

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

In the Matter of)
)
Jerry A. Schulman,)
)
Respondent.) Proceeding No. D2016-02
)
_____)

FINAL ORDER

The Director of the Office of Enrollment and Discipline (“OED Director”) for the United States Patent and Trademark Office (“USPTO” or “Office”) and Jerry A. Schulman (“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 conclusion, and sanctions.

Jurisdiction

1. At all times relevant hereto, Respondent of Oakbrook Terrace, Illinois, has been a registered patent attorney (Registration No. 27,834) and subject to the USPTO Code of Professional Responsibility and the USPTO Rules of Professional Conduct.¹
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, 11.20, and 11.26.

Stipulated Facts

3. Respondent was registered as a patent attorney on December 15, 1975 (Registration Number 27,834).
4. Respondent was admitted to practice in the State of Illinois on November 6, 1973.
5. Respondent represented Client #1 before the Office in trademark matters.
6. Respondent filed a patent application on behalf of Client #1, but did not inform

¹ The events at issue in this matter occurred both before and after May 3, 2013. Therefore, the USPTO Code of Professional Responsibility and the USPTO Rules of Professional Conduct are applicable. *See* 37 C.F.R. §§ 10.20 through 10.112 and 37 C.F.R. §§ 11.101 through 11.901.

Client # 1 of important Office correspondence regarding the application; allowed the patent application to become abandoned without Client #1's knowledge or consent; did not inform Client #1 of the abandonment; failed to respond to Client #1's inquiries about the status of the application; and for a period of years, misrepresented the status of the patent application to the client.

7. Respondent represented Client #2 and Client #3 before the Office in three patent matters.

8. Respondent neglected the three patent matters; did not inform Clients #2 or #3 of important Office correspondence regarding the patent applications; failed to respond to Office communications; allowed the patent applications to become abandoned without Client #2 or #3's knowledge or consent; and did not inform Client #2 or #3 of the abandonments.

9. Respondent represented Client #4 in 17 patent matters and 19 trademark matters.

10. Respondent filed 17 patent applications and 19 trademark applications on behalf of Client #4; neglected the applications; did not inform Client #4 of important Office correspondence regarding the applications; failed to timely respond to Office communications; allowed the patent and trademark applications to become abandoned without Client #4's knowledge or consent; did not inform Client #4 of the abandonments; and misrepresented the status of the three patent applications to the client.

11. Respondent has no prior disciplinary history before the Office during the forty years he has been registered as a patent practitioner.

12. Respondent has expressed remorse.

13. Respondent has attempted to mitigate the harm to his clients by reviving some patent applications at his own expense.

14. Respondent fully cooperated with the Office of Enrollment and Discipline during the investigation of this matter.

Joint Legal Conclusions

15. Respondent acknowledges, based on the above stipulated facts, that he violated 37 C.F.R. §§ 10.23(a) and (b) via 10.23(c)(8) (proscribing failure to inform a client of important Office correspondence when the correspondence (i) could have a significant effect on a matter pending before the Office, (ii) was received by the practitioner on behalf of a client or former client, and (iii) was such that a reasonable practitioner would believe under the circumstances that the client or former client should be notified) by not informing his clients of important Office correspondence that Respondent received in connection with their patent and trademark applications.

16. Respondent acknowledges, based on the above stipulated facts, that he violated 37 C.F.R. § 10.23(b)(4) (proscribing conduct involving dishonesty, fraud, deceit, or misrepresentation) by failing to inform Client #1 of the actual status of her patent application and making misrepresentations to her regarding the status of the application.

17. Respondent acknowledges, based on the above stipulated facts, that he violated 37 C.F.R. §§ 10.23(a) and (b) via 10.23(c)(2)(i) (proscribing knowingly giving false or misleading information to a client in connection with business before the Office) by falsely informing Client #1 that her application was proceeding normally when it had been abandoned.

18. Respondent acknowledges, based on the above stipulated facts, that he violated 37 C.F.R. § 10.77(c) (proscribing neglect of legal matters entrusted to a practitioner) by allowing patent and trademark applications to become abandoned without his clients' knowledge or consent.

19. Respondent acknowledges, based on the above stipulated facts, that he violated 37 C.F.R. § 10.84(a)(1) (proscribing failing to seek the lawful objectives of the client and prejudicing or damaging a client during the course of a professional relationship) by failing to respond to Office correspondence in a timely manner and allowing patent and trademark applications to become abandoned without his clients' knowledge or authority.

