documentation presented to it, it had an ‘Acknowledgment of receipt’ of the filing of the Divisional Application, from the EPO, dated 29 January 2013 and that at the bottom of this document it was signed ‘K. Boden’ (the Respondent).

47. Consequently, based on the evidence presented to it, the Panel was satisfied on the balance of probabilities, that Divisional Application EP13153020.6 (‘EP-Div 1’), had been filed on instruction from WCK, on behalf of MSP Corporation and thereafter prosecuted through the EPO by the Respondent.

48. Accordingly, Particular 1 is proved.

Particular 2(a)(i):

2. *In your prosecution of EP-Div 1 you failed to:*

49. The Panel first had regard to the wording of the Particular 2. In doing so, it noted that Particular 2 alleged that the Respondent had ‘failed to’ undertake a number of tasks including reporting or informing WCK adequately or at all of a number of actions or tasks performed by him. The Panel first considered, therefore, whether the Respondent was under a duty to perform the tasks outlined within each Particular prior to determining whether he had or had not undertaken each task.

50. The Panel had regard to the evidence of Mr Whitten, who outlined the following in his expert report:

*'... [010] Proper regard of the circumstances therefore places on attorneys a duty to communicate with their client, report progress and act under instructions so that prosecution remains aligned with client's needs. Operating without instructions risks losing touch with changing circumstances and doing something contrary to the client's needs. Regular, open and clear communication between the attorney and the client is therefore necessary to ensure work is done to an acceptable standard...*

*...[094] I mentioned in the above introduction the duty attorneys have during prosecution to communicate with their client to ensure work is done to an acceptable standard. Reporting progress and seeking and acting under instructions enables the attorney to keep track of the client's changing circumstances and helps ensure work is done consistent with their needs and thus to an acceptable standard.*

*[095] Making even minor amendments to language risks changing the meaning of the claims. The effect can take years to be fully appreciated. Often there is no realisation until the patent is stressed, e.g. in infringement or validity proceedings. Failing to communicate with the client and acting without instruction increased the risk of this happening...'*

51. Further, the Panel also had regard to the witness evidence of Mr Sawicki, who stated the following:

*'... 8. It is therefore important to adhere to the reporting structure that I described above. It means that the original patent attorney (often referred to as the "Instructing Associate") has both oversight of all the patent applications in the family, and contact with the applicant to discuss their commercial needs. The obvious response to a specific objection from (say) the EPO might not in fact be the one that is needed. That response might leave the claims invalid in the light of a document that was cited elsewhere and which the European Patent Attorney does not know about. Alternatively, that obvious response might limit the scope of the patent so that it no longer covers the applicant's products, or (worse) their competitor's product.*

*9. Therefore, the expected process is that "foreign associate", i.e. the one in direct contact with the foreign Patent Office, is expected to report developments to the instructing associate, along with any advice specific to that Office, and seek their instructions. The instructing associate, in turn, considers the foreign associate's advice, formulates their advice to the applicant in light of any developments elsewhere in the family and their knowledge of the applicant's commercial priorities, and seeks the*

*applicant's instructions. Once the applicant has taken that advice into account and made a decision, the instructing associate will prepare instructions for the foreign associate and send these.*

*10. This process not only ensures that the work done in the foreign Patent Office meets the applicant's needs, it also guards against accidental harm being caused to the applicant's interests. The official files of patent applications are open to public inspection, and if one member of the family is enforced against an infringer, they are likely to look at the file and see what was said on behalf of the applicant elsewhere. It would be very embarrassing if a defendant in the US patent litigation were to produce a letter sent on behalf of the patentee to (say) the EPO which contradicted statements made on their behalf to the USPTO or to the US Court.*

*11. Thus, the foreign associate would not be expected to take steps on their own initiative without specific instructions from the instructing associate or approval of a proposed course of action. If an objection is raised by a Patent Office, the foreign associate needs to report this to their instructing associate and wait for instructions before lodging a response, for reasons set out above.*

*12. Generally, the foreign associate's report is expected to be sent within a reasonable degree of promptness, so as to allow time for a discussion between the instructing associate and the applicant within the deadline set by the Patent Office. The level of detail that is expected in the report varies according to the preferences of the instructing associate. Some prefer a full and detailed report including the foreign associate's assessment, others prefer just to be told that an objection has been raised (and what the deadline is). Others prefer a happy medium between the two in which aspects of the objection which are specific to the foreign patent office are explained in a little more detail whereas aspects which are in line with universal principles are not gone into in depth. What is essential, though is that the objection is reported accurately and the instructions are sought in a timely manner...'*

52. Having regard to the aforementioned, the Panel was satisfied that the Respondent was under a duty to communicate with, report to, inform and seek instructions or approval from those instructing him (WCK) of any progress, changes or updates to the patent applications for the reasons expressed by Mr Whitten and Mr Sawicki. The Panel also considered that the Respondent's duty encompassed and included each matter outlined within Particulars 2(a), 2(b) 7(a)(i), 7(a)(iii) and 7(b). Having established a duty, the Panel next considered whether the Respondent had failed to act, as alleged, in each of the Particulars.

Particular 2(a)(i) - PROVED

2. In your prosecution of EP-Div 1 you failed to:

(a) Report to, or inform, WCK adequately and/or at all of:

- i. The totality of the amendments you made to the application in response to the EPO Written Opinion issued 6 March 2013;

53. The Panel considered Particular 2(a)(i) and whether the Respondent had failed to report or inform, adequately or at all, WCK of the totality of the amendments he made to the application (EP13153020.6) in response to the EPO written opinion issued on 06 March 2013.

54. The Panel had regard to the evidence of Mr Sawicki. In doing so, it noted that he stated, within his witness statement:

*'Dr Boden's reporting did not meet these expectations in respect of the applications that he handled on our behalf. In relation to application EP13153020.6:*

- a. *Dr Boden reported to us on 8 January 2014 to confirm that a response had been filed at the EPO, and claiming to "enclose a copy of our reply to the Examination Opinion". In fact, he had made two replies to the EPO, once on 8 November 2013 and once on 7 January 2014. On each occasion he submitted amendments to the application. However, the documents which were attached to his reporting email of 8 January 2014 comprised a copy of a reply letter that he submitted on 8 November 2013 and a different set of amendments – which did not correspond to the amendments filed on 8 November 2013 or those filed on 7 January 2014 but which appeared to be a partially -retyped version of the latter. No mention was made in Dr Boden's report of the response that had been filed the preceding day or of why the response was made in two stages. As such, therefore the report was neither timely nor accurate.'*

55. The Panel also had regard to the correspondence authored by the Respondent to the EPO, dated 08 January 2014, which stated:

*'I can confirm that we have attended to payment of the examination and designation fees, and also filed a reply to the Examination Opinion, as per your instructions.*

*I enclose a copy of our reply to the Examination Opinion. When filing this reply, we amended the claims to follow the claims as originally filed, which inter alia reference signs...'*

56. The Panel also noted that there was nothing before it from the FHS file to indicate what attachments or amendments were sent to the EPO. Further, noting that Mr Sawicki had stated that he, as the client, did not know what was reported to the EPO, the Panel considered that the Respondent had failed in his duty to inform WCK of the totality of the amendments that he made to the application in response to the EPO Written Opinion issued on 06 March 2013.

57. Consequently, Particular 2(a)(i) is proved.

Particular 2(a)(ii)- PROVED

2. In your prosecution of EP-Div 1 you failed to:

(a) Report to, or inform, WCK adequately and/or at all of:

(ii) The First Office Action issued by the EPO on 10 February 2014;

58. Having already determined that the Respondent was under a duty to communicate with, report to and inform those instructing him (WCK) of any progress, changes or updates to the patent applications, the Panel went on to consider whether the Respondent had reported to or informed WCK, adequately or at all, of the first Office Action issued by the EPO on 10 February 2014.

59. The Panel had regard to the witness evidence of Mr Sawicki. The Panel noted that Mr Sawicki stated:

*'b. A further examination report was issued on 10 February 2014 but was never reported to us. Dr Boden applied to extend the deadline on 20 June 2014, but did not tell us that he had taken that step. He replied to the report on 2 December 2014 using additional time allowed by the EPO's 'further processing' procedure, without having sought our instructions, making arguments that we had not seen or approved and amending the application in a manner that we had not approved. Had he reported the examination report to us and sought out instructions, we would likely have instructed him to prepare a response – but we would have been able to prepare a response that met the client's needs and which responded to the examiner's objections, instead of the response that Dr Boden presented - which I would characterize as a minimal holding response in order to meet the deadline.'*

60. Having regard to the aforementioned evidence, the Panel was satisfied that the Respondent had failed to report at all to WCK the first Office Action issued by the EPO on 10 February 2014.

61. Consequently, Particular 2(a)(ii) is proved.



Particular 2(a)(iii)- PROVED

2. In your prosecution of EP-Div 1 you failed to:

(a) Report to, or inform, WCK adequately and/or at all of:

(iii) The Second Office Action issued by the EPO on 6 March 2015;

62. Having determined that the Respondent was under a duty to communicate with, report to and inform those instructing him (WCK) of any progress, changes or updates to the patent applications, the Panel went on to consider whether the Respondent had reported to or informed WCK, adequately or at all, of the second Office Action issued by the EPO on 06 March 2015.

63. The Panel had regard to the witness evidence of Mr Sawicki. The Panel noted that Mr Sawicki stated:

*'c. Again, on 6 March 2015 the EPO issued an examination report; this was not reported to us at all, nor was the extension of time sought on 16 July 2015. A detailed reply with arguments and amendments to the application was filed on 16 September 2015 without seeking our instructions or approval in advance.'*

64. Having regard to the aforementioned evidence, the Panel was satisfied that the Respondent had failed to report at all to WCK the second Office Action issued by the EPO on 6 March 2015.

65. Consequently, Particular 2(a)(iii) is proved.

Particular 2(a)(iv) - PROVED

2. In your prosecution of EP-Div 1 you failed to:

(a) Report to, or inform, WCK adequately and/or at all of:

(iv) The Summons to Oral Proceedings issued on 28 February 2019 for proceedings due to be held on 5 July 2019;

66. Having determined that the Respondent was under a duty to communicate with, report to and inform those instructing him (WCK) of any progress, changes or updates to the patent applications, the Panel went on to consider whether the Respondent had reported to or informed WCK, adequately or at all, of the Summons to Oral Proceedings on 28 February 2019 for proceedings to be held on 05 July 2019.

67. The Panel had regard to the Summons to Oral Proceedings to be held on 05 July 2019, dated 28 February 2019, contained within the bundle. The Panel also noted the contents of Mr Downing's letter, dated 13 July 2020, to FHS, which stated that the Respondent had only notified WCK on 3 July 2019 of the hearing listed on 05 July 2019, and that the EPO had issued this summons in February 2019.

