

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

**IN THE MATTER OF  
PATRICK N. BURKHART,  
Respondent.**

)  
)  
)  
)  
)  
)  
)  
)  
)  
)

**Proceeding D07-02**

**FINAL ORDER**

The Director of Enrollment and Discipline (OED Director) of the United States Patent and Trademark Office (USPTO) and Patrick N. Burkhardt (Respondent), have submitted a settlement agreement in the above-identified proceeding that meets the requirements of 37 C.F.R. §10.133(g).

Pursuant to that agreement, this Final Order sets forth the following stipulated facts, legal conclusions and discipline.

**STIPULATED FACTS**

**COUNT 1**

1. Respondent was retained by Gerald and Loretta Byrd (the Byrds) in May 2002 to *inter alia* prepare and prosecute their patent applications.
2. On September 30, 2002, Respondent filed U.S. Patent Application No. 10/260,601 ('601 application) on behalf of inventor Gerald Byrd entitled "Replaceable Filter Element Assembly."
3. The USPTO issued an Office Action dated January 6, 2004, in the '601 application setting a three-month period for reply. The Office Action was mailed to Respondent at Respondent's (then) current address of record (hereinafter "Respondent's address"). Respondent has acknowledged receipt of the Office Action.
4. Respondent asserts that he sent a copy of the Office Action to Gerald Byrd by letter dated January 13, 2004. Mr. Byrd asserts that he did not receive the copy of the Office Action.
5. Respondent asserts that he sent Gerald Byrd a letter dated February 28, 2004, advising

Mr. Byrd that a reply to the Office Action was due. Mr. Byrd asserts that he did not receive the February 28, 2004, letter.

6. The USPTO received no response to the Office Action, and on August 9, 2004, the '601 application became abandoned. The USPTO issued a Notice of Abandonment dated August 11, 2004, in the '601 application. Respondent acknowledges receipt of the Notice of Abandonment.
7. Respondent asserts that he notified Gerald Byrd of the Abandonment by letter dated August 15, 2004. Mr. Byrd asserts that he did not receive the August 15, 2004 letter.
8. Respondent did not communicate with the Byrds from August 15, 2004, until February 11, 2005.
9. On February 11, 2005, in response to phone messages left by Gerald Byrd on February 7 to February 10, 2005, Respondent called Loretta Byrd and advised her that the '601 application had been abandoned and asserted that he had sent a letter in January 2004 requesting a payment of \$800.00 for preparing the amendment responding to the earlier unanswered office action. Respondent stated he would send a copy of the January 2004 letter to the Byrds.
10. Between February 14 and 24, 2005, the Byrds claim that they called and left telephone messages for Respondent and that Respondent did not reply to these messages. Respondent states that he did not receive messages from the Byrds at that time.
11. By certified letter dated March 7, 2005, the Byrds advised Respondent that they wanted to revive the '601 application and wanted Respondent to pay the USPTO fee. Respondent replied to the Byrds by letter dated March 9, 2005, advising them that he could not meet with them until March 16, 2005. On March 11, 2005, the Byrds went to Respondent's home and requested to see their file. Respondent refused to show the Byrds the file and indicated he would send them a copy of the file. By letter dated March 11, 2005, the Byrds requested the return of their file.
12. In a letter to the Byrds dated March 11, 2005, Respondent enclosed a number of documents, including unsigned copies of letters from Respondent to Gerald Byrd dated January 13, 2004, February 28, 2004 and August 15, 2004. The Byrds claim that they did not receive those letters.

## COUNT 2

13. Above paragraphs 1-12 are incorporated herein by reference.
14. On June 14, 2003 the Byrds left a telephone message for Respondent indicating they desired to file a CIP application based upon improvements to their replaceable filter element assembly invention. On June 16, 2003, the Byrds gave Respondent a check for \$2,000.00 to prepare the CIP application.

15. The Byrds assert that they never received a draft of the CIP application to review.
16. Respondent never filed the CIP application. Respondent asserts that the Byrds did not provide signed papers or a check for the filing fee, without which he would not have filed the CIP application.
17. In a letter dated March 7, 2005, the Byrds advised Respondent that the USPTO had no record of a CIP application in Gerald Byrd's name.
18. In a letter dated March 9, 2005, Respondent stated that his records indicated that all USPTO correspondence regarding the CIP application was sent to Gerald Byrd and a draft of the CIP application had also been sent for approval by Byrd.
19. By letter dated March 11, 2005, the Byrds requested the return of their file and return of the \$2,000.00 paid for the CIP application for Respondent's failure to perform the work on the CIP application.
20. In a letter dated March 11, 2005, Respondent enclosed what he referred to as "complete copies" of Respondent's files P0209 (the '601 application) and P0311 (the CIP application). The enclosures to the letter included a cover letter dated September 4, 2002, purporting to transmit a draft of the CIP application to the Byrds.
21. Respondent did not return the \$2,000.00 fee as requested by the Byrds.

