

**BEFORE THE UNDER SECRETARY OF COMMERCE  
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE  
UNITED STATES PATENT AND TRADEMARK OFFICE**

**In the Matter of**           )  
                                      )  
**Kley Achterhof,**           )  
                                      )  
**Appellant.**                )  
\_\_\_\_\_ )

Proceeding No. D2017-24

**Final Order**

Pursuant to 37 C.F.R. § 11.55, Kley Achterhof (“Appellant”) has appealed the December 11, 2018 Initial Decision and Order (“Initial Decision”) of Administrative Law Judge (“ALJ”) Alexander Fernandez to the Director of the United States Patent and Trademark Office (“USPTO”, “Office” or “Agency”). In that Initial Decision, the ALJ concluded that Appellant engaged in the unauthorized practice of law before the USPTO in violation of 37 C.F.R. § 11.505 and 37 C.F.R. § 11.116(a)(1).<sup>1</sup> (A.27).<sup>2</sup> Further, Appellant’s unauthorized practice of law before the USPTO was found to have violated former 37 C.F.R. § 10.23(b)(5) and current 11.804(d), both of which proscribe engaging in conduct that is prejudicial to the administration of justice. (*Id.*) Finally, the ALJ found that Appellant’s misconduct violated 37 C.F.R. § 11.701 which proscribes false or misleading communications regarding a practitioner’s services. (A.27-28). After considering these violations and the relevant factors set forth in 37 C.F.R. § 11.54(b), the ALJ ordered that Appellant be suspended from practice before the USPTO in patent, trademark, and other non-patent matters for 18 months. (*Id.*).

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<sup>1</sup> Effective May 3, 2013, the USPTO Rules of Professional Conduct (“USPTO Rules”), 37 C.F.R. §§ 11.101 through 11.901, apply to persons who practice before the USPTO. Prior to May 3, 2013, the USPTO Code of Professional Responsibility (“USPTO Code”) applied to persons practicing before the USPTO. *See* 37 C.F.R. §§ 10.20-10.112. Appellant engaged in misconduct that violated both the USPTO Rules and the USPTO Code.

<sup>2</sup> References to specific pages in the Administrative Record are designated as “A.\_”.

In this appeal, briefs were submitted by Appellant and the Director of the USPTO Office of Enrollment and Discipline (“OED Director”).<sup>3</sup>

For the reasons set forth below, the USPTO Director affirms the ALJ’s Initial Decision.

## **I. FINDINGS OF FACT**

1. Appellant is an attorney licensed and in good standing with the state of Wyoming. (A.993, No. 1; A.7762:9-10).

2. Appellant is not and never has been a practitioner registered to practice before the USPTO in patent matters. (A.993, no. 2; A.7762:11-13). On August 12, 2013, Appellant took the patent registration examination but failed the examination. (A.2288; A.7764:8-12; A.7845:9-12; Gov. Ex. 35). OED informed him that he did not achieve a passing grade on the examination on August 14, 2013. (Gov. Ex. 35). He did not retake the examination. (A.7845-7846).

3. Appellant has practiced as a trademark practitioner in multiple trademark matters before the USPTO. (A.35; A.79; A.5650-6176; 7852:4-10; Appeal at 6). He also participated in two (2) Trademark Trial and Appeal Board (“TTAB”) proceedings. (A.7857-7858). For one proceeding, No. 91223013, he remains the attorney of record in that matter. (A.6177-6208).

### The Inventors’ Roundtable

4. The Inventors’ Roundtable is “a group that is put together to support inventors and to help inform inventors of the various patent processes of how patents work, the differences of patents, basically all things patent-related.” (A.7884:10-14). The Inventors’ Roundtable meetings are described as a safe place to discuss the processes its members are going through for turning their ideas into inventions that are sold in the market place, including connecting inventors with

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<sup>3</sup> Appellant’s “Appeal and Appellant’s Brief” is referenced as “Appeal.” The Brief for Director of The Office of Enrollment and Discipline” is referenced as the “Response.” Finally, “Appellant’s Reply Brief For The Director” is referenced as the “Reply.”

service providers who may have expertise in relevant areas like intellectual property rights. (A.8734:7-20).

5. Appellant attended meetings of the Inventors' Roundtable and attended conferences where he was scheduled to sit or speak on a panel. (A.7884:5-8; Gov. Exs. 79, 80).

Appellant's Actions Regarding Charles Mason

6. In 2009, Charles Mason attended Inventors' Roundtable meetings. (A.7884:5-8, 15-18). Ms. Rita Compton, who owned a company called FLeCusa International ("FLeCusa") and was a founding member of the Inventors' Roundtable, put Mr. Mason in contact with Appellant regarding one of Mr. Mason's invention ideas. (Gov. Ex. 65, pp. 135-141; Gov. Ex. 66).<sup>4</sup> (A.7899-7900; A.7903:17-22). Appellant performed a patent search review for Mr. Mason. (Gov. Ex. 68). However, Mr. Mason did not retain Appellant to file and prosecute a patent application and, instead, another attorney assisted Mr. Mason with filing a provisional patent application in February, 2014. (A.7908:4-10; A.7913:1-3). A year later, on February 9, 2015, the non-provisional patent application for the invention, Application No. 14/617,479 (the '479 Application), was filed by Mr. Mason's counsel. (A.7912:2-4).

7. After becoming frustrated with his patent counsel, Mr. Mason reached out to Appellant on January 28, 2016 for assistance with the '479 Application. (A.7922:18-20; 7924:19-22; 7925:1-5; Gov. Ex. 65, pp. 1-4). Specifically, Mr. Mason requested that Appellant assist him in developing language to respond to an Office Action dated December 15, 2015. (A.7982:7-8; Gov. Ex. 65, pp. 1-4; Joint Ex. 22, pp. 137-144). Following a phone call on February 10, 2016, Appellant agreed to draft a response to the Office Action to be submitted to the USPTO. (Gov.

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<sup>4</sup> In a letter to Mr. Mason, Ms. Crompton stated that FLeCusa is comprised of legal assignment specialists that she would secure Mr. Mason one or more of FLeCusa's "contract law firms, attorneys or other legal professionals to represent [Mr. Mason] in the various legal matters [Mr. Mason] assigns to them." (Gov. Ex. 66). The letter also detailed billing and hourly fees. (*Id.*).

Ex. 65, p. 2). In addition, Appellant told Mr. Mason that Ms. Crompton would be in touch with instructions for revoking the power of attorney for the '479 Application. (*Id.*). The following week, Mr. Mason filed a document with the Office revoking the power of attorney for the '479 Application. (A.7922:11-20; Joint Ex. 22, p. 151).

8. Appellant drafted the response to the USPTO Office Action. (A.993-994, Nos. 10, 11; A.7932:8-21). The response contained amended claims and arguments as to the patentability of the invention in the '479 application. (A.994, no. 12). Appellant advised Mr. Mason to sign the Office Action as if he were proceeding *pro se*. (A.7928:9-16). Ms. Crompton or Appellant then filed the response to Office Action for the '479 Application, which was signed by Mr. Mason indicating that he was filing as a *pro se* applicant. (A.7931:16-7933:4; Gov. Ex. 75). However, Mr. Mason did not prepare the document. (A.7932:8-21).

9. On June 13, 2016, the USPTO sent Mr. Mason another Office Action wherein the examiner informed Mr. Mason that certain claims contained in the '479 Application remained rejected. (A.7934; Joint Ex. 22, pp. 177-184). Mr. Mason forwarded the Office Action to Appellant. (A.7937-7938).

10. Around that time, Mr. Mason was seeking investors for his invention. (A.7938:3-4). In discussions with one investor, Mr. Russ Krajec, involving Mr. Mason's invention and the '479 Application, Mr. Krajec informed Mr. Mason that he could not be *pro se* while having an attorney work on the patent. (A.7939:5-19). Mr. Mason then sought the opinion of three other attorneys who confirmed Mr. Krajec's view. (A.7940:22; 7941:1-12; Gov. Ex. 93).

11. In an effort to protect the '479 Application, Mr. Mason sought to obtain proof that he was misinformed that he could proceed *pro se* and have Appellant work on his patent application. (A.7946:7-21). Mr. Mason decided to secretly record conversations with Appellant,

with two (2) other individuals on the line during the conversation. (A.7946:11-14; A.7947; 7986:18-19; A.7987-7988; Gov. Ex. 93). During these conversations, Appellant explained to Mr. Mason that filing *pro se* while having a non-registered attorney work on the patent was a “gray area.” (Gov. Ex. 93, pp. 8-9). Appellant represented to Mr. Mason that it was not necessary for Appellant to be registered with the USPTO as long as Appellant was not appearing before the USPTO on Mr. Mason’s behalf. (Gov. Ex. 93). Mr. Mason informed Appellant that he had obtained the opinions of three other attorney who held a contrary view. (Gov. Ex. 93, p. 16). Appellant responded, “I don't think there’s any strong statutory law or case law or inclusion by the Patent Office that, that's the case . . . Because otherwise I wouldn't be doing this. I wouldn't jeopardize my law license if I thought that there was any-any inequitable conduct or anything like that.” (Gov. Ex. 94, p. 12). Mr. Mason informed Appellant that he would have to “disengage” with Appellant, hire a registered patent attorney, and receive a refund of his fees in order to protect his intellectual property rights. (Gov. Exs. 93, 94). In an email dated July 27, 2016, Mr. Mason terminated Appellant’s representation, directed him to stop working on the ‘479 Application, and requested a full refund of all monies paid to him. (Gov. Ex. 74).

#### Appellant’s Actions Regarding David Thomas

12. Ms. Crompton also provided Appellant’s contact information to another inventor, Mr. David Thomas. (A.994, no. 13; Gov. Ex. 62, pp. 1-2). In a September 17, 2014 e-mail to Ms. Crompton, Mr. Thomas stated that he wanted to contact Appellant about proceeding with a provisional patent application. (Gov. Ex. 62, pp. 1-2). Thereafter, Mr. Thomas sent Appellant an e-mail that included a description of his invention. (Gov. Ex. 62, pp. 3-7).