68. The Panel again also had regard to the witness evidence of Mr Sawicki. The Panel noted that Mr Sawicki stated:

*'d. The EPO issued a Summons to Oral Proceedings on 28 February 2019, setting a date of 5 July 2019 for a hearing in respect of the application. This was not reported to us until 3 July 2019, at which point it was far too late for us to discuss the matter with the applicant and seek their instructions ahead of the hearing. No copy of the Summons was included, and Dr Boden did not advise of the nature of the objections that had been raised. We queried this, noting that we did not seem to have been advised of the Summons, and Dr Boden replied to say that he was travelling and would arrange for a copy of his earlier report to be forwarded. No such report has even been identified, and there was no such report in the copy of FH's file which was eventually provided to us after we complained.'*

69. Having regard to the aforementioned evidence the Panel noted that Mr Sawicki accepted that WCK had been informed by the Respondent of the Summons to Oral Proceedings on 03 July 2019. However, in the Panel's view, accepting the evidence of Mr Sawicki, two days' notice of a hearing was unacceptably late notice, given that the Respondent was put on notice of the hearing date by the EPO in February 2019. The Panel also determined that two days' notice was inadequate, as it did not provide WCK with sufficient time to take instructions from the ultimate client (the Applicant) and pass these to the Respondent. The Panel therefore considered that the Respondent had failed to adequately inform WCK of the Summons to Oral Proceedings issued on 28 February 2019 for proceedings due to be held on 5 July 2019.

70. Consequently, Particular 2(a)(iv) is proved.

#### Particular 2(a)(v) - PROVED

2. In your prosecution of EP-Div 1 you failed to:

(a) Report to, or inform, WCK adequately and/or at all of:

(v) The Decision to Refuse the application and the Minutes of the Oral Proceedings both issued on 19 July 2019;

71. Having already determined that the Respondent was under a duty to communicate with, report to and inform those instructing him (WCK) of any progress, changes or updates to

the patent applications, the Panel went on to consider whether the Respondent had reported to or informed WCK, adequately or at all, of the Decision to Refuse the application and the Minutes of the Oral Proceedings both issued on 19 July 2019.

72. The Panel had regard to the documentary evidence contained within the bundles and noted that it had been provided with a copy of the EPO's 'Decision to refuse the European Patent application' and the 'Minutes of the oral proceedings', both of which were dated 19 July 2019 and which noted that the Respondent had not attended the hearing. Upon examination of the 'Decision to refuse' letter, the Panel also noted that this document was addressed to the Respondent.

73. The Panel again noted the evidence of Mr Sawicki who stated:

*'Dr Boden did not appear at the Oral Proceedings set for 5 July 2019 and the application was refused in a Decision dated 19 July 2019. Dr Boden did not report the Decision refusing the application to us, until we happened to notice that it had been issued and asked him on 22 August 2019.'*

74. The Panel considered the wording of this Particular carefully; noting specifically that Mr Sawicki stated that the Respondent did inform WCK of the refusal on 22 August 2019, when asked about the matter. The Panel considered that having done so, it could not be said that the Respondent did not inform WCK of the outcome, but rather that he had not informed WCK adequately. In forming this view, the Panel noted that the filing of an appeal, following a refusal, was limited to a two-month time period and that the Respondent had failed to inform WCK of the refusal for over a month of that time frame (19 July 2019 – 22 August 2019). In the Panel's view, this could not be considered to be adequate reporting to a client when it was highly likely that instructions would be needed from the client, and also from WCK, as to next steps.

75. Having regard to the aforementioned therefore, the Panel considered that the Respondent had failed to adequately report the Decision to Refuse the application and the Minutes of the Oral Proceedings, both issued on 19 July 2019, to WCK, when he was under an obligation to do so.

76. Consequently, Particular 2(a)(v) is proved.

Particular 2(a)(vi) – NOT PROVED.

2. In your prosecution of EP-Div 1 you failed to:

(a) Report to, or inform, WCK adequately and/or at all of:

(vi) The Notice of Appeal you filed at the EPO on 30 September 2019;

77. As above, having already determined that the Respondent was under a duty to communicate with, report to and inform those instructing him (WCK) of any progress, changes or updates to the patent applications, the Panel went on to consider whether the Respondent had reported to or informed WCK, adequately or at all, of the Notice of Appeal he filed at the EPO on 30 September 2019.

78. The Panel noted that contained within the documentary evidence presented to it, it had a copy of the 'Notice of Appeal' dated 30 September 2019, signed by the Respondent. The Panel also noted that within Mr Sawicki's witness statement he stated:

*'f. He filed an Appeal, without consulting us as to the Grounds of Appeal. A Summons to Oral Proceedings before the Board of Appeal was issued on 20 February 2020, setting a date of 25 May 2020 for the hearing; this was not reported to us until 10 June 2020 by which time Dr Boden had secured a postponement to 17 August 2020 in view of Covid-19 difficulties.'*

79. The Panel also noted that in Mr Downing's letter to FSH, dated 13 July 2020, he stated:

*'...In the absence of any response, WCK contacted Keith on 22 August 2019 to note that the EPO appeared to have issued a Decision to refuse the application on 19 July 2019, and asking for details of any options for Appeal. Keith responded on 28 August 2019 to advise WCK of the deadlines for Appeal. An Appeal against the refusal was lodged in good time. The appeal is currently pending and a Summons to Oral Proceedings before the Board of Appeal was issued on 20 February 2020 but was not reported to WCK until 10 June 2020. After a little back and forth relating to Keith's availability and Covid-19-related travel restrictions, a date of 17 August 2020 has now been fixed to hear the appeal.'*

80. Having regard to the aforementioned, the Panel considered that it could not be satisfied, from the evidence presented to it, that WCK were not aware of the Notice of Appeal being filed, but rather, it appeared to the Panel, that WCK had not been consulted upon the Grounds of Appeal as opposed to the Notice of Appeal itself.

81. In forming this view, the Panel considered Mr Sawicki's evidence that the Respondent '*filed an Appeal, without consulting us as to the Grounds of Appeal*'. Further, combining this with Mr Downing's letter (dated 13 July 2020), which stated that there had been some consultation and interactions between the Respondent and WCK in respect of the Appeal on or around 28 August 2019, the Panel was not satisfied, to the requisite standard, that the Respondent had failed to report or inform either adequately or at all, WCK of the Notice of Appeal filed at the EPO on 30 September 2019.

82. In the Panel's view, further to the aforementioned evidence, WCK were aware, as of the 22 August 2019, that the EPO had refused the application and that there followed some interaction between the Respondent and WCK, on 28 August 2019, regarding the options for appeal. Whilst the Panel accepted Mr Sawicki's evidence that WCK had not been consulted on the Grounds of Appeal, the Panel noted that the wording of the Particular being considered related to the Notice of the Appeal and not the Grounds of Appeal and therefore the Panel were not satisfied that IPReg had discharged its burden of satisfying it that the Respondent had failed to report or inform, adequately or at all, WCK of the Notice of Appeal he filed on 30 September 2019.

83. Consequently, Particular 2(a)(vi) is not proved.

Particular 2(a)(vii) – PROVED.

*2. In your prosecution of EP-Div 1 you failed to:*

*(a) Report to, or inform, WCK adequately and/or at all of:*

*(vii) The Board of Appeal's ("BoA") Summons to Oral Proceedings issued on 20 February 2020 for proceedings due to be held on 25 May 2020.*

84. Having already determined that a duty arose to communicate with, report to and inform those instructing him (WCK) of any progress, changes or updates to the patent applications, the Panel went on to consider whether the Respondent had reported to or informed WCK, adequately or at all, of the Board of Appeals Summons to Oral Proceedings issued on 20 February 2020 for proceedings due to be held on 25 May 2020.

85. Having regard to the aforementioned evidence of Mr Sawicki, as outlined at Particular 2(a)(vi), that '*A Summons to Oral Proceedings before the Board of Appeal was issued on 20 February 2020, setting a date of 25 May 2020 for the hearing; this was not reported to us until 10 June 2020 by which time Dr Boden had secured a postponement to 17 August 2020 in view of Covid-19 difficulties*', the Panel was satisfied that, whilst it was clear that the Respondent had informed WCK of the Summons to Oral Proceedings before the Board of Appeal, this was not done until after the date of the hearing had occurred and the Respondent had secured a postponed hearing date of 17 August 2020. In the Panel's view, whilst it could not be said that the Respondent had failed to notify WCK, it was clear to the Panel, on the evidence presented to it, that the Respondent had failed to notify WCK in good time of the impending oral proceedings and therefore, in its view, the Respondent had failed to notify WCK adequately of matters that concerned the patent application.

86. Consequently, the Panel found Particular 2(a)(vii) proved.

Particular 2(b)(i) - PROVED

2. In your prosecution of EP-Div 1 you failed to:

(b) Seek instructions and/or approval from WCK in relation to:

- i. All or some of the amendments you made to the application following receipt of the Written Opinion;

87. Having determined that the Respondent was under a duty to seek instructions and/or approval from WCK, the Panel went on to consider whether he had done so in respect of all or some of the amendments he made to the application following receipt of the written opinion.

88. The Panel had regard to the analysis performed by Mr Whitten, in his review of the patent applications. In particular, the Panel noted that Mr Whitten stated:

*'[100] The first time the claims were amended in this divisional application was in relation to the Written Opinion, which Dr Boden reported in a timely manner. WCK replied with instructions. Dr Boden initially filed amendments exactly as provided to him together with patentability arguments based on WCK's instructions. However, he subsequently returned to the application and filed a supplementary amendment without the knowledge or approval of WCK.*

*[101] The supplementary amendment added reference materials. It seems that Dr Boden realised he had overlooked the need for these, which he then corrected. Dr Boden also changed area back to region. The claims from WCK talked about an 'area of the chamber'. However, in the original patent specification the description talks about 'regions of space in the ionization chamber' and makes no mention of areas...*

*[102] The EPO's attitude to the introduction of new words to a patent specification during prosecution is strict. As with clarity, this is because of the multi-language nature of the European patent system. The European Patent Office (EPO) is concerned that there may be subtleties of language in the change that could be lost on non-native English speaker. It is therefore likely the examiner would have picked up on the replacement of region with area and objected accordingly.*

*[103] Each of these changes – reference numerals and changing back to region anticipate and avoid further objections by the examiner. They are both in the client's interest and I believe it likely WCK would have considered them appropriate had they been the only changes and had Dr Boden subsequently brought [sic] the amendments to WCK's attention.*

*[104] However, Dr Boden went further by adding to the claim first and second regions. This is a significant change. Regardless of what the words actually mean, their addition amounts to a substantive amendment. Before the change the claim was silent on first and second regions. After the change, the claim defined a different apparatus, i.e. an apparatus with first and second regions. I also consider these words confusing because adding first and second obscures the references to higher and lower electric field intensities.*

*[105] Dr Boden had time to seek approval before filing his amendments. The deadline was 8-Nov-13 and WCK sent instructions on 17-Oct-13. Many practitioners work to deadlines (rather than ahead of them) and it is therefore not unusual to see a response filed on the due date. This approach risks running out of time to seek further instructions before responding, which is what appears to have happened here. Nevertheless, there were options. Dr Boden could have responded initially as he did with WCK's claims and, before filing the supplementary amendment, gone back to WCK for approval of the adjustments he wanted to make. Moreover, he could have relied on further processing to gain more time to seek clarification before filing any amendments. Dr Boden did none of this.*

