

**BEFORE THE UNDER SECRETARY OF COMMERCE  
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE  
UNITED STATES PATENT AND TRADEMARK OFFICE**

**In the Matter of** )  
 )  
 **Louis A. Piccone,** )  
 )  
 **Appellant.** )  
 \_\_\_\_\_ )

Proceeding No. D2015-06

**Final Order**

Pursuant to 37 C.F.R. § 11.55, Louis A. Piccone (“Appellant”) has appealed the June 16, 2016 Initial Decision of Administrative Law Judge (“ALJ”) Susan L. Biro in this matter to the Director of the United States Patent and Trademark Office (“USPTO” or “Agency”). In that Initial Decision, the ALJ concluded that Appellant violated the following provisions of the Code of Professional Responsibility: 37 C.F.R. §§ 10.23(a) (prohibiting disreputable or gross misconduct) (A.33, A.35, A.39, A.42, A.53); 10.23(b)(4) (prohibiting conduct involving dishonest, fraud, deceit, or misrepresentation)(A.34, 35); 10.23(b)(5)(prohibiting conduct that is prejudicial to the administration of justice) (A.34, A.35, A.39, A.42, A.53; A.60); 10.77(b) (prohibit handling a legal matter without preparation adequate in the circumstances) (A.35); 10.77(c) (prohibit neglecting a legal matter entrusted to the practitioner) (A.53, A.60); 10.84(a)(1) (a practitioner shall not intentionally fail to seek the lawful objectives of a client through reasonably available means permitted by law and the Disciplinary Rules) (A.35). The ALJ also concluded that Appellant violated the following USPTO Rules of Professional Conduct: 37 C.F.R. § 11.505 (Unauthorized Practice of Law) (A.21, A.24, A.42, A.48). After considering these violations and the relevant factors under 37 C.F.R. § 11.549(b), the ALJ ordered that a three (3) year suspension from the practice before the USPTO. (A.68).

In this appeal, briefs have been submitted by Appellant and the Director of the USPTO Office of Enrollment and Discipline (“OED Director”). For the reasons set forth below, the USPTO Director<sup>1</sup> affirms the ALJ’s initial decision.

## I. FINDINGS OF FACT

### Background

1. Appellant was admitted to the bar of the Commonwealth of Pennsylvania on June 15, 1989. (A.4821).
2. He registered as a patent attorney before the USPTO on August 12, 1997. (A.3171).
3. Appellant submitted multiple documents in cases in Illinois, Massachusetts, and New Hampshire where it indicated that his *pro hac vice* admissions were pending. (A.3372; A.3841-2, A.3814-42; A.3855-78).
4. For various periods of time on three occasions between 2011 and 2014, Appellant was administratively suspended by the Pennsylvania bar for not satisfying his continuing legal education (“CLE”) requirements or not paying his bar dues. (A.3174-3175).
5. Around 2004 or 2005, Appellant moved to Massachusetts. (Tr. at 417-18).
6. In January 2008, while living in Massachusetts, Appellant was charged with felony kidnapping following allegations of child abuse. (A.3806; Tr. 30). He was incarcerated between mid-February 2008 and mid-March 2008 and was then placed under house arrest. (A.3806; Tr. at 402, 420). The charges were later dismissed but the apparent impacts from them included the

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<sup>1</sup> The regulations at 37 C.F.R. § 11.1 define “USPTO Director” to mean “the Director of the United States Patent and Trademark Office, or an employee of the Office delegated authority to act for the Director of the United States Patent and Trademark Office in matters arising under this part.” By Delegation of Authority No. 06-01 dated October 4, 2006, the Undersecretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office delegated to the General Counsel the authority to “exercise, pursuant to 35 U.S.C. § 3(a), the discretion reserved to the Undersecretary and Director in Parts 10 and 11 of 37 C.F.R.”

fact that Appellant's wife left Massachusetts for Russia in early 2008 and, he claims, that she has refused to come back to the United States. (A.6; Tr. at 402, 420).

7. Appellant began to maintain a second residence in Canada, but he and his wife still owns their house in Massachusetts, Appellant still carries a Massachusetts driver's license, and he continued to use his Massachusetts address in his Massachusetts Bar application and various legal proceedings in which he purported to represent clients, including most of the proceedings at issue in this disciplinary matter. (Tr. at 421-22; A.2337, A.2405, A.2478; A.2764; A.2799; A.2810; A.2829; A.2863; A.2922; A.2940; A.2949-2951; A.2999).

8. After the filing and subsequent dismissal of the criminal charges against him, Appellant began representing people all around the country, "shift[ing] the majority of the focus of [his] practice to civil rights cases." (Tr. at 412, 419).

#### **Practice in Massachusetts**

9. Although he lived and practiced in Massachusetts for several years, Appellant was not and is not a member of that state's bar. He applied for admission on motion on November 17, 2010. (A. 3027-3076; A.4056; A.4068).

10. The Board of Bar Examiners denied Appellant's application in a letter dated February 21, 2012. (A.3013; A.4059-4060). The Board "concluded that [Appellant's] constant private practice in Massachusetts after May 2006 was unauthorized (and therefore illegal) (i) as he was not admitted to the Massachusetts bar at any point and (ii) as at least two well-respected judges (one state and one federal) located in Massachusetts had concluded that the [Appellant's] Massachusetts legal practice was both unauthorized and improper." (A.4959-4960). In the decision by the U.S. Magistrate Judge Kenneth P. Neiman of the U.S. District Court, District of Massachusetts, the court denied Appellant's request for admission *pro hac vice* in *Sheryl Pease*,

*et al. v Karen Burns, et al.*, 679 F.Supp.2d 161 (D. Mass 2010) based on several prior matters<sup>2</sup> where Appellant engaged in the unauthorized practice of law. (A.3053-3057). In the decision by Judge Richard A. Simons of the Berkshire County Probate and Family Court, the court vacated a prior decision to allow Appellant to practice *pro hac vice* in *In the Matter of the Estate of Jason Michael Litchfield*, Docket No. 02P-0585AD, due to Appellant's initiation of ten lawsuits in Massachusetts without having sought admission to the Massachusetts Bar. (A3065).

11. Appellant appealed the Board's decision on but the appeal was denied without hearing on March 26, 2014, by Massachusetts' Supreme Judicial Court. (A.3013; A.4054).

### **Practice in Illinois**

12. On June 22, 2011, Respondent signed and filed the complaint in *Hankins v. Burton*, No. 4:11-cv-04048-SLD-JEH (C.D. Ill.). (A.2405; A.2421-36; A.5688). Below Appellant's electronic signature, the complaint states "Attorney for Plaintiff" and "Pending Admission *Pro Hac Vice*." (A.2436; Tr. at 295).

13. Respondent had not submitted a petition to be admitted *pro hac vice* prior to filing the complaint. (Tr. at 297-298).