13. On October 8, 2014, Mr. Thomas sent Appellant a draft of his provisional patent applications, including attachments, via e-mail. (Gov. Ex. 62, pp. 10-45). The e-mail also sought

to discuss strategy, as well as Appellant's opinion on "the best course of action" with regards to submitting his application. (Gov. Ex. 62, p. 10). Appellant assisted Mr. Thomas in drafting and revising his patent application materials. (Gov. Ex. 62, pp. 46-7, 49-50). Mr. Thomas then executed his patent application paperwork indicating he was proceeding *pro se*. (Gov. Ex. 62, pp. 114, 117).

#### Other Patent Services Provided by Appellant

14. Appellant prepared a non-provisional patent application for Mr. David Mimh on April 23, 2016. (A.8542:12-14; A.8543:17-18; A.8573-8574; Gov. Ex. 43). Appellant (or Ms. Crompton at Appellant's direction) filed the non-provisional patent application with the USPTO. (A.8542:15-20). Mr. Mimh signed the non-provisional patent application indicating that he was proceeding *pro se*. (A.8544:10-12; A.8546:15-19). Despite signing the application as a *pro se* applicant, it was Mr. Mimh's understanding that Appellant would be acting as his attorney and communicating on his behalf with the USPTO. (A.8545:16-21). Mr. Mimh was charged \$5,000 for Appellant's services. (A.8542:10-11). After his non-provisional application was received, the USPTO sent two Notices of Missing parts to which Appellant drafted a response on Mr. Mimh's behalf. (A.8547:11-12; A.8549-8551).

15. Three additional inventors, Dale Davenport, Richard Vigil, and Kent Stenzel, testified that Appellant consulted with them and drafted their patent applications for filing with the USPTO. (A.8379-8380; A.8668-8672; A.8711-8713; A.8716-8717).

16. Appellant produced 291 invoices demonstrating that he provided patent legal services to clients. (A.4481-4728; A.8592:5-9). These invoices reflect services provided by Appellant that included completion of provisional patent applications, work on office actions, work on utility patents, design patents, drafting claims, work on Continuations In Part ("CIP"), and preparation

of a PCT application. (A.4486-4490, A.4494-4497, A.4503, A.4508-4509, A.4516, A.4520, A.4525-4526, A.4541, A.4560-4561, A.4567, A.4593, A.4564, A.4637-4638). Notations on some of the bills indicate that Appellant would draft such documents and provide them to his clients to sign them as *pro se* applicants before Ms. Crompton would file them with the USPTO. (Gov. Ex. 101, pp. 43, 49, 109, 117, 220, 231).

17. Appellant also testified at the hearing that he completed the drafting of a utility patent application, drafted design patents, drafted patent drawings, drafted specification text for a CIP, drafted claims, modified drawings, and drafted a specification. (A8613:22-8614:18). Multiple clients testified at the hearing that Appellant provided them with patent legal services, including navigating the patent process and helping clients secure patents. (A.7925:1-5; A.8542:3-20; A.8669:2-8672:11).

## **II. OED DISCIPLINARY PROCEEDING**

The OED Director filed a Complaint and Notice of Proceedings under 35 U.S.C. § 32 (“Complaint”) with the ALJ on July 18, 2017, alleging that Appellant committed multiple violations of both the USPTO Code and the USPTO Rules. (A.34-49). Specifically, the OED Director alleged that Appellant engaged in misconduct prior to May 3, 2013 as follows:

- (a) 37 C.F.R. § 10.23(b)(4) (conduct involving dishonesty, fraud, deceit, or misrepresentation);
- (b) 37 C.F.R. § 10.23(b)(5) (conduct prejudicial to the administration of justice); and
- (c) 37 C.F.R. § 10.23(b)(6) (conduct that adversely reflects on the practitioner's fitness to practice).

(A.41-42).

The Complaint also alleged misconduct that occurred after May 3, 2013 as follows:

- (a) 37 C.F.R. § 11.505 (unauthorized practice of law);
- (b) 11.116(a)(1) (represented a client where the representation would result in a violation of the USPTO Rules of Professional Conduct or other law);
- (c) 11.701 (making a false or misleading communication about the practitioner or the practitioner's services);
- (d) 11.804(b) (committing a criminal act that reflects adversely on the practitioner's honesty, trustworthiness, or fitness as a practitioner in other respects);
- (e) 11.804(c) (conduct involving dishonesty, fraud, deceit, or misrepresentation);
- (f) 11.804(d) (conduct prejudicial to the administration of justice); and
- (g) 11.804(i) (other conduct that adversely reflects on the practitioner's fitness to practice before the Office).

(A.42-44).

Appellant requested a 30-day extension to answer the Complaint and that request was granted but limited to two weeks. (A.60-65). On or about August 20, 2017, Appellant notified the Court that he would be filing a Complaint and Request for Injunction with the Clerk of Court for the United States District Court for the District of Wyoming. (A.66-68; Appeal at 6). On August 22, 2017, Appellant filed an Emergency Motion for a Temporary Restraining Order and Preliminary Injunction. (A.4748-4753) (reference to attachments omitted). On August 30, 2017, the District Court held a hearing on Appellant's motion. (A.2). At the hearing, the U.S. District Court dismissed the case for lack of subject matter jurisdiction. (*Id.*).

Appellant timely filed his Answer to the disciplinary Complaint on August 31, 2017. (A.73-105).

Thereafter, Appellant filed a Motion to Dismiss on October 3, 2017, a Motion for Judgment on the Pleadings on October 13, 2017, and a second Motion to Dismiss on October 13, 2017. (A.371-586, A.614-685). The ALJ held those motions in abeyance and the motions were ultimately denied. (A.2).

A hearing in this matter was held in Denver, Colorado, the location at Appellant's request, from November 14, 2017 through November 16, 2017. (A.109-119; A.7667-8890). Both parties filed post-hearing briefs. (A. 1507-1539; A.1540-1570; A.1571-1593; A.1594-1616).

The ALJ issued the Initial Decision on December 11, 2018, finding that Appellant violated five (5) ethics rules: 37 C.F.R. §§ 11.505, 11.116(a)(1), 10.23(b)(5) (2012), 11.804(d), and 11.701. (A.27-28). After considering relevant aggravating and mitigating factors, the ALJ imposed an 18-month suspension. (A.28). This appeal followed.

### **III. INITIAL DECISION BY ADMINISTRATIVE LAW JUDGE**

On December 11, 2018, the ALJ issued the Initial Decision in this matter and concluded that the OED Director clearly and convincingly established that Appellant violated five (5) of USPTO's disciplinary rules. (A.1-29). Appellant's misconduct stemmed from Appellant providing patent legal to clients who filed applications with the USPTO on a *pro se* basis. Based on the misconduct identified that the ALJ identified, Appellant was found to have violated 37 C.F.R. §§ 11.505, 11.116(a)(1), 10.23(b)(5) (2012), 11.804(d), and 11.701. (A.27-28). After making these findings, and considering the factors under 37 C.F.R. § 11.54(b), the ALJ concluded that Appellant should be suspended from practice before the USPTO in patent, trademark, and non-patent matters for eighteen (18) months. (A.28).

#### IV. DECISION

Appellant is not a registered patent attorney. (A.7762). However, Appellant unquestionably provided patent legal services to clients. Further, he practiced as a trademark practitioner in multiple trademark and TTAB matters before the USPTO. Thus, and as discussed further in this opinion, he is subject to the USPTO's disciplinary authority. *See* 37 C.F.R. § 11.19(a). For the conduct involved in this disciplinary case, Appellant was subject to the ethical requirements set forth in both the USPTO Code and the USPTO Rules. The OED Director must prove violations of the USPTO Code or USPTO Rules by clear and convincing evidence. *See* 37 C.F.R. § 11.49. *See also In re: Johnson*, Proceeding No. D2014-12, at 2 (USPTO Dec. 31, 2014) (Initial Decision).

USPTO regulations permit a party to appeal an ALJ's Initial Decision to the USPTO Director within thirty days (30) of issuance of the Initial Decision. *See* 37 C.F.R. § 11.55(a); *see also* 35 U.S.C. § 2(b)(2)(D). On appeal, the USPTO Director has authority to conduct a *de novo* review of the factual record and may affirm, reverse, or modify the initial decision, or remand the matter to the hearing officer for such further proceedings as the USPTO Director may deem appropriate. *See* 37 C.F.R. §§ 11.55(f), 11.56(a).

Here, Appellant appeals from the December 11, 2018 Initial Decision of the ALJ entering judgment in favor of the Agency and suspending Appellant from the practice of patent, trademark, and other non-patent matters before the USPTO for eighteen (18) months. In support of his appeal, Appellant challenges the USPTO's disciplinary jurisdiction. He claims that he never practiced before the USPTO in patent matters. (Reply, at 11-12). Rather, he claims that he only assisted *pro se* clients. (*Id.*). Further, he claims that Congress did not authorize the USPTO to exercise disciplinary jurisdiction over unregistered practitioners. (Appeal at 11, 13, 19-20). It

is Appellant's view that, because he is not a registered practitioner and did not represent patent applicants before the Agency, discipline here is an overreach of the USPTO's authority. (Appeal at 13, 17-23). Although he admitted to filing a limited number of trademark applications, he claims that practice is not a sufficient basis for exercising disciplinary jurisdiction. (Appeal at 21-22).

In addition to challenging the USPTO's disciplinary jurisdiction, Appellant challenges the substantive findings and legal conclusions of the ALJ. He also asserts that discipline is barred by waiver, laches, unclean hands, and estoppel; he claims that the ALJ failed to respond to his Constitutional arguments concerning due process; and he argues that an 18-month suspension is unwarranted. (Appeal at 10, 15-17, 29-30).

The Director, having considered Appellant's appeal brief, the OED Director's response brief, Appellant's reply brief, as well as the record of the proceedings before the ALJ, finds that there is ample factual and legal support for the ALJ's Initial Decision. Consequently, the Initial Decision of the ALJ is **AFFIRMED**.