*[106] When Dr Boden reported the filing of his response to WCK he said 'we amended the claims to follow the claims as originally filed, which inter alia included reference signs'. He made no mention of supplementary response (where the reference numerals were added) or to his correction to region and his revision to introduce first and second regions. The reporting letter was therefore far from complete.*

*[107] The expectation between Fry Heath & Spence LLP (FHS) and WCK was for FHS only to act under instructions. There is no reason to assume that, absent any comments, WCK would have carefully considered the amendments reported to them. They would not expect significant amendments to be made or go unreported. Even if ECK considered the addition of reference numerals and correction of region to be acceptable, Dr Boden's unilateral introduction of first and second regions and subsequent silence did not meet his duty to report and act under instructions. I do not believe WCK would have found this acceptable for reasons I will not explain...'*

89. The Panel also noted, from the documentary evidence furnished to it, that Mr Sawicki, in an email dated 17 October 2013, did provide some instructions to the Respondent. However, it also had regard to Mr Sawicki's written statement to it which stated:

*...15 a. Dr Boden reported to us on 8 January 2014 to confirm that a response had been filed at the EPO, and claiming to “enclose a copy of our reply to the Examination Opinion”. In fact, he had made two replies to the EPO, once on 8 November 2013 and once on 7 January 2014. On each occasion he submitted amendments to the application. However, the documents which were attached to his reporting email of 8 January 2014 comprised a copy of a reply letter that he submitted on 8 November 2014 and a different set of amendments – which did not correspond to the amendments filed on 8 November 2013 or those filed on 7 January 2014 but which appeared to be a partially-retyped version of the latter. No mention was made in Dr Boden’s report of the response that had been filed the preceding day or of why the response was made in two stages. As such, therefore, the report was neither timely or accurate...’*

90. Having considered the evidence before it, the Panel was satisfied that the Respondent had sought some instructions and approval from WCK in relation to some of the amendments that he made to the application following receipt of the Written Opinion. However, the Panel also concluded that the Respondent had not sought instructions or approval in respect of all of the amendments he made, as he had an obligation to do.

91. Consequently, Particular 2(b)(i) is proved.

Particular 2(b)(ii) - PROVED

2. In your prosecution of EP-Div 1 you failed to:

(b) Seek instructions and/or approval from WCK in relation to:

- i. Your requests for an extension or extensions to the deadline set for reply to the first Office Action;

92. Having determined that the Respondent was under a duty to seek instructions and/or approval from WCK, the Panel went on to consider whether he had done so in respect of his requests for an extension or extensions to the deadline set for reply to the first Office Action.

93. The Panel considered Mr Sawicki’s evidence in this respect and noted that he stated:

*‘15 b. A further examination report was issued on 10 February 2014 but was never reported to us. Dr Boden applied to extend the deadline on 20 June 2014, but did not tell us that he had taken that step. He replied to the report on 2 December 2014 using additional time allowed by the EPO’s ‘further processing’ procedure, without having sought our instructions, making arguments that we had not seen or approved and amending the application in a manner that we had not approved.*



*Had he reported the examination report to us and sought our instructions, we would likely have instructed him to prepare a response – but we would have been able to prepare a response that met the client’s needs and which responded to the examiner’s objections, instead of the response that Dr Boden presented – which I would characterize as a minimal holding response in order to meet the deadline’.*

94. Having regard to the aforementioned, the Panel determined that the Respondent had failed to seek instructions and/or approval from WCK in relation to his request for an extension to the deadline set for reply to the first Office Action.

95. Consequently, Particular 2(b)(ii) is proved.

Particular 2(b)(iii) - NOT PROVED

2. In your prosecution of EP-Div 1 you failed to:

(b) Seek instructions and/or approval from WCK in relation to:

- i. Your decision not to respond to the first Office Action by the extended deadline;

96. Having already determined that a duty arose to seek instructions and/or approval from WCK, the Panel went on to consider whether he had done so in respect of a decision not to respond to the first Office Action by the extended deadline. In doing so, the Panel had regard to the wording of this Particular and noted that it included the word ‘decision’. In the Panel’s view, and in giving the word ‘decision’ its ordinary natural meaning, this Particular required the Panel to conclude that the Respondent had made a conscious choice to do, or not to do, a particular act or deed.

97. In respect of a decision not to respond to the first Office Action by the extended deadline, the Panel noted Mr Whitten stated:

*‘[110] Dr Boden put off replying to the Office Action for as long as he could. He requested an extension to the period set for reply to the Office Action and then allowed the application to go into further processing by failing to respond by the extended due date. In due course the EPO issued a further processing letter setting a final date for the application to be reinstated.’*

98. The Panel also had regard to Mr Downing’s letter to FHS, dated 13 July 2020, in which he stated:

*‘An examination report was issued on 10 February 2014 with a four-month term for replying, in respect of which an extension of time was requested on 20 June 2014.’*

*No reply was lodged in time, and so on 22 September 2014 the EPO indicated that the application was to be deemed abandoned. A response was eventually filed on 2 December 2014, together with a separate request for further processing, and amendments to the claims along with arguments in support. The request for further processing was accepted. None of this was reported to WCK.'*

99. Having regard to the aforementioned, the Panel was not satisfied that IPReg had proved, to the requisite standard, that the Respondent had made a conscious 'decision' not to respond to the first Office Action. Whilst the Panel noted that Dr Whitten's statement, as outlined above, seemed to infer that the Respondent had made a conscious act to '*put off replying to the Office Action*', having regard to the totality of the evidence presented to it, the Panel considered that Respondent's management of the patent applications was somewhat chaotic and at times the Panel considered he was responsive to actions required of him, rather than proactive and the Panel was not satisfied on the balance of probabilities that the Respondent had made a deliberate 'decision' not to act by the deadline and rely on 'further processing' provisions available to him, as opposed to simply missing the deadline.

100. Consequently, Particular 2(b)(iii) is not proved.

#### Particular 2(b)(iv) - PROVED

2. In your prosecution of EP-Div 1 you failed to:

(b) Seek instructions and/or approval from WCK in relation to:

(iv). Your decision to rely on Further Processing to extend the deadline for reply to the first Office Action;

101. As before, having determined that a duty arose to seek instructions and/or approval from WCK, the Panel went on to consider whether he had done so in respect of a decision to rely on further processing to extend the deadline for reply to the first Office Action. Similar to Particular 2(b)(iii), the Panel again noted that the wording of this Particular also included the word 'decision' and the Panel applied the same interpretation of the word to its assessment of this Particular. Namely, that this Particular required the Panel to conclude that the Respondent had made a conscious choice to do, or not to do, a particular act or deed.

102. The Panel noted that contained within the material provided to it, there was a letter, dated 02 December 2014, from the Respondent to the EPO in which he stated:

*'I now hereby request further processing of this application (under the provisions of Article 121 EPC). The fee for further processing is being paid separately from our*

*deposit account (no 28050107). In the unlikely event that payment is not received by the due date, then this letter should be taken as confirmation of instructions to debit out deposit account by the necessary monies'.*

103. The Panel also noted that it had a copy of the 'Online Fee Payment' made by FHS to the EPO.

104. The Panel also noted that Mr Sawicki, in his witness statement stated:

*'b. A further examination report was issued on 10 February 2014 but was never reported to us. Dr Boden applied to extend the deadline on 20 June 2014, but did not tell us that he had taken this step. He replied on the report on 2 December 2014 using additional time allowed by the EPO's 'further processing' procedure, without having sought our instructions, making arguments that we had not seen or approved and amending the application in a manner that we had not approved. Had he reported the examinations report to us and sought our instructions, we would likely have instructed him to prepare a response – but we would have been able to prepare a response that met the client's needs and which responded to the examiner's objections, instead of the response that Dr Boden presented – which I would characterize as a minimal holding response in order to meet the deadline.'*

105. Having regard to the aforementioned evidence, the Panel was satisfied that the Respondent had taken deliberate steps to rely upon 'further processing' to extend the deadline for reply to the first Office Action and that in doing so he had made a conscious decision for which he had not sought instructions or approval from WCK.

106. Consequently, Particular 2(b)(iv) is proved.

#### Particular 2(b)(v) - PROVED

2. In your prosecution of EP-Div 1 you failed to:

(b) Seek instructions and/or approval from WCK in relation to:

(v) Your amendments made to the application in response to the first Office Action;

107. Having determined that a duty arose to seek instructions and/or approval from WCK, the Panel went on to consider whether he had done so in respect of his amendments made to the application in response to the first Office Action.

108. The Panel noted that it had been furnished with two letters from the Respondent to the EPO, both dated 2 December 2014. The Panel noted from each of these documents that amendments were put forward by the Respondent to the EPO in respect of the patent application.

109. The Panel next had regard to Mr Sawicki's evidence, as outlined above, in its consideration of the earlier Particulars and noted that Mr Sawicki confirmed that the Respondent had made no mention in his report to WCK, *'of the response that had been filed the preceding day or of why the response was made in two stages. As such, therefore, the report was neither timely nor accurate.'*

110. Having regard to the evidence presented to it by IPReg, the Panel was satisfied that the Respondent had failed to seek instructions and/or approval from WCK in relation to his amendments that he made to the application in response to the first Office Action.

111. Consequently, Particular 2(b)(v) is proved.

Particular 2(b)(vi) and (vii) - PROVED

2. In your prosecution of EP-Div 1 you failed to:

(b) Seek instructions and/or approval from WCK in relation to:

(vi) Your request for an extension to the deadline set for reply to the second Office Action;

(vii) Your amendments made to the application in response to the second Office Action;

112. Having already determined that a duty arose to seek instructions and/or approval from WCK, the Panel went on to consider whether the Respondent sought instructions or approval in respect of his request for an extension to the deadline set for reply for the second Office Action or his amendments made to the application in response to the second Office Action.

113. The Panel noted that within the documentation furnished to it there was a copy of a letter, dated 16 July 2015, in which the Respondent wrote to the EPO and stated *'I hereby request a two-month extension to the term for filing a reply to the Examination Report'*. The Panel also noted that the material furnished to it included evidence of the amendments made to the application in response to the second Office Action. The Panel was therefore satisfied that the Respondent had made a request to the EPO for an extension to the deadline set for reply to the second Office Action and that he had made amendments to the application in response to the second Office Action.

114. The Panel next had regard to the evidence of Mr Sawicki, in which he stated:

*'c. Again, on 6 March 2015 the EPO issued an examination report; this was not reported to us at all, nor was the extension of time sought on 16 July 2015. A detailed reply with arguments and amendments to the application was filed on 16 September 2015 without seeking our instructions or approval in advance.'*

115. Having regard to the aforementioned evidence, the Panel determined that the Respondent did fail to seek instructions or approval from WCK in respect of his request for an extension to the deadline set for reply to the second Office Action and that he also failed to seek instructions or approval from WCK in respect of the amendments he made to the application in response to the second Office Action.

