

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

In the Matter of	)	
	)	
John E. Gibson,	)	Proceeding No. D2020-24
	)	
Respondent	)	
_____	)	

**FINAL ORDER**

Pursuant to 37 C.F.R. § 11.27(b), the Director of the United States Patent and Trademark Office (“USPTO” or “Office”) received for review and approval from the Director of the Office of Enrollment and Discipline (“OED Director”) an Affidavit of Resignation Pursuant to 37 C.F.R. § 11.27 executed by John E. Gibson (“Respondent”) on May 15, 2020. Respondent submitted the seven-page Affidavit of Resignation to the USPTO for the purpose of being excluded on consent pursuant to 37 C.F.R. § 11.27.

For the reasons set forth herein, Respondent’s Affidavit of Resignation shall be approved, and Respondent shall be excluded on consent from practice before the Office in patent, trademark, and other non-patent matters commencing on the date of this Final Order.

**Jurisdiction**

Respondent of Lawrence, Kansas is a registered patent attorney (Registration Number 52,944). Respondent is subject to the USPTO Rules of Professional Conduct, 37 C.F.R. § 11.101 *et seq.*<sup>1</sup>

Pursuant to 35 U.S.C. §§ 2(b)(2)(D) and 32 and 37 C.F.R. § 11.27, the USPTO Director has the authority to approve Respondent’s Affidavit of Resignation and to exclude Respondent on consent from the practice of patent, trademark, and other non-patent law before the Office.

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<sup>1</sup> The USPTO Rules of Professional Conduct apply to a practitioner’s conduct occurring on or after May 3, 2013.

## Respondent's Affidavit of Resignation

Respondent acknowledges in his May 15, 2020 Affidavit of Resignation that:

1. His consent is freely and voluntarily rendered, and he is not being subjected to coercion or duress.

2. He is aware that, pursuant to 37 C.F.R. § 11.22, the OED Director opened two investigations to determine whether Respondent may have violated the USPTO Rules of Professional Conduct, namely: OED File Nos. [REDACTED] and [REDACTED]. The investigations obtained information concerning, *inter alia*, the following facts and allegations regarding Respondent:

### [REDACTED] the Montgomery and Mycroft Representation

- a) Prior to May 30, 2017, Mr. Joshua Montgomery hired Respondent and his law firm, FreeState Patent Services, to perform patent legal services on his behalf and on behalf of his company, Mycroft AI, Inc ("Mycroft").

### First Provisional Patent Application

- b) Respondent filed a U.S. Provisional Patent Application ("the First Provisional Application") on May 30, 2017, on behalf of Mr. Montgomery.
- c) Mr. Montgomery remitted funds to Respondent to pay the USPTO filing fee for the First Provisional Application.
- d) Respondent did not submit the filing fee to the USPTO when he filed the First Provisional Application.
- e) Respondent did not inform Mr. Montgomery or anyone else at Mycroft that Respondent did not submit the filing fee when filing the First Provisional Application.
- f) Respondent did not submit the filing fee to the USPTO at any time even though he had received the funds from Mr. Montgomery to do so.
- g) On June 6, 2017, the USPTO mailed to Respondent a Notice to File Missing Parts of Provisional Application ("the NFMP") in the First Provisional Application. The NFMP specified that the filing fee relating to the First Provisional Application had not been received by the USPTO and that the filing fee remained due, in addition to a surcharge. The NFMP further specified that Respondent had two months from the date of the NFMP to file the missing items, *i.e.*, the filing fee and surcharge, to avoid abandonment of the First Provisional Application.

- h) Respondent received the NFMP or reasonably should have been aware of the NFMP.
- i) Despite having reasonable time and opportunity to do so, Respondent did not inform Mr. Montgomery or anyone else at Mycroft of the NFMP in the First Provisional Application, Respondent did not communicate its contents to them, and Respondent did not take reasonable steps in response to the NFMP to protect his clients' interests.
- j) On February 5, 2018, the USPTO mailed to Respondent a Notice of Abandonment in the First Provisional Application, as no response to the NFMP had been received.
- k) Respondent received the Notice of Abandonment or reasonably should have been aware of the Notice of Abandonment.
- l) Despite having reasonable time and opportunity to do so, Respondent did not inform Mr. Montgomery or anyone else at Mycroft of the Notice of Abandonment in the First Provisional Application, Respondent did not communicate its contents to them, and Respondent did not take reasonable steps in response to the Notice of Abandonment to protect his clients' interests.