### COUNT 3

22. Respondent was retained by John and Wendy Field (the Fields), as their intellectual property attorney to *inter alia* prepare and prosecute their patent applications.
23. Respondent in a letter dated December 19, 2003, advised John Field that the cost for performing a search, including the report and copies of the patents for a "Jig for Beam Fabrication" would be \$700.00. Respondent reported the results of the search to the Fields in a letter dated February 4, 2004, and advised the Fields that the fee for preparation of a patent application would be \$4,200.00, and the filing fee would be \$385.00. Respondent was paid \$4,200.00 by check dated February 10, 2004.
24. On August 14, 2004, Respondent met with the Fields and presented a draft of the patent application for the "Construction Jig" invention. During the meeting the Fields gave Respondent a check for \$385.00 for the filing fee. The USPTO has no record of having received the Construction Jig patent application.
25. Also on August 14, 2004, the Fields gave Respondent a check in the amount of \$700.00 to begin a search for a caisson tube (Sonotube) finishing form.

26. On August 20, 2004, Respondent reported the results of the search for the “Sonotube Trim Form” and advised the Fields that the fee for preparing the patent application would be \$4,200.00 and the filing fee would be \$385.00.
27. On September 13, 2004, Respondent met with the Fields and was given a check for \$2,100.00 for the “Sonotube Trim Form” patent application and a check in the amount of \$385.00 for the filing fee. Respondent forwarded to John Field a draft patent application for the “Caisson Tube Finishing Form” by letter dated September 24, 2004. The “Caisson Tube Finishing Form” and the “Sonotube Trim Form” are different names for the same invention. On October 1, 2004, Wendy Field gave Respondent a check in the amount of \$2,100.00 for the remainder of the patent application fee. The Fields assumed that Respondent would file the patent application.
28. The USPTO has no record of a patent application for a “Caisson Tube Finishing Form” or “Sonotube Trim Form” having been filed by Respondent.
29. Between October 2004 and August 2005, the Fields made occasional calls to Respondent to check on the status of their patent applications. The Fields claim that they did not understand what was happening with the applications.
30. On September 5, 2005, the Fields sent Respondent an e-mail notifying him of their change of address and phone number and to check on the status of the patent applications. On September 8, 2005, according to the Fields, Respondent sent an e-mail to the Fields advising them that he would forward the filing receipts to the Fields.
31. In a letter dated December 2, 2005, the Fields advised Respondent that they had not received notification from the USPTO that the patent applications had been filed and that they could not reach Respondent by phone.
32. In Response to a Request for Information by the Office of Enrollment and Discipline (OED), Respondent produced documents purporting to be transmittal letters for the Construction Jig and Caisson Tube Finishing Form patent applications. These letters included Express Mail numbers for which the United States Post Office has no record, or which correspond to correspondence unrelated to the Fields. One of the Express Mail numbers used on the transmittal letter was for Patent Application No. 10/938,264 for “Container Illumination,” a patent application filed by Respondent for a different client. Respondent also submitted a copy of his check No. 558, dated September 11, 2004, made payable to the Commissioner of Patents in the amount of \$385.00. The copy of check No. 558 gave no indication whether the check had been cashed.

#### COUNT 4

33. Respondent was retained by Thomas and Darby McNutt (the McNutts) to *inter alia* prepare and prosecute their patent application.

34. On March 1, 2004, Respondent filed U.S. Patent Application No. 10/791,020 ('020 Application) on behalf of Thomas and Darby McNutt entitled "Grouser Assembly."
35. The USPTO issued an Office Action dated November 3, 2004, in the '020 application setting a three-month period of reply. The Office action was mailed to Respondent at Respondent's address, and Respondent acknowledges having received it.
36. The USPTO received no response to the Office Action and on June 10, 2005, the '020 application became abandoned. The USPTO issued a Notice of Abandonment dated June 13, 2005, in the '020 application. The Notice of Abandonment was mailed to Respondent at Respondent's address. Respondent states that he did not receive the Notice of Abandonment.
37. In a letter to Respondent on or about August 6, 2005, Thomas McNutt reported that he had discovered that the '020 application had become abandoned and that Respondent had failed to contact either Thomas or Darby McNutt regarding the abandonment. In the letter Mr. McNutt requested the return of his file along with the return of an Auto Cad computer program and a computer drawing tablet.
38. In a letter to Thomas McNutt dated August 11, 2005, Respondent stated that the USPTO had misplaced the response to the Office Action, and that Respondent had not received the Notice of Abandonment.
39. In the August 11, 2005 letter, Respondent advised Thomas McNutt that he would file a petition for the withdrawal of the abandonment along with copies of the response to the Office Action and upon filing the petition would withdraw from any further representation on Thomas McNutt's behalf. Respondent also stated that he had been traveling since late May and that his phone was out of service for part of the first week of August and during that time he had not received any messages from Mr. McNutt either by phone or e-mail. Respondent also indicated that he had sent copies of all correspondence to and from the USPTO to Mr. McNutt and that he would prepare a copy of his file and forward it to him.
40. By letter dated August 16, 2005, Thomas McNutt advised Respondent that he wanted Respondent to file the petition to withdraw the abandonment. Mr. McNutt requested Respondent to withdraw from any further representation after Respondent completed the application process or to refund all the money paid to Respondent. Mr. McNutt also repeated the request for Respondent to return the Auto Cad computer program and the computer drawing tablet or to pay for them.
41. Respondent did not file a request to withdraw from representing Mr. McNutt, did not return Mr. McNutt's computer equipment as requested, and did not provide Mr. McNutt with a copy of his file as requested.
42. On September 1, 2005, OED mailed a Request For Statement of Respondent's Position to Respondent.

