

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

**In re Terry M. Gernstein,
Respondent.**

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Proceeding D99-06

FINAL ORDER

The Director of the Office of Enrollment and Discipline (OED Director) and Terry M. Gernstein (Respondent), of McLean, Virginia, Registration Number 26,891, having submitted a settlement of a disciplinary matter dated March 23, 2001, that meets the requirements of 37 C.F.R. § 10.133(g), it is ORDERED that:

1. Respondent is suspended from practice before the United States Patent and Trademark Office (USPTO) for three months.
2. The following notice will be published in the Official Gazette:

Notice of Suspension

Terry M. Gernstein, of McLean, Virginia, a patent attorney whose registration number is 26,891, has been suspended for three months beginning (30 days from the date of the USPTO Director's ORDER of suspension) from practice before the United States Patent and Trademark Office in patent, and non-patent law cases, pursuant to the provisions of 35 U.S.C. § 32, and 37 C.F.R. § 10.133(g).

3. Upon suspension, Respondent shall comply with the following:
 - A) During the three-month suspension, pursuant to the provisions of § 10.158(a), Respondent shall not engage in the unauthorized practice of patent, trademark and other non-patent law before the USPTO.
 - B) Within 30 days of the entry of the ORDER of suspension, Respondent shall notify all bars (of which he is a member) of the ORDER in separate written communications and shall file a copy of each written communication with the OED Director pursuant to the provisions of § 10.158(b)(1).

C) Within 30 days of the entry of the ORDER of suspension, Respondent shall notify in writing all clients who have active patent and trademark matters pending before the USPTO, that he is not able to represent any clients, provide any legal advice, or provide any patent law or trademark services of any kind during the three-month suspension period. Additionally, pursuant to § 10.158(b)(2) of the Disciplinary Rules, Respondent shall surrender all clients' active USPTO case files either to (i) the clients or (ii) to another practitioner or practitioners designated by the clients, who, upon receiving any communications requiring a response or action in the transferred cases, shall promptly file a power of attorney and notice of appearance in that matter. Respondent further agrees that during the three-month suspension period any communications relating to a client matter that are addressed to him and/or received by him shall be immediately forwarded to the client or the practitioner designated by the client, and that Respondent will take no other legal action in the matter, enter any appearance, or provide any legal advice concerning the matter that is the subject of the communication.

D) During the three-month period of suspension, pursuant to the provisions of § 10.158(b)(3) and § 10.158(b)(4) of the Disciplinary Rules, Respondent shall not hold himself out as authorized to practice law before the USPTO and shall remove from any monthly, weekly or daily directory/listing published during the period of suspension any statement which would reasonably suggest that he is authorized to practice patent, trademark or other non-patent law before the USPTO. Respondent shall not be required to remove his name as an attorney from any directories of general circulation that are published annually, provided he complies with §§ 10.158 (a)(b)(1-8) of the Disciplinary Rules during the three-month suspension period.

E) Pursuant to § 10.158(b)(5) of the Disciplinary Rules, during the period of suspension, Respondent shall not advertise his availability to perform or render legal services for any person having immediate, prospective, or pending business before the USPTO.

F) Pursuant to § 10.158(b)(6) of the Disciplinary Rules, during the period of suspension, Respondent shall not render legal advice or legal services to any person having immediate, prospective or pending business before the USPTO as to that business.

G) Pursuant to § 10.158(b)(7) of the Disciplinary Rules, during the period of suspension, Respondent shall promptly take steps to change any sign identifying the Respondent or the Respondent's firm's office and the Respondent's or the Respondent's firm's stationery, office brochures, or

other materials, to delete therefrom any advertisement, statement or representation that would reasonably suggest that he is authorized to practice patent, trademark or other non-patent law before the USPTO.

H) Pursuant to §10.158(b)(8) of the Disciplinary Rules, within 30 days after the commencement of the suspension, Respondent shall return to any client any unearned funds, including any unearned retainer fee, and any securities and property of his client.

I) Pursuant to §§ 10.158 (c) and (d) of the Disciplinary Rules allowing suspended practitioners to work as salaried employees of others during the period of suspension, Respondent shall comply with all provisions of those Rules if and when Respondent should assume any such salaried employee work.

4. After being suspended for three months in compliance with the provisions of A)-I)

above, Respondent may petition for reinstatement in accordance with the

following:

(A) The Petition for Reinstatement is to include the following items:

(i) A statement that Respondent has complied with all provisions of this ORDER;

(ii) Copies of all relevant documents to demonstrate compliance with the provisions of this ORDER;

(iii) A statement that Respondent has not knowingly accepted as new clients having matters before the Office any persons referred by invention development companies since 1995; and

(iv) A statement that Respondent will not accept any fee payments from any invention development companies for legal services provided to his clients in the future nor knowingly accept as clients persons referred by invention development companies at any time in the future.

(B) Upon receipt of the Petition for Reinstatement and the above-enumerated accompanying documentation, OED Director

will ensure, as provided for in § 10.160 of the Disciplinary Rules, that granting the Petition for Reinstatement will not be contrary to the public interest, and that he will accept the Petition, not oppose the granting of the Petition, and will promptly forward it for public comment with his recommendation that it be granted. Immediately upon receipt of such Petition and accompanying documentation, OED Director will grant Respondent limited recognition status to resume practice before the USPTO during the period that the OED Director publishes the Notice of Petition for Reinstatement for public comment as required by § 10.160(e).

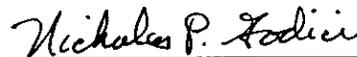
(C) If Respondent has not complied with the provisions of this ORDER during the period of suspension, he shall not be entitled to reinstatement and any limited recognition status previously granted will be subject to revocation.

(D) The provisions of §§ 10.160 (c)(1) and (2) will be waived so that Respondent will not be required to take and pass an examination or to pay costs and expenses, provided Respondent has fully complied with the terms of this ORDER.

5. The OED Director and Respondent shall bear their own costs.

APR - 9 2001

Date



Nicholas P. Godici

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

Attachment: Settlement Agreement, dated March 23, 2001

cc: Harry I. Moatz
Director of Enrollment and Discipline

Zona F. Hostetler, Attorney for Respondent
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