

UNITED STATES PATENT AND TRADEMARK OFFICE

In the Matter of:)
David J. Edmondson,) Proceeding No. D2023-23
Respondent)
_____)

FINAL ORDER PURSUANT TO 37 C.F.R. § 11.29

Pursuant to 37 C.F.R. § 11.29, the reciprocal transfer to disability inactive status of David J. Edmondson (“Respondent”) is hereby ordered.

Background

On February 28, 2023, the District of Columbia Court of Appeals issued an order in *In re David J. Edmondson*, No. 23-BS-0114 (D.C. Feb. 28, 2023), suspending Respondent regarding the practice of law in Washington, D.C., based upon an incapacity pursuant to D.C. Bar R. XI, § 13(c).

On August 31, 2023, a “Notice and Order Pursuant to 37 C.F.R. § 11.29” (“Notice and Order”) mailed by certified mail (receipt no. 70220410000250016992) notified Respondent that the Director of the Office of Enrollment and Discipline (“OED Director”) had filed a “Request for Reciprocal Transfer to Disability Inactive Status Pursuant to 37 C.F.R. § 11.29” (“Request”) requesting that the Director of the United States Patent and Trademark Office (“USPTO” or “Office”) transfer Respondent to disability inactive status based on the February 28, 2023 order of the District of Columbia Court of Appeals in *In re David J. Edmondson*, No. 23-BS-0114 (D.C. Feb. 28, 2023), suspending Respondent regarding the practice of law in Washington, D.C., based upon an incapacity pursuant to D.C. Bar R. XI, § 13(c).

The Notice and Order provided Respondent an opportunity to file, within thirty (40) days,

a response opposing the imposition of reciprocal transfer to disability inactive status, based on one or more of the reasons provided in 37 C.F.R. § 11.29.

On October 3, 2023, Respondent filed a response to the Notice and Order stating that he “consents to the OED Director’s Request for Reciprocal Transfer to Disability Inactive Status Pursuant to 37 CFR § 11.29” and that he “further acknowledges that the imposition of a functionally equivalent suspension at USPTO (transfer to disability inactive status) is appropriate.” See “Respondent’s Response to August 30 Notice and Order.”

Analysis

In light of Respondent’s response to the Notice and Order, in which Respondent consents to the transfer to disability inactive status, it is hereby determined that there is no genuine issue of material fact under 37 C.F.R. § 11.29(d) and the transferring of Respondent to disability inactive status, precluding him from the practice of patent, trademark and other non-patent law before the USPTO for an indefinite period, is appropriate.

ACCORDINGLY, it is hereby **ORDERED** that:

1. Respondent is transferred to disability inactive status, precluding him from the practice of patent, trademark and other non-patent law before the USPTO until further Order of the OED Director, effective the date of this Final Order;
2. The OED Director publish the following Notice in the *Official Gazette*:

Notice Of Transfer To Disability Inactive Status

This notice concerns David J. Edmondson, a registered patent attorney (Registration Number 35,126) of Washington, D.C. In a reciprocal transfer to disability inactive status proceeding, the Director of the United States Patent and Trademark Office (“USPTO”) has ordered Mr. Edmondson to be transferred to disability inactive status. While on disability inactive status, Mr. Edmondson shall not be authorized to engage in practice before the USPTO in patent, trademark, or other non-patent matters until reinstated to active status.

The USPTO Director's order is based upon a February 28, 2023 order of the District of Columbia Court of Appeals in *In re David J. Edmondson*, No. 23-BS-0114 (D.C. Feb. 28, 2023), suspending Mr. Edmondson based upon an incapacity pursuant to D.C. Bar R. XI, § 13(c) in Washington, D.C.

This action is taken pursuant to the provisions of 35 U.S.C. § 32 and 37 C.F.R. §§ 11.20 and 11.29. Disciplinary decisions and decisions regarding transfer to disability inactive status 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 transfer and the reasons for the transfer 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 shall dissociate Respondent's name from any Customer Number(s) 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.

Users, Shewchuk, David
Digitally signed by Users,
Shewchuk, David
Date: 2023.10.03 16:45:55
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Date

David M. Shewchuk
Deputy General Counsel for General Law
United States Patent and Trademark Office

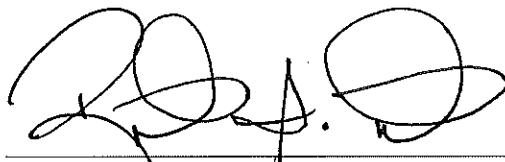
on delegated authority by
Katherine K. Vidal
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

CERTIFICATE OF SERVICE

I hereby certify that the foregoing Final Order Pursuant to 37 C.F.R. § 11.29 was mailed by first-class certified mail, return receipt requested, on this day to counsel for Respondent:

Mr. Daniel Schumack
Schumack + Guggenheim PLLC
3900 Jermantown Rd.
Suite 300
Fairfax, VA 22030-4900

10/4/2023
Date



United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

UNITED STATES PATENT AND TRADEMARK OFFICE

In the Matter of:)
)
David J. Edmondson,) Proceeding No. D2023-23
)
Respondent)
_____)

