

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

In the Matter of:)	
)	
Arthur Mark Feuerborn,)	Proceeding No. D2020-23
)	
Respondent.)	
)	

FINAL ORDER PURSUANT TO 37 C.F.R. § 11.24

Pursuant to 37 C.F.R. § 11.24, Arthur Mark Feuerborn (“Respondent”) is hereby suspended for one year from the practice of patent, trademark, and other non-patent law before the United States Patent and Trademark Office (“USPTO” or “Office”) for violation of 37 C.F.R. § 11.804(h), having been disciplined by a duly constituted authority of a state.

I. BACKGROUND

1. At all times relevant to this Complaint, Respondent of Camarillo, California, has been an attorney in good standing licensed by California to practice law in that jurisdiction. As a licensed attorney in good standing, Respondent is authorized to practice before the Office in trademark and non-patent matters pursuant to 37 C.F.R. § 11.14(a) and is engaged in practice before the Office; therefore, he is subject to the USPTO Rules of Professional Conduct set forth in 37 C.F.R. § 11.101 *et seq.*

2. The Director of the USPTO has jurisdiction over this proceeding pursuant to 35 U.S.C. §§ 2(b)(2)(D) and 32, and 37 C.F.R. §§ 11.19 and 11.24.

California Discipline

3. By Order dated July 11, 2019, the Supreme Court of California in *In re ARTHUR MARK FEUERBORN on Discipline* in Case No. SBC-19-O-30116 suspended Respondent from the practice of law for one year, stayed the suspension, placed him on a two-year period of probation, and suspended Respondent for the first 90 days of his probation. Exhibit A to the disciplinary complaint is a true and accurate certified copy of the Order. Respondent stipulated to the California discipline. *See In re Feuerborn*, No. SBC-19-O-30116, Order Approving Stipulation, at 11-21 (Cal. State Bar Ct Apr. 2, 2019) (“Stipulation”).

4. The July 11, 2019 Order of the Supreme Court of California, incorporates by attachment Respondent’s stipulation and the State Bar Court of California’s April 2, 2019¹ findings supporting the imposition of discipline. The July 11, 2019 Order, as set forth in the Stipulation, concluded that Respondent engaged in the misconduct: (1) by failing to comply with several Court orders in a bankruptcy case, Mr. Feuerborn failed to maintain the respect due to the courts; (2) by knowingly making false and misleading statements to a bankruptcy trustee in his response to a subpoena, Mr. Feuerborn committed acts involving moral turpitude, dishonesty, or corruption; and (3) by failing to report the imposition of several monetary sanctions against him to the State Bar, Mr. Feuerborn failed to report to the agency charged with attorney discipline, in writing, within 30 days of the time that he had knowledge of the imposition of judicial sanctions against him. *See Stipulation at 15.* Such acts and omissions violated the California Business and Professions Code Sections 6068(b), 6106, and 6068(o)(3). *Id.*

USPTO Reciprocal Discipline Proceeding

5. On June 17, 2020, a “Notice and Order Pursuant to 37 C.F.R. § 11.24” (“Notice and

¹ The July 11, 2019 order found the stipulation that Respondent signed to be “fair to the parties” and also concluded that “it adequately protects the public.” Thus, the stipulated facts and disposition were approved.

Order”) was sent by certified mail (receipt no. 70191640000071024659) notifying Respondent that the Director of the Office of Enrollment and Discipline (“OED Director”) had filed a “Complaint for Reciprocal Discipline Pursuant to 37 C.F.R. § 11.24” (“Complaint”) requesting that the Director of the United States Patent and Trademark Office impose reciprocal discipline upon Respondent identical to the discipline imposed by the Supreme Court of California in *In re ARTHUR MARK FEUERBORN on Discipline, Case No. SBC-19-O-30116*. The Notice and Order provided Respondent an opportunity to file, within forty (40) days, a response opposing the imposition of reciprocal discipline identical to that imposed by the Supreme Court of California in *In re ARTHUR MARK FEUERBORN on Discipline, Case No. SBC-19-O-30116*, based on one or more of the reasons provided in 37 C.F.R. § 11.24(d)(1).

