

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL
PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK
OFFICE

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

MEMORANDUM AND ORDER

(Petitioner) seeks review of the decision of the Director of the Office of Enrollment and Discipline (OED) disapproving Petitioner's petition for reinstatement to practice before the United States Patent and Trademark Office (USPTO).

I. **BACKGROUND AND PROCEDURAL HISTORY**

The extensive procedural history leading up to the instant petition is set forth in the OED Director's November 21, 2003 decision (OED Decision), and need not be repeated in detail here. Briefly, Petitioner was suspended from practice before the USPTO for seven years, with the final five years of the suspension stayed. Petitioner's suspension was sustained by the District Court for the District of Columbia, the Court of Appeals for the Federal Circuit, and the Supreme Court denied certiorari. The suspension went into effect in 1989. Petitioner has filed six previous petitions for reinstatement, each of which was denied due to petitioner's failure to comply with applicable requirements. The USPTO's denial of Petitioner's sixth petition for reinstatement has been upheld by the District Court for the District of Columbia, and Petitioner's appeal of

that decision has been dismissed by the Court of Appeals for the Federal Circuit as untimely.

II. LEGAL STANDARD FOR REINSTATEMENT

Title 37 C.F.R. § 10.158 requires that a suspended practitioner undertake or refrain from a number of specific actions. Briefly summarized, these include notifying other bars of which he or she is a member of the suspension; surrendering all clients' active case files; not holding himself or herself out as being authorized to practice law before the office; not advertising his or her availability to those with business before the Office; not rendering legal advice or services to those with business before the Office; altering any signs or letterhead suggesting that he or she is authorized to practice before the office; and returning unearned client funds and client property. If a suspended practitioner violates rule 10.158, he or she may not be readmitted to practice "until such time as the Director is satisfied that a period of suspension equal in time to that ordered by the [USPTO Director] . . . has passed during which the suspended . . . practitioner has complied with the provisions of § 10.158." 37 C.F.R. § 10.160(c).

The OED Decision, relying upon numerous previous decisions and Petitioner's own admission, found that Petitioner has violated 37 C.F.R. § 10.158. Petitioner has not meaningfully challenged that finding. Accordingly, in order to be reinstated, Petitioner must satisfy the OED Director that he has been in compliance with 37 C.F.R. § 10.158 for a period at least as long as the period for which he was originally suspended.

III. DISCUSSION

A. Merits

The petition below contains four unelaborated and, on the record, unsupported, statements apparently intended to demonstrate compliance with rule 10.158. Specifically, the petition states that Petitioner has not practiced as an attorney before the USPTO since March 27, 1989; that Petitioner has not held himself as authorized to practice before the USPTO since March 27, 1989; that Petitioner has not acted as a paralegal for any USPTO practitioner since July 15, 1991; and that Petitioner has not held himself as being authorized to practice law in Connecticut since about March 7, 2000. Even taken at face value, these statements appear to address only two of the eight separate requirements of rule 10.158(b).

Further, the OED Decision correctly dismissed these statements in the petition as “unquestionably false and contradicted by both the record and Petitioner’s own prior admissions.” The OED Decision notes that the Memorandum Petition and Final Order issued on February 24, 1999, in response to Petitioner’s fourth petition for reinstatement, specifically held that Petitioner had violated numerous provisions of Rule 10.158, including, inter alia, the prohibitions on conducting unauthorized practice before the Office and on holding himself out as being authorized to practice before the office. OED Decision at 7. The Commissioner’s Decision affirming upon review OED’s denial of Petitioner’s fourth petition for reinstatement also specifically concluded that Petitioner had continued to practice before the PTO. OED Decision at 8. The OED Decision therefore correctly held that Petitioner’s unsupported statement that he had not practiced

or held himself out as authorized to practice before the USPTO since his suspension became effective in 1989 were contradicted by previous final decisions of the USPTO.

