

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

In the Matter of	)	
	)	
Richard S. Missimer,	)	Proceeding No. D08-06
	)	
Respondent	)	
	)	

**Final Order**

Director of the Office of Enrollment and Discipline Harry I. Moatz (“OED Director”) and Richard S. Missimer (“Respondent”) have submitted a proposed settlement agreement to the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office or his designate (“USPTO Director”).

The OED Director and Respondent’s proposed settlement agreement sets forth certain stipulated facts, legal conclusions, and sanctions to which the OED Director and Respondent have agreed in order to resolve voluntarily a disciplinary complaint against Respondent. The proposed settlement agreement, which satisfies the requirements of 37 C.F.R. § 11.26, resolves all disciplinary action by the United States Patent and Trademark Office (“USPTO” or “Office”) arising from the allegations investigated by OED and the evidence submitted to the USPTO’s Committee on Discipline.

Pursuant to such proposed settlement agreement, this Final Order sets forth the parties’ stipulated facts, joint legal conclusions, and agreed upon discipline.

**Stipulated Facts**

1. At all times relevant hereto (i.e., between March 24, 2000, and October 26, 2006), Respondent of Hartford, Wisconsin, has been an agent registered to practice patent law before the Office (Registration Number 45,537) and is subject to the USPTO Code of Professional Responsibility set forth at 37 C.F.R. § 10.20 et seq.
2. Since September 11, 2006, Respondent has been an attorney in good standing licensed to practice in the State of Wisconsin (License Number 1042593).
3. Since October 26, 2006, Respondent has been an attorney registered to practice before the Office (Registration Number 45,537).

**Patents Penned, Inc.**

4. Unless otherwise specified, at all times relevant hereto:

- a. Patents Penned, Inc. ("PPi") was a corporation organized under Subchapter S of Chapter 1 of the Internal Revenue Code and Chapter 180 of The Wisconsin Statutes;
- b. PPi, as a corporate entity, was not and could not be registered to practice before the Office within the meaning of 37 C.F.R. §§ 11.5-11.11; therefore, it was not lawfully entitled to represent persons having prospective or immediate business before the Office in the preparation and prosecution of patent applications;
- c. Respondent was president of PPi;
- d. Respondent held PPi out to the public as a corporation that prepared and prosecuted patent applications;
- e. Respondent allowed PPi to enter into contracts with clients to prepare and prosecute their patent applications; and
- f. From March 20, 2000, until September 2006, PPi deposited advanced fees received from clients into its general operating account, which was not a client trust account.

5. Since September 2006,

- a. Respondent has restructured PPi (now known as "Patents Penned, S.C.") as a limited liability organization and registered it with the Wisconsin State Bar;
- b. Respondent has maintained lawyers professional liability insurance through a policy issued by Wisconsin Lawyers Mutual Insurance Company policy that affords liability coverage in the limits required by the State Bar of Wisconsin and that identifies himself and PPi as a named insured;
- c. Respondent has caused PPi to establish and use an Attorney IOLTA Trust Account in accordance with the requirements of the State Bar of Wisconsin; and
- d. Respondent has otherwise endeavored to comply with Wisconsin State Bar requirements for PPi to be recognized as a limited liability entity.

#### Representation of Client G.

6. In 2003, G. entered into a contract with PPi to prepare and prosecute U.S. patent applications for G.'s inventions.

7. Respondent asserts that it was difficult to communicate with G. about his inventions and patent applications because G. was rarely available, and, therefore, G. directed Respondent to communicate with G.'s father, a licensed professional engineer, who would act as an intermediary.

8. Respondent asserts that G. and G.'s father had different opinions relating to the invention and that Respondent deferred to G. because G. was the inventor and client. Respondent asserts that his deference to G. caused communications between G.'s father and Respondent to become increasingly antagonistic.

9. On January 26, 2004, Respondent filed a U.S. Patent Application with the Office on behalf of G. ("the '970 application").

10. On October 7, 2004, Respondent filed a second U.S. Patent Application with the Office on behalf of G. for a related invention ("the '156 application").

11. The '970 application and the '156 application were among the first patent applications that Respondent independently drafted, reviewed, and filed with the Office.

12. On February 16, 2005, the Office issued a non-final office action rejecting claims in the '970 application. The Office issued the office action, in part, because Respondent did not comply with the format requirements set forth in § 709.01(m) the Manual of Patent Examining Procedure (MPEP). The February 16, 2005, office action informed Respondent that a response thereto was due in three months.

