

**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,)	Proceeding No. D2015-06
)	
Appellant.)	
_____)	

FINAL ORDER UNDER 37 C.F.R. § 11.56(c)

Pursuant to 37 C.F.R. § 11.56(c), Louis A. Piccone (“Appellant”) requests the Director of the United States Patent and Trademark Office (“USPTO” or “Office”) to reconsider the Final Order Under 37 C.F.R. § 11.55 (“Final Order”), issued on May 25, 2017, which affirmed the June 16, 2016 Initial Decision of the Chief Administrative Law Judge (“ALJ”) Susan L. Biro in the above-captioned disciplinary matter. In that Final Order, the USPTO Director imposed on Appellant a three-year suspension from the practice of patent, trademark, and other non-patent law before the Office.

After consideration of the briefs submitted by Appellant and the Director of the Office of Enrollment and Discipline (“OED Director”), for the reasons set forth below, the USPTO Director **DENIES** Appellant’s request for reconsideration.

I. PROCEDURAL HISTORY

On June 14, 2017, by Appellant Louis A. Piccone (“Appellant”) submitted a timely filed untitled petition determined to be a Request for Reconsideration pursuant to 37 C.F.R. § 11.56(c) (“Request”) requesting the USPTO to reconsider the May 25, 2017 order. In that Request, Appellant argues for the dismissal of the USPTO Director’s May 25, 2017 Final Order affirming the June 16, 2016 Initial Decision of the ALJ due to errors in law and fact in the USPTO

Director's finding that Appellant engaged in the unauthorized practice of law (*See Request*, at 2-9) and that Appellant's appeal brief failed to comply with the USPTO filing rules set forth in 37 C.F.R. § 11.55. *See Request*, at 9-19.

On June 19, 2017, the OED Director filed with the USPTO Director the "OED Director's Motion to File Response to Respondent's Untitled Petition" moving for permission to file a response to address the issues raised in Respondent's Request for Reconsideration, and requesting until July 7, 2017 to do so, which was granted by the USPTO Director on June 21, 2017.

On June 23, 2017, Appellant filed a petition requesting that the USPTO Director reverse the June 21, 2017 Order and deny the OED Director's Motion, but this petition was denied by the USPTO Director on June 30, 2017.¹

On July 7, 2017, the OED Director timely filed the "OED Director's Response to Respondent's Request for Reconsideration Pursuant to 37 C.F.R. § 11.56(c)" ("Response") responding to the Appellant's Request. In that Response, the OED Director argues that the newly discovered evidence submitted by the Appellant did not meet the standard of review for reconsiderations under 37 C.F.R. § 11.56(c) because the evidence submitted was not "newly discovered" and was substantially similar to evidence already in the record (*See Response*, at 6-9), and that the USPTO Director did not commit any errors in law or fact in determining that Appellant engaged in the unauthorized practice of law that warrant dismissal of the Final Order. *See Response*, at 9-12. In addition, the OED Director argues that the USPTO Director correctly

¹ Although the General Counsel of the USPTO signed and issued this Order on June 30, 2017, as indicated in the June 30, 2017 email transmittal to parties, the date was inadvertently omitted from the signature page. This omission amounts to harmless error as it did not prejudice or otherwise result in any harm to parties, nor did it substantively affect or change any obligation or deadline imposed on the parties by the Order previously issued on June 21, 2017.

determined that Appellant's brief failed to comply with the USPTO filing rules set forth in 37 C.F.R. § 11.55. *See* Response, at 12-14.

Appellant timely filed a reply, "Louis A. Piccone's Reply to the OED Director's July 7, 2017, Opposition to Mr. Piccone's June 24, 2017, Petition for Reconsideration" ("Reply") on August 3, 2017, arguing that the USPTO Director committed an error in law as the regulations authorize him as a corporate officer to practice before the USPTO in trademark matters (*See* Reply, at 3-8), and that Appellant provided sufficient citations to the Administrative Record in accordance with the regulations at 37 C.F.R. § 11.56(a). *See* Reply, at 8-12.

