

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS

In re _____)
)
)
)
)

MEMORANDUM AND ORDER

(“Petitioner”) seeks review of the decision of the Director (“Director”) of the Office of Enrollment and Discipline (“OED”) disapproving Petitioner’s application for registration to practice before the Patent and Trademark Office (“PTO”) in patent cases. The Director disapproved petitioner’s application based on his failure to sustain his burden of establishing that he is of good moral character and repute. For the reasons stated below, the petition is *granted*.

BACKGROUND

, Petitioner submitted an Application to take both sections of the PTO Examination.¹ The background information section of the application includes several questions designed to determine whether the applicant is fit to practice before the Office. Specifically, question six asks whether the applicant has “ever been arrested, charged, or held by Federal, State or other law enforcement authorities for any violation of any Federal or State law, or any county or municipal law, regulation or ordinance.” This question explicitly excludes traffic violations with a fine of \$100 or less. Petitioner answered this question “no.” The following year,

¹Petitioner is currently licensed to practice law in _____ and has passed both the morning and afternoon sections of the registration examination.

, Petitioner continued the application process and sought registration on the basis of his successful passage of the registration examination. On this registration form, dated Petitioner *sua sponte* changed his question six response to "yes" -- indicating that he had been either arrested, charged or held as specified. In a one page memorandum attached to the application, Petitioner supplemented his affirmative response, notifying OED that he had

In response to question 6 on form PTO-158 I answered Yes. In fact I have received

I am currently in the process of taking care of this matter.

If you have any questions on this matter please do not hesitate to call me

By letter dated OED acknowledged receipt of the application and sought further details of and an explanation of Petitioner's changed response to question six -- from "no" on the application to "yes" on the application.

Petitioner responded to OED's request on . In a lengthy submission accompanied by numerous attachments, Petitioner apologized for the delay but noted the difficulty of gathering supporting documentation to respond to OED's detailed query. Specifically, Petitioner listed and documented the

Petitioner also confronted the discrepancy between his answers to question six in the two applications:

... I may be providing information that should have been disclosed earlier but was not provided. If it is determined that I have not previously provided information that is deemed relevant I hope to show that this information was not intentionally withheld but rather was an unfortunate oversight due to my inexperience in these matters.

Petitioner conceded: “[i]n attempting to answer all the issues raised in the OED correspondence of _____ I have determined that the information I provided in my application is *not entirely true*.” (emphasis added). Furthermore, in response to OED’s request for an explanation of his _____ Petitioner stated simply: “I now realize what a serious error in judgment this was. Not only have I had to pay out the fines levied against me but I have also placed my legal career in jeopardy.” Petitioner further admitted to “no excuse for not resolving this matter earlier.”

Petitioner also addressed the discrepancy between his answers to question six, explaining: “I was filling out the first application on one of the last, if not the last day that applications for the _____ exam were due. This resulted in a hurried and inaccurate reading of question six.”

He added:

“When I read the application more carefully on the second application I noticed that the question asked whether I had received _____
any _____ At that time I was not certain whether I had received or not but I figured that I should answer yes in the event I had.”

Following Petitioner’s _____ response, OED, in two letters dated _____ requested additional information about Petitioner’s “_____ as an indicia of [his] moral character and repute,” including further explanation of the discrepancy between the answers to question six. In addition, OED sought information about Petitioner’s answer to a similar question

on the SF-171 he submitted for employment

OED noted: "You answered

'no' to question 42. Your answer to question 42 on your SF-171 was not entirely true." OED

accordingly sought an explanation of the "no" answer to question 42 on the SF-171

submitted by Petitioner for his employment

Finally, OED stated:

You [are] advised of your fifth amendment rights under the federal constitution. Further, you are advised that the burden of proof of good moral character and repute is on the applicant for registration in the PTO.

* * * *

In view of your past submissions, I do not know of any method which will serve as litmus test to allow OED to tell which of your answers are absolutely true, not quite false, false, the product of a faulty short or long-term memory, or simply the result of indifferent attentiveness to the question asked.

In response to OED's letters, Petitioner, on submitted a six-page letter with attached exhibits A through P. Petitioner specifically addressed the SF-171 issue:

In the second part of your letter dated you asked me to explain why I answered "no" to question 42 on the SF-171 in It is very difficult for me to remember what I was thinking when I originally submitted that form . Knowing that I would not intentionally make a knowing misrepresentation, I must answer that this was merely an inadvertent error when filling out the form resulting from improper attention on my part.