#### First Non-provisional Patent Application

- m) Respondent filed a U.S. Non-provisional Patent Application ("the First Non-provisional Application") on May 25, 2018, on behalf of Mr. Montgomery and Mycroft, which stated that it claimed the benefit of the First Provisional Application.
- n) Respondent knew or reasonably should have known that the First Provisional Application was abandoned at the time he filed the First non-provisional Application, and that a claim of benefit to the First Provisional Application would likely be ineffective unless the First Provisional Application was revived.
- o) Despite having reasonable time and opportunity to do so, Respondent did not inform Mr. Montgomery or anyone else at Mycroft of the NFMP in the First Provisional Application, Respondent did not communicate its contents to them, Respondent did not communicate the necessity of additional steps to secure an effective claim of benefit to the First Provisional Application, and Respondent did not take reasonable steps in response to the NFMP to protect his clients' interests.
- p) Respondent knew or reasonably should have known that this claim of benefit would likely be ineffective, as that the USPTO had already mailed to him a Notice of Abandonment in the First Provisional Application at the time the application was submitted. Respondent did not inform Mr. Montgomery or anyone else at Mycroft that the claim of benefit would likely be ineffective in the First Non-provisional Application, and Respondent did not take reasonable steps to protect his clients' interests.

#### Client Communications after the Filing of the First Non-provisional Application

- q) Mycroft employees made inquiries to Respondent by email and telephone between May 25, 2018 and late summer 2019 regarding the First Non-provisional Application, but Respondent did not respond.
- r) Mr. Montgomery and Mycroft were not aware that the First Provisional Application was filed without the necessary fees or that it had gone abandoned.
- s) Mr. Montgomery and Mycroft had paid all invoices received from Respondent and/or his firm.
- t) When OED inquired as to the records of client funds required by 37 C.F.R. § 11.115(f), Respondent indicated that he did not maintain these records, and he did not identify the disposition of funds paid by his clients but not remitted to the USPTO.

#### ██████████ the Treger and JEE Investments Representation

- u) Prior to June 9, 2016, Mr. Steven Treger hired Respondent and his law firm, FreeState Patent Services, to perform patent legal services on his behalf and on behalf of his company, JEE Investments, LLC (“JEE Investments”).

#### Second and Third Provisional Patent Applications

- v) Respondent filed two U.S. Provisional Patent Applications (“the Second and Third Provisional Patent Applications”) on June 9, 2016, identifying Mr. Treger and Mr. Aaron Moncur as the named inventors.
- w) Despite having reasonable time and opportunity to do so, Respondent did not advise Mr. Treger, Mr. Moncur, or anyone else at JEE Investments that a provisional patent application is not examined by the USPTO or that a patent cannot be issued from the mere filing of a provisional patent application.
- x) Despite having reasonable time and opportunity to do so, Respondent did not inform Mr. Treger, Mr. Moncur, or anyone else at JEE Investments as to the consequences of filing a provisional patent application and then not filing to file a non-provisional patent application within one year. Nor did Respondent explain the deadlines for filing a non-provisional application in order to claim the benefit of the filing date of a provisional application.
- y) Neither Respondent nor anyone else filed an associated non-provisional patent application within one year of the filing of the Second and Third Provisional Patent Applications, and no petition seeking an extension of time to claim the benefit of an earlier-filed provisional applications was filed.

#### Second Non-provisional Patent Application

- z) Prior to November 2016, JEE Investments and Mr. Treger provided Respondent with a prototype of the invention they sought to be patented.

