UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE ADMINISTRATIVE LAW JUDGE

In the Matter of: DAVID F. KLEINSMITH, Respondent.	Proceeding No. D2016-10 November 5, 2019

<u>Appearances:</u>

Robin Crabb, Esq.
Elizabeth A. Francisl, Esq.
Associate Solicitors
United States Patent and Trademark Office

David F. Kleinsmith, Esq.
Pro Se

Before: Alexander **FERNÁNDEZ,** United States Administrative Law Judge

INITIAL DECISION AND ORDER

The Director of the Office of Enrollment and Discipline ("OED Director") for the United States Patent and Trademark Office ("USPTO" or "Office") filed a *Complaint* alleging David F. Kleinsmith ("Respondent") committed violations of the USPTO disciplinary rules. The essence of the *Complaint* is that Respondent committed misconduct by failing to pay or keep current on his court-ordered child support payments. In addition, the *Complaint* claims Respondent also engaged in misconduct by failing to cooperate with the OED's investigation of a written grievance that was submitted by the person to whom the court-ordered child support payments were due. Respondent filed an *Answer* generally admitting the factual allegations in the *Complaint* but denying that his conduct constituted willful violations of the USPTO's disciplinary rules. Respondent also raised a number of affirmative defenses and grounds for mitigation.

On July 15, 2019, the Court issued the *Order Granting Partial Summary Judgment*, wherein the Court found that undisputed material facts supported a finding that Respondent violated the USPTO disciplinary rules as alleged in the *Complaint*.[1] However, the Court

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[1] The Court's findings of fact and rulings on summary judgment are incorporated into this *Initial Decision*. A copy of the *Order Granting Partial Summary Judgment* is also attached.

declined to impose the eighteen-month sanction sought by the OED Director on summary judgment, because Respondent's *Answer* raised alleged facts that could mitigate the sanction to be imposed. Instead, the Court ordered that the matter should proceed to a hearing so that the Court could compile a complete record for consideration of the sanction that would be imposed.

The hearing was held on July 23, 2019. Respondent did not appear at the hearing.[2] The OED Director filed a timely post-hearing brief on September 23, 2019. Respondent did not file a post-hearing brief or respond to the OED Director's post-hearing brief.

FACTUAL FINDINGS

On October 18, 2007, Respondent represented himself in a hearing before the California Superior Court, San Diego County Division. The proceeding concerned child support payments to be paid to Elena Spight, by Respondent, for the support of their children. Following the hearing, the California Superior Court ordered Respondent to pay $2,092 per month to Elena Spight for current child support, applied retroactively to January 1, 2007. Between October 2009 and January 2016, Respondent almost never paid the full monthly amount due to Ms. Spight. In fact, there were twelve months during that period that Respondent made no payment at all. Instead, Respondent allowed his child support arrears to grow past $350,000 by November of 2018.

Between 2009 and 2013, Respondent's friend, Chris Nolan, loaned him at least $97,000. However, Respondent did not use the money he received from Mr. Nolan to bring his past-due child support payments current. For instance, after receiving $15,000 from Mr. Nolan, Respondent only paid $300 in court-ordered child support the following month. This was the same amount he paid in the prior month despite receiving the loan from Mr. Nolan. Instead, Respondent purposely tried to hide these loans by having Mr. Nolan send loan proceeds directly to third parties.

On January 29, 2015, the OED Director received a written grievance from Ms. Spight. The OED began investigating the allegations in the grievance and sent Respondent a Request for Information ("RFI") on March 27, 2015. After several attempts at delivery, Respondent received the RFI on April 23, 2015. However, Respondent did not respond to the RFI.

On June 1, 2015, the OED sent Respondent additional correspondence requesting that Respondent respond to the RFI by June 11, 2015. That letter was received by Respondent a few days after his mother passed away. Respondent did not submit a timely response to the June correspondence. Instead, Respondent contacted the OED on June 12, 2015, and requested additional time in which to respond to the RFI. However, Respondent never provided a substantive response to the RFI.

In July of 2018, after Respondent's oldest daughter turned 18 years old and graduated from high school, Respondent's monthly child support obligation decreased to $1,318 per month.