13. Respondent asserts that the format errors in the '970 application were caused, in part, by the operation of a "grammar check" function on the word processing software used to prepare the application, a proofreader's errors, and his own failure to catch the errors prior to submitting the application to the Office.

14. Respondent asserts he did not learn of the February 16, 2005, office action in a timely manner because he was going through a divorce proceeding, no longer resided at the address to where the Office mailed the office action, and his estranged wife, who still resided at such address, did not forward his mail to him in a timely fashion.

15. On May 11, 2005, Respondent filed a petition for an extension in time to respond to the February 16, 2005, office action in the '970 application.

16. Respondent did not promptly notify G. of the February 16, 2005, office action when Respondent received it, nor did Respondent notify G. that he had filed a petition for an extension in time to respond to that office action.

17. Respondent asserts that the delay in informing G. about the office action and request for extension was attributable, in part, to the general difficulties in communicating with G.

18. The February 16, 2005, office action was seven pages in length. Respondent asserts that he only received six of the seven pages from his estranged wife. The page missing was a cover sheet, which indicated the date of the office action. Respondent asserts that he did not realize that the cover sheet was missing because this was Respondent's first office action.

19. On July 12, 2005, G's father sent Respondent an e-mail indicating that G.'s father may have sent a prior e-mail to the wrong address for Respondent. The July 12, 2005, e-mail stated, in part, that "[G] TELLS ME YOU RECEIVED A REPLY OR QUESTIONS FROM THE PATENT OFFICE. PLEASE E-MAIL PATENT OFFICE REPLY, QUESTIONS OR WHATEVER, TO [G] OR I SO WE CAN PREPARE A SUITABLE REPLY."

20. Respondent could not scan and e-mail the requested documents to G.'s father on July 12, 2005. Thus, via a July 12, 2005, e-mail, Respondent asked G.'s father for a fax number in order to send the documents and explained, "There is only one page that addresses the things I need for [G.] to discuss so, I could type it into an eMail." Respondent's July 12, 2005, e-mail did not alert G. to the date of the office action.

21. Via a July 12, 2005, e-mail responding to Respondent's July 12, 2005, e-mail, G.'s father provided a fax number and again requested a copy of any reply, question, or other information from the Office regarding the '970 application. In response, on July 13, 2005, Respondent believes he sent the entire document (minus the cover sheet).

22. Via a July 13, 2005, e-mail, G.'s father informed Respondent that he had received only three pages of the February 16, 2005, office action. In response, via a July 13, 2005, e-mail to G.'s father, Respondent explained that he had sent what he informed G. he was going to send and asked G.'s father to specify what G. wanted Respondent to do.

23. Via a July 15, 2005, e-mail, Respondent informed G.'s father that he had faxed "the complete Office action." According to G.'s father, Respondent did not fax the cover sheet.

24. Via a July 27, 2005, e-mail, Respondent informed G.'s father that Respondent had spoken with the USPTO examiner about the examiner's concerns with the '970 application and "worked it all out" such that the examiner "is in a far difference position now than he was."

25. The OED Director asserts that the USPTO examiner could not recall any conversation with Respondent and that the USPTO examiner explained that he would have documented the file had any substantive agreement been reached with Respondent about the '970 application.

26. Respondent asserts that the conversation with the USPTO examiner occurred, that it was a general conversation in which the nature of the invention was discussed and the USPTO examiner agreed to communicate with Respondent via e-mail. Respondent agrees that no substantive agreement was reached with the USPTO examiner during this conversation.

27. On or about August 16, 2005, Respondent filed a response to the February 16, 2005, office action along with a second request for an extension of time to respond.

28. On August 16, 2005, Respondent informed G. that he had filed a response to the February 16, 2005, office action, but Respondent did not inform his client about the second extension request.

29. In an August 19, 2005, letter to Respondent, G. expressed dissatisfaction with Respondent's representation of G.'s interests and, in part, requested a return of certain monies paid to PPI.

30. In an August 24, 2005, letter to G., Respondent noted, in part, "Your letter comes addressed to me personally and not the corporation with which you have an agreement and working relationship. So, I remind you that your business relationship is with Patents Penned, Inc., and not me personally."