NOTICE AND ORDER PURSUANT TO 37 C.F.R. § 11.29

Pursuant to 37 C.F.R. § 11.29(b), the Director of the United States Patent and Trademark Office (“USPTO”) hereby issues notice to David J. Edmondson (“Respondent”) that the Director of the Office of Enrollment and Discipline (“OED Director”) has filed a Request for Reciprocal Transfer to Disability Inactive Status Pursuant to 37 C.F.R. § 11.29 (“Request”) requesting that the Director of the USPTO transfer Respondent to disability inactive status regarding the practice of patent, trademark, and other non-patent law before the USPTO. The Request alleges that Respondent was transferred to disability inactive status in Washington, D.C. The Request attaches a certified copy of an Order suspending Respondent based upon an incapacity pursuant to D.C. Bar R. XI, § 13(c) issued by the District of Columbia Court of Appeals on February 28, 2023, in *In re David J. Edmondson*, No. 23-BS-0114 (D.C. Feb. 28, 2023), which suspended David J. Edmondson from the practice of law in that jurisdiction.¹

¹ Subparagraph (c) (“Attorneys who may be incapacitated”) of Section 13 (“Incompetent and Incapacitated Attorneys”) of Rule XI (“Disciplinary Proceedings”) of the Rules Governing the District of Columbia Bar states:

If the Board has reason to believe that an attorney is incapacitated from continuing to practice law because of mental infirmity or illness or because of addiction to drugs or intoxicants, the Board may petition the Court to determine whether the attorney is so incapacitated. Upon the filing of the Board's petition, the Court may take or direct such action as it deems appropriate, including the examination of the attorney by such qualified medical expert or experts as it shall designate. If the Court concludes that the attorney is incapacitated from continuing to practice law, it shall enter an order suspending the attorney on the ground of such disability for an indefinite period, effective immediately and until further order of the Court, and any pending disciplinary proceeding against the attorney shall be held in abeyance. In a case of addiction to drugs or intoxicants, the Court alternatively may consider the possibility of probationary conditions. The Court may provide for such notice to the attorney of proceedings in the matter as it deems appropriate and may appoint counsel to represent the attorney if it determines that the

NOTICE is hereby provided to Respondent and the OED Director that the Director of the USPTO shall hear and decide the matter in accordance with 37 C.F.R. § 11.29(d).

A response to this Notice and Order, and not the Request, is required as set forth below.

ACCORDINGLY, it is:

ORDERED that Respondent file a response to this Notice and Order with the Director of the USPTO containing all information that Respondent believes is sufficient to establish, by clear and convincing evidence, a genuine issue of material fact that the suspension based upon an incapacity pursuant to D.C. Bar R. XI, § 13(c) imposed by the District of Columbia Court of Appeals by order dated February 28 2023, in *In re David J. Edmondson*, No. 23-BS-0114 (D.C. Feb. 28, 2023), would be unwarranted, and the reasons for such claim.

It is also ORDERED that Respondent predicate his response upon information and argument showing clearly and convincingly that:

- (i) the procedure culminating in the February 28, 2023 order of the District of Columbia Court of Appeals in *In re David J. Edmondson*, No. 23-BS-0114 (D.C. Feb. 28, 2023), suspending Respondent regarding the practice of law in Washington, D.C., based upon an incapacity pursuant to D.C. Bar R. XI, § 13(c) was so lacking in notice or opportunity to be heard as to constitute a deprivation of due process;
- (ii) there was such infirmity of proof establishing the February 28, 2023 order of the District of Columbia Court of Appeals in *In re David J. Edmondson*, No. 23-BS-0114 (D.C. Feb. 28, 2023), suspending Respondent regarding the practice of law in Washington, D.C., based upon an incapacity pursuant to D.C. Bar R. XI, § 13(c) as to give rise to the clear conviction that the USPTO could not, consistent with its duty, accept as final the conclusion of disability in that case;
- (iii) the imposition of the same suspension (transfer to disability inactive status) by the USPTO would result in grave injustice; and/or
- (iv) Respondent was not suspended based upon an incapacity pursuant to D.C. Bar R. XI, § 13(c) as set forth in the February 28, 2023 order of the District of Columbia Court of Appeals in *In re David J. Edmondson*, No. 23-BS-0114 (D.C. Feb. 28, 2023).

attorney is without adequate representation.

See 37 C.F.R. § 11.29(d)(1)(i)-(iv).

It is also ORDERED that Respondent shall file his response to this Notice and Order within forty (40) days of the date of this Notice and Order.

It is also ORDERED that failure to respond in a timely manner to this Notice and Order may result in an order imposing reciprocal transfer to disability inactive status.

It is also ORDERED that Respondent shall file his Response to this Notice and Order by mailing via first class mail to:

Office of General Counsel
ATTN: Deputy General Counsel for General Law
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

or by delivery service to:

Office of General Counsel
ATTN: Deputy General Counsel for General Law
United States Patent and Trademark Office
Madison Building East
10th Floor
600 Dulany Street
Alexandria, Virginia 22313-1450

It is also ORDERED that Respondent shall file a copy of his response to this Notice and Order with the OED Director by mailing via first-class mail to:

Sydney O. Johnson, Jr.
Senior Counsel for Enrollment and Discipline Litigation
Mail Stop 8
Office of the Solicitor
P.O. Box 1450
Alexandria, Virginia 22313-1450

or by delivery service to:

Sydney O. Johnson, Jr.
Senior Counsel for Enrollment and Discipline Litigation
Office of the Solicitor
United States Patent and Trademark Office
Madison Building West

600 Dulany Street, 8th Floor
Alexandria, Virginia 22313-1450

or by email to:

Sydney O. Johnson, Jr.
Senior Counsel for Enrollment and Discipline Litigation


Users, Shewchuk, David
Digitally signed by Users, Shewchuk, David
Date: 2023.08.30
14:47:03 -04'00'

Date

David Shewchuk
Deputy General Counsel for General Law
United States Patent and Trademark Office

on delegated authority by

Katherine K. Vidal
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office