

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

In the Matter of )  
Roy A. Ekstrand, )  
Respondent )  
\_\_\_\_\_ )

Proceeding No. D2016-13

**FINAL ORDER PURSUANT TO 37 C.F.R. § 11.26**

The Director of the Office of Enrollment and Discipline (“OED Director”) for the United States Patent and Trademark Office (“USPTO” or “Office”) and Roy A. Ekstrand (“Respondent”) have submitted a Proposed Settlement Agreement (“Agreement”) to the Under Secretary of Commerce for Intellectual Property and Director of the USPTO 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 found in the Agreement.

**Jurisdiction**

1. At all times relevant hereto, Respondent of Costa Mesa, California has been a registered patent attorney (Registration No. 27,485) and subject to the USPTO Rules of Professional Conduct.
2. The USPTO Director has jurisdiction over this matter pursuant to 35 U.S.C. §§ 2(b)(2)(D) and 32 and 37 C.F.R. § 11.19.

**Joint Stipulated Facts**

***I. Background***

3. At all times relevant hereto, Respondent has been registered as an attorney authorized to practice before the Office and is subject to the provisions of the USPTO Rules of Professional Conduct. Respondent's registration number is 27,485. Respondent has been registered as a patent agent since December 12, 1974, and as a patent attorney since December 30, 1976. Respondent was admitted to practice law in Illinois on November 23, 1976, but he is no longer registered in that state. Respondent is an active member of The State Bar of California, where he was admitted on January 7, 1986.

## ***II. Dishonored Payments***

4. In 2014 and 2015, Respondent represented clients in patent cases before the USPTO, including the prosecution of patent applications. During this period, Respondent drafted and signed eight (8) checks to the USPTO for filing fees that were returned for insufficient funds. Respondent represents that none of the checks were written against his client trust account. Respondent has yet to repay the fees for three (3) of the dishonored checks, but he agrees to do so and to be placed on a six-month probation.

### **U.S. Patent Application No. [REDACTED]**

5. Respondent drafted and signed a check for \$200.00 for a Petition and Fee for Extension of Time Under 37 C.F.R. § 1.136(a) dated July 21, 2014, in U.S. Patent Application No. [REDACTED].

6. Respondent represents that no funds were paid in advance to him for the \$200.00 fee and that the funds came from his business operating account.

7. On August 8, 2014, the \$200.00 check was dishonored and returned for insufficient funds.

8. On August 28, 2015, Respondent informed the client in this matter that the check for USPTO fees had been dishonored and returned for insufficient funds.

9. Respondent has not yet repaid the \$200.00 fee but agrees herein to do so.

### **U.S. Patent Application No. [REDACTED]**

10. Respondent drafted and signed a \$900.00 check for a Petition and Fee for Extension of Time Under 37 C.F.R. § 1.136(a) dated July 30, 2014, for U.S. Patent Application No. [REDACTED].

11. Respondent represents that no funds were paid in advance to him for the \$900.00 fee and that the funds came from his business operating account.

12. On August 19, 2014, the \$900.00 check was dishonored and returned for insufficient funds.

13. On October 3, 2014, Respondent repaid the \$900.00 and paid the \$50.00 returned payment surcharge.

14. On August 28, 2015, Respondent informed the client in this matter that the initial check for USPTO fees had been dishonored and returned for insufficient funds.

**U.S. Patent Application No. [REDACTED]**

15. Respondent drafted and signed a check for \$700.00 for a Petition and Fee for Extension of Time Under 37 C.F.R. § 1.136(a) dated October 8, 2014, in U.S. Patent Application No. [REDACTED]
16. Respondent represents that no funds were paid in advance to him for the \$700.00 fee and that the funds came from his personal checking account.
17. On October 28, 2014, the \$700.00 check was dishonored and returned for insufficient funds.
18. On August 28, 2015, Respondent informed the client in this matter that the check for USPTO filing fees had been dishonored and returned for insufficient funds.
19. Respondent has not repaid the \$700.00 fee but agrees herein to do so.

**U.S. Patent Application [REDACTED]**

20. On March 30, 2015, Respondent drafted and signed a check for \$100.00 for an Extension of Time to Respond within the First Month in U.S. Patent Application No. [REDACTED]
21. Respondent represents that no funds were paid in advance to him for the \$100.00 fee and that the funds came from his business operating account.
22. On April 15, 2015, the \$100.00 check was dishonored and returned for insufficient funds.
23. On August 28, 2015, Respondent informed the client in this matter that the check for USPTO fees had been dishonored and returned for insufficient funds.
24. On November 24, 2015, Respondent repaid the \$100.00 for the Extension of Time to Respond and paid the \$50.00 returned payment surcharge.

