

**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.	)	
_____	)	

**ORDER**

On July 10, 2019, the Director of the Office of Enrollment and Discipline (“OED Director”) filed a disciplinary Complaint against Appellant, alleging that he had violated ten Rules of Professional Conduct. After a hearing before an Administrative Law Judge (“ALJ”), on September 23, 2021, the ALJ issued his initial decision, concluding that Appellant had violated each of the charged rule violations and imposing a sanction of a suspension of not less than two years. On June 20, 2023, Appellant filed a timely notice of appeal to the USPTO Director.<sup>1</sup> However, on December 5, 2023, the USPTO Director issued a Final Order affirming the ALJ’s decision.

On December 22, 2023, Appellant timely filed a pleading entitled “Respondent Edwin D. Schindler’s Combined Motion For Reconsideration, Pursuant To 37 C.F.R. §11.56(C), Or, In The Alternative, For Remand To The Administrative Law Judge And Stay Of Proceedings” (“Request for Reconsideration”). The OED Director replied on January 5, 2024. That same day,

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<sup>1</sup> 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.

Appellant filed a pleading entitled “Respondent Edwin D. Schindler’s Motion For Leave, On Consent, To File A Reply To The OED’s Opposition To Respondent’s Motion For Reconsideration” (“Motion for Leave To File Reply”). The basis for Appellant’s Motion for Leave to File Reply is “for addressing new issues and inaccuracies in the OED Director’s Opposition.” Appellant cited no authority for granting the Motion for Leave to File Reply. Appellant asserts that the OED Director consented to the Motion.

#### Analysis and Order

The authority and regulatory framework governing Requests for Reconsideration are set forth in 37 C.F.R. § 11.56(c). That provision permits either party to make “a single request for reconsideration or modification of the decision by the USPTO Director if filed within 20 days from the date of entry of the decision.” *Id.* Requests for reconsideration have a limited scope of review. “No request for reconsideration or modification shall be granted unless the request is based on newly discovered evidence or clear 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.” *Id.* The regulation also sets for the framework for making and responding to Requests for Reconsideration. After such a request is filed, “[t]he other party may file a response to the request for reconsideration within 14 days of the filing of the request.” *Id.* There is no allowance in the rule for a Reply brief, or any other filings.

As the regulatory provisions of § 11.56(c) do not permit filing of a Reply brief, allowing Appellant’s Motion for Leave to File Reply, and thus allowing him to file a Reply, would require a suspension or waiver of that regulatory provision under 37 C.F.R. § 11.3. Pursuant to 37 C.F.R. § 11.3, “[i]n an extraordinary situation, when justice requires” any requirement of USPTO’s regulations governing disciplinary proceedings that is not a statutory requirement may be

suspended or waived by the USPTO Director *sua sponte* or on petition by any party. 37 C.F.R. § 11.3.

Although USPTO has sometimes granted waivers of disciplinary rules, waiver is strongly disfavored and will not be granted for circumstances that “could have been prevented by the exercise of ordinary care or diligence.” See *Nitto Chemical Indus. Co. v. Comer*, 39 U.S.P.Q. 2d 1778, 1994 WL 872610 (D.D.C. 1994). Indeed, the USPTO has said that the fact that the rules leave open the possibility of waiver “should not be construed as an indication that there could ever be any extraordinary situation when justice requires waiver of a disciplinary rule.” 73 Fed. Reg. 47,650, 47,651 (Aug. 14, 2008). And, in issuing § 11.3, the only example the Office provided in which waiver might be appropriate was when “a flood or fire” prevented an applicant from timely submitting information for an application to practice before the Office. *Id.* at 47,651.

Appellant’s Motion for Leave to File Reply does not identify any authority for what he seeks, and even if the basis for the request for leave to file a reply is a waiver of the relevant rules under § 11.3, the Motion fails to satisfy the standard under § 11.3. Appellant merely states that the basis for his Motion for Leave to File Reply is “for addressing new issues and inaccuracies in the OED Director’s Opposition.” This justification falls well short of an “extraordinary situation” under § 11.3. Instead, the Motion offers the sort of usual dispute or disagreement that occurs in litigation. That it is not extraordinary is especially true where the dispute or disagreement in no way concerns facts relevant to the limited review standard set forth in § 11.56(c). That standard involves whether or not there is newly discovered evidence that could not have been discovered by reasonable diligence or clear error of law or fact. It does not simply envision review based on “new issues and inaccuracies,” nor does it contemplate a reply brief. Finally, even if “new issues

and inaccuracies” were relevant, Appellant makes no showing that that any “new issues” or facts could not have been discovered by reasonable diligence and can only now be addressed by a reply brief.

Based on the foregoing, the Motion for Leave to File a Reply is DENIED.

**IT IS SO ORDERED.**

**Users, Berdan,** Digitally signed by Users,  
**David** Berdan, David  
Date: 2024.01.08 14:56:38  
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Date

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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 Order was sent to the parties below, in the manner indicated:

**Via Email to Respondent:**

Mr. Edwin Schindler

[REDACTED]

*Respondent*

**Via E-mail to the OED Director:**

Sydney Johnson

Hendrik deBoer,

Sydney.Johnson@uspto.gov

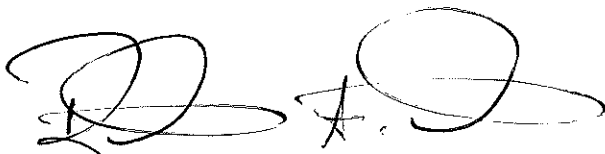
Hendrik.deBoer@uspto.gov

[REDACTED]

*Counsel for OED Director*

1/8/2024

Date



United States Patent and Trademark Office