II. LEGAL STANDARD

Following a final decision of the USPTO Director, either party may make a single request for reconsideration or modification of the decision by the USPTO Director if such request is filed within twenty days from the date of entry of the decision, and the request is based on newly discovered evidence, or an error of law or fact, and the requestor must demonstrate that any newly discovered evidence could not have been discovered any earlier by due diligence. *See* 37 C.F.R. § 11.56(c).

The standard of review governing requests under § 11.56(c) has not been defined beyond what appears in the regulations. However, although the Federal Rules of Civil Procedure are not applicable in administrative proceedings,² the courts have at times looked to them for useful guidance in judging actions taken by the USPTO.³ Because the standard of review used by federal courts for motions to alter or amend a judgment under Rules 59(e) and 60 of the Federal Rules of Civil Procedure are most similar to Requests for Reconsideration pursuant to § 11.56(c), that standard is applied here to Appellant's Request.

² *See Bender v. Dudas*, No. 04-13012006 WL 89831, at *23 (D.D.C. Jan. 13, 2006).

³ *See Gerritsen v. Shirai*, 979 F.2d 1524, 1532 (Fed. Cir. 1992).

Federal courts have clarified that the standard of review for Rules 59(c) and 60 are narrow and limited to only certain circumstances involving new evidence, or to correct errors of law or fact. *See Hutchinson v. Staton*, 994 F.2d 1076, 1081 (4th Cir. 1993). Any new evidence submitted must not have been available before the issuance of the final decision. *See Boryan v. United States*, 884 F.2d 767, 771 (4th Cir. 1989) (“Evidence that is available to a party prior to entry of judgment, therefore, is not a basis for granting a motion for reconsideration as a matter of law.”) (citing *Frederick S. Wyle P.C. v. Texaco, Inc.*, 764 F.2d 604, 609 (9th Cir. 1985)). Reconsideration “would be appropriate where, for example, the Court has patently misunderstood a party, or has made a decision outside the adversarial issues presented to the Court by the parties, or has made an error not of reasoning but of apprehension.” *Above the Belt, Inc. v. Mel Bohannan Roofing, Inc.*, 99 F.R.D. 99, 101 (E.D.Va. 1983); *United States v. Ali*, No. 13-3398, 2014 WL 5790996, at *3 (D. Md. Nov. 5, 2014).

It is long-settled that requests for reconsideration⁴ are not a vehicle to state a party’s disagreement with a final judgment. *See Hutchinson*, 994 F.2d at 1082 (“mere disagreement does not support a Rule 59(e) motion”); *Arthur v. King*, 500 F.3d 1335, 1343 (11th Cir. 2007), *cert. denied*, 552 U.S. 1040 (2007) (stating that a Rule 59(e) motion cannot be used to relitigate old matters, raise argument or present evidence that could have been raised prior to the entry of judgment). A request for reconsideration should not be used to rehash “arguments previously presented” or to submit evidence which should have been previously submitted. *Wadley v. Park at Landmark, LP*, No. 1:06CV777, 2007 WL 1071960, at *2 (E.D. Va. 2007) (citing *Hutchinson*, 994 F.2d at 1081-82); *Above the Belt, Inc.*, 99 F.R.D. at 101 (holding improper a motion for reconsideration “to ask the Court to rethink what the Court had already thought through—rightly

⁴ Such requests refer to either motions to alter or amend a judgment (Fed. R. Civ. P. 59(e)), or motions for relief from a judgment or order (Fed. R. Civ. P. 60).

or wrongly”); *Durkin v. Taylor*, 444 F. Supp. 879, 889 (E.D. Va. 1977) (stating that Rule 59(e) is not intended to give “an unhappy litigant one additional chance to sway the judge”).

While requests for reconsideration are permitted, they are seldom granted. These types of motions are extraordinary remedies reserved only for extraordinary circumstances. *See Dowell v. State Farm Fire & Cas. Auto. Ins. Co.*, 993 F.2d 46, 48 (4th Cir. 1993) (limiting relief under Rule 60(b)(6) to “extraordinary circumstances”); *Projects Mgmt. Co. v. DynCorp Int’l, LLC*, 17 F. Supp. 3d 539, 541 (E.D. Va. 2014), *aff’d*, 584 F. App’x 121 (4th Cir. 2014) (reconsideration of a judgment after its entry is an “extraordinary remedy which should be used sparingly”) (quoting *Pac. Ins. Co. v. Am. Nat’l Fire Ins. Co.*, 148 F.3d 396, 403 (4th Cir. 1998)); *see also Netscape Commc’ns Corp. v. ValueClick, Inc.*, 704 F. Supp. 2d 544, 546 (E.D. Va. 2010)).

