

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

In the Matter of	)	
	)	
Michael A. Berns,	)	Proceeding No. D2012-16
	)	
Respondent	)	
_____	)	

**FINAL ORDER**

The Deputy General Counsel for Enrollment and Discipline and Director of the Office of Enrollment and Discipline (“OED Director”) for the United States Patent and Trademark Office (“USPTO” or “Office”) and Michael A. Berns (“Respondent”) have submitted a proposed settlement agreement (“Agreement”) to the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (“USPTO Director”) for approval.

The Agreement, which resolves all disciplinary action by the USPTO arising from the stipulated facts set forth below, is hereby approved. This Final Order sets forth the parties’ stipulated facts, legal conclusions, and sanctions.

**Jurisdiction**

1. At all times relevant hereto, Respondent, of Urbana, Illinois, has been an attorney registered to practice before the Office (Registration Number 38,379) and is subject to the USPTO Disciplinary Rules set forth at 37 C.F.R. § 10.20 *et seq.*
2. The USPTO Director has jurisdiction over this matter and the authority to approve the Agreement pursuant to the provisions of 35 U.S.C. § 2(b)(2)(D) and 37 C.F.R. §§ 11.19 and 11.26.

**Stipulated Facts**

3. Respondent of Urbana, Illinois, is an attorney registered to practice patent law before the Office (Registration Number 38,379).
4. At all relevant times, Respondent has also been licensed to practice law in the state of Illinois.
5. Respondent represented an inventor in the prosecution of a U.S. patent application.

6. The USPTO mailed to Respondent a Notice of Abandonment dated October 28, 2010, for failure to timely reply to a Notice to File Corrected Application Papers dated February 16, 2010.

7. Respondent did not inform the client of the Notice of Abandonment.

### **Legal Conclusion**

8. Based on the foregoing stipulated facts, Respondent acknowledges that his conduct violated 37 C.F.R. § 10.23(b)(6) (engaging in conduct that adversely reflects upon a practitioner's fitness to practice before the Office) via his conduct in violation of 37 C.F.R. § 10.23(c)(8) (failing to inform a client of correspondence received from the Office when the correspondence (i) could have a significant effect on a matter pending before the Office, (ii) is received by the practitioner on behalf of a client or former client, and (iii) is correspondence of which a reasonable practitioner would believe under the circumstances the client or former client should be notified).

### **Agreed Upon Sanction**

9. Respondent agrees, and it is ORDERED that:
- a. Respondent be, and hereby is, publicly reprimanded;
  - b. The OED Director shall publish this Final Order at the Office of Enrollment and Discipline's Reading Room electronically located at:  
<http://des.uspto.gov/Foia/OEDReadingRoom.jsp>;
  - c. The OED Director shall publish the following notice in the *Official Gazette*:

### **Notice of Reprimand**

This notice concerns Michael A. Berns ("Respondent") of Urbana, Illinois, a registered patent attorney (Registration Number 38, 379).

The United States Patent and Trademark Office ("USPTO" or "Office") has publicly reprimanded Mr. Berns for violating 37 C.F.R. § 10.23(b)(6) (engaging in conduct that adversely reflects upon a practitioner's fitness to practice before the Office) via his conduct in violation of 37 C.F.R. § 10.23(c)(8) (failing to inform a client of correspondence received from the Office when the correspondence (i) could have a significant effect on a matter pending before the Office, (ii) is received by the practitioner on behalf of a client or former client, and (iii) is correspondence of which a reasonable practitioner would believe under the circumstances the client or former client should be notified).


Respondent represented an inventor in the prosecution of a U.S. patent application. The USPTO mailed to Respondent a Notice of Abandonment dated October 28, 2010, for failure to timely reply to a Notice to File Corrected Application Papers dated February 16, 2010. Respondent did not notify the client of the Notice of Abandonment.

This action is the result of a settlement agreement between Respondent and the OED Director pursuant to the provisions of 35 U.S.C. § 2(b)(2)(D) and 37 C.F.R. §§ 11.20, 11.26, and 11.59. Disciplinary decisions involving practitioners are posted at the Office of Enrollment and Discipline's Reading Room located at: <http://des.uspto.gov/Foia/OEDReadingRoom.jsp>.

- d. Nothing in the Agreement or this Final Order prevents the Office from considering the record of this disciplinary proceeding, including this Final Order, (1) when addressing any further complaint or evidence of the same or similar misconduct concerning Respondent brought to the attention of the Office, and/or (2) in any future disciplinary proceeding concerning Respondent, (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
- e. The OED Director and Respondent bear their own costs incurred to date and in carrying out the terms of this agreement.

APR 17 2012

Date

  
\_\_\_\_\_  
JAMES O. PAYNE  
Deputy General Counsel for General Law  
United States Patent and Trademark Office

on behalf of

David M. Kappos  
Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office

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JAMES O. PAYNE  
Deputy General Counsel for General Law  
United States Patent and Trademark Office

on behalf of

David M. Kappos  
Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office