14. On June 23, 2011, the Illinois District Court sent Appellant the paperwork necessary to seek *pro hac vice* admission, but Respondent never submitted the necessary motion. (Tr. at 298). On October 11, 2011, the Court entered an Order directing "Plaintiff or Plaintiff's Attorney to comply" with the Court's *pro hac vice* admission requirements, "or the case will be dismissed with prejudice." (A.3345; Tr. at 299). Despite the October 11, 2011, Order, Appellant

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<sup>2</sup> For example, in *Babeu v. Linker*, Civil Action No. 08-30127-MAP ("Babeu I") Appellant signed the complaint "pending admission pro hac vice" but failed to file a formal motion with the court. In *Babeu v. Linker*, Civil Action No. 09-30045-MAP ("Babeu II") Plaintiff filed a substantially similar complaint that was previously rejected, with the Appellant's assistance. In *Hohn v. Burke*, Civil Action No. 09-30143-MAP Plaintiff submitted a complaint pro se but indicated that it was "prepared with the aid of Louis A. Piccone, Esq.," who is "[a]dmitted in Pa and Patent Bar Only" and living in "Dalton, MA."

did not submit a motion to be admitted *pro hac vice*. (Tr. at 299-300). Instead, on October 24, 2011, the plaintiff in *Hankins* filed a “Notice of Pro Se Status” to “advise[] the court that she will proceed Pro Se, pending finding an attorney capable of representing her.” (A.2437; A.3345).

15. Despite the plaintiff’s notice of pro se status, despite the Court’s Order to comply with its *pro hac vice* requirements, and despite the subsequent suspension of his license by the Pennsylvania bar, Appellant testified that he continued to advise and represent the plaintiff in *Hankins*. (Tr. at 301-302).

16. On March 12, 2014, the Court in *Hankins* adopted a magistrate judge’s denial of entry of default against the sole remaining defendant and granted the defendant’s motion to dismiss. (A.2438-51). A Notice of Appeal from the Court’s order granting dismissal was filed on April 14, 2014. (A.2452-56). Although signed by the plaintiff, the Notice also contained the notation “THIS PLEADING PREPARED WITH THE AID OF LOUIS A. PICCONE.” (A.2455). Appellant conceded he assisted the plaintiff with her case by preparing the notice of appeal while he was not authorized to practice law by Pennsylvania and not admitted *pro hac vice* to the Central District of Illinois. (Tr. at 302-303).

#### **Practice in Iowa**

17. On February 28, 2014, while Appellant was administratively suspended by the Pennsylvania bar, a complaint was filed in the District Court for the Northern District of Iowa in an action styled *Nunley v. Erdmann*, No. 5:14-cv-04016-LTS (N.D. Iowa). (A.2594-2615). Although the plaintiff Nunley signed the complaint pro se, plaintiff testified at a deposition that Appellant wrote the complaint. (A.2615; A.3672, A.3692-93, A.3714-15).

### **Practice before the USPTO**

18. Appellant practiced before the USPTO as a trademark attorney and as the attorney-of-record for Lawless America Association. (A.3179). Appellant filed Trademark Application No. 85871932 on March 9, 2013, for the mark "Lawless America." (A.3176-3187; A.3264; Tr. at 255-256). Appellant is identified as the attorney-of-record and correspondent for the application. (A.2342-2343; Tr. at 257-258). At the time, Appellant was authorized to practice law based on his active license in Pennsylvania. (Tr. at 253, 255-56).

19. On June 27, 2013, the USPTO sent an Office Action concerning the Lawless application at Appellant's email address, requiring a response to the Office Action within six months of the date it was sent. (A.2348-2351; Tr. at 259-260, 412). A second Office Action followed on August 15, 2013, again sent to Appellant's email address and requiring a response within six months of the date it was sent. (A.2360-2365; Tr. at 260). Appellant sent a draft of a Response to Office Action to Mr. Windsor on February 12, 2014. (A.3303-3304; A.3309-3311). Appellant "participated heavily in the drafting" of the Response to Office Action filed on behalf of Mr. Windsor on February 18, 2014. (Tr. at 265, 273). Mr. Windsor did not draft the response. (A.3000). The draft contained both legal analysis and argument. (A.2366-2368). Appellant also remained the attorney-of-record at the time the Response to Office Action was submitted. (Tr. at 287). Further, the USPTO continued to send documents to him. (A.2382-2388; Tr. at 410-412).

### **OED Disciplinary Proceeding**

20. On December 11, 2013, the OED Director opened an investigation into alleged misconduct by Mr. Piccone. (Tr. at 82-83)

21. The OED Director sent Appellant four (4) Requests for Information during the investigatory phase of the matter. (A.3556-3566 (October 27, 2014); A.4118-4123 (Feb. 19, 2014); A.4124-4134 (April 9, 2014); A.4137-4162 (June 25, 2014)).

22. Ultimately, on December 10, 2014, the OED Director issued a Complaint and Notice of Proceedings against Appellant under 35 U.S.C. § 2(b)(2)(D), § 32, and 37 C.F.R. §§ 11.32, 11.34. (A.84-111).

23. In the Complaint, the Appellant is charged with nine counts of professional misconduct through violations of the USPTO Code of Professional Responsibility (“PTO Code”), 37 C.F.R. §§ 10.20-10.112, and the USPTO Rules of Professional Conduct (“PTO Rules”), 37 C.F.R. §§ 11.101 through 11.901.2. (A87-108). Count 1 stems from Appellant’s practice before the USPTO while his Pennsylvania law license was suspended (A.87-89); Counts 2 to 5 and 7 to 9 arise out of Appellant’s conduct in various federal district courts where he attempted to represent plaintiffs in civil rights cases (A.89-96; A.102-108); and Count 6 involves Appellant’s inadequate representation of a plaintiff in a contract dispute. (A.97-102).

24. After he was granted an extension of time to file his Answer, (A.116), Appellant filed four (4) pre-Answer motions on January 16, 2015,<sup>3</sup> seeking various forms of relief, such as to dismiss the case and to declare the matter a “contested” case. (A.118-133). The ALJ denied these motions on February 3, 2015. (A.159-166).

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<sup>3</sup> The four motions filed by Appellant were: 1) Respondent Louis A. Piccone’s Motion to [sic] Allow the Filing of a Motion to Dismiss Prior to the Filing of an Answer; 2) Respondent Louis A. Piccone’s Motion to Declare Matter Contested Case; 3) Respondent Louis A. Piccone’s Motion to [sic] Deny Any Leave to Amend the Complaint Against Respondent to Include Additional Charges of Professional Misconduct Arising From Matters Which the USPTO has Already Had the Opportunity to Investigate *and* Which Could Have Been Brought in the Complaint Already Filed; and 4) Respondent Louis A. Piccone’s Motion to Order the Patent and Trademark Office to Issue Him a Password So That He May Change His Address.

25. Appellant filed his Answer to the Complaint on February 9, 2015, denying liability for all violations and raising twenty affirmative defenses. (A.167-177).

26. On February 9, 2015, Appellant also filed "Respondent Louis A. Piccone's Motion to Dismiss All Counts of the December 10, 2014, Complaint." (A.178-181). In support of his motion, among the many arguments argued by Appellant, he alleges that the Complaint was invalid because the Deputy OED Director improperly signed the complaint rather than the OED Director, who was allegedly the only person with the authority to sign a complaint initiating disciplinary charges. (A.179). On March 3, 2015, the ALJ denied Appellant's motion based on a declaration signed by the OED Director supporting his Deputy's authority to sign for him in this case. (A.259-262). The ALJ concluded that the Deputy was not exercising his own authority, but rather "signed the complaint *on behalf of* Director Covey, and thereby sought to -- and did -- indicate the Director's approval of this exercise of the Director's own, uncontested, authority." (A.260).