[2] Respondent also failed to file exhibits and a prehearing statement in advance of the hearing date, as required by the Court's *Second Notice of Hearing and Order* issued on February 6, 2019.

That month, Respondent paid $10,336.20 towards his past-due child support obligation. And, for the three months following, Respondent paid $1,568 each month in child support.

LEGAL CONCLUSIONS ON SUMMARY JUDGMENT

On summary judgment, the Court found that Respondent committed violations of the USPTO disciplinary rules. Specifically, Respondent knowingly disobeyed the California Superior Court's order to him to make child support payments, which is a violation of 37 C.F.R. § 11.304(c). Respondent's refusal to comply with a court order also constitutes conduct that is prejudicial to the administration of justice in violation of 37 C.F.R. § 10.23(b)(5) and 37 C.F.R. § 11.804(d). Respondent also engaged in conduct that is prejudicial to the administration of justice by knowingly failing to respond to the OED's lawful request for information, which is a violation of 37 C.F.R. § 11.801(b).

SANCTION

When moving for summary judgment, the OED Director requested that Respondent be suspended for not less than eighteen (18) months, with Respondent's reinstatement conditioned on Respondent's compliance with all court orders prior to readmission, including the full payment of arrears. The OED Director now requests Respondent's exclusion from practicing before the Office. Before sanctioning a practitioner, the Court must consider the following four factors:

> (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. Violations of Duties Owed.

Respondent repeatedly failed to pay court-ordered child support payments to his ex-spouse for the support of their children. Such misconduct violates Respondent's duty to not only his children, but also to the public and the legal system. See People v. Verce, 286 P.3d 1107, 1109 (Colo. 2012) (noting that the refusal to make child support payments causes injury to the legal system, the public, and the minor child); Ky. Bar Ass'n v. James, 452 S.W.3d 604, 606 (Ky. 2015) (finding that the failure to pay court-ordered child support constitutes a violation of "the duty and the responsibility of an attorney as an officer of the court to conduct their personal and professional life in such manner as to be above reproach."); In re Fandey, 1994 Calif. Op. LEXIS 42, *33 (Mar. 28, 1994) ("[T]he enforcement of child support orders is of heightened concern" and noting that the enactment of the California Welfare and Institutions Code section 11350.6 and Business and Professions Code section 6143.5 recognize the seriousness of failing

to pay child support in our society by providing for the suspension of attorneys and other licensed professionals for non-payment of child support).

Respondent also violated his duty to the legal profession (specifically practitioners) by failing to cooperate in the OED's investigation. Such misconduct can be perceived to "weaken the public's perception of the legal profession's ability to self-regulate" and "undermine the integrity of the attorney disciplinary system." In re Brost, 850 N.W.2d 699, 705 (Minn. 2014).

Respondent's misconduct resulted in violations of his duties to the public, the legal system, and the legal profession. A severe sanction is warranted.

2. Respondent acted intentionally and knowingly.

As noted supra, Respondent was present at the hearing before the California Superior Court, wherein Respondent was ordered to make child support payments to Ms. Spight for the support of their children. However, he consistently failed to comply with the child support order. Such misconduct constitutes knowing violations of the USPTO disciplinary rules. See In re Disciplinary Action Against Giberson, 581 N.W.2d 351, 355 (Minn. 1998) (citing the ABA Standards for Imposing Lawyer Sanctions § 6.22 and stating "Knowing violations can occur when a lawyer fails to comply with a court order that applies directly to him or her, as in the case of lawyers who do not comply with a divorce decree ordering spousal maintenance or child support.")

In addition, Respondent specifically told the OED that he would respond to the RFI, but ultimately failed to do so. His failure to respond constitutes a knowing violation of the USPTO disciplinary rule requiring practitioners to comply with the OED's investigations. See People v. McNamara, 275 P.3d 792, 803 (Colo. 2011) (Knowledge is the conscious awareness of the nature or attendant circumstances of the conduct but without the conscious objective or purpose to accomplish a particular result.")