Thus, the standard of review for a Request for Reconsideration under § 11.56(c) is very high, and such requests should be granted sparingly and only in extraordinary circumstances. For the reasons discussed below, Appellant has not made any arguments or submitted any evidence that satisfies the standard of review.

II. LEGAL ANALYSIS

A. Appellant’s “new evidence” fails to meet the standard required under 37 C.F.R. § 11.56(c).

In his Request, Appellant attempts to submit newly discovered evidence in the form of an affidavit from William Windsor dated June 1, 2017 (“Windsor Affidavit”) to support his claim that the May 25, 2017 Final Order warrants dismissal. The affidavit appears to contain statements from Mr. Windsor attesting to the fact that he asked Appellant to serve as an officer of Lawless America Association and to file a trademark application on behalf of the organization. *See Windsor Affidavit*, at 1 para. 2, 3, 4, & 5; 2 para. 7 & 8. Under the standard set forth in 37 C.F.R. § 11.56(c), Appellant must demonstrate that the “newly discovered evidence

could not have been discovered any earlier by due diligence.” 37 C.F.R. § 11.56(c). Any evidence that was available or could have been available, with due diligence, to parties prior to entry of judgment do not meet this standard. *See Boryan*, 884 F.2d at 771 (“Evidence that is available to a party prior to entry of judgment, therefore, is not a basis for granting a motion for reconsideration as a matter of law.”) Appellant fails to meet this standard as Appellant has not satisfactorily demonstrated that Mr. Windsor’s affidavit could not have been submitted prior to this Request. Appellant submits Mr. Windsor’s affidavit to “clarify[] his testimony taken by the USPTO.” Request, at 20. Mr. Windsor’s deposition was taken by the USPTO on June 9, 2015, but this is the first attempt by Appellant to submit this affidavit despite having ample opportunities starting with the time immediately following Mr. Windsor’s deposition, continuing throughout the hearing before the ALJ, and finally during Appellant’s hearing appeal before the USPTO Director. However, Appellant never before attempted to submit any affidavit or otherwise “clarify” Mr. Windsor’s deposition testimony. Appellant’s attempt to now submit this evidence for the first time is not appropriate as a successful reconsideration request is reserved for only evidence that “could not have been discovered any earlier by due diligence,” a standard that this evidence clearly fails to meet since Appellant could have taken and submitted any clarifications of Mr. Windsor’s testimony prior to this Request. Thus, Appellant has not met the due diligence required under 37 C.F.R. § 11.56(c).

Even if Appellant had shown that he exercised the requisite due diligence, the information contained in Mr. Windsor’s affidavit cannot be considered “newly discovered.” Appellant’s allegedly “new” information attempts to support Appellant’s general argument that he could not have engaged in the unauthorized practice of law because he was designated as an

officer of Lawless America Association, pursuant to 37 C.F.R. § 11.14(e)(3). Mr. Windsor's affidavit states:

2. There came a point of time in 2013 when I created a not for profit business association called the "Lawless America Association". I asked Mr. Piccone in 2013 whether he would become the "Director" of the "Lawless America Association" and he consented. Soon afterward I made Mr. Piccone the Director of the association at the same time I held the position of "President".

* * * * *

4. On or about, March 13, 2013, Mr. Piccone, filed a trademark application with the United States Patent and Trademark Office ("USPTO") seeking trademark protection for the mark "Lawless America".

Windsor Affidavit, at 1 para. 2 & 4.

However, Appellant has not demonstrated that the information being offered is not substantially similar to what already appears in the record. Appellant's argument was raised previously in his disciplinary proceeding, specifically during his appeal, and the allegedly "new" evidence that Appellant attempts to now submit – Appellant's status as an officer of Lawless America Association – appears to be substantially the same information that appears in the deposition of Mr. Windsor taken on June 9, 2015. (*See* Administrative Record, at A.3243-A.3338). For example, in his deposition, Mr. Windsor testified that Mr. Piccone was the Director of Lawless America Association:

Q. So are you saying that at the time that the trademark application was filed on or around March 9, 2013, Mr. Piccone was the director of Lawless America Association?

A: I believe so.

Administrative Record, at A.3273-74.

This information was available to the ALJ and the USPTO Director who both found that despite this information, evidence in the record – which includes Mr. Windsor's deposition testimony – showed that Appellant acted in a representative capacity in Lawless America Association's application before the USPTO. The evidence that Appellant now attempts to

submit does not provide any “new” information that was not already considered and rejected, and thus fails to show that he has met the standard of review required under 37 C.F.R. § 11.56(c).

B. Appellant’s Request does not identify any errors in law or fact that warrant reversal of the Final Order.

In his Request, Appellant argues that the USPTO Director committed errors in law or fact that warrant dismissal of the May 25, 2017 Final Order. However, the bulk of Appellant’s request does nothing more than raise the same arguments made during the hearing appeal before the USPTO Director, which is not proper for a request for reconsideration.

Appellant reasserts the argument raised in his appeal that he did not engage in the unauthorized practice of law because he was in fact authorized to practice before the USPTO as a designated officer of the trademark applicant corporate entity, Lawless America Association, pursuant to 37 C.F.R. § 11.14(e)(3). *See* Request, at 3-9; Reply, at 3-8. However, as already stated, this argument was considered and rejected by the USPTO Director in the Final Order, who found that substantial evidence in the record did not support the contention that Appellant filed documents in connection with the Lawless America trademark application as a corporate officer. *See* Final Order, at 25. To the contrary, the USPTO Director found that the records support the conclusion that Appellant acted in the capacity as an attorney during the period when he was administratively suspended from the practice of law. *See* Final Order, at 24-26.

Appellant attempts to argue an error in law by claiming that that even if he did not act intentionally as a corporate official under the authority granted under 37 C.F.R. § 11.14(e)(3), that authority would automatically “cloak his actions in the full authority provided by the USPTO to corporate officers,” thereby rendering moot the USPTO’s claim that he was engaged in the unauthorized practice of law. Reply, at 5-6. However, Appellant’s interpretation that this

authority would spontaneously spring into effect to legitimize his actions is not supported by any legal authority or analysis, nor is it an interpretation that the USPTO has expressly provided through either its regulations or guidance, therefore it is rejected. Appellant's arguments raised in his Request and Reply merely amount to the rehashing of arguments previously presented, which is improper. *See Above the Belt, Inc.*, 99, F.R.D. at 101 (holding improper a motion for reconsideration "to ask the Court to rethink what the Court had already thought through—rightly or wrongly."). Thus, because the Request functions as little more than reiteration of Appellant's prior argument, it would be improper to grant reconsideration.

Appellant also attempts to argue that the USPTO Director erred by relying on an allegedly "flawed" interpretation of the Trademark Manual of Examining Procedure's (TMEP) guidance at §§ 611.02 and 611.06(d). Appellant argues that the TMEP's guidance violated the Administrative Procedure Act's ("APA") procedural rulemaking requirements for an improper interpretation of 37 C.F.R. § 11.14(e)(3). He alleges that the USPTO's interpretation of the regulations was allegedly narrow, restrictive, and is "so different" from the regulations to be misleading, and thus, such interpretation should have been promulgated by rulemaking rather than issued as mere guidance. Request, at 7-8. However, Appellant offers no legal analysis that the TMEP violates the procedural rulemaking requirements of the APA nor has Appellant provided any legal analysis of any error in law or fact made by the USPTO Director in determining that Appellant engaged in the unauthorized practice of law. Therefore, this argument is rejected.

In addition, Appellant reasserts the argument raised in his appeal that that his appeal brief was proper and that the USPTO Director committed an error in law by disposing of many of the claims for lack of legal citations and analysis. *See* Request, at 9-19. In support of his argument,

Appellant provides a discussion of the many ways in which his appeal brief contained legal citations and analysis. For example, Appellant argues that he did in fact provide 27 legal citations that included cites to the C.F.R. and U.S.C., and the names and dates relevant pleadings in the Administrative Record. *See* Request, at 17-18; Reply, at 11-12. He admits that some of the legal arguments presented are only one sentence in length and omit any citations to the record or legal authority, but claims that each legal issue has to be read in the context of the entire brief. *See* Request, at 12-13. For those arguments that were truncated, he found it unnecessary to fully repeat some arguments in his appeal brief since they were laid out in full in the record, which was fully accessible to the USPTO Director (*See* Request, at 15-16) and permissible under the regulations at 37 C.F.R. § 11.56(a), which allow reliance on the “whole record” rather than portions thereof (Reply, at 9-12). However, Appellant’s arguments all ignore the substantive deficiency specifically raised in the USPTO Director’s Orders dated September 8, 2016 and dated November 23, 2016, wherein the USPTO Director refused entry of Appellant’s first two appeal briefs for failing to adequately present the applicable standard of review and provide an adequate legal analysis demonstrating the errors committed by the ALJ in the Initial Decision. Appellant’s arguments address only the ways in which he met the literal requirements for a brief, and ignores the USPTO Director’s objection to the lack of substantive legal analysis. Thus, Appellant’s arguments merely amount to a mere disagreement with the USPTO’s determination, which is not a basis for granting a request for reconsideration.

Finally, Appellant attempts to argue that the USPTO Director committed an error in law by failing to consider the fact that the Massachusetts and Pennsylvania State bars chose not impose any discipline for the conduct that served as the basis for the USPTO Director’s determination that Appellant engaged in the unauthorized practice of law. *See* Response, at 19;

Reply, at 1-3. However, this information is irrelevant to the Request as state law is inapplicable in this matter. It is long-settled that "the State maintains control over the practice of law within its borders except to the limited extent necessary for the accomplishment of federal objectives." *Sperry v. State of Fla.*, 373 U.S. 379, 402 (1963). This is so even when attorney discipline is predicated on actions purportedly taken while working on a patent case or claim. *See Kroll v. Finnerty*, 242 F.3d 1359, 1365 (Fed. Cir. 2001). Under *Sperry*, a state may not enjoin a patent practitioner from preparing patent applications and other legal instruments to be filed before the USPTO since regulating admission and disciplinary issues before the USPTO lies within its exclusive jurisdiction. *See Sperry*, 373 U.S. at 385; *Kroll*, 242 F.3d at 1364. This is because the Office possesses "exclusive authority to establish qualifications and procedures for admitting persons to practice before the USPTO, and to suspend or exclude those patent practitioners from practicing before the USPTO," *see Kroll*, 242 F.3d at 1364. In addition, Appellant's argument concerning the non-action of the Massachusetts and Pennsylvania State bars fails to satisfy the standard of review for reconsiderations, which requires a demonstrated error in law or fact made by the USPTO Director in the final decision. The mere fact that the USPTO Director imposed discipline on Appellant, whereas the state bars did not, is not sufficient evidence to show that an error in law or fact was made by the USPTO Director. Thus, for the reasons above, this argument is rejected.

III. Appellant's Requests

Included in Appellant's Request are three additional requests for consideration by the USPTO Director: a request that the disciplinary matter be reopened and amended pursuant to 37 C.F.R. § 11.55(h) to include "include all documents filed in this matter both before the ALJ and that material before the USPTO Director," and an affidavit from Mr. William Windsor (*See*

Request, at 19-20); a request to correct the Administrative Record to include all documents making up the Administrative Record including Appellant's subpoenas and Touhy-related documents (*See* Request, at 21); and a request for clarification of the charges after the USPTO Director's May 25, 2017, decision. (*See* Request, at 21).

Appellant makes his request to reopen the disciplinary matter to include additional documents (*See* Request, at 20) under 37 C.F.R. § 11.55(h), which provides that "[a]ny request to reopen a disciplinary proceeding on the basis of newly discovered evidence must demonstrate that the newly discovered evidence could not have been discovered by due diligence." However, the exact nature of Appellant's first request is unclear as Appellant's objective appears to be to submit additional documents for consideration by the USPTO Director, but Appellant cites to the legal authority to reopen a disciplinary proceeding. Notwithstanding Appellant's true objective, what is clear is that Appellant has failed to meet the standard under § 11.55(h) as Appellant has not provided any newly discovered evidence to support his request to reopen the disciplinary hearing. Appellant offers no documentary evidence or any legal analysis to support his request, thus there appears to be no justification to warrant the reopening of the disciplinary matter. With regard to Appellant's request to admit an affidavit clarifying Mr. Windsor's testimony taken by the USPTO (*See* Request, at 19-20), Appellant provides as support only the justification that he was prevented from participating in Mr. Windsor's deposition because it was rescheduled at the last moment. *Id.* at 20. However, as discussed above, this document is not considered "newly discovered evidence" as it appears to be substantially the same information provided by Mr. Windsor's previous testimony given during the proceeding before the ALJ. Appellant had opportunity after Mr. Windsor's testimony before the USPTO to submit this affidavit, but did

not. Appellant's justifications do not warrant the reopening of the disciplinary matter, thus Appellant's request is **DENIED**.

Appellant also makes a renewed request to correct the Administrative Record to include all documents including Appellant's subpoenas and Touhy-related documents, Appellant cites to no legal authority nor provides any new justification for the request other than to allege that the USPTO "lost" records because they are allegedly missing from the record. *See* Request, at 21. In an Order dated March 8, 2017, the USPTO Director determined that the Administrative Record was complete, and Appellant's renewed request does not provide any additional justification or argument that would warrant reversing that determination, thus, Appellant's request is **DENIED**.

Finally regarding Appellant's request for clarification of the charges after the USPTO Director's May 25, 2017, decision, this request is not appropriate because it is outside the scope of a proper request for reconsiderations under the regulations at 37 C.F.R. § 11.56. The USPTO directs Appellant to review the May 25, 2017 Final Order for more information. Thus, Appellant's request is **DENIED**.

IV. Petition for the Suspension of Rules

Appellant includes in his Request a Petition to Waive Any Applicable Regulation Pursuant to 37 C.F.R. § 11.183, in the event that his Request is not granted. *See* Request, at 21-22. However, the regulation cited by Appellant, 37 C.F.R. § 11.183, does not exist. If Appellant is attempting to cite to the provision at 37 C.F.R. § 1.183, which allows for petitions to the Director for the waiver of any regulation in 37 C.F.R. Part 1 in an extraordinary situation when justice requires, that regulation is inapplicable. By its terms, § 1.183 allows for the waiver of only those regulations in 37 C.F.R. Part 1, which set forth the rules of practice in patent cases. Appellant was disciplined under 37 C.F.R. Part 11, which governs practitioners before the

USPTO, for nine counts of professional misconduct through violations of the USPTO Code of Professional Responsibility, 37 C.F.R. §§ 10.20 through 10.112, and the USPTO Rules of Professional Conduct, 37 C.F.R. §§ 11.101 through 11.901.2.⁵ These provisions clearly do not fall under the scope of § 1.183. Therefore, the waiver provision at § 1.183 is not applicable here. Assuming that Appellant intended to cite to the suspension of rules provision for disciplinary matters at 37 C.F.R. § 11.3, Appellant does not identify those regulations he is requesting to be waived, nor does he demonstrate the extraordinary situation that is required for granting a petition under this provision. Appellant's only support for his request are his claims of innocence on each of the charges against him, the political nature of this prosecution, and the large number of issues contained in the record. *See* Request, at 22. However, these claims are asserted without any additional evidence or information that justifies waiving the rules. Because Appellant's request fails to identify the regulation to be waived or demonstrate any extraordinary circumstances that meet the standard under § 11.3, this request is **DENIED**.

IT IS SO ORDERED.

2/9/18
Date

Sarah T. Harris
Sarah T. Harris
General Counsel
United States Patent and Trademark Office

on delegated authority by

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

cc:

⁵ The USPTO Code of Professional Responsibility applies to practitioner misconduct that occurred prior to May 3, 2013, while the USPTO Rules of Professional Conduct, 37 C.F.R. § 11.101 et seq., apply to a practitioner's misconduct occurring after May 2, 2013.

cc:

Louis Piccone

[REDACTED]

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