43. On September 30, 2005, OED received Respondent's response to its Request for Statement of Respondent's position. In the response, Respondent included a letter to Thomas McNutt bearing the date November 20, 2003 [sic] advising him of the November 3, 2004 Office Action and forwarding a copy of the action. Mr. McNutt asserts that he did not receive this letter or the attached office action.
44. Respondent filed a Petition to Withdraw the Abandonment of the '020 application on October 3, 2005. The Petition enclosed a copy of a document, entitled "Amendment A," purporting to be Respondent's response to the November 3, 2004 office action. The Certificate of Service for Amendment "A" claims a mailing date of December 10, 2004. The USPTO has no record of having received "Amendment A" prior to its inclusion with Respondent's Petition to Withdraw the Abandonment.
45. The USPTO granted the Petition to Withdraw Abandonment and revived the '020 application on December 19, 2005. The Notice of Rescinded Abandonment was mailed to Respondent at Respondent's address on December 27, 2005.
46. Despite Thomas McNutt's request that Respondent withdraw from representing the McNutts after filing the filing of the Petition To Withdraw Abandonment, Respondent failed to withdraw from representing the McNutts, and thus continued to receive correspondence regarding the McNutts' application. On March 10, 2006 the Office mailed an Office Action to Respondent at Respondent's address. The Office Action gave a shortened response period of three months.
47. In a letter dated March 21, 2006, but postmarked March 31, 2006, Respondent forwarded a copy of the March 10, 2006 Office Action and advised Thomas McNutt that he could no longer represent him in any matter, and also advised him that in order to avoid abandonment of the application a response must be filed on or before June 10, 2006. Respondent did not file a request to withdraw from representing Mr. McNutt.
48. The McNutts did not obtain another attorney to file an appearance with the USPTO on their behalf. On October 23, 2006, the '020 application was again abandoned for failure to respond to an Office Action. A Notice of Abandonment was mailed to Respondent at Respondent's address on October 24, 2006. Respondent failed to notify the McNutts of the abandonment upon receipt of the notice and failed to send a copy of the Notice of Abandonment to Thomas McNutt.

COUNT 5

49. Respondent was retained by [REDACTED] and [REDACTED] [REDACTED] to *inter alia* prepare and prosecute their patent application.
50. On September 8, 2005, Respondent filed U.S. Patent Application No. [REDACTED] ([REDACTED] application) on behalf of inventors [REDACTED] and [REDACTED] entitled “[REDACTED].”
51. Portions of the specification and claims contain blanks wherein disclosure is omitted. Respondent asserts that the clients were in a rush to have the application filed and directed that it be filed with these blank spaces, intending that they be completed at a later date. Page 5 of the [REDACTED] Application reads (in part):
- [REDACTED]
- [REDACTED]
- [REDACTED]
- [REDACTED]
- [REDACTED]
- [REDACTED]
- [REDACTED]
- [REDACTED]
- [REDACTED]
52. Claims 4 and 5 read as follows:
- [REDACTED]
- [REDACTED]
- [REDACTED]
- [REDACTED]
53. The USPTO issued a Notice to File Missing Parts of Nonprovisional Application (“Notice To File Missing Parts”) dated September 28, 2005, in the [REDACTED] application setting a two-month period for reply. The Notice To File Missing Parts requested replacement drawings in compliance with 37 C.F.R. §§ 1.84 and 1.121(d), filing fees and surcharges in the amount of \$365.00, an application search fee in the amount of \$250.00, a new oath or declaration identifying the application number, and in compliance with 37 C.F.R. § 1.63 identifying the residence of each inventor and complete mailing address of each inventor in order to avoid abandonment of the application. The original drawing sheets as submitted did not have the appropriate margins and were not reasonably free from erasures, alterations, overwriting, and interlineations. The original Declaration as submitted did not contain the city of residence for inventor [REDACTED]. The Notice was mailed to Respondent at Respondent’s address. Respondent acknowledges receipt of the Notice.