20. Respondent acknowledges, based on the above stipulated facts, that he violated 37 C.F.R. §§ 11.101 and 11.103 (failure to provide competent representation and to act with reasonable diligence and promptness in representing a client) by failing to promptly reply to Office correspondence and allowing patent and trademark applications to become abandoned without his clients' knowledge or authority, after May 3, 2013.

21. Respondent acknowledges, based on the above stipulated facts, that he violated 37 C.F.R. §§ 11.104(a)(2) and (a)(3) (failure to reasonably consult with the client about the means by which the client's objectives are to be accomplished and failure to keep the client reasonably informed about the status of a matter) by not informing Client #4 about a notice of abandonment issued after May 3, 2013.

22. Respondent acknowledges, based on the above stipulated facts, that he violated 37 C.F.R. § 11.804(c) (engaging in conduct involving dishonesty, fraud, deceit, or misrepresentation), by providing false information regarding the status of three patent applications to Client #4.

Agreed Upon Sanction

23. Respondent agrees and it is hereby ORDERED that:

- a. Respondent is suspended from practice before the Office in patent, trademark, and other non-patent matters for two (2) years commencing on the date this Final Order is signed;

- b. Respondent shall remain suspended from practice before the Office in patent, trademark, and other non-patent matters until the OED Director grants a petition requesting Respondent's reinstatement pursuant to 37 C.F.R. § 11.60;
- c. Respondent is granted limited recognition to practice before the Office commencing on the date the Final Order is signed and expiring sixty (60) days after the date the Final Order is signed, with such limited recognition being granted for the sole purpose of facilitating Respondent's compliance with the provisions of 37 C.F.R. § 11.58(b);
- d. Respondent shall comply with 37 C.F.R. § 11.58;
- e. The OED Director shall comply with 37 C.F.R. § 11.59;
- f. The USPTO shall promptly dissociate Respondent's name from all USPTO Customer Numbers and Public Key Infrastructure ("PKI") certificates;
- g. Respondent shall not apply for or obtain a USPTO Customer Number unless and until he is reinstated to practice before the USPTO;
- h. The OED Director electronically publish the Final Order at OED's electronic FOIA Reading Room, which is publicly accessible at:
<http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>;
- i. The OED Director publish a notice in the *Official Gazette* that is materially consistent with the following:

Notice of Suspension

This notice concerns Jerry A. Schulman of Oakbrook Terrace, Illinois, a registered patent attorney (Registration No. 27,834). The United States Patent and Trademark Office ("USPTO" or "Office") has suspended Mr. Schulman from practice before the Office in patent, trademark, and non-patent matters for two years for violating 37 C.F.R. §§ 10.23(a) and (b) via 10.23(c)(8) (proscribing failure to advise a client of important Office correspondence); 10.23(b)(4) (proscribing conduct involving dishonesty, fraud, deceit, or misrepresentation); 10.23(a) and (b) via 10.23(c)(2)(i) (proscribing knowingly giving false or misleading information to a client in connection with business before the Office; 10.77(c) (proscribing neglect of legal matters entrusted to a practitioner); 10.84(a)(I) (proscribing failing to seek the lawful objectives of the client and prejudicing or damaging a client during the course of a professional relationship); 11.101 and 11.103 (failure to provide competent representation and to act with reasonable diligence and promptness in representing a client);

11.104(a)(2) and (a)(3) (failure to reasonably consult with the client about the means by which the client's objectives are to be accomplished and failure to keep the client reasonably informed about the status of a matter); and 11.804(c) (engaging in conduct involving dishonesty, fraud, deceit, or misrepresentation).

Mr. Schulman allowed multiple patent and trademark applications to go abandoned without his clients' knowledge or consent and failed to communicate with his clients. Additionally, he made misrepresentations to two different clients about the status of their patent applications.

In mitigation, the OED Director considered the following: (i) Mr. Schulman has no prior disciplinary history before the Office during the 40 years he has been registered as a patent practitioner; (ii) Mr. Schulman has expressed remorse; (iii) Mr. Schulman has attempted to mitigate the harm to his clients by reviving some patent applications at his own expense; and (iv) Mr. Schulman fully cooperated with the Office of Enrollment and Discipline during the investigation of this matter.

This action is the result of a settlement agreement between Mr. Schulman 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, 11.20, and 11.26. Disciplinary decisions involving practitioners are posted for public reading at the OED Reading Room, available at: <http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>;

- j. Nothing in this Agreement or the Final Order shall prevent the Office from considering the record of this disciplinary proceeding, including the 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/or (3) in connection with any request for reconsideration submitted by Respondent pursuant to 37 C.F.R. § 11.60; and
- 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.



SARAH HARRIS
General Counsel
United States Patent and Trademark Office

4/13/16

Date

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

Jerry A. Schulman
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