

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

**In re Frank A. Santoro,
Respondent.**

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Proceeding No. D2008-15

FINAL ORDER

The Director of Enrollment and Discipline (OED Director) of the United States Patent and Trademark Office (USPTO) and Frank A. Santoro (Respondent) have submitted a settlement agreement in the above-identified proceeding that meets the requirements of 37 C.F.R. § 10.133(g).

In order to resolve the case without the necessity of a hearing, the OED Director and Respondent have agreed to certain stipulated facts, legal conclusions and sanctions, all of which are set forth below. It was further agreed between the OED Director and Respondent that this agreement resolves any and all disciplinary action by the USPTO arising from the allegations set forth in the Complaint.

Pursuant to that agreement, this Final Order sets forth the following stipulated facts, agreed-upon legal conclusions and sanctions.

STIPULATED FACTS

Background

1. At all times relevant hereto, Respondent of Brick, New Jersey, has been an attorney registered to practice patent law before the USPTO (Registration Number 26,357) and is subject to the USPTO Disciplinary Rules set forth at 37 C.F.R. § 10.20 *et seq.*
2. Respondent has been registered as a patent attorney with the USPTO since February 11, 1972.
3. Respondent was licensed to practice law in the State of New Jersey in 1970. At all relevant times to this Proposed Settlement, Respondent was so licensed until his disbarment by that state's highest court effective August 1, 2007.

Disbarment from New Jersey State Bar

4. The Supreme Court of New Jersey in a proceeding styled *In the Matter of Frank A. Santoro*, 192 N.J. 285, 927 A.2d 1285 (2007) entered a decision on August 1, 2007.

5. The Supreme Court of New Jersey stated that Respondent tendered his consent to disbarment as an attorney at law of the State of New Jersey.
6. The Supreme Court of New Jersey stated that there appeared to be good cause and ordered Respondent disbarred by consent, effective immediately.
7. The Supreme Court of New Jersey ordered Respondent's name be stricken from the roll of attorneys and that he be permanently restrained and enjoined from practicing law.
8. The Supreme Court of New Jersey ordered that all funds, if any, currently existing in any New Jersey financial institution maintained by Respondent pursuant to New Jersey Court Rule (Rule) 1:21-6 shall be restrained from disbursement except on application to this Court for good cause shown and shall be transferred by the financial institution to the Clerk of the Superior Court, who is directed to deposit the funds in the Superior Court Trust Fund pending further Order of the Court.
9. The Supreme Court of New Jersey ordered that Respondent comply with *Rule 1:20-20* dealing with disbarred attorneys
10. The Supreme Court of New Jersey ordered that the entire record of the matter be made a permanent part of Respondent's file as an attorney at law of this State
11. The Supreme Court of New Jersey ordered that Respondent reimburse the Disciplinary Oversight Committee for appropriate administrative costs and actual expenses incurred in the prosecution of this matter, as provided in *Rule 1:20-17*.

LEGAL CONCLUSIONS

12. Based on the information contained in paragraphs 1 through 11, inclusive, the Respondent acknowledges that his conduct violated 37 C.F.R. § 10.23(c)(5) of the USPTO Code of Professional Responsibility in that the Respondent was disbarred from practice as an attorney on ethical grounds by the Supreme Court of New Jersey.

SANCTIONS

Based on the foregoing, it is:

13. **ORDERED** that the Final Order incorporates the facts and legal conclusion stipulated in Paragraphs 1 - 12 above.
14. **ORDERED** that Respondent is excluded, pursuant to 35 U.S.C. § 32 and 37 CFR § 10.133(g), from practice before the Office in patent, trademark and other non-patent law

cases beginning immediately upon the Office Director signing the Final Order;

15. ORDERED that the Director of Enrollment and Discipline publish the Final Order;
16. ORDERED that the Director of Enrollment and Discipline publish the following notice in the Official Gazette:

NOTICE OF EXCLUSION

Frank A. Santoro, of Brick, New Jersey, a person registered as a patent attorney, Registration No. 26, 357, has been excluded from practice before the United States Patent and Trademark Office in patent, trademark, and other non-patent law cases. This action is taken pursuant to 35 U.S.C. § 32 and 37 CFR §§ 10.133(g) and 10.159(b).

