



On May 30, 2007, after numerous requests for extensions and delays in submissions by the Petitioner, the OED Director sent the Petitioner a Show Cause Requirement which provided the Petitioner the opportunity to create a record as to why his application should not be denied on the basis that he had not met his burden of establishing to the satisfaction of the OED Director that he possess good moral character and reputation as required to represent applicants before the USPTO (Agency or Office). 37 C.F.R. § 11.7(j). On August 31, 2007, the OED Director received Petitioner's response to the May 30, 2007, Show Cause Requirement. On October 16, 2007, the OED Director issued and served a final "Decision and Memorandum Opinion" (decision of October 16, 2007) denying Petitioner's application for registration to practice in patent cases before the USPTO.

On December 17 and 18, 2007, Petitioner sent three facsimiles with each containing a copy of an appeal under 37 C.F.R. § 11.2(d) of the decision of October 16, 2007. The first and second facsimiles were sent on December 17, 2007, at 11:53 p.m. Pacific Standard Time (PST) and 11:56 p.m. PST, respectively. The third facsimile was sent 12:01 a.m. PST on December 18, 2007. On December 18, 2007, Petitioner filed the appeal (appeal of December 18, 2007) under 37 C.F.R. § 11.2(d), including his original signature and payment of the required fee under 37 C.F.R. 1.21(a)(5)(ii), via the "Express Mail Post Office to Addressee" service of the United States Postal Service.

On February 14, 2008, Petitioner submitted a "Petition to Director of the USPTO for Suspension of Rule" (petition of February 14, 2008), pursuant to 37 C.F.R. § 11.3, requesting suspension of the following rules: 37 C.F.R. § 1.6(a)(3), providing that facsimile transmissions are accorded the date of receipt on which the complete

transmission is received; 37 C.F.R. § 1.6(d)(1), providing that facsimile submissions of matters requiring an original signature will not be accorded a date of receipt; and provisions of 37 C.F.R. § 11.2(d), requiring that the appropriate fee accompany the appeal and that an appeal of the decision of the OED Director must be filed within sixty days from the date of mailing of that decision.

On April 1, 2008, Petitioner's appeal of December 18, 2007, was dismissed as untimely, and the petition of February 14, 2008, was denied as unwarranted in a "Memorandum and Order" (order of April 1, 2008) issued on behalf of the Director of the USPTO.

On May 1, 2008, Petitioner filed a timely request for reconsideration of the order of April 1, 2008. Subsequently, on July 17, 2008, Petitioner submitted a letter (letter of July 17, 2008) notifying the USPTO that the State Bar of California had determined that he had the good moral character required for certification to practice law in California. In a "Memorandum and Decision Upon Reconsideration" dated August 6, 2008, (decision on reconsideration of August 6, 2008) USPTO Director's designee denied the request for reconsideration in its entirety.

On November 10, 2008, Petitioner filed the instant Petition for Suspension of Rules and Remand of Application (instant petition). Petitioner is seeking a suspension of 37 C.F.R. § 11.2(d) and "any other necessary rules" in order to have his case remanded to the OED Director for reconsideration.

## II. LEGAL STANDARD

The Director of the USPTO requires agents, attorneys, or other persons recognized as representatives of applicants or other persons to show that they are of good moral character and reputation prior to registration. 35 U.S.C. § 2(b)(2)(D), 37 C.F.R. § 11.7(a)(2)(i).

The OED Director receives and acts on applications for registration, including investigations into moral character and reputation. 37 C.F.R. § 11.2(b)(2)-(b)(3). An individual dissatisfied with the decision of the OED Director may petition the USPTO Director for review. 37 C.F.R. § 11.2(d). The petition must be filed within sixty days of the mailing date of the decision of the OED Director and must be accompanied by the appropriate fee. 37 C.F.R. §§ 11.2(d) and 1.21(a)(5)(ii). Petitions not filed within sixty days will be dismissed as untimely. 37 C.F.R. § 11.2(d). Any request for reconsideration of the USPTO Director's decision must be filed within thirty days after the mailing date of the decision. 37 C.F.R. § 11.2(d). The USPTO Director's decision on reconsideration is the final agency action. 37 C.F.R. § 11.2(d).