27. On March 12, 2015, Appellant submitted "Respondent Louis A. Piccone's Motion for the Administrative Law Judge to Reconsider Her March 3, 2015, Decision to Deny Respondent's Motion to Dismiss Allcounts [sic] of the December 10, 2014 Complaint." (A.278-290). In that motion, Appellant again argued that the Deputy OED Director improperly signed the complaint due to lack of authority. (A.384). On March 26, 2015, the ALJ entered an "Order Denying Respondent's Motion for Reconsideration" (A.382-388) that again denied Appellant's argument due to lack of newly discovered evidence or manifest errors of law or fact. (A.385-386).

28. On March, 12, 2015, Appellant submitted "Respondent Louis A. Piccone's Motion for Discoveryrelating [sic] To The Attendance of Witnesses and To The Production Of Documents And An Extension Of Time On All Deadline In The Scheduling Order," (A.291-294), and



“Respondent Louis A. Piccone’s Motion For Discoveryrelating [sic] To The Attendance Of Witnesses, To The Production Of Documents, And To Responses To Interrogatories.” (A.295-302). On March 20, 2015, the ALJ entered an “Order Denying Appellant’s Motion for an Extension of Time to File Answer [sic] and Motion For Discovery Relating to the Attendance of Witnesses, to the Production of Documents, and to Responses to Interrogatories” (A.361-365), which found that prior to the parties’ exchange of their respective Prehearing Statements, a request of additional discovery is not reasonable. (A.364).

29. On March 17, 2015, Appellant submitted “Motion to Dismiss All Charges of Misconductfor [sic] Want to Territorial and/or Subject Matter Jurisdiction.” (A.340-349), which argued that the USPTO had no jurisdiction to hear the matter because he was “outside of the territorial boundaries of the United States and outside of the territorial boundaries of the United States Patent and Trademark Office (USPTO) to enforce it’s [sic] regulations” during the time when he allegedly provided aid to the pro se litigant. (A.341). On March 20, 2015, in “Order Denying Motion to Dismiss All Charged of Miscondcutfor [sic] Want of Territorial and/or Subject Matter Jurisdiction.” (A.351-354), the ALJ denied the Motion finding that subject matter jurisdiction exists pursuant to an Interagency Agreement whereby the USPTO Director appointed the ALJ as the hearing officer in the disciplinary proceeding. (A.352). Also, the ALJ found that personal jurisdiction exists because the Appellant’s registered status and practice before the USPTO establishes more than the necessary minimum contacts with the USPTO, and thus the ALJ. (A.352).

30. On April 24, 2015, Appellant filed “Respondent Louis A. Piccone’s Renewed Motion for Discoveryrelating [sic] To The Attendance Of Witnesses, To the Production of Documents, and to Responses to Interrogatories.” (A.646-653). On May 4, 2015, the ALJ entered “Order Denying

Respondent's Renewed Motion for Discovery Relating to the Attendance of Witnesses, to the Production of Documents, and to Responses to Interrogatories" (A.973-976), which again denied Appellant's attempt to conduct discovery because it did not detail how the discovery sought is reasonable and relevant, and would unduly burden the OED Director to fully comply with the request. (A.976).

31. On May 7, 2015, Appellant filed an Amended Answer. (A.988-1002).

32. By Order dated June 5, 2015 issued by the ALJ, all of Appellant's affirmative defenses, except for his statute of limitations defense, were stricken from the record. (A.1202-1211).

33. On August 25, 2015, the Tribunal granted Appellant's motion for additional time to conduct discovery in support of his statute of limitations defense. (A.1351-1358). This allowed Respondent to depose Marilyn J. Wellington, an official from the Massachusetts Board of Bar Examiners (A.1540-1677) and to submit an interrogatory to the OED Director. (A.1320-1331). The OED Director answered the interrogatory on September 15, 2015 (A.1370-1374), and, following the Tribunal's order granting Appellant's motion to compel (A.1465-1469), on October 9, 2015. (A.1678-1690).

34. On October 7, 2015, the OED filed "OED Director's Motion In Limine" requesting that the ALJ refuse the admission of any evidence obtained as a result of a seven subpoenas for the testimony of several USPTO employees. (A.1474-1480). The Appellant opposed the Motion In Limine on October 9, 2015, and filed "Opposition to the OED Director's Motion in Limine And/Or Request for Reconsideration" (A.1691-1694), which the ALJ construed as a motion for reconsideration because it had already ruled on the OED Director's Motion. The ALJ denied Appellant's October 9, 2015, request for reconsideration (A.1695-1698) because Appellant made no attempt to comply with the requirement under 37 C.F.R. § 11.38 to obtain from the

Tribunal permission to subpoena for hearing his proposed witnesses, and would have required Appellant to show that the testimony of the witnesses sought would be material and relevant to disputed issues in the proceeding. (A.1696).

35. On October 13-14, 2015, the hearing in this matter was held in Washington, D.C. (A.3).

36. Appellant (A.2015-2164) and the OED Director (A.1822-1866) filed their initial post-hearing briefs on January 22, 2016. The OED Director timely filed his reply brief on February 19, 2016. (A.2165-2189). Appellant missed the deadline for filing his reply brief. He eventually filed the document on February 29, 2016. (A.2195-2260). Nothing further was filed thereafter, and the record closed with that filing.

37. After a hearing, the ALJ issued a decision on June 16, 2016. (A.1-70).

## **II. INITIAL DECISION BY ADMINISTRATIVE LAW JUDGE AND APPEAL**

On June 16, 2016, the ALJ issued an Initial Decision and Order in Proceeding No. D2015-06. (A.1-A.70). That decision exhaustively detailed the procedural background of the disciplinary proceedings, made detailed findings of fact, and issued conclusions of law with regard to the 9 counts of professional misconduct set forth in the disciplinary complaint. (*Id.*) In sum, the ALJ concluded that Appellant engaged in a pattern of misconduct that violated multiple provisions of the PTO Code and the PTO Rules<sup>4</sup> when he engaged in the unauthorized practice of law, failed seek or adhere to *pro hac vice* admission standards, failed to comply with court orders, neglected client matters, and made false statements to the court. As a result of these violations, and after considering the relevant factors under 37 C.F.R. § 11.54(b), the ALJ ordered that Appellant should be suspended for a period of three (3) years from practice before the USPTO. (A.68).

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<sup>4</sup>Effective May 3, 2013, the USPTO Rules of Professional Conduct, 37 C.F.R. §§ 11.101 through 11.901, apply to persons who practice before the Office. Prior to May 3, 2013, the USPTO Code of Professional Responsibility applied to persons practicing before the Office. *See* 37 C.F.R. §§ 10.20-10.112.

On July 26, 2016, Appellant filed a pleading entitled “Mr. Louis A. Piccone’s Appeal of the ALJ’s Initial Decision of June 21, 2016.” In response, on September 7, 2016, the OED Director filed the “OED Director’s Emergency Motion For The USPTO Director To Refuse the Entry of Respondent’s Non-Conforming Brief, Or In The Alternative, To Enlarge The Page Limit.” (“Emergency Motion”). In that Emergency Motion, the OED Director alleged multiple grounds on which the Appellant Brief failed to conform to the minimum requirements for such filings, as set forth in the Agency’s regulations at 37 C.F.R. § 11.55. *See* Emergency Motion, at 2-6.

