

In Re

¹ The instant Petition is filed pro se and is titled “Inequitable procedures within the Office of Enrollment and Discipline.” It argues against the OED Director’s April 6, 2011, decision declining to reinstate Petitioner and is treated herein as if it is an attempted petition for review of that decision pursuant to 37 C.F.R. § 11.2(d).

37 C.F.R. § 10.11(b)² and mailed on November 20, 1987, to all practitioners whose last name began with a letter of the alphabet from E to J. The survey letter and data sheet were mailed to Petitioner's last address of record on file with the Office of Enrollment and Discipline (OED).³ Public Notice of the survey letter was also published in the Official Gazette on December 29, 1987. As Petitioner did not respond to the November 1987 survey letter or data sheet, his name was removed from the register in accordance with former 37 C.F.R. § 10.11(b). Public Notice of his removal from the register was also published in the Official Gazette on July 5, 1988.

Petitioner first sought reinstatement over ten years later in a Petition dated April 28, 1999, which the OED Director denied in a September 16, 1999 decision. Petitioner did not timely appeal that decision.

Petitioner now seeks reinstatement again. On November 1, 2010, Petitioner submitted a two-page "Application for Registration To Practice Before the United States Patent and Trademark Office," requesting reinstatement to the active register. On February 4, 2011, OED staff denied Petitioner's request for reinstatement, finding that he "did not provide evidence with [his] request for reinstatement dated November 1, 2010 demonstrating that [he] continue[d] to possess the necessary qualifications." Petitioner timely petitioned the OED Director to review the OED staff decision under 37 U.S.C. § 11.7(c), on March 14, 2011. At the same time, he submitted a "Petition to the USPTO Director for review of the OED Director's presumed adverse decision in this matter." Therein he indicated that he would be

² In 2004, § 10.11 was revised by deleting paragraph (a) and deleting the designation (b) of paragraph (b). *See* 69 Fed.Reg. 35428-01.

³ Between 1973 and 1981, Petitioner filed two address changes with the Office. As of 1988, Petitioner's last known address of record indicated an address at [REDACTED]. Petitioner was required to maintain a current address of record with OED under former 37 C.F.R. § 10.11(a). That obligation is now codified at 37 C.F.R. § 11.11(a).

“out of the country for several months” beginning in the middle of March, 2011, and would be unable to timely respond should the OED Director decide his Petition within that time period.

In an April 6, 2011, final decision, the OED Director affirmed the OED staff decision and denied Petitioner’s request for reinstatement. Petitioner’s March 14, 2011 “Petition to the USPTO Director for review of the OED Director’s presumed adverse decision in this matter” was treated as a request under 37 C.F.R. § 11.3 that the OED Director waive the requirements under 37 C.F.R. § 11.2(d) that an appeal be filed in the 30-day appeal period after issuance of an OED Director decision. That request was also denied in the April 6, 2011 decision.

The April 6, 2011, decision informed Petitioner that he may seek an appeal by filing a Petition to the Director of the USPTO pursuant to 37 C.F.R. § 11.2(d) within thirty (30) days after the date of the decision.

Petitioner filed the instant Petition for review of the OED Director’s April 6, 2011 decision on March 21, 2012, which is over ten months past the deadline for appeal.

II. LEGAL STANDARD

The USPTO possesses authority to establish regulations governing the recognition of all practitioners, foreign and domestic, before the Office pursuant to 35 U.S.C. § 2(b)(2)(D). That provision states that the Director may establish regulations which:

may govern the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Office, and may require them, before being recognized as representatives of applicants or other persons, to show that they *are of good moral character and reputation and are possessed of the necessary qualifications to render to applicant or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office.* (Emphasis added).

By regulation, the USPTO keeps a register of attorneys and agents on which are entered the names of all individuals recognized as entitled to represent applicants in the preparation and prosecution of patent applications. 37 C.F.R. § 11.5(a). “Registration under the provisions of this part shall entitle the individuals so registered to practice before the Office only in patent matters.” *See id.*

The OED Director receives and acts on applications for registration. *See* 37 C.F.R. §11.2(b)(2). Requirements for registration to practice before USPTO include filing a complete application for registration and, in relevant part, establishing to the satisfaction of the OED Director that he “[p]ossesses good moral character and reputation, [p]ossesses the legal, scientific, and technical qualifications necessary for him . . . to render applicants valuable service; and [i]s competent to advise and assist patent applicants in the presentation and prosecution of their applications before the Office.” *See* 37 C.F.R. §11.7(a)(1) and (a)(2)(i)-(a)(iii). To enable the OED Director to determine whether an individual has the qualifications specified in §11.7(a)(2), a practitioner shall, *inter alia*, pass the registration examination. *See* 37 C.F.R. §11.7(b).