**A. Appellant Is Subject to the Disciplinary Jurisdiction of the Office.**

Appellant first argues that the OED lacks subject-matter jurisdiction to both initiate and prosecute a disciplinary proceeding against Appellant. Specifically, he claims that the disciplinary action here is an overreach of USPTO's statutory authority. (Appeal at 13, 17-22). He claims that Congress only intended USPTO to have disciplinary authority over registered practitioners, which he is not. (*Id.* at 11, 13, 19-20). He furthermore argues that any trademark practice he engaged in does not provide a sufficient basis for the USPTO to assert jurisdiction. (*Id.* at 21-22). This position, which is further dissected below, is without merit and contrary to statute, USPTO's regulations, and long-standing USPTO precedent.

Congress vested the USPTO with plenary, statutory authority to promulgate regulations “govern[ing] the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Office.” 35 U.S.C. § 2(b)(2)(D); *see Kroll v. Finnerty*, 242 F.3d 1359, 1364 (Fed. Cir. 2001) (stating that the USPTO has the “exclusive authority to establish qualifications for admitting persons to practice before it, and to suspend or exclude them from practicing before it.”); *Haley v. Lee*, 129 F. Supp 3d 377, 386 (E.D. Va. 2015) (noting that “Congress gave the USPTO wide latitude to govern the conduct of the members of its bar.”) The Director of the USPTO may suspend or exclude a person from practice before the USPTO if the person is “shown to be incompetent or disreputable, or guilty of gross misconduct,” or if the person violates regulations established by the Office. 35 U.S.C. § 32. Accordingly, the USPTO Director has authority to regulate practice before the Office in both patent and trademark matters, including the unauthorized practice of law before the Agency. *Id.*; *see also* 37 C.F.R. § 11.19(a) (“[a]ll practitioners engaged in practice before the Office . . . are subject to the disciplinary jurisdiction of the Office.”); *Haley*, 129 F. Supp 3d at 387 (“Congress also *explicitly* gives the USPTO the power to promulgate regulations related to the conduct of its members.”) In accordance with that authority, the USPTO has enacted an entire regulatory scheme that defines what constitutes practice before the Office and identifies the disciplinary authority of, and the disciplinary processes available to, the OED Director. The USPTO enacted the former USPTO Code, 37 C.F.R. §§ 10.20 *et seq.*, and the current USPTO Rules, 37 C.F.R. § 11.101 through 11.901, both of which include a number of mandatory rules setting forth the minimum level of conduct for practitioners before the Office. If a practitioner fails to comply with his or her professional obligations under these rules, the USPTO has the authority to suspend or exclude

the practitioner from further practice before the Office. *See* 35 U.S.C. §§ 2(b)(2)(D), 32; 37

C.F.R. § 11.19.

Having established that the Agency has broad statutory and regulatory authority to regulate the conduct of practitioners before it, and that it has exercised that authority to establish a comprehensive disciplinary scheme, the first issue to be determined is whether or not Appellant was engaged in practice before the USPTO such that he is subject to the Agency's disciplinary authority. As discussed below, his practice of providing patent legal services to clients and his practice in trademark matters before the USPTO make him unequivocally subject to the USPTO's disciplinary jurisdiction.

1. Appellant Has Practiced Before the USPTO in Patent Matters.

The first basis for finding disciplinary jurisdiction over Appellant is that he provided patent legal services to clients. Pursuant to the USPTO's broad authority, it has issued 37 C.F.R. § 11.19, which specifically prescribes when someone is subject to the USPTO's disciplinary jurisdiction. Section 11.19(a) states that "[a]ll practitioners engaged in practice before the Office ... are subject to the disciplinary jurisdiction of the Office." A person not registered or recognized to practice before the USPTO, like Appellant, is also subject to the Agency's disciplinary authority "if the person provides or offers to provide any legal services before the Office." *Id.* As will be shown, Appellant unequivocally practiced before the Office by providing patent legal services to clients.

The USPTO has defined "practice before the Office" as activity that includes, but is not limited to, any "law-related service that comprehends any matter connected with the presentation to the Office or any of its officers or employees relating to a client's rights, privileges, duties, or responsibilities under the laws or regulations administered by the Office for the grant of a patent

or registration of a trademark, or for enrollment or disciplinary matters.” 37 C.F.R. § 11.5(b).

“Such presentations include preparing necessary documents in contemplation of filing the documents with the Office, corresponding and communicating with the Office, and representing a client through documents or at interviews, hearings, and meetings, as well as communicating with and advising a client concerning matters pending or contemplated to be presented before the Office.” *Id.* More specifically, “[p]ractice before the Office in patent matters includes, but is not limited to, preparing and prosecuting any patent application, consulting with or giving advice to a client in contemplation of filing a patent application or other document with the Office, drafting the specification or claims of a patent application; drafting an amendment or reply to a communication from the Office that may require written argument to establish the patentability of a claimed invention; drafting a reply to a communication from the Office regarding a patent application; and drafting a communication for a public use, interference, reexamination proceeding, petition, appeal to or any other proceeding before the Board of Patent Appeals and Interferences, or other proceeding.” *Id.* § 11.5(b)(1).

Appellant is not a registered practitioner. (A.993, no. 2; A.7762: 11-13). However, contrary to his opinion, that does not insulate him from the disciplinary jurisdiction of the Office if he provided or offered to provide any legal services before the Office. 37 C.F.R. § 11.19(a). A review of the record, to include Appellant’s clients’ testimony and Appellant’s own testimony, as well as his Appeal and Reply brief in this proceeding, shows that he unequivocally engaged in activity and conduct that constitutes practice before the Office in patent matters. These services, which are irrefutable and supported by the record, included:

1. Appellant consulted and drafted the response to a USPTO Office Action for Charles Mason. (A.993-994, Nos. 10, 11; A.7932:8-21). The response contained amended claims

and arguments as to the patentability of the invention in the '479 Application. (A.994, no. 12).

2. Appellant reviewed a June 13, 2016, Office Action wherein the examiner informed Mr. Mason that certain claims contained in the '479 Application remained rejected. (A.7934; Joint Ex. 22, pp. 177-184).
3. On October 8, 2014, Mr. Dave Thomas sent Appellant a draft of a provisional patent applications, and attachments, via e-mail. (Gov. Ex. 62, pp. 10-45). The e-mail also sought to discuss strategy, as well as Appellant's opinion on "the best course of action" with regards to submitting his application. (Gov. Ex. 62, p. 10). Appellant assisted Mr. Thomas in drafting and revising his patent application materials. (Gov. Ex. 62, pp. 46-47, 49-50).
4. Appellant prepared a non-provisional patent application for Mr. David Mimh. (A.8542:12-14; A.8543:17-18; A.8573-4; Gov. Ex. 43). After his non-provisional application was received, the USPTO sent two Notices of Missing parts to Mr. Mimh and Appellant drafted a response to those Notices on Mr. Mimh's behalf. (A.8547:11-12; A.8549-8551).
5. Three additional inventors, Dale Davenport, Richard Vigil, and Kent Stenzel, testified that Appellant consulted with them and then drafted their patent applications for filing with the USPTO. (A.8379-8381; A.8668-8672; A.8711-8713; A.8716-8717).
6. Appellant produced 291 invoices demonstrating that he provided patent legal services to clients. (A.4481-4728; A.8592:5-9). Appellant's invoices show completion of provisional patent applications, work on Office actions, work on utility patents, design patents, drafting claims, work on Continuations In Part ("CIP"), and preparation of a PCT

application. (A.4486-4490, A.4494-4497, A.4503, A.4508-4509, A.4516, A.4520, A.4525-4526, A.4541, A.4560-4561, A.4567, A.4593, A.4564, A.4637-4638). Notations on some of the bills indicate that Appellant would draft such documents and provide them to his clients to sign them as *pro se* applicants before Ms. Crompton would file them with the USPTO. (Gov. Ex. 101, pp. 43, 49, 109, 117, 220, 231).

7. Appellant also testified that he completed the drafting of a utility patent application, drafted design patents, drafted patent drawings, drafted specification text for a CIP, drafted claims, modified drawings, and drafted a specification. (A.8613:22-8614:18).

In an attempt to circumvent the USPTO's disciplinary jurisdiction here, Appellant argues that he is not a registered practitioner and did not represent patent applicants before the Office but rather only assisted *pro se* applicants who were representing themselves. (Appeal at 3, 21, 23; Reply at 11-12). He asserts that never held himself out as a registered practitioner, never sought to represent clients before the USPTO, he never signed documents on behalf of clients, and all Office communications were directed to the clients. (Appeal at 4; Reply at 12). He claims that he only helped clients in drafting patent applications. (*Id.*) Because he is unregistered and his clients ultimately signed any filings with the Office as *pro se*, he believes that any services he provided behind the scenes are insulated from the disciplinary jurisdiction of the Office. He is incorrect.

First, as already noted, unregistered practitioners are subject to the disciplinary jurisdiction of the Office if they provide or offer to provide any legal services before the Office. 37 C.F.R. § 11.19(a). Being registered only sanctions performance of those services. 37 C.F.R. § 11.5(b)(1). Here, a review of the his testimony, his clients' testimony, the invoices he provided, as well as other evidence reveals that he provided his clients with the services that the USPTO has explicitly defined as practice in patent matters before the Office. To state it another way, despite

how Appellant characterizes the services he provided, the services he provide and which are previously identified in Sec. IV.A.1, 1-7, unequivocally show that Appellant “prepar[ed] and prosecut[ed] any patent application”, he “consult[ed] with or [gave] advice to a client in contemplation of filing a patent application or other document with the Office,” he “draft[ed] the specification or claims of a patent application”; he “draft[ed] an amendment or reply to a communication from the Office that may require written argument to establish the patentability of a claimed invention”; he “draft[ed] a reply to a communication from the Office regarding a patent application.” 37 C.F.R. § 11.5(b)(1). This conduct is “practice before the Office in patent matters” as defined in USPTO regulation. (*Id.*) Thus, Appellant is subject to USPTO’s disciplinary jurisdiction. The ALJ’s conclusion to that effect is supported by the record and is upheld.

2. Appellant Has Practiced Before the Office in Trademark Matters.

The Agency also appropriately exercised jurisdiction over Appellant because he is a trademark practitioner and practiced before the Office in trademark matters. Any attorney in good standing in a state is permitted to practice trademark matters before the Office and, as a result, is subject to the disciplinary jurisdiction of the Office. (A.8234-8235). This is a separate, independent basis for jurisdiction.