54. The USPTO received no response to the Notice to File Missing Parts and issued a Notice of Abandonment dated June 6, 2006, in the [REDACTED] application. The Notice of Abandonment was mailed to Respondent at Respondent's address. Respondent failed to file a petition to revive the [REDACTED] application after it became abandoned.
55. Respondent states that on or before October 15, 2005, Respondent met with inventor [REDACTED] at which time inventor [REDACTED] gave Respondent a money order in the amount of \$365.00 and that Respondent mailed the response to the Notice to File Missing Parts including the money order, a new declaration, corrected drawings and a copy of the Notice to File to the USPTO on October 15, 2005. Respondent has produced a copy of this filing, which includes a certificate of mailing that bears an incorrect address for the USPTO, even though the Notice clearly stated the address to which the response should have been mailed. The USPTO has no record of a response to the Notice having been filed.

#### COUNT 6

56. Respondent was retained by Jim Gravelle in November 2001, to *inter alia* prepare and prosecute their patent applications.
57. On December 24, 2001, Respondent filed U.S. Patent Application No. 10/033,516 ('516 application) on behalf of inventors Vaughan and Gravelle entitled "Multi-Position Wire Insulator and Fence Support."
58. The USPTO issued a final Office Action dated August 4, 2003, in the '516 application setting a three-month period for reply. The Office Action was mailed to Respondent at Respondent's address.
59. Inventor Gravelle passed away in August 2003. During a telephone conference call in September 2003, it was decided that Respondent would file paperwork for a change of assignee in the '516 application. The papers conveying the change were signed and notarized in September and sent via Federal Express to Respondent to file with the USPTO along with a check to cover the assignment recording fees. Respondent failed to file the change of assignee papers in the '516 application.
60. On November 4, 2003, Respondent filed an Amendment "B" in response to the final Office Action issued August 4, 2003.
61. On November 25, 2003, the USPTO issued an Advisory Action informing Respondent that the Amendment "B" filed on November 4, 2003 failed to place the '516 application in condition for allowance. Because Amendment B raised new issues that would require further consideration, it was not deemed to place the application in better form for appeal and further action was necessary to avoid abandonment. The Advisory Action set a three-month period of reply.



62. According to Ms. Vaughan, Respondent never reported the Advisory Action to Ms. Vaughan. Respondent claims that he notified Ms. Vaughan of the Advisory Action and that Ms. Vaughan authorized Respondent to file a Notice of Appeal on her behalf. In an e-mail dated January 19, 2004, Respondent stated to Ms. Vaughan that “the patent is still very much alive, and going to appeal.” Respondent states he filed the Notice of Appeal on February 25, 2004.
63. The USPTO received no Notice of Appeal, and no other response to the August 4, 2004 Office Action. Accordingly, on March 29, 2004, the ’516 application became abandoned. The USPTO issued a Notice of Abandonment on March 30, 2004. The Notice of Abandonment was mailed to Respondent at Respondent’s address. Respondent states that he did not receive the Notice.
64. If Respondent had filed a Notice of Appeal on February 25, 2004, his Appeal Brief would have been due on or about April 25, 2004. The USPTO did not receive any appeal brief from Respondent in this case.
65. In an e-mail to Respondent dated January 10, 2005, Ms. Vaughan inquired as to the status of the ’516 application. Respondent in an e-mail dated January 20, 2005, responded to Ms. Vaughan’s inquiry stating that he had sent Ms. Vaughan a status letter a “couple of months before” and that “nothing has changed since” and to let Respondent know if she had received the letter, and if not, he would forward a copy of it to her. Ms. Vaughan replied to Respondent’s e-mail on January 21, 2005 indicating that she had not received any correspondence from Respondent since July 2004. Ms. Vaughan states that Respondent never forwarded her a copy of the purported status letter.
66. During a meeting with Respondent in April 2005, Ms. Vaughan inquired as to the status of the ’516 application. Respondent told her that the Patent Office takes a very long time and that he would check into the status of the ’516 application. Respondent did not provide Ms. Vaughan with an update as to the status of the ’516 application.
67. Respondent e-mailed Ms. Vaughan in October 2005 and informed her that he was relocating to Canada for the hockey season. Respondent left no forwarding address or phone number by which he could be contacted. Respondent states in his Response to OED that from September 2005 to March of 2006 he was in Canada frequently for family reasons and that he returned regularly to his home to retrieve and answer correspondence. Between October 27, 2005, and March 2, 2006, Ms. Vaughan claims to have sent at least five emails to Respondent requesting information regarding the status of her application without receiving a response. Respondent asserts that he does not have any record of receiving the emails.
68. Ms. Vaughan visited Respondent, unannounced, at his home the weekend prior to April 17, 2006. During that meeting Ms. Vaughan asked for her file, but Respondent was not able to provide it to her then and there. Respondent offered to meet Ms. Vaughan later

that day and provide her with a copy of the file.

