FILED
Jul 13 2023
THE BOARD *of* DISCIPLINARY APPEALS
Appointed by the Supreme Court of Texas

BEFORE THE BOARD OF DISCIPLINARY APPEALS
APPOINTED BY
THE SUPREME COURT OF TEXAS

IN THE MATTER OF	**§**	
RUMIT RANJIT KANAKIA,	**§**	**CAUSE NO.** 68045
STATE BAR CARD NO. 24124286	**§**	

PETITION FOR RECIPROCAL DISCIPLINE

TO THE BOARD OF DISCIPLINARY APPEALS:

Petitioner, the Commission for Lawyer Discipline (hereinafter called "Petitioner"), brings this action against Respondent, Rumit Ranjit Kanakia, (hereinafter called "Respondent"), showing as follows:

1. This action is commenced by Petitioner pursuant to Part IX of the Texas Rules of Disciplinary Procedure. Petitioner is also providing Respondent a copy of Section 7 of this Board's Internal Procedural Rules, relating to Reciprocal Discipline Matters.

2. Respondent is a member of the State Bar of Texas and is licensed and authorized to practice law in Texas. Respondent may be served with a true and correct copy of this Petition for Reciprocal Discipline at Rumit Ranjit Kanakia, 7 Hillingdon, San Antonio, Texas 78209.

3. On or about May 8, 2023, a Final Order Pursuant to 37 C.F.R. § 11.26 (redacted) was entered in a matter styled, Proceeding No. D2023-25, *In the Matter of Rumit R. Kanakia, Respondent*, United States Patent and Trademark Office, Before the Director of the United States Patent and Trademark Office (Exhibit 1), which states in pertinent part:

Joint Legal Conclusions

> 58. Respondent acknowledges that, based on the information contained in the Joint Stipulated Facts, above, that Respondent's acts and omissions violated the following provisions of the USPTO Rules of Professional Conduct:

a. 37 C.F.R. § 11.103 (diligence) *inter alia* by (i) not always conducting a reasonable inquiry under the circumstances as required by 37 C.F.R. § 11.18 prior to claiming micro entity status to the USPTO (*e.g.*, at the time of filing applications or when paying issue fees for issued patents); (ii) failing to have in place reasonable procedures to corroborate information on which he relied to sign micro entity certification forms or otherwise present entity status claims to the USPTO on behalf of applicant (*e.g.*, at the time of filing applications and when paying issue fees for issued patents); (iii) presenting incorrect certifications of micro entity status to the USPTO at the time applications were filed; (iv) claiming micro entity status when authorizing the payment of micro entity issue fees even though the applicant was no longer entitled to micro entity status; and (v) not notifying the USPTO of applicants' loss of micro entity status and not paying the required issue fee in the small entity or undiscounted amount, as appropriate; and

b. 37 C.F.R. § 1 l.804(d) (conduct prejudicial to the administration of the USPTO patent process) *inter alia* by (i) not always conducting a reasonable inquiry under the circumstances as required by 37 C.F.R. § 11.18 prior to claiming micro entity status to the USPTO (*e.g.*, at the time of filing applications or when paying issue fees for issued patents); (ii) failing to have in place reasonable procedures to corroborate information on which he relied to sign micro entity certification forms or otherwise present entity status claims to the USPTO on behalf of applicant (*e.g.*, at the time of filing applications and when paying issue fees for issued patents); (iii) presenting incorrect certifications of micro entity status to the USPTO at the time applications were filed; (iv) claiming micro entity status when authorizing the payment of micro entity issue fees even though the applicant was no longer entitled to micro entity status; and (v) not notifying the USPTO of applicants' loss of micro entity status and not paying the required issue fee in the small entity or undiscounted amount, as appropriate.

Agreed-Upon Sanction

59. Respondent has freely and voluntarily agreed, and it is hereby ORDERED that:

a. Respondent is publicly reprimanded;

b. The OED Director shall electronically publish the Final Order at the OED's electronic FOIA Reading Room, which is publicly accessible through the Office's website at: https://foiadocuments.uspto.gov/oed/;

c. The OED Director shall publish a notice in the *Official Gazette* . . .

4. An official copy of the Final Order (redacted) is attached hereto as Petitioner's Exhibit 1 and made a part hereof for all intents and purposes as if the same were copied verbatim herein. Petitioner expects to introduce a certified copy of Exhibit 1 at the time of hearing of this cause.

5. Petitioner prays that, pursuant to Rule 9.02, Texas Rules of Disciplinary Procedure, this Board issue notice to Respondent, containing a copy of this Petition with exhibits, and an order directing Respondent to show cause within thirty (30) days from the date of the mailing of the notice, why the imposition of the identical discipline in this state would be unwarranted. Petitioner further prays that upon trial of this matter that this Board enter a judgment imposing discipline identical with that imposed by the United States Patent and Trademark Office and that Petitioner have such other and further relief to which it may be entitled.

Respectfully submitted,

Seana Willing
Chief Disciplinary Counsel

Judith Gres DeBerry
Assistant Disciplinary Counsel
Office of the Chief Disciplinary Counsel
State Bar of Texas
P.O. Box 12487
Austin, Texas 78711
Telephone: 512.427.1350
Telecopier: 512.427.4253
Email: judith.deberry@texasbar.com

Judith Gres DeBerry
Bar Card No. 24040780

ATTORNEYS FOR PETITIONER

<u>CERTIFICATE OF SERVICE</u>

I certify that upon receipt of the Order to Show Cause from the Board of Disciplinary Appeals, I will serve a copy of this Petition for Reciprocal Discipline and the Order to Show Cause on Rumit Ranjit Kanakia, by Email as follows:

Rumit Ranjit Kanakia
7 Hillingdon
San Antonio, Texas 78209
<u>Via Email to rumit.kanakia@gmail.com</u>

Judith Gres DeBerry

June 20, 2023

For certified copy purposes, I declare under penalty of perjury that the attached redacted copy of the Final Order in USPTO Proceeding No. D2023-25, *In the Matter of Rumit R. Kanakia* is a true and correct copy of the redacted version of the Final Order in, *In the Matter of Rumit R. Kanakia*, USPTO Proceeding No. D2023-25.

/Christa M. Shaffer/

Christa M. Shaffer
Paralegal Specialist
Office of Enrollment and Discipline

EXHIBIT
1

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

In the Matter of	)	
	)	
Rumit R. Kanakia	)	Proceeding No. D2023-25
	)	
Respondent	)	
	)	

FINAL ORDER PURSUANT TO 37 C.F.R. § 11.26

The Director of the Office of Enrollment and Discipline ("OED Director") for the United States Patent and Trademark Office ("USPTO" or "Office") and Rumit R. Kanakia ("Respondent") have submitted a Proposed Settlement Agreement to the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office ("USPTO Director") for approval.

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

Jurisdiction

1. At all times relevant, Respondent of Mumbai, India, has been a registered patent attorney (USPTO Registration Number 72,461) and, therefore is subject to the USPTO Rules of Professional Conduct, 37 C.F.R. § 11.101 *et seq*.

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

Legal Background

<u>Micro Entity Status for Certain Patent Applicants</u>

3. Certain applicants and patent owners can benefit from a significant reduction on most USPTO fees if they qualify and file the appropriate papers in their application or patent. To benefit from this fee reduction, applicants and patentees must establish "micro entity" status pursuant to 37 C.F.R. § 1.29. *See generally* Manual of Patent Examining Procedure ("MPEP") § 509.04.

4. There are two separate bases for establishing micro entity status. One is referred to as the "gross income basis" under 35 U.S.C. § 123(a), and the other is referred to as the "institution of higher education basis" under 35 U.S.C. § 123(d). *See* MPEP § 509 ("II. Bases for Establishing Micro Entity Status." Under the "gross income basis" for establishing micro entity status, there is a limit to the number of previously filed applications for an applicant to qualify for micro entity status.

5. In order to qualify as a micro entity, patent applicants must certify that:

> (1) the applicant qualifies as a small entity as defined in 37 C.F.R. § 1.27;
>
> (2) neither the applicant nor the inventor nor a joint inventor has been named as the inventor or a joint inventor on more than <u>four</u> previously filed patent applications;
>
> (3) neither the applicant nor the inventor nor a joint inventor, in the calendar year preceding the calendar year in which the applicable fee is being paid, had a gross income . . . exceeding three times the median household income for that preceding calendar year; and
>
> (4) neither the applicant nor the inventor nor a joint inventor has assigned, granted, or conveyed, nor is under an obligation by contract or law to assign, grant, or convey, a license or other ownership interest in the application concerned to an entity that . . . had a gross income . . . exceeding three times the median household income for that preceding calendar year . . . .

See generally 37 CFR § 1.29; MPEP § 509.04 (underline added).

Calculating the "Previously Filed Applications" Limit

6. For purposes of establishing micro entity status under the "gross income" basis, the application filing limit includes: (i) previously filed U.S. nonprovisional applications (e.g., utility, design, plant, continuation, and divisional applications), (ii) previously filed U.S. reissue applications, and (iii) previously filed U.S. national stage applications under the Patent Cooperation Treaty (PCT). *See* MPEP § 509.04(a) ("B. Application Filing Limit")

7. "All such applications naming the inventor or a joint inventor are counted toward the application filing limit, whether the applications were filed before, on, or after March 19, 2013. Further, it does not matter whether the previously filed applications are pending, patented, or abandoned; they are still included when counting to determine whether the application filing limit has been reached." MPEP § 509.04(a) ("B. Application Filing Limit")

8. "The application filing limit does not include: (i) foreign applications; (ii) international (PCT) applications for which the basic U.S. national stage filing fee was not paid; and (iii) provisional applications. In addition, where an applicant, inventor, or joint inventor has assigned, or is under an obligation by contract or law to assign, all ownership rights in the application as the result of the applicant's, inventor's, or joint inventor's previous employment; the applicant, inventor or joint inventor is not considered to be named on the prior filed application for purposes of determining micro entity status. *See* 37 CFR 1.29(b)." MPEP § 509.04(a) ("B. Application Filing Limit")

9. "Because the four application limit is a limit on previously filed U.S. nonprovisional applications, reissues applications, and national stage applications, the maximum number of applications in which fees can be paid at the micro entity discount rate can vary from 0 to 5 for any given inventor." MPEP § 509.04(a) ("B. Application Filing Limit")

Certification of Micro Entity Status

10. “35 U.S.C. 123 requires a certification as a condition for an applicant to be considered a micro entity. The certification must be in writing and must be filed prior to or at the time a fee is first paid in the micro entity amount in an application or patent.” MPEP § 509.04

11. “A fee may be paid in the micro entity amount only if it is submitted with, or subsequent to, the submission of a certification of entitlement to micro entity status. See 37 C.F.R. § 1.29(f).” MPEP § 509.04

12. “Any attempt to fraudulently establish status or pay fees as a micro entity shall be considered as a fraud practiced or attempted on the Office. Improperly, and with intent to deceive, establishing status or paying fees as a micro entity shall be considered as a fraud practiced or attempted on the Office. See 37 CFR 1.29(j).” MPEP § 509.04

Reevaluation of Micro Entity Status; Notifying the USPTO; and Correcting Errors of Micro Entity Status

13. An applicant is not required to provide a certification of micro entity status with each fee payment once micro entity status has been established by filing a certification in an application. *See* MPEP § 509.04(d).