31. Respondent asserts that, at the time he wrote the August 24, 2005, letter, Respondent understood that he was personally liable as a professional for the patent work related to G.'s invention and that he was merely directing G. to PPI with regards to refund and money handling issues only.

32. On or about August 19, 2005, G. terminated his relationship with PPI and obtained other representation for his patent applications, which were eventually abandoned.

#### Representation of Client B.

33. In 2003, B. entered into a contract with PPI to prepare and prosecute U.S. patent applications for B.'s invention.

34. On October 21, 2004, Respondent filed a U.S. Patent Application with the Office on behalf of B ("the '970 B application"). The '970 B application was among the first patent applications that Respondent independently drafted, reviewed, and filed with the Office.

35. On March 17, 2005, the Office issued a non-final office action rejecting the claims in the '970 B application for which a response was due in three months. The Office issued the office action, in part, because Respondent did not comply with the format requirements set forth in MPEP § 709.01(m). Part of the '970 B application also was not drafted in compliance with MPEP § 608.01(n).

36. Respondent asserts that the format errors in the '970 B application were caused, in part, by the operation of a "grammar check" function on the word processing software used to prepare the application, a proofreader's errors, and his own failure to catch the errors prior to submitting the application to the Office.

37. On August 12, 2005, Respondent filed his reply to the March 17, 2005, office action in the '970 B application with the Office. In part, the reply contained a new claim that did not comply with the format requirements set forth in MPEP § 709.01(m).

38. On September 20, 2005, the Office issued a final office action summary pointing out the deficiencies in Respondent's August 12, 2005, submission to the Office.

39. Respondent asserts that B. notified PPI to abandon the '970B application.

40. Respondent asserts that B. has expressed satisfaction with Respondent's representation.

#### Respondent's Declarations

41. Respondent declares:

- a. He attended Marquette University Law School from August 2000 to August 2006, and during his law school career he focused on patent drafting and law and completed courses in Intellectual Property, claims drafting, and patent prosecution.
- b. He attended a Practising Law Institute seminar entitled "Fundamentals of Patent Prosecution 2008: A Boot Camp for Claim Drafting and Amendment Writing" from June 18 to 20, 2008, in New York, New York, which the Wisconsin State Bar has approved for 20.0 hours of continuing legal education credit;
- c. He has created and currently uses a two-page checklist of USPTO requirements when drafting and reviewing patent applications as one means of ensuring compliance with MPEP requirements;
- d. He is currently reviewing all of the patent applications he drafted for PPI's clients and submitted to the Office for the purpose of identifying drafting errors and correcting them at no expense to the client; and
- e. He is amenable to refunding \$1,500.00 to G. and foregoing collection of the approximate \$600.00 that G. purportedly owes to PPI.

#### **Legal Conclusions**

42. Based on the information contained in paragraphs 1 through 40, above, Respondent acknowledges that his conduct violated the following Disciplinary Rules of the USPTO Code of Professional Responsibility:

- a. 37 C.F.R. § 10.23(b)(4), as further defined by 37 C.F.R. § 10.23(c)(2)(i), by not providing complete and accurate information in a timely manner to a client about the status of a pending application pending before the Office; and
- b. 37 C.F.R. §§ 10.48, 10.49, 10.78, and 10.112(b) based on the business arrangement with PPI as they pertain to PPI's preparation and prosecution of

patent applications.

### Sanctions

43. Respondent agreed, and it is ORDERED that:
- a. Respondent be, and hereby is, publicly reprimanded;
  - b. The OED Director shall publish this Final Order;
  - c. The OED Director shall publish the following Notice in the Official Gazette:

#### Notice of Reprimand

Richard S. Missimer of Hartford, Wisconsin, a patent attorney whose Registration Number is 45537, has been reprimanded and placed on probation by the United States Patent and Trademark Office for 1) not complying with 37 C.F.R. § 10.23 (b)(4), as further defined by 37 C.F.R. § 10.23(c)(2)(i), by not providing complete and accurate information in a timely manner to a client about the status of a patent application pending before the Office and 2) 37 C.F.R. §§ 10.48, 10.49, 10.78, and 10.112(b) based on his business relationship with a corporation that contracted to provide patent application preparation and prosecution services to the public. This action is taken pursuant to the provisions of 35 U.S.C. § 32 and 37 C.F.R. §§ 11.26 and 11.59.