Respondent knowingly violated the disciplinary rules by refusing to make court-ordered child support payments and failing to respond to the OED's lawful request for information. Accordingly, a severe sanction is warranted.

3. Respondent's misconduct caused actual injury.

Respondent's failure to make child support payments resulted in arrears of over $300,000. Of that amount, over $186,000 was for principal arrears alone. Respondent's children were denied the benefit of his support to a significant degree. Respondent's failure to make timely payments resulted in Respondent caused actual injury to his children. See People v. McNamara, 275 P.3d 792, 803 (Colo. 2011). Accordingly, a severe sanction is warranted.

4. Aggravating and mitigating factors exist in this case.

The Court often looks to the ABA's Standards for Imposing Lawyer Sanctions ("ABA Standards") when determining whether aggravating or mitigating factors exist. See In re Chae,

Proceeding No. D2013-01, slip op. at 4 (USPTO Oct. 21, 2013). A review of the record reveals that both aggravating and mitigating factors exist in this case.

The Court first considers the aggravating factors that are present in this case. They include Respondent's selfish motive, a pattern of misconduct, and multiple offenses. In this case, Respondent has claimed an inability to pay the court-ordered child support payments. However, evidence in the record demonstrates Respondent's misconduct was selfishly motivated. See In re Green, 982 P.2d 838, 839 (Colo. 1999) (finding that an attorney's failure to resolve child support debt evinces a selfish motive."). For instance, Respondent often made no payments to Ms. Spight, and even after receiving a substantial loan from a friend, Respondent only paid a fraction of one child support payments and did not attempt to lower the arrearages that accrued with the loan proceeds. Instead, Respondent asked his friend to transfer the loan proceeds directly to third parties in an attempt to frustrate Ms. Spight's attempts to have Respondent pay child support as required by court order.

Respondent's failure to comply with the court order to make child support payments was systematic and occurred over several years. In fact, Respondent defaulted on his child support payments on more occasions than he complied. This constitutes a pattern of misconduct and is an aggravating factor. See In re Morse, 900 P.2d 1170, 1176 (1995) ("Multiple acts of wrongdoing or a pattern of misconduct constitutes an aggravating circumstance.").

Respondent also committed multiple offenses, which is an aggravating factor. For years, Respondent refused to pay court-ordered child support. Then, when OED investigated Ms. Spight's grievance concerning the unpaid child support, Respondent failed to comply with the OED's investigation by responding to the RFI. Such conduct constitutes separate violations of the USPTO disciplinary rules.

Respondent is also an experienced practitioner. For over twenty-three years, Respondent has been authorized to practice before the USPTO. In addition although Respondent has been intermittently suspended by the State Bar of California, he has been an attorney in that jurisdiction since December of 1995. Based on Respondent's long career as an attorney, his misconduct cannot be excused.[3]

The Court must also consider mitigating factors. In this case, Respondent's lack of a prior disciplinary record and personal and emotional problems mitigate the sanction to be imposed by the Court. For instance, the most recent copy of the RFI that Respondent received during OED's investigation was delivered shortly after Respondent's mother passed away.

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[3] The OED Director also claims Respondent's failure to comply with this Court's prehearing deadlines or to appear at the hearing should constitute an aggravating factor. Indeed, in some cases, the Court has found that a respondent's failure to defend himself demonstrates a bad faith obstruction of the disciplinary proceeding. See In re Mar, Proceeding No. D2019-11 (USPTO Aug. 2, 2019). Here, Respondent's failure to appear at the hearing or submit evidence for the record is not an aggravating factor. It is the OED Director's burden to prove, by clear and convincing evidence, that Respondent committed the violations alleged in the *Complaint*. 37 C.F.R. § 11.49. And, if the OED Director does not meet his burden, a respondent need not present anything to prevail. In this case, Respondent sufficiently participated in this proceeding for the Court to conclude that his failure to appear was not a bad faith attempt to obstruct this process. If anything, Respondent's failure to appear at the hearing and present facts in mitigation of the sanction to be imposed was sufficiently prejudicial to his position.