116. Consequently, Particulars 2(b)(vi) and 2(b)(vii) are proved.

Particular 2(b)(viii) – PROVED

2. In your prosecution of EP-Div 1 you failed to:

(b) Seek instructions and/or approval from WCK in relation to:

(viii) Your decision not to respond and/or provide a full response to the Summons to Oral Proceedings issued on 28 February 2019 for proceedings scheduled for 5 July 2019;

117. Having determined that a duty arose to seek instructions and/or approval from WCK, the Panel went on to consider whether the Respondent sought instructions or approval in respect of his decision on 28 February 2019 for proceedings scheduled for 5 July 2019. The Panel again noted that this Particular also included the word ‘decision’ and the Panel applied the same interpretation of the word as it had done with the previous Particulars.

118. The Panel noted that it had before it a letter dated 28 February 2019, from the EPO to the Respondent, which was titled ‘Summons to Oral Proceedings’. The Panel also noted that this same letter stated ‘*You are hereby summoned to attend the oral proceedings arranged in connection with the above-mentioned European patent application*’ and that the letter also outlined the date of the hearing as the 05 July 2019. The Panel also noted that the letter had provided a final date for making written submissions and/or amendments of the 05 June 2019.

119. The Panel had regard to Mr Sawicki’s evidence to it that the EPO issued the Summons to Oral Proceedings on 28 February 2019, setting a date for the hearing of 05 July 2019, and that this information was not reported to WCK, by the Respondent, until 03 July 2019.

120. The Panel also had regard to Mr Downing’s letter to FHS, dated 13 July 2020, in which Mr Downing stated:

*‘...No acknowledgement was made to the EPO of the Summons (despite reminders), and no written submissions were lodged in advance of the Oral Proceedings. This was first reported to WCK via email on 3 July 2019, two days before the Oral proceedings date and after the deadline for written submissions had passed. No mention was made of the preceding two examination reports, and*

*Keith's advice was that the Oral Proceedings should not be attended as his "experience at oral proceedings before the Examining Division is that it is increasingly difficult to get the Examining Divisions to re-consider matters in any substantive or constructive way to oral proceedings, and that we have far more success on appeal...'*

121. Having regard to the aforementioned, the Panel considered that it was clear to it that the Respondent was aware of the Summons to Oral Proceedings as of the 03 July 2019 at the very latest, having notified WCK of the hearing date of the 05 July 2019, on 03 July 2019. It was also clear to the Panel, on the evidence available to it, that the Respondent had been provided with a number of reminders to respond to the Summons to Oral Proceedings by the EPO and the Respondent did not do so. In this regard, the Panel considered that it was highly likely therefore that the Respondent was aware of the Summons to Oral Proceedings, earlier than the 03 July 2019. Even then, there was still an opportunity to seek an adjournment or, albeit very late, attend to make representations. The Respondent did not do so and his email of 03 July 2019, moreover, suggested that there was no point in doing so and gave WCK inadequate time to consider the issue or take instructions. Having regard to this, the Panel concluded that the Respondent made a conscious decision not to respond to the EPO Summons to Oral Proceedings. The Panel also concluded, relying on Mr Sawicki's evidence, that the Respondent failed in his duty to seek instructions and or approval from WCK in respect of his decision not to respond to the Summons to Oral Proceedings issued on 28 February 2019 for proceedings scheduled for 05 July 2019.

122. Consequently, Particular 2(b)(viii) is proved.

Particular 2(b)(ix) –PROVED

2. In your prosecution of EP-Div 1 you failed to:

(b) Seek instructions and/or approval from WCK in relation to:

(ix) Your submissions of an appeal and/or the content of the Statement of Grounds of Appeal you filed on 29 November 2019;

123. Having already determined that a duty arose to seek instructions and/or approval from WCK, the Panel went on to consider whether the Respondent sought instructions or approval in respect of his submissions of an appeal and/or the content of the Statement of Grounds of Appeal filed on 29 November 2019.

124. The had regard to a letter dated 29 November 2019 from the Respondent addressed to the EPO. The Panel noted that appended to this letter, was a document titled 'Grounds of Appeal'.

125. The Panel also had regard to its earlier findings in respect of Particular 2(a)(vi) above and the evidence of Mr Sawicki's (also outlined above), and it noted that Mr Sawicki had been clear in his evidence to it that the Respondent had filed an appeal without consulting WCK as to the Grounds of Appeal, which the Panel had also already accepted as credible and reliable evidence.
126. The Panel took the term "submissions of an appeal" to mean the actual lodging of a Notice of Appeal, as opposed to the content of the Grounds of Appeal. The Panel had regard to an email from the Respondent to WCK dated 28 August 2019 in which the Respondent advised about the dates for an appeal. In that email, he indicated that '*we shall take no action absent contrary instructions.*' Since, as noted above, an appeal was lodged on 29 November 2019, the Panel could not be satisfied that the Respondent had not received instructions to submit an appeal.
127. Taking the above into account, the Panel was satisfied that the Respondent had failed to seek instructions and approval from WCK in relation to the content of the Statement of Grounds of Appeal, filed on 29 November 2019, but not that he failed to seek instructions and/or approval from WCK in relation to the submission of the Notice of Appeal itself.
128. Consequently, Particular 2(b)(ix) is proved.

Particular 2(b)(x) – NOT PROVED

2. In your prosecution of EP-Div 1 you failed to:

(b) Seek instructions and/or approval from WCK in relation to:

(x) Your decision not to respond to the Preliminary Opinion by the BoA dated 25 February 2020.

129. Having determined that a duty arose to seek instructions and/or approval from WCK, the Panel went on to consider whether the Respondent sought instructions or approval in respect of his decision not to respond to the Preliminary Opinion by the BoA, dated 25 February 2020.
130. Again, as it had with earlier Particulars, the Panel noted that this Particular contained the word 'decision', meaning that the Panel again needed to consider whether the Respondent had made a conscious choice to act or not to act.
131. The Panel noted that it had been provided with a copy of the BoA's Preliminary Opinion, dated 25 February 2020. The Panel noted within this opinion it stated the following:

*'10. If the appellant, in light of this assessment, does not wish to pursue further the appeal, the Board draws the appellant's attention to Rule 103(2)(a) EPC and the*

*possibility of a 50% reimbursement of the appeal fee in the event that the appeal is withdrawn.*

*11. Should the appeal be pursued further, the appellant's attention is directed to the fact that the admittance of new submissions, in particular of new requests, facts and evidence, is subject to the Board's discretion in accordance with Article 114(2) EPC, with Article 12(4) RPBA 2007 and with Article 13(1) and (2) RPBA 2020.'*

132. The Panel also had regard to a letter from the Respondent to the EPO, dated 25 February 2020, in which the Respondent outlined the following:

*'I refer to the Summons to oral proceedings as issued in connection with this application.*

*Unfortunately, I am not able to attend oral proceedings on 25 May 2020, as proposed. I am away on vacation, running in a 10k on 23 May 2020 and a half-marathon on 24 May 2020 in Edinburgh, Scotland, as evidenced by the attached receipts. Moreover, our firm is a small firm, having only three patent attorneys (one part-time), with the other two patent attorneys being chemists/biologists, and not capable of handling the relevant subject matter.'*

133. The Panel noted, from the wording of the Preliminary Opinion, that it was not mandatory that a response be filed in response to it, but rather that the BoA had presented two options within its preliminary opinion, dependent on whether the appeal was being pursued or not. In reviewing the matter, the Panel noted that the Respondent had responded to the request to attend the hearing, but had not provided a substantive response to the Preliminary Opinion. However, in this regard, given that the Respondent was seeking an adjournment of the oral proceedings owing to the personal commitments, the Panel considered that it was not necessary for the Respondent to seek instructions from WCK in respect of what the Panel considered to be an administrative matter, and one which did not concern the substance of the Appeal.

134. The Panel, however, could not be satisfied that the email dated 25 February 2020 indicated that the Respondent had taken an active decision not to make submissions. It noted that there remained considerable time between the date of the email and the hearing and, given the view the Panel had taken about the chaotic way in which the Respondent had conducted this matter, it could see no evidence that a definite decision not to respond had been taken by the Respondent.

135. Consequently, Particular 2(b)(x) is not proved.



Particular 2(c) - PROVED

2. In your prosecution of EP-Div 1 you failed to:

*(c) Acknowledge the summons to oral proceedings issued by EPO on 28 February 2019 and/or attend the oral proceedings held on 5 July 2019.*

136. The Panel noted that it had before it a letter from the EPO to the Respondent, dated 16 May 2019, in which the EPO stated: *'We did not receive an acknowledgement of receipt (form 2936) for the summons sent on 28.02.19...'* and that it also stated: *'...Please acknowledge the receipt of the summons to the oral proceedings dated 28.02.2019 via form 2936.'*

137. The Panel also noted that Mr Downing had expressed the following in his letter to FHS, dated 13 July 2020:

*'...The epi Council's 'Resolution regarding non-attendance at oral proceedings' requires professional representatives before the EPO to inform the EPO if they will not be attending Oral Proceedings as soon as possible, preferably at least one month before the oral proceedings. In respect of the Oral Proceedings before the Examining Division appointed for application 13153020.6, Keith did not notify the EPO at all...'*

138. The Panel also had regard to the EPO 'Decision of the Examining Division', dated 16 July 2019, in which the Panel noted it stated:

*'...2. The examining division confirmed that the applicant was duly summoned (see also enclosed postal investigation) and was not present. The applicant had not informed the EPO about his/her non-attendance.*

*3. The division noted that the applicant had not provided any amendments or further arguments in response to the summons to attend Oral Proceedings...'*

139. Having regard to the aforementioned, the Panel determined that the Respondent was under a duty to acknowledge the summons to Oral Proceedings issued by the EPO on 28 February 2019 and that he failed to do so.

140. The Panel next considered whether the Respondent was under a duty to attend the Oral Proceedings held on 05 July 2019.

141. In this respect, the Panel had regard to Mr Whitten's evidence to, as follows:

*'...[122] Dr Boden did not attend the Oral Proceedings with the Examining Division in July 2019. I consider this a missed opportunity to advance the application for reasons I set out later in this report. In his absence the Examining Division maintained the objections in the Summons and refused the application. This was inevitable and meant that the only possibility for continuing the application and reversing the Examining Division's refusal was to appeal'.*

142. The Panel had regard to the Respondent's view, as outlined in his email to Mr Sawicki (dated 13 July 2019), where he stated that there was 'no point' in attending oral proceedings. However, the Panel considered that this advice was wrong. In doing so the Panel preferred Mr Whitten's oral and written evidence, which indicated that an oral hearing provided an important opportunity to state the applicant's case and to understand the Examiner's arguments and engage in a dialogue. It might also assist in the preparation of an appeal. It also had regard to Mr Whitten's view that it was not unusual for applicants to be successful at such hearings. The Panel therefore considered that the Respondent had not advanced the application in the client's best interest.