- aa) Respondent filed a U.S. Non-provisional Patent Application (“the Second Non-provisional Patent Application”) on November 6, 2016, naming Mr. Treger, Ms. Evelyn Treger, and Mr. Philip Baron as the joint inventors. Respondent assigned the Second Non-provisional Patent Application to JEE Investments.
- bb) Prior to filing the Second U.S. Non-provisional Patent Application, Respondent received funds for paying the USPTO filing fees for the application.
- cc) Respondent did not submit the filing fee to the USPTO when he filed the Second U.S. Non-provisional Patent Application, or at any other time prior to October 19, 2017.
- dd) Despite having reasonable time and opportunity, Respondent did not inform the Mr. Treger, Ms. Treger, Mr. Baron, or anyone else at JEE Investments that he did not submit the USPTO filing fees when filing the Second Non-provisional Patent Application.
- ee) On November 15, 2016, the USPTO mailed to Respondent an NFMP in the Second Non-provisional Patent Application. The NFMP specified that the USPTO had not received the basic filing fee, search fee, and examination fee relating to the Second Non-provisional Patent Application, and that the fees remained due, in addition to a \$70 surcharge. The NFMP also noted that two replacement drawings would be required, and that no properly executed inventor’s oath or declaration had been received from Mr. Treger, Ms. Treger, or Mr. Baron. The NFMP further specified that Respondent had two months from the date of the NFMP to file the missing items, *i.e.*, the fees, surcharge, and drawings, to avoid abandonment of the Second Non-provisional Patent Application.
- ff) Respondent received the NFMP in the Second Non-provisional Patent Application or reasonably should have been aware of the NFMP.
- gg) Despite having reasonable time and opportunity, Respondent did not inform Mr. Treger, Ms. Treger, Mr. Baron, or anyone else at JEE Investments of the NFMP in the Second Non-provisional Patent Application, Respondent did not communicate its contents to them, and Respondent did not take any steps in response to the NFMP to protect his clients’ interests.
- hh) On July 19, 2017, the USPTO mailed to Respondent a Notice of Abandonment in the Second Non-provisional Patent Application stating that no response to the NFMP had been received.
- ii) Respondent received the Notice of Abandonment in the Second Non-provisional Patent Application or reasonably should have been aware of the Notice of Abandonment.
- jj) On October 19, 2017, Respondent filed a Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(a) (“a Petition to

Revive”). Respondent paid the missing fees, the \$70 surcharge specified by the NFMP, and the \$850 petition fee.

kk) On January 25, 2018, the USPTO mailed to Respondent a Decision on Petition dismissing the Petition to Revive for failure to include the corrected drawing.

ll) Respondent received the Decision on Petition or reasonably should have been aware of the notice of abandonment

mm) Despite having reasonable time and opportunity, Respondent did not inform Mr. Treger, Ms. Treger, Mr. Baron, or anyone else at JEE Investments of the Notice of Abandonment or the Decision on Petition in the Second Non-provisional Patent Application, Respondent did not communicate its contents to them, and Respondent did not take necessary and reasonable steps in response to the Notice of Abandonment or the Decision on Petition to protect his clients’ interests.

nn) Despite having reasonable time and opportunity, Respondent has failed to return the prototype to JEE Investments or Mr. Treger, despite repeated requests that Respondent do so.

oo) When OED inquired as to the records of client funds required by 37 C.F.R. § 11.115(f), Respondent indicated that he did not maintain these records, and he did not identify the disposition of funds paid by his clients but not remitted to the USPTO.

3. Respondent is aware that the OED Director is of the opinion based on these investigations that he violated the following provisions of the USPTO Rules of Professional Conduct: 37 C.F.R. §§ 11.101 (duty of competence); 11.102 (scope of representation and allocation of authority between client and practitioner); 11.103 (duty of diligence); 11.104 (duty of communication); 11.105(b) (duties regarding communicating scope of representation, fees, and expenses); 11.115 (duties to safekeep property and maintain required records); 11.116 (duties in terminating representation); 11.804(c) (proscribing conduct involving dishonesty, fraud, deceit, or misrepresentation); 11.804(d) (proscribing conduct prejudicial to the administration of justice); and 11.804(i) (proscribing other conduct that adversely reflects on the practitioner’s fitness to practice before the Office).

4. Without admitting to violating any of the disciplinary rules of the USPTO Rules of Professional Conduct investigated by the OED Director in OED File Nos. [REDACTED] and [REDACTED] Respondent acknowledges that, if and when he applies for reinstatement under 37 C.F.R. § 11.60 to practice before the USPTO in patent, trademark, and/or other non-patent matters, the OED Director will conclusively presume, for the purpose of determining the application for reinstatement, that:

(a) the facts and allegations regarding Respondent in OED File Nos. [REDACTED] and [REDACTED] are true, and

(b) he could not have successfully defended himself against the allegations embodied in the opinion of the OED Director that he violated 37 C.F.R. §§ 11.101 (duty of competence), 11.102 (scope of representation and allocation of authority between client and practitioner), 11.103 (duty of diligence), 11.104 (duty of communication), 11.105(b) (duties regarding communicating scope of representation, fees, and expenses), 11.115 (duties to safekeep property and maintain required records), 11.116 (duties in terminating representation), 11.804(c) (proscribing conduct involving dishonesty, fraud, deceit, or misrepresentation), 11.804(d) (proscribing conduct prejudicial to the administration of justice), and 11.804(i) (proscribing other conduct that adversely reflects on the practitioner's fitness to practice before the Office).