**U.S. Patent Application No. [REDACTED]**

25. Respondent drafted and signed a check for \$400.00 for a Petition and Fee for Extension of Time in U.S. Patent Application No. [REDACTED] dated May 4, 2015.
26. Respondent represents that no funds were paid in advance to him for the \$400.00 fee and that the funds came from his business operating account.
27. On May 20, 2015, the \$400.00 check was dishonored and returned for insufficient funds.
28. On August 28, 2015, Respondent informed the client in this matter that the check for USPTO fees was dishonored and returned for insufficient funds.

29. Respondent has not repaid the \$400.00 fee but agrees herein to do so.

**U.S. Patent Application No. [REDACTED]**

30. On May 4, 2015, Respondent drafted and signed a \$435.00 check to cover the following in U.S. Patent Application No. [REDACTED]: basic filing fee, surcharge, search fee, and examination fee.

31. Respondent represents that he received funds from the client for the \$435.00 and deposited the funds into his client trust account. Respondent represents, however, that the \$435 check was drawn against his business operating account.

32. On May 21, 2015, the \$435.00 check was dishonored and returned for insufficient funds.

33. On July 2, 2015, Respondent drafted and signed a \$635.00 check to pay/repay the following: Extension of Time to Respond, basic filing fee, search fee, examination fee, surcharge, and returned check surcharge.

34. Respondent represents that no funds for filing fees (beyond the aforementioned \$435.00) were paid in advance by the client and that the \$635 check was drawn against his business operating account.

35. On July 10, 2015, the \$635.00 check was dishonored and returned for insufficient funds.

36. On August 10, 2015, Respondent repaid the \$635.00 and paid the \$50.00 returned payment surcharge.

37. On August 28, 2015, Respondent informed the client in this matter that the check for USPTO fees had been dishonored and returned for insufficient funds.

**U.S. Patent Application No. [REDACTED]**

38. Respondent drafted and signed a \$300.00 check for a Petition and Fee for Extension of Time in U.S. Patent Application No. [REDACTED], dated July 17, 2015.

39. Respondent represents that no funds were paid in advance to him for the \$300.00 fee and that the funds came from his business operating account.

40. On July 29, 2015, the \$300.00 check was dishonored and returned for insufficient funds.

41. On August 25, 2015, Respondent repaid the \$300.00 and paid the \$50.00 returned payment surcharge.

42. On August 28, 2015, Respondent informed the client in this matter that the check for USPTO fees had been dishonored and returned for insufficient funds.

### **III. Additional Considerations**

43. Respondent has no prior disciplinary history before the Office during the forty-one (41) years he has been registered as a patent practitioner.
44. Respondent voluntarily attended a Continuing Legal Education (“CLE”) course on running a small legal practice.

### **Joint Legal Conclusions**

45. Respondent acknowledges that, based on the information contained in the Joint Stipulated Facts above, his conduct violated the following provisions of the USPTO Rules of Professional Conduct:

- a. 37 C.F.R. § 11.103, which requires reasonable diligence and promptness in representing a client, by failing to timely pay fees to the Office for which the clients had instructed or had otherwise relied upon Respondent to pay; and
- b. 37 C.F.R. § 11.804(c), which proscribes engaging in conduct involving dishonesty, fraud, deceit or misrepresentation, and 37 C.F.R. § 11.804(i), which proscribes engaging in conduct that adversely reflects on the practitioner’s fitness to practice, by authorizing payments to the Office drawn on accounts containing insufficient funds, resulting in the payments being dishonored.

### **Sanction**

In light of the OED Director’s and Respondent’s entering into the Agreement, the OED Director’s recommendation, and the discussed mitigating factors, it is hereby determined that there is no genuine issue of material fact and that discipline of Respondent is appropriate.

