

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

In the Matter of

Stewart L. Gitler,

Respondent.

Proceeding No. D2019-48

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

Pursuant to 37 C.F.R. § 11.24, Stewart L. Gitler is hereby suspended for 90 days from the practice of patent, trademark, and other non-patent matters 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 duly constituted authorities of the District of Columbia.

**I. Background**

Gitler is licensed to practice law in Virginia, the District of Columbia, and New York and is a registered practitioner before the USPTO. (Complaint, at 2, ¶ 1; OED Director Response, at 1). On May 13, 2019, Gitler and the Virginia State Bar stipulated to facts regarding Gitler’s breach of Virginia Rule of Professional Conduct 8.4 and agreed to negotiated discipline suspending Gitler from the practice of law for ninety days, beginning on May 8, 2019. (Complaint (Ex. B)). Respondent notified USPTO’s Office of Enrollment and Discipline (“OED”) of his Virginia suspension on May 29, 2019. (OED Director Response, at 3-4). Based on Virginia’s suspension, the District of Columbia imposed reciprocal discipline effective on June 10, 2019. (OED Director Response, at 1); *see In re Stewart L. Gitler*, No. 19-BG-449 (D.C. 2019). On August 28, 2019, the Director of the Office of Enrollment and Discipline (“OED Director”) filed

a “Complaint for Reciprocal Discipline Pursuant to 37 C.F.R. § 11.24” (“Complaint”) requesting that the Director of the USPTO also impose reciprocal discipline.

In response to the complaint, Gitler “does not dispute any facts found or any discipline imposed by the District of Columbia Court of appeals” and does not contest that reciprocal discipline is appropriate. (Response to Notice and Order at 1). Gitler does, however, request that his reciprocal suspension be imposed *nunc pro tunc* under 37 C.F.R. § 11.24, that is imposed retroactively so that his USPTO suspension will be deemed to have run concurrently with his District of Columbia suspension.<sup>1</sup> He also requests that, if necessary, the Director waive certain requirements for imposing discipline *nunc pro tunc* and that the Director waive certain conditions of reinstatement to practice under 37 C.F.R. § 11.60. (Reply Brief, at 20). For the reasons stated below, Gitler is ineligible for discipline to be imposed *nunc pro tunc*; the Director declines to waive the requirements for discipline *nunc pro tunc*; and the Director denies in part and grants in part Gitler’s request to waive § 11.60.

## **II. Discussion**

### **A. Eligibility for *Nunc Pro Tunc* Discipline**

When another jurisdiction or Federal agency disciplines a USPTO practitioner, “the USPTO Director ... *shall* impose ... identical” reciprocal discipline except in limited circumstances not applicable here. 37 C.F.R. § 11.24(d) (emphasis added). Practitioners subject to reciprocal discipline may request that discipline be imposed *nunc pro tunc*. 37 C.F.R. § 11.24(f). The Director may impose discipline “*nunc pro tunc only if* the practitioner promptly notified the OED Director of his or her ... [discipline] in another jurisdiction, and establishes by

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<sup>1</sup> A judgement *nunc pro tunc* is one “entered on a day after the time when it should have been entered, replacing that entered on the earlier date.” *See* Judgement, Black’s Law Dictionary (11th ed. 2019).

clear and convincing evidence that the practitioner voluntarily ceased all activities related to practice before the Office and complied with all” the duties of a suspended practitioner provided in § 11.58. *Id.* (emphasis added). Practitioners must satisfy § 11.24 and § 11.58 “*entirely, not just substantially*” to be eligible for *nunc pro tunc* reciprocal discipline. See *In re Levine*, Proceeding No. D2015-21, at 9 (USPTO Aug. 1, 2016) (emphasis added).