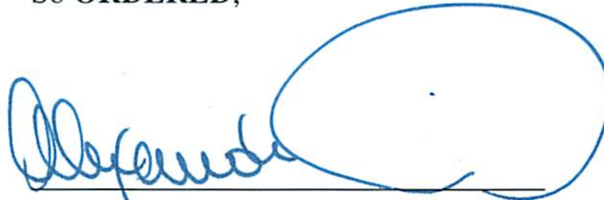
Although this does not justify Respondent's failure to respond to the RFI even after he was given an extension, it constitutes a mitigating circumstance.

Based on the foregoing, the Court finds a suspension of twenty-four (24) months to be warranted. See People v. McNamara, 275 P.3d 792, 805 (Colo. 2011) (citing ABA Standard 6.22 "Suspension is appropriate when a lawyer knowingly violates a court order or rule, and there is injury or potential injury to a client or a party, or interference or potential interference with a legal proceeding.").

ORDER

The Court has considered the factors for sanctions and finds that Respondent shall be **SUSPENDED** from practice before the United States Patent and Trademark Office for a period of not less than twenty-four (24) months.[4]

So **ORDERED**,



Alexander Fernández
United States Administrative Law Judge

Attachments: *Order Granting Partial Summary Judgment*, issued July 15, 2019.

[4] Respondent is directed to 37 C.F.R. § 11.58, which sets forth Respondent's duties while suspended. Respondent shall remain suspended from practice of patent, trademark, and non-patent law before the USPTO and until the OED Director grants a petition reinstating Respondent pursuant to 37 C.F.R. § 11.60(c).

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE ADMINISTRATIVE LAW JUDGE

In the Matter of:	Proceeding No. D2016-10
DAVID F. KLEINSMITH,	July 15, 2019
Respondent.	

ORDER GRANTING PARTIAL SUMMARY JUDGMENT

The Director of the Office of Enrollment and Discipline ("OED Director") for the United States Patent and Trademark Office ("USPTO" or "Office") filed a *Complaint* alleging David F. Kleinsmith ("Respondent") committed violations of the USPTO disciplinary rules. The essence of the *Complaint* is that Respondent committed misconduct by failing to pay or keep current on his court-ordered child support payments. In addition, the *Complaint* claims Respondent also engaged in misconduct by failing to cooperate with the OED's investigation of a written grievance that was submitted by the person to whom the court-ordered child support payments were due. Respondent filed an *Answer* generally admitting the factual allegations in the *Complaint* but denying that his conduct constituted willful violations of the USPTO's disciplinary rules. Respondent also raised a number of affirmative defenses and grounds for mitigation.

On June 21, 2019, the OED Director moved for summary judgment claiming that the undisputed facts establish, by clear and convincing evidence, that Respondent committed violations of the USPTO's disciplinary rules. In the *OED Director's Motion for Summary Judgment* ("Motion"), the OED Director sets forth his argument that Respondent's misconduct warrants a suspension of not less than eighteen (18) months. Respondent did not respond to the *Motion.*[1]

Applicable Law

Standard of Review. Summary judgment is proper where no genuine issue of material fact exists, and the moving party is entitled to judgment as a matter of law. Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248 (1986). A "genuine" issue exists when "the evidence is such that a reasonable jury could return a verdict for the nonmoving party." Id. Additionally, a fact is not "material" unless it affects the outcome of the suit. Id.

Summary judgment is a "drastic device" because, when exercised, it diminishes a party's ability to present its case. Selva & Sons, Inc. v. Nina Footwear, Inc., 705 F.2d 1316, 1323 (Fed.

[1] Respondent's last contact with the Court was a filing received on December 17, 2018. Respondent did not respond to the *OED Director's Motion to Strike Respondent's Affirmative Defenses* filed on February 15, 2019. Respondent also failed to comply with the Court's *Second Notice of Hearing and Order*, which required the parties to submit exhibits to the Court by July 9, 2019.

