

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

In the Matter of:)	
)	
David W. Denenberg,)	Proceeding No. D2015-20
)	
Respondent)	
_____)	

FINAL ORDER

Pursuant to 37 C.F.R. § 11.27(b), the Director of the United States Patent and Trademark Office (“USPTO” or “Office”) received for review and approval from the Director of the Office of Enrollment and Discipline (“OED Director”) an Affidavit of Resignation Pursuant to 37 C.F.R. § 11.27 executed by David Denenberg (“Respondent”) on March 9, 2015.

Respondent submitted the affidavit to the USPTO for the purpose of being excluded on consent pursuant to 37 C.F.R. § 11.27.

For the reasons set forth herein, Respondent’s Affidavit of Resignation shall be approved and Respondent shall be excluded on consent from practice before the Office in patent, trademark, and other non-patent matters commencing on the date of this Final Order.

Jurisdiction

Respondent of Merrick, New York is a registered patent attorney (Reg. No. 40,986) and is subject to the USPTO Code of Professional Responsibility, 37 C.F.R. § 10.20 *et seq.*, and the USPTO Rules of Professional Conduct, 37 C.F.R. § 11.101, *et seq.*¹

Pursuant to 35 U.S.C. §§ 2(b)(2)(D) and 32 and 37 C.F.R. § 11.27, the USPTO Director has the authority to approve Respondent’s Affidavit of Resignation and to exclude Respondent

¹ The USPTO Code of Professional Responsibility applies to a practitioner’s conduct that occurred prior to May 3, 2013, while the USPTO Rules of Professional Conduct, 37 C.F.R. § 11.101 *et seq.*, apply to a practitioner’s conduct that occurred on or after May 3, 2013.

on consent from the practice of patent, trademark, and other non-patent matters before the Office.

Respondent's Affidavit of Resignation

Respondent acknowledges in his March 9, 2015 Affidavit of Resignation that:

1. His consent is freely and voluntarily rendered, and he is not being subjected to coercion or duress.

2. He is aware that, pursuant to 37 C.F.R. § 11.22, the OED Director opened an investigation of allegations that that he violated the USPTO Code of Professional Responsibility and USPTO Rules of Professional Conduct, namely: OED File No. [REDACTED]. The investigation delved into and obtained information, *inter alia*, that:

- a. He was head of the Intellectual Property Department at the law firm of Davidoff Hutcher & Citron LLP ("DHC").
- b. While in this position at DHC, he provided legal representation to a particular client.
- c. Between approximately November 2006 and June 2014, inclusive, he sent and caused to be sent via U.S. Mail fraudulent bills, including fraudulent expense bills, to the particular client.
- d. The particular client paid DHC the amounts that he falsely billed for legal services that were never rendered.
- e. As a result of his conduct, he pled guilty to eight counts of mail fraud in *United States v. Denenberg*, 14-cr-00594 (E.D.N.Y. 2014).

3. Respondent is aware that the OED Director is of the opinion based on this investigation that he violated the following provisions of the USPTO Code of Professional Responsibility: 37 C.F.R. § 10.23(a) (A practitioner shall not engage in disreputable or gross misconduct); 37 C.F.R. § 10.23(b)(3) (A practitioner shall not engage in illegal conduct involving moral turpitude); and 37 C.F.R. § 10.23(b)(4) (A practitioner shall not engage in

conduct involving dishonesty, fraud, deceit, or misrepresentation).

4. Respondent is aware that the OED Director is of the opinion based on this investigation that he also violated the following provisions of the USPTO Rules of Professional Conduct: 37 C.F.R. § 11.804(b) (It is professional misconduct for a practitioner to commit a criminal act that reflects adversely on the practitioner's honesty, trustworthiness or fitness as a practitioner in other respects); 37 C.F.R. § 11.804(c) (It is professional misconduct to engage in conduct involving dishonesty, fraud, deceit, or misrepresentation); and 37 C.F.R. § 11.804(i) (It is professional misconduct to engage in other conduct that adversely reflects on the practitioner's fitness to practice before the USPTO).

5. Without admitting to violating any of the disciplinary rules of the USPTO Code of Professional Responsibility and/or the USPTO Rules of Professional Conduct investigated by the OED Director in OED File No. [REDACTED], Respondent acknowledges that, if and when he applies for reinstatement under 37 C.F.R. § 11.60 to practice before the USPTO in patent, trademark, and/or other non-patent matters, the OED Director will conclusively presume, for the purpose of determining the application for reinstatement, that:

- (a) the facts regarding him in paragraph 2, supra, true, and
- (b) he could not have successfully defended himself against the allegations embodied in the opinion of the OED Director that he violated 37 C.F.R. §§ 10.23(a); 10.23(b)(3); 10.23(b)(4); (11.804(b); 11.804(c); and 11.804(i).

