

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

In re _____)
) Decision on
) Petition for Review
) Under 37 C.F.R. § 10.2(c)
)

MEMORANDUM AND ORDER

This is a decision on a petition filed May 8, 1996, by
(petitioner) pursuant to 37 C.F.R. § 10.2(c).
Petitioner seeks review of a decision of the Director of the
Office of Enrollment and Discipline (OED), entered

denying his petition under 37 C.F.R. § 10.160 for
reinstatement as a practitioner before the Patent and Trademark
Office (PTO) in trademark and non-patent matters. For the
reasons given herein, the decision of the Director is affirmed.

Background

In _____, petitioner, who was then registered to
practice before the PTO, was charged with several counts of
professional misconduct. Petitioner was found to have

and

to have

and

. The found that submitted falsified documents to PTO, and then engaged in a coverup that revealed

Petitioner was suspended from practice before the PTO for years, with the possibility of probation, and thus reinstatement after two years.

Petitioner's suspension period began on

Petition for Reinstatement

In his present petition for reinstatement dated July 17, ,¹ petitioner seeks reinstatement to practice before the

¹ Plaintiff filed a previous petition for reinstatement on . The Commissioner on denied the petition.

Office in only trademark and other non-patent matters. As can best be discerned from the documents filed with the Director, the basis for petitioner's request to practice trademark and other non-patent law is that he has remained a member in good standing of the _____ Bar. As such, he should not be treated any "differently than any other attorney at law by the PTO and be permitted to practice trademark and other non patent law pursuant to 37 C.F.R. § 2.11." (A000078). Having served his suspension, petitioner contends that further suspension from practicing trademark and other non-patent law is "in gross violation of the Administrative Procedures Act and the dicta in Herman v. Dulles, 205 F.2d 715 (DC Cir. 1953) and Koden v. U.S. Department of Justice, 564 F.2d 228 (7th Cir. 1977)." (A000077).

Petitioner's July 17, _____ filing states, among other things, that he has not practiced as an attorney before the PTO since _____; that he has not acted as a paralegal for any PTO practitioner since _____; and that, since _____, he has not held and does not now hold himself out as being authorized to practice law before the Office. (Petition at 7).

Director's Decision

In a Memorandum Opinion and Interlocutory Decision dated August 9, (hereinafter "I.O.") the Director held final action on the petition "in abeyance pending submission of additional information, evidence and/or arguments." (I.O. at 17). In that decision, the Director identified specific information that petitioner needed to submit to establish his compliance with 37 C.F.R. § 10.158 and with the terms of his suspension. (I.O. at 13-15). This information included:

1. Evidence that he notified all clients with matters before the PTO of his suspension including a copy of each such notification (37 C.F.R. § 10.158(b)(1)) (I.O. at 6);
2. Evidence that he had surrendered all active PTO case files to either the client or another practitioner. (37 C.F.R. § 10.158(b)(2)) (I.O. at 7-10);
3. Evidence that he had not held himself out as authorized to practice before the PTO (37 C.F.R. § 10.158(b)(3)), and had not advertised his availability to render services before the PTO (37 C.F.R. § 10.158(b)(5)) (I.O. at 10-11); and
4. Evidence that he complied with 37 C.F.R. §§ 10.158(c)(1)(i) and 10.158(d) in connection with any work he performed before the PTO (I.O. at 11-13).

In response to the memorandum decision, petitioner submitted numerous copies of correspondence and other evidence. However, petitioner provided no evidence responsive to the four items identified above. Thus, on April 29, 1996, the Director issued a Final Order concluding that petitioner has not shown clearly and convincingly that he has complied with the first three elaborated provisions of § 10.158, which govern suspended practitioners.

With respect to the fourth elaborated provision, i.e., § 10.158(c), the Director found that petitioner had performed paralegal or other PTO-related work during his suspension. A suspended practitioner may, under the express provisions of § 10.158(c), perform paralegal and other Office-related work. However, the performance of such work triggers the provisions of § 10.158(d) when reinstatement is sought. Therefore, petitioner was required to submit affidavits as required by 37 C.F.R. § 10.158(d) establishing the precise nature of all paralegal or other services he performed. Petitioner failed to submit the required affidavits.