6. Respondent filed a Response to Notice and Order Pursuant to 37 C.F.R. § 11.24 (“Response to Notice and Order”) on August 26, 2020.² Therein, he claims that the imposition of reciprocal discipline here would result in a grave injustice. *See* Response to Notice and Order at 2. Respondent asserts that it has been more than a year since his California suspension began and more than 9 months since the suspension ended, that he complied with all requirements of his suspension, and that he was unfamiliar with the reporting requirements to USPTO regarding discipline in other states. *Id.*

7. The OED Director was permitted to respond to the Response to Notice and Order (“OED Response”) and did so on October 29, 2020. The OED Director argues that reciprocal discipline here would not amount to a grave injustice since the California discipline was within the range of appropriate sanctions for Respondent’s misconduct. *See* OED Response at 2. Further, the OED Director points out that Respondent is not challenging that the California discipline is improper

² By Order dated July 23, 2020, Respondent was granted an extension of time to file his Response to the Notice and Order. Pursuant to that Order, Respondent was permitted to file his response “on or before August 26, 2020.”

but, rather, that he should not have to serve the suspension since he already served a suspension in California and voluntarily ceased practice before the USPTO. *Id.* To the extent that Respondent is asking for discipline *nunc pro tunc*, the OED Director objects and states that Respondent's actions do not satisfy the requirements of 37 C.F.R. § 11.24(f). Accordingly, the OED Director claims that any such request should be denied.

8. Respondent filed a Reply brief on November 12, 2020, reasserting his earlier arguments.

II. LEGAL STANDARD

Pursuant to 37 C.F.R. § 11.24(d), and in accordance with *Selling v. Radford*, 243 U.S. 46 (1917), the USPTO has codified standards for imposing reciprocal discipline based on a state's disciplinary adjudication. Under *Selling*, state disbarment creates a federal-level presumption that imposition of reciprocal discipline is proper, unless an independent review of the record reveals: (1) a want of due process; (2) an infirmity of proof of the misconduct; or (3) that grave injustice would result from the imposition of reciprocal discipline. Federal courts have generally "concluded that in reciprocal discipline cases, it is the respondent attorney's burden to demonstrate, by clear and convincing evidence, that one of the *Selling* elements precludes reciprocal discipline." *In re Kramer*, 282 F.3d 721, 724 (9th Cir. 2002); *In re Friedman*, 51 F.3d 20, 22 (2d Cir. 1995). "This standard is narrow, for '[a Federal court, or here the USPTO Director is] not sitting as a court of review to discover error in the [hearing judge's] or the [state] courts' proceedings.'" *In re Zdravkovich*, 634 F.3d 574, 578 (D.C. Cir. 2011) (quoting *In re Sibley*, 564 F.3d 1335, 1341 (D.C. Cir. 2009)) (second and third alternations in original).

The USPTO's regulation governing reciprocal discipline, 37 C.F.R. § 11.24(d)(1), mirrors the standard set forth in *Selling*:

[T]he USPTO Director shall consider any timely filed response and shall impose the identical public censure, public reprimand, probation, disbarment, suspension,

or disciplinary disqualification unless the practitioner clearly and convincingly demonstrates, and the USPTO Director finds there is a genuine issue of material fact that:

- (i) The procedure elsewhere was so lacking in notice or opportunity to be heard as to constitute deprivation of due process;
- (ii) There was such infirmity of proof establishing the conduct as to give rise to the clear conviction that the Office could not, consistently with its duty, accept as final the conclusion on that subject;
- (iii) The imposition of the same public censure, public reprimand, probation, disbarment, suspension or disciplinary disqualification by the Office would result in a grave injustice; or
- (iv) Any argument that the practitioner was not publicly censured, publicly reprimanded, placed on probation, disbarred, suspended or disciplinarily disqualified.

Id.

To prevent the imposition of reciprocal discipline, Respondent is required to demonstrate that there is a genuine issue of material fact as to one of these criteria by clear and convincing evidence. *See id.* As discussed below, however, Respondent has not shown by clear and convincing evidence that there is a genuine issue of material fact with regard to any of the factors set forth in 37 C.F.R. § 11.24(d)(1).

III. ANALYSIS

Respondent filed a Response to the Notice and Order challenging the imposition of reciprocal discipline. He claims that the imposition of reciprocal discipline here would result in a grave injustice since it has been more than a year since his California suspension began and more than 9 months since the suspension ended, he complied with all requirements of his suspension, and he was unfamiliar with the reporting requirements to USPTO regarding discipline in other states. *See* Response to Notice and Order at 2. As already stated, however, Federal courts have generally “concluded that in reciprocal discipline cases, it is the respondent attorney’s burden to demonstrate, by clear and convincing evidence, that one of the *Selling* elements precludes reciprocal discipline.” *In re Kramer*, 282 F.3d at 724; *In re Friedman*, 51 F.3d at 22. Thus,

Respondent's recourse to mitigate or negate reciprocal discipline here is limited to arguing that the *Selling* factors preclude reciprocal discipline. Because he cannot satisfy this burden, reciprocal discipline is warranted here.