5. Respondent has fully read and understands 37 C.F.R. §§ 11.5(b), 11.27, 11.58, 11.59, and 11.60, and is fully aware of the legal and factual consequences of consenting to exclusion from practice before the USPTO in patent, trademark, and other non-patent matters.

6. Respondent consents to being excluded from practice before the USPTO in patent, trademark, and other non-patent matters.

#### **Exclusion on Consent**

Based on the foregoing, the USPTO Director has determined that Respondent's Affidavit of Resignation complies with the requirements of 37 C.F.R. § 11.27(a). Accordingly, it is hereby ORDERED that:

1. Respondent's Affidavit of Resignation shall be, and hereby is, approved;
2. Respondent shall be, and hereby is, excluded on consent from practice before the Office in patent, trademark, and other non-patent matters commencing on the date of this Final Order;
3. The OED Director shall electronically publish the Final Order at the Office of Enrollment and Discipline's electronic FOIA Reading Room, which is publicly accessible at <https://foiadocuments.uspto.gov/oed/>;
4. The OED Director shall publish a notice in the *Official Gazette* that is materially consistent with the following:

#### **Notice of Exclusion on Consent**

This notice concerns John E. Gibson, a registered patent attorney (Registration No. 52,944). The Director of the United States Patent and Trademark Office ("USPTO" or "Office") has accepted Mr. Gibson's affidavit of resignation and ordered his exclusion on consent from practice before the Office in patent, trademark, and non-patent law.

Mr. Gibson voluntarily submitted his affidavit at a time when disciplinary investigations were pending against him. The investigations concerned neglect of clients' provisional and non-provisional patent applications, failure to explain to clients the distinction between provisional and non-provisional patent applications, failure to respond to reasonable client inquiries and otherwise keep clients informed of the status of their matters, failure to safekeep property, failure to take reasonable steps to protect client interests in terminating representation, conduct involving dishonesty, fraud, deceit, or misrepresentation, and conduct prejudicial to the administration of justice. Mr. Gibson acknowledged that the OED Director was of the opinion that his conduct violated 37 C.F.R. §§ 11.101 (duty of competence), 11.102 (scope of representation and allocation of authority between client and practitioner), 11.103 (duty of diligence), 11.104 (duty of communication), 11.105(b) (duties regarding communicating scope of representation, fees, and expenses), 11.115 (duties to safekeep property and



maintain required records), 11.116 (duties in terminating representation), 11.804(c) (proscribing conduct involving dishonesty, fraud, deceit, or misrepresentation), 11.804(d) (proscribing conduct prejudicial to the administration of justice), and 11.804(i) (proscribing other conduct that adversely reflects on the practitioner's fitness to practice before the Office).

While Mr. Gibson did not admit to violating any of the disciplinary rules of the USPTO Rules of Professional Conduct as alleged in the pending investigations, he acknowledged that, if and when he applies for reinstatement, the OED Director will conclusively presume, for the limited purpose of determining the application for reinstatement, that (i) the facts set forth in the OED investigations against him are true, and (ii) he could not have successfully defended himself against the allegations embodied in the opinion of the OED Director that he violated 37 C.F.R. §§ 11.101 (duty of competence), 11.102 (scope of representation and allocation of authority between client and practitioner), 11.103 (duty of diligence), 11.104 (duty of communication), 11.105(b) (duties regarding communicating scope of representation, fees, and expenses), 11.115 (duties to safekeep property and maintain required records), 11.116 (duties in terminating representation), 11.804(c) (proscribing conduct involving dishonesty, fraud, deceit, or misrepresentation), 11.804(d) (proscribing conduct prejudicial to the administration of justice), and 11.804(i) (proscribing other conduct that adversely reflects on the practitioner's fitness to practice before the Office).

This action is taken pursuant to the provisions of 35 U.S.C. §§ 2(b)(2)(D) and 32, and 37 C.F.R. §§ 11.27 and 11.59. Disciplinary decisions involving practitioners are posted for public reading at the Office of Enrollment and Discipline Reading Room, available at: <https://foiadocuments.uspto.gov/oed/>;

5. Respondent shall comply fully with 37 C.F.R. § 11.58; and

6. Respondent shall comply fully with 37 C.F.R. § 11.60 upon any request for reinstatement.



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

18 May 2020

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Date

on delegated authority by

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

cc:

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

Mr. John E. Gibson  
FreeState Patent Service  
P.O. Box 1070  
Lawrence, KS 66044  
[REDACTED]