OPINION

Under PTO rules of practice, an individual who petitions for reinstatement must make a clear and convincing showing that he will conduct himself in accordance with PTO regulations. 37 C.F.R. § 10.160(c). A suspended practitioner who has violated the provisions of 37 C.F.R. § 10.158 during his period of suspension shall not be entitled to reinstatement until the Director is satisfied that petitioner has complied with Rule 10.158 for a period of time equal to the suspension. 37 C.F.R. § 10.160(d).

Regrettably, it is not clear what part of the Director's decision petitioner challenges because the petition to the Commissioner does not specifically address the Director's Final Decision. Rather, the petition addresses the proceedings of the original disciplinary matter which has already been fully adjudicated.

Petitioner's request to be reinstated to practice before the Patent and Trademark Office in trademark and non-patent matters must be denied for the following reasons. First, petitioner has not shown by clear and convincing evidence that he has complied with the terms of his suspension. Thus, his argument that he has "served his suspension" (petition at 7) must fail. Second, his

argument that he is being treated differently than other attorneys who are permitted to practice trademark and other non-patent law (A000077-78) is without merit. Petitioner is not in the same position as "other attorneys." He has been suspended from practice for serious misconduct by the PTO unlike other attorneys. Non-suspended attorneys generally observe the highest standards of honesty and integrity. See Kingsland v. Dorsey, 338 U.S. 318, 319 (1949). An attorney not permitted to practice patent law before the PTO because of misconduct should not be permitted to practice any law before the PTO especially when the misconduct that resulted in suspension is not unique to patent practice.

LACK OF COMPLIANCE WITH 37 C.F.R. § 10.158(b)

Petitioner was required to inform all of his clients that he had been suspended from practice before the PTO within 30 days of his suspension, and provide OED with copies of all of the relevant correspondence. 37 C.F.R. § 10.158(b)(1). Petitioner has produced no evidence that he notified his clients of his suspension and has not provided OED with the copies of such notice as required by Section 10.158(b)(1).

Section 10.158(b)(2) requires petitioner to surrender all active files to the client or to another attorney designated by the client. Petitioner has made no showing demonstrating compliance with this requirement.

Indeed, the Director presented evidence indicating that petitioner continues to be actively involved in work before the PTO in contravention of this requirement. This evidence includes a motion filed by petitioner with the PTO in a trademark application under petitioner's signature as attorney representing the applicant (A000019)², and a letter requesting a change in a mailing date of an Office action in a patent application indicating petitioner's reinstatement was imminent and that petitioner would be handling the application (A000025-26). This action was signed by petitioner and mailed to his client using a certificate of mailing as recently as November, . This document alone is strong evidence of petitioner's violation of the terms of his suspension and probation. See

. Petitioner had not petitioned for reinstatement at the time this document was filed

² Reference is to the "Bates" numbered appendix attached to the Director's Final Decision.

and the PTO refused to accept this action because petitioner is suspended. (A000033).

Examining all of the evidence of record, the Director found:

The foregoing records and information convincingly demonstrate that since at least , Petitioner has had one or more clients having immediate, prospective, or pending business before the PTO, and that Petitioner remains in control of their files in violation of 37 C.F.R. § 10.158(b)(2). Petitioner has adduced no evidence that he fully complied with § 10.158(b)(2).

(Final Dec. at 14).

Petitioner's submission to PTO of substantive papers with a certificate of mailing, while he was suspended from practice is strong evidence that petitioner will not comply with § 10.158(b).

LACK OF COMPLIANCE WITH 37 C.F.R. §§ 10.158(c) and (d)

Section 10.158(c)(1)(i) permits a suspended practitioner to aid another practitioner in work before the PTO provided that:

(1) the suspended practitioner is under the direct supervision of the supervisory practitioner; and (2) the suspended practitioner is a salaried employee of the supervisory practitioner or the supervisory practitioner's law firm.