14. While an applicant is not required to provide such a certification with each fee payment, the applicant must still be entitled to micro entity status to pay a fee in the micro entity amount at the time of all payments of fees in the micro entity amount. Thus it must be determined whether the requirements for micro entity status exist at the time each fee payment is made. *See* MPEP § 509.04(d).

15. If any requirement for micro entity status is no longer met, then the applicant must notify the Office of loss of micro entity status and pay the required fee in the small entity or undiscounted amount, as appropriate. *See* MPEP § 509.04(d); *see also* MPEP § 509.04(e).

16. If (a) an applicant or patentee establishes micro entity status in an application or patent in good faith; (b) the applicant or patentee pays fees as a micro entity in the application or patent in good faith; and (c) the applicant or patentee later discovers that such micro entity status either was established in error, or that the Office was not notified of a loss of entitlement to micro entity status as required through error, the error will be excused upon compliance with the separate submission and itemization requirements of 37 C.F.R. § 1.29(k)(1) and the deficiency payment requirement of § 1.29(k)(2). *See* MPEP § 509.04(f).

<u>Certifications to the USPTO when Presenting Papers</u>

17. Registered practitioners make important certifications via 37 C.F.R. § 11.18 whenever presenting (*e.g.*, by signing, filing, submitting, or later advocating) any paper to the USPTO.

18. The registered practitioner certifies that all statements made on his or her own knowledge are true, and that all statements based on the presenter's information and belief are believed to be true. *See* 37 C.F.R. § 11.18(b)(1).

19. The registered practitioner also certifies that:

> [t]o the best of the party's knowledge, information and belief, *formed after an inquiry reasonable under the circumstances* (i) the paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding before the Office; (ii) the other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law; (iii) the allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and (iv) the denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

37 C.F.R. § 11.18(b)(2) (emphasis added). Accordingly, a registered practitioner who presents any paper to the USPTO —including certifications of micro entity status— certifies that he or she has conducted an inquiry reasonable under the circumstances that supports the factual assertions set forth in the paper. *See* 37 C.F.R. § 11.18(b)(2)(iii).

20. Violations of § 11.18 may jeopardize the probative value of the filing, and any false or fraudulent statements are subject to criminal penalty under 18 U.S.C. § 1001. *See* 37 C.F.R. § 11.18(b)(1).

21. Any registered practitioner who violates the provisions of this section may also be subject to disciplinary action. *See* 37 C.F.R. § 11.18(d).

Joint Stipulated Facts

A. <u>Respondent</u>

22. The USPTO registered Respondent as a registered patent attorney (Reg. No. 72,461) on April 7, 2014, and he currently resides in Mumbai, India.

23. Respondent is also an attorney who was licensed by California on June 4, 2013 (California Bar # 289577) and by Texas on July 15, 2021 (Texas Bar # 24124286).

B. <u>KA Filing, KA Partners, and KAanalysis</u>

24. According to publicly available online records from the Florida Department of State, "KA Filing, LLC" is a Florida limited liability company (FEI/EIN Number 83-3415941) located at 2112 W. Marjory Avenue, Tampa, Florida, and its managers are Nilanshu Shekhar, Ashutosh Choudhary, and Wayne V. Harper.

a. Mr. Shekhar and Mr. Choudhary are non-practitioners. *See* 37 C.F.R. § 11.1 (definition of "practitioner"). According to Respondent, Mr. Shekhar and Mr. Choudhary are intellectual property lawyers licensed in India.

b. Mr. Harper is a registered practitioner who is currently on disability inactive status. *See In re Harper*, Proceeding No. D2010-10 (USPTO Oct. 2, 2020 "Notice of Transfer to Disability Inactive Status").

25. Respondent's relationship with KA Filing, LLC began approximately in December 2018 when he was contacted by two individuals who owned the company.

26. Respondent represents that KA Partners is an Indian law firm located in New Delhi, India. Respondent further represents that KA Partners uses the alternative business name, KAnalysis.

27. Respondent's relationship with KA Partners began in or around December 2020 when he starting working directly for KA Partners in an "Of Counsel" capacity.

28. Respondent understands that KA Filing LLC is "U.S. affiliate" of KA Partners and that the two companies have maintained an active business relationship since 2018. According to Respondent, KA Partners and KA Filing LLC are essentially the same entity (*e.g.,* sharing the same office space and office staff).

29. Hereinafter, KA Partners, KAnalysis, and KA Filing are jointly referred to as "KA."

30. KA conducts business with numerous foreign-domiciled companies —including many located in China— that refer patent applicants seeking U.S. patent protection to KA.

31. Respondent understands that the foreign associates include, but are not limited to,

[redacted]

[redacted]

32. Respondent understands that KA is currently managing a portfolio of 15,000 patents in over 80 countries.

33. In December 2020, Respondent became the USPTO registered practitioner of record for thousands of patent clients referred to KA for filing and prosecuting patent applications before the USPTO.

34. Respondent represents that he already gave his notice of resignation and intends to resign from his "Of Counsel" position with KA effective May 31, 2023 due to a personal emergency.

C. <u>USPTO Customer Number for KA Filing</u>

35. In February 2019, the USPTO issued a Customer Number to a registered practitioner previously affiliated with KA. The name and correspondence address for the Customer Number was "KA Filing, LLC., 2112 W. Marjory Ave., Tampa, FL 33606."

36. At all relevant times, Respondent was associated with that Customer Number.

37. From January 15, 2021, through February 3, 2023, Respondent was the only registered practitioner in active status associated with that USPTO Customer Number.

38. Over 4,300 design patent applications were filed with (or received by) the USPTO from January 15, 2021, through February 3, 2023, that are associated with that USPTO Customer Number as of the date of this Agreement.

39. Respondent was the only registered practitioner associated with over 1,850 design patent applications filed with the USPTO in 2022 associated with that Customer Number.

D. <u>Respondent's Improper Certifications of Micro Entity Status</u>

40. Respondent represents that he supervised a team of twelve (12) employees of KA and took charge of its U.S. operations. Respondent's team currently includes two partners and ten support staff including paralegals, draftsmen and office staff. None of the persons on Respondent's team were practitioners. Respondent's team of non-practitioner assistants helped Respondent in obtaining client entity status information besides helping him in all other aspects of his practice.

41. Respondent explained that he and his team had a difficult time obtaining information about the applicant's eligibility for micro entity status. Respondent explained that this was, in part, due to language and cultural barriers and the Respondent relied upon instructions from foreign associates. He also explained how no information about the China-based applicants could readily be found online. Respondent acknowledges that these challenges in no way (a) lessened his obligation to conduct an inquiry reasonable under the circumstances prior to presenting papers to the Office or (b) altered the ethical obligations he owed to clients and the USPTO.

42. The USPTO issued Notices of Payment Deficiency in applications that were filed where the applicant, inventor, or joint inventor was named on more than four previously filed patent applications. Each notice informed applicant that there was *prima facie* evidence that the certification of micro entity was in error because the filing limit was exceeded. Further, each notice informed applicant that to avoid abandonment, if the certification was erroneous, applicant had to provide an itemization of the total deficiency payment and pay the deficiency owed or if applicant asserted the certification of micro entity was not made in error, applicant had to reply with an explanation and necessary evidence that is sufficient to rebut the *prima facie* evidence.

43. Specifically, between August 2021 and February 2022, the USPTO issued a Notice of Payment Deficiency for several design patent applications that were filed under the Customer Number for KA Filing. A review of the notices revealed Mr. Kanakia was responsible for filing the Certification of Micro Entity in fifty-five (55) of those design patent applications, and personally signed the Certification with the USPTO for thirty-seven (37) of those fifty-five (55) applications. Most of the affected applications were filed on behalf of applicants domiciled in China.

44. Based upon the representations made to him by the foreign associate for the applicants, Respondent personally signed the Certification of Micro Entity submitted in thirty-seven (37) of the aforementioned 55 design patent applications. Respondent represents that he signed twenty-seven (27) of the 37 certifications because regulations require that all filings for a juristic entity be signed by the practitioner of record—or if not a juristic entity, by the practitioner or all joint inventors. *See* 37 CFR § 1.33. Respondent represents that ideally, he should have had the inventors sign the certifications in the remaining ten (10) applications; however, he believes he was otherwise permitted to, and in these cases, did so due to the filing requests (i.e., expedited requests or having to coordinate filings on the same exact day in different countries). Respondent acknowledges that his stated reasons for signing the certifications in no way (a) lessened his obligation to conduct an inquiry reasonable under the circumstances prior to presenting papers to the Office or (b) altered the ethical obligations he owed to clients and the USPTO.

45. Respondent acknowledged that mistakes were made by him and his team regarding the above referenced 37 applications that he signed where micro entity status was incorrectly claimed at the time of filing. Respondent acknowledged that his personally signing the USPTO

Form PTO/SB15A in some of the cases may have required some more diligence from him. Contrary to Respondent's position, the OED Director asserts that Respondent's personally signing the USPTO Form PTO/SB15A in cases in fact required some more diligence from Respondent. Respondent acknowledged that mistakes were made, in part, because of docketing problems, namely: applications not appearing in his docketing system. Respondent acknowledges that his problems with his docketing system in no way (a) lessened his obligation to conduct an inquiry reasonable under the circumstances prior to presenting papers to the Office or (b) altered the ethical obligations he owed to clients and the USPTO.