A. Reciprocal Discipline Would Not Amount to a Grave Injustice.

As stated, an attorney respondent may seek to defeat that presumption that discipline is proper by showing by clear and convincing evidence that a "grave injustice" would result under 37 C.F.R. § 11.24(d)(1)(iii). The grave injustice analysis focuses on whether the severity of the state ordered punishment "fits" the misconduct. *See In re Thav*, 852 F. Supp. 2d 857, 861-62 (E.D. Mich. 2012); *see also In re Kramer*, 282 F.3d at 727 (on challenge to imposition of reciprocal discipline, "we inquire only whether the punishment imposed by [the first] court was so ill-fitted to an attorney's adjudicated misconduct that reciprocal disbarment would result in grave injustice"); *In re Attorney Discipline Matter*, 98 F.3d 1082, 1088 (8th Cir. 1996) (no grave injustice where disbarment imposed by the state court "was within the appropriate range of sanctions"); *In re Benjamin*, 870 F. Supp. 41, 44 (N.D.N.Y. 1994) (public censure within range of penalties for misconduct and thus censure was not a grave injustice). Here, not only does the California sanction "fit" Respondent's misconduct, Respondent's agreement to an actual suspension of 90 days is reflected in his signature on the Stipulation date _____. *See* Stipulation at 20.

A review of the Stipulation, which approved by the California State Bar and formed the basis for the July 11, 2019 order of the Supreme Court of California, is dispositive on the grave injustice issue. In the Stipulation, Respondent agreed to the application of the American Bar Association's Standards for Imposing Lawyer Sanctions, which "set forth a means for determining the appropriate disciplinary sanction in a particular case and to ensure consistency

across cases dealing with similar misconduct and surrounding circumstances.” Stipulation at 17 (citing Rules Proc. of State Bar, tit. IV, Stds. for Atty. Sanctions for Prof. Misconduct, std. 1.1). Respondent agreed that “...the standards are entitled to ‘great weight’ and should be followed ‘whenever possible’ in determining the level of discipline.” *Id.* The Stipulation further explained that “...where a respondent ‘commits two or more acts of misconduct and the Standards specify different sanctions for each act, the most severe sanction must be imposed.’” *Id.* Finally, again applying the ABA standards, the Stipulation provided that aggravating and mitigating factors would be used in determining the appropriate disciplinary sanction. *See id.* at 17-18. It is noted that the ABA Standards have been referenced when determining the appropriate sanction to be imposed in a USPTO disciplinary proceeding. *See, e.g., In re Hormann*, Proceeding No. D2008-04 (USPTO July 8, 2009)11; *In re Robinson*, Proceeding No. D2009-48 (USPTO July 1, 2010).

As to the substance of Respondent’s misconduct, Respondent stipulated that he engaged in serious misconduct when he committed statutory violations, including failure to maintain respect due to the courts, moral turpitude-misrepresentation, and failure to report judicial sanctions. *See* Stipulation at 17. He also stipulated to serious misconduct by engaging in dishonesty when he tendered untruthful responses to the bankruptcy Trustee’s subpoena. *Id.* Disbarment or suspension was a sanction applicable to Respondent’s misconduct of dishonesty and failing to maintain the respect due to courts. *Id.* at 17-18.

Applying aggravating and mitigating factors, the Stipulation identified the presence of serious aggravating factors, to include multiple, statutory violations and causing the estate in the bankruptcy case to suffer a significant economic loss. Stipulation at 2-3, 18. A number of mitigating factors were also noted, however. These included the fact that Respondent had “14 years of discipline-free practice, [he provided] strong evidence of good character and pro bono

legal services, and [he agreed] to enter into [the] Stipulation.” *Id.* at 2-4, 18. As a result, it was agreed that Respondent’s misconduct was “aberrational, and that [R]espondent [was] not likely to be deceitful or disrespectful to law and the judicial system again.” *Id.* at 18. Based on this analysis, it was agreed—and the California State bar recommended—that “there is no evidence that a sanction short of disbarment is inadequate to deter future misconduct and protect the public.” *Id.* However, “given the seriousness of [R]espondent’s misconduct, the presumed sanction of actual suspension” was still concluded as warranted. *Id.* In reaching this conclusion, Respondent agreed that case law provided appropriate guidance as to the appropriate amount of actual suspension that was warranted. *Id.* (citing *Maltaman v. State Bar*, 43 Cal. 3d 924 (1987)). Accordingly, Respondent agreed to, and the California State Bar recommended, that “discipline consisting of a one-year suspension, stayed, two-year probation, with conditions including a 90 day actual suspension is warranted. . . .” *Id.* at 19.

