

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

In the Matter of	)	
	)	
Jimmy Mark Gilbreth,	)	
	)	Proceeding No. D09-18
Respondent	)	
_____	)	

**Final Order**

Office of Enrollment and Discipline Director Harry I. Moatz (“OED Director”) and Jimmy Mark Gilbreth (“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 (“USPTO Director”) or his designate for approval.

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 stipulated facts set forth below.

Pursuant to such Proposed Settlement Agreement, this Final Order sets forth the parties’ stipulated facts, legal conclusions, and agreed upon discipline.

**Jurisdiction**

1. At all times relevant hereto, Respondent of Bellaire, Texas, has been registered to practice before the USPTO and is subject to the Disciplinary Rules of the USPTO Code of Professional Responsibility set forth at 37 C.F.R. § 10.20 et seq.
2. The USPTO Director has jurisdiction over this matter pursuant to 35 U.S.C. §§ 2(b)(2)(D) and 32 and 37 C.F.R. §§ 11.20 and 11.26.

**Stipulated Facts**

3. At all times relevant hereto, Respondent of Bellaire, Texas, has been registered to practice before the USPTO and is subject to the Disciplinary Rules of the USPTO Code of Professional Responsibility set forth at 37 C.F.R. § 10.20 et seq. Respondent’s registration number is 33,388.
4. Respondent is also an attorney licensed to practice in the State of Texas (State Bar Card Number 07904793) and the State of Oklahoma (State Bar Number 1303).

A. The '423 and '427 Applications

5. In 2005, while prosecuting U.S. Application XX/XXX,XXX (“the ‘423 application”) and U.S. Application XX/XXX,XXX (“the ‘427 application”) before the Office, Respondent did not notify his client about his receipt of a Notice of Allowance and Fee(s) Due issued in each application.

6. The ‘423 and the ‘427 applications became abandoned for failure to pay the respective issue fees, and Respondent received the Notice of Abandonment issued by the Office in each application.

7. Respondent did not notify the client of the abandonment of the applications, nor did he take action to revive the applications.

8. The client subsequently learned of the abandonments and hired another practitioner to file petitions to revive the applications. The client paid the petition fees.

9. Respondent explained that, in 2005, he replaced computers in his office resulting in an unintended loss of case docketing data. When he received the Notice of Allowance and Fee(s) Due issued in the applications, he set them aside in a folder and used a “sticky note” to remind him to notify the client and to pay the issue fees. Respondent subsequently lost track of the folder.

10. Respondent further explained that when he received the Notice of Abandonment issued in the applications, he intended to revive the applications but again lost track of the notices and failed to do so.

B. The '597 Application

11. In 2006, while prosecuting U.S. Application XX/XXX,XXX (“the ‘597 application”), Respondent received an Office Action but did not notify his client about it.

12. Respondent did not respond to the Office Action issued in the ‘597 application.

13. The client subsequently learned of the Office Action and hired new counsel to prepare a response and an extension of time to reply thereto. The client paid the extension of time fee.

14. Respondent explained that the events concerning the ‘597 application occurred after he began using various means to track his files and that he intended to file a response but lost track of the file.

C. Additional Information

15. According to Respondent’s licensed psychologist, Respondent was suffering from severe clinical depression at the time of the aforementioned events. The psychologist

presented a medical report to the Office of Enrollment and Discipline stating that Respondent's untreated severe clinical depression contributed to Respondent's overlooking certain responsibilities and deadlines in his patent law practice.

16. Respondent is currently receiving medical assistance and treatment for his depression.

17. Respondent has purchased, and is implementing, a new computerized docketing system for his patent cases.

18. Respondent has made restitution to the client for the increased fees and costs incurred with reviving the three abandoned applications.

### **Legal Conclusion**

19. Based on the stipulated facts, Respondent acknowledges that his conduct violated:

- a. 37 C.F.R. § 10.23(b)(6), via § 10.23(c)(8), by failing to inform a client of correspondence received from the Office; and
- b. 37 C.F.R. § 10.77(c) by neglecting legal matters entrusted to him.

### **Sanction**

20. Respondent agreed, and it is ORDERED that:

- a. Respondent be suspended from practicing patent, trademark and other non-patent law before the Office for twelve (12) months and that all twelve (12) months of the suspension be, and hereby are, immediately stayed;
- b. Respondent serve a 12-month probationary period commencing on the date on which this Final Order is signed;
- c. Respondent: (1) within six months from the date of the Final Order, to enroll, complete, and receive Continuing Legal Education credit under the Rules of the Texas State Bar for at least one course where the primary subject matter is case management (e.g., calendaring and communicating with clients) for small firms and/or solo practitioners and (2) within seven months from the date of the Final Order, provide the OED Director corroborating proof of successful completion of such a course, including: a) documentary evidence of Respondent's attendance and completion of a case management course, 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;