As stated, all practitioners engaged in practice before the Office are subject to the disciplinary jurisdiction of the Office. *See* 37 C.F.R. § 11.19(a). Practice before the Office in trademark matters includes, but is not limited to, consulting with or giving advice to a client in contemplation of filing a trademark application or other document with the Office; preparing and prosecuting an application for trademark registration; preparing an amendment which may require written argument to establish the registrability of the mark; and conducting an opposition,

cancellation, or concurrent use proceeding; or conducting an appeal to the Trademark Trial and Appeal Board. *See* 37 C.F.R. § 11.5(b)(2); (A.8234:11-13).

Appellant is an attorney licensed and in good standing with the state of Wyoming. (A.991, No. 1; A.7762:9-10). He is permitted to practice in trademark matters before the Office as a result. And he has unequivocally done so. Appellant has practiced as a trademark practitioner in multiple trademark matters before the Office. (A.35; A.79; A.5650-6176; A.7852:4-10; Appeal at 6). He also participated in two (2) Trademark Trial and Appeal Board (“TTAB”) proceedings. (A.7857-7858). For one TTAB matter, proceeding No. 91223013, he remains the attorney of record in that matter. (A.6177-6208). Thus, by practicing in trademark matters before the Office, Appellant subjected himself to the jurisdiction of the USPTO. *See* 37 C.F.R. § 11.5(b)(2). Appellant’s self-serving claim that filing for a trademark does not subject Appellant to USPTO disciplinary rules, (Appeal at 11, 23), is contrary to the plain language of the Agency’s regulations and, as a result, is flatly incorrect.

As an alternative argument, he claims that there is no readily apparent warning during the trademark filing process or in the TTAB rules that warns an attorney that the USPTO will assert jurisdiction over an attorney and an attorney’s work if they file a trademark even for a single client or participate in TTAB proceedings. (Appeal at 12, 23-30; A.7859-7860). Without such a warning, Appellant implies that there cannot be any jurisdiction. The ALJ rejected that claim, however, and it is similarly rejected here.

First, Appellant’s lack of knowledge or ignorance of USPTO’s rules is not relevant to the finding of jurisdiction here. *See Torres v. I.N.S.*, 144 F.3d 472, 474 (7th Cir. 1998) (“Ignorance of a statute is generally no defense even to a criminal prosecution, and it is never a defense in a civil case, no matter how recent, obscure, or opaque the statute.”). Additionally,

and contrary to Appellant's assertions, the warnings Appellant claims are lacking are, in fact, readily available. The ALJ identified links in the filing documents and on the Agency's website that provide an attorney with resources for determining the rules that apply to a trademark practitioner before the Office. (A.21-22). The first resource, the Trademark Manual of Examining Procedure ("TMEP"), states that there are standards of conduct that trademark practitioners are expected to follow and it references the USPTO disciplinary rules. (A.21-22; A.8235:15-22; A.8236:1-4; TMEP § 601).<sup>5</sup> The disciplinary rules are also found in the Code of Federal Regulations and on OED's website. (A.8236:11-17).

In sum, the ALJ's conclusion that Appellant practiced before the Office in trademark matters and accordingly was subject to the USPTO's disciplinary jurisdiction, (A.20-22), is supported by the record. Appellant does not deny he practiced in trademark matters before the Office. The ALJ's conclusion is also supported by a plain reading of the USPTO disciplinary rules and applicable USPTO precedent, as noted in the Initial Decision. *See In re Blackowicz*, Proceeding No. D2015-13 (USPTO May 11, 2015) (Final Order) (practitioner practiced solely in trademark matters before the Office and the USPTO had disciplinary jurisdiction over him and was suspended for thirty days by the terms of a settlement agreement). There is no reason to disturb the ALJ's finding of disciplinary jurisdiction on this basis.

**B. Appellant Engaged in Misconduct That Violated USPTO's Disciplinary Rules.**

The Initial Decision concluded that Appellant engaged in various acts of misconduct that violated five (5) of USPTO's disciplinary rules. These violations were of 37 C.F.R. §§ 11.505, 11.116(a)(1), 10.23(b)(5), 11.804(d), and 11.701. (A.27). A review of that Initial Decision, as

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<sup>5</sup> The ALJ concluded that "Respondent ... knew or should have known of the contents in the TMEP, and more specifically, the language giving notice that practitioners authorized to practice in trademark matter before the Office are subject to the disciplinary authority of the USPTO." (A.22).

well as the record of the disciplinary proceedings, provides ample support for the ALJ's findings and conclusions. As further discussed below, the Initial Decision is upheld as to the findings that the OED Director proved Appellant violated five (5) USPTO disciplinary rules.

1. Appellant Engaged in the Unauthorized Practice of Patent Law.

A practitioner shall not practice law in a jurisdiction in violation of the regulation of the legal profession in that jurisdiction, or assist another in doing so. 37 C.F.R. § 11.505. The USPTO is considered a jurisdiction for the purposes of this rule. (A.13) (citing CHANGES TO REPRESENTATION OF OTHERS BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE, 78 Fed. Reg. 20180, 20180-01 (Apr. 3, 2013) and *In re Peirce*, 128 P.3d 443,444 (Nev. 2006) (“We therefore conclude that ‘another jurisdiction’ includes the USPTO. The professional conduct rules are similar, so that what constitutes misconduct before the USPTO is misconduct in Nevada.”)). While individuals are permitted to prosecute matters before the Office on a *pro se* basis, “only practitioners who are registered under § 11.6 . . . are permitted to prosecute patent applications of *others* before the Office or represent *others* in any proceedings before the Office.” (A.13) (alteration in original) (citing 37 C.F.R. § 11.10).

Section IV.A.1 has already discussed activity that constituted “practice before the Office” and “practice before the Office in Patent Matters.” 37 C.F.R. § 11.5. As shown, the record is replete with evidence that demonstrates that Appellant undertook activities that constitute practice before the Office. He provided patent legal services such as reviewing and drafting responses to the USPTO Notices and Office Action for clients (A.993-994, Nos. 10, 11; A.7932:8-21; A.7934; Joint Ex. 22, pp. 177-184; A.8547:11-12; A.8549-8551); he made arguments as to the patentability of inventions to the Office (A.994, no. 12); and he discussed patent application strategy and drafted and revised patent applications for clients (Gov. Ex. 62,

pp. 10-47, 49-50; A.8542:12-14; A.8543:17-18; A.8573-8574; Gov. Ex. 43; A.8379-8380; A.8668-8672; A.8711-8713; A.8716-8717).

Appellant's own testimony also provides support for the conclusion that he provided patent legal services to clients. For example, he testified that he drafted a utility patent application, drafted design patents, drafted patent drawings, drafted specification text for a CIP, drafted claims, modified drawings, and drafted a specification. (A8613:22-8614:18). Multiple clients also testified at the hearing and corroborated that Appellant provided them with patent legal services, including navigating the patent process and helping clients secure patents. (A.7925:1-5; A.8542:3-20; A.8669:2-8672:11). Finally, Appellant produced 291 invoices showing that provide work such as completion of provisional patent applications, work on Office actions, work on utility patents, design patents, drafting claims, work on Continuations In Part ("CIP"), and preparation of a PCT application. (A.4481-4728; A.8592:5-9; A.4486-4490, A.4494-4497, A.4503, A.4508-4509, A.4516, A.4520, A.4525-4526, A.4541, A.4560-4561, A.4567, A.4593, A.4564, A.4637-4638).

That Appellant provided these services in uncontested. However, Appellant attempts to escape sanction by characterizing his services as merely providing assistance to his clients. But that argument is without merit. The services he provided are plainly identified by the Office in its disciplinary regulations, not as assistance, but as constituting practice before the Office in patent matters. He provided these services even though he was not a registered practitioner with the Office. Thus, he engaged in the unauthorized practice of law before the Office. 37 C.F.R. § 11.505; *see also* 37 C.F.R. § 11.5(b)(1) ("registration to practice before the Office in patent cases sanctions the performance of those services. . . .").

In addition to the unauthorized practice of law, Appellant's actions are also a violation of 37 C.F.R. § 11.116. That provision requires a practitioner to decline representation of a client, or to withdraw where representation has commenced, if representation will violate the USPTO Rules. 37 C.F.R. § 11.116(a)(1). The ALJ correctly noted that "[b]ecause the activities in which [Appellant] engaged violated the USPTO disciplinary rule proscribing unauthorized practice before the Office in patent matters, [Appellant] was not permitted to provide his clients with the representation they requested. Accordingly, [Appellant] also violated this disciplinary rule." (A.14).

It is noted that the parties both discuss whether the ALJ's Initial Decision here is consistent with prior USPTO precedent. It is. As the OED Director notes in his brief, two prior proceedings before the USPTO found that trademark practitioners violated the USPTO disciplinary rules by engaging in the unauthorized practice of law because they engaged in practice before the Office in patent matters despite being unregistered practitioners. *See, e.g., In re Wengrovsky*, Proceeding No. D2003-09 (USPTO Jan. 5, 2004) (attorney not registered to practice patent law suspended for violating the terms of his probation he received in connection with engaging in the unauthorized practice of patent law before the Office); *In re Gaudio*, Proceeding No. D2012-12 (USPTO Dec. 12, 2012) (an attorney not registered to practice patent law excluded on consent for providing patent legal services without being licensed by the Office to do so, including preparing, or causing to be prepared, patent applications and other patent application documents related to the prosecution of patent applications before the Office). The lawyers in both cases were solely trademark practitioners but prepare and prosecuted patent applications and other patent application documents filed with the Office. As with Appellant, Mr. Wengrovsky and Mr. Gaudio did not sign the patent applications filed with the Office on behalf of their clients, but

were nonetheless considered to have engaged in the practice of patent law before the Office. (A8237:4-8238:3).

Appellant argues that *Wengrovsky* and *Gaudio* are inapposite. (Reply at 7-8). However, it is concluded that these cases are not distinguishable in any relevant way. Appellant largely makes arguments of procedure and jurisdiction in an attempt to distinguish those cases from his own disciplinary matter. On those points, the fact that the cases had a different procedural posture is insignificant as they are demonstrative that USPTO does regulate unregistered practitioners who engage in the unauthorized practice of patent law. With regard to any jurisdictional argument, as already discussed, there are no jurisdictional irregularities present in this matter. Appellant's last argument on this point is that *Gaudio* and *Wengrovsky* both involved misconduct that is more significant than are present in his disciplinary matter. (Reply at 9-10). But the significance of his misconduct is an issue relevant to sanction and not to the issue of whether he engaged in the unauthorized practice of law in the first place.