A petitioner may seek suspension of the rules “[i]n an extraordinary situation.” 37 C.F.R. § 11.3.

## III. ANALYSIS

Petitioner seeks waiver of 37 C.F.R. § 11.2(d) and “other necessary rules” pursuant to 37 C.F.R. § 11.3 because he asserts that extraordinary circumstances exist and justice requires that his application necessitates further review. Petitioner further requests that the Director of the USPTO remand the application to the OED Director for reconsideration. Specifically, Petitioner argues that the following allegations amount to

an “extraordinary situation” in accordance with 37 C.F.R. § 11.3: 1) the Petitioner has been found to possess good moral character by the State Bar of California; 2) Petitioner has not been given an opportunity to complete the record; 3) the October 16, 2007 decision contains substantive errors; and 4) Petitioner is without reasonable alternative recourse. These allegations, taken individually or cumulatively, do not amount to an extraordinary situation and thus the instant Petition is DENIED in its entirety.

Before reaching the merits of Petitioner's arguments, the instant petition is barred by 37 C.F.R. § 11.2(d). In relevant part, rule 11.2(d) states:

*If any request for reconsideration is filed, the decision on reconsideration shall be the final agency action.*

Petitioner filed a “Motion for Reconsideration” on May 1, 2008. In response, the Agency issued its decision on reconsideration of August 8, 2008. Therefore, in accordance with the rules, the Agency issued its final agency action in the above matter on August 8, 2008.

Moreover, Petitioner's arguments in the instant petition with regard to his lack of an opportunity to complete the record are essentially the same as those made in the petition of February 14, 2008. The order of April 1, 2008, and decision on reconsideration of August 6, 2008, addressed the Petitioner's assertions that he was not given an opportunity to complete the record. The USPTO Director found that the Petitioner did not make a timely appeal and his request for review under 37 C.F.R. § 11.2(d) was denied.

Petitioner's evidence that the State Bar of California has determined that he possesses good moral character was also not considered in the decision on reconsideration of August 6, 2008, because it is new evidence. Inasmuch as Petitioner's

arguments regarding his request for review and consideration of the State Bar of California determination on moral character have been considered by the USPTO Director, these circumstances do not amount to an extraordinary situation and thus waiver of the rules under 37 C.F.R. § 11.3 is unwarranted.

**A. Admission to the State Bar of California does not Constitute an Extraordinary Situation.**

In the letter of July 17, 2008, Petitioner notified the Agency that the State Bar of California determined that he possesses the good moral character required for certification to practice law in California. Subsequently, Petitioner also informed the Agency that he is now a licensed attorney in the State of California. This information submitted to the Agency after the time period allotted for Petitioner to request review had expired was properly excluded from consideration and does not rise to the level of an extraordinary situation under 37 C.F.R. § 11.3.

The Director of the USPTO will not consider new evidence in review of the OED Director's decision or upon reconsideration. 37 C.F.R. § 11.2(d). Inasmuch as the information pertaining to Petitioner's bar status in the State of California was not revealed to the Agency until July 17, 2008, over eight (8) months after the OED Director's final decision of October 16, 2007, and approximately three (3) months after the USPTO Director's order of April 1, 2008, is evidence that the information is "new" and therefore will not be considered. 37 C.F.R. § 11.2(d).

Petitioner contends that the State Bar of California's determination should be afforded great weight because the findings of said Bar were a result of consideration of the evidence that formed the basis of the contrary decision of the OED Director.

Petitioner deems this an extraordinary situation which justifies waiver of the rules. As stated above, the information regarding the State Bar of California's moral character determination is not considered because it was raised for the first time on reconsideration. 37 C.F.R. § 11.2(d). Even if this information were considered, the findings of the State Bar of California do not rise to the level of an extraordinary situation. The Agency is authorized by federal law to promulgate rules and regulations governing the recognition and conduct of attorneys that practice before it. 35 U.S.C. § 2(b)(2)(D). The OED Director's decision was undertaken in a manner which thoroughly reviewed the documentation submitted by the Petitioner and the circumstances surrounding the entire admission application process. The OED Director found that the Petitioner failed to demonstrate that he possesses the good moral character necessary to be admitted to practice before the USPTO.