46. Despite changing the entity status and paying the deficiency fee, Respondent represents he reasonably believed that he properly signed and/or filed 27 of the 37 Certifications of Micro Entity Status because, based on his inquiry, the applications: (i) passed his internal checks and publicly available records for the number of filings and/or (ii) appeared to have assigned all ownership rights, or were obligated to assign all ownership rights, as a result of the applicant's previous employment. The OED Director disagrees that Respondent's belief was reasonable or Respondent's inquiry prior to presenting the certifications to the Office was reasonable under the circumstances.

47. Respondent also represents that he reasonably believed that, at the time of filing, his presentation of the Certifications of Micro Entity Status was proper because the requests for micro entity status were submitted to him by foreign associates (a) with whom Respondent's firm had existing relationships, (b) who had been trained as to the qualifications for micro entity status, and (c) his team checked the number of applications filed per applicant/inventor. The OED Director disagrees that Respondent's belief was reasonable or that Respondent's presentations were proper.

48. On thirteen (13) occasions, Respondent also authorized payment of a reduced micro entity patent issue fee for applicants that no longer qualified for micro entity status.

49. Respondent acknowledged that mistakes were made when paying issue fees for applicants who were no longer eligible for micro entity status because he did not have a specific process for verifying the entity status at the time of the payment of the fee.

50. Respondent represents that the period of Respondent's lapses coincided with a Covid wave in India, which was particularly devastating and impacted his firm's ability to function as the whole team was required to work remotely during the lockdown and through illnesses. Respondent acknowledges that his firm's ability to function in no way (a) lessened his obligation to conduct an inquiry reasonable under the circumstances prior to presenting papers to the Office or (b) altered the ethical obligations he owed to clients and the USPTO.

51. Respondent represents that he is currently facing a personal and family emergency. He resigned from the firm and is leaving the practice of law to focus on his family in the near future. Respondent acknowledges that his personal and family emergencies in no way (a) lessened his obligation to conduct an inquiry reasonable under the circumstances prior to presenting papers to the Office or (b) altered the ethical obligations he owed to clients and the USPTO.

52. Since the receipt of the above referenced Notices of Payment Deficiency, Respondent represents that he and his team have helped implement new policies and procedures at KA to help ensure that entity status claims are reasonably and appropriately corroborated before presenting certificates of entity status to the USPTO when filing applications, including the following:

a. Respondent and his team at KA now send a questionnaire for all inventors/applicants to be filled out at intake. The questionnaire is in a language that allows the information to be communicated accurately to the China-domiciled inventors/applicants. The questionnaire warns the inventors and applicants about the consequences of not being accurate with their responses while asking them about the following issues:

i. The questionnaire asks the inventors and applicants to voluntarily list all previous US patent applications in which they have been named as inventors.

ii. The questionnaire asks questions pertaining to inventorship under MPEP § 2109.

iii. The questionnaire provides information and asks questions pertaining to patentability and on sale bar issues under AIA 35 U.S.C. § 102.

iv. The questionnaire asks questions that help the inventor and applicants decide which entity status to claim and informs them of the rules governing entity status discounts under MPEP §2550.

v. The questionnaire warns the inventors and applicants about potential damages from falsely claiming small or micro entity status under the new rules outlined in the Unleashing American Innovators Act of 2022.

vi. The questionnaire asks the inventors and applicants to sign the questionnaire with a handwritten signature.

vii. The questionnaire informs the inventors and applicants about their ongoing duty to disclose any information material to patentability under 37 C.F.R. § 1.56.

b. Respondent and his team at KA have performed an internal audit of all US applications in its docketing system to proactively change the entity status of applications caught in its audit that were erroneously filed claiming micro entity status.

c. KA has assigned personnel to oversee all these checks and is in the process of increasing the personnel in charge of docketing and maintaining the docketing system.

d. Respondent and his team at KA are sending an inquiry email before accepting a clients' additional fees for any deficient fees to further ensure and confirm the client's eligibility for small entity status.

e. Respondent and his team at KA are checking with the client about any changes in entity status at the time of paying any fees (including but not limited to fees for expedited examination, issue fees etc.).

53. In addition, regarding certification of entity status at the time of paying issue fees, Respondent recently informed the partners at KA via email of the following USPTO rules and practices to be followed to comply with such rules:

a. While an applicant is not required to provide a certification of micro entity status with each fee payment, the applicant must still be entitled to micro entity status to pay a fee in the micro entity amount at the time of all payments of fees in the micro entity amount. Therefore, it must be determined whether the requirements for micro entity status exist at the time each fee payment is made and regardless of if there is a notice of loss of micro entity status issued by the Office.

b. Adequate measures are to be in place to ensure that, at the time an applicant or patentee pays fees (*e.g.*, including but not limited to patent issue fees), the applicant or patentee is still entitled to micro entity status to pay a fee in the micro entity amount.

c. The USPTO rules and regulations provide that, if any requirement for micro entity status is no longer met, the applicant must notify the Office of loss of micro entity status and pay the required fee in the small entity or undiscounted amount, as appropriate, as set forth in MPEP § 509.04(e).

d. The USPTO rules and regulations provide that, if (a) an applicant or patentee establishes micro entity status in an application or patent in good faith, (b) the applicant or patentee pays fees as a micro entity in the application or patent in good faith, and (c) the applicant or patentee later discovers that such micro entity status either was established in error, or that the Office was not notified of a loss of entitlement to micro entity status as required through error, the error will be excused upon compliance with the separate submission and itemization requirements of 37 C.F.R. § 1.29(k)(1) and the deficiency payment requirement of 37 C.F.R. § 1.29(k)(2), as set forth in MPEP § 509.04(f).

Additional Considerations

54. Respondent has never been the subject of professional discipline by the USPTO, and he represents that he has not been disciplined on ethical grounds by any other jurisdiction.

55. Respondent has acknowledged his lapses in conducting inquiries reasonable under the circumstances as required by 37 C.F.R. § 11.18 when presenting entity status claims to the USPTO; demonstrated genuine contrition for such lapses; and accepted responsibility for his acts and omissions.

56. Respondent fully cooperated with OED's investigation by conducting a voluntary interview with OED and by providing *sua sponte* informative, supplemental responses to his original response to OED's request for information.

57. Respondent took *sua sponte* action to endeavor to comply with the professional responsibilities set forth in the USPTO Rules of Professional Conduct after he received the Notices and before the OED inquiry.

Joint Legal Conclusions

58. Respondent acknowledges that, based on the information contained in the Joint Stipulated Facts, above, that Respondent's acts and omissions violated the following provisions of the USPTO Rules of Professional Conduct:

a. 37 C.F.R. § 11.103 (diligence) *inter alia* by (i) not always conducting a reasonable inquiry under the circumstances as required by 37 C.F.R. § 11.18 prior to claiming micro entity status to the USPTO (*e.g.*, at the time of filing applications or when paying issue fees for issued patents); (ii) failing to have in place reasonable procedures to corroborate information on which he relied to sign micro entity certification forms or otherwise present entity status claims to the USPTO on behalf of applicant (*e.g.*, at the time of filing applications and when paying issue fees for issued patents); (iii) presenting incorrect certifications of micro entity status to the USPTO at the time applications were filed; (iv) claiming micro entity status when authorizing the payment of micro entity issue fees even though the applicant was no longer entitled to micro entity status; and (v) not notifying the USPTO of applicants' loss of micro entity status and not paying the required issue fee in the small entity or undiscounted amount, as appropriate; and

b. 37 C.F.R. § 11.804(d) (conduct prejudicial to the administration of the USPTO patent process) *inter alia* by (i) not always conducting a reasonable inquiry under the circumstances as required by 37 C.F.R. § 11.18 prior to claiming micro entity status to the USPTO (*e.g.*, at the time of filing applications or when paying issue fees for issued patents); (ii) failing to have in place reasonable procedures to corroborate information on which he relied to sign micro entity certification forms or otherwise present entity status claims to the USPTO on behalf of applicant (*e.g.*, at the time of filing applications and when paying issue fees for issued patents); (iii) presenting incorrect certifications of micro entity status to the USPTO at the time applications were filed; (iv) claiming micro entity status when authorizing the payment of micro entity issue fees even though the applicant was no longer entitled to micro entity status; and (v) not notifying the USPTO of applicants' loss of micro entity status and not paying the required issue fee in the small entity or undiscounted amount, as appropriate.

Agreed-Upon Sanction

59. Respondent has freely and voluntarily agreed, and it is hereby ORDERED that:

a. Respondent is publicly reprimanded;

b. The OED Director shall electronically publish the Final Order at the OED's electronic FOIA Reading Room, which is publicly accessible through the Office's website at: https://foiadocuments.uspto.gov/oed/;

c. The OED Director shall publish a notice in the *Official Gazette* that is materially consistent with the following:

Notice of Reprimand

This notice concerns Rumit R. Kanakia of Mumbai, India, who is a registered patent attorney (Registration Number 72,461). Mr. Kanakia is hereby reprimanded for violating 37 C.F.R. §§ 11.103 (failing to act with reasonable diligence in representing a client) and 11.804(d) (engaging in conduct that is prejudicial to the integrity of the patent process). The reprimand is predicated upon his violations of these provisions of the United States Patent and Trademark Office ("USPTO" or "Office") Rules of Professional Conduct in connection with Mr. Kanakia (i) not always conducting a reasonable inquiry under the circumstances as required by 37 C.F.R. § 11.18 prior to claiming micro entity status to the USPTO (*e.g.*, at the time of filing applications or when paying issue fees for issued patents); (ii) failing to have in place reasonable procedures to corroborate information on which he relied to sign micro entity certification forms or otherwise present entity status claims to the USPTO on behalf of applicant (*e.g.*, at the time of filing applications and when paying issue fees for issued patents); (iii) presenting incorrect certifications of micro entity status to the USPTO at the time applications were filed; (iv) claiming micro entity status when authorizing the payment of micro entity issue fees even though the applicant was no longer entitled to micro entity status; and (v) not notifying the USPTO of applicants' loss of micro entity status and not paying the required issue fee in the small entity or undiscounted amount, as appropriate.