Among other things, § 11.58 requires that suspended practitioners:

“File a notice of withdrawal as of the effective date of the ... suspension ... in each pending patent and trademark application, each pending reexamination and interference or trial proceeding, and every other matter pending in the Office. ...” 37 C.F.R. § 11.58(b)(1)(i);

“Provide notice to all State and Federal jurisdictions and administrative agencies to which the practitioner is admitted to practice and all clients the practitioner represents having immediate prospective business before the Office ... of the order of [suspension] and of the practitioner’s consequent inability to act as a practitioner. ...” 37 C.F.R. § 11.58(b)(1)(ii); and

“Take any necessary and appropriate steps to remove from any telephone, legal, or other directory any advertisement, statement, or representation which would reasonably suggest that the practitioner is authorized to practice patent, trademark, or other non-patent law before the Office.” 37 C.F.R. § 11.58(b)(1)(vi).

Gitler is ineligible for *nunc pro tunc* discipline because he has not proven that he complied with these requirements.

First, Gitler admits that he failed to withdraw from pending cases before the USPTO as required by 37 C.F.R. § 11.58(b)(1)(i).<sup>2</sup> (Reply Brief, at 8-9). Instead, Gitler states that his USPTO customer number “is shared by ... [Gitler] and two other attorneys” at his firm. (Reply Brief, at 9). As a result, he “did not believe it was necessary for him to file a notice of his individual withdrawal because his two partners are associated with that customer number and remained as counsel in the pending matters” and his clients had all been notified of his

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<sup>2</sup> An independent investigation by OED confirms that he did not. (OED Director Response, at 5).

suspension. (Reply Brief, at 8-9). The fact that Gitler's partners used his customer number is not relevant to 37 C.F.R. § 11.58(b)(1)(i) and does not excuse his failure to withdraw from pending matters. Since Gitler admitted that he did not comply with § 11.58(b)(1)(i), he has failed to demonstrate that he is eligible for reciprocal discipline *nunc pro tunc* under § 11.24(f).<sup>3</sup>

Second, Gitler offers no evidence that he notified New York of his suspensions by Virginia and the District of Columbia, as required by § 11.58(b)(1)(ii). Gitler argues only that New York had *notice* of his Virginia and District of Columbia suspensions, pointing to a New York Supreme Court order directing him to show cause why New York should not also impose reciprocal discipline. (Reply Brief, at 11-12). However, the fact that New York *had* notice of Gilbert's discipline by Virginia and the District of Columbia is not enough. Section 11.58(b)(1)(ii) requires that *the "practitioner ... [p]rovide notice."* *Id.* (emphasis added). Gitler does not point to any evidence that *he* provided New York notice of his Virginia and District of Columbia suspensions and none is apparent from the record. Accordingly, Gitler has failed to show that he complied with 37 C.F.R. § 11.58(b)(1)(ii) and, for this reason too, is ineligible for reciprocal discipline *nunc pro tunc* under § 11.24(f).

Lastly, Gitler has not proven that he took "necessary and appropriate steps" to remove attorney advertisements during his suspension as required by § 11.58(b)(1)(vi). During his

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<sup>3</sup> In a footnote, Gitler argues that it was not possible to satisfy 37 C.F.R. § 11.58(b)(1)(i), because the requirement to withdraw is triggered by an order of discipline from the USPTO, which had yet to issue. (Respondent Brief, at 8 n.2). The argument is unpersuasive. The requirement to withdraw in § 11.58(b)(1)(i) is triggered by "the effective date of the ... suspension," not an order from USPTO. Section 11.24(f) provides that the effective date of a *nunc pro tunc* suspension "shall be the date the practitioner voluntarily ceased all activities related to practice before the Office." In other words, the date to which the Director can backdate Gitler's suspension is "the effective date of ... suspension" which is "the date [Gitler] ... ceased ... practice before the Office," not the date on which any order actually issues. *Id.* Gitler's failure to "cease[] ... practice" before USPTO, by, among other things, failing to withdraw from USPTO matters, means that there is no earlier effective date of his discipline to which his suspension may be back dated. Thus, he is ineligible for discipline *nunc pro tunc*.

suspension, Gitler's biography remained on his firm's website advertising that he was authorized to practice before USPTO. (OED Director Response, at 8-10; OED Director Response, Attach. 4). Gitler concedes this fact, but argues that he was unaware that his biography remained active and that his failure to have it removed was an "honest mistake." (Reply Brief, at 14). Honest though his mistake may have been, his duty was to take reasonable steps, not just honest ones. It would have been easy for Gitler to verify whether his firm removed his website biography and request that it be removed, even while he was away from the office. Since Gitler offers no evidence that he took such reasonable steps, he has failed to show that he complied with 37 C.F.R. § 11.58(b)(1)(iv) and therefore is ineligible for reciprocal discipline *nunc pro tunc* under § 11.24(f).