69. Respondent met with Ms. Vaughan on April 18, 2006, and provided Ms. Vaughan with a folder. Respondent asserts that it contained a copy of his full file, while Ms. Vaughan claims that it included only a few items. When Ms. Vaughan asked Respondent about the abandonment of the '516 application, Respondent stated he never received the Notice of Abandonment. Ms. Vaughan told Respondent that she no longer required his services and that he should contact her new attorney, whose name she provided. Ms. Vaughan claims that she requested that Respondent file a Request to Withdraw as attorney of record in the '516 application. Respondent claims that she did not make that request, but only told him that she had obtained other counsel.
70. On April 28, 2006, Ms. Vaughan's new attorney filed a Revocation/Power of Attorney in the '516 application, as well as a Petition to Revive the application. The application has since issued into a patent.
71. On April 18, 2006, OED sent Respondent a Request for Statement of Respondent's Position. Respondent sent a response to the request on June 19, 2006. Attached to the response was a copy of a document purporting to be a Notice of Appeal in the '516 application, bearing a mailing date of February 25, 2004. The USPTO has no record of having received this Notice of Appeal in 2004.

#### COUNT 7

72. Above paragraphs 56-71 are incorporated herein by reference.
73. On December 23, 2002, Respondent filed PCT Application No. PCT/US02/40936 (PCT application) which claimed priority to the '516 application on behalf of inventor James Gravelle entitled "Multi-Position Wire Insulator and Fence Support Bracket."
74. On June 24, 2003, Respondent filed a PCT Chapter II Demand for the PCT application. The Demand filed by Respondent was missing page 2, and thus did not contain a designation of an agent (Box 3), or an election of the basis for international examination (Box 4). Although the Demand indicated that a check for the preliminary examination fee and handling fee was attached, the USPTO received no check with the Demand.
75. The USPTO issued an International Search Report on June 10, 2004. The search report was mailed to Respondent at Respondent's address. The search report gave a two-month period in which to file an Article 19 Amendment. In a letter dated July 6, 2004, to Ms. Vaughan, Respondent recommended filing an Article 19 Amendment and conducting an interview with the examiner to clarify the issues raised in the International Search Report. Respondent advised Ms. Vaughan that the cost of the interview would be \$500.00.

76. On August 10, 2004, Respondent filed an Article 19 Amendment in response to the International Search Report. The Article 19 Amendment was not entered into the record because it was not in the proper format.
77. On August 11, 2004, the USPTO issued a Notification Concerning Payment of the Preliminary Examination and Handling Fees, notifying Respondent that required fees totaling \$662.00 were not received and giving a one-month period in which to submit the proper fees.
78. Also on August 11, 2004, the USPTO issued a PCT form PCT/IPEA/424 Communication in Cases for Which No Other Form is Applicable advising Respondent that the Demand was incomplete, and requesting clarification.
79. Respondent failed to respond to the Notification Concerning Payment of Preliminary Examination and Handling Fees, or the Communication in Cases for Which No Other Form is Applicable issued on August 11, 2004.
80. On January 13, 2005, the USPTO issued a Written Opinion in the PCT application. The Written Opinion set a reply period of one month from the date of mailing. The Written Opinion was mailed to Respondent at Respondent's address. The Written Opinion refused all the claims except for claims 6, 13, and 19 based upon a lack of novelty and lack of an inventive step. Respondent failed to file a response to the Written Opinion.
81. Respondent failed to notify Ms. Vaughan of the August 11, 2004 notices and of the January 13, 2005, Written Opinion. Respondent advised Ms. Vaughan in an e-mail dated April 1, 2005, that "everything was fine on the intellectual property side" even though the deadlines for responding to the August 11, 2004 notices and the January 13, 2005 Written Opinion had already passed. Respondent asserts that the PCT "application" is a placeholder to extend the time in which international application can be filed. The outer limit of that period is 30 months. Respondent claims that, before that time had expired, Ms. Vaughan had informed him that she was not going to file an international application due to the expense involved.
82. On June 2, 2005 the USPTO issued an International Preliminary Examination Report. The report was mailed to Respondent at Respondent's address. The International Preliminary Examination Report listed the same claim refusals as were listed in the Written Opinion.