Mr. Kanakia worked for (a) KA Filing, LLC, a Florida company and (b) KA Partners, an Indian law firm located in New Delhi, India, that uses the alternative business name, KAnalysis (jointly referred to as "KA"). Mr. Kanakia represented that KA Partners and KA Filing are essentially the same entity and have business relationships with numerous foreign-domiciled companies —including many located in China— that refer patent applicants seeking U.S. patent protection to KA Partners and KA Filing.

At all relevant times, Mr. Kanakia's team of non-practitioner assistants at KA helped Mr. Kanakia in obtaining client entity status information. Mr. Kanakia explained that he and his team had a difficult time obtaining information about the applicant's eligibility for micro entity status especially due to language and cultural barriers. He also explained how no information about the China-based applicants could readily be found online. Respondent acknowledges that these challenges in no way (a) lessened his obligation to conduct an inquiry reasonable under the circumstances prior to presenting papers to the Office or (b) altered the ethical obligations he owed to clients and the USPTO.

The USPTO issued a Notice of Payment Deficiency for fifty-five (55) design patent applications that were filed under the Customer Number for KA Filing that Mr. Kanakia was responsible for filing. A review of the fifty-five applications revealed Mr. Kanakia was responsible for filing the Certifications of Micro Entity and personally signing the Certification with the USPTO for thirty-seven (37) design patent applications. Most of the affected applications were filed on behalf of applicants domiciled in China. Based upon the representations made to him by the foreign associate for the applicants, Respondent personally signed the Certification of Micro Entity submitted in 37 of the aforementioned 55 design patent applications.

Respondent acknowledged that mistakes were made by him and his team at KA regarding the above referenced 37 applications that he signed where micro entity status was incorrectly claimed at the time of filing. Respondent acknowledged that these mistakes were made, in part, because of docketing problems. Respondent acknowledges that his problems with his docketing system in no way (a) lessened his obligation to conduct an inquiry reasonable under the circumstances prior to presenting papers to the Office or (b) altered the ethical obligations he owed to clients and the USPTO.

Respondent also acknowledged that mistakes were made when paying issue fees for applicants who were no longer eligible for micro entity status. Respondent acknowledged that these mistakes were made because he did not have a specific process for verifying the entity status at the time of the payment of the fee.

Registered practitioners are reminded of their obligations under 37 C.F.R. § 11.8 to conduct an inquiry reasonable under the circumstances whenever presenting assertions of micro or small entity status to the USPTO on behalf of a client (*e.g.*, when paying a patent application fee or patent issue fee). Any attempt to fraudulently establish status or pay fees as a micro entity shall be considered as a fraud practiced or attempted on the Office. Establishing entity status or paying fees as a micro entity improperly and with intent to deceive shall be considered as a fraud practiced or attempted on the Office. *See* 37 C.F.R. § 1.29(j); MPEP § 509.04. Violations of § 11.18 may jeopardize the probative value of the filing, and any false or fraudulent statements are subject to criminal penalty under 18 U.S.C. § 1001. *See* 37 C.F.R. § 11.18(b)(1). Any registered practitioner who violates the provisions of this section may also be subject to disciplinary action. *See* 37 C.F.R. § 11.18(d).

Registered practitioners are also reminded that, even though an applicant is not required to provide a certification of micro entity status with each fee payment once micro entity status has been established by filing a certification in an application (*see* MPEP § 509.04(d)), the applicant must still be entitled to micro entity status to pay a fee in the micro entity amount at the time of all payments of fees in the micro entity amount. Thus, it must be determined whether the requirements for micro entity status exist at the time each fee payment is made. *See* MPEP § 509.04(d). If any requirement for micro entity status is no longer met, the applicant must notify the Office of loss of micro entity status and pay the required fee in the small entity or undiscounted amount, as appropriate. *See* MPEP § 509.04(d); *see also* MPEP § 509.04(e).

In reaching this Agreement, the Office of Enrollment and Discipline ("OED") Director took into account that (a) Mr. Kanakia has never been the subject of professional discipline by the USPTO and Mr. Kanakia represents that he has not been disciplined on ethical grounds by any other jurisdiction; (b) Mr. Kanakia has acknowledged his lapses in conducting inquiries reasonable under the circumstances as required by 37 C.F.R. § 11.18 when presenting entity status claims

> to the USPTO; demonstrated genuine contrition for such lapses; and accepted responsibility for his acts and omissions; (c) Mr. Kanakia cooperated with OED's investigation by offering to conduct an interview with OED and by providing *sua sponte* informative, supplemental responses to his original response to OED's request for information; and (d) Mr. Kanakia took *sua sponte* action to endeavor to comply with the professional responsibilities set forth in the USPTO Rules of Professional Conduct.
>
> This action is the result of a settlement agreement between Respondent and the OED Director pursuant to the provisions of 35 U.S.C. §§ 2(b)(2)(D) and 32 and 37 C.F.R. §§ 11.19, 11.20, and 11.26. Disciplinary decisions involving practitioners are posted for public reading at the Office of Enrollment and Discipline Reading Room accessible at: https://foiadocuments.uspto.gov/oed/;

d. Respondent shall cooperate fully with the USPTO in any present or future USPTO inquiry made into improper filings by KA Filing, KA Partners (a.k.a. KAnalysis), or any foreign associates with whom these two companies have worked or to whom Mr. Kanakia has provided patent legal services.

e. Respondent shall (1) provide a copy of the Final Order to KA Filing and KA Partners (a.k.a. KAnalysis); the owners of these two companies; and to all officers, directors, and managers of these two companies and (2) retain copies of all notices sent and maintain records of the various steps taken under this subparagraph;

f. The OED Director shall provide a copy of the Final Order to all registered practitioners associated with the Customer Number referenced above as of the effective date of the Final Order.

g. The OED Director shall provide a copy of the Final Order to KA Filing's managers as identified in the public records of the Florida Department of State, at 2112 W. Marjory Avenue, Tampa, FL 33606.

h. Nothing in this Agreement or the Final Order shall prevent the Office from considering the record of this disciplinary proceeding, including the Final Order: (1) when addressing any further complaint or evidence of the same or similar misconduct concerning Respondent brought to the attention of the Office and (2) in any future disciplinary proceeding against Respondent (i) as an aggravating factor to be taken into consideration in determining any discipline to be imposed, and/or (ii) to rebut any statement or representation by or on Respondent's behalf;

i. Respondent, by his agreement, has waived all rights to seek reconsideration of the Final Order under 37 C.F.R. § 11.56, waived the right to have the Final Order reviewed under 37 C.F.R. § 11.57, and waived the right otherwise to appeal or challenge the Final Order in any manner; and

j. Each party shall each bear their own costs incurred to date and in carrying out the terms of this Agreement and any Final Order.

Users, Shewchuk, David

Digitally signed by Users, Shewchuk, David
Date: 2023.05.08 16:26:29 -04'00'

David Shewchuk Deputy General Counsel for General Law United States Patent and Trademark Office	Date

on delegated authority by

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

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that the foregoing Final Order was sent, on this day, to the parties via email-

Emil Ali
emil@mccabeali.com
Counsel for Respondent

Hendrik deBoer
[redacted]
Counsel for the OED Director

Users, Walker, Robert (Shawn)
Digitally signed by Users, Walker, Robert (Shawn)
Date: 2023.05.09 13:04:39 -04'00'

Date

United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

INTERNAL PROCEDURAL RULES

BOARD OF DISCIPLINARY APPEALS

Current through June 21, 2018

Contents

I. GENERAL PROVISIONS 1

Rule 1.01. Definitions 1

Rule 1.02. General Powers 1

Rule 1.03. Additional Rules in Disciplinary Matters 1

Rule 1.04. Appointment of Panels 1

Rule 1.05. Filing of Pleadings, Motions, and Other Papers 1

Rule 1.06. Service of Petition 2

Rule 1.07. Hearing Setting and Notice 2

Rule 1.08. Time to Answer 2

Rule 1.09. Pretrial Procedure 2

Rule 1.10. Decisions 3

Rule 1.11. Board of Disciplinary Appeals Opinions 3

Rule 1.12. BODA Work Product and Drafts 3

Rule 1.13. Record Retention 3

Rule 1.14. Costs of Reproduction of Records 3

Rule 1.15. Publication of These Rules 3

II. ETHICAL CONSIDERATIONS 3

Rule 2.01. Representing or Counseling Parties in Disciplinary Matters and Legal Malpractice Cases 3

Rule 2.02. Confidentiality 4

Rule 2.03. Disqualification and Recusal of BODA Members 4

III. CLASSIFICATION APPEALS 4

Rule 3.01. Notice of Right to Appeal 4

Rule 3.02. Record on Appeal 4

IV. APPEALS FROM EVIDENTIARY PANEL HEARINGS 4

Rule 4.01. Perfecting Appeal 4

Rule 4.02. Record on Appeal 5

Rule 4.03. Time to File Record 6

Rule 4.04. Copies of the Record 6

Rule 4.05. Requisites of Briefs 6

Rule 4.06. Oral Argument 7

Rule 4.07. Decision and Judgment 7

Rule 4.08. Appointment of Statewide Grievance Committee 8

Rule 4.09. Involuntary Dismissal 8

V. PETITIONS TO REVOKE PROBATION 8

Rule 5.01. Initiation and Service 8

Rule 5.02. Hearing 8

VI. COMPULSORY DISCIPLINE **8**
Rule 6.01. Initiation of Proceeding 8
Rule 6.02. Interlocutory Suspension 8
VII. RECIPROCAL DISCIPLINE **9**
Rule 7.01. Initiation of Proceeding 9
Rule 7.02. Order to Show Cause 9
Rule 7.03. Attorney's Response 9
VIII. DISTRICT DISABILITY COMMITTEE HEARINGS **9**
Rule 8.01. Appointment of District Disability Committee 9
Rule 8.02. Petition and Answer 9
Rule 8.03. Discovery 9
Rule 8.04. Ability to Compel Attendance 10
Rule 8.05. Respondent's Right to Counsel 10
Rule 8.06. Hearing 10
Rule 8.07. Notice of Decision 10
Rule 8.08. Confidentiality 10
IX. DISABILITY REINSTATEMENTS **10**
Rule 9.01. Petition for Reinstatement 10
Rule 9.02. Discovery 10
Rule 9.03. Physical or Mental Examinations 10
Rule 9.04. Judgment 10
X. APPEALS FROM BODA TO THE SUPREME COURT OF TEXAS **11**
Rule 10.01. Appeals to the Supreme Court 11

INTERNAL PROCEDURAL RULES
Board of Disciplinary Appeals

Current through June 21, 2018

I. GENERAL PROVISIONS

Rule 1.01. Definitions

(a) "BODA" is the Board of Disciplinary Appeals.

