

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

**In re**

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)  
) Decision on Petition  
) Under 37 C.F.R. § 11.2(d)  
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**MEMORANDUM AND ORDER**

(Petitioner) seeks review of the decision of the Director of the Office of Enrollment and Discipline (OED) disapproving Petitioner's Eighth Petition for Reinstatement to practice before the United States Patent and Trademark Office (USPTO). For the reasons stated below, the Petition for Review is **DENIED**, and the decision of the Director is **AFFIRMED**.

**I. BACKGROUND AND PROCEDURAL HISTORY**

The circumstances leading to Petitioner's suspension from practice before the USPTO are well-documented. As the United States District Court for the District of Columbia recently summarized,

The USPTO instituted a disciplinary proceeding against [Petitioner] in 1984, charging him with fraudulently back-dating documents he filed with the USPTO, neglecting legal matters entrusted to him, and providing false information in connection with the USPTO's investigation of his conduct. After an extensive discovery period and hearing, the Administrative Law Judge ("ALJ") found that [Petitioner] had violated various USPTO disciplinary rules and recommended that he be suspended from practice for two years. The USPTO Director agreed with the ALJ's decision, and issued a final order suspending [Petitioner] from practice for two years. The order provided that he could qualify for reinstatement after the two year suspension by complying with the requirements found in 37 C.F.R. §§ 10.158 ("Rule 158") and 10.160 ("Rule 160").

Since that time, instead of complying with the terms of the Director's order regarding reinstatement, [Petitioner] has filed eight petitions with the USPTO, and

numerous cases in the federal district courts and appeals to the Federal Circuit, each substantively challenging his original suspension from practice.

...

All of [Petitioner's] petitions to the USPTO have been denied for the same reason – namely that [Petitioner] failed to comply with the requirements for reinstatement outlined in Rules 158 and 160. All of the USPTO's decisions denying [Petitioner's] petitions have been upheld in federal district court. ... All of the District Court decisions which were appealed were affirmed by the Federal Circuit.

*Klein v. Toupin*, No. CIV. 05-647(GK), 2006 WL 1442611, at \*1 (D.D.C. May 24, 2006); *aff'd*, 208 Fed. Appx. 906 (Fed. Cir. 2006) (citations omitted) (*Klein*).

In his Eighth Petition for Reinstatement and subsequent filings, Petitioner claimed that he “[has] been in compliance with 37 C.F.R. § 10.158 since about March 2000.” Eighth Petition for Reinstatement at 1. Petitioner also asserted, presumably in lieu of complying with the OED Director's November 21, 2003, Memorandum Opinion and Final Decision (which requires that Petitioner take and pass the USPTO registration examination as a condition of reinstatement), that he “has completely familiarized himself, via the Internet, with all changes of the USPTO rules and laws which have occurred since his suspension,” and that, notwithstanding OED's order, the need for him to take the examination at all is obviated because “through no fault of his own, the issue of when [Petitioner] acquired his knowledge of the ‘Clopper Memoranda’ had not been finally adjudicated until [December 6, 2006.]”<sup>1</sup> Verified Supplement to Eighth Petition for Reinstatement, January 31, 2007, at 6. Petitioner further claimed that he had discussions with Sydney Johnson, an attorney in the USPTO's Solicitor's Office, through which, though “not

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<sup>1</sup> The “Clopper Memoranda” “were part of the record the [ALJ] considered in initially suspending [Petitioner] from practice. The Clopper Memoranda were listed in the USPTO's exhibit list, which was served on [redacted] on June 3, 1985, through his lawyer. ... Indeed, [Petitioner] even cited to the Clopper Memoranda in his reply brief, filed on October 30, 1985, at the disciplinary hearing. ... [Petitioner's] argument that the Clopper Memoranda were only recently ‘discovered’ is without any merit whatsoever,” [redacted] at \*3. It is unclear why Petitioner believes his case is advanced by reference to the date of the adjudication of when he became aware of the Clopper Memoranda.

stated directly [redacted] had “gained the impression that the withdrawal of his Eighth Petition would result in the USPTO giving favorable consideration” to his reinstatement. *Id.*

