

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

In the Matter of)
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Robert J. Van Der Wall)
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Respondent.)
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_____)

Proceeding No.: D04-02

FINAL ORDER

The Director of Enrollment and Discipline (OED Director) of the United States Patent and Trademark Office (USPTO) and Robert J. Van Der Wall, Respondent, USPTO registration number 28,125, 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 against Respondent without the necessity of a formal complaint, Respondent and the OED Director agreed to certain stipulated facts, legal conclusions and discipline.

Pursuant to that agreement, this final order sets forth the following stipulated facts, agreed upon legal conclusions, and discipline.

STIPULATED FACTS

1. [Person I], president of XXXX, Inc., invented a XXXX. On XXXX, 1998, XXXX filed US Patent Application No. [Application #1] naming [Person I] as the sole inventor.

2. [Person 2] was hired by XXXX as its sales agent to market the basket. Before teaming with XXXX, [Person II] invented a method of removing and replacing third party paid advertising. Respondent had represented [Person II] in various business activities for a number of years.
3. After becoming XXXX's marketing agent, [Person II] asked Respondent to review [Application #I]. Respondent recommended filing a preliminary amendment in [Application #I] to broaden the claims.
4. Based on the recommendation, [Person I] hired Respondent and gave him a \$2000.00 retainer.
5. On January 7, 1999, Respondent filed a preliminary amendment concerning [Application #I].
6. On XXXX, 1999, Respondent filed in the USPTO a PCT application entitled "XXXX." The PCT application claims advertising and priority to [Application #I]. In addition to [Person I], the PCT application also names [Person II] as an inventor.
7. Prior to filing the PCT application, Respondent did not discuss with [Person I] whether advertising should be added to the invention or whether [Person II] should be added as an inventor.
8. After receiving a copy of the PCT application, [Person I] called Respondent to determine why [Person II] was listed as co-inventor. Respondent informed [Person I] that adding [Person II] was a mistake by his office.

9. On May 4, 1999, the USPTO mailed Respondent an Office action in the '990 application which set a three-month period for response.
10. Respondent informed [Person I] that the application was not worth pursuing. However, Respondent failed to tell [Person I] that if a response was not filed within six months of the May 4, 1999 office action, [Application #I] would go abandoned. No response was ever filed. As a result, [Application #I] went abandoned on XXXX, 1999. Respondent did not inform [Person I] of the abandonment.
11. Respondent is registered to practice before the Florida Bar. [Person I] informed the Florida Bar about Respondent's conduct during his representation.
12. On March 25, 2003, the Grievance Committee of the Florida Supreme Court issued a report which recommended to the Florida Supreme Court that Respondent be sanctioned with an admonishment for minor misconduct.
13. On April 23, 2003, the Grievance Committee's Report became final.

LEGAL CONCLUSIONS

14. Based upon the foregoing stipulated facts, Respondent acknowledges that his conduct violated the following Disciplinary Rules of Professional Conduct as outlined in Section 10 of 37 C.F.R.:
 - a. 10.23(b)(8) in that Respondent failed to inform a client of a Notice of Abandonment;
 - b. 10.77 (c) in that Respondent neglected to communicate with his client

before adding an inventor to a PCT application.

DISCIPLINE

15. Based upon the foregoing, it is ordered that:
- a. Respondent be reprimanded; and
 - b. The OED Director comply with 37 C.F.R. § 10.159(a) and also publish the following Notice in the Official Gazette:

Notice of Reprimand

Robert J. Van Der Wall, a patent attorney with Registration No. 28,125, of Miami, FL, is hereby reprimanded. This action by the Director is taken pursuant to the provisions of 35 U.S.C. § 32, and 37 C.F.R. § 10.133(g).

May 27, 2004
Date

/s/ _____
James A. Toupin
General Counsel
United States Patent and Trademark Office
on behalf of
Jon W. Dudas
Acting Under Secretary of Commerce For Intellectual Property and
Acting Director of the United States Patent and Trademark Office

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

Robert J. Van Der Wall