(b) "Chair" is the member elected by BODA to serve as chair or, in the Chair's absence, the member elected by BODA to serve as vice-chair.

(c) "Classification" is the determination by the CDC under TRDP 2.10 or by BODA under TRDP 7.08(C) whether a grievance constitutes a "complaint" or an "inquiry."

(d) "BODA Clerk" is the executive director of BODA or other person appointed by BODA to assume all duties normally performed by the clerk of a court.

(e) "CDC" is the Chief Disciplinary Counsel for the State Bar of Texas and his or her assistants.

(f) "Commission" is the Commission for Lawyer Discipline, a permanent committee of the State Bar of Texas.

(g) "Executive Director" is the executive director of BODA.

(h) "Panel" is any three-member grouping of BODA under TRDP 7.05.

(i) "Party" is a Complainant, a Respondent, or the Commission.

(j) "TDRPC" is the Texas Disciplinary Rules of Professional Conduct.

(k) "TRAP" is the Texas Rules of Appellate Procedure.

(l) "TRCP" is the Texas Rules of Civil Procedure.

(m) "TRDP" is the Texas Rules of Disciplinary Procedure.

(n) "TRE" is the Texas Rules of Evidence.

Rule 1.02. General Powers

Under TRDP 7.08, BODA has and may exercise all the powers of either a trial court or an appellate court, as the case may be, in hearing and determining disciplinary proceedings. But TRDP 15.01 [17.01] applies to the enforcement of a judgment of BODA.

Rule 1.03. Additional Rules in Disciplinary Matters

Except as varied by these rules and to the extent applicable, the TRCP, TRAP, and TRE apply to all disciplinary matters before BODA, except for appeals from classification decisions, which are governed by TRDP 2.10 and by Section 3 of these rules.

Rule 1.04. Appointment of Panels

(a) BODA may consider any matter or motion by panel, except as specified in (b). The Chair may delegate to the Executive Director the duty to appoint a panel for any BODA action. Decisions are made by a majority vote of the panel; however, any panel member may refer a matter for consideration by BODA sitting en banc. Nothing in these rules gives a party the right to be heard by BODA sitting en banc.

(b) Any disciplinary matter naming a BODA member as Respondent must be considered by BODA sitting en banc. A disciplinary matter naming a BODA staff member as Respondent need not be heard en banc.

Rule 1.05. Filing of Pleadings, Motions, and Other Papers

(a) **Electronic Filing.** All documents must be filed electronically. Unrepresented persons or those without the means to file electronically may electronically file documents, but it is not required.

(1) Email Address. The email address of an attorney or an unrepresented party who electronically files a document must be included on the document.

(2) Timely Filing. Documents are filed electronically by emailing the document to the BODA Clerk at the email address designated by BODA for that purpose. A document filed by email will be considered filed the day that the email is sent. The date sent is the date shown for the message in the inbox of the email account designated for receiving filings. If a document is sent after 5:00 p.m. or on a weekend or holiday officially observed by the State of Texas, it is considered filed the next business day.

(3) It is the responsibility of the party filing a document by email to obtain the correct email address for BODA and to confirm that the document was received by BODA in legible form. Any document that is illegible or that cannot be opened as part of an email attachment will not be considered filed. If a document is untimely due to a technical failure or a system outage, the filing party may seek appropriate relief from BODA.

(4) Exceptions.

(i) An appeal to BODA of a decision by the CDC to classify a grievance as an inquiry is not required to be filed electronically.

(ii) The following documents must not be filed electronically:

a) documents that are filed under seal or subject to a pending motion to seal; and

b) documents to which access is otherwise restricted by court order.

(iii) For good cause, BODA may permit a party to file other documents in paper form in a particular case.

(5) Format. An electronically filed document must:

(i) be in text-searchable portable document format (PDF);

(ii) be directly converted to PDF rather than scanned, if possible; and

(iii) not be locked.

(b) A paper will not be deemed filed if it is sent to an individual BODA member or to another address other than the address designated by BODA under Rule 1.05(a)(2).

(c) **Signing.** Each brief, motion, or other paper filed must be signed by at least one attorney for the party or by the party pro se and must give the State Bar of Texas card number, mailing address, telephone number, email address, and fax number, if any, of each attorney whose name is signed or of the party (if applicable). A document is considered signed if the document includes:

(1) an "/s/" and name typed in the space where the signature would otherwise appear, unless the document is notarized or sworn; or

(2) an electronic image or scanned image of the signature.

(d) **Paper Copies.** Unless required by BODA, a party need not file a paper copy of an electronically filed document.

(e) **Service.** Copies of all documents filed by any party other than the record filed by the evidentiary panel clerk or the court reporter must, at or before the time of filing, be served on all other parties as required and authorized by the TRAP.

Rule 1.06. Service of Petition

In any disciplinary proceeding before BODA initiated by service of a petition on the Respondent, the petition must be served by personal service; by certified mail with return receipt requested; or, if permitted by BODA, in any other manner that is authorized by the TRCP and reasonably calculated under all the circumstances to apprise the Respondent of the proceeding and to give him or her reasonable time to appear and answer. To establish service by certified mail, the return receipt must contain the Respondent's signature.

Rule 1.07. Hearing Setting and Notice

(a) **Original Petitions.** In any kind of case initiated by the CDC's filing a petition or motion with BODA, the CDC may contact the BODA Clerk for the next regularly available hearing date before filing the original petition. If a hearing is set before the petition is filed, the petition must state the date, time, and place of the hearing. Except in the case of a petition to revoke probation under TRDP 2.23 [2.22], the hearing date must be at least 30 days from the date that the petition is served on the Respondent.

(b) **Expedited Settings.** If a party desires a hearing on a matter on a date earlier than the next regularly available BODA hearing date, the party may request an expedited setting in a written motion setting out the reasons for the request. Unless the parties agree otherwise, and except in the case of a petition to revoke probation under TRDP 2.23 [2.22], the expedited hearing setting must be at least 30 days from the date of service of the petition, motion, or other pleading. BODA has the sole discretion to grant or deny a request for an expedited hearing date.

(c) **Setting Notices.** BODA must notify the parties of any hearing date that is not noticed in an original petition or motion.

(d) **Announcement Docket.** Attorneys and parties appearing before BODA must confirm their presence and present any questions regarding procedure to the BODA Clerk in the courtroom immediately prior to the time docket call is scheduled to begin. Each party with a matter on the docket must appear at the docket call to give an announcement of readiness, to give a time estimate for the hearing, and to present any preliminary motions or matters. Immediately following the docket call, the Chair will set and announce the order of cases to be heard.

Rule 1.08. Time to Answer

The Respondent may file an answer at any time, except where expressly provided otherwise by these rules or the TRDP, or when an answer date has been set by prior order of BODA. BODA may, but is not required to, consider an answer filed the day of the hearing.

Rule 1.09. Pretrial Procedure

(a) **Motions.**

(1) Generally. To request an order or other relief, a party must file a motion supported by sufficient cause with proof of service on all other parties. The motion must state with particularity the grounds on which it is based and set forth the relief sought. All supporting briefs, affidavits, or other documents must be served and filed with the motion. A party may file a response to a motion at any time before BODA rules on the motion or by any deadline set by BODA. Unless otherwise required by these rules or the TRDP, the form of a motion must comply with the TRCP or the TRAP.

(2) For Extension of Time. All motions for extension of time in any matter before BODA must be in writing, comply with (a)(1), and specify the following:

(i) if applicable, the date of notice of decision of the evidentiary panel, together with the number and style of the case;

(ii) if an appeal has been perfected, the date when the appeal was perfected;

(iii) the original deadline for filing the item in question;

(iv) the length of time requested for the extension;

(v) the number of extensions of time that have been granted previously regarding the item in question; and

(vi) the facts relied on to reasonably explain the need for an extension.

(b) **Pretrial Scheduling Conference.** Any party may request a pretrial scheduling conference, or BODA on its own motion may require a pretrial scheduling conference.

(c) **Trial Briefs.** In any disciplinary proceeding before BODA, except with leave, all trial briefs and memoranda must be filed with the BODA Clerk no later than ten days before the day of the hearing.

(d) **Hearing Exhibits, Witness Lists, and Exhibits Tendered for Argument.** A party may file a witness list, exhibit, or any other document to be used at a hearing or oral argument before the hearing or argument. A party must bring to the hearing an original and 12 copies of any document that was not filed at least one business day before the hearing. The original and copies must be:

(1) marked;

(2) indexed with the title or description of the item offered as an exhibit; and

(3) if voluminous, bound to lie flat when open and tabbed in accordance with the index.

All documents must be marked and provided to the opposing party before the hearing or argument begins.

Rule 1.10. Decisions

(a) **Notice of Decisions.** The BODA Clerk must give notice of all decisions and opinions to the parties or their attorneys of record.

(b) **Publication of Decisions.** BODA must report judgments or orders of public discipline:

(1) as required by the TRDP; and

(2) on its website for a period of at least ten years following the date of the disciplinary judgment or order.

(c) **Abstracts of Classification Appeals.** BODA may, in its discretion, prepare an abstract of a classification appeal for a public reporting service.

Rule 1.11. Board of Disciplinary Appeals Opinions

(a) BODA may render judgment in any disciplinary matter with or without written opinion. In accordance with TRDP 6.06, all written opinions of BODA are open to the public and must be made available to the public reporting services, print or electronic, for publishing. A majority of the members who participate in considering the disciplinary matter must determine if an opinion will be written. The names of the participating members must be noted on all written opinions of BODA.

(b) Only a BODA member who participated in the decision of a disciplinary matter may file or join in a written opinion concurring in or dissenting from the judgment of BODA. For purposes of this rule, in hearings in which evidence is taken, no member may participate in the decision unless that member was present at the hearing. In all other proceedings, no member may participate unless that member has reviewed the record. Any member of BODA may file a written opinion in connection with the denial of a hearing or rehearing en banc.