### COUNT 8

83. Above paragraphs 56-82 are incorporated herein by reference.
84. Respondent was retained by Kelly Vaughan, as her intellectual property attorney in 2003, to *inter alia* prepare and prosecute her trademark application.
85. Ms. Vaughan gave Respondent a check in 2003 to file the trademark application.

Respondent never filed said trademark application.

86. In an e-mail dated March 21, 2006, Respondent told Ms. Vaughan that he had filed the trademark application “some time ago” and that he would check on the status as soon as he could. On information and belief, Respondent’s assertion to Ms. Vaughan that he had filed the trademark application was not accurate.
87. In an e-mail dated May 16, 2005, Respondent told Ms. Vaughan that he had checked on the status of the trademark application and that the USPTO had lost some papers. Respondent stated that he would refile the missing documents.
88. Respondent on several occasions communicated to Ms. Vaughan that he had filed the trademark application. Respondent asserts that he was mistaken about the trademark application having been filed, and that he believed the information to be accurate at the time. In his Response to OED, after having had a chance to investigate the matter, Respondent stated that he did not file the application because he lacked a signed power of attorney from Ms. Vaughan.

#### COUNT 9

89. Above paragraphs 56-88 are incorporated herein by reference.
90. In April 2005, Ms. Vaughan met with Respondent regarding a patent application on a different invention. In June 2005, Ms. Vaughan paid Respondent \$800 to perform a search related to the new invention, and \$1,000 towards drafting an application. In October 2005, Ms. Vaughan paid Respondent an additional \$2,000 for drafting the application, and provided Respondent a check made out to the Commissioner of Patents to cover the filing fee.
91. Ms. Vaughan claims that Respondent did not respond to emails from her regarding the status of this application. Respondent asserts that he delivered a full copy of the CIP application to Ms. Vaughan and she could have filed it any time before the issuance of her patent in May of 2007.

#### COUNT 10

92. Respondent was retained by Victoria White on June 23, 2005, to *inter alia* prepare and prosecute her patent application.
93. During a meeting with Respondent on July 5, 2005, Ms. White gave Respondent a check in the amount of \$4,000.00 to prepare a patent application on her behalf. Respondent stated that he would prepare the patent application.
94. In an e-mail to Respondent dated October 21, 2005, Ms. White inquired as to the status of the patent application and advised Respondent that she had made several attempts to contact him with no response. Respondent replied in an email that he would be back in

town in two weeks and would contact Ms. White to set up a meeting. Respondent asserts that in a “follow-up e-mail” he sent a copy of a draft application for Ms. White’s review. However, Ms. White asserts that she did not receive a draft of the application. Ms. White states that she did not hear from Respondent again until she went to see him at his home in April 2006.

95. Ms. White visited Respondent at his home, unannounced, the weekend prior to April 17, 2006. During that meeting Ms. White requested her file, but Respondent was not able to provide it to her then and there. Respondent met with Ms. White on April 18, 2006, and provided Ms. White with a folder containing documents relating to her case. Respondent claims that he gave her the entire file, including her completed application. Ms. White claims that the folder contained only a few documents, but not her entire file.
96. On September 15, 2006, OED sent Respondent a Request for Statement of Respondent’s Position. In his Response, Respondent states that he received \$4,000.00 from Ms. White to prepare a patent application on Ms. White’s behalf. Respondent states that he replied to Ms. White’s October 21, 2005 e-mail by offering to meet with Ms. White. Respondent also states that he sent a follow-up e-mail with a copy of the completed application for Ms. White to review and make any changes before setting a time to meet. Respondent also states that during the April 18, 2006 meeting, Respondent provided Ms. White with another copy of the draft application and advised Ms. White that if she wanted Respondent to file the application she needed to inform Respondent of any changes and provide Respondent with a check for the filing fees made out to the Commissioner of Patents. Respondent admits not filing the patent application on behalf of Ms. White and asserts that he failed to file the application because he did not receive a signed declaration or filing fee from Ms. White.
97. OED’s Request sought copies of Respondent’s client ledger card and all financial records of legal fees and costs paid to Respondent by Ms. White. Respondent’s response to OED’s Request failed to provide the documents.

### **LEGAL CONCLUSIONS**

98. Based on the foregoing stipulated facts, Respondent agreed that his conduct violated the following Disciplinary Rules of the Code of Professional Responsibility as outlined in Section 10 of 37 C.F.R.:
  - a. Rule 10.23 (b)(5) in that Respondent engaged in conduct that is prejudicial to the administration of justice;
  - b. Rule 10.23(b)(6) in that Respondent engaged in other conduct which adversely reflects on Respondent’s fitness to practice before the USPTO;
  - c. Rule 10.77(c) in that Respondent neglected legal matters entrusted to him;

- d. Rule 10.84(a)(1) in that Respondent failed to seek the lawful objectives of his client by failing to file the patent and trademark applications as instructed by his clients; and
- e. Rule 10.84(a)(2) in that Respondent failed to carry out contracts of employment by failing to diligently file and prosecute patent applications on behalf of his clients.