143. The Panel therefore concluded that the Respondent was under an obligation to attend the Oral Proceedings held on 05 July 2019 and that he failed to do so.

144. Consequently, Particular 2(c) is proved.

#### Particular 2(d) - PROVED

2. In your prosecution of EP-Div 1 you failed to:

*(d) Respond substantively to the Written Opinion accompanying the BoA's summons to oral proceedings due to be held on 25 May 2020.*

145. The Panel noted that it had before it both the BoA's summons to Oral Proceedings dated 20 February 2020, in addition to the BoA's Written Opinion, dated 25 February 2020.

146. In addition, the Panel also had regard to the evidence of Mr Whitten when he stated:

*'[165] Dr Boden filed a Notice of Appeal and followed it with a Statement of Grounds. He received a Summons to Oral Proceedings before the Board of Appeal to be held on 25 May 20. That was accompanied by a preliminary opinion, which Dr Boden chose to ignore. There was a whole slew of communications between Dr Boden and the Board of Appeal concerning his inability to attend. He was running a half-marathon. Covid was an issue. As it turned out Covid became the reason that the hearing was postponed. Dr Boden's decision not to reply to the preliminary*

*opinion accompanying the Summons was yet another missed opportunity to make progress toward allowance.*

*[166] Dr Boden's failure to report the Board of Appeal's Summons to Oral Proceedings meant WCK had no opportunity to provide feedback and other instructions. Failing to respond to the written opinion accompanying the Summons and failing to attend the Oral Proceedings meant inevitable refusal of the application by the Examining Division.*

*[167] I cannot see how any of this could be justified as reasonable. I believe it to be far below the acceptable standard.'*

147. Having considered the aforementioned, the Panel was satisfied that there was a duty on the Respondent to respond to the Written Opinion accompanying the BoA's summons to oral proceedings due to be held on 25 May 2020. The Panel could see no evidence that the Respondent had responded to it and was satisfied that he failed to do so.

148. Consequently, Particular 2(d) is proved.

#### Particulars 3 and 4(a) – PROVED

3. *On 3 July 2019, you wrote an email to WCK in which you sought to justify your non-attendance at the oral proceedings held in July 2019. In doing so you misrepresented the benefits of oral proceedings in advancing prosecution.*

4. *Your conduct at 3 above was:*

*(a) Misleading;*

149. The Panel had regard to the email dated 03 July 2019, in which the Respondent had written to WCK and stated the following:

*'...In the absence of instructions, I am presuming that we are to follow our advised approach of not attending the scheduled oral proceedings (Friday, 5 July 2019), allowing this application to be provisionally refused, and then appealing that provisional refusal, in the same manner as done on the parent application. As mentioned, our experience at oral proceedings before the Examining Division is that it is increasingly difficult to get the Examining Divisions to re-consider matters in any substantive or constructive way at oral proceedings, and that we have far more success on appeal...'*

150. The Panel also considered Mr Whitten's oral and written evidence to it. In doing so, it had regard to his written evidence outlined above (in respect of Particular 2(c)), in addition to the following:

*' [155] The advice was given two days before the Oral Proceedings when Dr Boden contacted WCK out of the blue with his "in the absence of instructions..." email. It appears to me to be an after-the-event justification for Dr Boden's unreported prosecution of the application through two Office Actions to the Oral Proceedings before the Examining Division. It does nothing to negate Dr Boden's failure to report and act under instructions.*

*[156] However, the statement appears to be an opinion and might be based on Dr Boden's experiences of patent prosecution generally. I will therefore ignore its timing and take the statement at face value. While there may be some truth in Dr Boden's comment that it can be difficult to get Examining Divisions to reconsider, Dr Boden is not in a position to say, beyond generalities, how a given Examining Division would behave in Oral Proceedings. It is entirely possible that in the parent and first divisional applications the other two members of the Examining Division were unaware of the specifics of the primary examiner's clarity objections. Moreover, there is nothing in FHS's file of this first divisional application to suggest the applicant, MSP Corporation, was concerned by costs or would have vetoed Dr Boden's attendance at the Oral Proceedings.*

*[157] I believe Dr Boden's behaviour in relation to Oral Proceedings in the parent application helps gives context to the above comment in relation to the first divisional application when taken at face value. His behaviour suggests to me he prefers not to attend them.'*

151. Having considered the aforementioned evidence and its view in respect of Particular 2(c), the Panel concluded that the advice provided by the Respondent was inadequate and simply recommended an approach without outlining to WCK the pros or cons of attending an oral hearing. In the Panel's view, there was a clear benefit in attendance at such proceedings in order to seek to persuade the examiners as to the merits of the application or to understand the views of the examiners.

152. In the Panel's view, the Respondent's email to WCK, outlined above, did not present the benefits of attending such a hearing to WCK and by not doing so the Panel considered that he had misrepresented matters to WCK and misled it. Whilst the Panel considered that it was possible that the Respondent's personal experience may have led him to the conclusion about the likely outcome of the Hearing as expressed in his email, the Panel was also of the view that the benefits outlined in Mr Whitten's opinion applied irrespective

of the outcome and attendance was clearly in the client's best interests. In any event, the Respondent, as a professional patent attorney, had a duty to present all of the options to WCK and he did not do so.

153. Consequently, Particulars 3 and Particular 4a) are proved.

Particular 4:

4. *Your conduct at 3 above was:*

*(b) Dishonest, in that you knew there were advantages in attending oral proceedings.*

154. In its consideration of whether the Respondent's conduct was dishonest, the Panel applied the test as outlined in *Ivey v Genting Casinos (UK) Ltd t/a Crockfords [2017] UKSC 67*.

155. The Panel considered whether the Respondent would have known that there were advantages in attending oral proceedings. The Panel had regard to the opinion of Mr Whitten noted above. It considered that an understanding of the advantages of an oral hearing as set out there were so obvious that they would be part of the basic knowledge of any European Patent Attorney. The Panel was satisfied that the Respondent, as an experienced practitioner, would have been aware of these advantages and he did not make those advantages known to WCK.

156. The Panel further noted that the Respondent's email to WCK was sent on 3 July 2019, two days before the oral hearing listed on 05 July 2019. In the Panel's view, this was a highly relevant factor in determining that the Respondent had acted dishonestly in not presenting all of the options to WCK. The Respondent had been on notice of the oral hearing for a considerable period of time and had not submitted any response prior to the hearing or responded to any of the requests for an acknowledgement that he was aware that the Hearing was taking place. There was no evidence that he had made any preparations for the Hearing and the Panel was aware that it would be extremely difficult for him to prepare such submissions in two days. He had not given any information about the hearing to WCK before 03 July 2019 or sought any instructions. In his email, the Respondent made no mention of the advantages of attending such a hearing, to enable WCK to make an informed decision. Nor did he give them time to consider the matter or give him instructions.

157. In the Panel's view, given the timing of the email, the Respondent presented his non-attendance as a *fait accompli*, for his own benefit, when he knew there were advantages in attending the oral hearing. The Respondent's actions were crafted to serve his own

convenience and to cover his mismanagement of the patent application and the Panel considered that the average person would consider the Respondent's actions in this regard to be dishonest.

158. The Panel therefore concluded that the Respondent had been dishonest in not informing WCK that there were advantages in attending the oral proceedings.

159. Consequently, Particular 4(b) is proved.

#### Particular 5 - PROVED

5. *When submitting the Grounds of Appeal you failed to take instructions from WCK regarding amendments to the claims and/or whether to make auxiliary requests.*

160. The Panel had regard to the Grounds of Appeal contained within the hearing bundle. The Panel also had regard to the evidence before it from Mr Whitten and Mr Sawicki and determined that the Respondent was under a duty to take instructions from WCK regarding amendments to the claims and/or whether to make auxiliary requests for the reasons outlined within this determination previously (and in particular for the reasons outlined within Particular 2(a)(i) above). It noted that it was clear from the evidence presented to it that he had not done so.

161. Consequently, Particular 5 is proved.

#### Particular 6 - PROVED

6. *On 30 November 2017 you filed Divisional Application EP17204672.4 ("EP-Div 2") on instruction from WCK on behalf of MSP and thereafter prosecuted the application through the EPO.*

162. The Panel had regard to an 'Acknowledgment of receipt' document from the EPO which outlined that the Respondent had filed Divisional Application EP17204672.4, online, on 30 November 2017 at 14.42pm.

163. The Panel also had regard to an email from the Respondent to WCK, dated 30 November 2017, in which the Respondent stated:

*'I can confirm that we have attend to the filing of the divisional, and withdrawn this application, ahead of the oral proceedings scheduled for tomorrow. Copies of the relevant documents are attached, together with a copy of the filing receipt for the divisional.*

*As you will see, the divisional has been accorded application number 17204672.4. You will note that we have included the original claims in addition to the present claims from this application, in an attempt to preserve scope for possible claim amendments should the need arise...'*

164. Additionally, the Panel noted that in Mr Downing's letter to FHS, dated 13 July 2020, he stated:

*'The application was lodged on 30 November 2017 as a divisional application based on earlier filing no. 11001982.5. That filing date is the day prior to Oral Proceedings before the Board of Appeal in respect of the parent application, no. 11001982.5, and the same day that Keith gave notice of withdrawal of that application. It was therefore the last day on which it was possible to make the filing...'*

165. Having regard to the aforementioned evidence, the Panel was satisfied that the Respondent filed Divisional Application EP17204672.4 on instruction from WCK, on behalf of MSP, and thereafter prosecuted the application through the EPO.

166. Consequently, Particular 6 is proved.

Particular 7(a)(i) - PROVED

7. *In your prosecution of EP-Div 2 you failed to:*

*(a) Report to, or inform, WCK adequately and/or at all of:*

*i. Some or all of the amendments you made to the application in response to the EPO Written Opinion issued on or around 05 March 2018;*

167. Having already determined that the Respondent was under a duty to report and inform WCK of his actions, including any amendments to documentation, the Panel went on to consider whether the Respondent had informed WCK of some or all of the amendments that he made to the application in response to the EPO Written Opinion issued on or around 05 March 2018.

168. The Panel considered the Respondent's letter to WCK, dated 16 October 2018, and noted that it informed WCK that 'a reply to the outstanding Examination Opinion' had been filed with the EPO and that this same letter included a copy of the reply filed.

169. The Panel also considered Mr Whitten's evidence to it, when he stated:

*'[139] When Dr Boden reported the filing of the response he made no mention of the ways in which his amendments deviated from what WCK had told him to do. As I said*

*in relation to the first divisional application, there is no reason to assume that WCK would have carefully considered the amendments reported to them. Dr Boden should have identified the amendments, thereby giving WCK an opportunity to question and, if necessary, correct what he had done.'*

170. Having considered the evidence presented to it, the Panel concluded that whilst the Respondent had provided a copy of the response filed with the EPO to WCK he had not highlighted the amendments made which deviated from the instructions given by WCK. In this respect, whilst the Panel considered that it could not be said that the Respondent failed to report the amendments to WCK, because he had technically provided a full copy of the response filed, the Panel accepted Mr Whitten's evidence that he would not expect a client to review each document with critical scrutiny where amendments are not highlighted. Having regard to this, the Panel therefore determined that the Respondent had failed in his duty to adequately inform WCK of some or all of the amendments made within the response filed.