(c) A BODA determination in an appeal from a grievance classification decision under TRDP 2.10 is not a judgment for purposes of this rule and may be issued without a written opinion.

Rule 1.12. BODA Work Product and Drafts

A document or record of any nature—regardless of its form, characteristics, or means of transmission—that is created or produced in connection with or related to BODA's adjudicative decision-making process is not subject to disclosure or discovery. This includes documents prepared by any BODA member, BODA staff, or any other person acting on behalf of or at the direction of BODA.

Rule 1.13. Record Retention

Records of appeals from classification decisions must be retained by the BODA Clerk for a period of at least three years from the date of disposition. Records of other disciplinary matters must be retained for a period of at least five years from the date of final judgment, or for at least one year after the date a suspension or disbarment ends, whichever is later. For purposes of this rule, a record is any document, paper, letter, map, book, tape, photograph, film, recording, or other material filed with BODA, regardless of its form, characteristics, or means of transmission.

Rule 1.14. Costs of Reproduction of Records

The BODA Clerk may charge a reasonable amount for the reproduction of nonconfidential records filed with BODA. The fee must be paid in advance to the BODA Clerk.

Rule 1.15. Publication of These Rules

These rules will be published as part of the TDRPC and TRDP.

II. ETHICAL CONSIDERATIONS

Rule 2.01. Representing or Counseling Parties in Disciplinary Matters and Legal Malpractice Cases

(a) A current member of BODA must not represent a party or testify voluntarily in a disciplinary action or proceeding. Any BODA member who is subpoenaed or otherwise compelled to appear at a disciplinary action or proceeding, including at a deposition, must promptly notify the BODA Chair.

(b) A current BODA member must not serve as an expert witness on the TDRPC.

(c) A BODA member may represent a party in a legal malpractice case, provided that he or she is later recused in accordance with these rules from any proceeding before BODA arising out of the same facts.

Rule 2.02. Confidentiality

(a) BODA deliberations are confidential, must not be disclosed by BODA members or staff, and are not subject to disclosure or discovery.

(b) Classification appeals, appeals from evidentiary judgments of private reprimand, appeals from an evidentiary judgment dismissing a case, interlocutory appeals or any interim proceedings from an ongoing evidentiary case, and disability cases are confidential under the TRDP. BODA must maintain all records associated with these cases as confidential, subject to disclosure only as provided in the TRDP and these rules.

(c) If a member of BODA is subpoenaed or otherwise compelled by law to testify in any proceeding, the member must not disclose a matter that was discussed in conference in connection with a disciplinary case unless the member is required to do so by a court of competent jurisdiction

Rule 2.03. Disqualification and Recusal of BODA Members

(a) BODA members are subject to disqualification and recusal as provided in TRCP 18b.

(b) BODA members may, in addition to recusals under (a), voluntarily recuse themselves from any discussion and voting for any reason. The reasons that a BODA member is recused from a case are not subject to discovery.

(c) These rules do not disqualify a lawyer who is a member of, or associated with, the law firm of a BODA member from serving on a grievance committee or representing a party in a disciplinary proceeding or legal malpractice case. But a BODA member must recuse himor herself from any matter in which a lawyer who is a member of, or associated with, the BODA member's firm is a party or represents a party.

III. CLASSIFICATION APPEALS

Rule 3.01. Notice of Right to Appeal

(a) If a grievance filed by the Complainant under TRDP 2.10 is classified as an inquiry, the CDC must notify the Complainant of his or her right to appeal as set out in TRDP 2.10 or another applicable rule.

(b) To facilitate the potential filing of an appeal of a grievance classified as an inquiry, the CDC must send the Complainant an appeal notice form, approved by BODA, with the classification disposition. The form must include the docket number of the matter; the deadline for appealing; and information for mailing, faxing, or emailing the appeal notice form to BODA. The appeal notice form must be available in English and Spanish.

Rule 3.02. Record on Appeal

BODA must only consider documents that were filed with the CDC prior to the classification decision. When a notice of appeal from a classification decision has been filed, the CDC must forward to BODA a copy of the grievance and all supporting documentation. If the appeal challenges the classification of an amended grievance, the CDC must also send BODA a copy of the initial grievance, unless it has been destroyed.

IV. APPEALS FROM EVIDENTIARY PANEL HEARINGS

Rule 4.01. Perfecting Appeal

(a) **Appellate Timetable.** The date that the evidentiary judgment is signed starts the appellate timetable under this section. To make TRDP 2.21 [2.20] consistent with this requirement, the date that the judgment is signed is the "date of notice" under Rule 2.21 [2.20].

(b) **Notification of the Evidentiary Judgment.** The clerk of the evidentiary panel must notify the parties of the judgment as set out in TRDP 2.21 [2.20].

(1) The evidentiary panel clerk must notify the Commission and the Respondent in writing of the judgment. The notice must contain a clear statement that any appeal of the judgment must be filed with BODA within 30 days of the date that the judgment was signed. The notice must include a copy of the judgment rendered.

(2) The evidentiary panel clerk must notify the Complainant that a judgment has been rendered and provide a copy of the judgment, unless the evidentiary panel dismissed the case or imposed a private reprimand. In the case of a dismissal or private reprimand, the evidentiary panel clerk must notify the Complainant of the decision and that the contents of the judgment are confidential. Under TRDP 2.16, no additional information regarding the contents of a judgment of dismissal or private reprimand may be disclosed to the Complainant.

(c) **Filing Notice of Appeal.** An appeal is perfected when a written notice of appeal is filed with BODA. If a notice of appeal and any other accompanying documents are mistakenly filed with the evidentiary panel clerk, the notice is deemed to have been filed the same day with BODA, and the evidentiary panel clerk must immediately send the BODA Clerk a copy of the notice and any accompanying documents.

(d) **Time to File.** In accordance with TRDP 2.24 [2.23], the notice of appeal must be filed within 30 days after the date the judgment is signed. In the event a motion for new trial or motion to modify the judgment is timely filed with the evidentiary panel, the notice of appeal must be filed with BODA within 90 days from the date the judgment is signed.

(e) **Extension of Time.** A motion for an extension of time to file the notice of appeal must be filed no later than 15 days after the last day allowed for filing the notice of appeal. The motion must comply with Rule 1.09.

Rule 4.02. Record on Appeal

(a) **Contents.** The record on appeal consists of the evidentiary panel clerk's record and, where necessary to the appeal, a reporter's record of the evidentiary panel hearing.

(b) **Stipulation as to Record.** The parties may designate parts of the clerk's record and the reporter's record to be included in the record on appeal by written stipulation filed with the clerk of the evidentiary panel.

(c) **Responsibility for Filing Record.**

(1) Clerk's Record.

(i) After receiving notice that an appeal has been filed, the clerk of the evidentiary panel is responsible for preparing, certifying, and timely filing the clerk's record.

(ii) Unless the parties stipulate otherwise, the clerk's record on appeal must contain the items listed in TRAP 34.5(a) and any other paper on file with the evidentiary panel, including the election letter, all pleadings on which the hearing was held, the docket sheet, the evidentiary panel's charge, any findings of fact and conclusions of law, all other pleadings, the judgment or other orders appealed from, the notice of decision sent to each party, any postsubmission pleadings and briefs, and the notice of appeal.

(iii) If the clerk of the evidentiary panel is unable for any reason to prepare and transmit the clerk's record by the due date, he or she must promptly notify BODA and the parties, explain why the clerk's record cannot be timely filed, and give the date by which he or she expects the clerk's record to be filed.

(2) Reporter's Record.

(i) The court reporter for the evidentiary panel is responsible for timely filing the reporter's record if:

a) a notice of appeal has been filed;

b) a party has requested that all or part of the reporter's record be prepared; and

c) the party requesting all or part of the reporter's record has paid the reporter's fee or has made satisfactory arrangements with the reporter.

(ii) If the court reporter is unable for any reason to prepare and transmit the reporter's record by the due date, he or she must promptly notify BODA and the parties, explain the reasons why the reporter's record cannot be timely filed, and give the date by which he or she expects the reporter's record to be filed.

(d) **Preparation of Clerk's Record.**

(1) To prepare the clerk's record, the evidentiary panel clerk must:

(i) gather the documents designated by the parties' written stipulation or, if no stipulation was filed, the documents required under (c)(1)(ii);

(ii) start each document on a new page;

(iii) include the date of filing on each document;

(iv) arrange the documents in chronological order, either by the date of filing or the date of occurrence;

(v) number the pages of the clerk's record in the manner required by (d)(2);

(vi) prepare and include, after the front cover of the clerk's record, a detailed table of contents that complies with (d)(3); and

(vii) certify the clerk's record.

(2) The clerk must start the page numbering on the front cover of the first volume of the clerk's record and continue to number all pages consecutively—including the front and back covers, tables of contents, certification page, and separator pages, if any—until the final page of the clerk's record, without regard for the number of volumes in the clerk's record, and place each page number at the bottom of each page.

(3) The table of contents must:

(i) identify each document in the entire record (including sealed documents); the date each document was filed; and, except for sealed documents, the page on which each document begins;

(ii) be double-spaced;

(iii) conform to the order in which documents appear in the clerk's record, rather than in alphabetical order;

(iv) contain bookmarks linking each description in the table of contents (except for descriptions of sealed documents) to the page on which the document begins; and

(v) if the record consists of multiple volumes, indicate the page on which each volume begins.

(e) **Electronic Filing of the Clerk's Record.** The evidentiary panel clerk must file the record electronically. When filing a clerk's record in electronic form, the evidentiary panel clerk must:

(1) file each computer file in text-searchable Portable Document Format (PDF);

(2) create electronic bookmarks to mark the first page of each document in the clerk's record;

(3) limit the size of each computer file to 100 MB or less, if possible; and

(4) directly convert, rather than scan, the record to PDF, if possible.

(f) **Preparation of the Reporter's Record.**

(1) The appellant, at or before the time prescribed for

perfecting the appeal, must make a written request for the reporter's record to the court reporter for the evidentiary panel. The request must designate the portion of the evidence and other proceedings to be included. A copy of the request must be filed with the evidentiary panel and BODA and must be served on the appellee. The reporter's record must be certified by the court reporter for the evidentiary panel.

(2) The court reporter or recorder must prepare and file the reporter's record in accordance with TRAP 34.6 and 35 and the Uniform Format Manual for Texas Reporters' Records.