17. ORDERED that, in accordance with 37 C.F.R. § 10.159, the Director of Enrollment and Discipline give notice to appropriate employees of the Office, interested departments, agencies, and courts of the United States; appropriate authorities of any State in which respondent is known to be a member of the bar; and any appropriate bar association.
18. ORDERED that, in accordance with 37 C.F.R. § 10.158(b)(1), Respondent shall within 30 days of entry of the Final Order: a) notify in separate written communications all bars of which Respondent is a member and all his clients for whom he is handling matters before the Office of the exclusion, if any, and b) file a copy of each written communication with the Director of Enrollment and Discipline.
19. ORDERED that, in accordance with 37 C.F.R. § 10.158(b)(2), Respondent, to the extent he has any such files, shall within 30 days of the date of the Final Order: a) surrender each client's active Office case file(s) to each client or to another practitioner designated by each client and b) file proof thereof with the Director of Enrollment and Discipline.
20. ORDERED that, in accordance with 37 C.F.R. §§ 10.158(b)(4) and (b)(7), Respondent, to the extent any such expressions or indications exist, shall promptly take any necessary and appropriate steps to remove from any telephone book, legal directory, sign, letterhead, and other media all advertisements, statements, representations, and all other expressions and indications that would reasonably suggest that the practitioner is authorized to practice law before the Office, and, within 30 days of taking those steps, shall file with the Director of Enrollment and Discipline an affidavit describing the precise nature of the steps taken.
21. ORDERED that, in accordance with 37 C.F.R. §§ 10.158(b)(8) and 10.160(d), Respondent, to the extent he has any such funds, shall within 30 days of the date of the Final Order return to any client having immediate or prospective business before the Office any unearned legal

funds, including any unearned retainer fee, and any securities and property of the client, and shall file a proof thereof with the Director of Enrollment and Discipline no later than filing his petition for reinstatement.

22. ORDERED that, in accordance with 37 C.F.R. §§ 10.158(a) and (b), Respondent, during the period of exclusion, shall: a) not engage in unauthorized practice of patent, trademark and other non-patent law before the Office; b) not hold himself out as authorized to practice before the Office; c) not advertise his availability or ability to perform or render legal services for any person having immediate, prospective, or pending business before the Office; and d) not render legal advice or services to any person having immediate, prospective, or pending business before the Office as to that business.

23. ORDERED that in the event that Respondent acts as a paralegal or aids or endeavors to aid another practitioner in any way in the other practitioner's practice of law before the Office during the period of any exclusion directed by the Final Order, Respondent shall comply with 37 C.F.R. §§ 10.158(c) and (d);

REINSTATEMENT

24. ORDERED that following exclusion for five years in compliance with the provisions of § 10.158, Respondent may apply for reinstatement to practice by filing a petition for reinstatement and an affidavit showing:

- a. Compliance with 37 CFR §§ 10.158(a) and 10.160;
- b. Compliance with the orders of the Supreme Court of New Jersey in a proceeding styled *In the Matter of Frank A. Santoro*, 192 N.J. 285, 927 A.2d 1285 (2007);
- c. Respondent acknowledges that, if and when he applies for reinstatement, the Director of Enrollment and Discipline will conclusively presume, for limited purpose of determining the application for reinstatement, that (i) the stipulated facts, above, are true and (ii) Respondent could not have successfully defended himself against the legal conclusions stemming from those facts.

25. ORDERED that all parties shall bear their own costs.

On behalf of Jon W. Dudas
*Under Secretary of Commerce For Intellectual
Property and Director of the United States Patent
And Trademark Office*

16 May 08

Date

for Will R G

James A. Toupin

General Counsel

United States Patent and Trademark Office

cc: Harry I. Moatz
OED Director

Frank S. Santoro