Each bar generally has its own character and fitness requirements for admission thereto. Determinations as to whether to admit a person to a particular bar are fact specific and are usually decided on a case by case basis. It does not amount to an extraordinary situation for one bar to find that an individual possesses good moral character while another did not. *Kentucky Bar Ass'n v. Singer*, 533 S.W.2d 534, 536 (Ky. 1976) (judicial disbarment of attorney in one jurisdiction does not affect right to practice in any other). In particular, it is not anomalous for an agency that has received inconsistent statements from an applicant for admission to accord those statements different weight than an organization that was not asked by that person to rely on such statements. Therefore, notwithstanding the exclusion of the State Bar of California for

reconsideration purposes, the State Bar's determination of fitness does not amount to an extraordinary situation.

**B. Petitioner Had Ample Opportunity to Complete the Record**

Petitioner alleges that he was not afforded the right to complete the record, thus creating an extraordinary situation which warrants the waiver of certain applicable rules. Specifically, the Petitioner maintains that the OED Director alleged for the first time, in the final decision of October 16, 2007, that Petitioner made inconsistent statements. In a letter dated January 11, 2006, Petitioner stated, "I have never possessed a license for two states simultaneously." Later, Petitioner submitted into the record his Application for Determination of Moral Character for the State Bar of California (California Moral Character Application) as an attachment to a letter dated April 5, 2007. On the California Moral Character Application, Petitioner stated that he possessed a California State driver's license and a license for an unidentified state. The Petitioner had ample opportunity to address the inconsistency when he first submitted his California Moral Character Application up to the time that his Petition to the USPTO Director was due on December 17, 2007. As it is well documented, the Petitioner's appeal of December 18, 2007 was late and thus not considered. The Petitioner was afforded the right to complete the record, but through his own inaction, did not timely do so. Therefore, the alleged lack of opportunity to complete the record does not constitute an extraordinary situation and thus waiver of the rules is unwarranted.

**C. Errors in the October 16, 2007, Decision and Memorandum Opinion are Diminimiss**

The Petition alleges errors in the final decision of October 16, 2007, as an extraordinary situation that requires waiver of the rules. This allegation stems from the use of the term “convictions,” plural, in describing Petitioner’s alcohol related offenses. Again, Petitioner was given the opportunity to address the merits of this allegation in his appeal to the USPTO Director. Due to his untimely appeal, the merits of this argument will not be addressed. Even if the Director were to consider this allegation, it would not grant the relief requested. The OED Director’s decision was based on the record as a whole and does not rest solely on the errors alleged by the Petition. Based on the entire record, the OED Director found that Petitioner’s lack of candor, inconsistent statements, repeated multiple charges and offenses and violation of probation were the basis for his findings.

**D. Petitioner Has Reasonable Recourse**

Petitioner has the opportunity to reapply if he so chooses. Specifically, an individual that is denied registration “may reapply for registration two years after the date of the decision, unless a shorter period is otherwise ordered by the USPTO Director.” 37 C.F.R. § 11.7(k). A reapplication for registration must be accompanied by the appropriate fees at 37 C.F.R. §§ 1.21(a)(1)(ii) and 1.21 (a)(10).

**IV. CONCLUSION**

Petitioner has not shown that the allegations contained in his instant petition constitute an “extraordinary situation.” Therefore, the instant Petition is DENIED.

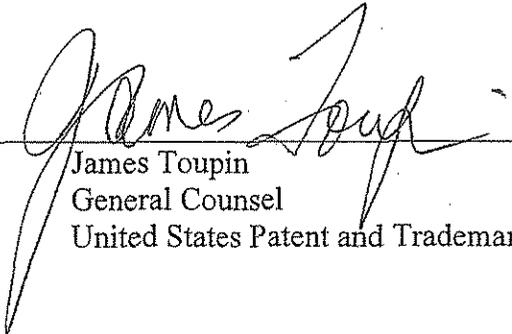
ORDER

Upon petition to the USPTO Director for suspension of certain rules under 37 C.F.R. § 11.3, it is ORDERED that the Petitioner's Request is DENIED.

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

FEB 9 2009

Date



James Toupin  
General Counsel  
United States Patent and Trademark Office

cc: