

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

In the Matter of)

Respondent.)

) **Proceeding No. D2003-13**
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FINAL ORDER

Harry I. Moatz, the Director of the Office of Enrollment and Discipline (OED Director) of the United States Patent and Trademark Office (USPTO) and (Respondent), have submitted a settlement agreement in the above proceeding that meets the requirements of 37 C.F.R. § 10.133(g).

In order to resolve the case without the necessity of a hearing, Respondent and the OED Director have agreed to certain stipulated facts, legal conclusions, and sanctions, all of which are set forth below in their entirety. It was further agreed between the OED Director and Respondent that this agreement resolves any and all disciplinary action by the USPTO that could arise from the Committee on Discipline's August 20, 2003, finding of probable cause to bring charges against Respondent under 37 C.F.R. §§ 10.23(b)(4) and (c)(2)(i), and 10.36.

Pursuant to that agreement, this Final Order sets forth the following stipulated facts, agreed-upon legal conclusions and sanctions:

STIPULATED FACTS

1. From 1997 to 2003, Respondent was a shareholder with the firm of _____ in _____. In 1997, the firm acquired a new client, _____ of _____. Over the course of the next two years, Respondent performed trademark legal services on behalf of _____ and related companies.
2. In late 1999, Mr. _____ B _____, a shareholder with the firm, received an inquiry from _____, corporate counsel for _____. Mr. _____ expressed concern that the amount and cost of the legal work performed by Respondent was far more than expected. Mr. B _____ conducted a review of invoices and related files. In a written memorandum subsequently given to Respondent, Mr. B _____ concluded that Respondent had overcharged _____ by approximately four times the value of the work performed over the prior two years. Using the American Intellectual Property Lawyer Association's (AIPLA) 1999 Economic Survey, B _____'s memo concluded that Respondent had charged _____ \$73,368.80 for work valued at no more than \$18,000, an overcharge in excess of \$55,000.

3. In a written response to the memorandum, Respondent substantially reiterated the description of services provided in the original invoices to N. and Fr., two other shareholders in the firm, reviewed Respondent's response and the files on which he had worked. Both agreed with B.'s conclusion of overbilling, identifying "numerous instances of billing improprieties including blatant misrepresentations regarding the date and nature of services provided."
4. On March 13, 2000, having left the firm of , B. N. F. and a fourth lawyer S. wrote two letters alleging that Respondent committed "serious violations" of the rules of attorney conduct in his representation of . from 1997 through 1999. One letter was directed to the USPTO Office of Enrollment and Discipline, the second, a copy of which was provided to the OED Director, was directed to the
5. The . files were reviewed by the ' firm. It was determined that . should be reimbursed approximately \$50,000, a sum for which Respondent largely assumed responsibility.
6. Respondent is no longer associated with the firm of
7. Following an investigation, the OED Director concluded that from 1997 through 1999, Respondent in his representation of . violated: (i) 37 CFR § 10.23(c)(2)(i) by knowingly giving false or misleading information to a client in connection with immediate, prospective or pending business before the office; (ii) 37 CFR § 10.23(b)(4) by engaging in conduct involving dishonesty, deceit or misrepresentation; and (iii) 37 CFR § 10.36 by charging or collecting an illegal or clearly excessive fee. The OED Director recommended to the Committee on Discipline that charges be brought against Respondent. As noted above, on August 20, 2003, the Committee found probable cause for bringing such charges.
8. The State of ' , also investigated the complaint regarding billing improprieties in connection with trademark services provided to . A private reprimand was issued by the ' as a result of its investigation.

LEGAL CONCLUSIONS

9. Based upon the foregoing stipulated facts, Respondent acknowledged that Respondent could not have successfully defended his conduct against charges predicated on violations of the following Disciplinary Rules of the Code of Professional Responsibility as outlined in Section 10 of 37 C.F.R:
 - (i) Rule 10.23(b)(4), in that Respondent engaged in conduct involving dishonesty, deceit or misrepresentation;

(ii) Rule 10.23(c)(2)(i), in that Respondent knowingly gave false or misleading information to a client in connection with immediate, prospective or pending business before the office; and

(iii) Rule 10.36 in that Respondent charged or collected an illegal or clearly excessive fee.

SANCTIONS

10. Based upon the foregoing and the fact that the _____ issued a private reprimand, it is **ORDERED** that:
- (a) this FINAL ORDER incorporates the facts stipulated in paragraphs 9 to 16 above.
 - (b) Respondent is hereby **Privately Reprimanded** for his conduct in knowingly giving false or misleading information to a client in connection with immediate, prospective or pending business before the office; by engaging in conduct involving dishonesty, deceit or misrepresentation; and by charging or collecting an illegal or clearly excessive fee.
 - (c) the OED Director publish the following notice in the Official Gazette:

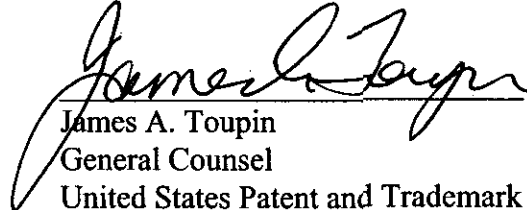
NOTICE OF PRIVATE REPRIMAND

A practitioner has been privately reprimanded by the USPTO General Counsel, on behalf of the Acting Director of the United States Patent and Trademark Office. This action is taken pursuant to 35 U.S.C. § 32 and 37 C.F.R. 10.133(g) for: charging or collecting an illegal or clearly excessive fee; knowingly giving false or misleading information to a client in connection with immediate, prospective or pending business before the office; and engaging in conduct involving dishonesty, deceit or misrepresentation.

- (d) this private reprimand is made of record in file D2003-13, a disciplinary file regarding only Respondent;
- (e) this FINAL ORDER, the Settlement Agreement, record, proceeding, and private reprimand be kept confidential, but the same may be released to any licensing authority including the _____ upon request thereof, and the same may be considered not only in dealing with any further complaint or evidence of the same or similar misconduct which may come to the attention of the USPTO, but it may also be considered in any disciplinary proceeding occurring in the future as an aggravating factor to be taken into consideration in determining any

discipline to be imposed, and to rebut any statement or representation by or on Respondent's behalf, in any disciplinary proceeding occurring in the future.

February 9, 2024
Date


James A. Toupin
General Counsel
United States Patent and Trademark Office
on behalf of

Jon W. Dudas
Acting Undersecretary of Commerce for Intellectual
Property and Acting Director of the United States
Patent and Trademark Office

cc: Harry I. Moatz
Director, Office of Enrollment
and Discipline, USPTO