#### **B. Request for Waiver**

"In an extraordinary situation, when justice requires," the USPTO Director or his delegee may waive any requirement of the disciplinary regulations which is not a requirement of statute. 37 C.F.R. § 11.3(a). Gitler requests waiver of 37 C.F.R. § 11.58(b)(1)(i) and (vi), and in the alternative, § 11.60. (Reply Brief, at 6). His request is denied in part and granted in part.

##### **1. Request for Waiver of § 11.58**

Gitler's request to waive § 11.58(b)(1)(i) and (vi) is denied, because waiving those provisions would not change the result of these proceedings. Under § 11.24(f), Gitler bears the burden of proving compliance with *all* the requirements of § 11.58. Even if the Director were to waive the requirements of § 11.58(b)(1)(i) and (vi), Gitler would remain ineligible for *nunc pro tunc* discipline because, as explained above, he has failed to prove compliance with § 11.58(b)(1)(ii). Accordingly, granting his request to waive to other parts of § 11.58 would serve no purpose.

Furthermore, even if Gitler had requested a broader waiver, it would not be granted. Although USPTO has sometimes granted waivers of disciplinary rules, waiver is strongly disfavored and will not be granted for circumstances that “could have been prevented by the exercise of ordinary care or diligence.” *See Nitto Chemical Indus. Co. v. Comer*, 39 U.S.P.Q. 2d 1778 (D.D.C. 1994). Indeed, the Office has said that the fact that the rules leave open the possibility of waiver “should not be construed as an indication that there could ever be any extraordinary situation when justice requires waiver of a disciplinary rule.” 73 Fed. Reg. 47,650, 47,651 (Aug. 14, 2008). And, in issuing § 11.3, the only example the Office provided in which waiver might be appropriate was when “a flood or fire” prevented an applicant from timely submitting information for an application to practice before the Office. *Id.* at 47,651.

Gitler offers no compelling reason to grant a waiver of § 11.58 here. He argues that he complied with the “spirit and purpose” of § 11.58(b)(1)(i) by ceasing practice before the USPTO and by notifying his clients of the suspension. (Reply Brief, at 10.) He reiterates that he “did not believe that filing a notice of withdrawal was necessary,” because he shared a customer number with his partners. (*Id.*) However, a practitioner’s misunderstanding of the rules or compliance with the “spirit and purpose” of a rule does not constitute circumstances justifying a waiver. Similarly, Gitler argues for waiver of § 11.58(b)(1)(vi), because he ceased practice before the Office in good faith and was unaware that his biography remained on his firm’s website during his suspension. (*Id.*) Gitler’s lack of awareness of the status of his biography on his firm’s website is not an extraordinary situation. Section 11.58(b)(1)(vi) requires practitioners to take “reasonable” steps to remove attorney advertising, which includes maintaining a reasonable awareness of such advertising. Accordingly, Gitler’s requests to waive § 11.58(b)(1)(i) and (vi) are denied.

## 2. Request for Waiver of § 11.60

Under § 11.60, a suspended practitioner may “not resume practice” before the Office until reinstated by the OED Director and may “apply for reinstatement only upon expiration of the period of [his or her] suspension,” demonstrating “full compliance with § 11.58,” and payment of a fee. 37 C.F.R. § 11.60(a)-(c). Finally, “[b]efore reinstating any excluded or suspended practitioner, the OED Director shall publish a notice of the excluded or suspended practitioner’s petition for reinstatement and shall permit the public a reasonable opportunity to comment or submit evidence with respect to the petition for reinstatement.” *Id.* at § 11.60(g).

