

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

In the Matter of)	
)	
Joel Henry,)	Proceeding No. D2025-09
)	
Respondent)	
<hr/>)	

FINAL ORDER PURSUANT TO 37 C.F.R. § 11.26

The Director of the Office of Enrollment and Discipline (“OED Director”) for the United States Patent and Trademark Office (“USPTO” or “Office”) and Mr. Joel Henry (“Respondent”) have submitted a Proposed Settlement Agreement (“Agreement”) to the Acting Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (“USPTO Director”) for approval.

The Agreement, which resolves all disciplinary action by the USPTO arising from the stipulated facts set forth below, is hereby approved. This Final Order sets forth the parties’ stipulated facts, legal conclusions, and sanctions.

Jurisdiction

1. Respondent of Missoula, Montana, is an attorney who is licensed in Montana and Wyoming and who practices before the Office in trademark matters.
2. Respondent is subject to the USPTO Rules of Professional Conduct, 37 C.F.R. § 11.101 *et seq.*
3. The USPTO Director has jurisdiction over this matter pursuant to 35 U.S.C. §§ 2(b)(2)(D) and 32 and 37 C.F.R. §§ 11.19, 11.20, and 11.26.

Joint Stipulated Facts

4. Respondent is as an attorney licensed to practice law in Wyoming and Montana.
Respondent is not registered to practice before the Office in patent matters.
5. At all relevant times, Respondent was a business lawyer with a relationship with registered practitioners to whom Respondent would refer clients seeking to file design or utility patent applications.
6. At all relevant times, Respondent did not fully understand or appreciate the breadth of 37 C.F.R. § 11.5(b)(1) regarding the definition of practice before the Office in patent matters.
7. Respondent acknowledged providing input and assistance in preparing and filing of the seven (7) provisional patent applications over a forty-six month period between March 2018 through October 2022 for some of his business clients with the clients' knowledge and permission and at the clients' express direction.
8. Respondent represents that his involvement with the seven provisional patent applications were not filed (a) with the intent to violate any USPTO rule or regulation, or (b) for financial gain (i.e., the clients were not charged for this service).
9. Once OED explained the scope of 37 C.F.R. § 11.5(b)(1) to Respondent, he immediately expressed a commitment not to engage in practice before the Office in patent matters.

Additional Considerations

10. Respondent cooperated fully with OED's investigation, including participating in an online interview.
11. Respondent has acknowledged his lack of understanding of what constitutes practice before the Office in patent matters, demonstrated genuine contrition, and accepted responsibility for his acts and omissions.

Joint Legal Conclusions

12. Respondent acknowledges that, based on the information contained in the joint stipulated facts, above, that his assisting in preparing and filing seven (7) provisional patent applications over a forty-six month period between March 2018 through October 2022 violated 37 C.F.R. § 11.505.

Agreed-Upon Sanction

13. Respondent has freely and voluntarily agreed, and it is hereby ORDERED that:
- a. Respondent be publicly reprimanded;
 - b. The OED Director electronically publish the Final Order at the OED's electronic FOIA Reading Room, which is publicly accessible through the Office's website at: <https://foiadocuments.uspto.gov/oed/>;
 - c. The OED Director shall publish a notice in the *Official Gazette* that is materially consistent with the following:

Notice of Public Reprimand

This notice concerns Joel Henry of Missoula, Montana, who is licensed to practice law in Montana and Wyoming and practices before the Office in trademark matters. Mr. Henry is not registered to practice before the Office in patent matters. The USPTO Director publicly reprimanded Mr. Henry for violating 37 C.F.R. § 11.505, engaging in the unauthorized practice of patent law, predicated on providing input and assistance in preparing and filing of seven (7) provisional patent applications over a forty-six month period between March 2018 through October 2022 for some of his business clients with the clients' knowledge and permission and at the clients' express direction.

This action is the result of a settlement agreement between Joel Henry and the OED Director pursuant to the provisions of 35 U.S.C. §§ 2(b)(2)(D) and 32 and 37 C.F.R. §§ 11.19, 11.20, and 11.26. Disciplinary decisions involving practitioners are posted for public reading at the Office of Enrollment and Discipline Reading Room accessible at: <https://foiadocuments.uspto.gov/oed/>;

- d. Nothing in this Final Order shall prevent the Office from considering the record of this disciplinary proceeding, including the Final Order: (1) when addressing any further complaint or evidence of the same or similar misconduct concerning Respondent brought to the attention of the Office; (2) in any future disciplinary

proceeding against Respondent (i) as an aggravating factor to be taken into consideration in determining any discipline to be imposed, and/or (ii) to rebut any statement or representation by or on Respondent's behalf;

e. Based on Respondent's agreement to do so, Respondent waives all rights to seek reconsideration of the Final Order under 37 C.F.R. § 11.56, waives the right to have the Final Order reviewed under 37 C.F.R. § 11.57, and waives the right otherwise to appeal or challenge the Final Order in any manner; and

f. Each party shall each bear their own costs incurred to date and in carrying out the terms of the Agreement and this Final Order.

Users,
Seifert,
Jennifer

Digitally signed
by Users,
Seifert, Jennifer
Date:
2024.12.18
11:57:14 -05'00'

Jennifer R. Seifert
Associate General Counsel for General Law
United States Patent and Trademark Office

Date

on delegated authority by

Derrick L. Brent
Acting Under Secretary of Commerce for Intellectual Property and
Acting Director of the United States Patent and Trademark Office

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that the foregoing Final Order was sent, on this day, to the parties in the manner indicated below-

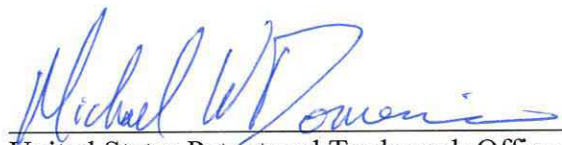
Via first-class certified mail, return receipt requested:

Mr. Joel E. Henry
Hall Booth Smith, PC
101 E. Front Street
Missoula, MT 59802
Respondent

Via e-mail:

Sydney Johnson
[REDACTED]
SO-OEDcases@uspto.gov
Counsel for the OED Director

12/18/2024
Date


United States Patent and Trademark Office
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