(3) The court reporter or recorder must file the reporter's record in an electronic format by emailing the document to the email address designated by BODA for that purpose.

(4) The court reporter or recorder must include either a scanned image of any required signature or "/s/" and name typed in the space where the signature would otherwise

(6[1]) In exhibit volumes, the court reporter or recorder must create bookmarks to mark the first page of each exhibit document.

(g) **Other Requests.** At any time before the clerk's record is prepared, or within ten days after service of a copy of appellant's request for the reporter's record, any party may file a written designation requesting that additional exhibits and portions of testimony be included in the record. The request must be filed with the evidentiary panel and BODA and must be served on the other party.

(h) **Inaccuracies or Defects.** If the clerk's record is found to be defective or inaccurate, the BODA Clerk must inform the clerk of the evidentiary panel of the defect or inaccuracy and instruct the clerk to make the correction. Any inaccuracies in the reporter's record may be corrected by agreement of the parties without the court reporter's recertification. Any dispute regarding the reporter's record that the parties are unable to resolve by agreement must be resolved by the evidentiary panel.

(i) **Appeal from Private Reprimand.** Under TRDP 2.16, in an appeal from a judgment of private reprimand, BODA must mark the record as confidential, remove the attorney's name from the case style, and take any other steps necessary to preserve the confidentiality of the private reprimand.

[1] So in original.

Rule 4.03. Time to File Record

(a) **Timetable.** The clerk's record and reporter's record must be filed within 60 days after the date the judgment is signed. If a motion for new trial or motion to modify the judgment is filed with the evidentiary panel, the clerk's record and the reporter's record must be filed within 120 days from the date the original judgment is signed, unless a modified judgment is signed, in which case the clerk's record and the reporter's record must be filed within 60 days of the signing of the modified judgment. Failure to file either the clerk's record or the reporter's record on time does not affect BODA's jurisdiction, but may result in BODA's exercising its discretion to dismiss the appeal, affirm the judgment appealed from, disregard materials filed late, or apply presumptions against the appellant.

(b) **If No Record Filed.**

(1) If the clerk's record or reporter's record has not been timely filed, the BODA Clerk must send notice to the party responsible for filing it, stating that the record is late and requesting that the record be filed within 30 days. The BODA Clerk must send a copy of this notice to all the parties and the clerk of the evidentiary panel.

(2) If no reporter's record is filed due to appellant's fault, and if the clerk's record has been filed, BODA may, after first giving the appellant notice and a reasonable opportunity to cure, consider and decide those issues or points that do not require a reporter's record for a decision. BODA may do this if no reporter's record has been filed because:

(i) the appellant failed to request a reporter's record; or

(ii) the appellant failed to pay or make arrangements to pay the reporter's fee to prepare the reporter's record, and the appellant is not entitled to proceed without payment of costs.

(c) **Extension of Time to File the Reporter's Record.** When an extension of time is requested for filing the reporter's record, the facts relied on to reasonably explain the need for an extension must be supported by an affidavit of the court reporter. The affidavit must include the court reporter's estimate of the earliest date when the reporter's record will be available for filing.

(d) **Supplemental Record.** If anything material to either party is omitted from the clerk's record or reporter's record, BODA may, on written motion of a party or on its own motion, direct a supplemental record to be certified and transmitted by the clerk for the evidentiary panel or the court reporter for the evidentiary panel.

Rule 4.04. Copies of the Record

The record may not be withdrawn from the custody of the BODA Clerk. Any party may obtain a copy of the record or any designated part thereof by making a written request to the BODA Clerk and paying any charges for reproduction in advance.

Rule 4.05. Requisites of Briefs

(a) **Appellant's Filing Date.** Appellant's brief must be filed within 30 days after the clerk's record or the reporter's record is filed, whichever is later.

(b) **Appellee's Filing Date.** Appellee's brief must be filed within 30 days after the appellant's brief is filed.

(c) **Contents.** Briefs must contain:

(1) a complete list of the names and addresses of all parties to the final decision and their counsel;

(2) a table of contents indicating the subject matter of each issue or point, or group of issues or points, with page references where the discussion of each point relied on may be found;

(3) an index of authorities arranged alphabetically and indicating the pages where the authorities are cited;

(4) a statement of the case containing a brief general statement of the nature of the cause or offense and the result;

(5) a statement, without argument, of the basis of BODA's jurisdiction;

(6) a statement of the issues presented for review or points of error on which the appeal is predicated;

(7) a statement of facts that is without argument, is supported by record references, and details the facts relating to the issues or points relied on in the appeal;

(8) the argument and authorities;

(9) conclusion and prayer for relief;

(10) a certificate of service; and

(11) an appendix of record excerpts pertinent to the issues presented for review.

(d) **Length of Briefs; Contents Included and Excluded.** In calculating the length of a document, every word and every part of the document, including headings, footnotes, and quotations, must be counted except the following: caption, identity of the parties and counsel, statement regarding oral argument, table of contents, index of authorities, statement of the case, statement of issues presented, statement of the jurisdiction, signature, proof of service, certificate of compliance, and appendix. Briefs must not exceed 15,000 words if computer-generated, and 50 pages if not, except on leave of BODA. A reply brief must not exceed 7,500 words if computer-generated, and 25 pages if not, except on leave of BODA. A computer generated document must include a certificate by counsel or the unrepresented party stating the number of words in the document. The person who signs the certification may rely on the word count of the computer program used to prepare the document.

(e) **Amendment or Supplementation.** BODA has discretion to grant leave to amend or supplement briefs.

(f) **Failure of the Appellant to File a Brief.** If the appellant fails to timely file a brief, BODA may:

(1) dismiss the appeal for want of prosecution, unless the appellant reasonably explains the failure, and the appellee is not significantly injured by the appellant's failure to timely file a brief;

(2) decline to dismiss the appeal and make further orders within its discretion as it considers proper; or

(3) if an appellee's brief is filed, regard that brief as correctly presenting the case and affirm the evidentiary panel's judgment on that brief without examining the record.

Rule 4.06. Oral Argument

(a) **Request.** A party desiring oral argument must note the request on the front cover of the party's brief. A party's failure to timely request oral argument waives the party's right to argue. A party who has requested argument may later withdraw the request. But even if a party has waived oral argument, BODA may direct the party to appear and argue. If oral argument is granted, the clerk will notify the parties of the time and place for submission.

(b) **Right to Oral Argument.** A party who has filed a brief and who has timely requested oral argument may argue the case to BODA unless BODA, after examining the briefs, decides that oral argument is unnecessary for any of the following reasons:

(1) the appeal is frivolous;

(2) the dispositive issue or issues have been authoritatively decided;

(3) the facts and legal arguments are adequately presented in the briefs and record; or

(4) the decisional process would not be significantly aided by oral argument.

(c) **Time Allowed.** Each party will have 20 minutes to argue. BODA may, on the request of a party or on its own, extend or shorten the time allowed for oral argument. The appellant may reserve a portion of his or her allotted time for rebuttal.

Rule 4.07. Decision and Judgment

(a) **Decision.** BODA may do any of the following:

(1) affirm in whole or in part the decision of the evidentiary panel;

(2) modify the panel's findings and affirm the findings as modified;

(3) reverse in whole or in part the panel's findings and render the decision that the panel should have rendered; or

(4) reverse the panel's findings and remand the cause for further proceedings to be conducted by:

(i) the panel that entered the findings; or

(ii) a statewide grievance committee panel appointed by BODA and composed of members selected from the state bar districts other than the district from which the appeal was taken.

(b) Mandate. In every appeal, the BODA Clerk must issue a mandate in accordance with BODA's judgment and send it to the evidentiary panel and to all the parties.

Rule 4.08. Appointment of Statewide Grievance Committee

If BODA remands a cause for further proceedings before a statewide grievance committee, the BODA Chair will appoint the statewide grievance committee in accordance with TRDP 2.27 [2.26]. The committee must consist of six members: four attorney members and two public members randomly selected from the current pool of grievance committee members. Two alternates, consisting of one attorney and one public member, must also be selected. BODA will appoint the initial chair who will serve until the members of the statewide grievance committee elect a chair of the committee at the first meeting. The BODA Clerk will notify the Respondent and the CDC that a committee has been appointed.

Rule 4.09. Involuntary Dismissal

Under the following circumstances and on any party's motion or on its own initiative after giving at least ten days' notice to all parties, BODA may dismiss the appeal or affirm the appealed judgment or order. Dismissal or affirmance may occur if the appeal is subject to dismissal:

(a) for want of jurisdiction;

(b) for want of prosecution; or

(c) because the appellant has failed to comply with a requirement of these rules, a court order, or a notice from the clerk requiring a response or other action within a specified time.

V. PETITIONS TO REVOKE PROBATION

Rule 5.01. Initiation and Service

(a) Before filing a motion to revoke the probation of an attorney who has been sanctioned, the CDC must contact the BODA Clerk to confirm whether the next regularly available hearing date will comply with the 30-day requirement of TRDP. The Chair may designate a three-member panel to hear the motion, if necessary, to meet the 30-day requirement of TRDP 2.23 [2.22].

(b) Upon filing the motion, the CDC must serve the Respondent with the motion and any supporting documents in accordance with TRDP 2.23 [2.22], the TRCP, and these rules. The CDC must notify BODA of the date that service is obtained on the Respondent.

Rule 5.02. Hearing

Within 30 days of service of the motion on the Respondent, BODA must docket and set the matter for a hearing and notify the parties of the time and place of the hearing. On a showing of good cause by a party or on its own motion, BODA may continue the case to a future hearing date as circumstances require.

VI. COMPULSORY DISCIPLINE

Rule 6.01. Initiation of Proceeding

Under TRDP 8.03, the CDC must file a petition for compulsory discipline with BODA and serve the Respondent in accordance with the TRDP and Rule 1.06 of these rules.

Rule 6.02. Interlocutory Suspension

(a) **Interlocutory Suspension.** In any compulsory proceeding under TRDP Part VIII in which BODA determines that the Respondent has been convicted of an Intentional Crime and that the criminal conviction is on direct appeal, BODA must suspend the Respondent's license to practice law by interlocutory order. In any compulsory case in which BODA has imposed an interlocutory order of suspension, BODA retains jurisdiction to render final judgment after the direct appeal of the criminal conviction is final. For purposes of rendering final judgment in a compulsory discipline case, the direct appeal of the criminal conviction is final when the appellate court issues its mandate.