Cir. 1983). Accordingly, the moving party bears the burden of demonstrating the absence of any material issues of fact. See Anderson, 477 U.S. at 256. Rule 56 of the Federal Rules of Civil Procedure provides that when a party asserts that a fact cannot be genuinely disputed, that party must: (i) cite to materials in the record; or (ii) show the cited materials do not establish the presence of a genuine dispute.[2] Therefore, when the moving party has carried its burden under Rule 56(c), the nonmoving party may not rest upon mere allegations or denials, but must come forward with "specific facts showing that there is a *genuine* issue for trial." Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574, 586-87 (1986) (emphasis added) (citing Fed. R. Civ. P. 56(e)).

Undisputed Material Facts

On December 6, 1995, Respondent was admitted to the State Bar of California. Since February 14, 1996, Respondent has been registered to practice before the USPTO in patent matters and he is currently registered to practice before the USPTO as an attorney. His registration number with the USPTO is 40,050.

On October 18, 2007, Respondent represented himself in a hearing before the California Superior Court, San Diego County Division. The proceeding concerned child support payments to be paid to Elena Spight, by Respondent, for the support of their children. Following the hearing, the California Superior Court ordered Respondent to pay $2,092 per month to Elena Spight for current child support, applied retroactively to January 1, 2007. Between October 2009 and January 2016, Respondent almost never paid the full monthly amount due to Ms. Spight. In fact, there were twelve months during that period that Respondent made no payment at all. Instead, Respondent allowed his child support arrears to grow past $200,000 by November of 2015.[3]

On August 22, 2011, the California Supreme Court ordered that Respondent be suspended from the practice of law for failure to keep current on his court-ordered child support payments. Thereafter, Respondent was reinstated to practice in California on November 2, 2011. However, on March 25, 2013, Respondent was suspended again for being delinquent in court-ordered child support payments. Respondent was reinstated on April 3, 2013 only to be suspended on June 27, 2013, for the same reasons.

On January 29, 2015, the OED Director received a written grievance from Ms. Spight. The OED began investigating the allegations in the grievance and sent Respondent a Request for Information ("RFI") on March 27, 2015. The RFI was returned unclaimed. The OED Director made additional attempts to deliver the RFI to Respondent at two other addresses where the OED Director reasonably believed Respondent received mail. On April 23, 2015, Respondent signed

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[2] The hearing procedures set forth at 37 C.F.R. § 11.43 permit the parties to submit "prehearing motions commonly filed under the Federal Rules of Civil Procedure" to the Court. And, although the Federal Rules of Civil Procedure are not binding upon this proceeding, the Court may refer to the Federal Rules for guidance when necessary.

[3] The OED Director provided documentation from the State of California reflecting total arrears of $ 254,170.94 in November 2015. This amount includes both the principal arrears of $186,286.79, and interest charged by California on unpaid court-ordered child support obligations.

a certified mail receipt demonstrating the RFI was successfully delivered to him. However, Respondent did not respond to the RFI.

On June 1, 2015, the OED sent Respondent additional correspondence requesting that Respondent respond to the RFI by June 11, 2015. That letter was received by Respondent, but he did not submit a response. Instead, Respondent contacted the OED on June 12, 2015, and requested additional time in which to respond to the RFI. However, Respondent never provided a substantive response to the RFI.

Discussion

The OED Director moves for summary judgment in his favor and requests that the Court issue an order suspending Respondent from practice before the Office for a minimum of eighteen months. In support, the OED Director claims the undisputed fact establish, by clear and convincing evidence, that Respondent committed misconduct by failing to comply with a known legal obligation imposed by a court order, and by failing to cooperate with the ensuing OED investigation.

I. Count I – Respondent failed to comply with a court order to make monthly child support payments.

In Count I of the *Complaint*, the OED Director alleges Respondent violated the USPTO disciplinary rules by knowingly disobeying an obligation under the rules of a tribunal, and engaging in conduct that was prejudicial to the administration of justice.[4] The specific misconduct alleged is Respondent's failure to pay court-ordered child support payments to Ms. Spight for the support of their children.