The instant petition does not meaningfully dispute the conclusions of the OED Decision in this regard. Petitioner does argue obliquely that he ceased practicing before the USPTO in March 2000, after the Connecticut Supreme Court denied his petition for certification challenging his suspension by the State of Connecticut. However, Petitioner never says so directly, much less presents any evidence to support his assertions. In any event, the statements in the instant petition were not before the OED Director, and new evidence may not be submitted as part of a petition for review. 37 C.F.R. § 10.2(c).

The instant petition also asserts that: “[i]t is, of course, obvious that after the petitioner was suspended . . . on March 27, 1989 he could not have practiced before the USPTO as an Attorney since that date until he had been reinstated by the USPTO” [emphasis in original]. Petitioner appears to be arguing that, as a matter of law, unauthorized practice before the Office is not practice before the Office at all. Such an assertion is clearly frivolous; acceptance of Petitioner’s position would render the requirement that suspended or excluded practitioners not practice before the Office, and indeed the requirement for registration by practitioners, mere formalities. Plaintiff’s assertion that he has not practiced before the USPTO since 1989 therefore does not provide probative evidence that he has been in compliance with § 10.158 for a length of time equal to the term of his original suspension.

B. Other Issues

The petition below includes references to four “attachments,” which were neither attached to the petition nor filed with it. Despite being advised that he must submit the

attachments if they were to be considered, Petitioner insisted that the attachments were otherwise in the USPTO's possession, and requested that the OED Director copy the documents and place them in the petition file. The OED Director declined to do so, relying on 37 C.F.R. § 1.4, and did not consider the substance of the documents in rendering his decision.

Title 37 C.F.R. § 1.4(b) provides that “[s]ince every file must be complete in itself, a separate copy of every paper to be filed in [a patent or trademark file] or other proceeding must be furnished for each file to which the paper pertains, even though the contents of the papers filed in two or more files may be identical.” Petitioner does not dispute the general applicability of this rule to OED proceedings, but instead argues that the documents in question were served upon the OED Director through his “attorneys” in the litigation over Petitioner’s sixth petition for reinstatement. Regardless of whether the documents can be considered to have been served upon the OED Director, Federal Court litigation over Petitioner’s sixth petition is not the same proceeding as administrative consideration of his seventh petition. Petitioner argues that the drafters of 37 C.F.R. § 1.4 “never contemplated a situation regarding service of papers on the OED where there exists a pending litigation – i.e., the 02-789 civil action – between the petitioner

and the OED Director Harry Moatz.” The express purpose of § 1.4(b), however, is to ensure the completeness of files, and the existence of litigation over one petition does nothing to diminish the need for completeness of the file in a subsequent petition. Accordingly, the OED Director did not err in declining to consider the referenced “attachments” and they do not form part of the record upon which the instant decision is based.

As if to illustrate the need for the USPTO to control the contents of its files, the instant Petition for Reconsideration purports to incorporate by reference the entire record of the civil proceeding over the Petitioner's sixth petition, as well as including several "exhibits." Recourse to 37 C.F.R. § 1.4(b) is not required here, however. Title 37 C.F.R. § 10.2(c) requires that petitions for reconsideration be decided on the existing record and explicitly prohibits the USPTO Director from considering new evidence. Accordingly, neither the documents "incorporated by reference" in the instant Petition nor the "exhibits" appended thereto have been considered in rendering this decision.

The petition below included a request that the OED Director recuse himself from consideration of the petition. The grounds Petitioner asserted for recusal were (1) the OED Director's asserted involvement in the in re Small matter; (2) the OED Director's role in writing 37 C.F.R. part 10; and (3) what Petitioner alleges was a threat by the OED Director.