6. Respondent has fully read and understands 37 C.F.R. §§ 11.5(b), 11.27, 11.58, 11.59, and 11.60, and is fully aware of the legal and factual consequences of consenting to exclusion from practice before the USPTO in patent, trademark, and other non-patent matters.

7. Respondent consents to being excluded from practice before the USPTO in patent, trademark, and other non-patent matters.

Exclusion on Consent

Based on the foregoing, the USPTO Director has determined that Respondent's Affidavit of Resignation complies with the requirements of 37 C.F.R. § 11.27(a). Accordingly, it is hereby ORDERED that:

- a. Respondent's Affidavit of Resignation shall be, and hereby is, approved;
- b. Respondent shall be, and hereby is, excluded on consent from practice before the Office in patent, trademark, and other non-patent matters commencing on the date of this Final Order;
- c. The OED Director shall electronically publish this Final Order at the Office of Enrollment and Discipline's electronic FOIA Reading Room, which is publicly accessible at <http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>;
- d. The OED Director shall publish the following notice in the *Official*

Gazette:

Notice of Exclusion on Consent

This notice concerns David W. Denenberg, a registered patent attorney (Reg. No. 40,986). The Director of the United States Patent and Trademark Office ("USPTO" or "Office") has accepted Mr. Denenberg's affidavit of resignation and ordered his exclusion on consent from practice before the Office in patent, trademark, and other non-patent matters.

Mr. Denenberg voluntarily submitted his affidavit at a time when a disciplinary investigation was pending against him. The investigation concerned his fraudulent billing of a client, resulting in his guilty plea to eight counts of mail fraud in *United States v. Denenberg*, 14-cr-00594 (E.D.N.Y. 2014). Mr. Denenberg acknowledged that the OED Director was of the opinion that his conduct violated 37 C.F.R. §§ 10.23(a) (A practitioner shall not engage in disreputable or gross misconduct); 37 C.F.R. § 10.23(b)(3) (A practitioner shall not engage in illegal conduct involving moral turpitude); 37

C.F.R. § 10.23(b)(4) (A practitioner shall not engage in conduct involving dishonesty, fraud, deceit, or misrepresentation); 37 C.F.R. § 11.804(b) (It is professional misconduct for a practitioner to commit a criminal act that reflects adversely on the practitioner's honesty, trustworthiness or fitness as a practitioner in other respects); 37 C.F.R. § 11.804(c) (It is professional misconduct to engage in conduct involving dishonesty, fraud, deceit, or misrepresentation); and 37 C.F.R. § 11.804(i) (It is professional misconduct to engage in other conduct that adversely reflects on the practitioner's fitness to practice before the USPTO).

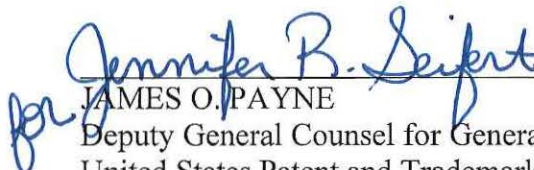
While Mr. Denenberg did not admit to violating any of the disciplinary rules of the USPTO Code of Professional Responsibility and/or the USPTO Rules of Professional Conduct as alleged in the pending investigation, he acknowledged that, if and when he applies for reinstatement, the OED Director will conclusively presume, for the limited purpose of determining the application for reinstatement, that (i) the facts set forth above are true, and (ii) he could not have successfully defended himself against the allegations embodied in the opinion of the OED Director that he violated 37 C.F.R. §§ 10.23(a); 10.23(b)(3); 10.23(b)(4); 11.804(b); 11.804(c); and 11.804(i).

This action is taken pursuant to the provisions of 35 U.S.C. §§ 2(b)(2)(D) and 32, and 37 C.F.R. §§ 11.27 and 11.59. Disciplinary decisions involving practitioners are posted for public reading at the Office of Enrollment and Discipline Reading Room, available at: <http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>.

- e. Respondent shall comply fully with 37 C.F.R. § 11.58; and
- f. Respondent shall comply fully with 37 C.F.R. § 11.60 upon any request for reinstatement.

MAR 24 2015

Date


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

on behalf of

Michelle K. Lee
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

cc:

Director of the Office of Enrollment and Discipline
U.S. Patent and Trademark Office

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