- d. Respondent, during his probationary period, shall submit a report to the OED Director at three months, six months, 9 months, and 12 months after the date the Final Order is signed; and said report shall (1) identify by application number each U.S. utility patent application entrusted to Respondent and/or Gilbreth & Associates, P.C., to prosecute in which the Office issued during Respondent's probationary period a Notice of Abandonment predicated on the failure to file a timely and/or proper response to any Office communication, including, but not limited to a non-final Office Action, a final Office Action, an Office Advisory, and a Notice of Allowance; (2) state whether, how, and when Respondent reported the Office communication to the client prior to the application becoming abandoned; (3) provide documentary evidence that Respondent reported the Office communication to the client prior to the application becoming abandoned (e.g., copies of the correspondence to the client about the Office communication); (4) state whether, how, and when Respondent reported the Notice of Abandonment to the client; (5) state whether, how and when Respondent counseled the client about the abandonment of the application, including whether Respondent counseled the client in adequate time to take appropriate action to avoid abandonment; (6) provide documentary evidence that Respondent reported the Notice of Abandonment to the client and counseled the client about it (e.g., copies of the correspondence to the client about the Notice of Abandonment); and (7) for each application where Respondent did not counsel the client about an Office communication in adequate time to take appropriate action to avoid abandonment, identify each application by application number and each client by full name and address;
- e. the OED Director publish this Final Order;
- f. the OED Director publish the following Notice in the *Official Gazette*:

Notice of Suspension

Jimmy Mark Gilbreth of Bellaire, Texas (Registration Number 33,388) has been suspended for twelve months, with the entirety of the suspension immediately stayed, and placed on probation by the United States Patent and Trademark Office ("USPTO") for violating 37 C.F.R. § 10.23(b)(6), via § 10.23(c)(8), by failing to inform a client of correspondence received from the Office and for violating 37 C.F.R. § 10.77(c) for neglecting legal matters entrusted to him by a client. In two U.S. patent applications, Mr. Gilbreth did not notify his client about his receipt of Notices of Allowance and Fee(s) Due, allowed the applications to become abandoned for failure to timely pay the issue fee without the client's knowledge or consent, did not notify the client of the abandonment of the applications, and did not take action to revive the applications. In another U.S. application, Mr. Gilbreth did not notify his

client about his receipt of an Office Action and did not respond to it. This action is the result of an agreed upon disposition between Mr. Gilbreth and the USPTO pursuant to the provisions of 35 U.S.C. §§ 2(b)(2)(D) and 32, and 37 C.F.R. §§ 11.20, 11.26 and 11.59. Disciplinary decisions are available for public review at the Office of Enrollment and Discipline's Reading Room located at:  
<http://des.uspto.gov/Foia/OEDReadingRoom.jsp>.

- g. in accordance with 37 C.F.R. § 11.59, the OED Director give notice of the public discipline and the reasons for the discipline to disciplinary enforcement agencies in the State where the practitioner is admitted to practice, to courts where the practitioner is known to be admitted, and the public; and
- h. (1) in the event that the OED Director is of the opinion that Respondent, during the probationary period, (a) failed to comply with any provision of this Final Order, (b) allowed a utility patent application entrusted to Respondent to prosecute to go abandoned for failure to respond to an Office communication without the client's prior knowledge of the Office communication, or (c) violated any of the current or future Disciplinary Rules of the USPTO Code of Professional Responsibility, the OED Director to issue to Respondent an Order to Show Cause why Respondent should not be suspended for up to twelve (12) months, send the Order to Show Cause to Respondent at the last address of record Respondent furnished to the OED Director pursuant to 37 C.F.R. § 11.11(a), and grant Respondent fifteen (15) days to respond to the Order to Show Cause;

and

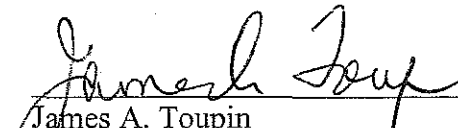
(2) in the event after the 15-day period for response and consideration of the response, if any, received from Respondent, the OED Director continues to be of the opinion that Respondent, during the probationary period, (a) failed to comply with any provision of this Final Order, (b) allowed a utility patent application entrusted to Respondent to prosecute to go abandoned for failure to respond to an Office communication without the client's prior knowledge of the Office communication, or (c) violated any of the current or future Disciplinary Rules of the USPTO Code of Professional Responsibility, the OED Director shall (a) deliver to the USPTO Director or his designate for imposition of an immediate suspension: (i) the Order to Show Cause, (ii) Respondent's response to the Order to Show Cause, and (iii) evidence causing the OED Director to be of the opinion that Respondent failed to comply with any provision of this Final Order, allowed a utility patent application entrusted to Respondent to prosecute to go abandoned for failure to respond to an Office communication without the client's prior knowledge of the Office communication, or violated any of the current or future Disciplinary Rules of the USPTO Code of Professional Responsibility and (b) request that the

USPTO Director immediately suspend Respondent for up to twelve (12) months;

- i. 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;
- j. if Respondent is suspended during any portion of his 12-month probationary period pursuant to the terms of this Final Order, Respondent shall comply with 37 C.F.R. § 11.58;
- k. if Respondent is suspended during any portion of the 12-month probationary period pursuant to the terms of this Final Order, the OED Director shall comply with 37 CFR § 11.59;
- l. nothing in the Proposed Settlement Agreement or the Final Order shall limit the number of times during his probation that Respondent may be suspended pursuant to the Final Order;
- m. nothing in the Proposed Settlement Agreement or the Final Order shall prevent the Office from seeking discipline against Respondent pursuant to 37 C.F.R. §§ 11.19 through 11.57 for any misconduct engaged in by Respondent prior to, during, or after his probationary period;
- n. the record of this disciplinary proceeding, including the 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
- o. the OED Director and Respondent shall bear their own costs incurred to date and in carrying out the terms of this agreement.

JUL 14 2009

Date

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

on behalf of

John J. Doll  
Acting Under Secretary of Commerce for  
Intellectual Property and Acting Director of the  
United States Patent and Trademark Office

cc:

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Director Office of Enrollment and Discipline  
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