The USPTO disciplinary rules prohibit practitioners from knowingly disobeying an obligation under the rules of a tribunal. 37 C.F.R. § 11.304(c). "Knowingly" means having "actual knowledge of the fact in question." Id. at § 11.1. And, a "tribunal" can refer to "the Office, a court, an arbitrator in a binding arbitration proceeding or a legislative body, administrative agency or other body acting in an adjudicative capacity. Id. A practitioner who knowingly disobeys a court order is also in violation of the USPTO disciplinary rules proscribing conduct that is prejudicial to the administration of justice. See People v. Verce, 286 P.3d 1107, 1109 (Colo. 2012) (Knowingly disobeying a court order to pay child support constitutes conduct prejudicial to the administration of justice.); *In re* Disciplinary Action Against Giberson, 581 N.W.2d 351, 354 (Minn. 1998).

Here, Respondent admitted that the California Superior Court ordered him to pay $2,092 per month to Ms. Spight for child support, and the OED Director presented uncontested evidence that Respondent represented himself during that proceeding. Respondent also admitted that he

[4] Effective May 3, 2013, the USPTO Rules of Professional Conduct apply to persons who practice before the Office. See 37 C.F.R. §§ 11.101 through 11.901. Conduct occurring prior to May 3, 2013, is governed by the USPTO Code of Professional Responsibility. See 37 C.F.R. §§ 10.20 through 10.112 (2012). The allegations of misconduct set forth in the *Complaint* occurred both prior to and after May 3, 2013. Therefore, the Court must consider both the USPTO Code of Professional Responsibility and USPTO Rules of Professional Conduct when determining whether Respondent is liable for violations of the USPTO disciplinary rules.

had been administratively suspended from the practice of law for being delinquent in court-ordered child support payments. Although Respondent stated in his *Answer* that he did not have sufficient evidence to admit or deny the approximate amount of his child support arrears as of November 2015, Respondent admitted that the amount was at least $ 200,000.

The foregoing undisputed, material facts constitute clear and convincing evidence that Respondent knew of his court-ordered obligation to make child support payments of $2,092 per month to Ms. Spight. And yet, between October 2009 and January 2016, Respondent repeatedly disobeyed the California Superior Court's order. Accordingly, the Court finds that Respondent knowingly disobeyed his obligation under the rules of a tribunal, which constitutes a violation of 37 C.F.R. § 11.304(c). See e.g., People v. McNamara, 275 P.3d 792, 796 (Colo. 2011) (finding that an attorney's failure to make child support payments constituted a violation of the Colorado Rules of Professional Conduct proscribing knowingly disobeying an obligation under the rules of a tribunal); *In re* Disciplinary Action Against Giberson, 581 N.W.2d at 355 ("Knowing violations can occur when a lawyer fails to comply with a court order that applies directly to him or her, as in the case of lawyers who do not comply with a divorce decree ordering spousal maintenance or child support."). And, because knowingly disobeying a court's order constitutes conduct prejudicial to the administration of justice, the Court finds, by clear and convincing evidence, that Respondent also violated 37 C.F.R. § 10.23(b)(5) for delinquent child support payments prior to May 3, 2013, and 37 C.F.R. § 11.804(d) for delinquent child support payments on or after May 3, 2013.

II. Count II – Respondent failed to cooperate with the OED's investigation into Ms. Spight's grievance.

The OED Director alleges Respondent's failure to respond to the OED's RFI constitutes professional misconduct in violation of the USPTO Rules of Professional Conduct at 37 C.F.R. § 11.801(b) and 37 C.F.R. § 11.804(d).

The USPTO disciplinary rules state that a practitioner, in connection with a disciplinary matter, shall not knowingly fail to respond to a lawful demand or request for information unless disclosure of such information is protected. 37 C.F.R. § 11.801(b). As noted *supra*, "knowingly" means having "actual knowledge of the fact in question." Id. at § 11.1.

In his *Answer*, Respondent admitted that he received both the RFI when it was sent to him in April 2015 and the Lack of Response Notice sent by the OED in June 2015. He also admits that, despite receiving the RFI from the OED, he never provided a substantive response to the RFI. Based on the foregoing undisputed and material facts, the Court finds Respondent knowingly failed to respond to the OED's RFI. Accordingly, the OED Director has proven, by clear and convincing evidence, that Respondent violated 37 C.F.R. § 11.801(b). And, because the failure to cooperate in the OED's investigation may constitute conduct prejudicial to the administration of justice, Respondent's misconduct also violates 37 C.F.R. § 11.804(d). See e.g., Iowa Supreme Court Atty. Disciplinary Bd. v. Kadenge, 706 N.W.2d 403, 409 (Iowa 2005).