ACCORDINGLY, Respondent has agreed, and it is **ORDERED** that:

- a. Respondent shall be, and hereby is, publicly reprimanded;
- b. Respondent shall serve a 6-month probationary period commencing on the date this Final Order is signed by the USPTO Director;
- c. Within the 6-month probationary period, Respondent shall make all remaining repayments for fees in U.S. Patent Application Nos. [REDACTED]; [REDACTED]; and [REDACTED];
- d. (1) in the event that the OED Director is of the opinion that Respondent, during the probationary period, failed to comply with any provision of the Final Order or any provision of the USPTO Rules of Professional Conduct, the OED Director shall:

A. issue to Respondent an Order to Show Cause why the USPTO Director should not order that Respondent be immediately suspended for up to ninety (90) days for the violations set forth in paragraph 45 above,

B. send the Order to Show Cause to Respondent at the last address of record Respondent furnished to the OED Director pursuant to 37 C.F.R. § 11.11(a), and

C. grant Respondent fifteen (15) days to respond to the Order to Show Cause;

and

(2) in the event that, after the fifteen-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 Final Order or any provision of the USPTO Rules of Professional Conduct, the OED Director shall:

A. deliver to the USPTO Director or his designee: (i) the Order to Show Cause, (ii) Respondent's response to the Order to Show Cause, if any, and (iii) evidence and argument causing the OED Director to be of the opinion that Respondent failed to comply with the Final Order or any provision of the USPTO Rules of Professional Conduct during the probationary period, and

B. request that the USPTO Director immediately suspend Respondent for up to ninety (90) days for the violations set forth in paragraph 45, above;

- e. The OED Director 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>;
- f. The OED Director to publish a notice materially consistent with the following Notice of Reprimand and Probation in the *Official Gazette*:

#### **Notice of Public Reprimand and Probation**

This notice concerns Roy A. Ekstrand of Costa Mesa, California, a registered patent attorney (Registration No. 27,485). The United States Patent and Trademark Office ("USPTO") has publicly reprimanded Mr. Ekstrand and placed him on probation for six (6) months for violating 37 C.F.R. § 11.103 (requiring reasonable diligence and promptness in representing a client), 37 C.F.R. § 11.804(c) (conduct involving dishonesty, fraud, deceit or misrepresentation), and 37 C.F.R. § 11.804(i)

(engaging in other conduct that adversely reflects on the practitioner's fitness to practice) of the USPTO Rules of Professional Conduct. Mr. Ekstrand is permitted to practice before the USPTO in patent, trademark, and other non-patent matters while on probation unless he is subsequently suspended or excluded by a Final Order of the USPTO Director.

In 2014 and 2015, Mr. Ekstrand submitted eight dishonored check payments to the USPTO on behalf of a number of clients. None of the checks were written against Mr. Ekstrand's client trust account. At the time of presentment of each payment, there were not sufficient funds held in the account from which the payment was drawn to cover the payment. The total amount of dishonored payments was \$3,670. Mr. Ekstrand has repaid five of the dishonored payments and has agreed to repay the remaining dishonored payments.

Factors reflected in the agreed upon resolution of this disciplinary matter include that Mr. Ekstrand has no prior disciplinary history before the Office during the 41 years he has been registered as a patent practitioner and that he voluntarily attended a CLE course on running a small legal practice.

This action is the result of a settlement agreement between Mr. Ekstrand and the OED Director pursuant to the provisions of 35 U.S.C. §§ 2(b)(2)(D) and 32 and 37 C.F.R. §§ 11.19, 11.26, and 11.59. Disciplinary decisions involving practitioners are posted for public reading at the Office of Enrollment and Discipline Reading Room accessible at: <http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>.


- g. If Respondent is suspended pursuant to the provisions of subparagraph d, above:
  - A. the USPTO shall promptly dissociate Respondent's name from all USPTO customer numbers and public key infrastructure ("PKI") certificates,
  - B. Respondent shall not use any USPTO customer number or PKI certificate unless and until he is reinstated to practice before the USPTO, and

C. Respondent may not obtain a USPTO customer number or a PKI certificate unless and until he is reinstated to practice before the USPTO;

- h. In the event that the USPTO Director suspends Respondent pursuant to subparagraph d, above, any review or appeal of the suspension shall not operate to postpone or otherwise hold in abeyance the suspension;
- i. Nothing in the Agreement or this Final Order shall prevent 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; (2) in any future disciplinary proceeding against Respondent (i) as an aggravating factor to be taken into consideration in determining any discipline to be imposed, and/or (ii) to rebut any statement or representation by or on Respondent's behalf; and
- j. 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.

MAR 14 2016

Date



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Nicolas F. Oettinger  
Acting 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