171. Consequently, Particular 7(a)(i) is proved.

Particular 7(a)(ii) - NOT PROVED

7. *In your prosecution of EP-Div 2 you failed to:*

*(a) Report to, or inform, WCK adequately and/or at all of:*

*ii. The change of examiner for the application;*

172. The Panel first considered whether the Respondent was under an obligation or duty to report to or inform WCK of the change of examiner for the application.

173. The Panel had regard to Dr Whitten's evidence when he stated:

*'...[24] The Working relationship between FHS and WCK seems clear from the correspondence in the two divisional files. FHS would report official communications with minimal input other than, say, identifying deadlines and providing brief observations on selected issues. WCK would provide amended claims and comments on patentability. FHS would proceed as instructed and not act in the absence of instructions...*

[and]



*...[140] I believe Mr Boden not commenting on the change in examiner was, at best, an oversight and a missed opportunity to make positive progress in the application..'*

174. In the Panel's view, having considered the totality of the evidence presented by IPReg, the Panel was not satisfied that the Respondent was under a duty to inform WCK of the change of examiner for the application. The Panel noted that Mr Whitten had expressed a view that not reporting on the change of examiner was '*at best, an oversight*', having regard to the nature of the relationship between the FHS and WCK, also outlined by Mr Whitten. However, the Panel considered that Mr Whitten was applying a very high standard in his observations.

175. Mr Whitten stated that the fact that there was a new Examiner might have provided the Respondent with an opportunity to make contact with the Examiner in order to understand their approach and undertaken some informal advocacy on behalf of his client and that the failure to seek instructions on this from WCK missed that opportunity. The Panel considered that this view was speculative and noted that two other individuals would be involved at an Oral Hearing who would not necessarily share the Examiner's views and that there was nothing to suggest that any approach to the Examiner might have been successful. The Panel could see no procedural or other rule which placed any duty on a practitioner to engage in this way. In the Panel's view, such an action might well indicate excellent service by a practitioner, but it did not consider that a competent practitioner necessarily had a duty even to notice that the Examiner had changed, let alone report this to the client or seek instructions on whether to take the actions suggested by Mr Whitten. The client's interests would be appropriately protected by making appropriate responses to the findings.

176. Consequently, Particular 7(a)(ii) is not proved.

Particular 7(a)(iii) and (iv) - PROVED

7. *In your prosecution of EP-Div 2 you failed to:*

(a) *Report to, or inform, WCK adequately and/or at all of:*

iii. *The EPO's first Office Action issued 1 March 2019;*

iv. *The response you filed in response to the EPO's first Office Action;*

177. Having already determined that the Respondent was under a duty to report and inform WCK of his actions, the Panel went on to consider whether the Respondent had reported to or informed WCK of the EPO's first Office Action issued on 01 March 2019 or the response he filed in response to the EPO's first Office Action.

178. The Panel had regard to Mr Sawicki's evidence to it when he stated:

*'Application EP17204672.4 proceeded in a similar manner, with us not being advised of progress until after a response had been filed unilaterally. Specifically;*

- a. An examination report was issued on 1 March 2019, with the usual four-month deadline for response. An extension of time in which to respond was sought on 11 July 2019, but no response was lodged within the extended deadline. A response was eventually filed on 19 December 2019, presenting amendments to the claims and arguments in support of their clarity, novelty and inventive step, together with a request for "further processing" to excuse its late filing.*
- b. No update as to progress was provided between 16 October 2018 and 10 June 2020. This response of 19 December 2019 was not reported to us until 10 June 2020, the same day on which Dr Boden finally advised us as to the progress in relation to application EP13153020.6 (see paragraph 15.f above).*
- c. This [sic], within the period between 16 October 2018 and 10 June 2020;*
  - i. A first examination report was issued*
  - ii. An extension of time in respect of the deadline for the first examination report was filed*
  - iii. A request for further processing in respect of the extended deadline for the first examination report was presented, and*
  - iv. A response to the first examination report was filed*

*Each of these steps merited a report to us, but none were provided. The amendments to the claims that were presented with the response were not cleared with or approved by us prior to submission. The response was presented as a fait accompli on 10 June 2020, over a year after the examination report and almost six months after the response.'*

179. The Panel also noted the contents of Mr Downing's letter, dated 13 July 2020, to FHS in which he stated:

*'...An examination report was issued on 1 March 2019, with the usual four-month deadline for response. The examiner expressed the view that the deletion of claims 1-3 resolved the clarity objections in the Search Opinion, but that the amendments raised additional lack-of-clarity issues and objected that the amended apparatus claim still lacked novelty. An extension of time in which to respond was sought on 11 July 2019 and granted on 17 July 2019, but no response was lodged in time. On 9 October 2019*

*the EPO indicated that the application was to be deemed abandoned. None of this was reported to WCK.*

*A response was eventually filed on 19 December 2019, presenting amendments to the claims and arguments in support of their clarity, novelty and inventive step. A request for further processing was filed separately on the same date. The request for further processing was accepted, so the application is now re-instated as pending. This response was not reported to WCK until 10 June 2020, at which point Keith sent a copy of his reply.'*

180. Having considered the evidence presented to it, the Panel was satisfied that the Respondent had not reported or informed WCK, at all, of the EPO's first Office Action issued on 01 March 2019.

181. In respect of the response filed by the Respondent on 19 December 2019, the Panel noted that the Respondent did inform WCK of this response 10 June 2020. Having done so, the Panel could not be satisfied that the Respondent had failed to inform WCK of his response at all. However, the Panel did consider that the Respondent had failed to adequately report or inform WCK of the response filed. The Panel noted that, in his email of 10 June 2020, the Respondent said that *'In reviewing our file, I note that we have not yet reported the filing of a reply to the Examination Report as issued in connection with this application, a copy of which is now enclosed'*. The Panel considered that taking almost six months to report on this was inadequate and failed to comply with the Respondent's duties to his clients.

182. Consequently, Particulars 7(a)(iii) and (iv) are proved.

#### Particular 7(b)(i) - PROVED

7. *In your prosecution of EP-Div 2 you failed to:*

*(b) Seek instructions and/or approval from WCK in relation to:*

*i. The amendments you made to the application in response to the EPO's Written Opinion;*

183. Having already determined that the Respondent was under a duty to seek instructions and/or approval from WCK, the Panel went on to consider whether the Respondent had sought instructions and/or approval from WCK in respect of the amendments made to the application in response to the EPO's written opinion.

184. The Panel had regard to Mr Sawicki's evidence, as outlined above in respect of its decision on Particulars 7(a)(iii) and 7(a)(iv) and noted that Mr Sawicki outlined the actions

and steps taken by the Respondent in response to the EPO, and had also stated that ‘...Each of the steps merited a report to us, but none was provided. The amendments to the claims that were presented with the response were not cleared with or approved by us prior to submission.’

185. The Panel also noted Mr Whitten stated:

*‘...[134] It would have made sense to contact WCK to understand their thinking here. Dr Boden, however, did not question the instructions. It appears from the file he took them at face value and used WCK’s amended claims as a basis for the response. Moreover, Dr Boden again did not do exactly as instructed.’*

*[135]...*

*[136]...*

*[137]...*

*[138]...*

*[139] When Dr Boden reported the filing of the response he made no mention of the ways in which his amendments deviated from what WCK had told him to do.’*

186. The Panel considered the term ‘amendments’ within the wording of the Particular and noted, from the evidence presented to it, that there appeared to be two categories of amendments; the first being those directed by WCK which the Respondent undertook and a second category of amendments which the Respondent took it upon himself to make without seeking instructions prior to filing.

187. In respect of the second category of amendments, the Panel considered that the Respondent had made amendments to the application in response to the EPO’s written opinion without seeking instructions or approval from WCK prior to doing so.

188. Consequently, Particular 7(b)(i) is proved.

#### Particular 2(b)(ii) – NOT PROVED

7. In your prosecution of EP-Div 2 you failed to:

(b) Seek instructions and/or approval from WCK in relation to:

ii. Your decision not to respond to the first Office Action by the extended deadline;

189. Having already established and determined that the Respondent was under a duty to seek instructions and/or approval from WCK, the Panel went on to consider whether the

Respondent sought instructions and/or approval from WCK in respect of his decision not to respond to the first Office Action by the extended deadline.

190. The Panel again noted the word ‘decision’ included within the wording of the Particular and it applied the same interpretation of the word as it had with previous Particulars. Namely, that this Particular required the Panel to conclude that the Respondent had made a conscious choice to do, or not to do, a particular act or deed.

191. In respect of the Respondent’s decision not to respond to the first Office Action by the extended deadline, the Panel noted Mr Sawicki’s evidence, as outlined above, that ‘...*An extension of time in which to respond was sought on 11 July 2019, but no response was lodged within the extended deadline...*’

192. The Panel also had regard to Mr Downing’s letter, dated 13 July 2020, to FHS, in which he stated (and is also outlined above) ‘...*An extension of time in which to respond was sought on 11 July 2019 and granted on 17 July 2019, but no response was lodged in time...*’

193. As it had before, in respect of Particular 2(b)(iii), the Panel the Panel was not satisfied that IPReg had proved, to the requisite standard, that the Respondent had made a conscious ‘decision’ not to respond to the first Office Action. Whilst the Panel noted that it was clear from the evidence before it that a response had not been filed to the first Office Action, it was not clear, on the totality of the evidence presented to it, that the Respondent had made a deliberate ‘decision’ not to respond by the extended deadline as opposed to simply missing the deadline and not responding.

194. Consequently, Particular 7(b)(ii) is not proved.

#### Particular 7(b)(iii) – PROVED

7. *In your prosecution of EP-Div 2 you failed to:*

*(b) Seek instructions and/or approval from WCK in relation to:*

*iii. Your decision to rely on Further Processing to extend the deadline for reply;*

195. Having already determined that the Respondent was under a duty to seek instructions and/or approval from WCK, the Panel went on to consider whether the Respondent sought instructions and/or approval from WCK in respect of his decision to rely on Further processing to extend the deadline for reply.

196. The Panel again noted the word ‘decision’ included within the wording of this Particular and the Panel applied the same interpretation of the word ‘decision’ as it had with previous Particulars.