### **DISCIPLINE**

99. Respondent agreed, and it is ordered that:
- a. Respondent is suspended from practice before the USPTO for a period of three years.
  - b. Respondent's suspension will be stayed, and he will be permitted to continue to practice, so long as he complies with the terms of this Final Order.
  - c. In the event that Respondent fails to comply with any of the terms of this Final Order, the stay of suspension will be immediately vacated and Respondent shall serve a three-year suspension, starting at the time the stay is vacated, prior to being eligible for reinstatement.
  - d. Before vacating the stay, the USPTO shall provide Respondent with an Order To Show Cause Why The Stay Should Not Be Vacated. The Order To Show Cause will give Respondent ten (10) days to show cause to the USPTO Director why the stay should not be vacated. The USPTO Director may then exercise his discretion to vacate the stay. Any review shall be pursuant to 37 C.F.R. § 10.157 (or its successor that is operative at that time, and would not operate to postpone vacating of the stay during pendency of the review. Respondent shall be suspended and ineligible to practice during such review.
  - e. The following Notice shall be published in the Official Gazette:

#### **Notice of Suspension**

Patrick N. Burkhart (Burkhart), of Chicago, Illinois, is a patent attorney whose registration number is 33,352. The Director of the United States Patent and Trademark Office has ordered Burkhart be suspended for three years from practice before the United States Patent and Trademark Office in patent and non-patent law cases. The suspension will be stayed, so long as Respondent complies with the terms of the Final Order. This action is taken pursuant to the provisions of 35 U.S.C. § 32, and 37 C.F.R. §§ 10.133(g) and 10.159.

- f. Starting on June 15, 2008 and continuing until June 15, 2010, Respondent will provide partial refunds of legal fees charged to a designated list of clients as agreed to by the OED Director and Respondent and reflected in the refund payment schedule below. Respondent will provide a \$500 or \$1,000 initial payment to each client on the designated list by June 15, 2008, and will make quarterly payments to each client on the designated list in compliance with the following repayment schedule:

<u>Client</u>	<u>Total Refund</u>	<u>Quarterly Payment</u>	<u>First Payment Date</u>	<u>Final Payment Date</u>
Gerald and Loretta Byrd	\$2,000	\$500	June 15, 2008	March 15, 2009
John and Wendy Field	\$8,785	\$1000	June 15, 2008	June 15, 2010 (\$785)
Thomas and Darby McNutt	\$2,000	\$500	June 15, 2008	March 15, 2009
Kelly Vaughan	\$2,700	\$500	June 15, 2008	Sept 15, 2009 (\$200)
Victoria White	\$4,000	\$500	June 15, 2008	March 15, 2010

- g. Within 30 days of the entry of this Final Order, Respondent shall notify all bars of which he is a member of the order of the stayed suspension 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). All notices required by this paragraph shall be served by certified mail, return receipt requested. To the extent that another bar disciplines Respondent for only the conduct covered by the present Complaint, the USPTO will not impose any further discipline as a result of the other bar's discipline.
- h. Within 30 days of the entry of this Final Order, Respondent shall notify in writing all clients on the designated list, based on their last known address using certified mail, return receipt requested, that he will be providing a partial refund of past collected legal fees and shall notify them of the refund payment schedule. Respondent will not make any claim to being absolved from any and all claims upon fulfilling the payment schedule. Respondent's written notice will (i) notify each client of the payment schedule, (ii) set forth the amount Respondent is obligated to pay each quarter until payment is complete, and (iii) include the following paragraphs:

After reviewing my files, I have come to realize that I charged you too much for legal services rendered during the period \_\_\_\_\_ . I promise to return \_\_\_\_\_ of the relevant attorney

fees I collected, in accordance with the following payment schedule:

SCHEDULE HERE

As you can see from the payment schedule, this refund to you will total \$ \_\_\_\_\_ over a period of \_\_\_ years/months. The reason for this payment schedule is because I cannot afford to pay the entire refund immediately.

