

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

In the Matter of)
)
)
Kenneth Brian Matlock,) Proceeding No. D2011-52
)
)
Respondent)

FINAL ORDER

The Deputy General Counsel for Enrollment and Discipline and Director of the Office of Enrollment and Discipline (“OED Director”) for the United States Patent and Trademark Office (“USPTO” or “Office”) and Kenneth Brian Matlock (“Respondent”) have submitted a Proposed Settlement Agreement (“Agreement”) to the Under Secretary of Commerce for Intellectual Property and USPTO Director for approval.

The Agreement, which resolves all disciplinary action by the USPTO arising from the stipulated facts set forth below and the disciplinary complaint pending against Respondent, is hereby approved. This Final Order sets forth the parties’ stipulated facts, legal conclusions, and sanctions found in the Agreement.

Jurisdiction

1. Respondent is a registered patent practitioner (Registration Number 52,005) and is subject to the Disciplinary Rules of the USPTO Code of Professional Responsibility, which are set forth in Part 10 of Title 37, Code of Federal Regulations.

2. The USPTO Director has jurisdiction over this matter under 35 U.S.C. §§ 2(b)(2)(D) and 32 and 37 C.F.R. § 11.26.

Stipulated Facts

Background

3. Respondent of Walnut Creek, California, has been registered to practice patent law before the Office as an agent since August 5, 2002, and as an attorney since January 9, 2008. Respondent’s registration number is 52,005.

Representation of Client, [REDACTED]

4. [REDACTED] hired Respondent to prepare, file, and prosecute patent applications on his behalf, including U.S. Patent Application Number 1 [REDACTED] (“the [REDACTED]

application”) and U.S. Application Number [REDACTED] (“the [REDACTED] application”).

5. On September 26, 2008, the Office mailed Respondent a Notice of Allowance and Fees Due in the [REDACTED] application. Respondent did not timely respond to the September 26, 2008 notice; consequently, the [REDACTED] application became abandoned without [REDACTED] consent.

6. On March 9, 2009, the Office mailed Respondent a Notice of Missing Parts in the [REDACTED] application informing him that the inventor’s oath was missing and that a supplemental fee was required. Although Respondent represents that he timely responded to the March 9, 2009 notice, the USPTO did not receive the payment and, consequently, the [REDACTED] application became abandoned without [REDACTED] consent.

Representation of Client, [REDACTED]

7. [REDACTED] hired Respondent to prosecute patent applications on her behalf, including U.S. Patent Application Number [REDACTED] (“the [REDACTED] application”).

8. On November 5, 2009, the Office mailed Respondent a Notice of Allowance in the [REDACTED] application. Respondent mistakenly directed the Office to pay the issue fee on an application other than the [REDACTED] application; consequently, the [REDACTED] application became abandoned without [REDACTED] consent. Respondent represents that, upon learning of the mistaken direction, he requested that the Office apply the issue fee to the [REDACTED], but the Office took no action.

9. After learning of the status of the [REDACTED] application from the Office, [REDACTED], herself, filed a petition to revive the [REDACTED] application and paid the eight hundred and ten dollar (\$810.00) petition fee. The Office granted the petition and issued a patent to [REDACTED] on the [REDACTED] application.

Miscellaneous Information

10. Respondent delegated important client matters to his office staff.

11. Respondent represents that his firm had significant staffing problems during the events at issue and that new office manager made several clerical and administrative errors that contributed to the abandonments of the [REDACTED] application, the [REDACTED] application, and the [REDACTED] application.

12. Respondent represents that, since the events at issue, his firm has subsequently hired new personnel, including a new office manager and intellectual property paralegal, and has meticulously trained them in patent procedures.

Legal Conclusions

13. Respondent acknowledges that, based on the information contained in the Stipulated Facts, his conduct violated 37 C.F.R. § 10.77(c) (proscribing neglect of entrusted legal matters) by (i) allowing clients' patent applications to become abandoned without the clients' consent and (ii) not adequately supervising his office staff to which he had delegated important client matters.