As far as can be ascertained from the record, Petitioner's first ground for requesting recusal was based on the assertion that the current OED Director was collecting envelopes in an apparently unrelated disciplinary matter (in re Small) at the same time his then supervisor testified that envelopes were not retained in the disciplinary action against Petitioner. Why this assertion, even if true, should require the OED Director to be recused from considering a petition by Petitioner filed nearly twenty years later is simply not evident. Similarly, Petitioner's second asserted basis for seeking recusal, that the OED Director assisted in drafting the regulations under which the petition was considered, does not appear to create a conflict of interest of any sort, much less require recusal.

Finally, Petitioner asserted below that the OED Director threatened to retaliate against him. The only information in the record about the alleged threat is that it occurred during a telephone conversation held April 4, 2003. The petition below refers to an affidavit dated April 5, 2003, assertedly memorializing the conversation, cited as exhibit B to the petition below. As discussed above, however, the purported exhibits to the petition were never made a part of the record in this matter. Petitioner's failure to provide a copy of the affidavit with petition below effectively precludes review of this matter. There is therefore no basis in the record to disturb the OED Director's dismissal of this allegation as "unfounded." OED Decision at 13.

The instant petition appears to raise an additional alleged ground for recusal: that the OED Director adjudicated Petitioner's fifth, sixth and seventh petitions for reinstatement. Plainly, the OED Director's consideration of the petition below did not provide grounds to recuse himself from doing so, and it is simply not apparent why his consideration of the two previous petitions would provide grounds for recusal.

Petitioner also asserts that "he should have been reinstated . . . long ago" under the rules that were in effect at the time the disciplinary proceeding against him were instituted. The initial decision disciplining Petitioner was issued in 1986. The current reinstatement provisions became effective in 1985. Nothing in the rule or the Federal Register notice under which it was promulgated, 50 F.R. 5172, Feb. 6, 1985, appears to exclude practitioners suspended as a result of disciplinary proceedings pending on the effective date of the rule. Petitioner did not raise this issue in his petition to OED and has even now presented no legal argument supporting his position that he should be subject to the prior rule. Accordingly the issue need not be further considered.

C. Requirement for Petitioner to Take Examination

The OED Decision also determined that, due to the length of time during which Petitioner has been suspended and his repeated failure to comply with USPTO procedures, Petitioner would be required to take and pass the exam given under §10.7(b) in addition to complying with all other applicable requirements for reinstatement. Petitioner asserts that the OED Director has failed to specify the procedures Petitioner has failed to follow. Title 37 C.F.R. § 10.160(c)(1) provides the OED Director with discretion to require a suspended practitioner to pass the registration exam as a condition for reinstatement. Petitioner's repeated failure to demonstrate that he is in compliance with the requirements applicable to suspended practitioners strongly suggests that he either does not understand these requirements or is unwilling to comply with them. Petitioner is free to argue in a subsequent petition that his extended non-compliance is attributable to the latter and not to the former. The current record, however, establish no basis to question the OED Director's exercise of his discretion.

Petitioner also asserts that he "has thoroughly and completely familiarized himself over the years with all changes of the UPSTO rules and laws which have occurred since his suspension, via the Internet." It is not necessary to decide what weight, if any, should be assigned to this statement; it is presented for the first time in the Petition for Review and therefore is not for consideration. 37 C.F.R. § 10.2(c).

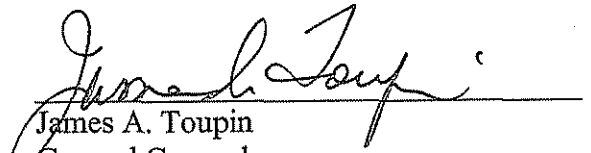
IV. CONCLUSION

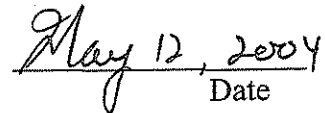
For the reasons stated above, the OED Director's decision is in accord with the governing regulations and well-based on the evidence in the record. The OED Director's decision is hereby affirmed.

ORDER

It is ORDERED that the petition is denied.

On behalf of the Under Secretary of Commerce
for Intellectual Property and Director of the
United States Patent and Trademark Office


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


Date