In sum, there is legal and factual support for the ALJ's finding that the OED proved Appellant engaged in the unauthorized practice of law and also violated § 11.116. Thus, those findings of misconduct are upheld.

2. Appellant Gave False Information Regarding the Nature of His Services to Clients.

The ALJ concluded that Appellant gave false information regarding the nature of his services to Mr. Mason. (A.15-16). Specifically, he found that after Mr. Mason confronted Appellant and informed him that he did not believe he could proceed *pro se* while having Appellant provide patent legal services to him, Appellant informed Mr. Mason that such conduct was permissible. (A.15). As discussed further below, the record supports this conclusion.

The USPTO Rules proscribe making false or misleading communication about the practitioner or the practitioner's services. *See* 37 C.F.R. § 11.701. Section 11.701 further explains “[a] communication is false or misleading if it contains a material misrepresentation of fact or law, or omits a fact necessary to make the statement considered as a whole not materially misleading.” Thus, the ALJ properly recognized that the rule does not require any intent or knowledge in order to find a violation. In other words, ignorance of the law is not a defense to a violation of this section.

The record reflects that while Mr. Mason was seeking investors for his invention, one potential investor, Mr. Russ Krajec, stated his belief that Mr. Mason could not prosecute his patent application on a *pro se* basis while having an attorney work on the patent. (A.7938:3-4; A.7939:5-19). Mr. Mason testified that he then sought the opinion of three other attorneys who confirmed Mr. Krajec’s view. (A.7940:22; A.7941:1-12; Gov. Ex. 93).

In an effort to protect the ‘479 Application, and the intellectual property rights of his invention, Mr. Mason sought to obtain proof that he was misinformed that he could proceed *pro se* and have Appellant work on his patent application. (A.7946:7-21). Mr. Mason decided to secretly record conversations with Appellant, with two (2) other individuals on the line during the conversation. (A.7946:11-14; A.7947; A.7986:18-19; A.7987-7988; Gov. Ex. 93). During these conversations, Appellant explained to Mr. Mason that filing *pro se* while having a non-registered attorney work on the patent was a “gray area.” (Gov. Ex. 93, pp. 8-9). Appellant represented to Mr. Mason that it was not necessary for Appellant to be registered with the USPTO as long as Appellant was not appearing before the USPTO on Mr. Mason’s behalf. (Gov. Ex. 93). Mr. Mason informed Appellant that he had obtained the opinions of three other attorney who held a contrary view. (Gov. Ex. 94, p. 16). Appellant, however, stated, “I don't think there’s

any strong statutory law or case law or inclusion by the Patent Office that, that's the case . . .

Because otherwise I wouldn't be doing this. I wouldn't jeopardize my law license if I thought that there was any—any inequitable conduct or anything like that.” (Gov. Ex. 94, p. 12). Appellant also stated that the USPTO does not enforce its rules, stating that “there’s been some findings on that, and the Patent Office has come out and said that they’re not going to, you know, enforce anything about that.” (A.4421).

Appellant’s statements to Mr. Mason were plainly false. First, as already stated, the USPTO Rules clearly prohibit the services that Appellant provided to clients as the unauthorized practice of law. Additionally, contrary to his statements to Mr. Mason, the USPTO does enforce the disciplinary rules against trademark practitioners who are non-registered. (A.8236:22-8238:17; A.8253:1-12) (citing *Gaudio* and *Wengrovsky*).

The OED Deputy Director, William Griffin, testified at the hearing that Appellant is not a registered practitioner and therefore is not allowed to represent patent applicants before the Office under both the old USPTO Code and the current USPTO Rules. (A.8236:18-20; A.8257:21-8259:20; A.8260:1-5). Mr. Griffin confirmed that the USPTO has asserted jurisdiction over non-registered practitioners practicing in patent matters since at least 1999. (A.8260:1-5). Appellant attempts to undermine Mr. Griffin’s testimony by citing to an interaction at the disciplinary hearing wherein he asked Mr. Griffin whether OED had ever enforced the rules regarding a non-registered practitioner who never filed a trademark. (Appeal at 25-26). Appellant finds it significant that Mr. Griffin testified in response to Appellant’s question “Not that I'm aware of.” (A.8260:10-19). However, as properly noted in the OED Director’s Brief, that hypothetical in no way exonerates Appellant here because Appellant *has*

filed trademarks on behalf of clients. (Response at 12) (emphasis added). His situation is, thus, more akin to *Wengrovsky* and *Gaudio*.

Lastly, Appellant argues that he relied on the assertions of Mr. Gene Quinn who publishes an online blog and stated in one of his articles that the USPTO does not enforce the rules against non-registered practitioners who engage in unauthorized practice in patent matters before the Office. (Appeal at 26). Because of Mr. Quinn's "preeminence in the field of Intellectual Property", he claims his reliance on his opinions was reasonable. (*Id.* 26-27). Consequently, he argues his statements were not false or misleading. But, as already stated, § 11.701 does not "require any intent or knowledge." (A.15). And Appellant's ignorance of the law or reliance on misplaced authority is irrelevant to finding a violation of § 11.701.

Because there is sufficient factual support in the record, and Appellant's defenses are legally without merit, the ALJ's conclusion that Appellant gave false information regarding the nature of his services to Mr. Mason is upheld.

### 3. Appellant's Actions Were Prejudicial to the Administration of Justice.

The ALJ lastly concluded that violated both the USPTO Code, 37 C.F.R. § 10.23(b)(5) (2012), and the USPTO Rules, 37 C.F.R. § 11.804(d). (A.16). The ALJ noted that conduct that is prejudicial to the administration of justice is "'conduct which impedes or subverts the process of resolving disputes' or 'frustrates the fair balance of interests or "justice" essential to litigation or other proceedings.'" (A.16) (citing *In re Friedman*, 23 P.3d 620, 628 (Alaska 2001)). "Generally, an attorney engages in such conduct when his behavior negatively impacts the public's perception of the courts or legal profession or undermines public confidence in the efficacy of the legal system". (A.16) (citing *Att'y Grievance Comm'n v. Rand*, 981 A.2d 1234, 1242 (Md. 2009)). Courts have found that the unauthorized practice of law is a serious threat to the effective

administration of justice. (A.16) (citing *United States v. Johnson*, 327 F.3d 554, 560 (7th Cir. 2003)). With these principles in mind, the ALJ concluded that “because the unauthorized practice of law threatens the effective administration of justice ... [Appellant’s] misconduct violated 37 C.F.R. § 10.23(b)(5) (2012) and 37 C.F.R. § 11.804(d).” (A.16). There is no factual or legal basis to disturb this conclusion.

Appellant’s sole argument here is to restate his belief that the services and activities he undertook for his clients constituted an authorized practice of law. (Appeal at 13, 27). Because he believes he did not engage in any unauthorized practice of law, his actions cannot be prejudicial to the administration of justice. (*Id.*) But, the propriety of the legal services he offered has already been addressed and it was concluded that his practice of law was unauthorized under the USPTO Rules. *See supra* pp. 13-7, 20-3. Having articulated no other argument as to the ALJ’s conclusion here, the finding that Appellant’s conduct was prejudicial to the administration of justice is upheld.

### **C. Appellant’s Other Challenges.**

#### **1. The ALJ Correctly Denied Appellant’s Request to Secure a Witness Subpoena for Mr. Gene Quinn’s Testimony.**

In an attempt to negate the ALJ’s Initial Decision, Appellant argues that he was prejudiced by the ALJ’s failure to allow him to subpoena Mr. Gene Quinn as a witness.<sup>6</sup> (Appeal at 7, 14, 27-28). Appellant sought to compel Mr. Quinn to testify via video conferencing or telephone from Washington, D.C., where the HUD court is located. (A.1429-1438). The ALJ denied the

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<sup>6</sup> Pursuant to 35 U.S.C. § 24, the clerk of any United States Court for the district wherein testimony is to be taken for use in any contest case in the USPTO, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being with in such district, commanding him to appear and testify. Upon the filing of an answer by a respondent, a disciplinary proceeding shall be regarded as a contested case within the meaning of 35 U.S.C. 24. 37 C.F.R. § 11.38. Evidence obtained by a subpoena issued under 35 U.S.C. 24 shall not be admitted into the record or considered unless leave to proceed under 35 U.S.C. 24 was previously authorized by the hearing officer. *Id.*

motion. (A.1473-1474). Appellant claims there was enough time to secure a subpoena and that USPTO's requests for subpoenas in shorter timeframes were granted. (Appeal at 7, 14, 28).

Appellant requested the hearing take place in Denver, Colorado, and the ALJ granted that request on September 11, 2017. (A.109-103, A.118-119). The hearing was scheduled to occur in Denver, Colorado beginning on Tuesday, November 14, 2017. (A.118). On October 5, 2017, well in advance of the hearing date, Appellant named Mr. Quinn as a witness on the witness list provided to counsel for the OED Director. (A.168-173). Despite this, based on the record, there is no indication or evidence that Appellant tried to secure Mr. Quinn's voluntary attendance at the hearing. Alternatively, there is no indication or evidence that Appellant attempted to conduct a deposition in lieu of personal appearance or in a timely manner seek to subpoena Mr. Quinn for remote attendance. Instead, and as the ALJ noted in his order denying the Motion for Leave to Subpoena Witness, Appellant waited until less than two business days before the hearing to attempt to secure Mr. Quinn's testimony for his case-in-chief. (A.1426-38; A.1473). This is so despite the fact that the Colorado hearing location was requested by Appellant and the date was known as of September 11, 2017. Such lack of diligence undercut, in the ALJ's view, the "critical" nature of Mr. Quinn's testimony. (*Id.*) And while the ALJ stated that he would normally permit witnesses to appear via video or telephone, such arrangements require equipment to be reserved weeks in advance. (*Id.*) Nevertheless, and despite the late request, the ALJ informed Appellant that he would still permit Mr. Quinn's testimony at the hearing in Colorado if he secured Mr. Quinn's voluntary appearance. (A.1474). Appellant did not do so.