Agreed Upon Sanction

14. Respondent agrees, and it is ORDERED that:
- a. Respondent be, and hereby is, suspended from practicing patent, trademark, and other non-patent law before the Office for twenty-four (24) months commencing on the date on which this Final Order is signed;
 - b. Respondent be, and hereby is, granted limited recognition to practice before the Office commencing on the date on which this Final Order is signed and expiring thirty (30) days after the date on which this Final Order is signed with such limited recognition being granted for the sole purpose of facilitating Respondent's compliance with the provisions of 37 C.F.R. § 11.58(b);
 - c. Respondent shall comply with 37 C.F.R. § 11.58, and the OED Director shall comply with 37 C.F.R. § 11.59;
 - d. At any time after twelve (12) months from the date on which this Final Order is signed, Respondent may file a petition for reinstatement pursuant to 37 C.F.R. § 11.60 requesting reinstatement effective prior to the expiration of the 24-month period of suspension set forth in subparagraph a., above;
 - e. Respondent shall remain suspended from practice before the Office until the OED Director grants a petition requesting Respondent's reinstatement pursuant to 37 C.F.R. § 11.60(c);
 - f. Respondent shall serve a twenty-four (24) month period of probation beginning on the date this Final Order is signed;
 - g. (1) if the OED Director is of the opinion that Respondent, during Respondent's probationary period, failed to comply with any provision of this Final Order or any Disciplinary Rule of the USPTO Code of Professional Responsibility, the OED Director shall:
 - (A) (i) if Respondent has not yet been reinstated: issue to Respondent an Order to Show Cause why the USPTO Director should not enter an order barring Respondent from filing a request for reinstatement during the 24-four month suspension set forth in subparagraph a., above;

or

(ii) if Respondent has been reinstated: issue to Respondent an Order to Show Cause why the USPTO Director should not enter an order immediately suspending Respondent for up to an additional twelve (12) months for the violations set forth in paragraph 13, above;

(B) send the Order to Show Cause to Respondent at the last address of record Respondent furnished to the OED Director pursuant to 37 C.F.R. § 11.11; and

(C) grant Respondent fifteen (15) days to respond to the Order to Show Cause;

and

(2) in the event after the 15-day period for response and consideration of the response, if any, received from Respondent, the OED Director continues to be of the opinion that Respondent, during Respondent's probationary period, failed to comply with any provision of this Final Order or any Disciplinary Rule of the USPTO Code of Professional Responsibility, the OED Director shall:

(A) deliver to the USPTO Director: (i) the Order to Show Cause, (ii) Respondent's response to the Order to Show Cause, if any, and (iii) argument and evidence supporting the OED Director's conclusion that Respondent, during Respondent's probationary period, failed to comply with any provision of this Final Order or any Disciplinary Rule of the USPTO Code of Professional Responsibility, and

(B) (i) if Respondent has not been reinstated: request that the USPTO Director enter an order barring Respondent from filing a request for reinstatement during the 24-month suspension set forth in subparagraph a., above,

or

(ii) if Respondent has been reinstated: request that the USPTO Director enter an order immediately suspending Respondent for up to an additional twelve months for the violations set forth in paragraph 13, above;

h. Directs that, if, pursuant to the preceding subparagraph, the USPTO Director

enters an order barring Respondent from filing a request for reinstatement during the 24-month suspension set forth in subparagraph a., or enters an order immediately suspending Respondent up to an additional twelve months for the violations set forth in paragraph 13, above: (i) the USPTO shall promptly dissociate Respondent's name from all USPTO Customer Numbers and Public Key Infrastructure ("PKI") certificates and (ii) Respondent may not apply for or obtain a USPTO Customer Number unless and until he is reinstated to practice before the USPTO;