On September 8, 2016, the OED Director’s Emergency Motion was granted. *See* Order dated Sept. 8, 2016, at 1. Appellant’s non-conforming brief was stricken from the record and he was permitted to file another brief that complied with the Agency’s regulations. *See id.* A new briefing schedule was also set that ordered submission of Appellant Brief’s in accordance with the requirements set forth at 37 C.F.R. § 11.55 by no later than October 10, 2016. *See id.* Appellant’s September 12, 2016, Petition for Reconsideration of this Order was denied by the ALJ. *See* Order dated Sept. 16, 2016, at 3-4.

On October 10, 2016, Appellant submitted his Amended Appeal Brief. However, on October 31, 2016, the OED Director requested leave to file a “Motion to Strike Respondent’s Appeal Brief” (“Second Motion to Strike”), asking the Director to refuse entry of Appellant’s Amended Appeal Brief. On November 2, 2016, Appellant opposed the OED Director’s request and motion. The OED Director’s “Second Motion to Strike” was granted on November 23, 2016 and Appellant’s July 26, 2016 Appellant’s Brief was not entered. *See* Order dated November 23, 2016, at 4-5. Appellant was ordered to file Appellant Brief’s in strict accordance with the requirements set forth at 37 C.F.R. § 11.55, by no later than December 16, 2016. *See id.*

On November 25, 2016, Appellant filed “Mr. Louis A. Piccone’s Third Amended Appeal of the ALJ’s Initial Decision of June 16, 2016” (“Third Amended Appeal Brief”). On December 22, 2016, the OED Director filed “Brief for Director of the Office of Enrollment and Discipline.” Appellant’s Reply was filed on January 4, 2017.

### III. DECISION

Appellant has been a registered patent attorney since August 12, 1997. (A.3171). As such, he is subject to the disciplinary authority of the Office. 37 C.F.R. § 11.19(a). For the conduct involved in this disciplinary case, Appellant was subject to the ethical requirements set forth in both the PTO Code and the PTO Rules. Violations of the PTO Code or PTO Rules must be proven by clear and convincing evidence. *See* 37 C.F.R. § 11.49; *see also Johnson*, PTO Proceeding No. 2014-12, at 2 (Dec. 31, 2015) (Initial Decision).

USPTO regulations permit a party to appeal an ALJ’s initial decision to the USPTO Director within thirty days (30) of issuance of the initial decision. *See* 37 C.F.R. § 11.55(a). *See also* 35 U.S.C. § 2(b)(2)(d). On appeal, the USPTO Director has authority to conduct a *de novo* review of the factual record and may affirm, reverse, or modify the initial decision, or remand the matter to the hearing officer for such further proceedings as the USPTO Director may deem appropriate. *See* 37 C.F.R. §§ 11.55(f), 11.56(a).

Here, Appellant appeals from the June 16, 2016 initial decision of the ALJ entering judgment in favor of the Agency and suspending Appellant from the practice of patent, trademark, and other non-patent matters before the Office for three (3) years. In his Third Amended Appeal Brief, Appellant identified fifty-three (53) “disputed points of law” that he contends exist in ALJ’s initial decision. He also challenges the sanction imposed by the ALJ.

The Director, having considered Appellant's Third Amended Appeal Brief, the OED Director's response brief, Appellant's reply brief, as well as the record of the proceedings before the ALJ, finds that there is ample factual and legal support for the ALJ's initial decision. Consequently, the initial decision of the ALJ is **AFFIRMED**.

**A. Initial Appeal Issues**

**1. Appellant's Appeal Brief and Reply Fail to Comply with the USPTO Filing Rules.**

The regulations at 37 C.F.R. §11.55 set forth the mandatory filing requirements for appeal filings submitted to the Director. These requirements include directing all appeal briefs to comply with the substantive requirements found in FRAP Rules 28(a)(2), (3), and (5) through (10) and 32(a)(4) through (6). *See* 37 C.F.R. §11.55(c) and (d). These rules require that appeal briefs, among other things, contain "appellant's contentions and the reasons for them, with citations to the authorities and parts of the record on which the appellant relies," and for each issue, "a concise statement of the applicable standard of review." *See* FRAP 28(a)(8).

Appellant's Third Amended Appeal Brief was, as is apparent from the title of the pleading and as set forth at pages 11-12 of this Order, his third attempt to file an appeal brief that complied with the USPTO's requirements under 37 C.F.R. § 11.55. *See* Orders dated September 8, 2016 and November 23, 2016.

Appellant's first brief was filed on July 26, 2016. On September 8, 2016, in response to a motion filed by the OED Director, the USPTO Director struck that appeal brief, upon motion from the OED Director and on the basis that the brief did not conform to the filing requirements. *See* Order dated September 8, 2016. Specifically, that Order accepted the arguments of the OED Director that the appeal brief failed to conform to the USPTO's substantive filing requirements when the appeal brief was filed without a statement of fact or law, without any table of contents

or table of authorities, without a statement of the issues, without a statement of the case, without an argument summary, and without any citations of authority. *Id.*; *see also* Emergency Motion, at 4. In addition, the Order summarily accepted the OED Director's identification of various procedural requirements as to the form of the appeal brief, including type size and exceeding the page limit. *See* Order dated Sept. 8, 2016; Emergency Motion, at 4.

Appellant then filed an Amended Appeal Brief on October 10, 2016. Again, the OED Director requested leave to file a "Motion to Strike Respondent's Appeal Brief", asking the Director to refuse entry of Appellant's Amended Appeal Brief. *See* Second Motion to Strike, at 3-7. In doing so, the OED Director cited to numerous places where the Amended Appeal Brief again failed to comply with the substantive filing requirements under 37 C.F.R. § 11.55. These deficiencies included Appellant's incorporation by reference the entirety of the more than 5,700 pages of the administrative record, Appellant's failure to specifically cite to the record so that his claims may be properly identified, and a wholesale failure to specify which facts and issues of law that Appellant disagrees with, as well as a failure to supply the authorities and parts of the record on which Appellant relied in support of his contentions. *See* Second Motion to Strike at 3-4. The OED Director characterized the Appellant's non-conforming brief as "willful" since his initial appeal brief had been stricken from the record for failing to satisfy the requirements set forth in § 11.55. *See* Second Motion to Strike at 7-8. Appellant opposed the motion.

On November 23, 2016, the Director issued an order on the Second Motion to Strike, again concluding that Appellant's Amended Brief failed to comply with many of the USPTO's filing requirements, including Federal Rules of Appellate Procedure ("FRAP") Rule 28(a)(6)-(8). *See* Order dated Nov. 23, 2016, at 3. For example, although Appellant's Amended Brief identified 59 issues in his brief, many of the arguments did

not address a legal issue but instead merely made brief, conclusory statements of fact without any citations to the administrative record. *Id.* Further, the remaining legal issues lacked any substantive arguments of merit and/or were not supported in any way. *Id.* The Amended Appeal Brief was thus found to lack any substantive legal analysis of the issues presented, which made it impossible to evaluate the merits of his appeal. *Id.* at 3-4.

Despite this holding, however, the Director afforded Appellant a third opportunity to file an appeal brief that “strictly complies with all of the Agency’s filing requirements, to include the incorporated Federal Rules of Appellate Procedure. *See* Order dated Nov. 23, 2016, at 4-5. (emphasis in original). Appellant was also warned that “[the] filing requirements will not be waived.” *Id.* at 5.

Despite being on notice of the filing requirements, Appellant submitted his Third Amended Appeal Brief that contains the same substantive flaws as the two initially filed, and previously stricken, briefs. It is comprised of 53 separate challenges to the ALJ’s opinion, most of which contain no substantive discussion or legal analysis. Most of the challenges are comprised only of a short paragraph, and some are comprised of two or three sentences. There are no citations to the administrative record as Appellant merely disputes the facts “contained in the record before the ALJ.” *See* Third Amended Appeal Brief, at 5. Similarly, the document contains virtually no legal citations. Appellant’s arguments are fairly characterized as conclusory statements of his belief and general denials. These flaws are significant, substantive, and make any meaningful review of his appeal difficult. These flaws are especially significant given his prior notice of the filing requirements, the fact that these types of flaws were identified as bases on which to strike his prior filings, and the fact that he was advised of the need to strictly comply with the filing requirements in this third brief. Thus, it is concluded that Appellant’s failure to, for a third time,



file an appeal brief that complies with the USPTO's substantive filing requirements provides an independent basis for rejecting all of Appellant's arguments and, thus, his appeal.<sup>5</sup>

Despite this conclusion, Appellant asserted more than a conclusory argument with regard to several issues in his Third Amended Brief. Thus, although those arguments are unsatisfactory under the filing rules, the substance of those issues will be further addressed further below.

## 2. The USPTO Has Disciplinary Jurisdiction Over the Appellant.

One of the discernable arguments in Appellant's Third Amended Appeal Brief is the argument that the USPTO "lacked territorial jurisdiction" over actions occurring outside the borders of the United States. *See* Third Amended Appeal Brief, at 10; Reply Brief, at 16. In his view, but without any legal citation,<sup>6</sup> the U.S. patent laws are "only enforceable within the territorial boundaries of the United States." Third Amended Appeal Brief, at 10; *see also* Reply Brief, at 16-17. As a result, he argues that any alleged misconduct by him that occurred while he resided outside the territorial borders of the United States is outside the disciplinary jurisdiction of the USPTO.<sup>7</sup> *Id.* This argument was rejected by the ALJ and, despite Appellant's belief to the contrary, is wholly without merit.

Congress vested the USPTO with plenary, statutory authority to promulgate regulations "govern[ing] the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Office." 35 U.S.C. § 2(b)(2)(D); *see also Kroll v. Finnerty*, 242 F.3d 1359, 1364 (Fed. Cir. 2001) (stating that the USPTO has the "exclusive authority to

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<sup>5</sup> It is noted that Appellant's Reply Brief suffers from the same flaws noted in this Order.

<sup>6</sup> Here again, Appellant does not provide citations to the record for his claims that he previously cited "binding precedent" to support this argument. Third Amended Appeal Brief, at 10. As already stated, this sort of challenge flies in the face of the USPTO briefing requirements, of which Appellant has been warned about on multiple occasions. Thus, having not provided either the necessary citations to the record or the alluded to legal citations, the Director will not mine the over 5,700 pages of administrative record to fill in the gaps in his argument.

<sup>7</sup> In making this argument, he also states that he did not engage in the unauthorized practice of law. (A.10). This argument is rejected for reasons stated later in this Order. *See infra.* at 23.

establish qualifications for admitting persons to practice before it, and to suspend or exclude them from practicing before it."); *Haley v. Lee*, 2015 WL 5277880 at \*8 (E.D.Va., Sept. 8, 2015) (noting that "Congress gave the USPTO wide latitude to govern the conduct of the members of its bar") The Director of the USPTO may suspend or exclude a person from practice before the USPTO if the person is "shown to be incompetent or disreputable, or guilty of gross misconduct," or if the person violates regulations established by the Office. 35 U.S.C. § 32. Accordingly, the USPTO Director has authority to regulate practice before the Office in both patent and trademark matters, including the unauthorized practice of law before the Office. (*Id.*); *see also Haley*, at \*9 ("Congress also explicitly gives the USPTO the power to promulgate regulations related to the conduct of its members.")

Pursuant to its authority to regulate the conduct of practitioners, the USPTO enacted its former Code of Professional Responsibility, 37 C.F.R. §§ 10.20 *et seq.*, and the current Rules of Professional Conduct, 37 C.F.R. §§ 11.101 through 11.901, both of which include a number of mandatory "Disciplinary Rules" setting forth the minimum level of conduct below which no registered patent practitioner can fall without being subjected to disciplinary action. If a registered patent practitioner fails to comply with his or her professional obligations, the USPTO has the authority to suspend or exclude the practitioner from further practice before the Office. *See* 35 U.S.C. § 32; 37 C.F.R. § 11.19. Appellant has been registered as a patent attorney before the USPTO since August 12, 1997. (A. 3171). He has also practiced in trademark matters before the Office. (A.3176-3183, A.3218-3220; Tr. at 255-256). Both of those bases bind Appellant to comply with USPTO's disciplinary rules and subject him to the disciplinary jurisdiction of the office. 37 C.F.R. § 11.19(a).

There is no U.S. “residency” or “territorial” requirement contained in the plain language of any of the disciplinary rules. Rather, disciplinary jurisdiction is determined by § 11.19(a), which covers Appellant here as both a registered practitioner and someone who practices before the Office. And as the ALJ properly acknowledged in her Initial Decision, it would be absurd to recognize such an exception and allow practitioners to side-step the disciplinary rules by stepping foot outside the borders of the United States. (A.20). Consequently, Appellant’s argument has no legal support whatsoever and is rejected.

In sum, since Appellant is registered patent attorney he is subject to the USPTO’s disciplinary rules. There is no merit in Appellant’s argument that a practitioner’s physical residency at the time misconduct occurred affects the USPTO’s disciplinary jurisdiction and he cites no authority for his position. Disciplinary jurisdiction is conveyed by 37 C.F.R. § 19(a) and the plain language of the USPTO’s disciplinary rules don’t contain such any “territorial” requirements.

### **3. The Disciplinary Complaint Was Properly Signed.**

Appellant also argues that the ALJ erred in denying Respondent’s Motion to Dismiss by allegedly failing to address the USPTO’s requirement that the Complaint be signed by the OED Director, in accordance with 37 C.F.R. § 11.34(a)(5), thus rendering the Complaint invalid. (Third Amended Appeal Brief, at 13-15). However, a review of the Administrative Record shows that the ALJ, in Orders dated March 3, 2015 and March 26, 2015, clearly and expressly addressed the signature requirement, finding that the Complaint as signed by a subordinate official “*per procuracy*, or *on behalf of*” the Director was properly issued. (A.260; A.385-386). Finding that the OED Director sufficiently consented for the Deputy OED Director to sign the Complaint in his absence, as evidenced in the Declaration of William R. Covey, Deputy

General Counsel for Enrollment and Discipline and Director of the OED (A.260; A.202-203), the ALJ found no practical difference between a Complaint personally signed by the OED Director and a one signed “on behalf” of the OED Director (A.260). The ALJ also determined that exercising a “cure” for the deficiency would be a “useless act providing no legal significance.” (A.386).

In his appeal brief, Appellant objects to the ALJ’s decisions but does not provide any case law or authority to show why a signature made *per procuracionem* is not allowable for the Complaint nor does he address any legal or factual errors in ALJ’s argument. Rather, Appellant merely asserts that the Complaint is invalid because it failed to meet the signature requirement of 11.34(a)(5). Third Amended Appeal Brief, at 14. Rather, he argues that the OED Director’s delegation of authority was improper due to the absence of an express written delegation order from the USPTO Director authorizing such subdelegation. Third Amended Appeal Brief, at 15-16. Here again, though, Appellant does not provide any legal authority to support this argument.

As analyzed by the ALJ in her Orders dated March 2, 2015 and March 25, 2015, current case law clearly acknowledges that a subdelegation to a subordinate federal officer is “presumptively permissible absent affirmative evidence of a contrary congressional intent,” *U.S. Telecom Ass’n v. F.C.C.*, 359 F.3d 554, 565 (D.C. Cir. 2004). (A260; A385-386). Here, Appellant has not identified any evidence of congressional intent to prohibit a delegation by the OED Director, nor are there any USPTO regulations implementing such restriction, thus the OED Director was free to delegate his authorities as necessary. Such delegation was evidenced in the Declaration of William R. Covey, Deputy General Counsel for Enrollment and Discipline and Director of the OED, where the OED Director consented to the Deputy signing on his behalf while he was out of the office (A.202-203), and the Position Description for the Supervisory Patent Attorney/Deputy

Director, OED, which contemplated that the Deputy OED Director may be delegated authority to act on behalf of the OED Director upon his absence from the office. (A.204-208). With regard to Appellant's argument that any execution of a delegation must be memorialized in writing from the USPTO Director to be effective, the USPTO regulations do not require such procedures, and Appellant has not provided any case law that dictates this requirement. Third Amended Appeal Brief, at 15-16. Appellant attempts to cite 37 C.F.R. § 11.2 as authority that the USPTO Director reserves the authority to delegate to an acting OED Director, however Respondent misunderstands the purpose of these regulations. Third Amended Appeal Brief, at 16. Section 11.2 speaks only to the USPTO Director's appointment authorities and the prescribed duties of the OED Director, and does address the delegable authorities of that position or the conditions under which they may be delegated. For this reason, the ALJ properly denied Appellant's Motion to Dismiss. Similarly, Appellant's Motion for Reconsideration was also properly denied as he failed to satisfy the requirements for reconsideration under 37 C.F.R. § 11.56(c) (requiring newly discovered evidence or to correct errors of law or fact). Appellant's arguments, here and before the ALJ, are merely amount to a disagreement with the ALJ's decision.

4. **Appellant Was Not Improperly Denied the Ability to Subpoena Witnesses at His Disciplinary Hearing.**

Appellant's next claim is that the ALJ erred in denying his ability to subpoena witnesses in her Orders dated March 20, 2015<sup>8</sup> and May 4, 2015<sup>9</sup>, arguing that the USPTO's regulations at 37 C.F.R. § 11.38 are not authorized and inconsistent with the provisions at 35 U.S.C. § 24. Third Amended Appeal Brief, at 7. Section 11.38 prohibits the submission of evidence obtained by a

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<sup>8</sup> Order Denying Respondent's Motion for an Extension of Time to File Answer [sic] and Motion for Discovery Relating to the Attendance of Witnesses, to the Production of Documents, and to Responses to Interrogatories, dated March 20, 2015. (A.361-365).

<sup>9</sup> Order Denying Respondent's Renewed Motion for Discovery relating to the Attendance of Witnesses, to the Production of Documents, and to Response to Interrogatories, dated May 4, 2015. (A.977).

subpoena issued under 35 U.S.C. § 24, unless leave to proceed is authorized by the hearing officer. Appellant claims that ALJ erred by “failing to read the plain and unambiguous meaning of 35 U.S.C. § 24”, which allows Appellant subpoena power. Third Amended Appeal Brief, at 17. Appellant asserts that that the language of 35 U.S.C. § 24 is “clear and unambiguous,” and that the additional procedural requirements at 37 C.F.R. § 11.38 are “illegal under 35 U.S.C. § 2, and unconstitutional” because an executive branch agency “is not authorized to restrict or negate a statute passed by congress.” Third Amended Appeal Brief, at 7.

The ALJ properly determined in her Orders that the provisions of 37 C.F.R. part 11 is authorized and consistent with 35 U.S.C. § 24, and that the USPTO properly exercised its rulemaking authority to address discovery matters. (A.363; A.974-A.975). The ALJ found that Congress intended the judicial subpoena power of 35 U.S.C. § 24 to be used “strictly in aid of the primary proceeding” conducted by PTO in accordance with USPTO’s rules. *Sheehan v. Doyle*, 513 F.2d 895, 898-99 (1st Cir. 1975). (A.363; A.975). Further, the court in *Abbott Labs v. Cordis Corp.*, 710 F.3d 1318, 1322-26 (Fed. Cir. 2013) found that “[35 U.S.C. § 24] only empowers district courts to issue subpoenas in proceedings for which the PTO has authorized parties to present evidence by means of deposition,” and does not afford a party in proceedings before the USPTO “discovery beyond that permitted by PTO discovery rules and rules of admissibility.” *Id.* at 1325-26. The court in *Abbott Labs* also specifically found that the provisions in 37 C.F.R. § 11.38 were not an “unconstitutional restriction.” In his appeal, Appellant ignores this case law, and expresses objections to the ALJ’s determinations, but cites no case law distinguishing the ALJ’s legal analysis or identifies any error in the ALJ’s decision other than to repeatedly assert his unsupported claims that 37 C.F.R. § 11.38 is unauthorized and inconsistent with 35 U.S.C. § 24. Third Amended Appeal Brief, at 7 and 17.

Appellant alludes to a double standard citing an incident where the Solicitor's Office allegedly went to the District Court to seek a subpoena for privileged documents after the ALJ issued a decision forbidding the discoverability of that information. Third Amended Appeal Brief, at 18. However, Appellant provides no details or any evidence in the record to support the allegation, such as whether the subpoenas were granted or whether the materials that were the subject of the subpoenas were allowed to be submitted into the record by the ALJ. Thus, this argument is dismissed as meritless.

Finally, Appellant attempts to argue that the ALJ erred when denying his request to subpoena USPTO Officials for failing to meet the discovery requirements at 37 C.F.R. § 11.52(d). Third Amended Appeal Brief, at 10. Again Appellant does not provide any legal authorities that justify his claim that the ALJ erred. The ALJ properly denied Appellant's pending Motion for Discovery for failing to explain in sufficient detail, for each request made, how the discovery sought is reasonable and relevant, contrary to the requirements of 37 C.F.R. § 11.52(d). (A.364). In his appeal, Appellant makes no legal arguments whatsoever addressing the ALJ's decision, thus in light of this lack of evidence, Appellant argument is determined to be without merit.

**B. Appellant Engaged in the Unauthorized Practice of Law.**

Appellant's only substantive arguments regarding the ALJ's findings of misconduct, and violations of disciplinary rules, is a series of confusing arguments regarding the ALJ's findings and conclusions that Appellant engaged in the unauthorized practice of law. As stated, these arguments fail on the independent grounds of failing to satisfy the USPTO's filing requirements. *See supra*, at 14-17. In addition, as further discussed below, Appellant's arguments also fail on the merits.

The prohibition against practitioners engaging in the unauthorized practice of law is set forth at 37 C.F.R. 11.505, which states “[a] practitioner shall not practice law in a jurisdiction in violation of the regulation of the legal profession in that jurisdiction, or assist another in doing so.” The ALJ made multiple findings of Appellant having engaged in the unauthorized practice of law over a period of years and concluded that the misconduct was a pattern of misconduct, over a period of years, in multiple jurisdictions. (A.21, A.24, A.42, A.48). The ALJ noted the particular misconduct in those jurisdictions, examined the law governing practicing before those jurisdictions, and properly concluded that the Appellant engaged in the unauthorized practice of law in those jurisdictions.

Importantly, the ALJ also concluded that Appellant engaged in the unauthorized practice of law before the USPTO. (A.19). Between September 20, 2013, and August 13, 2014, Appellant’s license to practice law was suspended by the Supreme Court of Pennsylvania. (A.19). During that time, he was not permitted to practice before the USPTO. (A.19). The ALJ noted,

“[w]ith respect to practice before the PTO, “[o]nly an individual qualified to practice under § 11.14 of this chapter may represent an applicant, registrant, or party to a proceeding before the Office in a trademark case. 37 C.F.R. § 2.17(a). Any individual who is an attorney as defined in § 11.1 may represent others before the Office in trademark and other non-patent matters.” 37 C.F.R. § 11.14(a). An “attorney” is “an individual who is a member in good standing of the highest court of any State . . . and *not under an order of any court . . . suspending, enjoining, restraining, disbarring or otherwise restricting the attorney from practice before the bar of another State or Federal agency.*” 37 C.F.R. § 11.1 (emphasis in original).”

Despite being administratively suspended by the State of Pennsylvania, he continued to practice before the USPTO. He was the attorney-of-record and correspondent for Lawless America Association’s Trademark Application No. 85871932, for the mark “Lawless America.” (A.3176-3187; A.3264; Tr. at 255-256). Appellant is identified as the attorney-of-record and



correspondent for the application. (A.2342-2343; Tr. at 257-258). Appellant sent a draft of a Response to a USPTO Office Action to Mr. Windsor on February 12, 2014. (A.3303-3304; A.3309-3311). Appellant admitted that he “participated heavily in the drafting” of the Response to Office Action filed on behalf of Mr. Windsor on February 18, 2014. (Tr. at 265, 273). Mr. Windsor did not draft the response. (A.3000). The draft contained both legal analysis and argument. (A.2366-2368). Appellant also remained the attorney-of-record at the time the Response to Office Action was submitted. (Tr. at 287). Further, the USPTO continued to send documents to him. (A.2382-2388; Tr. at 410-412). This is the practice of law before the USPTO during a period of time that Appellant was unauthorized to practice law. *See* 37 C.F.R. § 11.5(b)(2) (“Practice before the Office in trademark matters includes, but is not limited to, consulting with or giving advice to a client in contemplation of filing a trademark application or other document with the Office; preparing and prosecuting an application for trademark registration; preparing an amendment which may require written argument to establish the registrability of the mark; and conducting an opposition, cancellation, or concurrent use proceeding; or conducting an appeal to the Trademark Trial and Appeal Board.); *see also* Trademark Manual of Examining Procedure (“TMEP”), at § 608.01.

Appellant claims that he was permitted to file materials with the USPTO in support of the pending Trademark application due to his position as a corporate officer with Lawless. *See* Reply Brief, at 13-14. This argument fails since, though a corporate officer is permitted to sign and submit some trademark pleadings, *see* TMEP §§ 611.02, 611.06(d), Appellant has not proffered as single piece of evidence in support of this position. And a review of the documents filed in connection with the Lawless America trademark application do not support this contention.

With respect to the Appellant's other arguments, all of the ALJ's finding and conclusions are supported by facts in the administrative record and supported by law. First, his attempts to characterize his actions as something less than the practice of law the jurisdictions noted in the disciplinary complaint are completely without any support. Indeed, the ALJ's findings and conclusions rely on Appellant's own testimony and concessions that his actions constitute the practice of law in the various jurisdictions. Third, Appellant raises the argument that "Rule 5.5" in various jurisdictions that permit him to practice law in those jurisdictions on a temporary basis. *See* Third Amended Appeal at 23-25, 34. However, this argument was soundly rejected by the ALJ and it is rejected here for the reasons noted in the ALJ's opinion. In short, and as the ALJ noted, there is no evidence that in any of the jurisdictions for which he claims he properly acted on a "temporary" basis that his practice was, in fact, temporary or that his actions in those jurisdictions were permissible under those authorities. (A.30-32, A.38, A.46-47). To the contrary, the facts of the record as noted in the ALJ's opinion and this final order show a pattern of conduct in which he flouted the rules governing the practice of law across multiple jurisdictions. In all of the jurisdictions for which he practiced without an authorizing bar membership, he was required to receive authority of the courts. He unquestionably failed to do so. Thus, the ALJ properly rejected these arguments and, further, the ALJ's findings of misconduct are appropriate.

**C. The Penalty of a Three (3) Year Suspension Is Appropriate.**

The ALJ's initial decision concluded that Appellant violated USPTO's disciplinary rules and engaged in misconduct, and as a result, a three (3) year suspension from practice before the Office was the appropriate sanction. An ALJ initial decision that imposes exclusion or

suspension must explain the reason for imposing such a sanction after consideration of the following four factors:

- (1) Whether the practitioner has violated a duty owed to a client, to the public, to the legal system, or to the profession;
- (2) Whether the practitioner acted intentionally, knowingly, or negligently;
- (3) The amount of the actual or potential injury caused by the practitioner's misconduct; and
- (4) The existence of any aggravating or mitigating factors.

37 C.F.R. § 11.54(b)(1)-(4).

The Director of the USPTO reviews an appeal from an ALJ initial decision on the record before the ALJ. *See* 37 C.F.R. § 11.55(f); *see also Marinangeli v. Lehman*, 32 F. Supp. 2d 1, 5 (D.D.C. 1998). After such review, and as discussed below, the ALJ's initial decision to suspend Appellant for three (3) years from practicing before the USPTO included a careful and proper analysis of the four factors set forth in 37 C.F.R. § 11.54(b). The ALJ's sanction of a three-year suspension is warranted and thus upheld. Here, the ALJ properly considered and applied the four factors relevant to an exclusion or suspension under 37 C.F.R. § 11.54(b) and the findings are supported by both the administrative record and precedential case law. This analysis is discussed further, below.

**1. Whether the practitioner has violated a duty owed to a client, to the public, to the legal system, or to the profession.**

The ALJ properly noted, as already discussed, that Appellant on several occasions violated duties to his clients, the public, the legal system, and the profession when he repeatedly engaged in the unauthorized practice of law. (A.64). Noting USPTO case law that affirmed that

“[a]ttorneys who practice before the PTO are expected to ‘assist in maintaining the integrity and competence of the legal profession’ and aid in the prevention of the unauthorized practice of law.” *Jaeger*, PTO Proceeding No. D2012-29 at 13 (quoting 37 C.F.R. §§ 10.21, 10.46), the ALJ stated that Appellant failed to prevent the unauthorized practice of law but instead engaged in and enabled it. (A.64). He did so in violation of court orders instructing him to obtain *pro hac vice* status, in disregard for his clients, and harmed the public by causing various states to waste resources he had no authority to bring in the first place. (A.64). These findings are amply supported in the record.

**2. Whether the practitioner acted intentionally, knowingly, or negligently.**

As to the second factor, the ALJ noted that Appellant’s conduct was admittedly willful. (A.64). As support for this, the ALJ noted that “in case after case, [Appellant] was warned by various courts that his participation was improper until he obtained *pro hac vice* admission.” (A.64). The ALJ noted three (3) specific instance of this behavior in Massachusetts and noted that Appellant, rather than disavow intent, has consistently maintained his belief that his actions were proper. (A.64). The ALJ’s finding of willfulness thus has firm support in the record and is proper.

**3. The amount of the actual or potential injury caused by the practitioner’s misconduct.**

In sanctioning Appellant, the ALJ also noted that Appellant’s misconduct caused actual injury to his clients including dismissal (*Nolan, Babeu, Hohn, Katz I, Hankins, and Doe*). (A.64-A.65). Importantly, Appellant abandoned a client in a pending trademark matter before the USPTO, resulting in the applicant unable to gain trademark protection on his own. (A.65). These findings are amply supported in the record and not in dispute. As such, they were properly considered by the ALJ in determining Appellant’s discipline.

#### **4. The existence of any aggravating or mitigating factors.**

Lastly, the ALJ identified four (4) aggravating and one (1) mitigating factors which were considered in determining the penalty. As aggravating, the ALJ noted Appellant's clear pattern of misconduct in four jurisdictions and despite repeated warnings that his behavior crossed ethical lines. (A.65). Appellant's misconduct violated multiple disciplinary rules. (A.65). Also, the ALJ noted with concern the fact that Appellant negligently engaged in untruthful behavior during the disciplinary process. (A.65-A.66). Appellant's behavior was identified as "willful" and, given his nearly two decades of legal practice prior to the first instance of misconduct here, there was "no excuse" for failing to comply with the Code or USPTO Rules. (A.66).

In mitigation, the ALJ noted that Appellant has no known disciplinary history and he offered some commendation for the fact that Appellant sought to represent underserved clients on a somewhat pro bono basis. (A.66). Considering all the required factors, and Appellant's arguments, the ALJ concluded that the three-year suspension requested by the OED Director was appropriate, "if not generous." (A.68). In reaching this conclusion, the ALJ also considered several cases that support the imposition of a 3-year suspension for Appellant. (*Id.*) Thus, Appellant's 3-year suspension here is consistent with past precedent.

In her review of the case law, the ALJ considered the fact that courts have repeatedly held that attorneys who continuously violate disciplinary rules over a lengthy period of time should receive a substantial suspension if not exclusion. (*Id.*) (citing *Hormann*, PTO Proceeding No. D08-04 at 21 (excluding attorney from the practice before the USPTO for neglect, dishonesty, fraud, deceit or misrepresentation, failure to notify, inadequate preparation, habitual violations of disciplinary rules, and failure to promptly deliver client property); *In the Matter of McAllister*, 265 Ga. 420, 420-21 (1995) (disbarring attorney engaged in multiple violations of state

disciplinary rules over three years, including abandoning legal matters entrusted to him, engaging in conduct involving dishonesty, fraud, deceit, or misrepresentation, and failing to respond to state disciplinary authorities); and *In the Matter of Hammock*, 278 Ga. 385, 387 (2004) (majority holding that a two-year suspension was proper when attorney failed to communicate with clients for months, misrepresented the status of their cases, had three prior disciplinary infractions and neglected clients' legal matters).

The AJL also considered instances where an attorney's record is free of prior disciplinary violations, like Appellant here, but nonetheless found disbarment justified. *See Hormann*, PTO Proceeding No. D08-04 at 21 (excluding attorney from the practice before the USPTO even though the record does not show a history of prior violations); *In the Matter of Shehane*, 276 Ga. 168, 170 (2003) (disbarring attorney, holding that even though "respondent has not been the subject of any prior disciplinary action during his eight-year membership in the State Bar of Georgia, we take very seriously his deliberate, deceitful acts to obfuscate the truth").

Finally, the ALJ also cited to *Kelber*, PTO Proceeding No. D2006-13 at 64, a case where the practitioner was sanctioned for instances of misrepresentation that "stretch[ed] and exceed[ed] the limits of trustworthiness, honesty and candor in several contexts over several years," but was only given a 60-day suspension. However, this case can be distinguished as the practitioner in *Kelber* was charged only with two fairly minor infractions; count 1 was fabrication of an exhibit introduced into evidence during a proceeding in 2003 and count 2 was misrepresentation in a letter submitted to OED in 2005 of his fitness to practice before the USPTO. When compared to Appellant's pattern of serious misconduct, *Kelber* is not determinative here. This, combined with the fact that a 3-year suspension is within the range of sanctions previously applied to the type of

misconduct found here, renders the ALJ's sanction supported prior precedent and thus reasonable.

In conclusion, the ALJ's sanction analysis complies with 37 C.F.R. § 11.54(b) and finds support in the record and in the case law noted by the ALJ concerning demonstrated patterns of misconduct over a lengthy period such as Appellant engaged in here. Consequently, the three-year suspension ordered by the ALJ fully supported and will not be disturbed.

### **ORDER**

Having considered Appellant's appeal under 37 C.F.R. § 11.55 from the June 16, 2016 Initial Decision of the ALJ suspending Appellant from the practice of all patent, trademark, and other non-patent matters before the Office for three (3) years, it is **ORDERED** that the initial decision of the ALJ is **AFFIRMED**.

It is further:

**ORDERED** that the OED Director give notice pursuant to 37 C.F.R. § 11.59 of the public discipline and the reasons for the discipline to disciplinary enforcement agencies in the state(s) where Appellant is admitted to practice, to courts where Appellant is known to be admitted, and to the public;

**ORDERED** that the USPTO dissociate Appellant's name from any Customer Numbers and the public key infrastructure ("PKI") certificate associated with those Customer Numbers;

**ORDERED** that Appellant shall not apply for a USPTO Customer Number, shall not obtain a USPTO Customer Number, nor shall he have his name added to a USPTO Customer Number, unless and until he is reinstated to practice before the USPTO; and

**ORDERED** that Appellant shall comply with the provisions of 37 C.F.R. § 11.58 governing the duties of disciplined practitioner.

**RECONSIDERATION AND APPEAL RIGHTS**

Any request for reconsideration of this decision must be filed within twenty (20) days from the date of entry of this decision pursuant to 37 C.F.R. § 11.56(c). Any request for reconsideration mailed to the USPTO must be addressed to:

Sarah T. Harris  
General Counsel  
United States Patent and Trademark Office  
600 Dulany St.  
P.O. Box 1450  
Alexandria, VA 22314

A copy of the request must also be served on the attorney for the Director of Enrollment and Discipline:

Robin Crabb  
Counsel for the Director of Office of Enrollment and Discipline  
600 Dulany St.  
P.O. Box 1450  
Alexandria, VA 22314

Any request hand-delivered to the USPTO must be hand-delivered to the Office of the General Counsel, in which case the service copy for the attorney for the Director shall be hand-delivered to the Office of Enrollment and Discipline.

If a request for reconsideration is not filed, and Appellant desires further review, Appellant is notified that he is entitled to seek judicial review on the record in the U.S. District Court for the Eastern District of Virginia under 35 U.S.C. § 32 "within thirty (30) days after the date of the order recording the Director's action." See E.D.Va. Local Civil Rule 83.5.



**IT IS SO ORDERED.**

5/25/17

Date



Sarah T. Harris

General Counsel

United States Patent and Trademark Office

on delegated authority by

Michelle K. Lee

Under Secretary of Commerce for Intellectual Property and

Director of the United States Patent and Trademark Office

cc:

Louis A. Piccone

*Appellant*

Robin Crabb

*Associate Solicitors*

Counsel for the Director of Office of Enrollment and Discipline