In this letter, petitioner also revisited his response to question six on his application:

²On Petitioner had signed an application for federal employment to become On respectively, Petitioner signed Standard Form 61-B and entered into employment Question 42 of the SF-171 Form asks: "During the last 10 years have you forfeited collateral, been convicted, been imprisoned, been on probation, or been on parole? Do not include violations reported in 39, 40, or 41, above." This form further directs the applicant to omit "traffic fines of \$100.00 or less."

With regard to my answering no to Question 6 on my application for registration submitted on _____ I believe I completed this application on one of the last days that I could apply to take the _____ patent bar exam. I remember being in a great hurry to fill out and have notarized the documentation necessary to take that exam. I believe in this rush, I again did not fully understand what was required of me.

Moreover in Exhibit M to his letter, Petitioner expressed unequivocal contrition, both with respect to his _____ his disclosures to OED:

I fully recognize that the conduct involving my _____ is wrong. Being confronted with the possible destruction of my career has made me think, on a daily basis for almost a year, of the foolish way in which I handled my _____ I don't know if I can be more sorry for these facts than I was.

* * * *

I think that I have matured tremendously over the past several years. Since I can now say that if I had to live my life over again I would not have handled my _____ so foolishly, I think that I was relatively inexperienced when the subject conduct transpired.

Approximately one year after the _____, letter in which Petitioner admitted to his wrongdoing and accepted full responsibility, OED issued an Order and Supplementary Order to Show Cause affording Petitioner yet again "the opportunity to show why his application for _____ registration should be approved." On _____ Petitioner responded, relying primarily upon his replies to questions proffered prior to the issuance of the Order to Show Cause.

On _____ issued _____ decision denying Petitioner enrollment based on his lack of good moral character. The Director based _____ decision on Petitioner's lack of commitment to the legal process, and lack of candor and truthfulness. Thereafter, on _____ Director _____ on reconsideration disapproved Petitioner's application for registration. In _____ Decision on reconsideration, however, the Director raised for

the first time and concluded that Petitioner had engaged in the unauthorized practice of patent law before the PTO. These charges were not made part of the Show Cause Order either initially or by subsequent amendment.

Petitioner objected to this procedure and sought leave to supplement the record with evidence rebutting OED's finding of unauthorized practice. By Order issued

declined to supplement the record. Accordingly,

Petitioner sought review by the Commissioner of the Director's Decision on

Reconsideration. In response to arguments raised in Petitioner's brief,

reconsidered his refusal to permit further amplification of the record; and,

in an interlocutory order issued concluded that Petitioner was entitled to an opportunity to respond to the Director's allegations that he had engaged in the unauthorized practice of law.

In a Supplemental Decision on Reconsideration, the Director again rejected Petitioner's application for registration. the Director determined that Petitioner's

forgetfulness and incomplete recollection of events and fines precludes him from sustaining his burden of proving he meets the highest degree of candor and good faith.

Petitioner now appeals.

OPINION

The Commissioner is granted express authority to require that -- as a condition to practice before the PTO -- any applicant show that he or she is possessed of "good moral character and reputation." 35 U.S.C. § 31. To ensure that those practicing before the PTO in patent cases do

so with "the highest degree of candor and good faith,"³ the PTO rules require that:

(a) No individual will be registered to practice before the Office [PTO] unless he or she shall:

* * * *

(2) Establish to the satisfaction of the Director [of OED] that he or she is:

(i) Of good moral character and repute;

37 C.F.R. §10.7. "Good moral character" denotes "an absence of proven conduct or acts which have been historically considered as manifestations of 'moral turpitude'." *Konigsberg v. State Bar of California*, 353 U.S. 252, 263 (1957).

This opinion examines whether Petitioner is presently of sufficiently "good moral character" to merit registration. First, I consider whether Petitioner's conduct reflects moral turpitude. Second, I look at Petitioner's rehabilitation. Finally, I consider the Director's allegations of unauthorized practice of law.

³See *Kingsland v. Dorsey*, 338 U.S. 318, 319-20 (1949). In *Kingsland*, the Supreme Court stated:

By reason of the nature of an application for patent, the relationship of attorneys to the Patent Office requires the highest degree of candor and good faith. In its relation to applicants, the Office . . . must rely upon their integrity and deal with them in a spirit of trust and confidence It was the Commissioner, not the courts, that Congress made primarily responsible for protecting the public from the evil consequences that might result if practitioners should betray their high trust.

Id. Accord Cupples v. Marzall, 101 F. Supp. 579, 583, 92 U.S.P.Q. 169, 172 (D.D.C. 1952) ("primary responsibility for protection of the public from unqualified practitioners before the Patent Office rests in the Commissioner of Patents"), *aff'd*, 204 F.2d 58, 97 U.S.P.Q. 1 (D.C. Cir. 1953), *quoted with approval in Gager v. Ladd*, 212 F. Supp. 671, 673, 136 U.S.P.Q. 627, 628 (D.D.C. 1963).