As a result of the Stipulation and the analysis therein, on July 11 2019, the Supreme Court of California ordered, in *In re Arthur Mark Feuerborn*, Case No. SBC-19-O-30116, that Respondent was “...suspended from the practice of law in California for one year, execution of that period of suspensions...stayed, and Respondent [was] placed on probation for two years subject to...conditions” that included his “...suspen[sion] from the practice of law for the first 90 days of probation.” This sanction is not, and cannot be, a grave injustice as it is within the range of allowable penalties under the ABA standards and California precedent, as recognized and agreed to by Respondent. When the sanction is appropriate for a practitioner’s misconduct there is no grave injustice for the USPTO to impose reciprocal discipline. *See Chaganti v. Matal*, 695 F. App’x 549 (Fed. Cir. 2017) (unpublished) (per curiam); *see also Persaud v. Dir. of U.S. Patent & Trademark Office*, No. 16-cv-00495, 2017 WL 1147459, at *2 (E.D. Va. Mar. 27,

2017) (“As long as the discipline from the state bar was within the range of appropriate sanctions, it is not grave injustice for the [USPTO] to impose reciprocal discipline.”).

Accordingly, Respondent has not demonstrated by clear and convincing evidence that there is a genuine issue of material fact that the imposition of a reciprocal suspension here would result in a grave injustice.

A. Respondent Has Not Satisfied the Requirements for Discipline to be Imposed *Nunc Pro Tunc*.

Having failed to satisfy any of the factors at 37 C.F.R. § 11.24(d), Respondent also argues that he already complied with all of the requirements of his California suspension and that “[i]t has been more than one year since my suspension period began and more than 9 months since the suspension ended.” Response to Notice and Order at 2. Thus, Respondent argues that he already served his 90-day suspension in California and during that time he refrained from practicing in trademarks before the Office; accordingly, he believes that he should not have to serve a 90-day reciprocal discipline suspension. *Id.* This is, essentially, a request that the USPTO impose reciprocal discipline *nunc pro tunc* under 37 C.F.R. § 11.24(f). However for the reasons stated below, his request that discipline be imposed *nunc pro tunc*, or otherwise suspended, is denied.

Upon request by a practitioner, “reciprocal discipline may be imposed *nunc pro tunc* only if the practitioner promptly notified the OED Director of his or her [suspension] in another jurisdiction, and establishes by clear and convincing evidence that the practitioner voluntarily ceased all activities related to practice before the Office and complied with all provisions of § 11.58.” 37 C.F.R. § 11.24(f). The provisions of 37 C.F.R. § 11.58 concern duties of disciplined practitioners and include, but are not limited to, requirements such as filing notices of withdrawal in each patent and trademark application pending before the USPTO and providing notices of the

discipline to all State and Federal jurisdictions and to all clients. *See* 37 C.F.R. § 11.58(b)(1)(i) and (ii).

The central issue here is whether or not Respondent can establish that he complied with all provisions of § 11.58. Respondent carries the burden of proof to establish § 11.58 compliance clear and convincing evidence. *See* 37 C.F.R. § 11.24(f). The USPTO Director regularly enforces the express terms of § 11.24(f) before applying reciprocal discipline *nunc pro tunc*. *See In re Levine*, Proceeding No. 2015-21 (USPTO Aug. 1, 2016); *see also In re Plache*, Proceeding No. D2014-20 (USPTO Sept. 24, 2014) (The USPTO Director refused to reciprocally apply a New York three-year suspension *nunc pro tunc* where the practitioner did not notify the OED Director of the suspension. The Final Order states that: "...voluntary cessation of practice before the USPTO alone has no legal effect on the imposition of reciprocal discipline."). Further, the OED Director opposes *nunc pro tunc* discipline here on the basis that allowing Respondent to serve his suspension *nunc pro tunc* would violate the Office's policy of protecting the public and would be inconsistent with the applicable rules and prior disciplinary decisions.