III. Respondent's special defenses are rejected.

In his *Answer*, Respondent raised a number of defenses, most of which were stricken in the Court's *Ruling and Order on OED Director's Motion to Strike Affirmative Defenses*. Respondent's remaining defenses are that his misconduct was not willful and that he did not receive adequate notice that 37 C.F.R. § 11.304(c) would apply to unpaid child support. For the reasons set forth below, Respondent's defenses are rejected.

First, Respondent argues that the word "knowing" in 37 C.F.R. § 11.304(c) "rises to the level of the word 'willful' as utilized in 5 U.S.C. § 558." Therefore, Respondent claims that his mere knowledge of the court-ordered child support obligation is insufficient to prove, by clear and convincing evidence, that he violated 37 C.F.R. § 11.304(c).

The USPTO disciplinary rules that Respondent violated do not require that the misconduct be willful. In fact, only 37 C.F.R. § 11.304(c) includes a scienter requirement, which is satisfied when a practitioner "knowingly" engages in the alleged misconduct. See 37 C.F.R. § 11.304(c) (stating that a practitioner shall not "knowingly disobey an obligation under the rules of a tribunal . . . ."). Moreover, there is no basis for Respondent's proposition that "knowingly" under 37 C.F.R. § 11.304(c) should mean "willful" when the disciplinary rules plainly define "knowingly" as "actual knowledge of the fact in question." Id. at § 11.1. Accordingly, Respondent's defense is rejected.[5]

Next, Respondent claims that any rule-making notice provided by the USPTO in connection with 37 C.F.R. § 11.304(c) that did not specifically reference the applicability of this rule to child support orders did not put California attorneys on proper notice. In support of this argument, Respondent explains that, at the time of the misconduct, California was the only state that did not draw its disciplinary rules from the Model Rules of Professional Conduct of the American Bar Association ("ABA Model Rules"). And, because the USPTO Rules of Professional Conduct were implemented to conform with the ABA Model Rules, Respondent did not have adequate notice that 37 C.F.R. § 11.304(c) would cover the nonpayment of court-ordered child support.

On October 18, 2012, the USPTO published a Notice of Proposed Rulemaking in the Federal Register informing the public that new USPTO disciplinary rules based on the ABA Model Rules were being proposed. See CHANGES TO REPRESENTATION OF OTHERS BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE, 77 Fed. Reg. 64,190 (proposed Oct. 18, 2012) (to be codified at 37 C.F.R. pt. 11). The Notice further explained that the purpose of the change was to "align the USPTO's professional responsibility rules with those of most other U.S. jurisdictions." Id. Even if the Federal Register notices did not explicitly state that the soon-to-be

[5] The OED Director concedes the Administrative Procedure Act (APA) requires that the USPTO must establish one of three prerequisites prior to the imposition of a limitation on a practitioner's license. See 5 U.S.C. § 558(c). One prerequisite is that the conduct was willful. Id. To the extent that Respondent is claiming that his conduct must be willful pursuant to APA, the Court finds that his general assertion, without supporting evidence, is insufficient to raise a genuine factual dispute. That is because there is binding precedent that the willfulness requirement of 5 U.S.C. § 558(c) is satisfied by showing that a practitioner disregarded a known legal obligation. See Halvonik v. Dudas, 398 F. Supp. 23 115, 124-25 (D.D.C. 2005). As such, Respondent's admission that he knew of his legal obligation to pay court-ordered child support and to respond to the RFI, both of which are legal obligations, support a finding that clear and convincing evidence exists to prove Respondent's misconduct was willful.

implemented rule found at 37 C.F.R. § 11.304(c) would extend to delinquent court-ordered child support payments, the Court finds that Respondent had sufficient notice. After all, that an attorney is considered to have disobeyed a rule of a tribunal by failing to comply with court order for child support is not a novel proposition. See e.g., In re Fortin, Proceeding No. D2014-39 (USPTO Dec. 9, 2014) *available at* https://foiadocuments. uspto.gov/oed/0791_dis_2014-12-09.pdf; People v. McNamara, 275 P.3d at 796. Moreover, the Federal Register Notice explained,

> by adopting professional conduct rules consistent with the ABA Model Rules and the professional responsibility rules of 50 U.S. jurisdictions, the USPTO both would provide attorneys with consistent professional conduct standards, and would provide practitioners with large bodies of both case law and opinions written by disciplinary authorities that have adopted the ABA Model Rules.