(b) **Criminal Conviction Affirmed.** If the criminal conviction made the basis of a compulsory interlocutory suspension is affirmed and becomes final, the CDC must file a motion for final judgment that complies with TRDP 8.05.

(1) If the criminal sentence is fully probated or is an order of deferred adjudication, the motion for final judgment must contain notice of a hearing date. The motion will be set on BODA's next available hearing date.

(2) If the criminal sentence is not fully probated:

(i) BODA may proceed to decide the motion without a hearing if the attorney does not file a verified denial within ten days of service of the motion; or

(ii) BODA may set the motion for a hearing on the next available hearing date if the attorney timely files a verified denial.

(c) **Criminal Conviction Reversed.** If an appellate court issues a mandate reversing the criminal conviction while a Respondent is subject to an interlocutory suspension, the Respondent may file a motion to terminate the interlocutory suspension. The motion to terminate the interlocutory suspension must have certified copies of the decision and mandate of the reversing court attached. If the CDC does not file an opposition to the termination within ten days of being served with the motion, BODA may proceed to decide the motion without a hearing or set the matter for a hearing on its own motion. If the CDC timely opposes the motion, BODA must set the motion for a hearing on its next available hearing date. An order terminating an interlocutory order of suspension does not automatically reinstate a Respondent's license.

VII. RECIPROCAL DISCIPLINE

Rule 7.01. Initiation of Proceeding

To initiate an action for reciprocal discipline under TRDP Part IX, the CDC must file a petition with BODA and request an Order to Show Cause. The petition must request that the Respondent be disciplined in Texas and have attached to it any information concerning the disciplinary matter from the other jurisdiction, including a certified copy of the order or judgment rendered against the Respondent.

Rule 7.02. Order to Show Cause

When a petition is filed, the Chair immediately issues a show cause order and a hearing notice and forwards them to the CDC, who must serve the order and notice on the Respondent. The CDC must notify BODA of the date that service is obtained.

Rule 7.03. Attorney's Response

If the Respondent does not file an answer within 30 days of being served with the order and notice but thereafter appears at the hearing, BODA may, at the discretion of the Chair, receive testimony from the Respondent relating to the merits of the petition.

VIII. DISTRICT DISABILITY COMMITTEE HEARINGS

Rule 8.01. Appointment of District Disability Committee

(a) If the evidentiary panel of the grievance committee finds under TRDP 2.17(P)(2), or the CDC reasonably believes under TRDP 2.14(C), that a Respondent is suffering from a disability, the rules in this section will apply to the de novo proceeding before the District Disability Committee held under TRDP Part XII.

(b) Upon receiving an evidentiary panel's finding or the CDC's referral that an attorney is believed to be suffering from a disability, the BODA Chair must appoint a District Disability Committee in compliance with TRDP 12.02 and designate a chair. BODA will reimburse District Disability Committee members for reasonable expenses directly related to service on the District Disability Committee. The BODA Clerk must notify the CDC and the Respondent that a committee has been appointed and notify the Respondent where to locate the procedural rules governing disability proceedings.

(c) A Respondent who has been notified that a disability referral will be or has been made to BODA may, at any time, waive in writing the appointment of the District Disability Committee or the hearing before the District Disability Committee and enter into an agreed judgment of indefinite disability suspension, provided that the Respondent is competent to waive the hearing. If the Respondent is not represented, the waiver must include a statement affirming that the Respondent has been advised of the right to appointed counsel and waives that right as well.

(d) All pleadings, motions, briefs, or other matters to be filed with the District Disability Committee must be filed with the BODA Clerk.

(e) Should any member of the District Disability Committee become unable to serve, the BODA Chair must appoint a substitute member.

Rule 8.02. Petition and Answer

(a) **Petition.** Upon being notified that the District Disability Committee has been appointed by BODA, the CDC must, within 20 days, file with the BODA Clerk and serve on the Respondent a copy of a petition for indefinite disability suspension. Service must comply with Rule 1.06.

(b) **Answer.** The Respondent must, within 30 days after service of the petition for indefinite disability suspension, file an answer with the BODA Clerk and serve a copy of the answer on the CDC.

(c) **Hearing Setting.** The BODA Clerk must set the final hearing as instructed by the chair of the District Disability Committee and send notice of the hearing to the parties.

Rule 8.03. Discovery

(a) **Limited Discovery.** The District Disability Committee may permit limited discovery. The party seeking discovery must file with the BODA Clerk a written request that makes a clear showing of good cause and substantial need and a proposed order. If the District Disability Committee authorizes discovery in a case, it must issue a written order. The order may impose limitations or deadlines on the discovery.

(b) **Physical or Mental Examinations.** On written motion by the Commission or on its own motion, the District Disability Committee may order the Respondent to submit to a physical or mental examination by a qualified healthcare or mental healthcare professional. Nothing in this rule limits the Respondent's right to an examination by a professional of his or her choice in addition to any exam ordered by the District Disability Committee.

(1) Motion. The Respondent must be given reasonable notice of the examination by written order specifying the name, address, and telephone number of the person conducting the examination.

(2) Report. The examining professional must file with the BODA Clerk a detailed, written report that includes the results of all tests performed and the professional's findings, diagnoses, and conclusions. The professional must send a copy of the report to the CDC and the Respondent.

(c) **Objections.** A party must make any objection to a request for discovery within 15 days of receiving the motion by filing a written objection with the BODA Clerk. BODA may decide any objection or contest to a discovery motion.

Rule 8.04. Ability to Compel Attendance

The Respondent and the CDC may confront and cross-examine witnesses at the hearing. Compulsory process to compel the attendance of witnesses by subpoena, enforceable by an order of a district court of proper jurisdiction, is available to the Respondent and the CDC as provided in TRCP 176.

Rule 8.05. Respondent's Right to Counsel

(a) The notice to the Respondent that a District Disability Committee has been appointed and the petition for indefinite disability suspension must state that the Respondent may request appointment of counsel by BODA to represent him or her at the disability hearing. BODA will reimburse appointed counsel for reasonable expenses directly related to representation of the Respondent.

(b) To receive appointed counsel under TRDP 12.02, the Respondent must file a written request with the BODA Clerk within 30 days of the date that Respondent is served with the petition for indefinite disability suspension. A late request must demonstrate good cause for the Respondent's failure to file a timely request.

Rule 8.06. Hearing

The party seeking to establish the disability must prove by a preponderance of the evidence that the Respondent is suffering from a disability as defined in the TRDP. The chair of the District Disability Committee must admit all relevant evidence that is necessary for a fair and complete hearing. The TRE are advisory but not binding on the chair.

Rule 8.07. Notice of Decision

The District Disability Committee must certify its finding regarding disability to BODA, which will issue the final judgment in the matter.

Rule 8.08. Confidentiality

All proceedings before the District Disability Committee and BODA, if necessary, are closed to the public. All matters before the District Disability Committee are confidential and are not subject to disclosure or discovery, except as allowed by the TRDP or as may be required in the event of an appeal to the Supreme Court of Texas.

IX. DISABILITY REINSTATEMENTS

Rule 9.01. Petition for Reinstatement

(a) An attorney under an indefinite disability suspension may, at any time after he or she has been suspended, file a verified petition with BODA to have the suspension terminated and to be reinstated to the practice of law. The petitioner must serve a copy of the petition on the CDC in the manner required by TRDP 12.06. The TRCP apply to a reinstatement proceeding unless they conflict with these rules.

(b) The petition must include the information required by TRDP 12.06. If the judgment of disability suspension contained terms or conditions relating to misconduct by the petitioner prior to the suspension, the petition must affirmatively demonstrate that those terms have been complied with or explain why they have not been satisfied. The petitioner has a duty to amend and keep current all information in the petition until the final hearing on the merits. Failure to do so may result in dismissal without notice.

(c) Disability reinstatement proceedings before BODA are not confidential; however, BODA may make all or any part of the record of the proceeding confidential.

Rule 9.02. Discovery

The discovery period is 60 days from the date that the petition for reinstatement is filed. The BODA Clerk will set the petition for a hearing on the first date available after the close of the discovery period and must notify the parties of the time and place of the hearing. BODA may continue the hearing for good cause shown.

Rule 9.03. Physical or Mental Examinations

(a) On written motion by the Commission or on its own, BODA may order the petitioner seeking reinstatement to submit to a physical or mental examination by a qualified healthcare or mental healthcare professional. The petitioner must be served with a copy of the motion and given at least seven days to respond. BODA may hold a hearing before ruling on the motion but is not required to do so.

(b) The petitioner must be given reasonable notice of the examination by written order specifying the name, address, and telephone number of the person conducting the examination.

(c) The examining professional must file a detailed, written report that includes the results of all tests performed and the professional's findings, diagnoses, and conclusions. The professional must send a copy of the report to the parties.

(d) If the petitioner fails to submit to an examination as ordered, BODA may dismiss the petition without notice.

(e) Nothing in this rule limits the petitioner's right to an examination by a professional of his or her choice in addition to any exam ordered by BODA.

Rule 9.04. Judgment

If, after hearing all the evidence, BODA determines that the petitioner is not eligible for reinstatement, BODA may, in its discretion, either enter an order denying the petition or direct that the petition be held in abeyance for a reasonable period of time until the petitioner provides additional proof as directed by BODA. The judgment may include other orders necessary to protect the public and the petitioner's potential clients.

X. APPEALS FROM BODA TO THE SUPREME COURT OF TEXAS

Rule 10.01. Appeals to the Supreme Court

(a) A final decision by BODA, except a determination that a statement constitutes an inquiry or a complaint under TRDP 2.10, may be appealed to the Supreme Court of Texas. The clerk of the Supreme Court of Texas must docket an appeal from a decision by BODA in the same manner as a petition for review without fee.

(b) The appealing party must file the notice of appeal directly with the clerk of the Supreme Court of Texas within 14 days of receiving notice of a final determination by BODA. The record must be filed within 60 days after BODA's determination. The appealing party's brief is due 30 days after the record is filed, and the responding party's brief is due 30 days thereafter. The BODA Clerk must send the parties a notice of BODA's final decision that includes the information in this paragraph.

(c) An appeal to the Supreme Court is governed by TRDP 7.11 and the TRAP.