- d. The OED Director shall give notice to the Wisconsin State Bar that Respondent has been reprimanded and placed on probation;
- e. Respondent shall: 1) within twelve months from the date of this Final Order, enroll, complete, and receive Continuing Legal Education credit under the Rules of the Wisconsin State Bar for at least one course where the subject matter includes ethics and professional responsibility in the context of client communications; and 2) within thirteen months from the date of the Final Order, the OED Director must have received from Respondent corroborating proof of successful completion of such a course, including: a) documentary evidence of course attendance, b) a description of the content of the course for which credit was received, and c) copy of all written materials provided to course participants or other corroborating proof acceptable by the OED Director;
- f. Respondent shall: 1) within three months from the date of the Final Order, review all pending patent applications that he has filed with the Office to determine if they have been drafted in accordance with sections 608.01(m) and (n) of the MPEP and, if not so drafted, file appropriate papers with the Office in each patent application to correct any such drafting errors; 2) within four months from

the date of this Final Order, Respondent shall have filed with the OED Director an affidavit identifying all pending patent applications reviewed, identifying the applications amended, and stating the corrective action taken in each application; and 3) otherwise require Respondent bear all the costs and expenses of the provisions of this subparagraph;


- g. Respondent shall: 1) within thirty days from the date of the Final Order, deliver to G. the monetary compensation reflected in paragraph 41(e) above; and 2) within forty-five days from the date of the Final Order, the OED Director must receive from Respondent an affidavit demonstrating that Respondent timely complied with the provisions of this subparagraph;
- h. Respondent shall serve a twenty-four (24) month probationary period beginning with the date of the entry of this Final Order;
- i. In the event that the OED Director is of the opinion that during the twenty-four month probationary period Respondent failed to comply with any of the terms of this Final Order, the OED Director shall issue to Respondent an Order to Show Cause why Respondent should not be suspended for six months, send the Order to Show Cause to Respondent at the last address of record Respondent furnished to the OED Director pursuant to § 11.11(a), and grant Respondent fifteen (15) days to respond to the Order to Show Cause;
- j. In the event that after the 15-day period for response and consideration of the response, if any, received from Respondent, the OED Director continues to be of the opinion that, during the twenty-four month probationary period Respondent failed to comply with any of the terms of this Final Order, the OED Director shall deliver to the USPTO Director or his designate for imposition of a six-month suspension: the Order to Show Cause, Respondent's response to the Order to Show Cause, and evidence causing the OED Director to be of the opinion that during the twenty-four month probationary period that Respondent failed to comply with any of the terms of this Final Order;
- k. In the event that the USPTO Director suspends Respondent pursuant to this Final Order and Respondent seeks a review of the USPTO Director's decision to suspend Respondent, any such review shall not operate to postpone or otherwise hold in abeyance the immediate suspension of Respondent;
- l. If Respondent is suspended pursuant to the terms of this Final Order, Respondent shall comply with 37 C.F.R. § 11.58;
- m. If Respondent is suspended pursuant to the terms of this Final Order, the OED Director shall comply with 37 CFR § 11.59;
- n. Respondent, after completing the entire suspension arising pursuant to the terms of this Final Order, may apply for reinstatement to practice before the Office upon



filing a petition for reinstatement that complies fully with 37 C.F.R. § 11.60;

- o. Nothing in the proposed Settlement Agreement or this Final Order shall limit the number of times during his probation that Respondent may be suspended pursuant to this Final Order, above;
- p. Nothing in the proposed Settlement Agreement or this Final Order shall prevent the Office from seeking discipline against Respondent for the same misconduct that causes a suspension pursuant to paragraphs 43(i), and (j), above;
- q. The record of this disciplinary proceeding, including this Final Order, shall be considered 1) when addressing any further complaint or evidence of the same or similar misconduct brought to the attention of the Office, and/or 2) in any future disciplinary proceeding a) as an aggravating factor to be taken into consideration in determining any discipline to be imposed and/or b) to rebut any statement or representation by or on Respondent's behalf; and
- r. The OED Director and Respondent shall bear their own costs incurred to date and in carrying out the terms of this agreement

10/24/08  
Date

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

on behalf of

Jon W. Dudas  
Under Secretary of Commerce for Intellectual  
Property and Director of the United States  
Patent and Trademark Office

cc:

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