77 Fed. Reg. 64,190. The Notice further stated,

> a body of precedent specific to practice before the USPTO will develop as disciplinary matters brought under the USPTO Rules of Professional Conduct progress through the USPTO and the Federal Courts. In the absence of binding USPTO-specific precedent, practitioners may refer to various sources for guidance.

Id. The Notice then offered that,

> relevant guidance may be provided by opinions issued by State bars and disciplinary decisions based on similar professional conduct rules in the states. Such guidance is not binding precedent relative to USPTO Rules of Professional Conduct, but it may provide a useful tool in interpreting the rules while a larger body of USPTO-specific precedent is established.

Id. Therefore, even if Respondent was not explicitly informed that disobeying a court order to make child support payments would constitute misconduct under 37 C.F.R. § 11.304(c), Respondent was adequately informed that the proposed disciplinary rules would be consistent with the ABA Model Rules, and that guidance from other jurisdictions that adopted rules similar to the ABA Model Rules could be used for interpreting the new USPTO disciplinary rules. Accordingly, the Court finds Respondent's argument to be unpersuasive and is rejected.

The Court concludes that undisputed, material facts demonstrate that Respondent failed to comply with a court order to make child support payments to Ms. Spight. That failure constitutes violations of 37 C.F.R. § 10.23(b)(5) of the USPTO Code of Professional Responsibility, and 37 C.F.R. §§ 11.304(c) and 11.804(d) of the USPTO Rules of Professional Conduct. In addition, the undisputed, material facts also demonstrate that Respondent failed to respond to the OED's RFI, which constitutes violations of 37 C.F.R. §§ 11.801(b) and 11.804(d). Respondent's admissions and failure to respond to the OED's *Motion*, or otherwise present

evidence rebutting the material facts alleged in the *Complaint*, support a finding that the OED Director has met his burden and is entitled to judgment as a matter of law.

IV. Sanction

The OED Director requests that the Court sanction Respondent by entering an order suspending him from practice before the Office for a period of not less than eighteen months with reinstatement conditioned on Respondent's compliance with all court orders prior to readmission, including but not limited to the full payment of arrears. Before sanctioning a practitioner, the Court must consider the following four factors:

> (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).

The majority of Respondent's *Answer* a recitation of alleged mitigating factors. For instance, Respondent describes, at length, numerous events and circumstances occurring shortly before and during the period he should have responded to the RFI. Respondent claims these factors mitigate his failure to respond to the RFI. In addition, Respondent stated in his *Answer* that he would be prepared, at the hearing, to present evidence rebutting any attempt by the OED Director to establish that Respondent had the ability to pay the court-ordered child support payments but willfully failed to do so.

Respondent's arguments and supporting evidence should have been produced when the OED Director moved for summary judgment seeking an eighteen-month suspension. However, the Court finds Respondent's *Answer* sufficiently identifies facts that, if proven, could be relevant to the mitigation of any sanction. Therefore, despite Respondent's failure to respond to the OED Director's *Motion*, the Court is reluctant to grant summary judgment without first allowing Respondent to present evidence relevant to the issue of the sanction.

Accordingly, the OED Director's *Motion* is **GRANTED** as it relates to Counts I and II of the *Complaint*, but **DENIED** as to the OED Director's request for an eighteen-month minimum sanction. This matter shall proceed to hearing, as scheduled, so that the Court compile a complete record as to the four factors it must consider pursuant to 37 C.F.R. § 11.54(b).

So **ORDERED**,

Alexander Fernández
United States Administrative Law Judge