After considering Petitioner’s submissions, the OED Director denied his reinstatement. Specifically, the OED Director noted that “Petitioner fails to present any objective evidence” supporting his claim of compliance with § 10.158, and that Petitioner’s claim of “complete familiar[ity]” with USPTO rules and laws is not “objective evidence that [he] has applied for, taken, and passed the registration examination” as was required of him under § 10.160. Memorandum Opinion and Final Decision, February 5, 2007, at 2. The Director concluded that, because “OED must ensure that a suspended practitioner seeking reinstatement has produced *objective evidence* of compliance with *mandatory requirements* of 37 C.F.R. §§ 10.158 and 10.160,” and because Petitioner has not met this burden, “reinstatement would be improper at this time.”

Petitioner now seeks review of the OED Director’s decision under 37 C.F.R. § 11.2(d). In his Petition for Review, [redacted] again raises his conversations with [redacted]; although Petitioner does not suggest that Mr. [redacted] had committed OED to any particular action, or was even authorized to do so, he nonetheless evinces “surprise” at the denial of his Eighth Petition for Reinstatement. Petition for Review at 1.

Petitioner also renews his reliance on the Clopper Memorandum, calling for the agency to take “judicial notice” of two facts: first, that “it was only ... [on] 2/5/07 that OED has acknowledged for the first time the fact that the issues raised by the discovery by Klein of the Clopper Memoranda ... have never been considered by [the USPTO],” and, second, that “the USPTO has consistently maintained ... that there never had been retained any [redacted] [(Petitioner’s former law firm)] envelopes by USPTO management.” *Id.* at 3.

Petitioner further argues that these facts constitute mitigating circumstances, and points to another decades-old discipline case in which a practitioner was suspended from practice before the USPTO. In that case, the then-USPTO Director cited to the physical evidence as supporting OED's discipline of that practitioner. Under Petitioner's theory, "USPTO was actively concealing the fact that it had at least eleven envelopes with postmark dates" in his own case, and this alleged concealment is a mitigating circumstance. *Id.* at 4-5. In this same connection, Petitioner asserts that his "discovery ... of the existence of the Clopper Memoranda on or about May-16, 2002," constitutes an "extraordinary circumstance" under 37 C.F.R. §10.170, "requir[ing] that [he] be given the requested relief, namely his reinstatement[.]" *Id.* at 7.

Finally, Petitioner claims that the passage of time has impeded his ability to show, by objective evidence, his compliance with 37 C.F.R. § 10.158. For this reason, he asks that "he be given access to his files by the USPTO so that he may hopefully find the documents OED requires him to produce." *Id.*

## II. LEGAL STANDARDS

Upon suspension, a practitioner must comply with the rules pertaining to suspended practitioners, set forth in 37 C.F.R. § 10.158. If a practitioner does not comply with those rules, he may not be readmitted to practice until he has complied with 37 C.F.R. § 10.158 for a period of time equal to the original period of suspension. 37 C.F.R. § 10.160(c). The OED Director has previously determined that Petitioner violated Rule 158 and, therefore, Petitioner must demonstrate that he is currently in compliance with the Rule, and has been in compliance for a period at least as long as his original suspension.

In addition to demonstrating compliance with Rule 158, a petitioner must "make[] a clear and convincing showing that [he] will conduct himself ... in accordance with the regulations of this

part and that granting a petition for reinstatement is not contrary to the public interest. As a condition to reinstatement, the Director may require the individual to ... tak[e] and pass[]” the registration examination. 37 C.F.R. 10.160(c).

### III. ANALYSIS

Neither his Eighth Petition for Reinstatement nor his Petition for Review provides any basis to grant Petitioner’s reinstatement or otherwise set aside the OED Director’s decision.

To the extent that Petitioner’s arguments call for his original discipline to be revisited or mitigated, those arguments are out of place. Petitioner’s discipline has been extensively litigated, both before the USPTO and the federal courts (*see, e.g.* [redacted] and is – in all factual and legal respects – *res judicata*. Contrary to Petitioner’s assertions, there is nothing exceptional about this case that requires or justifies perpetual reexamination of Petitioner’s conduct and the subsequent disciplinary proceedings. Although the arguments in the Petition for Review will be discussed in turn, they are inapposite to the only relevant issues: whether Petitioner has complied with 37 C.F.R. § 10.158; and the OED Director’s order, pursuant to 37 C.F.R. § 10.160, to take and pass the registration examination.