In sum, the Denver, Colorado hearing location was at Appellant's request. Appellant had two (2) months to secure Mr. Quinn's voluntary attendance at that hearing, or to take alternative steps to secure his testimony. His last minute request to subpoena Mr. Quinn for remote attendance

was denied due to inability to secure the necessary equipment. However, the ALJ stated Appellant would still permit Mr. Quinn's testimony at the hearing in Colorado if he secured Mr. Quinn's voluntary appearance. He did not. In short, Appellant had every opportunity to secure Mr. Quinn's testimony, via several different methods, and failed to do so. Thus, as his failure to secure Mr. Quinn's testimony was the result of his own inaction, Appellant was not prejudiced and the ALJ did not err in denying Appellant's motion to subpoena Mr. Quinn.

2. The ALJ Provided Appellant with the Opportunity to Call William Griffin, OED Deputy Director, in His Case-In-Chief but Appellant Chose Not to Do So.

Appellant also claims that the ALJ prejudiced him by denying his right to call Mr. Griffin when planned. (Appeal at 14-15, 28-29). Because he could not call Mr. Griffin to testify in the order he preferred, Appellant declined to call him at all. Because that decision was made at his own volition, he cannot now claim to be prejudiced by it.

As background, during the disciplinary proceedings, Appellant requested that a USPTO employee be provided to testify about general matters and eight specific matters. (A.603-605). The ALJ granted that motion and counsel for the OED Director identified Mr. Griffin who would testify as the requested Rule 30(b)(6) witness on October 30, 2017. (A.740-742; A.842-843). At the time OED Director identified Mr. Griffin as its Rule 30(b)(6) witness, the OED Director also provided notice that "the OED Director will produce Mr. Griffin in its case in chief and he will be available for cross-examination by Respondent." (A.843).

At the hearing, and as stated in its witness list, counsel for the OED Director called Mr. Griffin during the case-in-chief. (A.8209:20-22). Despite Appellant's objections, Mr. Griffin was permitted to be called out of turn on the second day of the hearing as he was unable to stay for the third day of the hearing. (A.8211:17-8212:1-16). Appellant was given the opportunity to call him as a witness, but a day earlier than he had planned. (Appeal at 15, 29; A.8212:3-16).

Appellant, unhappy with the order in which Mr. Griffin would testify, then voluntarily chose not to call Mr. Griffin on direct. (A.8215:18-21). The ALJ allowed counsel for the OED Director to call Mr. Griffin as a rebuttal witness and Appellant cross-examined him. (A.8216:3-11; A.8217:13-19; A.8219:12-19). Having voluntarily chose to give up Mr. Griffin's testimony during his case-in-chief, he cannot now claim he was prejudiced by his own choice.

3. The OED Director's Brief Conformed to the Filing Requirements.

Appellant requests that the OED Directors Response brief not be entered because "it is an unconscionably inequitable, non-conforming brief." (Reply at 2). Appellant claims that the Response brief violated the page length set by 11 C.F.R. § 11.55. (Reply at 3). He claims that the OED Director blatantly attempted to circumvent its own USPTO rules by not labeling certain pages with numbers –table of contents, table of authorities, and a title page- and labeling them with roman numerals instead. (*Id.*) He argues "[e]ither Appellee's brief contains 35 pages or Appellee's brief is considered not to contain the table of contents and table of authorities." (Reply at 4). He notes, without citation that "a previous brief by Respondent/Appellant was deemed non-conforming by the ALJ and was summarily refused entry." (*Id.*) Consequently, he argues that should be the appropriate sanction in this instance.

The regulations at 37 C.F.R. § 11.55 set forth the mandatory filing requirements for appellate filings, which includes directing all such briefs to comply with the substantive requirements found in the Federal Rules of Appellate Procedure (FRAP) Rule 28(a)(2), (3), and (5) through (10), and the form requirements in FRAP Rule 32(a)(4) through (6). *See* 37 C.F.R. § 11.55(c), (d). Section 11.55(d) further specifies that "[a]n appellant's, cross-appellant's, appellee's and cross-appellee's brief shall be no more than thirty pages in length. The USPTO Director may refuse entry of a nonconforming brief.

Appellant's main complaint about the OED Director's Response is that it exceeded the 30 pages allotted for an appellee brief. He claims that the OED Director attempted to circumvent the page requirement by not numbering, and thus not including in the total page limit, the table of contents and table of authorities. This argument is devoid of merit. According to FRAP 32(f), "[i]n computing any length limit, headings, footnotes, and quotations count toward the limit but the following items do not: the cover page; . . . a table of contents; [and] a table of citations. . . ." Although this provision was not incorporated into the USPTO rules governing appeal briefs, it is nonetheless persuasive that this should be the practice adopted in disciplinary appeals. Further, excluding such items from the page limits required by § 11.55(d) is in keeping with the prior practice of other disciplinary hearing appeals under 37 C.F.R. § 11.55.

A review of the OED Director's Response brief shows it to be twenty-nine (29) pages in length, which is within the allowable page limits set by § 11.55(d). Excluded from that page length is a title page, a table of contents, and a table of authorities. This is a permitted exclusion under the FRAP and it is determined to be a permitted exclusion here. Thus, as the OED Director's Response brief is in compliance with the applicable filing requirements, there is no basis to strike it.

**D. Appellant's Affirmative Defenses Are Without Merit.**

Appellant raised a number of affirmative defenses in his Answer to the Complaint, several of which were reiterated in later Motions filed with the ALJ. Practitioners have the burden of proving any affirmative defense by clear and convincing evidence. 37 C.F.R. § 11.49. Appellant failed to satisfy that burden with regard to any of the affirmative defenses raised in this appeal.

1. USPTO Disciplinary Rules Do Not Violate Statutory Authority.

Appellant's main defense is that his discipline was an overreach of USPTO statutory authority. (Appeal at 13, 17-22; Reply at 6). Appellant relies on *Hull v. United States*, 390 F.2d 462 (D.C. Cir. 1968) for the proposition that Congress intended to withhold from USPTO the authority to regulate each and every aspect of the provision of patent legal services.<sup>7</sup> (Appeal at 17-18, 20; Reply at 4). He claims that legislative history and *Hull* permit Appellant to work to assist clients who represent themselves *pro se* before the Office. (Appeal at 12, 24; Reply at 5). Appellant believes USPTO lacks the authority to make registration with USPTO an essential condition to the preparation of patent applications. (Reply at 4). According to Appellant, USPTO's attempts to characterize as the unauthorized practice of law "any assistance to clients in the field of preparation of patent applications, even if the attorney is not representing the clients before the Office" is administrative overreach. (Reply at 4-6).

*Hull* is plainly inapposite to Appellant's disciplinary case here. *Hull* is a criminal case that addressed the type of conduct that is illegal under 35 U.S.C. § 33. *Hull*, 390 F.2d at 463. Here, the USPTO's Complaint was not brought pursuant to 35 U.S.C. § 33, but was brought pursuant to 35 U.S.C. § 32. *Hull* had nothing to do with practitioner discipline under USPTO disciplinary rules. As such, the ALJ properly noted that the precedential value of *Hull* is "significantly compromised, if not diminished entirely." (A.18). Further, the ALJ also properly accounted for *United States v. Blasius*, 397 F.2d 203, 207 (2d Cir. 1968). In that case, the Second Circuit rejected the conclusion in *Hull*. Specifically, the Second Circuit found that that the holding in

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<sup>7</sup> Appellant's assertion that the USPTO is improperly attempting to regulate any individual who practices in the field of patents is incorrect. (Appeal at 17). USPTO does not regulate a non-registered attorney who litigates patent cases before a federal court. Such activity does not constitute practice before the USPTO in patent matters, as defined in USPTO's disciplinary rules, and deprives the USPTO of disciplinary jurisdiction in such instances. See 37 C.F.R. §§ 11.5(b)(1), 11.19(a).

*Hull* was inconsistent with statutory language and the legislative intent to "protect inventors from unskilled and unethical practitioners." (A.18) (citing *Blasius*, 397 F.2d. at 207). Thus, *Hull* is not only inapposite to the instant case, *Hull*'s precedential value is questionable.

As stated above in Sect. IV.A, the USPTO was vested by Congress with broad statutory authority to establish regulations which may "govern the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Office. . . ." 35 U.S.C. § 2(b)(2)(D). They properly did so. This was recognized by the ALJ in the Initial Decision. (A.18-9). As a result there is no administrative overreach or breach of its statutory authority. The USPTO properly issued regulations that govern the practice of law before it and Appellant violated those rules. This was the finding of the ALJ and that finding is upheld.

## 2. Appellant Was Afforded Due Process.

Appellant next raises the first of two constitutional claims. The first is that ALJ failed to respond to Appellant's Constitutional arguments that his due process rights were "significantly eroded and abridged." (Appeal at 15-16, 29). This claim is rejected as the record more than supports a finding that Appellant received due process throughout the entire disciplinary proceeding.

"The fundamental requirement of due process is the opportunity to be heard at a meaningful time and in a meaningful manner." *In re Karten*, 293 F. App'x. 734, 736 (11th Cir. 2008) (quoting *Mathews v. Eldridge*, 424 U.S. 319, 333 (1976)). In disciplinary proceedings, an attorney is entitled to due process, such as reasonable notice of the charges before the proceedings commence. See *In re Ruffalo*, 390 U.S. 544, 551 (1968); *In re Cook*, 551 F.3d 542, 549 (6th Cir. 2009) (procedural due process includes fair notice of the charge). Due process requirements are satisfied where a respondent "attended and participated actively in the various

hearings, and was afforded an opportunity to present evidence, to testify, to cross-examine witnesses, and to present argument.” *In re Squire*, 617 F.3d 461, 467 (6th Cir. 2010) (quoting *Ginger v. Circuit Court for Wayne Cnty*, 372 F.2d 620, 621 (6th Cir. 1967)); *see also In re Zdravkovich*, 634 F.3d 574 (D.C. Cir. 2011) (stating that attorney could not satisfy claim of due process deprivation where he was given notice of the charges against him, was represented by counsel, and had hearing at which counsel had the opportunity to call and cross-examine witnesses, make arguments, and submit evidence). Due process requirements are also met where a respondent is given “an opportunity to respond to the allegations set forth in the complaint, testify at length in [his] own defense, present other witnesses and evidence to support [his] version of events . . . , [and is] able to make objections to the hearing panel’s findings and recommendations.” *In re Squire*, 617 F.3d at 467 (ellipsis and third alteration in original) (quoting *In re Cook*, 551 F.3d 542, 550 (6th Cir. 2009)).