197. The Panel first had regard to a letter from the Respondent to the EPO, dated 15 December 2019, in which he stated:

*'...I now hereby request further processing of this application (under the provisions of Article 121 EPC). The fee for further processing is being paid separately from our deposit account...'*

198. The Panel again noted the evidence of Mr Sawicki, as outlined above, in which he stated (in summary) *'iii. A request for further processing in respect of the extended deadline for the first examination report was presented...'* and *'...Each of these steps merited a report to us, but none were provided...'*

199. The Panel also noted that Mr Downing in his letter to FHS, dated 13 July 2020, stated, under 'client care issues':

*'The examination reports of 10 February 2014 and 6 March 2015 were not reported, nor were the responses to either examination report, or the extensions of time that were requested, or the further processing request that was lodged.'*

200. Having regard to the aforementioned evidence, the Panel determined that the Respondent did make a conscious decision to rely on further processing to extend the deadline for reply, and that he did not seek instructions or approval from WCK prior to doing so and, as a result, the Panel also considered that he had failed in his duty to WCK.

201. Consequently, Particular 7(b)(iii) is proved.

#### Particular 7(b)(ix) - PROVED

7. In your prosecution of EP-Div 2 you failed to:

(b) Seek instructions and/or approval from WCK in relation to:

iv. *The filing of the response to the first Office Action and/or your amendments and arguments therein;*

202. Having determined that the Respondent was under a duty to seek instructions and/or approval from WCK, the Panel went on to consider whether the Respondent sought instructions and/or approval from WCK in respect of the filing of the response to the first Office Action and/or his amendments and arguments outlined therein.

203. The Panel noted that contained within the evidence presented to it, there was a letter from the Respondent to the EPO, dated 19 December 2019, which appended a copy of the response to the first Office Action with amendments contained therein. Further, the Panel

also noted that contained within the letter dated 19 December 2019, there were arguments asserted in response to the Examination report.

204. The Panel again had regard to Mr Sawicki's evidence to it that a response to the first Office Action was filed without instructions or approval. Further, the Panel also had regard to Mr Downing's letter to FSH, dated 13 July 2020, in which he stated '*... The amendments to the claims that were presented with the response were not cleared with or approved by WCK prior to submission.*'

205. Having regard to the aforementioned evidence, the Panel determined that the Respondent did not seek instructions or approval from WCK in relation to his amendments and arguments in relation to the filing of the response to the first Office Action and that he failed in his duty when he filed without instructions or approval from WCK.

206. Consequently, Particular 7(b)(iv) is proved.

#### Particular 8 – NOT PROVED

*8. You failed to notify or provide payment of a refund you received from EPO to WCK in a reasonable time on the following occasions:*

*(a) €1300 refunded on 21 March 2018;*

*(b) €1575 refunded on 3 May 2018;*

*(c) €1300 refunded on 16 May 2018.*

207. The Panel first considered whether the Respondent had a duty to notify or provide a payment to WCK, when it was received from the EPO. The Panel determined that there was a clear duty to do so. In forming this view, the Panel considered the evidence of Mr Sawicki. It noted that he stated '*Once these refunds arrived in FHS's account, they should then have been credited to our [WCK's] account so that we could return the funds to the client.*' However, the Panel considered that such a duty could only apply to the Respondent where he was aware that such a refund had been made or was in a position where he had responsibility for FHS's arrangements for managing its accounts.

208. Having determined that the Respondent could be under a duty to return any monies received from the EPO to WCK, the Panel considered whether any monies had been received by FHS. In doing so, the Panel noted that it had been provided with the following copies of refund orders:

*i. 21 March 2018 - €1300;*

- ii. 03 May 2018 - €1575; and
- iii. 16 May 2018 - €1300.

209. Whilst the Panel noted that each of these refund notices were addressed to the Respondent, the Panel also had regard to Mr Sawicki's evidence to it where he stated:

*'20. Mr Downing's investigations into the two applications also revealed that FHS had been credited with a total of €3,200 in refunds of official fees from the EPO in relation to the applications. Copies of the EPO refund orders are provided in Exhibit ZPS1. None of these were reported to us by Dr Boden. Normally, EPO fee refunds are notified to the EPO representative in two ways – first, there is a letter (ZPS1) explaining the reason for the refund and second, the refund will be credited to the deposit account which the representative maintains at the EPO and will therefore appear in the regular statements for that account.*

*21. Once these refunds arrived in FHS's account, they should have been credited to our account so that we could return the funds to the client. We would have done that either by crediting the client's account with us, or (if they prefer) by sending them a check. (sic) These official fees are costs that have been invoiced to and paid by the client and therefore the refunded money belongs to the ultimate client and Fry Heath & Spence received them on trust for the client.*

*22. Acting on our behalf, Mr Downing asked FHS why these refunds had not been notified to us or credited to our account. Initially, we were only aware of the refund dated 21 March 2018; on 13 July 2020 we requested a copy of their file including details of the handling of that refund order; a copy of the file was provided on 16 July 2020 but did not include any reference to any refunds, so we asked again on 17 July 2020. Mr Lock replied on behalf of FHS on 22 July 2020 to say that "we cannot trace ever having received the letter from the EPO informing us that a refund had been generated and our account credited, which would normally trigger a review of our account to ascertain if a refund had been received, and if so transmission of that refund to the client. We have however checked the account and it appears that a refund was received, which we have now transferred to WCK".*

210. The Panel also had regard to Mr Whitten's oral evidence to it regarding the manner in which his previous patent attorney firm used to process refunds from the EPO. However, whilst the Panel noted that it was clear from the documentation and evidence before it that FHS had indeed received the refunds from the EPO, the Panel considered that IPReg had not provided evidence that: i) the notices from the EPO had been received by the Respondent; ii) the internal processes at FHS were likely to ensure that the Respondent



would have been personally notified or aware of the EPO refunds and/or iii) the Respondent had any direct responsibility for the management of FHS's accounts.

211. Whilst the Panel had regard to the correspondence from the Respondent to the EPO that FHS was a small patent attorney firm with three patent attorneys, the Panel was not clear on the evidence available to it, on the arrangements within FHS for the management of such funds received from the EPO. Whilst Mr Whitten was able to talk in generalities regarding the operation of his previous patent attorney firm, in the Panel's view, this did not relate specifically to the operation of FHS, nor did it confirm that the Respondent would have personally known about the refunds from the EPO in order to inform or provide them to WCK.

212. Consequently, Particular 8 is not proved.

### Particular 9

*9. Your conduct at 2 to 4 and 7 above was contrary to Rules 5 and 6 of the Rules of Conduct for Patent Attorneys, Trade Mark Attorneys and Other Regulated Persons.*

213. The Panel noted that there were different Rules of Conduct in respect of each Particular found proved. The Panel considered the Rules of Conduct in place at the time in respect of each Particular.

214. The Panel noted that Rule 5 related to Integrity and Rule 6 related to Client Care and Service.

215. The Panel considered each of the individual Particulars found proved and went on to determine, as a consequence, whether Rules 5 and/or 6 had been breached. The Panel noted that this was a decision for its own independent judgement, but in forming that judgement the Panel had regard to the evidence presented to it.

216. Having done so, the Panel considered that each Particular found proved in Particulars 2, 3, 4 and 7, save for Particulars 2(a)(i), 2(b)(i), 7(a)(i) and 7(b)(i), amounted to a breach of Rule 5. Additionally, the Panel also considered that those matters found proved within Particulars, 2, 3, 4 and 7 also amounted to a breach of Rule 6.

217. The Panel first considered how Rule 6 applied to the Particulars found proved. Rule 6 imposes a duty to '*carry out ... professional work in a timely manner and with proper regard for standards of professional service and client care.*' The Panel had regard to the evidence from Mr Sawicki and Mr Whitten set out above which outlines the normal expectations of

client service in the relationship between WCK and the Respondent. The Panel considered that all of the matters found proved under Particulars 2, 3, 4, 5 and 7 related to the service that the Respondent provided to his clients. They involved failures to inform the client of key events in the prosecution of the application, to seek instructions on submissions that he was making to the EPO, to conduct matters before the EPO in his client's best interests by failing to respond to requests for acknowledgement or to submit responses on his client's behalf, and to provide appropriate advice to the client. All of these matters led at the very least to delay and expense for the client and, potentially, to adverse outcomes. The Panel was satisfied that, individually and cumulatively, they breached Rule 6.

218. The Panel then considered how Rule 5 applied to the Particulars found proved. Rule 5 imposes a duty to '*at all times act with integrity putting their clients' interests foremost subject to the law and any overriding duty to any Court or Tribunal*'. The Panel had regard to the case of *Wingate and Others v SRA* [2018] EWCA Civ 366 and Jackson LJ's definition of integrity (at para. 100 - 101):

*Integrity connotes adherence to the ethical standards of one's own profession. That involves more than mere honesty. To take one example, a solicitor conducting negotiations or a barrister making submissions to a judge or arbitrator will take particular care not to mislead. Such a professional person is expected to be even more scrupulous about accuracy than a member of the general public in daily discourse. The duty to act with integrity applies not only to what professional persons say, but also to what they do. It is possible to give many illustrations of what constitutes acting without integrity.*

Then at para. 102:

*Obviously, neither courts nor professional tribunals must set unrealistically high standards, as was observed during argument. The duty of integrity does not require professional people to be paragons of virtue. In every instance, professional integrity is linked to the manner in which that particular profession professes to serve the public.*

219. The Panel also considered the submissions of Mr Grey in respect of recklessness to the effect that whilst it cannot be said that a lack of integrity can only be found where recklessness occurs, the converse is invariably true, namely that where there is recklessness a finding of a lack of integrity will be likely to follow. *Brett v SRA* [2014] 2974 (Admin) at 49. In this context, Mr Grey pointed out that in the context of regulation '*conduct is reckless as to a particular result where a professional is aware of a risk that the result will occur, and it is, in the circumstances known to him, unreasonable to take that risk.*' *R v G*[2004] 1 AC 1034.

220. The Panel noted that it had already found that all the Particulars found proved had amounted to a breach of Rule 6 in respect of client care. It considered that, for Rule 5 to be engaged, there must be some additional element to the conduct which aggravated it so that the Respondent's integrity was called into question.
221. The Panel considered that Particulars 2(a)(i), 2(b)(i), 7(a)(i) and 7(b)(i) involved failures to inform WCK of amendments that the Respondent had made to drafts submitted by WCK. While the Panel had found that he had duty to do so, it did not consider that there was any ulterior motive to the amendments or his failure to draw them to the attention of WCK. The amended documents were sent to WCK.
222. The remaining matters in Particulars 2 and 7 involved failing to inform WCK of significant matters of which they needed to be aware and on which they were denied the opportunity to take instructions. In the Panel's view, the Respondent would have been aware that WCK needed to be aware of the matters and would be likely to wish to give instructions on how proceed. The Panel considered that the failures to report and seek instructions fell within the definition of recklessness set out above. Furthermore, the failures to report and seek instructions set out in Particulars 2(a) (iv), (v), and (vii), 2(b) (ii), (iv), (vi) and (ix), 7(a) (iv) and 7 (b) (iii) and (iv) meant that WCK were unaware of his failures to take the action that his duty required. In the Panel's view, this suggested a wish to keep WCK in the dark about those failures and, in the Panel's view, this demonstrated a lack of integrity.
223. The Panel was also satisfied that its findings in respect of Particulars 3 and 4 demonstrated a lack of integrity because the Panel was satisfied that the Respondent was aware that his advice was misleading and was directed towards his own convenience rather than his client's best interests.