Nature of Petitioner's Conduct

I first consider whether Petitioner's conduct relating to _____ reflects moral turpitude. Moral turpitude has been defined as an "act or behavior that gravely violates the moral sentiment or accepted moral standards of the community" and "the morally culpable quality held to be present in some criminal offenses as distinguished from others." *Lee v. Wisconsin State Bd. Of Dental Examiners*, 139 N.W.2d 61, 65 (1966) (quoting *Webster's New International Dictionary* (3d ed.)). Given that Petitioner's _____ exhibit none of the requisite elements of "fraud, deceit, or criminal intent," *id.*, I cannot conclude that Petitioner's _____ reflect his commission of an act involving moral turpitude. Thus, although these _____ may reflect carelessness or even misconduct on the part of _____ Petitioner, under the present facts, they cannot form the sole basis for holding that Petitioner lacks good moral character.

As to Petitioner's conduct relating to lack of candor, such conduct would rise to the level of actions reflecting moral turpitude. However, the evidence supporting the Director's conclusion that Petitioner lied in his applications is, at best, inconclusive. Rather, the SF-171 and first application for registration more clearly reflect inadvertent omissions. This is supported by Petitioner's second application for admission in which -- on his own and without any prompting from OED -- he notified OED of the problems _____ and his previous omission. There is no doubt that Petitioner was sloppy in completing the SF-171 and the first application. However, his voluntary notification and subsequent full disclosure cast serious doubt on any determination that he intended to mislead OED when he failed to properly fill out the two forms.

Rehabilitation

I next consider whether Petitioner is sufficiently rehabilitated in regards to his

Whether Petitioner is sufficiently rehabilitated involves an examination of the following criteria:

(1) [C]ommunity service and achievements, as well as the opinions of others regarding present character; (2) candor before the court; (3) the age of the applicant at the time of the offenses; (4) the amount of time which has passed since the last offense; (5) the nature of the offenses; and (6) the applicant's current mental state.

In re Loss, 119 Ill.2d 186, 196, 518 N.E.2d 981, 985 (1987), *quoted with approval in In re Childress*, 138 Ill.2d 87, 100, 561 N.E.2d 614, 620 (1990). *Accord In re Application of G.L.S.*, 292 Md. 378, 397-98, 439 A.2d 1107, 1117-18 (1982). Each factor is addressed in turn.

As to the first factor -- "opinions of others" regarding Petitioner's present character -- the record contains no less than nine letters prepared by Petitioner's employers and colleagues. Without exception they express strong support for Petitioner's integrity and honesty.⁴

⁴*See Letter of* ("he possesses both integrity and honesty in his professional transactions"); *Letter of* ("I feel the office would be doing a great injustice not only to [Petitioner] but also to the public in not admitting a person so qualified in terms of moral character to the patent bar."); *Letter of* ("I have come to know him as an ethical and diligent professional."); *Letter of* ("I observed that [Petitioner] showed great integrity in both his personal and business affairs."); *Letter of* ("I am familiar with the order to show cause and its effect toward [Petitioner] and believe that in spite of the appearance of the situation that [Petitioner] has high moral standards, is competent, and able to successfully perform the duties of a patent attorney before the USPTO in an exceptional manner."); *Letter of* ("I believe that [Petitioner] is fit and capable of practicing before the Patent & Trademark Office. [Petitioner] deserves every encouragement to achieve his goal and I am confident that with such encouragement [he] will reach his full potential in a manner that will be more responsible."); *Letter of* ("he has always demonstrated qualities of honesty, integrity and high ethical standards."); *Second Letter of*

Furthermore, these letters span a time period from [redacted] through [redacted] and all reflect an awareness of Petitioner's past conduct with regard to his [redacted] and application for registration. Notwithstanding these issues, each individual expresses full confidence in Petitioner's present ethical and moral probity. These documents provide strong evidence of Petitioner's rehabilitation and present state of "good moral character."

As to the second factor, Petitioner's "candor" before the PTO, there can be no doubt that Petitioner, since his [redacted] application, has "come clean." Indeed, the record reflects that in his response to OED's [redacted] letter, Petitioner admitted his error in failing to disclose information "necessary to evaluate [redacted]" and that such information "should have been disclosed earlier but was not provided." Petitioner further demonstrated candor in his admission that "the information [he] provided in [his]

application is not entirely true." This, he acknowledged, was "a serious error in judgment" that "placed [his] legal career in jeopardy." Petitioner admitted to "no excuse for not resolving this matter earlier."