Here, Appellant was put on notice of the charges as set forth in OED’s Requests for Information (“RFI”) and in the Complaint. (A.34, paras. 45, 72; A.6968-6974; A.6986-6996). As visible from the voluminous record that includes a disciplinary Complaint, Appellant’s Answer, as well as other Motions, notices, and briefings filed by Appellant, and a full hearing transcript, Appellant fully participated in the disciplinary proceedings including the hearing that took place November 14 - 16, 2017. Appellant presented evidence, testified, cross-examined witnesses and presented argument at that hearing. (A.7667-8890).

Having fully participated in every aspect of the disciplinary proceedings against him, there is no merit to Appellant’s claims that he was denied due process.

### 3. Appellant's Other Constitutional Claims Are Improper.

Next, Appellant claims the Agency violated his constitutional rights. (A.24). In his appeal, he refers to “violation by the USPTO of Appellant’s rights to substantive due process (‘inherent fairness’ in the form of ‘equal protection’) under the substantive due process right secured to Appellant within the due process clause of the 5<sup>th</sup> Amendment to the U.S. Constitution. (Appeal at 15). Further, he claims he was not afforded due process of the allegations against him or a meaningful opportunity to be heard. (*Id.*) Finally, he challenges the ALJ’s conclusion that constitutional challenges are inappropriate for resolution by an administrative tribunal. (*Id.* at 16).

The ALJ correctly noted that “[a]djudication of the constitutionality of congressional enactments has generally been thought beyond the jurisdiction of administrative agencies.” *See Oestereich v. Selective Serv. Syst. Local Bd. No. 11*, 393 U.S. 233, 242 (1968) (Harlan, J., concurring) (footnote omitted). However, more recently, it has been recognized that an agency’s expertise in its own procedures and any statute it regularly applies can “be ‘brought to bear’” on even constitutional challenges to those statutes. *See Elgin v. Dept. of Treasury*, 567 U.S. 1, 16, 22-23 (2012) (quoting *Thunder Basin Coal Co. v. Reich*, 510 U.S. 200, 214-15 (1994)).

Here, the Agency declines to address Appellant’s constitutional claims because those claims are insufficiently plead and developed, and are both factually and legally unsupported. Despite having the burden of proving this defense, 37 C.F.R. § 11.49, he cites no facts or law in support of his claim. It is not the USPTO Director’s obligation to carry Appellant’s burden of proving his defenses for him. *See U.S. v. Great American Ins. Co. of New York*, 738 F.3d 1320, 1328 (Fed. Cir. 2013) (“It is well established that arguments that are not appropriately developed in a party’s briefing may be deemed waived.”); *SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312,

1320 (Fed. Cir. 2006 (“A skeletal ‘argument,’ really nothing more than an assertion, does not preserve a claim. . . . Especially not when the brief presents a passel of other arguments. . . .”)) (quoting *U.S. v. Dunkel*, 927 F.2d 955, 956 (7<sup>th</sup> Cir. 1991)). Here, Appellant’s assertion of constitutional violations are nothing more than assertions buried in a slew of other arguments and assertions. He provides an insufficient basis for identifying, developing, and arguing any constitutional violation. As a result, that argument is waived.

4. Appellant’s Discipline Is Not Barred by the Doctrines of Waiver, Laches, Unclean Hands, and Estoppel.

Appellant argues that the disciplinary action against him is barred by the doctrines of waiver, laches, unclean hands, and estoppel. (Appeal at 10). This argument is premised on Appellant’s belief that “the USPTO has never attempted to enforce the unauthorized practice of patent law against an unregistered attorney who assists clients, without more actions by the attorney.” (*Id.*) However, as already discussed, *see supra*. pp. 25-6, the USPTO does investigate and enforce its disciplinary rules against non-registered practitioners who impermissibly practice in patent matters before the Office.

At the hearing of this disciplinary matter, Deputy Director for OED, William Griffin, testified and explained that at least since 1999, when he first came to work with OED, OED has asserted jurisdiction over trademark practitioners, even though such practitioners are not registered to practice before the office in patent matters. (A.8234-8235). Mr. Griffin cited to *Gaudio* and *Wengrovsky* as examples of when the Office pursued discipline against unregistered practitioners who provided patent legal services to clients. (A.8237-8238). Mr. Griffin also clarified that the USPTO rules state that unregistered practitioners who practice before the Office are subject to the OED’s jurisdiction. (A.8238). Appellant has not offered a scintilla of evidence to contradict Mr. Griffin or to support his own argument. He merely repeats his own conclusory

argument. Thus, the ALJ's finding that Appellant has not proved this affirmative defense is upheld.

## **V. SANCTION**

The ALJ's Initial Decision concluded that Appellant engaged in misconduct that violated five (5) of USPTO's disciplinary rules, and ordered and imposed an 18-month suspension from the practice before the office. (A.27-28). An ALJ initial decision that imposes exclusion or suspension must explain the reason for imposing such a sanction after consideration of 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)-(4).

The Director of the USPTO reviews an appeal from an ALJ Initial Decision on the record before the ALJ. *See* 37 C.F.R. § 11.55(f); *see also Marinangeli v. Lehman*, 32 F. Supp. 2d 1, 5 (D.D.C. 1998). After such review, and as discussed below, the ALJ's Initial Decision to suspend Appellant from practicing before the USPTO for 18 months included a careful and proper analysis of the four factors set forth in 37 C.F.R. § 11.54(b). The ALJ's sanction of an 18-month suspension is warranted and thus upheld. Here, the ALJ properly considered and applied the four factors relevant to an exclusion or suspension under 37 C.F.R. § 11.54(b). This analysis is discussed further, below.

**A. Appellant Violated His Duty to His Clients and the Legal Profession.**

The ALJ concluded that Appellant violated his duties to his clients. (A.25). Appellant's provision of patent and trademark legal services to clients, as previously detailed, obliged him to serve his clients competently, including requiring him to maintain familiarity with the USPTO practice and disciplinary rules. (*Id.*). In fact, the record is replete of testimony and other evidence supporting that he provided such services to clients. *See supra* pp. 14-16. Instead of abiding by the rules that applied to him, however, Appellant rejected their applicability and instead maintained that he was not bound by the disciplinary rules. (A.25) This resulted in Appellant providing false information to his clients. (*Id.*)

The ALJ concluded that Appellant also violated his duty to the legal profession by engaging in the unauthorized practice of patent matters before the Office. (A.25). The ALJ relied on *United States v. Johnson*, 327 F.3d 554, 560 (7th Cir. 2003) ("[T]he unauthorized practice of law poses both to the integrity of the legal profession and to the effective administration of justice."). In addition, the ALJ found that Appellant's failure to cooperate in the OED's investigation can be perceived to "weaken[] the public's perception of the legal profession's ability to self-regulate" and "undermin[e] the integrity of the attorney disciplinary system."<sup>8</sup> *In re Brost*, 850 N.W.2d 699, 705 (Minn. 2014). Accordingly, the ALJ determined that this factor warrants a severe sanction. (*Id.*)

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<sup>8</sup> The ALJ did not conclude that Appellant's failure to cooperate violated 37 C.F.R. § 11.801(b), which states that a practitioners, 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. (A.17). The ALJ accepted Appellant's assertion that he did not knowingly fail to respond to the OED's lawful requests for information. (*Id.*) But, he nonetheless noted that Appellant did refuse to cooperate based on his incorrect belief that OED lacked disciplinary jurisdiction for the requests in the first place. (*Id.*)

Based on Appellant's testimony, and the other evidence in the record, the ALJ's conclusion that Appellant violated his duty to his client, to the public, and the legal system and profession is upheld.

**B. Appellant Did Not Act Intentionally.**

The ALJ concluded that the Appellant did not act intentionally. (A.26). Rather, he generally acted according to his incorrect belief that his conduct fell within a "gray area." (*Id.*) The ALJ believed that Appellant's belief that the USPTO could not and would not discipline his conduct was largely attributed to his reliance on "bad information." (*Id.*) The Court also credited Appellant with making "a modicum of effort to find a legal basis for his position by consulting a patent attorney and doing a cursory search for applicable case law." (*Id.*)

At some point, however, questions were raised about the propriety of his conduct. (A.26). For example, Mr. Mason raised the issue with him and the OED informed him of its concern he was engaged in unauthorized practice before the Office in patent matters. (*Id.*) Despite this, Appellant did not try to inform himself about whether his legal services were permissible under USPTO rules and he continued providing patent legal services to clients. (*Id.*) These failures, the ALJ recognized, deviated from the standard care expected of a lawyer. While the ALJ did not find Appellant's conduct to be intentional, the ALJ nonetheless found that he "should not be rewarded for his negligence." (*Id.*) Accordingly, the ALJ found this factor supported a moderate sanction. Because this finding has support in the record, the ALJ's findings are upheld here.

**C. Appellant Did Cause Actual Injury.**

The ALJ did not find that the OED Director offered any evidence of any actual or potential injury caused by Appellant's misconduct. (A.26). To the contrary, none of the witnesses testified that Appellant represented them poorly and most of the witnesses testified that he generally

provided competent legal services to them. (*Id.*). Further, there is no evidence that Appellant's misconduct negatively impacted his clients' intellectual property rights. (*Id.*) Accordingly, the ALJ found that the "lack of actual or potential injury should temper the severity of the sanction imposed." This finding is upheld.

**D. Aggravating and Mitigating Factors Exist in This Case.**

The ALJ's findings included the existence of both aggravating and mitigating factors. In finding both aggravating and mitigating actors, the ALJ relied on the ABA's Standards for Imposing Lawyer Sanctions ("ABA Standards"). (A.26); *see In re Chae*, Proceeding No. D2013-01, slip op. at 4 (USPTO Oct. 21, 2013).