- i. Directs that, if, pursuant to subparagraph g., above, the USPTO Director enters an order barring Respondent from filing a request for reinstatement during the 24-month suspension set forth in subparagraph a., or enters an order immediately suspending Respondent for up to an additional twelve months for the violations set forth in paragraph 13, above, and Respondent seeks a review of the USPTO Director's action, any such review shall not operate to postpone or otherwise hold in abeyance the USPTO Director's order;
- j. Directs the OED Director to publish this Final Order at the Office of Enrollment and Discipline's Reading Room electronically located at: <http://des.uspto.gov/Foia/OEDReadingRoom.jsp>; except that the names of the clients and the application numbers referenced herein may be redacted.
- k. Directs the OED Director to publish a notice in the *Official Gazette* materially consistent with the following:

Notice of Suspension and Probation

This notice concerns Kenneth Brian Matlock of Walnut Creek, California, a registered patent attorney (Registration No. 52,005). Mr. Matlock has been suspended for twenty-four months by the United States Patent and Trademark Office ("USPTO" or "Office") for violating 37 C.F.R. § 10.77(c). Mr. Matlock is eligible to request reinstatement after serving twelve months of his 24-month suspension. Mr. Matlock has also been placed on probation for twenty four months.

During his representation of certain clients before the Office, Mr. Matlock allowed patent applications to become abandoned without those clients' consent. Mr. Matlock represents that his firm had significant staffing problems during the time of the events at issue and that a new office manager made several clerical and administrative errors that contributed to the abandonments. He further represents that, since the events at issue, his firm has subsequently hired new personnel, including a new office manager and intellectual property paralegal, and has meticulously trained them in patent procedures.

This action is the result of a settlement agreement between Mr. Matlock and the OED Director pursuant to the provisions of


35 U.S.C. §§ 2(b)(2)(D) and 32 and 37 C.F.R. §§ 11.20, 11.26, and 11.59. Disciplinary decisions involving practitioners are posted for public reading at the Office of Enrollment and Discipline Reading Room located at: <http://des.uspto.gov/Foia/OEDReadingRoom.jsp>.

- l. Respondent shall pay restitution in the amount of eight hundred and ten dollars (\$810.00) to [REDACTED] in strict compliance with the following payment schedule:
 - i. \$405.00 as soon thereafter as is practical given the date on which this Final Order is signed;
 - and
 - ii. \$405.00 on or before March 1, 2012;
- m. Within fifteen (15) days of the due date of each payment identified in subparagraph l., above, Respondent shall provide the OED Director with an affidavit and corroborating document(s) (e.g., a copy of the payment letter mailed to the client) demonstrating his compliance with those payment obligations;
- n. Within (30) days of the date on which this Final Order is signed, the OED Director shall file a motion to dismiss the disciplinary proceeding currently pending against Respondent;
- o. Nothing in the Agreement or this Final Order shall prevent the Office from seeking discipline against Respondent in accordance with the provisions of 37 C.F.R. §§ 11.34 through 11.57 for the misconduct that caused the USPTO Director to enter an order barring Respondent from filing a request for reinstatement during the twenty-four (24) month suspension set forth in subparagraph a., or immediately suspending Respondent pursuant to the provisions of subparagraph g, above;
- p. Directs that nothing in the Agreement or this Final Order shall prevent the Office from considering the record of this disciplinary proceeding, including this Final Order, when addressing any further complaint or evidence of the same or similar misconduct by Respondent brought to the attention of the Office or in any future disciplinary proceeding concerning Respondent (i) as an aggravating factor to be taken into consideration in determining any discipline to be imposed and/or (ii) to rebut any statement or representation by or on Respondent's behalf; and

- q. Directs that the OED Director and Respondent shall each bear their own costs incurred to date and in carrying out the terms of the Agreement.

FEB - 7 2012

Date



JAMES O. PAYNE
Deputy General Counsel for General Law
United States Patent and Trademark Office

on behalf of

David M. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

cc:

Director of the Office of Enrollment and Discipline
U.S. Patent and Trademark Office

K. Brian Matlock

[REDACTED]
[REDACTED]