Respondent has not asserted, nor has he proven, that he satisfied the provisions of § 11.24(f) such that discipline *nunc pro tunc* is appropriate. While he refrained from practicing in trademarks before the Office during the period of his California suspension, that is where his compliance with the requirements of § 11.24(f) ends. He failed to allege, much less show, that he complied with any of the provisions of § 11.58. For example, he has provided no proof that he filed notices of withdrawal in each trademark application pending before the USPTO or that he provided notice of the discipline to all State and Federal jurisdictions and to all clients. For that reason, his implied request for discipline to be imposed *nunc pro tunc* here is denied.

Finally, Respondent's remaining claims are also dismissed. They are factually unsupported

or legally irrelevant to reciprocal discipline. For example, ignorance of the law is not a defense to the disciplinary matter or failing to satisfy the §§ 11.24(f) and 11.58 requirements. In fact, “any defense predicated on ignorance of the law is inconsistent with ... the right to advise other people of the law.” See *Halvonik v. Dudas*, 398 F. Supp. 2d 115, 126 (D.D.C. 2005). His claims of economic hardship are likewise dismissed as irrelevant to the disciplinary case and the claims made here.

ORDER

ACCORDINGLY, it is ORDERED that:

1. Respondent is suspended for one year from the practice of trademark and other non-patent law before the USPTO, effective the date of this Final Order. Respondent is permitted to file a petition for reinstatement pursuant to 37 C.F.R. § 11.60 after completing ninety (90) days of the one-year suspension. Respondent shall serve a two-year probationary period commencing on the date of the granting of any petition for his reinstatement.
2. The OED Director publish a notice in the *Official Gazette* materially consistent with the following:

Notice of Suspension and Probation

This notice concerns Arthur Mark Feuerborn of Camarillo, California, who is authorized to practice before the United States Patent and Trademark Office (“USPTO”) only in trademark and non-patent matters. In a reciprocal disciplinary proceeding, the Director of the USPTO has ordered that Mr. Feuerborn (a) be suspended for one year from practice before the USPTO in trademark and other non-patent matters, (b) be allowed to file a petition for reinstatement after completing ninety (90) days of the one-year suspension, and (c) be placed on and serve a two-year probation commencing on the date of the granting of a petition for his reinstatement. Such discipline was imposed based on Mr. Feuerborn’s violation of 37 C.F.R. § 11.804(h), which is predicated upon his being suspended from the practice of law for one year in California, the suspension being stayed, being placed on a two-year period of probation,

and being suspended for the first 90 days of his probation. Mr. Feuerborn is not authorized to practice before the USPTO in patent matters.

The Supreme Court of California adopted the State Bar Court of California's April 2, 2019 findings that (1) by failing to comply with several Court orders in a bankruptcy case, Mr. Feuerborn failed to maintain the respect due to the courts; (2) by knowingly making false and misleading statements to a bankruptcy trustee in his response to a subpoena, Mr. Feuerborn committed acts involving moral turpitude, dishonesty, or corruption; and (3) by failing to report the imposition of several monetary sanctions against him to the State Bar, Mr. Feuerborn failed to report to the agency charged with attorney discipline, in writing, within 30 days of the time that he had knowledge of the imposition of judicial sanctions against him. Such acts and omissions violated California Business and Professions Code Sections 6068(b), 6106, and 6068(o)(3).

This action is taken pursuant to the provisions of 35 U.S.C. § 32 and 37 C.F.R. § 11.24. Disciplinary decisions are available for public review at the Office of Enrollment and Discipline's FOIA Reading Room, located at: <https://foiadocuments.uspto.gov/oed/>;

3. 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 Respondent is admitted to practice, to courts where Respondent is known to be admitted, and to the public;
4. Respondent shall comply with the duties enumerated in 37 C.F.R. § 11.58;
5. The USPTO dissociate Respondent's name from any Customer Numbers and USPTO verified Electronic System account(s), if any; and
6. Respondent 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.

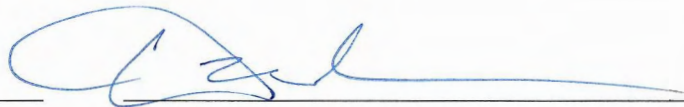
Pursuant to 37 C.F.R. § 11.57(a), review of the final decision by the USPTO Director may be

had by a Petition filed with 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.

12/21/2020

Date



David Berdan
General Counsel for General Law
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