- i. Within 30 days of giving written notice to all clients on the designated list of his intent to provide a refund, he must provide copies to the OED Director of each and every letter sent to all clients on the designated list.
- j. Payments shall be sent to each client on the designated list by certified mail, return receipt requested. Throughout the period of stayed suspension, Respondent will provide the OED Director copies of all refund payment checks sent to clients on the designated list, along with the cover letters identifying the certified mail number, within 30 days of the mail date of each check and cover letter, and Respondent shall continue to provide copies of checks and cover letters evidencing payment until the refund payment schedule is completed. Throughout the period of stayed suspension, Respondent will provide the OED Director copies of all returned receipts showing delivery of the certified mail.
- k. If any letter or check is returned by the Post Office as undeliverable, Respondent will make a reasonable effort to locate the intended recipient. Reasonable effort shall be defined as (1) searching Respondent's files for any alternate contact information and (2) performing an Internet search (including a property records search) and printing out the results. If the person still cannot be located, Respondent shall promptly document his reasonable efforts to OED. Respondent shall be thereafter released from his obligations hereunder to that person who could not be located, unless OED locates the person and provides Respondent the person's address. In addition, if at any time during the payment schedule period a client who had not been successfully located becomes discovered, then Respondent is still obligated to pay that client the full amount of the refund.
- l. Within six months of the entry of this Final Order, Respondent shall complete a course, approved by the Illinois State Bar Association, on law office management procedures.
- m. Within one year of the entry of this Final Order, Respondent shall take and pass the Multistate Professional Responsibility Examination (MPRE).



- n. During the period of the stay of the suspension, Respondent shall not commit any new violations of the Disciplinary Rules.
- o. The OED Director and Respondent shall each bear their own costs.

### **PETITION TO REMOVE CONDITIONS**

- 100. The Suspension shall be deemed fulfilled no sooner than the date that is three years from the date upon which this Final Order is entered.
- 101. On or after that date, Respondent may file a petition to relieve the terms of this Final Order.
- 102. Respondent's petition shall include: include (1) proof that he has completed a course, approved by the Illinois State Bar Association, on law office management procedures; (2) proof that he has passed the Multistate Professional Responsibility Examination (MPRE); and (3) proof that he has satisfied the repayment requirements of this Final Order.

### **REINSTATEMENT**

*This section of this Final Order is relevant only if Respondent fails to comply with any of the terms of this Final Order, resulting in the vacating of the stay of suspension.*

- 103. If the stay of suspension is vacated, and the three-year suspension period is imposed on Respondent, upon conclusion of the three-year suspension period, Respondent may immediately file a Petition for Reinstatement. Further the Final Order shall provide:
  - (1) The Petition for Reinstatement for reinstatement is to include the following items:
    - (a) A statement that Respondent has complied with the provisions of this Final Order (i) requiring him to take a law office management course, (ii) requiring him to pass the Multistate Professional Responsibility Examination (MPRE), and (iii) requiring him to refund legal fees to his clients;
    - (b) Copies of all relevant documents not previously furnished to demonstrate compliance with the provisions of the Final Order;
    - (c) A statement and proof that the Respondent has the moral character qualifications, competency, and learning in law required under 37 C.F.R. § 10.7 or any succeeding regulation; and

(d) A statement that the resumption of practice before the Office will not be detrimental to the administration of justice or subversive to the public interest;

- (2) Respondent shall comply with all the provisions of 37 C.F.R. § 10.158; and
- (3) (a) Upon receipt of the Petition for Reinstatement and the above enumerated accompanying documentation and statements by Respondent and compliance with § 10.158, the OED Director shall, as provided for in § 10.160 (or successor regulations), if Respondent has complied with the regulation existing at the time the stay of suspension is vacated (37 C.F.R. § 10.158 or its successor regulations) and granting the Petition for Reinstatement will not be contrary to the public interest, accept the Petition, not oppose the granting of the Petition, and shall promptly forward it for public comment with his recommendation that it be granted.  
  
(b) The OED Director shall publish Respondent's name in a Notice of Petition for Reinstatement for public comment as required by § 10.160(e) (or successor regulations). The OED Director shall conduct investigations pursuant to 37 C.F.R. § 10.131 (and successor regulations) of possible violations of USPTO disciplinary rules by Respondent upon receipt from within or outside the USPTO of a complaint or information of a possible violation of said rules, and in conducting the investigation the OED Director may communicate with current, or potential future clients of Respondent, as well as any other person or party possibly having relevant information regarding said violations.  
  
(c) If Respondent has not complied with the provisions of this Final Order during the period of suspension, he shall not be entitled to reinstatement and the OED Director shall deny the Petition for Reinstatement.

(d) Respondent shall comply with the procedures and fees in effect at the time he files a petition for reinstatement.

3/27/08

Date

James A. Toupin  
James A. Toupin  
*General Counsel*  
*United States Patent and Trademark Office*

On behalf of Jon W. Dudas  
*Under Secretary of Commerce For*  
*Intellectual Property and Director of the*  
*United States Patent and Trademark Office*

cc: Harry I. Moatz  
OED Director

cc: Patrick N. Burkhart  
134 North LaSalle Street  
Suite 2040  
Chicago, IL 60602