#### Particular 10

*10. Your conduct at 5 above was contrary to Rules 4, 5 and 6 of the Rules of Conduct for Patent Attorneys, Trade Mark Attorneys and Other Regulated Persons.*

224. The Panel noted that Rule 4 related to Competence and Rule 5 again related to Integrity and Rule 6 related to Client Care and Service. The Panel again noted that a decision as to a breach of the Rules of Conduct was a matter for its own independent judgement, but in forming that judgement the Panel had regard to the evidence presented to it.
225. In considering whether Particular 5 amounted to breaches of Rules 4, 5 and 6 of the Rules of Conduct, the Panel had regard to all of the evidence before it and it paid particular

attention to the evidence of Mr Whitten. In doing so, the Panel noted that Mr Whitten had expressed the opinion that the Respondent had failed to take instructions from WCK when making amendments to the claims and auxiliary requests. In view of this, and its earlier findings, the Panel considered that the Respondent had breached Rules 5 and 6. In both cases, it was in the client's interests to know about the appeal and provide instructions as to the Grounds and the failure to do so meant that the client was kept in ignorance of important developments in the case. While the Panel agreed that a competent practitioner would have sought instructions on these matters, it did not consider that the failure to do so was any less competent than the failures set out in the other Particulars, where there was no such charge, or that the Grounds of Appeal themselves were drafted with less care or skill than the other matters. Consequently, the Panel considered that the conduct found proved at Particular 5 amounted to a breach of Rules 5 and 6, but not Rule 4.

#### Particular 11

226. Having found Particular 8 not proved, the Panel did not go on to consider whether it amounted to a breach of Rules 5, 6 or 11 (Financial matters).

#### Misconduct

227. As required by paragraph 52.1 of the SOP, having determined the facts of the case, and having found a number of the Particulars proved, the Panel went on to consider whether the Respondent's conduct amounted to misconduct. In doing so, the Panel took Mr Grey's submissions into account and it accepted the advice of the Legal Advisor.

228. In considering the issue of misconduct, the Panel bore in mind the explanation of that term given by the Privy Council in the case of Roylance v The General Medical Council [2000] 1 AC 311 where it was stated:

*“‘Misconduct’ is a word of general effect, involving some act or omission which falls short of what would be proper in the circumstances. The standard of propriety may often be found by reference to the rules and standards ordinarily required to be followed by a ...practitioner in the particular circumstances. The misconduct is qualified in two respects. First, it is qualified by the word ‘professional’ which links the misconduct to the profession ... Secondly, the misconduct is qualified by the word ‘serious’. It is not any professional misconduct which will qualify. The professional misconduct must be serious.”*

229. The Panel was aware that a breach of Rules 5 and 6 of the Rules of Conduct does not necessarily constitute misconduct. The Panel considered each of the Particulars found proved in turn. Having done so, the Panel was satisfied that each of the Particulars found

proved, represented a serious breach of professional standards, falling far below the behaviour expected of a registered patent attorney and that each amounted to misconduct.

230. The Panel had regard to its findings. It considered that the Respondent's management of the patent applications was chaotic, lacked structure, was often responsive rather than proactive and did not have the client's best interests at the centre of his actions. Furthermore, it found that the Respondent had acted without integrity and had been dishonest in matters where the client had placed trust in him. The Particulars did not involve difficult or complex matters but were failures at the heart of the Attorney/client relationship and caused significant delay and additional cost for the client. Whilst the Panel noted that the Respondent had stated to the EPO that FHS was a small firm of patent attorneys, there was nothing before the Panel to suggest that the Respondent was overworked, or lacked appropriate support to enable him to properly manage the patent applications submitted to the EPO on WCK's behalf.

231. The Panel was also satisfied that fellow practitioners and members of the public would consider the Respondent's behaviour, in this regard, as serious and thus the Panel determined that his conduct amounted to misconduct.

### Sanction

232. Having found facts and misconduct, the Panel invited submissions from Mr Grey in respect of sanction.

233. Mr Grey drew the Panel's attention to a previous regulatory finding made against the Respondent and to the aggravating and mitigating factors in the case. He also drew the Panel's attention to IPReg's Disciplinary Sanctions Guidance (hereafter 'the sanctions guidance') and the relevant paragraphs therein.

234. In reaching a decision on sanction, the Panel took Mr Grey's submissions into account on behalf of IPReg. The Panel also referred to the sanctions guidance issued by IPReg and accepted the Legal Advisor's advice. The Panel also had in mind that the purpose of sanction was not to punish the Respondent, but to protect the public, maintain public confidence in the profession and maintain proper standards of conduct and performance. The panel was also cognisant of the need to ensure that any sanction is proportionate.

235. The Panel considered the level of seriousness in respect of the Respondent's conduct. It noted that the sanctions guidance indicates that findings of dishonesty fell within the classification of 'very serious'.

236. To assist it in assessing the relevant level of sanction, the panel identified the following mitigating and aggravating factors:

Aggravating factors:

- i. previous disciplinary history for similar concerns, which tended to suggest a pattern of behaviour as it was similar in nature to this Panel's findings of fact;
- ii. the Panel had found dishonest conduct in the case;
- iii. the Respondent's behaviour had caused harm to the client in terms of cost and delay;
- iv. the Respondent had shown no insight;
- v. the Respondent had demonstrated limited engagement with his regulator;
- vi. there was no evidence of remorse or remediation;
- vii. there was no admission of guilt; and
- viii. the Respondent was a senior partner at FHS at the time the concerns arose.

Mitigating factors:

i. [REDACTED]

237. As advised by the Legal Advisor, the panel started its consideration of this matter from the bottom of the scale of possible sanctions. It considered that a warning or reprimand would not be appropriate in this case given its findings that the Respondent's conduct was very serious in nature, with a finding of dishonesty also having been made.

238. The Panel next moved on to consider whether an undertaking or a financial penalty would be appropriate in this case and determined that that they would not. In the Panel's view, the Respondent had engaged in a limited manner with IPReg and in order for an undertaking to be appropriate there would need to be some engagement and agreement from the Respondent, which was not present in this case. Further, the Panel also noted from the sanctions guidance that both of these sanctions were considered to be appropriate where the conduct could be described as 'less serious to serious' and the Panel had already determined that the Respondent's conduct in this case could be said to amount to conduct that was best described as 'very serious'. Consequently, the Panel considered that neither of these sanctions would be appropriate or sufficient to mark the seriousness of the conduct found proved.

239. The Panel next considered a Conditions of Practice Order. The Panel determined that a Conditions of Practice Order was not the appropriate sanction in this case. In forming this view, the Panel had regard to the fact that the Respondent had indicated that he had retired from public practice. The Panel had no information from the Respondent to indicate that he may be willing to comply with a conditions of practice order. Therefore,

the Panel could not be satisfied that a conditions of practice order would be workable, appropriate or verifiable. Additionally, whilst the Panel considered that a conditions of practice order may have been appropriate had the Respondent's conduct been limited to his management of the patent applications, its findings in respect of dishonesty meant that conditions of practice could not be formulated to address this aspect of his conduct.

240. The Panel next considered whether to make a Suspension Order. The Panel considered that such an order would provide the necessary degree of protection for the public, whilst leaving open the possibility of remediation and improved insight. However, the Panel was not satisfied that a Suspension Order was appropriate owing to the very serious nature of the misconduct and because the Panel had insufficient confidence that the Respondent would not repeat his conduct.

241. The Panel carefully evaluated the mitigating circumstance, but considered that it could apply limited weight to it, [REDACTED]. Further, the Panel noted that the Respondent has not shown any remorse and this fact did not reassure the Panel in relation to the fundamental matter of his integrity. For these reasons the Panel did not consider that a Suspension Order was sufficient to uphold public confidence in the profession and the regulatory process. The Panel had determined that the Respondent's conduct in this case was serious and members of the public would expect the regulator to regard such conduct as incompatible with continued registration, especially when there is no evidence of a commitment from the Respondent to acknowledge and/or address the Panel's concerns. The dishonesty is combined with a lack of insight and includes an attempt by the Respondent to put his own needs before that of his professional responsibilities.

242. The Panel therefore considered the option of a Removal Order and decided that it was the appropriate and proportionate sanction. The Panel considered the Registrant's interests, but decided that they were outweighed by the need to protect the public and the wider public interest.

243. The Panel noted that many of the factors highlighted in the case law which indicated that a Removal Order may be appropriate were present in this case including proven dishonesty in the course of professional duties, and a lack of insight.

244. The Panel therefore decided that the appropriate and proportionate order is a Removal Order.

COSTS:

245. The Panel was asked to consider the award of costs and carefully considered the costs schedule provided by IPReg. In doing so, it reminded itself that the usual principle was that costs follow the event and it could see no reason to depart from this course.
246. In forming this view, the Panel noted the Respondent's correspondence to IPReg, dated 07 May 2024, when the schedule of costs was served upon him, in accordance with paragraph 75 of the SOP. Whilst the Panel noted that the Respondent had submitted that he would challenge any costs awarded, the Panel also noted that the Respondent had not provided any financial information nor had he provided submissions regarding his ability to pay any costs awarded, despite having been afforded an opportunity to do so.
247. The Panel noted that the Respondent had argued that the hearing was unnecessary because he had volunteered to retire from the Register and therefore, he should not be responsible for its costs. The Panel considered that IPReg had a duty to take this action against the Respondent in the public interest, to demonstrate that such conduct from a practitioner is unacceptable and that the regulator will take action in such cases. It therefore did not accept this argument.
248. The Panel carefully considered the costs sought by IPReg. It considered that the bulk of the costs were appropriate and necessary to bring the case. However, it noted that IPReg was seeking to claim costs for a postponement application from 24 January 2024. The Panel considered that it was disproportionate to award any costs in this regard, because as far as the Panel understood it, the postponement had been sought owing to IPReg's Counsel's availability and the Panel could therefore see no good reason as to why the Respondent should bear the cost in this regard of £401.58. It therefore decided to remove this item from the costs that could be claimed against the Respondent. The Panel therefore determined to make a costs order in the sum of £47,533.12.



IN THE MATTER OF THE INTELLECTUAL PROPERTY REGULATION BOARD DISCIPLINARY PANEL

BETWEEN:

THE INTELLECTUAL PROPERTY REGULATION BOARD

(Complainant)

- and -

KEITH MCMURRAY BODEN

(Respondent)

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ORDER

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IT IS ORDERED THAT:

With effect from 10<sup>th</sup> day of May 2024, the following action be taken in relation to the registration of: KEITH MCMURRAY BODEN:

1. Pursuant to Chapter 4, paragraph 3.4.9 of IPReg's Core Regulatory Framework that his entry be removed from the Register; and
2. Shall pay to the Intellectual Property Regulation Board the sum of £47,533.12 pursuant to Chapter 4, paragraph 5.1 of IPReg's Core Regulatory Framework.

Signed.....

Chair of the Disciplinary and Interim Orders Tribunal

06 June 2024