Petitioner's candor is further reflected in his response to OED's [redacted] letters, both with respect to his handling of [redacted] and his disclosures to OED:

I fully recognize that the conduct involving my [redacted] is wrong. Being confronted with the possible destruction of my career has made me think, on a daily basis for almost a year, of the foolish way in which I handled my [redacted]. I don't know if I can be more sorry for these facts than I was.

("I believe that he would not knowingly make a material misrepresentation in connection with any governmental matter . . . I remain of the opinion that [Petitioner] should be admitted to the Patent Bar."); *Second Letter of* (same).

This factor also strongly supports a finding of rehabilitation.

The third factor, [€] Petitioner's age at the time of his misstatements is clearly reflected in the record: Petitioner was born on [redacted] Thus, in [redacted] and [redacted] the years in which the misstatements were made, Petitioner was [redacted]

Petitioner's age at the time of his misconduct is a relatively minor factor.

The fourth and related factor to be considered is the amount of time which has passed since Petitioner's last alleged transgression. Petitioner's last alleged misconduct took place in his [redacted] application for registration. Moreover, the record contains no evidence of further misstatements or other infractions since that time. Accordingly, Petitioner has had [redacted] years to ponder his alleged misdeeds and rehabilitate himself. Although not sufficient in and of itself, this lengthy period of time would weigh heavily in favor of Petitioner's case for registration.

As to the fifth factor -- the nature of Petitioner's alleged offenses and any corresponding significance -- it is noted that Petitioner's [redacted] occurred in a context outside the field in which he now seeks registration. Furthermore, Petitioner's lack of care in failing to fully disclose these facts in his job and first registration applications does not relate directly to the practice of patent law. Nevertheless, this type of carelessness of Petitioner from [redacted] through [redacted] might have raised doubts as to his ability to conduct himself before this Office with the requisite candor. Accordingly, with respect to this factor Petitioner would have borne a substantial burden to demonstrate his rehabilitation. *See, e.g., Childress*, 138 Ill.2d at 101, 561 N.E.2d at 620 ("degree of rehabilitation that must be

established to warrant admission or reinstatement will depend in large measure on the nature of the wrong committed").

Finally, Petitioner's current mental state is not apparent in this record. Certainly as early as [redacted] Petitioner expressed regret and accepted responsibility for any omissions. Furthermore, there is no evidence in the record to suggest that his position in this regard has changed or that he now no longer feels regret for his actions.

The weight of the factors discussed above supports a finding that Petitioner has rehabilitated himself. He has provided nine letters documenting strong support for his honesty and integrity; he has voluntarily admitted his misstatements; it has been more than [redacted] since his last misconduct; his offenses did not involve moral turpitude; and he has expressed regret and accepted responsibility for his conduct.

Unauthorized Practice of Law

Finally, the Director [redacted] on reconsideration concluded that Petitioner had engaged in the unauthorized practice of patent law before the PTO. This conclusion rested upon two bases: 1) Because Petitioner engaged in the unauthorized practice of law in [redacted]

Petitioner is the type of individual who would do the same before this Office; and 2) Petitioner's name appears on two Examiner Interview Summary Records dating back to [redacted]

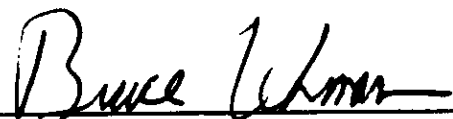
I note that the Director [redacted] Supplemental Decision of Reconsideration -- withdrew unauthorized practice as a basis [redacted] refusal to register Petitioner. As to the second factor, the circumstances surrounding these interviews are not sufficiently clear to warrant the continued exclusion of Petitioner from the patent bar on this basis alone.

Conclusion

It has been _____ years since the _____ letter in which Petitioner voluntarily admitted his misstatements. He has acknowledged his mistake _____, and has expressed regret for his misconduct. Furthermore, his _____ did not involve acts reflecting moral turpitude. Petitioner has also provided strong support for his honesty and integrity in the form of nine letters of recommendation. There is strong support for Petitioner's assertions that his inaccurate answers to questions no. 6 and 42 were inadvertent. This is best reflected in his voluntary admission of the error. Accordingly, Petitioner possesses the requisite good moral character to practice before the PTO.

Order

Upon consideration of the petition to the Commissioner for registration to practice before the PTO in patent cases, it is ORDERED that the petition is *granted*. It is further ORDERED that the Decision on Reconsideration as supplemented is *vacated*,



BRUCE A. LEHMAN
Assistant Secretary of Commerce and
Commissioner of Patents and Trademarks

cc: