

**UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE ADMINISTRATIVE LAW JUDGE**

In the Matter of:

WILSON DANIEL SWAYZE, JR.,  
  
Respondent.

Proceeding No. D2019-44

August 24, 2023

Appearances:

Elizabeth A. Francis, Esq.  
Robin J. Crabb, Esq.  
*Associate Solicitors, United States Patent and Trademark Office*

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*For Respondent*

BEFORE: Alexander **FERNÁNDEZ-PONS**, United States Administrative Law Judge

**INITIAL DECISION AND ORDER**

This matter arises from a disciplinary complaint filed by the Director of the Office of Enrollment and Discipline (“OED Director”) for the United States Patent and Trademark Office (“USPTO” or “the Office”) against patent attorney Wilson Daniel Swayze, Jr. (“Respondent”) pursuant to 35 U.S.C. § 32 as implemented by 37 C.F.R. part 11.<sup>1</sup>

The OED Director alleges that, while representing a client in a patent matter before the Office, Respondent violated seven provisions of the USPTO Rules of Professional Conduct (37 C.F.R. §§ 11.101, *et seq.*) pertaining to competence, diligence, client communications, and honesty. The OED Director asks the Court to sanction Respondent for the alleged violations by suspending him from practice before the Office for six months, imposing two years’ probation, and ordering restitution to Respondent’s former client in an unspecified amount. Respondent counters that his conduct did not rise to the level of violating any of USPTO’s rules.

**PROCEDURAL HISTORY**

On July 2, 2019, the OED Director filed a *Complaint and Notice of Proceedings under 35 U.S.C. § 32* (“*Complaint*”) against Respondent alleging violations of the USPTO Rules of Professional Conduct. On July 3, 2019, this Court issued a *Notice of Hearing and Order* that

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<sup>1</sup> Pursuant to an Interagency Agreement effective March 27, 2013, Administrative Law Judges working within the U.S. Department of Housing and Urban Development have been appointed by the U.S. Commerce Secretary and are authorized to hear cases brought by USPTO.

ordered Respondent to file an Answer to the *Complaint* on or before August 1, 2019, and scheduled an oral hearing to commence on October 15, 2019. Respondent timely filed his *Answer* on August 1, 2019. After the OED Director filed an unopposed motion for a continuance, the Court issued a *Second Notice of Hearing and Order* setting this matter for hearing beginning January 28, 2020, and establishing various prehearing deadlines.

A hearing was held in Washington, D.C. on January 28 and 29, 2020, at which time the Court received documentary evidence and heard testimony. The parties timely submitted post-hearing briefs and response briefs in May 2020.<sup>2</sup>

## APPLICABLE LAW

**USPTO Disciplinary Proceedings.** USPTO has the “exclusive authority to establish qualifications for admitting persons to practice before it, and to suspend or exclude them from practicing before it.” *Kroll v. Finnerty*, 242 F.3d 1359, 1364 (Fed. Cir. 2001); see also *Sperry v. Fla. ex rel. Fla. Bar*, 373 U.S. 379 (1963). This authority flows from 35 U.S.C. § 2(b)(2)(D), which authorizes USPTO to establish regulations governing the conduct of patent attorneys and agents who practice before it, and 35 U.S.C. § 32, which authorizes USPTO to discipline malfeasant practitioners. The regulations governing the conduct of USPTO practitioners are known as the Rules of Professional Conduct and are codified at 37 C.F.R. §§ 11.101 to 11.901. Before disciplining a practitioner who is accused of violating the Rules of Professional Conduct, USPTO must provide notice and an opportunity for a hearing. 35 U.S.C. § 32. Disciplinary hearings are conducted in accordance with the procedural rules at 37 C.F.R. part 11 and with section 7 of the Administrative Procedure Act, 5 U.S.C. § 556, by an impartial hearing officer appointed by USPTO. See 37 C.F.R. §§ 11.39, 11.44.

**Standard and Burden of Proof.** The OED Director has the burden of proving any alleged violations by clear and convincing evidence, and the respondent bears the burden of proving any affirmative defenses by clear and convincing evidence. 37 C.F.R. § 11.49. “Clear and convincing” evidence is an intermediate standard of proof, falling somewhere between the “beyond a reasonable doubt” standard governing criminal cases and the “preponderance of the evidence” standard governing most civil cases, which requires evidence of such weight that it “produces in the mind of the trier of fact a firm belief or conviction, without hesitancy, as to the truth of the allegations sought to be established” or “proves the facts at issue to be ‘highly probable.’” *Jimenez v. DaimlerChrysler Corp.*, 269 F.3d 439, 450 (4th Cir. 2001); see also *Colorado v. New Mexico*, 467 U.S. 310, 316 (1984) (requiring evidence sufficient to produce “an abiding conviction” that the factual allegations are “highly probable”).

## FACTUAL BACKGROUND

The following findings of fact are based on the stipulations submitted by the parties on January 23, 2020, as well as the record evidence in this case, which includes Joint Exhibits 1-5,

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<sup>2</sup> The delay between briefing and the issuance of this Decision was caused by limited government resources, the time taken to consider the parties’ respective evidence and positions, and the COVID-19 pandemic, which necessitated closure and reopening of the Court’s physical office while this case was pending and disrupted some of the Court’s operations and workflow.

7-10, 12-23, 25-26, and 28-29; Government Exhibits 6 and 27; and the testimony of Respondent, his former client Charles H. Wells III, and OED investigative attorney Andrew Roberts.

### Respondent's Background and Prior USPTO Warnings

Respondent is an attorney with a master's degree in electrical engineering and work experience as an engineer, a patent examiner for USPTO, and patent counsel for Texas Instruments. He was admitted to practice law in the state of New York in 1989. He was registered as a patent attorney by USPTO in 1990, and has filed almost a thousand successful patent applications since then. The events at issue in this case took place between 2014 and 2018, at which time Respondent maintained a solo practice representing private clients in patent matters before USPTO.

Several years earlier, on August 12, 2010, the OED Director had issued a written warning letter to Respondent after investigating grievances filed by two different clients.<sup>3</sup> In the letter, the OED Director advised Respondent that he "should have been reviewing Private PAIR [USPTO's Patent Application Information Retrieval system] periodically to note any action upon the application for which [Respondent] assumed responsibility to prosecute."<sup>4</sup> The letter noted instances where clients stated they had not received communications Respondent claimed to have sent, and warned Respondent against unilaterally taking action or failing to act on behalf of a client without "clear communication with the client and ... complete advice disclosing the courses of action available to that client." Although the letter concluded that Respondent's actions may not rise to the level of sanctionable conduct, it expressly warned him against future conduct implicating the Office's ethics rules, including those requiring honesty and diligence.

After conducting an investigation of another matter concerning a different client, the OED Director issued a second warning letter to Respondent on January 9, 2012. The OED Director found that Respondent "appear[ed] to have communicated inadequately" with the client and again cautioned him against such failures. Under the heading "Failure to Communicate," the warning letter stated: "A practitioner shall not neglect a legal matter entrusted to him. See 37 C.F.R. § 10.77(c) [predecessor to current 37 C.F.R. § 11.103]. This Disciplinary Rule requires a practitioner to communicate adequately with the client, including advising the client appropriately and responding to the client's questions about the subject of the representation."

### The '394 Application and Respondent's Engagement to Represent Mr. Wells

On December 31, 2014, client Charles H. Wells III retained Respondent to prepare and file a patent application for Mr. Wells' Portable Beverage Caddy Apparatus invention. On January 2, 2015, Mr. Wells paid Respondent \$3,460.00, consisting of \$2,900.00 to prepare the application and \$560.00 in government filing fees. Mr. Wells did not engage Respondent to

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<sup>3</sup> Under 37 C.F.R. § 11.21, the OED Director may conclude a disciplinary investigation by issuing a warning, which must "identify the USPTO Rules of Professional Conduct relevant to the facts," but does not constitute discipline.

<sup>4</sup> The PAIR system allows users to access information from USPTO's internal patent database to track patents and patent applications. Public PAIR is accessible to the general public and provides information on published patent applications. Private PAIR allows authorized independent inventors and registered patent practitioners to access the content of Public PAIR, as well as documents, real-time status information, and transaction history for their own pending unpublished patent applications.

perform a search of the prior art, which would have cost an additional \$550.00. Although the engagement letter Respondent sent to Mr. Wells on December 31, 2014, cautioned that Respondent “does not make any representation or warranty of patentability,” Mr. Wells testified that Respondent seemed optimistic about the likelihood of receiving a patent.

In January 2015, Mr. Wells sent Respondent a package containing photographs, a drawing, and information about the invention and asked, via email, at what point he could claim patent pending status so he could start showing his invention to manufacturers. Respondent replied: “You are patent pending when the application is filed with the patent office.”

On February 15, 2015, Mr. Wells emailed: “Hi [Respondent] how are you today? Just wondering how everything’s going? Also what will you send me to show this prospective manufacturer that the patent has been filed and is in patent pending status? Thanks” (*sic* throughout).<sup>5</sup> Mr. Wells testified that it was important to him to be able to show that his idea was protected so he could obtain funding for his invention. On February 16, 2015, Respondent replied: “Hi Charles I have started your patent application, and it should be ready for you within one week. Please call me with your questions.”

On February 26, 2015, Mr. Wells emailed Respondent, “Hi [Respondent] - what will you send me to show manufacturers that I am patent pending-thanks.” The next day, Respondent replied, “Hi Charles Please approve this application.” On February 28, 2015, Mr. Wells replied, “Hi [Respondent] the application is fantastic! I approve the application, and I also approved the drawings. Look forward to the next step. Thanks.”

On March 4, 2015, Respondent emailed Mr. Wells a Certification of Micro Entity Status<sup>6</sup> to sign. The document listed the inventor as Ray Wells, not Charles Wells. Mr. Wells testified that he called Respondent about the error; thereafter, Respondent emailed, “Charles I am very sorry about the typo” and sent a corrected form, which Mr. Wells signed and returned on March 6, 2015. Although the error was quickly corrected, Respondent testified that Mr. Wells’ “whole attitude changed” after receiving this form with the wrong name.

On March 8, 2015, Respondent filed U.S. Patent Application No. 14/641,394 (“the ‘394 application”) for a “Portable Beverage Caddy Apparatus” naming Mr. Wells as the inventor and listing Respondent’s USPTO customer number in the Representative Information section. To illustrate the invention, the application included four photographs and the hand-made drawing Mr. Wells had earlier provided to Respondent, with numbers added by Respondent to mark the different components of the invention.<sup>7</sup>

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<sup>5</sup> Many of the emails between Respondent and his client contain typographical, spelling, and grammatical errors. To preserve the tone and gravamen of the communications, the Court has included them unaltered where possible.

<sup>6</sup> The America Invents Act created a micro entity status for patent applications meeting certain requirements, which allows the applicant to pay reduced fees. See generally Pub. L. No. 112-29, 125 Stat. 283 (Sept. 16, 2011).

<sup>7</sup> Respondent’s engagement letter had stated: “The Patent Application will be filed with informal drawings that are to be provided by the Patent Attorney. When the PTO requires formal drawings, the Inventor will bear this cost.”

### The Filing Receipt for the '394 Application

On March 8, 2015, Respondent emailed Mr. Wells, "Hi Charles Enclosed is your filing receipt." On March 14, 2015, Mr. Wells emailed Respondent, "[Respondent] for crying out loud man!!! There's no filing date on my Elictronic Acknowledgement Receipt!! I asked you from the beginning about this Receipt. I'm aware of al of the Elictronic illegal activities. I gave you \$ 3 .400 dollars and I will hold you accountable while iam investigating this matter." The same day, he further emailed, "Please don't just think you can just rob me !!!!!" and "I should wake up because iam not going to be able to sleep until you get this straight. I will be calling you at sunrise!!!"

On March 15, 2015, Respondent emailed Mr. Wells a screen shot of a filing receipt copy-pasted from PAIR. The receipt did not list a filing date, but displayed the status of Mr. Wells' application as "Application Undergoing Preexam Processing" as of March 8, 2015.

On March 18, 2015, USPTO mailed Respondent a paper filing receipt showing a filing date of March 8, 2015, and a projected publication date of September 8, 2016. Mr. Wells alleges that Respondent did not forward the paper filing receipt to him.

### The 2016 Office Action and Untimely Response

On April 6, 2016, USPTO issued a non-final Office action ("the 2016 Office action") signed by patent examiner Matthew Ing rejecting the '394 application and setting a shortened statutory period of three months to submit a reply, i.e., by July 6, 2016. The Office action stated that, although an extension of time may be available, "[i]n no event ... may a reply be timely filed after SIX MONTHS from the mailing date of this communication," i.e., after October 6, 2016, and warned that failure to timely reply would cause the application to become abandoned.

The 2016 Office action rejected all ten claims of the '394 application. Among other reasons, the patent examiner found that the application failed to comply with 37 C.F.R. § 1.84(b), which provides that photographs are not ordinarily permitted in utility patent applications unless they are the "only practicable medium for illustrating the claimed invention." The examiner also listed rejections under 35 U.S.C. § 112, which sets forth criteria for the specification, and 35 U.S.C. § 103, which provides that a claimed invention is not patentable if its claims are obvious in light of the prior art.

On April 17, 2016, Respondent's office assistant emailed Mr. Wells a copy of the 2016 Office action. The email warned Mr. Wells that the application would go abandoned without a response and stated that Respondent's fixed fee for filing a response was \$850.00. The email stated that the response was due by July 4, 2016, instead of July 6, 2016. At hearing, Respondent indicated this discrepancy was intentional, testifying that he was trying to provide a "cushion" to ensure the response would be timely filed.

Mr. Wells testified that the April 17 email was confusing, that he did not understand what an Office action was, and that Respondent did not explain it, other than to say that the patent examiner had a problem with the photos submitted with the application. Respondent, by contrast,

testified that he discussed with his client the importance of distinguishing between the invention and the prior art cited by the patent examiner.

On May 9, 2016, Mr. Wells emailed Respondent, “Hi ... I called Mr. Matthew Ing at 9:am Ga time but no answer. Also called his Supervisor but no answer. Perhaps the time there there is behind the time here. I will call back around 12:noon. Thanks.” Later that day, Mr. Wells further emailed: “Hi I will be sending you the \$850 in a few weeks for the office action. I am depending on your stated knowledge of the USPTO. Please let me know if you need pieces of the trim or fabric. Also as I stated , the utility will be made from plastic, but wood can be an option with the structure. Thanks.” At some point between June 22 and July 11, 2016, after saving up money, Mr. Wells paid Respondent \$850.00 to draft and submit a response to the 2016 Office action. Meanwhile, on July 7, 2016, the shortened statutory period to submit a response to the 2016 Office action had expired.

On July 11, 2016, Respondent emailed Mr. Wells: “The examiner requires drawings instead of pictures. Should I get an estimate for the drawings? I will do my best to obtain a patent for you. I cannot guarantee results because the examiner is making the decisions.” Mr. Wells replied: “Are you asking me a question about the Drawing? Did not quite understand. I hope that everything is ok.” Mr. Wells testified that he did not understand that a certified draftsman could be hired to render formal drawings, and he does not recall Respondent replying to his inquiry.

On August 4, 2016, Mr. Wells emailed Respondent, “I was sitting here going over everything that you have said though out this process. If That useless piece of junk that they compared my Art to , got a Patent, then surly I should be issued a patent on my useful and elegant art. Inventor -Charles Harry Wells 111. Best regards.”

On August 7, 2016, Respondent filed an untimely response (“Response”) to the 2016 Office action. As set forth in the Office action and USPTO’s regulations, any response filed after July 7, 2016, needed to include a request for an extension of time and the associated government fee, but Respondent did not submit either. He did include some amendments to Claims 1-6 and 8-10 of the invention and a two-page Petition Under 37 CFR 1.84 (“Petition to Accept Photographs”) requesting “that the drawings including the photographs be approved and the examiner’s objection be reversed.” As grounds for this request, he characterized the photographs as “the only practical medium for illustrating the claimed invention” and wrote that “it would be extremely difficult if not impossible to include all the details in the photographs in a drawing.”

On August 9, 2016, Mr. Wells inadvertently emailed Respondent, “Hi David ... This is what I found. It’s great. Hope it don’t come down to this , but it just mite. Thanks for everything.” The email included a link to a Quora article titled, “Can patent attorneys steal your idea before they help you patent it?” Mr. Wells testified that “David” was a friend with legal expertise whom he had consulted about his patent application because he was afraid Respondent was trying to steal his invention, but despite his misgivings, he did not fire Respondent because he could not afford to hire another attorney. Mr. Wells never discussed the August 9 email with Respondent after accidentally sending it. Respondent testified that, although he became aware that Mr. Wells was unhappy with the representation, he did not withdraw because he “felt responsible for the ... problems with the drawings, to try to get that right for Mr. Wells.”

On August 11, 2016, Mr. Wells emailed: "I hope that its not deliberate. The poor Drawing and illustrations . The examiner , is telling me that I need a competent person to do the job. I know that you have the knowledge. I will be glad when this is done properly. I'am sick of worrying about the shady situation." Respondent replied: "The examiner is concerned about the photographs. I filed a petition to have the photographs entered." Mr. Wells responded: "What is his concern over the photographs? Can you please give me more insight on the situation[?]" Respondent replied: "The patent office prefers line drawings, and a petition is necessary for photographs."

#### Further Action on the '394 Application

On September 8, 2016, USPTO mailed to Respondent a Notice of Publication explaining that the '394 application would be published pursuant to 37 C.F.R. § 1.211 on that date, meaning the application could now be accessed on Public PAIR. Respondent neglected to send this notice to Mr. Wells until eight months later. Respondent asserts he did not realize the patent application had been published and states he "answered several questions [from his client] incorrectly on the assumption that the application was still private."

On October 17, 2016, USPTO issued a decision signed by patent examiner Daniel Troy dismissing the Petition to Accept Photographs that Respondent had filed with his untimely Response to the 2016 Office action, on the bases that the petition did not include an amendment to the specification and that "the colored drawings" were not the only practical medium to illustrate the invention. Mr. Wells indicated that Respondent forwarded him the October 17 decision without explaining it, which Respondent denies. On November 2, 2016, Mr. Wells emailed Respondent:

I spoke with Mr Troy and we want to set up a 3 way interview . I asked him was your way of doing business , (Unusual), and he said yes. I'am not a dummy , and it is obvious that you are trying to deliberately fail my application. I'am up to my eye balls with your dishonesty. I paid you a lot of hard earn money ... This is my life that you are trying to take from me . You will not succeed . I paid you for a service and I expect you to Finnish the job. You sent this email and did not bother to explain it to , or what the next step is in the process . I will be coming to visit you in person soon. Don't be upset with me because I will not let you take something that not yours. Please just Finnish the job so we will not have to ever speak to each other again.(Please ). I will be call Mr .Troy with your reply.

Later that day, Mr. Wells further emailed Respondent's office assistant: "I will give you time to reply before I call you on the phone . Hopefully that will avoid a heated phone conversation. I'am over trying to be professional." On November 21, 2016, Respondent emailed Mr. Wells: "Hello Charles Of course I will make this right. Please contact me directly." The record does not document Mr. Wells' response.

On December 5, 2016, USPTO mailed Respondent a notice titled "NOTICE REQUIRING EXTENSION OF TIME FEE / *No New Time Period is Provided.*" The notice

stated that the Response to the 2016 Office action was untimely and lacked the appropriate extension of time fee, and indicated that the time to file a response to the Office action had now expired. Respondent states he does not recall whether he forwarded this notice to Mr. Wells, who maintains he did not receive it.

On December 8, 2016, USPTO mailed Respondent a Notice of Abandonment (“2016 Notice of Abandonment”) stating that the ‘394 application had gone abandoned because the Response had been submitted late and without a request for extension of time or the associated fee. Respondent did not immediately forward this notice to Mr. Wells, and asserts he was unaware of the abandonment until after December 15, 2016. Meanwhile, Mr. Wells was not even aware that the Response had been filed late, and asserts he did not learn that the application had gone abandoned until much later when he was trying to obtain funding for his invention.

#### The Supplemental Response to the 2016 Office Action

Respondent testified he believed that a response to USPTO’s October 17, 2016 decision rejecting the Petition to Accept Photographs was due by December 17, 2016. On the morning of Thursday, December 15, 2016, Respondent emailed Mr. Wells: “Enclosed is a proposed response to the concerns of the examiner. Please approve them or let me have your changes. This is due on December 17. Please remember that I cannot guarantee results. The examiner ultimately makes the decision.”

Later that day, without waiting for Mr. Wells to respond to his email, Respondent filed a Supplemental Response to the 2016 Office action. Respondent testified that he filed without waiting for his client’s input because he feared he would not otherwise get it done on time and believed he could later correct and re-submit it if Mr. Wells offered any feedback. The Supplemental Response included a Renewed Petition asking USPTO to accept photographs to illustrate the invention, was supported by the same drawing and pictures previously submitted to USPTO, and stated that Claims 1-6 and 8-10 “remain in the application for consideration.”

On Friday, December 16, 2016—after Respondent had already filed the Supplemental Response—Mr. Wells emailed Respondent:

I don’t see where you enclosed anything. Can you please sent me what I need to see. Why did you wait one day of 17th to send me this ? I hope that you have given up on trying to steal my invention? I if that peace of junk that that that you dug up and compared to my invention, got a patent, you can never convince,me that my art can’t be patented. You wouldn’t be trying every trick in the book to steal it if it was not patentable. You may as well get ready to shoot me in the head, before I let you take my future away from me and my kids. I will call you in the morning so that you can explain what the heck is going on (NOW)!!!!

Mr. Wells also sent another email that day stating “Just so you know , I do know how to sue . And I will file to sue you 2 min after you fail my application. Count on it !!!!!!!!!!!!!!!!!!!!!!!!!!!!!!!”



Respondent replied to Mr. Wells on December 17, 2016, stating: “I am resending my email of the 15th. Since the 17th is a Saturday, it is not due until Monday the 19th.” Although Respondent had already filed the documents referenced as being due on Monday, he did not disclose this fact to Mr. Wells. Mr. Wells responded with an email stating:

I knew that you lied about sending the proposed response along with this email mail. You asked me to send you another email, and I did. Still no answer from you. It is clear to me that you have deliberately set things up for me to miss a dead line. You are determined to undermined the service that I paid you for, in Oder to take my art for your own personal gain. You are not answering my call, after you did just a few minutes ago. I will begin taking steps to see you in court. When you deleted your picture from linked in, after we were linked together, I knew at that point you were going to try to steal my idea. I have each and every email that we have shared. (Hard copies). You slipped up more that you probably remember.

Respondent subsequently faxed the draft documents to Mr. Wells, who testified that he “still [did] not know[] what to change or what I was looking at.” On December 18, 2016, Mr. Wells emailed Respondent: “I have read the PDF ... You asked me if I wanted to change anything. Well you never care to explain any of the process, so please send the examiners what you (KNOW) that they need, to complete the services that I paid you and your Law Office for. I guess if I must say yes or no it’s no.”

The next day, December 19, 2016, Mr. Wells further emailed Respondent: “It’s absolutely ridiculous, that it has been almost two years since you filed my Application. Especially on a very simple invention. You have spent more time undermine, the whole process, in order to later, do it correctly, for this (Sam Wells guy). I will be contacting Mr. Chambers, to discuss this situation, and all of the Examiners.as well as.”

#### Mr. Wells’ Status Requests and the 2017 Petition to Revive

On January 30, 2017, Mr. Wells emailed Respondent asking, “Can you please tell me where we are in the process.” The next day, Respondent replied, “Waiting for the patent office.” This was inaccurate, as USPTO had already deemed the application abandoned.

On February 16, 2017, for the first time, Respondent purportedly attempted to forward the 2016 Notice of Abandonment to Mr. Wells. He did so by sending the client a letter via the U.S. Postal Service, rather than emailing or faxing him. This was unusual, as the record indicates that Respondent never communicated with Mr. Wells via written letter in any other instance. Mr. Wells was not living at the address to which the letter was sent and never received it.

At some point in 2017, Mr. Wells began speaking to a mentor at the Small Business Administration (“SBA”) who advised him to request a formal drawing and told him anyone could check the status of their patent application through PAIR. On July 20, 2017, Mr. Wells emailed Respondent requesting a copy of the drawing, which Respondent sent the same day. On July 23, 2017, Mr. Wells further emailed Respondent: “Hi [Respondent] would you be so kind to

send me the link to check the status of the application? I must be clicking on the wrong site. Perhaps you know a more direct way for me to go in and check the status?"

The next morning (July 24, 2017), without first consulting with Mr. Wells, Respondent filed a Petition to Revive the '394 application stating that the "applicant submits the entire delay was unintentional." Respondent paid the \$850 filing fee for the Petition to Revive himself and did not tell his client he had filed it.

In response to Mr. Wells' email requesting help checking the status of his application, Respondent sent a message several minutes after he filed the Petition to Revive stating: "The patent office only allows one person to access." Respondent testified he did not realize the application had been published at that point, and therefore believed it could only be viewed by one person on Private PAIR. Later that same day, Mr. Wells sent Respondent emails stating: "I was told that you did not check the box for me to talk to the examiner. And it's not true that I cant check it . The examiner told me that I could. It appears that you are lying ! I have someone assisting now , and I shall begin suing you and your firm..." and "You are lying! It appears that you are probably trying to have my invention made in China. You will regret stealing my invitation."

Thereafter, still on July 24, 2017, Respondent sent Mr. Wells an email attaching power of attorney forms and stating, "Please fill this form out, sign it and file it so that you can see everything." If signed, the forms would have revoked Respondent's status as attorney of record while also giving Mr. Wells power of attorney over the patent application, which Respondent testified would have allowed Mr. Wells to view the application on Private PAIR. Mr. Wells responded: "I will be given instructions on checking my status by tomorrow. If it does not show , then we will know that you may have already sold it to someone. I will have those forms explained. You may just be trying to free your self with them." Ultimately, Mr. Wells did not sign the forms.

On July 25, 2017, Respondent emailed Mr. Wells: "This is between you and the patent office. If the patent office does not act quickly enough, I suggest giving them a call." Mr. Wells responded, "I don't know what you mean by this but just so you know , I have someone in your field helping me . They will be informing me on each step to take right on up to our court date . Which will happen a lot sooner that you think."

On July 27, 2017, Mr. Wells emailed:

Hi [Respondent], I am working with a an executive with the Small Business Administration. And what they're trying to do is fund the project. They have looked over every email and documents. They said that the \$835.00 formal drawing looked like a child did it. That's a lot of money your law firm charged me. I told them that you were extremely uninformative. Also what your motives are. But on behalf of the very nice Executives at the S.B.A. Would you please save us a whole lot of time and headache, by answering the following questions . 1. What is the status of the application ? 2. What name did you file it under? 3 . did you file a utility patent? 4.whats the next

step in the status. Would you please be so kind to provide this information to us. thanks.

On July 28, 2017, Respondent replied: "Hello Charles We are awaiting for a decision from the patent office. The invention was filed under your name and a non-provisional patent application was filed." Mr. Wells replied:

[Y]ou are not being specific. I am just going to file the complaint because you are not rendering the services that I payed your firm for. I paid you for a utility patent. I know what a provision patent cost. Also the Drawing was a ripoff. We will proceed with the complaints and start legal proceedings. If you take action to fix this and make it right before you get the subpoena, then we will drop the charges. And the complaints. But for now we are going to file the complaints with each and every one that we can think of. They are waiting to find my invention. We must take this action.

Respondent replied: "I did not charge you anything for the original drawings and the replacement drawings were provided free of charge. I did charge you for the response (my fee) to the office action. If you feel otherwise, please send me proof requesting money for the drawings. Enclosed is your filing receipt showing that a utility application was filed."

Mr. Wells responded with emails stating, "I have been advised that the amount of money that you charged me , was Definitely supposed to not only protect my invention here in this country, but abroad as well . The bank considers that extremely important for me to get the loan," and "I have a computer at home now, so I can look into things and file all of the complaints myself. It's the status website that's giving me a little problem. But I will establish that account this weekend. You know exactly what the bank needs to see. Why don't you just fax it to me . It would save everyone trouble."

Respondent replied, "This is what we agreed to, filing in PTO," and attached copies of his engagement letters with Mr. Wells. Later, on July 31, 2017, Respondent forwarded Mr. Wells a copy of his entire file, including all USPTO correspondence, by email.

On August 10, 2017, the USPTO issued an Electronic Acknowledgement Receipt for the Petition to Revive showing payment of the \$850.00 fee. Respondent did not forward this receipt to his client.

In late August or early September 2017, Respondent had a phone call with Mr. Wells and Mr. Wells' mentor from the SBA. Mr. Wells asserts that, during the phone call, Respondent did not mention that the '394 application was abandoned or that he had filed a Petition to Revive. By contrast, Respondent maintains that the phone call "focused mainly on the abandonment, its effect, and the pending Petition to Revive," noting that Mr. Wells had a complete copy of his file by this time and therefore would have been aware of the abandonment and petition to revive.

## The 2018 Final Office Action and the 2018 Notice of Abandonment

On November 8, 2017, USPTO granted the Petition to Revive the '394 application, resulting in revival of the claims and restoration of the original filing date. Respondent testified that his office assistant sent the November 8 action to Mr. Wells, although the record contains no documentation of this. Mr. Wells asserts that Respondent did not notify him of the action or explain what would happen next.

On January 19, 2018, USPTO issued a Final Office Action rejecting all pending claims in the '394 application. Like the 2016 Office Action, the 2018 Final Office Action again rejected the application's mode of illustrating the invention. The examiner also rejected the claims for obviousness in light of the prior art. The Final Office Action was mailed to Respondent and set a shortened statutory period to reply, by April 19, 2018.

On January 21, 2018, Respondent's office assistant emailed Mr. Wells a copy of the 2018 Final Office Action. The email stated that the deadline to reply was April 17, 2018. The email further stated that Respondent's fixed fee for a response to an Office action was \$850.00 and that there would be an additional government fee if the Office action were final.

On January 22, 2018, Mr. Wells sent Respondent emails stating, "You were supposed to file a international application as well. You lied to me the whole way . This is the last straw. I shall see you in court!" and "I know good and well you are not asking me for more money. If you are asking me for a dime, I will proceed with legal action right away!!!!!"

On January 27, 2018, Respondent emailed: "There is going to be a government fee of approx. \$1000. Do you want to continue?" Mr. Wells responded, "yes I want to continue for the record. your company is charging me twice for the same work. your company failed to render services paid for. we shall see you in court." On January 28, 2018, Respondent replied: "I am willing to do the work without my fee, but I cannot pay the government fee. If you do not respond, the application will go abandon." Mr. Wells replied with emails stating: "What do you mean respond? What do I need to Do ????" and "You have lied from the very beginning??? I have on choice but to protect my family & their futures! ! !" and "Do to all of the lies that were told from the very beginning, and the Certification of Micro Entity Status Form that was DELIBERATELY, email with someone else name on it. I will began to file [bar] complaints ... so that they will be on record, when we meet in COURT!"

On February 27, 2018, Respondent emailed Mr. Wells, "I am not sure what you want done [Mr. Wells]. I have agreed to respond without cost to you (except for the government fees)." And on February 28, 2018, Respondent further emailed Mr. Wells: "you never instructed me to file a international application and you never paid me to do so."

Because USPTO did not receive a response to the 2018 Final Office Action, the '394 application went abandoned on April 20, 2018. USPTO issued a Notice of Abandonment on September 18, 2018. Respondent's office forwarded it to Mr. Wells on October 10, 2018.

Meanwhile, on April 4, 2018, Mr. Wells emailed Respondent, “Your law firm has cost my company millions of dollars.” Mr. Wells testified that, although he “never really asked any investors for money” because his invention was not protected by a patent, he was told by unidentified marketing experts that the invention was worth either \$200 million or \$1 billion. As of the date he testified in this matter, Mr. Wells believed Respondent was still trying to steal his invention, perhaps in conspiracy with someone named Ray Wells, and may be manufacturing the invention in China.

On July 9, 2018, Mr. Wells filed with USPTO the grievance that initiated the instant proceeding. Mr. Wells testified that he also filed a complaint with the New York State Bar, and received a letter stating Respondent’s law license was suspended in New York. However, the record shows that Respondent is an attorney in good standing in the state of New York with no history of public discipline.

## DISCUSSION

The OED Director alleges that Respondent’s conduct during his representation of Mr. Wells violated seven provisions of the USPTO Rules of Professional Conduct: 37 C.F.R. §§ 11.101 (competence); 11.103 (diligence); 11.104(a)(3), (a)(4), and (b) (client communications); 11.804(c) (honesty); and 11.804(d) (conduct prejudicial to the administration of justice).<sup>8</sup>

Respondent admits he made three mistakes during his representation of Mr. Wells: he inserted the wrong name (“Ray Wells” instead of “Charles Wells”) on the micro-entity form; he did not immediately notify Mr. Wells of the 2016 Notice of Abandonment; and he failed to notice when Mr. Wells’ patent application was published. However, Respondent argues there is no clear and convincing evidence that his conduct violated any disciplinary rules.

At the outset, the record reflects that Mr. Wells may have been an especially difficult client. However, even the most unpleasant clients deserve representation that is professional and ethical. Indeed, perhaps such clients are those most in need of adequate representation. The record suggests that Mr. Wells was wholly unfamiliar with the patent application process and retained Respondent’s representation with the hope of navigating that process successfully. Mr. Wells’ own conduct, and even his apparently spurious accusations of theft, do not serve to release Respondent from his duties of professionalism. Instead, the Court finds that Respondent violated the USPTO Rules of Professional Conduct for the reasons discussed below.

### **I. Respondent violated his duties of competence and diligence.**

The USPTO Rules of Professional Conduct require a practitioner to “provide competent representation,” which “requires the legal, scientific, and technical knowledge, skill, thoroughness and preparation reasonably necessary for the representation.” 37 C.F.R. § 11.101. The Rules also require a practitioner to “act with reasonable diligence and promptness in representing a client.” *Id.* § 11.103. The OED Director alleges that Respondent’s conduct fell short of these standards on numerous occasions, amounting to a pattern of neglect.

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<sup>8</sup> The *Complaint* also charged a violation of 37 C.F.R. § 11.804(i), a catchall provision barring “other conduct that adversely reflects on ... fitness to practice,” but the OED Director is no longer pursuing that charge.

First, the OED Director asserts Respondent violated § 11.101 and § 11.103 by sending his client a Micro Entity Status Certification form that listed “Ray Wells” instead of “Charles Wells” in the inventor field. However, this was a mere typographical error, which does not amount to actionable misconduct.

The OED Director further alleges that Respondent violated his duties of diligence and competence by forwarding the electronic filing receipt for Mr. Wells’ patent application without explaining why there was no filing date listed, “despite knowing how important it was to Mr. Wells to claim patent pending status.” But Respondent had already explained to Mr. Wells via a January 12, 2015 email that he could claim patent pending status once the application was filed. The e-filing receipt constituted proof of filing, and after Mr. Wells complained that it did not include a filing date, Respondent promptly forwarded additional proof in the form of a screenshot from PAIR showing that Mr. Wells’ application had been received by USPTO and was being processed. This conduct does not amount to a failure of competence or diligence.

Likewise, the Court rejects the OED Director’s argument that Respondent violated § 11.101 and § 11.103 when he told Mr. Wells that a response to the 2016 Office action was due on July 4, 2016, rather than July 6, 2016. Respondent testified he did this on purpose to provide a “cushion” of time in hopes of ensuring a timely response to the Office action.<sup>9</sup> An attorney should be able to submit timely filings without giving his client an early deadline. However, Respondent’s intentional misstatement of the deadline for a benign purpose is not a clear and convincing breach of his duties of competence and diligence.

The OED Director argues that Respondent failed to act diligently and competently when he submitted photographs to USPTO without attempting to show why they were the only practical medium for illustrating Mr. Wells’ invention. However, the record shows Respondent did attempt to address this issue by filing a Petition to Accept Photographs through which he asked USPTO to accept photographs in addition to a drawing because “it would be extremely difficult if not impossible to include all the details in the photographs in a drawing.”

The OED Director claims it is “most telling about Respondent’s representation” that the 2016 Office action and 2018 final Office action rejected Mr. Wells’ invention for largely the same reasons, including the use of photographs, as well as obviousness in light of the prior art. However, the record shows that Respondent attempted to address these issues by filing a Response to the 2016 Office action that included amendments to all but one of the invention’s claims and, as discussed above, a Petition to Accept Photographs. The OED Director has not explained what else Respondent could or should have done to change the outcome. Respondent appears to have made a reasonable attempt to defend the invention’s claims and to justify the use of photographs. Although he was unsuccessful, losing a case does not necessarily establish a breach of the rules of professional conduct. Thus, the record does not contain clear and convincing evidence that Respondent failed to exercise diligence and competence in addressing USPTO’s objections relating to the photographs and prior art.

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<sup>9</sup> A January 21, 2018 email similarly misstates the deadline to respond to the 2018 Final Office Action, corroborating that Respondent gave his client early deadlines on purpose.

On the other hand, Respondent did violate his duties of diligence and competence when he filed the August 7, 2016 Response to the 2016 Office action a month late without requesting an extension of time or paying the required late fee. On December 5 and 8, 2016, USPTO sent notices expressly informing Respondent that the Response had been filed late, that no new deadline was being provided, and that Mr. Wells' patent application had gone abandoned as a result. However, Respondent failed to acknowledge or address these notices, instead proceeding as if he had not seen them by filing a Supplemental Response to the 2016 Office action on December 15, 2016. Respondent asserts he simply did not realize the application had gone abandoned. But this information should have been readily available to him both in his own files and on PAIR. It is clear that Respondent was not monitoring PAIR or otherwise staying up-to-date on actions taken by USPTO in his client's patent matter, despite having previously received two warning letters from OED advising him to exercise diligence in this regard. Because he neglected to stay abreast of developments in Mr. Wells' patent matter, Respondent failed to respond timely and appropriately to the 2016 Office action, thereby violating his duties of diligence and competence under 37 C.F.R. § 11.101 and § 11.103.

Similarly, Respondent violated § 11.101 and § 11.103 by neglecting to timely and appropriately respond when USPTO issued the September 8, 2016 Notice of Publication and the December 8, 2016 Notice of Abandonment, both of which carried potentially significant implications for Mr. Wells' intellectual property rights. There is no evidence Respondent ever forwarded the Notice of Publication to his client or addressed it in any way. It is unclear when he notified his client of the Notice of Abandonment, and he did not respond to it until he filed a Petition to Revive—without telling his client—in July 2017. Meanwhile, when Mr. Wells had requested an update on the status of his patent application on January 30, 2017, Respondent apparently failed to check his files or PAIR and simply replied, "Waiting on the patent office." This conduct demonstrated a clear lack of diligence, resulting in incompetent handling of Mr. Wells' patent matter.

Respondent argues that "[t]here is no obligation to consult PAIR every five minutes or for routine questions." However, a patent practitioner is expected to consult PAIR as needed to respond to Office actions appropriately and avoid providing a client with inaccurate information. Reasonable promptness and diligence required Respondent to stay abreast of the status of his client's matter and to meet clearly defined deadlines, which he failed to do. While a "single forgetful moment or honest mistake" may not amount to actionable conduct, an attorney "has a duty to maintain awareness of his cases as they wend their way through the patent process." *In re Kroll*, Proceeding No. D2014-14, slip op. at 8 (USPTO Apr. 24, 2015).<sup>10</sup> Respondent's failure to fulfill this duty amounted to neglect of his client's matter warranting discipline. See, e.g., *Matter of Siccardi*, 859 N.Y.S.2d 728, 730 (N.Y. App. Div. 2008) ("[N]eglect of client matters has been held to constitute professional misconduct which warrants discipline."); *Att'y Grievance Comm'n v. Sutton*, 394 Md. 311, 329-30 (2006) ("[W]e have 'consistently regarded neglect and inattentiveness to a client's interests to be a violation ... warranting the imposition of some disciplinary sanction.'"); *In re Levin*, 463 N.E.2d 715, 717 (Ill. 1984) ("Culpable neglect of a client's affairs is misconduct sufficient to warrant disciplinary sanction.").

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<sup>10</sup> All USPTO disciplinary decisions cited herein are available online at <https://foiadocuments.uspto.gov/oed/>.

Respondent also argues he is a skilled patent attorney with years of experience and success, noting he has obtained more than 900 patents for a wide range of inventions during his career. But this does not speak to whether the specific conduct at issue in this case demonstrated the competence required under § 11.101. Here, the OED Director has shown by clear and convincing evidence that Respondent made multiple mistakes in handling Mr. Wells' patent application because he did not act with the promptness, thoroughness, preparation, or attention to detail that was necessary to provide competent representation.

## **II. Respondent failed to properly and adequately communicate with his client.**

Section 11.104 of the USPTO Rules of Professional Conduct sets forth the guidelines a patent practitioner must follow when communicating with a client in a matter before the Office. One fundamental requirement is that the practitioner must “[k]eep the client reasonably informed about the status of the matter.” 37 C.F.R. § 11.104(a)(3). The practitioner also must explain the matter “to the extent reasonably necessary to permit the client to make informed decisions regarding the representation.” *Id.* § 11.104(b).

In his closing brief, the OED Director lists numerous ways he believes Respondent violated both his duty to keep Mr. Wells reasonably informed under § 11.104(a)(3) and his duty to explain matters so as to allow Mr. Wells to make informed decisions under § 11.104(b). Some of these alleged violations are not borne out by clear and convincing evidence.

For example, the OED Director asserts that, at the outset of the representation, Respondent did not adequately explain to Mr. Wells the likelihood of receiving a patent or temper Mr. Wells' high expectations about the patentability of his invention. But Respondent denies this, and his engagement letter expressly disclaims any promise of patentability. The only evidence supporting the OED Director's accusation is Mr. Wells' testimony.

Likewise, although the OED Director alleges that Respondent failed to adequately explain to Mr. Wells the 2016 Office action and 2018 final Office action or the options for responding, these allegations are primarily based on Mr. Wells' testimony. Respondent disputes this testimony, and although his emails were terse and not always as informative as could be hoped, there are signs that he and Mr. Wells engaged in further discussion of the Office actions through communications such as phone calls that are not memorialized in the record.<sup>11</sup>

In the face of conflicting testimony, and given that Mr. Wells made a number of exaggerated and less-than-believable statements,<sup>12</sup> the Court is unwilling to fully credit his

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<sup>11</sup> For example, in a May 9, 2016 email discussing how to respond to the 2016 Office action, Mr. Wells' references to specific details of his invention suggest that he and Respondent had already discussed these details, even though no such discussions appear in the record (“Please let me know if you need pieces of the trim or fabric. Also as I stated, the utility will be made from plastic, but wood can be an option with the structure.”). As another example, in a December 16, 2016 email to Respondent, Mr. Wells' reference to “that peace of junk ... that you dug up and compared to my invention” signal extra-record discussions of the prior art.

<sup>12</sup> For example, Mr. Wells testified that the patent examiner who signed the 2016 Office action informed him Respondent was “incompetent” and “sending in shoddy work.” But Respondent points out that USPTO has no record of this conversation, despite requiring any examiner who speaks to an inventor to file an interview summary



assertions that Respondent failed to explain matters such as the Office actions and the likelihood of patentability. However, the OED Director has presented clear and convincing evidence that Respondent's conduct violated § 11.104(a)(3) and (b) in three instances.

First, Respondent filed the December 15, 2016 Supplemental Response to the 2016 Office action without adequately communicating the status of the matter to Mr. Wells or explaining the filing to the extent necessary to enable Mr. Wells' meaningful participation. Respondent neglected to contact Mr. Wells about this filing until December 15, just two days before Respondent believed it was due, then he submitted it to USPTO that same day without informing Mr. Wells or waiting for Mr. Wells' consent. Even if he had waited, Mr. Wells' email of December 18, 2016, makes clear that he did not understand what was going on well enough to provide meaningful input ("You asked me if I wanted to change anything. Well you never care to explain any of the process ... I guess if I must say yes or no it's no."). To enable informed decisionmaking, Respondent should have more thoroughly explained the Supplemental Response to his client in advance. Moreover, there was no excuse for Respondent not to notify his client when it was filed. Respondent's conduct with respect to the Supplemental Response violated his duties under § 11.104(a)(3) and (b) to keep Mr. Wells reasonably informed and to explain matters to the extent reasonably necessary to allow Mr. Wells to make informed decisions.

Respondent also violated § 11.104(a)(3) and (b) when he failed to notify Mr. Wells of the December 8, 2016 Notice of Abandonment or the July 24, 2017 Petition to Revive. Respondent asserts he did not immediately see the Notice of Abandonment because it was hidden under another document in his paper file. However, he should have been regularly checking PAIR, not just his paper file. Further, even after he realized his oversight, he failed to discuss the Notice of Abandonment with Mr. Wells or give his client an opportunity to respond. In February 2017, instead of calling Mr. Wells on the phone or following his usual practice of forwarding the notice via email, Respondent mailed a paper copy to an address where Mr. Wells did not reside—a move seemingly designed to ensure Mr. Wells would not actually receive the notice or learn of

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in the patent database. Further, as admitted by Mr. Wells, patent examiners are not supposed to speak to represented inventors.

As another example, Mr. Wells maintains that Respondent never told him about the '394 application going abandoned or about the Petition to Revive, not even during the conference call they held in August or September 2017. However, as Respondent had already sent Mr. Wells his entire file in July 2017, Mr. Wells was almost certainly aware of the abandonment by then. It is unclear what would have remained for discussion during the call if Respondent had pretended otherwise. Respondent's contrary account of the phone call (he said they mainly discussed the abandonment, its effect, and the Petition to Revive) is much more plausible.

Mr. Wells also claimed that Respondent's misconduct had cost him a fortune, asserting that his invention was worth either \$200 million or \$1 billion. Aside from being completely unsupported, these figures are so far apart that they appear random and unreliable.

Mr. Wells also testified he had met with approximately 20 attorneys and "[q]uite a few" had agreed to represent him in a malpractice suit against Respondent. Yet there is no evidence that he has initiated any such lawsuit, much less that he has spoken to over a dozen lawyers about it. Improbably, Mr. Wells also testified he received a letter from the New York State Bar stating that Respondent's law license is suspended, which is not true.

In short, Mr. Wells' testimony included a number of unverifiable and implausible assertions. He was also clearly angry with Respondent, accusing Respondent of intentionally mishandling his patent application and trying to steal his invention. Even if Mr. Wells was not actively trying to cast Respondent in a negative light, his suspicions may have clouded his recollection of his interactions with Respondent. These factors detract from the credibility of Mr. Wells' testimony.

the abandonment. Then, on July 24, 2017, Respondent filed a Petition to Revive without notifying or consulting with his client. Thus, Respondent did not keep Mr. Wells reasonably informed about the abandonment, much less explain the matter in a way that would allow his client to make an informed decision about how to proceed.

Similarly, Respondent violated § 11.104(a)(3) and (b) when he failed to notify Mr. Wells of the September 8, 2016 Notice of Publication or explain that Mr. Wells' patent application had been published, even after Mr. Wells requested a link to PAIR on July 23, 2017. Respondent filed a Petition to Revive the very next day, suggesting he had checked Mr. Wells' file. Yet instead of informing Mr. Wells that the application was public and explaining how to view it on Public PAIR, Respondent told Mr. Wells that only one person could access the database and forwarded power of attorney forms without explaining that Mr. Wells' signature on the forms would terminate the representation. By declining to disclose that Mr. Wells' patent application had been published or to explain how to access the published application, and by forwarding power of attorney forms without explaining what they would accomplish, Respondent failed to keep Mr. Wells reasonably informed and withheld information Mr. Wells needed to make informed decisions about the representation.

In addition to violating his duties to keep his client reasonably informed and to adequately explain matters under § 11.104(a)(3) and (b), the OED Director alleges that Respondent also failed to adequately respond to his client's requests for information. Under § 11.104(a)(4), a practitioner must "[p]romptly comply with reasonable requests for information from the client." 37 C.F.R. § 11.104(a)(4). Respondent violated this provision in four instances.

First, after Respondent told Mr. Wells that the patent examiner required drawings instead of pictures and asked if Mr. Wells wanted to get an estimate for the drawings, on July 11, 2016, Mr. Wells emailed: "Are you asking me a question about the drawings? Did not quite understand." There is no evidence Respondent replied. The next month, Mr. Wells emailed: "What is [the] concern over the photographs? Can you please give me more insight on the situation[?]" Respondent did reply to this message, but the fact that Mr. Wells sent it corroborates that he had received no reply to his earlier inquiry, in violation of § 11.104(a)(4).

Second, in response to a January 30, 2017 email from Mr. Wells asking, "Can you please tell me where we are in the process," Respondent replied, in full: "Waiting on the patent office." This was inaccurate. It was the Office that was waiting on Mr. Wells and Respondent, as Mr. Wells' patent application had recently gone abandoned and needed to be revived. Respondent should have checked Mr. Wells' file and/or PAIR to avoid giving erroneous information to his client, and should have offered more than a one-line response that failed to provide any accurate information about the status of his client's patent matter.

Third, on July 23, 2017, Mr. Wells requested information about how to check the status of his patent application. At this point, the application was available on both Private and Public PAIR. But instead of telling Mr. Wells how to view the application, and without disclosing any information about its status, Respondent claimed that USPTO "only allows one person to access" and forwarded power of attorney forms without further explanation. This reply was not responsive to Mr. Wells' inquiry and failed to satisfy § 11.104(a)(4).

Finally, on July 27, 2017, Mr. Wells sent Respondent an email asking, among other things, “What is the status of the application?” and “What is the next step in the status?” At this point, the application had long since gone abandoned, and Respondent had filed a Petition to Revive three days earlier and paid the filing fee himself. Yet he did not disclose these facts to Mr. Wells or explain what the next steps would entail, instead simply stating: “We are awaiting [sic] for a decision from the patent office.” This inadequate, evasive response failed to fulfill Respondent’s duties under § 11.104(a)(4).

### **III. Respondent engaged in conduct involving dishonesty, deceit, and misrepresentation.**

The USPTO Rules of Professional Conduct prohibit a practitioner from engaging in “conduct involving dishonesty, fraud, deceit or misrepresentation.” 37 C.F.R. § 11.804(c). Dishonest conduct is characterized by a lack of truth, honesty, straightforwardness, or trustworthiness. *In re Lane*, Proceeding No. D2013-07, slip op. at 14 (USPTO Mar. 11, 2014) (citing Merriam-Webster definition); see also *In re Shorter*, 570 A.2d 760, 767-68 (D.C. 1990). “Deceit” encompasses “dishonest behavior” and “behavior that is meant to fool or trick someone.” *In re Lane*, *supra*, slip op. at 14 (citing Merriam-Webster definition). Misrepresentation constitutes “[t]he act of making a false or misleading assertion about something, usu[ally] with the intent to deceive.” *Id.* (citing Black’s Law Dictionary).

The OED Director first argues that Respondent violated § 11.804(c) by misleading his client about the date he intended to file the Supplemental Response to the 2016 Office action. The evidence supports this allegation. Respondent emailed Mr. Wells about the Supplemental Response on December 15, 2016, noting, “This is due on December 17.” However, he filed the document with USPTO later that day without waiting for Mr. Wells’ input or approval. On December 16, Mr. Wells angrily emailed that he could not see the document and asked why Respondent had waited until just before the deadline to send it to him. Respondent did not admit to his client that he was also concerned about the deadline or that he had, in fact, already filed the document without his client seeing it. Instead, Respondent replied, “I am resending ... Since the 17th is a Saturday, it is not due until Monday the 19th,” disingenuously implying that he would wait for Mr. Wells’ feedback before filing it. This conduct violated § 11.804(c).

The OED Director argues that Respondent further violated § 11.804(c) by representing to USPTO in the December 15, 2016 Supplemental Response that certain claims in the ‘394 application “remain[ed] in the application for consideration,” and by telling Mr. Wells that they were “[w]aiting on the patent office” as of January 30, 2017. Both representations were erroneous because the application had previously gone abandoned. However, it is unclear when Respondent became aware of the abandonment. He maintains he did not see the Notice of Abandonment immediately, which is consistent with the Court’s finding that he was not diligently monitoring PAIR or otherwise staying up-to-date on developments in Mr. Wells’ patent matter. Sanctionable dishonesty or misrepresentation generally requires an intent to deceive. See, e.g., *In re Achterhof*, Proceeding No. D2017-24, slip op. at 15 (USPTO Dec. 11, 2018) (finding that a misrepresentation based on a sincere yet mistaken belief does not violate § 11.804(c)); *In re Piccone*, Proceeding No. D2015-06, slip op. at 48 (USPTO June 16, 2016) (finding no violation of § 11.804(c) in absence of evidence that practitioner’s conduct in making misrepresentation was anything more than negligent). The record does not contain clear and

convincing evidence that Respondent knew the two representations were untrue or that he made the representations with the intent to mislead. Before February 16, 2017,<sup>13</sup> the record proves, at most, that Respondent failed to exercise the diligence and competence required of a USPTO practitioner in addressing the 2016 abandonment.

After that date, however, the record shows that Respondent engaged in conduct involving dishonesty and deceit when he took steps to conceal the abandonment from his client. These steps included forwarding the 2016 Notice of Abandonment to Mr. Wells by mail instead of by email, despite never having communicated with Mr. Wells by mail on any other occasion, and prevaricating and providing evasive answers when Mr. Wells asked about the status of his patent application in July 2017 and requested information that would allow him to check the status himself. Instead of telling Mr. Wells how to view the application on PAIR, Respondent told him that USPTO “only allows one person to access” and asked his client to sign a form that would have terminated the representation. Meanwhile, Respondent quickly filed a Petition to Revive without telling Mr. Wells and paid the filing fee out of his own pocket. The reasonable inference to be drawn from the circumstances is that Respondent realized he had mishandled the application of an already difficult client and decided he would try to conceal his mistakes by reviving the application, and possibly terminating the representation, without the client’s knowledge or participation. In addition to misleading his client, Respondent also misled USPTO by stating in the Petition to Revive that the “*applicant* submits the entire delay was unintentional” (emphasis added), even though the applicant, Mr. Wells, was unaware there had been a delay, much less that it had caused an abandonment necessitating a petition to revive. This conduct was dishonest and violated § 11.804(c).

#### **IV. Respondent engaged in conduct prejudicial to the administration of justice.**

USPTO practitioners are prohibited from engaging in conduct that is “prejudicial to the administration of justice.” 37 C.F.R. § 11.804(d). Generally, an attorney is considered to have engaged in such conduct when his behavior negatively impacts the public’s perception of the courts or legal profession or undermines public confidence in the efficacy of the legal system. See Att’y Grievance Comm’n v. Rand, 981 A.2d 1234, 1242 (Md. 2009); In re Pasquine, Proceeding No. D2019-39, slip op. at 18 (USPTO Aug. 13, 2021).

The OED Director alleges that Respondent’s violations of § 11.804(c) also violated § 11.804(d). The Court agrees. Respondent was not forthright with Mr. Wells, particularly when he tried to revive Mr. Wells’ patent application without letting on that it had gone abandoned in the first place. Although there is no evidence Respondent intended to harm Mr. Wells’ interests, his behavior did not merit his client’s trust. This type of conduct is prejudicial to the administration of justice because it negatively impacts public perception of the legal profession.

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<sup>13</sup> Respondent mailed his client a paper copy of the Notice of Abandonment on February 16, 2017. This is the earliest evidence of the date Respondent actually knew of the abandonment. Of course, a competent and diligent practitioner *should have* known of the abandonment months earlier. But constructive knowledge is not a basis for a finding of intent to deceive.

## SUMMARY OF VIOLATIONS FOUND

For the reasons discussed above, clear and convincing evidence shows that Respondent violated his duties of competence and diligence under 37 C.F.R. § 11.101 and § 11.103 by failing to timely and appropriately respond to the 2016 Office action, the 2016 Notice of Abandonment, and the Notice of Publication in Mr. Wells' patent application.

Respondent also failed to communicate with his client in the professional manner required under 37 C.F.R. § 11.104. In handling the 2016 Office action and December 15, 2016 Supplemental Response thereto, the Notice of Publication, and the 2016 Notice of Abandonment and resultant Petition to Revive, Respondent failed to keep Mr. Wells reasonably informed under § 11.104(a)(3) or to explain matters to the extent reasonably necessary to allow Mr. Wells to make informed decisions under § 11.104(b), and he further violated § 11.104(a)(4) by failing to adequately respond to several of Mr. Wells' reasonable requests for information.

Finally, Respondent also engaged in conduct that was dishonest and prejudicial to the administration of justice, in violation of 37 C.F.R. § 11.804(c) and (d), by leading Mr. Wells to believe that he would file the Supplemental Response on December 19, 2016, when in fact he had already filed it without awaiting Mr. Wells' input, and by attempting to conceal the fact that the patent application had gone abandoned in 2016 due to his own negligence.

## SANCTIONS

To sanction Respondent for his misconduct, the OED Director asks the Court to impose a six-month suspension from practice before the Office with two years of probation and to order restitution to Mr. Wells. Respondent argues that no sanction is warranted.

In determining an appropriate sanction, USPTO regulations require the Court to consider the following four factors: (1) whether the practitioner has violated a duty owed to a client, the public, the legal system, or the profession; (2) whether the practitioner acted intentionally, knowingly, or negligently; (3) the amount of the actual or potential injury caused by the misconduct; and (4) the existence of any aggravating or mitigating factors. 37 C.F.R. § 11.54(b). The Court often looks to the American Bar Association's Standards for Imposing Lawyer Sanctions for guidance when determining the proper length and severity of a sanction, or when determining whether aggravating or mitigating factors exist. *See In re Chae*, Proceeding No. D2013-01, slip op. at 4 (USPTO Oct. 21, 2013); ABA, STANDARDS FOR IMPOSING LAWYER SANCTIONS (1992) ("ABA Standards").

### 1. Violation of Duties Owed to a Client, the Public, the Legal System, or the Profession

Respondent owed his client a duty to represent the client's interests competently and diligently, to communicate with the client in a clear and professional manner as described in the provisions of 37 C.F.R. § 11.104, and to be honest and straightforward with the client. *See, e.g., Combs v. Gent*, 181 S.W.3d 378, 384 (Tex. App. 2005) (explaining that attorneys owe clients a duty of "perfect candor, openness, and honesty, and the absence of any concealment or deception"). He violated these duties when he engaged in the misconduct described above, and in

doing so, he also violated duties owed to the public that the USPTO Rules serve to protect. See, e.g., *In re Ruffenach*, 486 N.W.2d 387, 391 (Minn. 1992) (“Honest and integrity are chief among the virtues the public has a right to expect of lawyers.”).

Respondent’s misconduct also breached duties owed to the legal system and legal profession. As representatives of the Bar and of the legal system in general, attorneys have a duty to avoid any conduct that reflects negatively on lawyers or the court system. Respondent’s actions in this case—particularly engaging in dishonest conduct—decrease public confidence in the integrity of the legal system and profession and in the Bar’s ability to self-regulate.

## 2. Whether Respondent Acted Intentionally, Knowingly, or Negligently

Respondent acted negligently in failing to meet the standards of competence and diligence required under 37 C.F.R. § 11.101 and § 11.103. His violations of § 11.104 were knowing. He knew or should have known the status of Mr. Wells’ patent matter, as he was the attorney of record to whom the Office sent notices and mailings, and had been warned twice before that he needed to communicate clearly with clients and monitor PAIR to stay up-to-date on applications for which he was responsible. Yet he failed to adequately communicate with Mr. Wells on multiple occasions, and at times provided the client with inaccurate information about his patent matter. Respondent engaged in intentional misconduct, the highest level of culpability, when he led Mr. Wells to believe that the Supplemental Response would not be filed until December 19, 2016, when in fact it had already been filed, and when he took steps to conceal the 2016 abandonment from Mr. Wells.

## 3. Actual or Potential Injury

Respondent asserts that his actions caused no harm. The OED Director argues that, by causing Mr. Wells’ patent application to go abandoned for over a year, Respondent delayed the prosecution of the application, thereby reducing the term of any issued patent, and left Mr. Wells “anxiously waiting unnecessarily” due to Respondent’s neglect.

The record does not show that Respondent’s misconduct caused actual financial loss or injury to Mr. Wells’ intellectual property rights. Despite Respondent’s neglect of his client’s patent matter, he successfully revived Mr. Wells’ patent application in 2017. The application went abandoned again in 2018 after Mr. Wells indicated he was unwilling to expend funds to respond to the 2018 Final Office Action rejecting his claims. There is no evidence to substantiate Mr. Wells’ assertions that his invention, if patented, would have been worth \$200 million or \$1 billion dollars, nor that Respondent’s misconduct cost him millions of dollars. On the other hand, as argued by the OED Director, Respondent caused potential injury to his client by wasting time, making mistakes, and delaying the prosecution of Mr. Wells’ application. Dishonest conduct by an attorney is also inherently harmful to the public, the Bar, and the legal system in general.

## 4. Aggravating and Mitigating Factors

The American Bar Association has promulgated a list of potential aggravating and mitigating factors to be considered when assessing disciplinary sanctions for attorneys. See

ABA Standards §§ 9.22, 9.32. The OED Director argues that two aggravating factors warrant an increase in the severity of the sanction in this case: Respondent's refusal to acknowledge the wrongful nature of his conduct, and his substantial experience in the practice of law. See id. § 9.22(g), (i). Respondent counters that six mitigating factors apply: absence of a prior disciplinary record; absence of a dishonest or selfish motive; full cooperation in the disciplinary investigation; good character or reputation; delay in the disciplinary proceedings; and imposition of other penalties or sanctions. See id. § 9.32(a), (b), (e), (g), (j), (k).

Respondent concedes he has substantial experience in the practice of law, including patent law. As an experienced patent practitioner, he should have known better than to engage in the misconduct at issue here, especially having been twice warned against similar misconduct by the OED Director. However, his years of experience are somewhat mitigated by his clean disciplinary record.

The OED Director argues that Respondent has refused to accept responsibility for his misconduct. But Respondent does admit that he made some mistakes during his representation of Mr. Wells. Although he has not conceded that he engaged in misconduct warranting sanctions, this is not a significant aggravating factor, as he should not be punished more severely for exercising his right to a hearing on liability.

Respondent has cooperated in the disciplinary proceedings against him, including by responding to four requests for information and documents during the OED investigation and by complying with this Court's orders and procedures. However, this is not a strong mitigating factor because practitioners are expected to cooperate in disciplinary proceedings.

Respondent argues he did not act with a dishonest or selfish motive, but "made a noble effort to continue work on [Mr. Wells'] patent application under difficult and unpleasant conditions" in the knowledge that Mr. Wells had minimal opportunity to engage a new attorney. By contrast, Mr. Wells alleges Respondent was trying to steal his invention. The record does not show that Respondent's motives were purely altruistic. In fact, the Court has found he intentionally engaged in dishonest conduct. But the record also does not support Mr. Wells' allegations of thievery, nor does it show that Respondent was acting for pecuniary gain. Rather, the underlying motive for Respondent's intentional misconduct (dishonesty) seems to have been damage control—he knew he had made mistakes in handling Mr. Wells' patent application, and was trying to avoid disclosing this unwelcome information to a client who was already baselessly accusing him of "trying to deliberately fail my application."

Specifically, Respondent filed the December 15, 2016 Supplemental Response without Mr. Wells' input because he had waited until the last minute and feared he was about to miss the deadline. It is likely he simply did not want to explain this to an already difficult client. Similarly, after the application went abandoned due to Respondent's lack of diligence, he tried to revive it without telling Mr. Wells, even going so far as to pay the filing fee himself. It appears he hoped he could correct or minimize his mistakes without further angering his client. While these circumstances do not excuse Respondent's misconduct, they suggest he may be entitled to some leniency, as he did not act with the kind of selfish aims that are often cited to justify a more severe sanction. See, e.g., In re Aquilla, Proceeding No. D2022-27, slip op. at 9 (USPTO Jan. 27,

2023) (finding dishonest and selfish motive where practitioner intentionally solicited and kept funds for services he did not intend to perform); *In re Correll*, Proceeding No. D2018-12, slip op. at 27 (USPTO Oct. 3, 2019) (finding selfish motive where attorney earned more than half a million dollars unlawfully maintaining a private practice while employed as a government employee, in violation of federal conflict-of-interest rules); *In re Fuess*, Proceeding No. D2015-08, slip op. at 71 (USPTO July 21, 2017) (finding selfish motive where practitioner allowed client's applications to go abandoned while refusing to withdraw from representation in attempt to force client to remit unpaid legal fees).

Respondent cites his good character or reputation as a mitigating factor, but he has not produced any character evidence other than Mr. Wells' testimony that he considered Respondent to be more honest than other attorneys because Respondent charged lower legal fees. Likewise, Respondent offers no evidentiary support for his contention that he has already been subjected to penalties for the misconduct at issue here. As for his argument that delay in these disciplinary proceedings justifies a less severe sanction, delay is not generally deemed a mitigating factor unless it causes prejudice, such as by impairing an attorney's ability to defend himself, which Respondent has not alleged or proven in this case. *See, e.g., In re Preszler*, 232 P.3d 1118, 1133 (Wash. 2010); *In re McBride*, 865 N.E.2d 1110, 1119 (Mass. 2007). Accordingly, the Court does not consider these to be mitigating factors.

## 5. Conclusion

Respondent breached his professional and ethical duties by neglecting a client matter, failing to adequately communicate with the client, and failing to be forthright with the client about mistakes made during the representation. Respondent's dishonesty was intentional, which is the highest level of culpability. However, Respondent appears to have been motivated mainly by a desire to avoid conflict with an already difficult client, rather than by greed or anticipation of personal gain, which is a mitigating circumstance even though it does not excuse his conduct. Respondent's misconduct involved a single client and patent matter, and the record does not show any actual injury to the client's financial interests or intellectual property rights. Still, as an experienced attorney and patent practitioner who had twice been warned to communicate clearly with clients and diligently monitor PAIR, Respondent knew better than to engage in the conduct at issue here, and he should have been honest with his client and conducted himself in a more professional manner. The Court concludes that a suspension is warranted.

The OED Director requests a six-month suspension with two years of probation, citing several settlements with dissimilar facts. A more similar case is *In re Martinez*, Proceeding No. D2019-37 (USPTO Feb. 15, 2022). In that case, a practitioner mishandled a client's patent application, causing it to go abandoned. After ignoring the client's inquiries for almost a year, the practitioner finally provided a status update that falsely assured the client all was in order. The practitioner was assessed a six-month suspension with twelve months of probation upon reinstatement, which is similar to what the OED Director is requesting here. *Id.*, slip op. at 4. However, unlike in the instant case, there is no indication the practitioner in *Martinez* tried to revive his client's application or otherwise rectify the errors he had made in handling the application, and he also failed to cooperate in OED's disciplinary investigation. This suggests greater leniency is warranted here.



Considering all the foregoing, the Court finds that Respondent’s misconduct warrants a 90-day suspension, with twelve months of probation upon reinstatement.

The OED Director asserts that Respondent also should be ordered to make restitution to Mr. Wells. However, unlike in other USPTO disciplinary cases where restitution has been ordered,<sup>14</sup> the record does not show that Mr. Wells suffered any concrete economic loss due to Respondent’s misconduct or that Respondent was unjustly enriched. *See In re Longacre*, 122 P.3d 710, 721-22 (Wash. 2005) (declining to impose restitution where record did not establish amount of client’s financial injury); ABA, MODEL RULES FOR LAWYER DISCIPLINARY ENFORCEMENT, cmt. to R.10(A)(6) (2002) (suggesting that restitution is ordered only where “the value of the client’s loss resulting from the respondent’s misconduct is established”). Moreover, the central purpose of disciplinary proceedings is to protect the public, not to compensate injured clients. *See In re Hormann*, Proceeding No. D2008-04, slip op. at 20 (USPTO July 8, 2009); *In re Robertson*, 612 A.2d 1236, 1239-41 (D.C. 1992) (reversing order of restitution that was intended to compensate client for damages, and suggesting purpose of restitution in disciplinary proceedings should be limited to preventing unjust enrichment). Accordingly, the Court declines to order restitution.

## ORDER

For the reasons set forth above, Respondent shall be **SUSPENDED** from practice before the U.S. Patent and Trademark Office in patent, trademark, and other non-patent matters for a period of ninety (90) days, with twelve (12) months of probation upon reinstatement.<sup>15</sup>

So **ORDERED**,

**ALEXANDER  
FERNANDEZ-  
PONS**

Digitally signed by: ALEXANDER  
FERNANDEZ-PONS  
DN: CN = ALEXANDER FERNANDEZ-  
PONS C = US O = U.S. Government OU  
= Department of Housing and Urban  
Development, Office of the Secretary  
Date: 2023.08.24 15:28:08 -04'00'

Alexander Fernández-Pons  
United States Administrative Law Judge

**Notice of Appeal Rights:** Within fourteen (14) days of the date of this initial decision, either party may appeal to the USPTO Director by filing a notice of appeal. 37 C.F.R. § 11.55(a). In the absence of an appeal, this decision will become the final decision of the USPTO Director pursuant to 37 C.F.R. § 11.54(d).

<sup>14</sup> *See, e.g., In re Aquilla*, *supra*, slip op. at 11 (ordering practitioner to repay fees retained for work he did not perform); *In re Stecweycz*, Proceeding No. D2014-15, slip op. at 7 (USPTO Jan. 17, 2017) (ordering restitution for amounts client paid to revive application that went abandoned due to practitioner’s misconduct).

<sup>15</sup> Respondent is directed to 37 C.F.R. § 11.58, which sets forth Respondent’s duties while suspended. Respondent shall remain suspended from the practice of patent, trademark, and non-patent law before the USPTO until the OED Director grants a petition reinstating Respondent pursuant to 37 C.F.R. § 11.60(c).

**CERTIFICATE OF SERVICE**

I hereby certify that copies of the foregoing **INITIAL DECISION AND ORDER**, issued by Alexander Fernández, Administrative Law Judge, in D2019-44, were sent to the following parties on this 24<sup>th</sup> day of August 2023, in the manner indicated:



Cinthia Matos, Docket Clerk  
HUD Office of Hearings and Appeals

**VIA E-MAIL:**

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