First, Petitioner’s purported conversations with [redacted] even if taken as true and accurate, offer him no relief. Petitioner has failed to demonstrate any adverse affect from Mr.

[redacted] purported suggestion; Petitioner did not, for instance, withdraw his petition or otherwise detrimentally rely on Mr. [redacted] advice. Moreover, as noted above, there is no allegation that M [redacted] acted in such a way as to bind OED, that he had authority to bind OED, or even that he appeared to have such authority. This should not be construed as an indication that the undersigned would view the matter any differently if any of these considerations had been alleged (or proven). Conversations between Petitioner and an attorney

in the Solicitor's Office have no bearing whatsoever upon whether Petitioner should be reinstated, an inquiry that is limited to whether Petitioner has complied with the terms of Rules 158 and 160.

Second, "judicial notice" is unavailable for the two propositions identified by Petitioner, concerning the Clopper Memoranda. As an initial matter, an administrative body is – by definition – incapable of taking "judicial" notice. Moreover, even if Petitioner's request were to be interpreted as seeking administrative notice, Petitioner's propositions are not the type of "commonly known fact" of which notice-taking is appropriate. *Cf.* 8 C.F.R. § 1003.1(d)(3)(iv) (authorizing Board of Immigration Appeals to take limited "administrative notice of commonly known facts such as current events or the contents of official documents").

Third, apart from the unavailability of official notice, the identified propositions are irrelevant. They do not support mitigation, or comprise extraordinary circumstances. It is fully settled that Petitioner was aware of the Clopper Memoranda in 1985. As the district court noted, Petitioner cited the Clopper Memoranda in his October 30, 1985, Reply Brief. *See* fn.1, above. This plainly belies Petitioner's recent claim that he "discovered" the memoranda in May 2002. Furthermore, Petitioner's "active concealment" claim has been previously rebutted; the USPTO has explained that the envelopes in question were discarded in the routine course of business. *See* affidavit of Harris A. Pitlick, April 2, 1991, provided to Petitioner in response to Freedom of Information Act Request No. 05-158.

Fourth, any comparison between Petitioner's discipline and other discipline cases is irrelevant. The OED sanction has been litigated and upheld. Even if a case-to-case comparison were to show that Petitioner had been treated materially differently from other practitioners, his original discipline is no longer at issue.

Fifth, Petitioner's request for "access to his files [kept] by the USPTO," would be fruitless, even if granted. Petitioner has, in response to his many Freedom of Information Act requests, been provided with all relevant information that is still within USPTO's files. Whether that information, by itself, is insufficient to demonstrate compliance is irrelevant: the burden of demonstrating compliance with Rule 158 by objective evidence is Petitioner's to bear. Petitioner also overlooks the fact that, even if his unsubstantiated assertion of compliance with Rule 158 were accepted, he still has not taken and passed the USPTO registration examination, as the OED Director has required, consistent with Rule 160.

#### **IV. CONCLUSION**

Petitioner's arguments do not provide a basis to grant his Petition for Review of the OED Director's February 5, 2007, Final Decision. The OED Director correctly determined that Petitioner has failed to demonstrate compliance with Rules 158 and 160, and properly disposed of Petitioner's continued attempts to relitigate his original discipline.

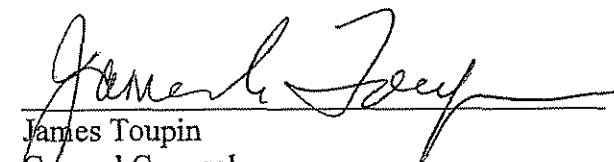
**ORDER**

Upon consideration of the Petition to the USPTO Director for review under 37 C.F.R. § 11.2(d), it is ORDERED that the Final Decision of February 5, 2007, is AFFIRMED.

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

DEC 19 2007

Date

  
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