Gitler argues that the Director should waive § 11.60, because he already served the 90-day suspension imposed by Virginia and the District of Columbia, and he ceased all practice before the USPTO during that time. (Reply Brief, at 18). He claims that requiring him to file for reinstatement would extend the period of his suspension and cause his suspension to exceed the identical discipline imposed by § 11.24. (Reply Brief, at 19). He also claims that the reinstatement fee is extraordinary in light of the fact that Gitler ceased all legal work for a period of 90 days. (*Id.*)

None of these facts are extraordinary. Rather, they are the ordinary consequence USPTO’s rules and Gitler’s failure to prove eligibility for *nunc pro tunc* discipline. Waiver here would be especially inappropriate since Gitler still has not established compliance with § 11.58. Section 11.58 describes the duties of a suspended practitioner and a suspension without compliance with § 11.58 would be of little practical consequence. Accordingly, except as described below, Gitler’s request to waive § 11.60 is denied.

Section 11.60’s prohibition on seeking reinstatement until the end of a suspension combined with its requirement for a public comment period prior to reinstatement prolongs suspended

practitioners' discipline significantly beyond the ordered suspension period. To better align the period of suspensions ordered with the actual time practitioners are excluded from practice, the Office has proposed amending its regulations "to allow a notice of a practitioner's intent to seek reinstatement to be published [for public comment] prior to the expiration date of the suspension or exclusion." *See Changes to Representation of Others Before the United States Patent and Trademark Office*, 85 Fed. Reg. 45,812, 45,817 (July 30, 2020). For the same reason, the Office has, in other similar cases, waived § 11.60(g). *See, e.g., In re Levine*, Proceeding No. D2015-21, at 10. The proposed change to USPTO's regulations and the history of the Office's treatment of § 11.60(g) in prior cases constitute an extraordinary circumstance under § 11.3. Therefore, as provided below, § 11.60(g) is waived.

### ORDER

ACCORDINGLY, it is ORDERED that:

1. Stewart L. Gitler is suspended from the practice of patent, trademark, and other non-patent law for ninety (90) days effective the date of this order;
2. The OED Director shall publish a Notice in the Official Gazette that is materially consistent with the following:

#### Notice of Suspension

This notice concerns Stewart L. Gitler of Alexandria, Virginia, who is a registered patent attorney (Registration Number 31,256). In a reciprocal disciplinary proceeding, the Director of the United States Patent and Trademark Office ("USPTO") has ordered that Mr. Gitler be suspended for a period of 90 days from practice before the USPTO in patent, trademark, and other non-patent matters for violating 37 C.F.R. § 11.804(h), predicated upon being suspended from the practice of law by a duly constituted authority of the District of Columbia.

The District of Columbia suspended Mr. Gitler from the practice of law for a period of 90 days based on its reciprocal discipline arising from his



suspension from practice in Virginia based on misconduct related to his forgery and notarization of certain documents in a European patent application. The Virginia State Bar found violations of its rules 8.4(b) (criminal or deliberately wrongful act that reflects adversely on honesty, trustworthiness, or fitness to practice law) and 8.4(c) (dishonesty, fraud, deceit or misrepresentation that reflects adversely on fitness to practice law).

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 Gitler is admitted to practice, to courts where Gitler is known to be admitted, and to the public;

4. Gitler shall comply with the duties enumerated in 37 C.F.R. § 11.58;

5. Except as stated in this Order, Gitler shall not resume practice before the Office until reinstated by order of the OED Director or the USPTO Director as set forth in 37 C.F.R. § 11.60;

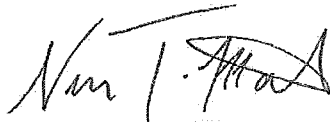
6. The provision of 37 C.F.R. § 11.60(g) is waived pursuant to 37 C.F.R. § 11.3(a) and Gitler is permitted to file written notice of his intent to seek reinstatement with the OED Director and request that such notice be published prior to the expiration of the 90-day suspension; and

7. The USPTO shall dissociate Gitler's name from any Customer Number(s) and USPTO verified Electronic System account(s), if any.

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.

8/11/2020  
Date



Nicholas T. Matich IV  
Acting 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