Section 10.158(d) sets forth the evidentiary showing necessary for reinstatement of a suspended practitioner who practices under section 10.158(c). Section 10.158(d) requires:

(1) The suspended or excluded practitioner shall have filed with the Director an affidavit which (i) explains in detail the precise nature of all para-legal or other services performed by the suspended or excluded practitioner and (ii) shows by clear and convincing evidence that the suspended or excluded practitioner has complied with the provisions of this section and all Disciplinary Rules, and

(2) The other practitioner shall have filed with the Director a written statement which (i) shows that the other practitioner has read the affidavit required by subparagraph (d)(1) of this section and that the other practitioner believes every statement in the affidavit to be true and (ii) states why the other practitioner believes that the suspended or excluded practitioner has complied with paragraph (c) of this section.

In the Director's Interlocutory Decision, petitioner was provided with evidence of petitioner's continued practice in matters pending before the PTO. In view of this evidence, petitioner was required by 37 C.F.R. § 10.158(d) to file affidavits regarding his work as a paralegal. Inasmuch as petitioner failed to submit any affidavits, the Director did not err by requiring petitioner to comply with the requirements of 37 C.F.R. § 10.158(d) to obtain reinstatement.

**SUSPENSION FROM PRACTICE BEFORE THE PTO IS NOT LIMITED TO
PATENT PRACTICE -**

Petitioner argues that he should be able to represent parties before the PTO in trademark cases despite the fact that he is otherwise suspended from practice before the PTO. He attempted to argue this in his previous petition for reinstatement.³ A practitioner who has committed serious violations of PTO disciplinary rules in patent cases should not be permitted to practice before the PTO in trademark cases. The relevant statutory authority, including 5 U.S.C. § 500; 15 U.S.C. § 1123; and 35 U.S.C. §§ 6, 31 and 32, allows the PTO to adopt rules regulating the practice of all attorneys before the PTO. This authority includes the inherent authority to discipline both patent practitioners and attorneys who practice trademark or

³

other non-patent law before the PTO. See Kodon v. U.S. Dept. Of Justice, 564 F.2d 228, 233 (7th Cir. 1977).

Petitioner further argues that 5 U.S.C. § 500 prohibits an agency from imposing sanctions on attorneys who practice before it. This argument has previously been rejected by the courts. See Polydoroff v. ICC, 773 F.2d 372, 374 (D.C. Cir. 1985) (explaining that 5 U.S.C. § 500(d)(2) provides that section 500(b) "does not authorize or limit the discipline, including disbarment, of individuals who appear in a representative capacity before an agency."). Accord, Touche Ross & Co. v. SEC, 609 F.2d 570, 582 (2d Cir. 1979) (finding that the SEC had authority to promulgate a rule to discipline professionals appearing before it). This authority is in addition to the inherent authority agencies have to regulate who may practice before them as attorneys. See Goldsmith v. U.S. Board of Tax Appeals, 270 U.S. 117, 122 (1926); Herman v. Dulles, 205 F.2d 715, 716 (D.C. Cir. 1953).

Accordingly, suspension before the PTO applies to both patent and trademark cases. The Director was correct in requiring compliance with 37 C.F.R. § 10.158 to establish petitioner's eligibility for reinstatement, including reinstatement for any practice before the PTO.

Conclusion

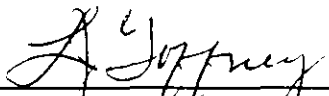
is recommended that petitioner heed the advice of
and reapply when he can provide clear and convincing evidence
that he has complied with the terms of his suspension, which
includes every item set forth in 37 C.F.R. § 10.158.

ORDER

Upon consideration of the Petition to the Commissioner under 37 C.F.R. § 10.2(c), it is

ORDERED that the petition is denied, and the decision of the Director is affirmed.

11/6/96
Date



LAWRENCE J. GOFNEY
Acting Deputy Assistant Secretary
of Commerce and Acting Deputy
Commissioner of
Patents and Trademarks

cc: