

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

In the Matter of)	
)	
Edwin D. Schindler,)	Proceeding No. D2019-43
)	
Appellant.)	
_____)	

FINAL ORDER

Pursuant to 37 C.F.R. § 11.55, Edwin D. Schindler (“Appellant”) has appealed the September 23, 2021 Initial Decision and Order (“Initial Decision”) of Administrative Law Judge (“ALJ”) J. Jeremiah Mahoney to the Director of the United States Patent and Trademark Office (“USPTO” or “Office”). In that Initial Decision, the ALJ concluded that Appellant violated USPTO’s disciplinary rules¹ 37 C.F. R. §§ 11.505, 11.804(d), 11.105(b) and (e), 11.102(a), 11.104(a)(2), (a)(3), and b, and 11.804(c) and (d), and, after considering the relevant factors set forth in 37 C.F.R. § 11.54(b), the ALJ ordered that Appellant be suspended from practice before the USPTO for not less than two years.

For the reasons set forth below, the ALJ’s Initial Decision is **AFFIRMED**.

I. FINDINGS OF FACT

A. Background

1. At all times relevant to the Complaint, Appellant has been a registered patent attorney (Registration No. 31,459) who has been authorized to practice before the USPTO in patent

¹ 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.

matters. (A.1781 ¶ 1; A.1963)². As such, he is subject to the USPTO Rules of Professional Conduct (“USPTO Rules”). *See* 37 C.F.R. §§ 11.101 through 11.901.

2. Appellant was admitted to practice law in New York on May 22, 1985, and is currently an active member in good standing. (A.1781 ¶ 2; A.1962; A.9754).

3. Appellant’s practice consists mostly of “patent and trademark law, mostly prosecutions, some litigation.” (A.9754). Appellant testified that he performs most of his work “through foreign patent associates” who send him work for their clients, which Appellant then reviews and files with the USPTO. (A.9754).

4. Appellant has known and worked on patent and trademark matters with a New York attorney, Michael Kroll for many years. (A.9755; A.9768-69).

B. Kroll’s Disciplinary History

5. Mr. Kroll is an attorney licensed to practice law in the state of New York. (A.1781 ¶ 4). Mr. Kroll was formerly authorized to practice as a patent attorney before the USPTO. (A.1781 ¶ 3).

6. Mr. Kroll was suspended from practice before the USPTO effective May 18, 2016. (A.2070-2077) (Gov. Ex. 10). Mr. Kroll is currently excluded from practice pursuant to Final Orders dated December 11, 2017 and April 5, 2021. (A.2101-2132).³ Appellant represented Mr. Kroll in the disciplinary proceedings before the USPTO. (A.2076-77; A.2132).

² References to specific pages in the Administrative Record are designated as “A. _”.

³ On April 5, 2021, an ALJ in a separate disciplinary proceeding issued an Initial Decision and Order concluding, among other things, that Mr. Kroll’s arrangement with Respondent at issue in this matter constituted the unauthorized practice of law and imposing a sanction of exclusion. *In re Kroll*, Proceeding No. D2019-15 (USPTO Apr. 5, 2021) (Initial Decision and Order) https://foiadocuments.uspto.gov/oed/Kroll_Initial_Decision_and_Order_D2019-15_dated_04_05_2021_Redacted.pdf. The Initial Decision and Order became the final decision of the USPTO Director pursuant to 37 C.F.R. § 11.54(d).

7. Appellant admitted that, at all times relevant to the current charges, he was aware Mr. Kroll was not authorized to practice before the USPTO. (A.1781 ¶ 3; A.9756-57).

8. Prior to Mr. Kroll's suspension, Appellant helped draft patent prosecution documents for Mr. Kroll, some of which Mr. Kroll would file and some of which Appellant would file under his own name. (A.9769, lines 4-8). For more than a decade prior to his suspension, Mr. Kroll listed Appellant on powers of attorney that he filed on behalf of his clients. (A.9769, lines 9-18; A.9770, lines 3-11).

9. Following his suspension, Mr. Kroll purportedly told Appellant that he sent a notification to all of his clients informing them that he had been suspended. (A.9816; lines 12-25; A.9817; lines 2-22). Appellant produced a copy of the "general notification," dated July 17, 2016, that Mr. Kroll claimed to have sent to his clients informing them of his suspension and that Appellant would be handling their patent file until the suspension was resolved. (A.8262; A.9818, lines 5-12). Appellant never saw proof that the notification was sent to specific clients. (A.9817, lines 11-14).

C. Appellant and Mr. Kroll's representation of specific joint clients

a. [REDACTED]

10. Appellant and Mr. Kroll jointly represented [REDACTED] with respect to multiple patent applications. (A.1781-82 ¶¶5, 14, 15). Appellant never directly communicated with [REDACTED] and allowed Mr. Kroll to handle all communications with the client. (A.3140; A.9835, lines 21-24).

11. On [REDACTED], [REDACTED] executed a Declaration and Power of attorney in favor of Appellant and Mr. Kroll. (A.1781 ¶ 5; A.8242; A.5000). The Declaration and Power of

Attorney did not list any information of the Appellant except his name and USPTO registration number. (A.8242; A.5000).

12. On [REDACTED], Mr. Kroll filed U.S. Patent Application No. [REDACTED] application (“the [REDACTED] application”), which named [REDACTED] as the sole inventor of his “[REDACTED]” invention. (A.1781 ¶ 5; A.4949). The [REDACTED] application was still pending when Mr. Kroll was suspended from practice in 2016. (A.9815, lines 11-14).

13. [REDACTED] told the USPTO’s Office of Enrollment and Discipline (“OED”) that Mr. Kroll had never disclosed his suspension or exclusion to him and that he had continued to work directly with Mr. Kroll on his patent matters uninterrupted. (A.3140; A.9916, lines 10-15). He also told OED that he did not know who Appellant was and that he had no idea Appellant was working on his patent matters. (A.3140; A.9916, lines 16-20). He produced to OED 786 pages of correspondence he had received from Mr. Kroll, none of which contained the “general notification” Mr. Kroll claimed he had sent to all of his clients. (A.3141-3926).

14. On [REDACTED], the USPTO issued an Office Action in the [REDACTED] application. (A.5089-5110). Because Mr. Kroll had not filed a notice of withdrawal in the [REDACTED] application following his May 18, 2016 suspension, the Office Action was mailed directly to him. (A.5089; A.9815, lines 15-19). On October 3, 2016, Mr. Kroll sent [REDACTED] a letter notifying him of the Office Action, advising on options for responding, consequences for not responding, and quoting a \$3,650 fee for the filing of a response. (A.3143-44). The letter identified Mr. Kroll as “Attorney at Law” and prominently featured his contact information with the words “Patents Trademarks &

Copyrights” directly below. (A.3143). Appellant was only mentioned in a footnote, stating “Above to be performed by Leonard Belin, Reg. #18,062; Edwin D. Schindler, Reg. #31,459; and/or Joseph C. Merek, Reg. #57,953 all of whom are registered to practice before the US Patent and Trademark Office.” (A.3144). The letter did not contain Appellant’s telephone number, address, or any other contact information; it provided only his USPTO registration number. (A.3143-44; A.9821-22, lines 25-4).

15. On January 12, 2017, Mr. Kroll emailed [REDACTED] stating that “the response to the last office action is being processed and we will advise as soon as we hear back from the Patent Office.” (A.3162). Thereafter, on [REDACTED], Appellant filed a response to the Office Action and Change of Correspondence Address with the USPTO. (A.5111-31). Of the \$3,650 in funds collected by Mr. Kroll for the response, Appellant received only \$800. (A.9826-27, lines 25-6). Appellant testified that Mr. Kroll had earned the most of the fee by referring the client, dealing with the client, and contacting the client. (A.9287, lines 15-17).

16. On [REDACTED], the USPTO issued another Office Action in the [REDACTED] application. (A.5136-61). The Office Action was sent directly to Appellant. (*Id.*) On August 30, 2017, Mr. Kroll sent [REDACTED] a letter advising him about the Office Action and again quoting a \$3,650 fee for the filing of a response. (A.3250-51). Again, Mr. Kroll signed the correspondence, which contained only Mr. Kroll’s contact information and identified him as an “Attorney At Law” in “Patents, Trademarks & Copyrights.” (*Id.*) Appellant was again only mentioned in a footnote. (*Id.*) On [REDACTED], Appellant filed an Amendment in response to the Office Action. (A.5162-72).

17. On [REDACTED], the USPTO issued a Final Rejection for the [REDACTED] Application. (A.5176-5202). In a January 24, 2018 letter, Mr. Kroll advised [REDACTED] that “we need to

respond to the attached office action” and quoted a fee of \$3,275 for the filing of a response. (A.3324-27). On [REDACTED], Appellant filed a Request for Continued Examination. (A.5203-19). Out of that fee, Mr. Kroll paid Appellant \$1,625 in the form of two checks, \$800 of which was for Appellant and the remainder for USPTO fees. (A.8254-55, A.9850, lines 17-20).

18. On [REDACTED], the USPTO issued another Office Action. (A.5225-62). As of the date of the hearing, the application remained pending. (A.9848, lines 2-4).

19. In addition to the [REDACTED] application, Appellant and Mr. Kroll represented [REDACTED] in connection with U.S. Patent Application No. [REDACTED] (“the [REDACTED] application”), which named [REDACTED] as the sole inventor of his “[REDACTED]” invention. (A.1782 ¶14; A.5285-94). On February 25, 2017, Mr. Kroll sent an email stating, “This will confirm we are working on your [REDACTED]” and recommending [REDACTED] “file a patent application ASAP so that you can maintain priority and not lose the invention to an earlier filer.” (A.3167). On March 17, 2017, Mr. Kroll emailed [REDACTED], attaching a draft patent application and asking [REDACTED] to review and advise if there were any necessary changes or additions. (A.3175-76). Mr. Kroll did not copy Appellant on the email or provide [REDACTED] with Appellant’s contact information. (*Id.*)

20. On March 27, 2017, Mr. Kroll sent [REDACTED] another draft of the patent application. (A.3201-02). Again, Mr. Kroll did not copy Appellant or provide [REDACTED] with Appellant’s contact information. (*Id.*) Mr. Kroll advised [REDACTED] that “[t]rademark protection may also be available if you have a special name for your invention.” (*Id.*) At the hearing, Appellant admitted that Mr. Kroll’s advising [REDACTED] of the availability of trademark protection constituted legal advice. (A.9860-61, lines 25-8).

21. On [REDACTED], Appellant filed the [REDACTED] application. (A.5285-94). Mr. Kroll drafted the application and Appellant revised it “as to form.” (A.9857, lines 3-13). Appellant never directly communicated with [REDACTED] prior to filing the application. (A.9857, lines 22-25; A.9858, lines 1-2). This is so, even though Appellant was the only practitioner listed on the Declaration and Power of Attorney filed in the [REDACTED] application. (A.5279). Mr. Kroll gave Appellant \$400 of the funds he received from [REDACTED] for what Appellant testified was five hours of work. (A.9857, lines 2-3, 13-14). [REDACTED] paid Mr. Kroll “a lot more money” for prosecution of the [REDACTED] application than the \$400 Appellant received. (A.9857, lines 16-21).

22. Appellant and Mr. Kroll also represented Dr. Botero with respect to U.S. Patent Application No. 15/650,961 (“the ’961 application”), which named Dr. Botero as the sole inventor of his “High-Pressure Heat Bulb” invention. (A.1782 ¶15; A.5316-25). On July 16, 2017, Appellant filed the ’961 application. (*Id.*) That same day, Mr. Kroll sent an email to Dr. Botero notifying him of the filing and advising him to file in Canada. (A.3248). On July 27, 2017, Mr. Kroll sent another email reiterating his advice that Dr. Botero file to patent his invention in Canada. (A.3247-48). In neither email did Mr. Kroll mention Appellant or provide his contact information. (A.3247-48).

23. On March 30, 2018, the USPTO issued an Office Action in the ’961 Application and, on April 5, 2018, Mr. Kroll sent Dr. Botero a letter in which he informed Dr. Botero of the Office Action. (A.3270-3273; A.5327-39). As in the other applications, Mr. Kroll referred to himself as “Attorney at Law” in “Patents, Trademarks & Copyrights,” did not provide Appellant’s contact information, and only mentioned him in a footnote as one of multiple practitioners who might work on the matter. (A.3272-73). On September 30, 2018, Appellant filed a response to the

Office Action with the USPTO. (A.5341-54). Appellant received a payment from Mr. Kroll of \$1,500 with respect to this response; \$900 to pay USPTO fees and \$800 for himself. (A.8253).

24. On January 23, 2019, the USPTO issued another Office Action in the '961 Application. (A.5356-62). On July 12, 2019, Mr. Kroll paid Appellant \$2,150 for his work on the '961 Application, \$800 of which was for Appellant and the remainder for USPTO fees. (A.8256).

b. [REDACTED]

25. On [REDACTED], prior to his 2016 suspension, Mr. Kroll filed U.S. Patent Application No. [REDACTED] ("the [REDACTED] application"), which named [REDACTED] as the sole inventor of his "[REDACTED]" invention. (A.1782 ¶ 12; A.5535). The filing included a power of attorney executed in favor of Mr. Kroll and Appellant. (A.1782 ¶ 12; A.5573).

26. On [REDACTED], after Mr. Kroll's suspension, the USPTO sent a notice of abandonment to Mr. Kroll, who had not withdrawn from the representation or changed the correspondence address for the application. (A.5667-69). Appellant did not inform [REDACTED] that the [REDACTED] application had become abandoned. (A.4051).

27. Appellant was also listed on the power of attorney for two additional applications filed by Mr. Kroll on behalf of [REDACTED] prior to Mr. Kroll's suspension. (A.5851; A.5944). Following Mr. Kroll's suspension, Appellant made filings in at least one of the applications. (A.5996; A.6004; A.6022).

28. [REDACTED] later told OED that he did not know that Mr. Kroll had been suspended and excluded from practice before the USPTO and that he was not aware of Appellant's involvement with his applications or that Appellant was receiving a portion of the fees that [REDACTED] had paid to Mr. Kroll. (A.4051; A.9919-20, lines 18-3).

c. Mr. Adel El-Hennawy and Dr. Elena Frolova.

29. On March 6, 2015, prior to his suspension, Mr. Kroll filed U.S. Patent Application No. 14/641,078 (“the ’078 application”), which named Adel Sayed El- Hennawy and Elena Frolova as joint inventors of their “Lock Solution for Venous Catheters Using Sodium Bicarbonate” invention. (A.1782 ¶ 10; A6033-34). The filing included a power of attorney executed in favor of Mr. Kroll and Appellant. (A.1782 ¶ 10; A.6060)

30. On January 11, 2017, after Mr. Kroll’s suspension, the USPTO issued a nonfinal rejection in the ’078 application. (A.6128-37). On May 5, 2017, Appellant submitted an amendment and request for reconsideration. (A.6148-51). On October 17, 2017, the USPTO issued Patent Number 9,789,227 based on the ’078 application. (A.6176). Appellant did not have any direct communication with Mr. El-Hennawy or Dr. Frolova or explain his fee structure to them. (A.9868, lines 20- 25; A.9869, lines 1-2).

31. Mr. El-Hennawy later told OED that Mr. Kroll had never disclosed that he had been suspended or excluded from practice before the USPTO, he had no idea who Appellant was or that he was working on his application, and he had not agreed for Appellant to do so. (A.2406; A.9907-08, lines 17-5). Mr. El-Hennawy estimated that he paid Mr. Kroll around \$30,000 to prosecute the ’078 application. (A.2406).

d. Mr. Amer Samad

32. On June 5, 2015, prior to his suspension, Mr. Kroll filed U.S. Patent Application No. 14/732,076 (“the ’076 application”), which named Amer Samad as the sole inventor of his “Portable Adjustable Stair Railing” invention. (A.1782 ¶ 6; A.6190-92). The filing included a power of attorney executed in favor of Mr. Kroll and Appellant. (A.1782 ¶ 6; A.6233).

33. On January 8, 2018, after Mr. Kroll's suspension, Appellant filed a response to an Office action issued in the '076 application. (A.6309-25). In September 2018, Appellant received a \$1,275 check from Mr. Kroll in connection with the '076 application. (A.8261). On October 1, 2018, Appellant filed an Amendment to the '076 application. (A.6481-90) Appellant never directly communicated with Mr. Samad about the '076 application and did not communicate with him in writing regarding the structure of his fees. (A.9866, lines 7-16).

34. Mr. Samad later told OED that Mr. Kroll never informed him that he had been suspended or excluded from practice before the USPTO, that he had continued to work directly with Mr. Kroll on the '076 application, and that he did not know who Appellant was or that Appellant was involved in the prosecution of his patent application. (A.2534).

e. [REDACTED]

35. On [REDACTED], prior to his suspension, Mr. Kroll filed U.S. Patent Application No. [REDACTED] ("the [REDACTED] application"), which named [REDACTED] as the sole inventor of his "[REDACTED]" invention. (A.1782 ¶ 13; A.6702-06). The filing included a power of attorney executed in favor of Mr. Kroll and Appellant. (A.1782 ¶ 13; A.6736).

36. In the [REDACTED] application, Appellant submitted a response to an Office Action on [REDACTED]; a request for continued examination on [REDACTED]; an amendment and request for reconsideration on [REDACTED]; and another request for continued examination on [REDACTED]. (A.6756-58; A.6782; A.6809-15; A.6844). Appellant received a \$1,400 check from Mr. Kroll for his work responding to an Office Action on [REDACTED] behalf, consisting of \$800 for his legal fee and the remainder for USPTO filing fees. (A.8260; A.9800, lines 12-

25). Appellant did not speak directly with [REDACTED] until 2019 and never informed [REDACTED] of his fee structure. (A.9869-70, lines 19-16).

f. [REDACTED]

37. On [REDACTED], prior to his suspension, Mr. Kroll filed U.S. Patent Application No. [REDACTED] (“the [REDACTED] application”), which named [REDACTED] as the sole inventor of his “[REDACTED]” invention. (A.1782 ¶ 7; A.6889-93). The filing included a power of attorney to Mr. Kroll and Appellant. (A.1782 ¶ 7; A.6939).

38. On [REDACTED], Appellant filed a response to an Office Action in the [REDACTED] application. (A.6963-68). On [REDACTED], the USPTO issued a Final Rejection in the [REDACTED] application and sent it to Appellant. (A.6996-7007). Appellant did not file a response, causing the USPTO to issue a Notice of Abandonment on [REDACTED]. (A.7008-09).

39. Appellant never directly communicated with or explained his fee structure to [REDACTED] (A.9866-67, lines 17-8). [REDACTED] later told OED that Mr. Kroll had not informed him of his suspension or exclusion from practice before the USPTO, he had never met Appellant and did not know that Appellant was making filings in the [REDACTED] application, and he was unaware that the application had become abandoned nearly a year earlier. (A.4404; A.9927-28, lines 5-2).

g. Mr. Andrew Cochran

40. On April 21, 2016, prior to his suspension, Mr. Kroll filed U.S. Patent Application Nos. 15/136,286 (“the ’286 application”) and 15/135,322 (“the ’322 application”), which named Andrew Cochran as the sole inventor of his “Segmented Shaped Swim Fin” and “Segmented Rounded Swim Fin” inventions. (A.1782 ¶¶ 8-9). Both filings included powers of attorney executed in favor of Mr. Kroll and Appellant. (A.1782 ¶¶ 8-9; A.7037; A.7145).

41. On June 14, 2018, Notices of Abandonment for both the '286 application and '322 application were mailed directly to Appellant. (A.7116-17; A.7221-22). Approximately a month earlier, on May 7 and [REDACTED], 2018, Appellant had submitted two design patent applications on Mr. Cochran's behalf, both titled "Swim Fin" under U.S. Patent Application Nos. 29/646,781 and [REDACTED]. (A.7224-25; A.7261-62). Appellant did not directly communicate with Mr. Cochran until March 2019 and did not disclose the structure of his fee to Mr. Cochran. (A.9867, lines 20-25; A.9868, lines 1-10).

42. On August 15, 2018, Mr. Cochran told OED that Mr. Kroll had never disclosed his suspension or exclusion from practice before the USPTO and that Mr. Kroll had recently informed him that his patent matters were on track. (A.4516; A.9930, lines 1-6). Mr. Cochran was not aware of Appellant or his involvement in his patent applications, that his utility patent applications had been abandoned, or that design patent applications had been filed on his behalf. (A.4516; A.9930, lines 7-10).

II. OED DISCIPLINARY PROCEEDING

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, 11.39 on July 10, 2019 (A.25-64). The Complaint alleged three Counts of misconduct including assisting in the unauthorized practice of law (Count I), improperly dividing fees without client consent (Count II), and failure to communicate with clients (Count III). (*Id.*) The OED Director requested that Appellant be excluded or suspended from practice before the USPTO in patent, trademark, and other non-patent matters. (A.61).

Appellant filed his "Answer to Complaint and Notice of Proceeding Under 35 U.S.C. § 32" ("Answer") on August 9, 2019 and raised various defenses and counterclaims. (A.73-187).

After consideration and denial of various motions filed by Appellant, a hearing was held on November 20, 2019 in Islip, New York. (A.9728-10006). Both Appellant and OED Staff Attorney, Diana Oleksa, testified at the hearing and exhibits were received into evidence. (A.9731-9733). Post-hearing briefs were filed in lieu of closing arguments. (A.1822-1911).

III. INITIAL DECISION BY ADMINISTRATIVE LAW JUDGE

The Initial Decision concluded that Appellant violated 37 C.F.R. ¶¶ 11.505 and 11.804(d)(Count I); 11.105(b) and (e)(Count II), and 11.102(a), 11.104(a)(2), (a)(3) and (b), and 11.804(c) and (d) (Count III). (A.17). The ALJ ordered that Appellant be suspended for not less than two years from practice before the USPTO. (A.20).

Appellant filed a timely Notice of Appeal To The USPTO Director on June 20, 2023.⁴ Thereafter he filed “Respondent Edwin D. Schindler’s Appeal brief, Pursuant to 37 C.F.R. § 11.55” (Appeal Brief). In the Appeal Brief, Appellant claims the findings concerning the unauthorized practice of law must be reversed since the definition of “practice before the Office” is overly broad and improperly prohibits Mr. Kroll from engaging in activities before the office that are permissible for non-registered foreign attorneys. *See* Appeal Brief, at 36-41. He also asserts that any division of legal fees was appropriate since Mr. Kroll remained an attorney in good standing in New York and he was properly associated with and supervised by Appellant. *See id.* at 22-25. Finally, he argues that he should not have been sanctioned by the ALJ. *See id.* at 49-54.

⁴ The parties never received the Initial Decision issued on September 23, 2021 due to delays from the ALJ’s office. *See* Memorandum from J. Jeremiah Mahoney to Sydney O. Johnson, re: *In the Matter of Edwin D. Schindler*, Proceeding No. D2019-43 (June 8, 2023). The Initial Decision was redistributed to the parties in June 8, 2023 and Respondent was allotted fourteen (14) days after the service of the redistributed Initial Decision to appeal to the USPTO Director. *See id.* As a result, the Appellant’s appeal was timely filed.

IV. DECISION

The USPTO Director shall decide an appeal from an initial decision of the hearing officer. On appeal from the initial decision, the USPTO Director has authority to conduct a *de novo* review of the factual record. 37 C.F.R. §§ 11.55(l), 11.56(a). *See also Marinangeli v. Lehman*, 32 F. Supp. 2d 1, 5 (D.D.C. 1998). The USPTO Director 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. 37 C.F.R. §§ 11.55(l), 11.56(a).

The OED Director has the burden of proving the alleged violations by clear and convincing evidence. 37 C.F.R. § 11.49. "Evidence is clear 'if it is certain, unambiguous, and plain to the understanding,' and it is convincing 'if it is reasonable and persuasive enough to cause the trier of facts to believe it.'" *Foster v. AlliedSignal, Inc.*, 293 F.3d 1187, 1194 (10th Cir. 2002).

Having considered the record, as well as the arguments presented by the parties, the ALJ's Initial Decision is Affirmed.

A. Appellant Engaged in Misconduct That Violated USPTO's Disciplinary Rules.

As noted, the USPTO Director reviews an appeal from an ALJ Initial Decision on the record before the ALJ. *See* 37 C.F.R. §§ 11.55(l), 11.56(a). And as discussed more fully below, the record plainly and unambiguously supports the ALJ's conclusions that Appellant violated USPTO's disciplinary rules. Thus, the ALJ's Initial Decision is Affirmed.

1. 37 C.F.R. §§ 11.505 and 804(d).

The Complaint charged Appellant with assisting Mr. Kroll in the unauthorized practice before the USPTO in violation of 37 C.F.R. §§ 11.505 and 804(d), by enabling Mr. Kroll's continued representation and counseling of clients before the USPTO. (A.57-58). The ALJ concluded that the OED Director sufficiently proved this charge and, consequently, Appellant

was found to have violated both §§ 11.505 and 11.804(d). (A.13). After a review of the record, as well as the parties' arguments and briefs, this finding is Affirmed.

a. 37 C.F.R. § 11.505

The USPTO Rules plainly state that “[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.” 37 C.F.R. § 11.505. The USPTO is considered a jurisdiction for the purposes of this rule. *Changes To Representation Of Others Before The United States Patent And Trademark Office*, 78 Fed. Reg. 20180-01, 2013 WL 1309612 (Apr. 3, 2013); *see also In re Discipline of Peirce*, 128 P.3d 443 (Nev. 2006) (“We therefore conclude that ‘another jurisdiction’ includes the USPTO.”). Thus, to prove its claim that Appellant violated 37 C.F.R. § 11.505, the OED Director must establish that Mr. Kroll engaged in unauthorized practice before the Office and that Appellant facilitated such practice. *See In re Bang-er Shia*, Proceeding No. D2014-31, at 34 (USPTO Mar. 4, 2016)⁵. As discussed further, below, the OED Director is able to establish both of these factors.

i. Mr. Kroll's Unauthorized Practice of Law.

The USPTO's definition of “practice before the office” is clearly articulated in the disciplinary rules. “Practice before the Office” includes, but is not limited to, any “law-related service that comprehends any matter connected with the presentation to the Office or any of its officers or employees relating to a client's rights, privileges, duties, or responsibilities under the laws or regulations administered by the Office for the grant of a patent or registration of a trademark.” 37 C.F.R. § 11.5(b) (2012). This includes “preparing necessary documents in contemplation of filing the documents with the Office ... as well as communicating with and

⁵ https://foiadocuments.uspto.gov/oed/0874_dis_2016-03-04.pdf

advising a client concerning matters pending or contemplated to be presented before the Office.” *Id.*; *see, e.g., In re Piccone*, Proceeding No. D2015-06, at 24-25 (USPTO May 25, 2017)⁶ (finding that disbarred attorney engaged in “practice before the Office” where he was identified as attorney-of-record and correspondent for patent application and participated in drafting response to Office action).

That Mr. Kroll continued to communicate with an advise clients concerning matters pending or contemplated to be presented before the Office is not in dispute. During the disciplinary hearing, for example, Appellant conceded that Mr. Kroll continued to give legal advice to their joint clients with respect to matters pending before the Office even after being suspended from practice in May 2016. (A.9860-61, lines 25-8).

While Appellant’s concession is sufficient to establish that Mr. Kroll engaged in the unauthorized practice of law, the record identifies and sets forth many other instances of practice before the Office as defined by § 11.5(b). Mr. Kroll’s actions with regard to [REDACTED], alone, reveal that he counseled him regarding options for prosecuting patents, advised him of the legal significance of Office correspondence, strategized with him regarding the filing of documents such as patent applications and responses to office actions, and identified himself as a current patent attorney. *See Supra*, Sect. I.C. ¶¶ 14, 16, 17, 19, 20, 22, 23. This is all activity that constitutes practice before the Office.

Other activities that indicate Mr. Kroll engaged in the unauthorized practice of law include that he did not promptly withdraw or change the correspondence address for some applications and remained attorney-of-record for after he was suspended from the practice before the USPTO in violation of 37 C.F.R. § 11.58(b)(1)(i)(c), and that he remained the sole point of contact for

⁶ https://biadocuments.uspto.gov/oed/0942_dis_2017-05-25.pdf

clients on patent matters. *See Supra*, Sect. I.C. ¶¶ 33, 36, 39, 41. In fact, many clients had no idea that Mr. Kroll had been suspended or knew who Appellant was or that he was working on their matters. *See Supra*, Sect. I.C. ¶¶ 28, 31, 34, 39, 42. Mr. Kroll also unilaterally set the fee for legal services that Appellant provided. *See Supra*, Sect. I.C. ¶¶ 14, 15, 17, 21, 23, 24. These actions, all occurring while Mr. Kroll was suspended or excluded, all constitute unauthorized practice before the Office in violation of § 11.5. *See also In re Piccone, supra* at 25 (remaining attorney of record in trademark matter and receiving correspondence from USPTO while suspended was unauthorized practice of law).

In opposition to this conclusion, Appellant asserts that Mr. Kroll is a general practice attorney who is an attorney in good standing with the New York State Bar. *See* Appeal Brief, at 7-8. As such, Appellant argues that Mr. Kroll is permitted to engage in litigation before federal and state courts, even in matters involving intellectual property matters, and he has first amendment rights to provide legal advice to others. *See id.* at 10-13. However, these arguments do not provide Appellant with respite from discipline.

First, Mr. Kroll's active New York license is of little relevance to this matter. It is long settled that the USPTO's has the exclusive authority to exclude practitioners from practice before it and that the USPTO's "regulations governing the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Patent Office" preempt state laws governing the practice of law. *See Sperry v. State of Fla., x rel. Fla. Bar*, 373 U.S. 379, 384 (1963); *see also Kroll v. Finnerty*, 242 F.3d 1359, 1364 (Fed. Cir. 2001) ("The [US]PTO has exclusive authority to establish qualifications and procedures for admitting persons to practice before the [US]PTO, and to suspend or exclude those patent practitioners from practicing before the [US]PTO."); *In re Shia*, Proceeding No. D2014-31 at 20 ("It is long-settled that regulating

admission and disciplinary issues before the USPTO lies within USPTO's exclusive jurisdiction.”) Accordingly, while Mr. Kroll’s New York license may permit him to lawfully practice in the New York courts, that license does not permit him to practice before the USPTO subsequent to his suspension, and later, exclusion before the USPTO. Only the USPTO may authorize practitioners to engage in practice before it.

Appellant’s First Amendment argument is also without merit and the OED Director correctly sets forth the reasons why. “The [United States] Supreme Court has long recognized that governmental regulation of the professions is constitutional if the regulations ‘have a rational connection with the applicant’s fitness or capacity to practice’ the profession.” *Acct’s. Soc’y. of Va. v. Bowman*, 860 F.2d 602, 603–04 (4th Cir. 1988) (quoting *Lowe v. S.E.C.*, 472 U.S. 181, 228 (1985) (Justice White, concurring)); *see also Cap. Associated Indus., Inc. v. Stein*, 922 F.3d 198, 207–08 (4th Cir. 2019) (“Many laws that regulate the conduct of a profession or business place incidental burdens on speech, yet the [United States] Supreme Court has treated them differently than restrictions on speech.”) Jurisdictions “have a right to restrict the practice of law to qualified individuals, thus justifying the unauthorized practice rule’s provision that lawyers may not assist non-lawyers in the unauthorized practice of law. Any abridgment of the right to free speech is merely the incidental effect of observing an otherwise legitimate regulation.” *Lawline v. Am. Bar Ass’n*, 956 F.2d 1378, 1386 (7th Cir. 1992) (citing, *inter alia*, *Ohralik v. Ohio State Bar Ass’n*, 436 U.S. 447, 459, 467–468 (1978)).

Further, also as the OED Director notes, prior precedent does not support or sanction the argument that Appellant is making here. *See* OED Response, at 28-29. *See also In re Correll*, Proceeding No. D2018-12, at 16-21 (USPTO Feb. 4, 2021)10 (Final Order) (government employee did not have First Amendment right to represent private clients before the USPTO),

affirmed on appeal, *Correll v. Under Sec’y of Com. Of Intell. Prop.* (“Director”), No. 121CV898AJTIDD, 2022 WL 298125, at *2 (E.D. Va. Jan. 13, 2022), *aff’d sub nom., Correll v. Vidal*, No. 2022-1420, 2022 WL 2564106, at *4-5 (Fed. Cir. July 8, 2022) (USPTO’s interests outweigh any alleged burden on free speech; alternatively, practitioners waive any such free speech rights when they register to practice before the PTO by signing an “Oath or Affirmation” in which they promise to “observe the laws and rules of practice of the [PTO]”). Appellant offers no legal argument, analysis, or precedent that undermines this line of cases or to rebut the OED Director’s arguments.

Based on the foregoing, the ALJ’s conclusion that “after May 2016, Mr. Kroll carried on practicing patent law much as he had before his suspension, and because he continued to provide legal advice to clients concerning patent applications pending before the USPTO, his conduct amounted to ‘practice before the Office’”, and that practice was unauthorized, is Affirmed. (A.11).

ii. Appellant Assisted Mr. Kroll in the Unauthorized Practice of Law.

The ALJ also correctly concluded, and the record also shows, that Appellant assisted Mr. Kroll’s unauthorized practice in violation of 37 C.F.R. § 11.58(e)(1)(2013).⁷ That provision prohibits a suspended or excluded practitioner from aiding another practitioner in any way in the other practitioner’s practice of law before the Office unless the suspended or excluded practitioner was a salaried employee under the practitioner’s direct supervision.

First, Mr. Kroll was unequivocally not a salaried employee of Appellant’s firm and there is nothing in the record, or credibly argued by Appellant, to establish such a business arrangement.

⁷ This provision was amended on May 26, 2021. This citation is the version of the rule that was in effect on the dates of Respondent’s misconduct.

Additionally, as the OED Director correctly notes, even if Mr. Kroll had been a salaried employee, he was still prohibited from “communicat[ing] directly in writing, orally, or otherwise with a client of the other practitioner in regard to any immediate or prospective business before the Office” and “[r]ender[ing] any legal advice or any legal services to a client of the other practitioner in regard to any immediate or prospective business before the Office.” 37 C.F.R. § 11.58(e)(3) (2013). Those actions, as already discussed, were the unauthorized practice of law by Mr. Kroll after his suspension and exclusion, and negate any argument that he was somehow only operating under Appellant’s direct supervision.

Appellant argues that his arrangement with Mr. Kroll “is both legally and factually indistinguishable from the acknowledged and acceptable practice before the [US]PTO by foreign patent attorneys and agents who cannot legally practice before the [US]PTO but ‘associate’ with U.S. patent attorneys and agents having recognition to practice before the [United States] Patent and Trademark Office.” Appeal Brief, at 19 (emphasis omitted). *See also*, Reply at 9-22.

However, as an initial matter, Mr. Kroll is not a foreign agent or corporate liaison and, unlike those liaisons, he had been explicitly suspended, then excluded, from practice before the Office. Additionally however, and as the OED Director explains, the USPTO’s published guidance regarding the use of corporate liaisons and foreign agents as intermediaries states that “when [a] practitioner is operating through such a corporate liaison or foreign agent . . . the registered practitioner may rely upon the advice of the corporate liaison or the client/patent applicant’s foreign agent as to the action to be taken *so long as the practitioner is aware that the client/patent applicant has consented after full disclosure to be represented by the liaison or agent.*” OED Response, at 30-31 (citing 1086 OG 457 (Dec. 10, 1987) (emphasis added). *see also* 1091 OG 26 (May 25, 1988)¹³ (“In practice it is common for instructions relating to the

application of an inventor . . . who is the client of the U.S. practitioner, to be passed to the U.S. practitioner through intermediaries, such as corporate liaisons or foreign agents . . . In such an arrangement, the practitioner may rely upon instructions of, and accept compensation from, the corporate liaison or the foreign agent as to the action to be taken in a proceeding before the Office so long as the practitioner is aware that the client has consented to have instructions conveyed through the liaison or agent.”). Here, there is no support offered or provided by Appellant demonstrating that any of Appellant and Mr. Kroll’s clients consented to the arrangement between them. To the contrary, many of their joint clients were not aware of who Appellant was or that Appellant was involved in their legal matters. *See* § C.1 ¶¶ 28, 31, 34, 39, 42. Finally, but no less importantly, the USPTO guidance does not permit intermediary arrangements between a registered practitioner, like Appellant, and an individual who has been suspended or excluded before the office, like Mr. Kroll. *See In re Colitz*, Proceeding No. D1999-04 at 5-8 (USPTO, Dec. 3, 2002) (Final Decision) (determining that USPTO guidance does not permit intermediary arrangement without direct client contact between practitioners party who is not foreign agent or corporate liaison). Appellant cites no authority allowing such an arrangement and for good reason. Such an arrangement plainly contradicts the USPTO’s regulation and guidance. *See* 37 C.F.R. § 11.58(e)(3).⁸ (2013).

In sum, after he was suspended, and then excluded, from practice before the Office, Mr. Kroll continued with his client practice before the USPTO much as he had before he was suspended and excluded. He was only able to so continue with his practice with Appellant’s support and enabling. Indeed, because his credentials had been suspended, he could not continue

⁸ The ALJ and Respondent cite to 37 C.F.R. § 11.58(e) which, at the time of the hearing, governed a disciplined practitioner’s ability to aid a registered practitioner in practice before the Office. This regulation was amended on May 26, 2021 and the provision governing a disciplined practitioner’s ability to aid a registered practitioner is now found at 37 C.F.R. § 11.58(h).

with his activities without reliance on, and the use of, Appellant's credentials and status as a registered practitioner. (A.2131) (language suspending Mr. Kroll's credentials with the USPTO). As such, the ALJ's conclusion that Appellant violated 37 C.F.R. § 11.505 is Affirmed.

b. 37 C.F.R. § 11.804(d)

The Disciplinary Complaint also charged Appellant with, by assisting in unauthorized practice, engaging in conduct prejudicial to the administration of justice, in violation of 37 C.F.R. § 11.804(d) (2020). (A.58) Complaint and Notice of Proceeding Under 35 U.S.C. § 32 (Complaint). *See also* OED Response, at 33. Under that provision, 37 C.F.R. § 11.804(d), it is professional misconduct to engage in conduct that is prejudicial to the administration of justice. Generally, an attorney engages in conduct prejudicial to the administration of justice when his behavior negatively impacts the public's perception of the courts or legal profession or undermines public confidence in the efficacy of the legal system. *See Att'y Grievance Comm'n v. Rand*, 981 A.2d 1234, 1242 (Md. 2009). Courts have found the unauthorized practice of law to represent a serious threat to the effective administration of justice. *See, e.g., United States v. Johnson*, 327 F.3d 554, 560 (7th Cir. 2003); *Am. Express Co. v. Monfort Food Distrib. Co.*, 545 S.W.2d 49, 52 (Tex. Civ. App. 1976). Further, the USPTO Director has previously concluded that assisting in the unauthorized practice of law is conduct prejudicial to the administration of justice. *See Shia, supra*, at 35. Appellant provides no argument or analysis on this point. Thus, having affirmed the finding that Mr. Kroll engaged in the unauthorized practice of law, and Appellant assisted in that misconduct, the ALJ's conclusion that Appellant's conduct was prejudicial to the administration of justice and violated § 11.804(d) is Affirmed.

2. 37 C.F.R. §§ 11.105(b) and (e)

The Complaint charged Appellant with violating 37 C.F.R. § 11.105(b) and (e) when he improperly divided fees with Mr. Kroll and failed to obtain written client agreement before accepting compensation for client work from Mr. Kroll. (A.34-35). The provisions of 37 C.F.R. § 11.105(b) require that the scope of the representation and the basis or rate of the fee and expenses for which the client will be responsible be communicated to the client, preferably in writing, before or within a reasonable time after commencing the representation, except when the practitioner will charge a regularly represented client on the same basis or rate. Further, 37 C.F.R. § 11.105(e) provides that a division of a fee between practitioners who are not in the same firm may be made only if: (1) The division is in proportion to the services performed by each practitioner or each practitioner assumes joint responsibility for the representation; (2) The client agrees to the arrangement, including the share each practitioner will receive, and the agreement is confirmed in writing; and (3) The total fee is reasonable.

The ALJ concluded Appellant violated these provisions when he and Mr. Kroll did not notify their clients of their fee division arrangement or obtain the clients' written consent to the arrangement. (A.13-14). In support of this conclusion, the ALJ noted that not only did Appellant fail to communicate to his joint clients the basis or rate of the fees for which the clients would be responsible, as required under § 11.105(b), but Appellant admitted he rarely communicated with the joint clients at all. (A.13; A.9829, lines 20-24; A.9835, lines 21-24; A.9866, lines 7-10; A.9866-67, lines 25-4; A.9868, lines 20-24; A.9870, lines 1-7). Further, Appellant admitted he did not know the total fee amount Mr. Kroll charged to each client and instead he merely assumed the clients had agreed to a reasonable fee. (A.13; A.9850, lines 17-22; A.9866, lines 11-16; A.9867, lines 5-8; A.9868, lines 6-10; A.9868-69, lines 25-2). Further, none of the clients

consented to any fee arrangement as the power of attorney used by Appellant and Mr. Kroll did not disclose the fee division arrangement. (A.14). *See Supra*, § I.C ¶¶ 28, 33, 36, 39.

Consequently, the joint clients could not have meaningfully consented to the fee arrangement as required by § 11.105(e)(2). (*Id.*)

In his Appeal Brief, Appellant argues that Mr. Kroll has the right to collect and share in a legal fee as his is a general practice attorney in good standing in the state of New York and he relies on the American Bar Association's Formal Opinion 08-451 (Aug. 5, 2008) as support for the idea that he may have any fee arrangement with Mr. Kroll that he chooses. *See Appeal Brief*, at 22-24. He also complains about the ALJ's determination that, under the USPTO rules, an excluded or suspended practitioner can only perform paralegal or other services for a registered practitioner if he was a salaried employee operating under the registered practitioner's direct supervision, claiming it infringes upon Mr. Kroll's "constitutional right to earn a livelihood." *Appeal Brief*, at 22-25. Alternatively, he argues that he and Mr. Kroll formed a law firm. *Id.* at 48. Finally, he asserts that no client filed a grievance or complained of, or is known to have paid, an unreasonable fee. *Id.* at 49). These arguments are without merit.

First, as the OED Director notes, the ABA Formal Opinion is not binding authority on the USPTO. *See OED Response*, at 35. Additionally, the opinion that Appellant relies upon plainly states that "appropriate disclosures should be made to the client regarding the use of lawyers or nonlawyers outside of the lawyer's firm" and "[t]he fees charged must be reasonable and otherwise in compliance with Rule 1.5."⁹ The record is clear that Appellant made no such disclosures to his clients, in violation of § 11.105(b) and (e), *see supra*. §. IC.1 ¶¶ 28, 30, 33, 36, 39, and the ABA Formal Opinion doesn't excuse Appellant's misconduct here.

⁹ Model Rule 1.5(b) and (e) are the equivalent rule to USPTO's §§ 11.105(b) and (e).

Appellant's constitutional argument is also without merit as there is no right to practice before the USPTO. Rather, as the OED Director notes and supports with case law, Mr. Kroll's right to practice before the USPTO was a privilege granted to him, but since revoked.¹⁰ OED Response, at 36 (citing *Asher v. Mississippi Bar*, 661 So. 2d 722, 728 (Miss. 1995) (citing *Mississippi Bar v. Young*, 509 So. 2d 210, 219 (Miss. 1987) and *In re Isserman*, 345 U.S. 286, 289 (1953), judgment set aside 348 U.S. 1 (1954)). Having failed to abide by the USPTO's rules, his ability to practice before the USPTO was properly rescinded.

Next, there is no credible evidence that Appellant and Mr. Kroll formed a law firm, or that their business arrangement otherwise met the definition of a law firm such that the provisions of § 11.105 are inapplicable. There is no evidence that the two share office space or letterhead, share office resources, have a joint account, advertise their services jointly or present themselves as a firm, and Mr. Kroll is not a salaried employee of Appellant's firm. (A.13-14). To the contrary, Appellant conceded that he merely performs referral work for Mr. Kroll. (A.9827, lines 15-17; A.9777, lines 21-24). And finally, more than once during his hearing testimony, Appellant made clear that he and Mr. Kroll were not part of the same firm. Appellant stated that he had his own practice where 90-95% of his practice is his own work and the remainder is acting as a "gatekeeper" for filings and work that Mr. Kroll would have done on his own and for "his own practice" before his suspension. (A.9783, lines 16-24; A.9785, lines 2-13). This undermines his claims of having formed a law firm and he is required to comply with, and failed to comply with, the provisions of § 11.105 here.

¹⁰ To the extent that Appellant appears to argue that he or Mr. Kroll have suffered due process during their respective disciplinary processes, Reply, at 5 (citing *Board of Regents of State Colleges v. Roth*, 408 U.S. 564, 571-572 (1972)), those claims are rejected. The record of Mr. Kroll's prior discipline, as well as these disciplinary proceedings, reveal that both were provided extensive due process.

Lastly, Appellant asserts that no client filed a grievance or complained of, or is known to have paid, an unreasonable fee. Appeal Brief at 49. Though that is a factor relevant to sanction, and it was a factor considered by the ALJ here, it does not negate the existence of a violation of the USPTO's rules.

3. 37 C.F.R. §§ 11.102(a), 11.104(a)(2), (a)(3), (b), and 11.804(c) and (d).

The final count, Count III, of the Complaint charged Appellant with failing to adequately communicate with his clients in violation of 37 C.F.R. § 11.102(a), 11.104(a)(2), (a)(3), (b) and, because of that same misconduct, violated § 11.804(c) and (d). (A.59-60). Here, the ALJ concluded that Appellant violated these provisions as charged by the OED Director. (A.17).

a. 37 C.F.R. § 11.102(a), 11.104(a)(2), (a)(3), (b)

The USPTO Rules set forth a number of requirements that concern a practitioner's duty to reasonably communicate with their clients. First, 37 C.F.R. § 11.102(a)(2020) requires that a practitioner to abide by a clients' decisions regarding the objectives of the representation and to consult with the client as to the means by which the objectives are to be pursued. Also, § 11.104(a)(2) requires practitioners to reasonably consult with clients regarding the means by which the clients' objectives are to be accomplished. Finally, a practitioner must also keep a client reasonable informed about the status of the client's matters and explain matters to the extent reasonably necessary to permit the client to make informed decisions. 37 C.F.R. §§ 11.104(a)(3) and (b).

The record supports the ALJ's conclusions that Appellant violated each of these rules by having no direct communication with his joint clients with Mr. Kroll. At least seven (7) clients had no idea who Appellant even was, much less that he was working on their legal matters. See *Supra*, § C.1. ¶¶ 13, 28, 31, 36, 39, 42. Appellant admitted that he rarely spoke to his and Mr.

Kroll's joint clients and clients were not given Appellant's contact information. (A.15; A.3143-44; A.3175-76; A.3201-2; A.3248-49; A.3250-51; A.3272-73; A.5000; A.5573; A.5851; A.5944; A.6060; A.6233; A.6939; A.8242; A.9829, lines 20-24; A.9835, lines 21-24; A.9866, lines 7-10; A.9866-67, lines 25-4; A.9868, lines 20-24; A.9870, lines 1-7). Simply put, Appellant's statements and the record shows that Appellant impermissibly relied on Mr. Kroll, who was suspended and then excluded from practice before the USPTO, to communicate with clients about their patent applications.

As specific evidence of his failure under these rules, the OED Director notes, and Appellant did not contest at the hearing, Appellant's failures in this Count lead to two clients, Messrs. [REDACTED] and [REDACTED], not being informed that their patent applications had become abandoned. *See* OED Response, at 37. His misconduct also led Mr. Cochran to not being informed that his utility patent applications were abandoned and design patent applications were filed, or provided information about the differences between the two types of application. *See id.* at 37-38. Though Appellant is correct the ALJ did not find that a general failure to consult with clients, the ALJ did find and the record supports that Appellant failed to specifically communicate with his clients in several specific circumstances, (A.16), and as already discussed that conclusion finds support in the record.

Appellant argues that that the ALJ's conclusions rely on hearsay evidence and, as a result, supporting evidence under this Count are inadmissible and cannot be used to support the conclusion that his clients were not reasonably informed about the status of their matters. Appeal Brief, at 9-10, 31, 49; Reply, at 6-9. However, it is long-settled that hearsay is admissible in USPTO disciplinary proceedings. *See Colitz, supra* at 22 (rules of evidence are not applicable in USPTO disciplinary proceedings); *Kroll, supra* at 28 (hearsay admissible in USPTO disciplinary

proceedings); *see also* 37 C.F.R. § 11.50 (“The rules of evidence prevailing in courts of law and equity are not controlling in hearings in disciplinary proceedings”). Thus, this argument does not negate the ALJ’s conclusions.

Finally, in his reply brief, Appellant claims that he informed Mr. Kroll’s clients of his suspension and that certain clients took steps in response to that information. Reply at 1 -2. He states there may have been some “lazy” clients didn’t read what was sent to them and/or that clients were not helpless to discover the information to contact him. Reply at 2-4. This is irrelevant. While some may have known about Mr. Kroll’s suspension and exclusion, as already discussed, the record shows many did not.

b. 37 C.F.R. § 11.804

The OED Director also charged that Appellant, by failing to inform his clients that Mr. Kroll was suspended, he also violated 37 C.F.R. § 11.804(c) and (d) (2020). Section 11.804(c) proscribes “conduct involving dishonesty, fraud, deceit or misrepresentation,” while §11.804(d) proscribes conduct prejudicial to the administration of justice. See *In re Lane*, Proceeding No. D2013-07, at 14 (USPTO Mar. 11, 2014) (discussing definitions of “deceit,” “dishonesty,” and “misrepresentation”). The ALJ agreed and concluded that Appellant violated these provisions by deceptively allowing Mr. Kroll to continue counseling and directly communicating with their joint clients and using Appellant’s name and customer number for filings while Mr. Kroll was suspended and excluded from practice before the Office. (A.16). For reasons already discussed, the record supports these findings. Consequently, the ALJ’s conclusion here is Affirmed.

V. SANCTION

The ALJ’s Initial Decision concluded that Appellant engaged in misconduct and ordered that a not less than two-year suspension from the practice of patent, trademark, and other nonpatent law before the USPTO was the appropriate discipline here. (A.17-20). In rendering the sanction,

the ALJ explained the reason for imposing such a sanction after consideration of the following four factors set forth in 37 C.F.R. § 11.54(b):

- (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. § 11.56; *see also Marinangeli v. Lehman*, 32 F. Supp. 2d 1, 5 (D.D.C. 1998).

Here, the ALJ concluded that Appellant violated his duties to clients by failing to communicate with them and to keep them informed. (A.17). He was also found to have violated duties to the public, the legal system, and the legal profession when he assisted in the unauthorized practice before the Office. (A.17). The ALJ found that Appellant acted knowingly with regard to assisting Mr. Kroll's unauthorized practice and acted negligently in failing to ensure that his and Mr. Kroll's client communications and information conformed to the USPTO's Rules. (A.18). ALJ also identified two (2) aggravating factors (dishonest motive of undermining the disciplinary system, substantial experience as a patent attorney) and one (1) mitigating factor (absence of prior disciplinary record) relevant to the sanction issued. (A.19-20).

Appellant argues that he should not be subject to any sanction because he believes that this matter is a novel legal interpretation for which he was not provided notice as to what constitutes "practice before the office." Appeal Brief, at 50-52. However, there is no merit to this argument.

As the OED Director notes in his response, the USPTO Rules expressly prohibit assisting another in the unauthorized practice of law and plainly describe what constitutes the “practice before the Office.” 37 C.F.R. §§ 11.5(b), 11.505. These rules, along with interpreting case law, provided Appellant with sufficient notice about the parameters of associating with suspended and excluded practitioners.

Lastly, Appellant argues that a two-year suspension is not consistent with USPTO precedent. Appeal Brief, at 52-54. However, for the reasons stated in the OED Director’s Response, this argument also has no merit. The cases cited by Appellant in support of this argument are not relevant to the facts of his disciplinary case as they do not involve the unauthorized practice of law. Further, cases cited by the OED Director show that cases involving the unauthorized practice routinely involve disciplinary suspensions. *See* OED Response, at 43 (citing *Piccone* and *Achterhof*). Of particular note, the OED Director raises the 2021 case of Mr. Kroll where he was excluded from practice before the office for the conduct that Appellant has assisted him in carrying out. *See In re Kroll*, Proceeding No. D2019-15 (USPTO April 5, 2021). The ALJ’s sanction is Affirmed.

ORDER

Having considered Appellant’s appeal from the September 23, 2021 Initial Decision of the ALJ, it is **ORDERED** that the ALJ’s initial decision 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.

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:

David Berdan
General Counsel
United States Patent and Trademark Office
600 Dulany St.
P.O. Box 1450
Alexandria, VA 22313-1450

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

Sydney Johnson
Counsel for the Director of Office of Enrollment and Discipline
600 Dulany St.
P.O. Box 1450
Alexandria, VA 22313-1450

Any request hand-delivered to the USPTO must be hand-delivered to the Office of the General Counsel. Service copies of hand-delivered requests should be delivered to the Solicitor's Office.

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.

(Signature page follows)

(Signature page for Final Order, *In re: Schindler*, D2019-43)

IT IS SO ORDERED.

Users, Berdan, Digitally signed by Users,
Berdan, David
David Date: 2023.12.05 17:11:44
-05'00'

Date

David Berdan
General Counsel
Office of the General Counsel
United States Patent and Trademark Office

on delegated authority by


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

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that the foregoing Final Order was sent to the parties below, in the manner indicated:


Via Email to Respondent:

Mr. Edwin Schindler


Respondent

Via E-mail to the OED Director:

Sydney Johnson
Hendrik deBoer,
Sydney.Johnson@uspto.gov
Hendrik.deBoer@uspto.gov


Counsel for OED Director

12/6/2023
Date



United States Patent and Trademark Office