

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

In the Matter of)	
)	
James B. Hicks,)	Proceeding No. D2013-11
)	
Respondent)	
_____)	

Final Order
Pursuant to 37 C.F.R. 11.26

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 James B. Hicks (“Respondent”) have submitted a Proposed Settlement Agreement (“Agreement”) to the Acting Under Secretary of Commerce for Intellectual Property and Acting 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 conclusion, and sanctions.

Jurisdiction

1. At all times relevant hereto, Respondent of Los Angeles, California has been an attorney who has practiced before the Office in trademark matters and is subject to the USPTO Disciplinary Rules set forth at 37 C.F.R. § 10.20 *et seq.*¹
2. The USPTO Director has jurisdiction over this matter pursuant to 35 U.S.C. §§ 2(b)(2)(D) and 37 C.F.R. § 11.26.

Stipulated Facts

3. Respondent of Los Angeles, California is an attorney licensed to practice law in California (Bar # 109117). He has practiced before the Office in trademark matters and is subject to the USPTO Disciplinary Rules set forth at 37 C.F.R. § 10.20 *et seq.* Respondent is not a registered patent practitioner.

¹ Effective May 3, 2013, the USPTO Rules of Professional Conduct apply to persons who practice before the Office. *See* 37 C.F.R. §§ 11.01 through 11.901. Since the alleged conduct occurred prior to May 3, 2013, the USPTO Code of Professional Responsibility is applicable in this case. *See* 37 C.F.R. §§ 10.20-10.112.

4. On March 31, 2011, the United States District Court for the Eastern District of New York, in the matter of *Rates Technology, Inc. v. Mediatrx Telecom, Inc.*, No. 05-CV-2755, entered an order sanctioning Respondent for failing to comply with the court's discovery orders.

5. On July 26, 2012, the Court of Appeals for the Federal Circuit affirmed the District Court's decision. See *Rates Technology, Inc. v. Mediatrx Telecom, Inc.*, 688 F.3d 742 (Fed. Cir. 2012).

6. In part, the Federal Circuit opinion stated, "[o]n a separate matter, we note that Mr. Hick's brief on appeal to this court contained several statements that were misleading or improper." *Id.* at 750.

7. Respondent represents that he respectfully disagrees with these rulings in *Rates Technology, Inc. v. Mediatrx Telecom, Inc.*, but he did not seek further appellate review and he has entered this settlement, after consultation with his client.

Legal Conclusion

8. Respondent acknowledges that, based on the above stipulated facts, he violated 37 C.F.R. § 10.23(b)(5) by engaging in conduct that is prejudicial to the administration of justice.

Agreed Upon Sanction

9. Respondent agrees, and it is hereby ORDERED that:
- a. Respondent is hereby publicly reprimanded;
 - b. Respondent shall serve a one year probationary period commencing on the date this Final Order is signed;
 - c. Respondent shall be permitted to practice trademark and other non-patent law before the USPTO during his probationary period unless his probation is revoked and he is suspended by order of the USPTO Director;
 - d. In the event the OED Director is of the opinion that Respondent, during the probationary period, failed to comply with any provision of the Agreement, Final Order, or any Disciplinary Rule of the USPTO Rules of Professional Responsibility, the OED Director shall:
 - i. issue to Respondent an Order to Show Cause why the USPTO Director should not order that Respondent be immediately suspended for up to sixty (60) days for the violation set forth in paragraph 8, above;

- ii. send the Order to Show Cause to Respondent at the last address of record Respondent furnished to the California State Bar Association; and
 - iii. grant Respondent fifteen (15) calendar days to respond to the Order to Show Cause;
- e. In the event that after the 15-day period for response and consideration of the response, if any, received from Respondent, the OED Director continues to be of the opinion that Respondent, during the probationary period, failed to comply with any provision of the Agreement, Final Order, or any Disciplinary Rule of the USPTO Rules of Professional Responsibility, the OED Director shall:
- i. deliver to the USPTO Director or his designee: (A) the Order to Show Cause, (B) Respondent's response to the Order to Show Cause, if any, and (C) argument and evidence causing the OED Director to be of the opinion that Respondent failed to comply with any provision of the Agreement, Final Order, or any Disciplinary Rule of the USPTO Rules of Professional Responsibility during the probationary period, and
 - ii. request that the USPTO Director immediately suspend Respondent for up to sixty (60) days for the violations set forth in paragraph eight, above;
- f. In the event the USPTO Director suspends Respondent pursuant to subparagraph e, above, and Respondent seeks a review of the suspension, any such review of the suspension shall not operate to postpone or otherwise hold in abeyance the suspension;
- g. The OED Director shall electronically publish the Final Order at the OED's electronic FOIA Reading Room, which is publicly accessible through the Office's website at: <http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>;
- h. The OED Director shall publish the following notice in the *Official Gazette*:

Notice of Public Reprimand and Probation

This notice regards James B. Hicks of Los Angeles, California, a California attorney who has practiced before the United States Patent and Trademark Office ("USPTO" or "Office"). Mr. Hicks is not a registered patent practitioner. The Office has publicly reprimanded Mr. Hicks and placed him on probation for one year. Mr. Hicks is permitted to practice before the Office in trademark and other non-patent matters during his

probationary period unless he is subsequently suspended or excluded by order of the USPTO Director.

Mr. Hicks engaged in conduct prejudicial to the administration of justice. In *Rates Technology, Inc. v. Mediatrrix Telecom, Inc.*, No. 05-CV-2755, the United States District Court for the Eastern District of New York entered an order sanctioning Respondent for failing to comply with the court's discovery orders. Additionally, the United States Court of Appeals for the Federal Circuit found that Mr. Hicks had made misleading and improper statements in a brief submitted to it in *Rates Technology, Inc. v. Mediatrrix Telecom, Inc.*, 688 F. 3d 742 (Fed. Cir. 2012). Mr. Hicks respectfully disagrees with such findings.


Practitioners are reminded of their duty to fully comply with all lawful court orders and be honest and candid in all documents filed with any court.

This action is the result of a settlement agreement between Mr. Hicks 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://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>.

- i. Nothing in this Final Order prevents the Office from considering the record of this disciplinary proceeding (i) when addressing any further complaint or evidence of the same or similar misconduct brought to the attention of the Office, and/or (ii) in any future disciplinary proceeding (A) as an aggravating factor to be taken into consideration in determining any discipline to be imposed and/or (B) to rebut any statement or representation by or on Respondent's behalf;
- j. The OED Director and Respondent shall file a joint motion dismissing the USPTO disciplinary proceeding pending against Respondent within fourteen days after entry of any Final Order approving this Agreement;
- k. The OED Director and Respondent shall each bear their own costs incurred to date and in carrying out the terms of this Agreement and any Final Order approving this Agreement.

[SIGNATURE ONLY FOLLOWS ON NEXT PAGE]



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

September 10, 2013
Date

on behalf of

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

cc: Director of the Office of Enrollment and Discipline
United States Patent and Trademark Office

James B. Hicks
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