With regard to aggravating factors, the ALJ identified Appellant's selfish motive, a pattern of misconduct, multiple offenses, and his substantial experience in the practice of law. (A.26). The ALJ highlighted Appellant's selfish motivation, noting that he was paid significant fees for performing services he was not authorized to perform. (A.26-27). Despite Appellant's testimony that he provided small investor's with relief from large law firms that charged exorbitant fees, the ALJ noted that Appellant was still paid for his work. (A.27). This finding is supported in the record.

Next, the ALJ noted evidence in the record that demonstrated that Appellant engaged in unauthorized practice before the Office in patent matters for years representing numerous clients. (A.27). This pattern of misconduct and the presence of multiple offenses were both identified as aggravating factors.

Last, the ALJ concluded that Appellant's substantial experience in the practice of law is also an aggravating factor. (A.27). Appellant has been licensed by the Wyoming Bar since 2007. (A.991, No. 1; A.7762:9-10). Before that time, Appellant testified that he permissibly worked on

patent matters under the supervision of registered practitioners. (A.7761-7762). Thus, his substantial experience in the patent law and matters pertaining to the USPTO was found to be an aggravating factor. (A.27).

The ALJ also identified mitigating factors. The absence of a prior disciplinary record constituted a mitigating factor. (A.27). Also mitigating was the fact that Appellant is an attorney in good standing and has not been disciplined by the Wyoming State Bar. (*Id.*) The ALJ credited as mitigating Appellant's testimony that he believed he was providing a needed and affordable service to small investors who had limited resources and who did not wish to relinquish control of the patent process. (*Id.*) Thus, the ALJ found that Appellant's misconduct accompanied by "good intentions." (*Id.*) These factors –absence of prior disciplinary record, his good standing in Wyoming, and Appellant's good intentions- mitigated Appellant's sanction.

In an effort to argue for a mitigation or negation of the sanction here, Appellant claims that his practice has been destroyed and, as a result, the suspension here should be stayed or suspended to allow him to rebuild his practice. (Appeal at 30). He also argues that the fact that no client was harmed counsels in favor of mitigation here. (*Id.*).<sup>9</sup> These arguments, however, are insufficient to mitigate the 18-month suspension ordered by the ALJ.

The disciplinary proceedings and result here are the result of Appellant's own actions and that he is suffering consequences from those actions is not a sufficient basis to mitigate the sanction further. Additionally, the Initial Decision suspending Appellant from practice before the Office was issued on December 11, 2018. Thus, he has had 11 months from that date to rebuild

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<sup>9</sup> In his Reply, Appellant also requests "an opportunity to provide a showing that the practitioner has taken steps to prevent recurrence of the same or similar conduct." (Reply at 14-15). However, the Director of the USPTO reviews an appeal from an ALJ Initial Decision on the record before the ALJ. *See* 37 C.F.R. § 11.55(f). As this request would require additional evidence to be considered, outside the record of these disciplinary proceedings, the Director declines to consider this evidence.

his law practice in a way that does not involve practice before the USPTO. Finally, and as the OED Director notes, an order for discipline in a final decision is not stayed except on proof of exceptional circumstances. *See* 37 C.F.R. § 11.57(b). No such circumstances were articulated here. As to the lack of harm to clients, the ALJ already weighed this factor but found that the aggravating factors outweighed any mitigation and that an 18-month suspension was warranted.

Considering all of the ALJ's findings, the ALJ's analysis of the § 11.54 factors was reasonable and his findings are amply supported by the record. As such, the ALJ's imposition of an 18-month suspension from the practice of patent, trademark, and other non-patent matters before the USPTO is affirmed.

### **ORDER**

Having considered Appellant's appeal under 37 C.F.R. § 11.55 from the December 11, 2018 Initial Decision of the ALJ to suspend Appellant from practice before the USPTO in patent, trademark and other non-patent matters, it is **ORDERED** that the ALJ's initial decision is **AFFIRMED**.

It is further:

**ORDERED** that Appellant is suspended for 18 months from the practice of patent, trademark, and other non-patent matters before the USPTO effective the date of this Final Order. Upon reinstatement, Appellant is reminded that he is not permitted to engage in the practice of patent matters, to include providing patent services for *pro se* clients, because he is not registered to practice in patent matters before the USPTO. Only practitioners who are registered to practice before the USPTO are permitted to provide patent legal services to clients, including *pro se* clients, or to represent others in any proceedings before the USPTO;

**ORDERED** that the OED Director shall publish a Notice in the *Official Gazette* that is materially consistent with the following:

**Notice of Suspension**

This notice concerns Kley Achterhof of Newcastle, Wyoming. After a review of an Initial Decision and Order by an Administrative Law Judge (“ALJ”) pursuant to 37 C.F.R. §§ 11.55 and 11.56, the Director of the United States Patent and Trademark Office (“USPTO”) has ordered that Mr. Achterhof be suspended for 18-months from the practice of patent, trademark, and other non-patent matters before the Office. Mr. Achterhof is an attorney in good standing in the State of Wyoming. However, he is not registered to practice before the Office.

On December 11, 2018, an ALJ issued an Initial Decision and Order concluding that Mr. Achterhof engaged in the unauthorized practice of law before the Office in violation of 37 C.F.R. § 11.505 and 37 C.F.R. § 11.116(a)(1). Further, Appellant’s unauthorized practice of law before the Office was found to have violated former 37 C.F.R. § 10.23(b)(5) and current 11.804(d), both of which proscribe engaging in conduct that is prejudicial to the administration of justice. Finally, the ALJ found that Appellant’s misconduct violated 37 C.F.R. § 11.701 which proscribes false or misleading communications regarding a practitioner’s services. Mr. Achterhof’s misconduct stemmed from his providing patent legal to clients who filed applications with the USPTO on a *pro se* basis without being a registered practitioner, which is the unauthorized practice of law. Further, Mr. Achterhof provided false information regarding the nature of his services to clients. The ALJ ordered that Mr. Achterhof be suspended from practice before the USPTO in patent, trademark, and other non-patent matters for 18 months. The USPTO Director affirmed the ALJ’s Initial Decision and Order.

Upon reinstatement, Appellant is not permitted to engage in the practice of patent matters, to include providing patent services to *pro se* clients, because he is not registered to practice in patent matters before the USPTO. Only practitioners who are registered to practice before the USPTO are permitted to provide patent legal services to clients, including *pro se* clients, or to represent others in any proceedings before the USPTO.

This action is taken pursuant to the provisions of 35 U.S.C. § 32 and 37 C.F.R. § 11.55. Disciplinary decisions are available for public review at the Office of Enrollment and Discipline’s FOIA Reading Room, located at: <http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>;

**ORDERED** that the OED Director give notice pursuant to 37 C.F.R. § 11.59 of the public discipline and the reasons for the discipline to disciplinary enforcement agencies in the state(s) where Appellant is admitted to practice, to courts where Appellant is known to be admitted, and to the public;

**ORDERED** that the USPTO shall dissociate Respondent's name from any Customer Number(s) and USPTO verified Electronic System account(s), if any;

**ORDERED** that Appellant shall not apply for a USPTO Customer Number, shall not obtain a USPTO Customer Number, nor shall he have his name added to a USPTO Customer Number, unless and until he is reinstated to practice before the USPTO; and

**ORDERED** that Appellant shall comply with the provisions of 37 C.F.R. § 11.58 governing the duties of disciplined practitioner.

#### **RECONSIDERATION AND APPEAL RIGHTS**

Any request for reconsideration of this decision must be filed within twenty (20) days from the date of entry of this decision pursuant to 37 C.F.R. § 11.56(c). Any request for reconsideration mailed to the USPTO must be addressed to:

Sarah T. Harris  
General Counsel  
United States Patent and Trademark Office  
600 Dulany St.  
P.O. Box 1450  
Alexandria, VA 22313-1450

A copy of the request must also be served on the attorney for the Director of Enrollment and Discipline:

Melinda M. DeAtley  
Elizabeth Ullmer Mendel  
Counsel for the Director of Office of Enrollment and Discipline  
600 Dulany St.  
P.O. Box 1450


Alexandria, VA 22313-1450

Any request hand-delivered to the USPTO must be hand-delivered to the Office of the General Counsel, in which case the service copy for the attorney for the Director shall be hand-delivered to the Office of Enrollment and Discipline.

If a request for reconsideration is not filed, and Appellant desires further review, Appellant is notified that he is entitled to seek judicial review on the record in the U.S. District Court for the Eastern District of Virginia under 35 U.S.C. § 32 "within thirty (30) days after the date of the order recording the Director's action." *See* E.D.Va. Local Civil Rule 83.5.

**IT IS SO ORDERED.**

11/18/19  
Date

  
Sarah T. Harris  
General Counsel  
United States Patent and Trademark Office

on delegated authority by

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

cc:

Raymond P. Burrasca  
Law Office of R.P. Burrasca  
244 Fifth Avenue, Suite D69  
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Kley Achterhof  
PO Box 653  
Newcastle, WY 82701  
*Appellant*

Melinda M. DeAtley  
Elizabeth Ullmer Mendel  
*Associate Solicitors*  
Counsel for the Director of Office of Enrollment and Discipline

## CERTIFICATE OF SERVICE

I HEREBY CERTIFY that the foregoing Final Order was sent to the parties below, in the manner indicated:

### VIA FIRST CLASS MAIL, RETURN RECEIPT REQUESTED, and E-MAIL:

Kley Achterhof  
PO Box 653  
Newcastle, WY 82701  
[REDACTED]

*Appellant*

### VIA E-MAIL:

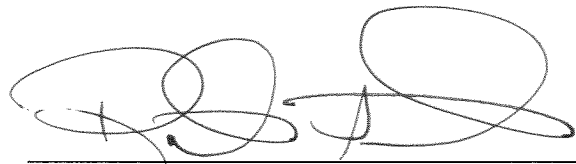
[REDACTED]  
*Appellant's co-counsel*

### VIA HAND-DELIVERY AND E-MAIL:

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[REDACTED]  
[REDACTED]

*OED Director*

11/18/2019  
Date

  
\_\_\_\_\_  
United States Patent and Trademark Office