Taking the registration examination is not limited to initial applications for registration. The Office consistently requires that an individual retake the registration examination in cases where the individual was removed from the register or administratively suspended from practice before the USPTO for two years or more. *See* 37 C.F.R. § 11.7(k) (an applicant who is refused registration for lack of good moral character may reapply two years after the date of the decision refusing registration, and must also retake and pass the registration examination “even though the individual has previously passed a registration examination”); 37 C.F.R. § 8(c) (an individual who does not file a completed Data Sheet, an oath or declaration, and registration fee within two

years of the mailing date of a notice of passing registration examination will be required to retake the registration examination); 37 C.F.R. § 11.11(f)(1) (“A practitioner who has resigned or was administratively suspended for two or more years before the date the Office receives a completed application from the person who resigned or was administratively suspended must also pass the registration examination under §11.7(b)(1)(ii).”)

Where, as here, an individual is removed from the register pursuant to 37 C.F.R. § 10.11 (formerly § 10.11(b)) for failing to respond to a survey, the individual may be reinstated on the register “as may be appropriate.” 37 C.F.R. § 10.11. In such cases, individuals must take and pass the examination registration if five or more years have elapsed since removal from the register. *See Reinstatement of Patent Attorneys and Agents to Practice Before the U.S. Patent and Trademark Office*, 1064 *Off. Gaz. Pat. Office* 12 (March 11, 1986) (“ . . . where the person seeks reinstatement to the register five (5) or more years after his or her name was either removed . . . or endorsed as inactive . . . , that person will be required to again meet the requirements of 37 C.F.R. 10.7 . . . including taking and passing the examination . . . before reinstatement is granted”). This five-year period applicable to removals under 37 C.F.R. § 10.11 is more lenient than the two-year period provided in the other rules cited above.

II. DISCUSSION

A. Petitioner’s Appeal to Director is Untimely Filed.

A party dissatisfied with a final decision of the OED Director regarding enrollment or recognition may seek review of that decision upon Petition to the USPTO Director, accompanied by payment of the appropriate fee. *See* 37 C.F.R. §11.2(d). “Any Petition not filed within thirty days after the final decision of the OED Director may be dismissed as untimely.” *See* 37 C.F.R. §11.2(d). Here, Petitioner did not file a Petition for review of the OED Director’s April 6, 2011,

decision until March 21, 2012.⁴ Petitioner makes no attempt to explain why the Petition is filed 10 months later. As the Petition was filed more than 10 months after the deadline for appealing OED Director's decision, the Petition is untimely and will be dismissed.

B. If the Petition Were Timely, the OED Decision Would Be Affirmed Because Petitioner Has Not Demonstrated, Or Attempted to Demonstrate, That He Meets the Requirements for Reinstatement.

Had Petitioner timely filed for review of the OED Director's decision, and the merits were reached, the decision would be to affirm the OED Director. Petitioner has not presented any evidence demonstrating that he possesses the necessary qualifications for reinstatement to the active register. Nor has he properly applied and shown eligibility for reinstatement under 37 C.F.R. § 10.11 and 11.7, including recent passage of the registration examination.

A patent practitioner, including a non-attorney practitioner, engages in the practice of law before the office. *See Sperry v. State of Florida ex rel. Florida Bar*, 373 U.S. 379, 383, 83 S.Ct. 1322, 1325 (1963). Congress has directed the Office to oversee admission of practitioners in a manner similar to how state supreme courts oversee admission of attorneys to the state bars. *See* 35 U.S.C. § 2(b)(2)(D). It is imperative that an individual who has been removed for 24 years show current competency and otherwise meet the application requirements before being allowed to be reinstated.

⁴ As set forth in the OED Director's April 6, 2011 decision, Petitioner's March 14, 2011 pro se "Petition to the USPTO Director for review of the OED Director's presumed adverse decision in this matter" was not a proper Petition for review under 37 C.F.R. § 11.2(d). The document was premature as it was filed outside of the 30-day period for filing petitions for review. *See* 37 C.F.R. § 11.2(d) (petitions for review must be "filed within thirty days after the final decision of the OED Director.") (Emphasis added). In an effort to give effect to the document, the OED Director reviewed it as if it were a Petition under 37 C.F.R. § 11.3(a) to allow an appeal outside of the 30-day period provided under 37 C.F.R. § 11.2(d). Section 11.3(a) authorizes the OED Director to suspend or waive a requirement "[i]n an extraordinary situation, when justice requires." The OED Director properly found, however, that even if the document were treated as a Petition under § 11.3(a), it would not meet the Petitioner's burden of showing an "extraordinary situation" and an injustice as required by that rule. There was no timely appeal from this decision and the current Petition (which is untimely) presents no argument on this point.

If Petitioner wishes to become reinstated to the active register of authorized practitioners, he must apply for registration and establish to the satisfaction of the OED Director that he presently satisfies the criteria for registration. Those criteria, set forth at 37 C.F.R. § 11.7(a)(2)(i)-(a)(2)(iii), require Petitioner to establish to the satisfaction of the OED Director that he “[p]ossesses good moral character and reputation, [p]ossesses the legal, scientific, and technical qualifications necessary for him . . . to render applicants valuable service; and [i]s competent to advise and assist patent applicants in the presentation and prosecution of their applications before the Office.” Petitioner has presented no evidence to attempt to show that he satisfies these criteria.

Petitioner is also required to again take and pass the registration examination. The Office has consistently required that practitioners retake the registration examination in cases where the individual was removed from the register or administratively suspended from practice before the USPTO for two years or more. *See* 37 C.F.R. § 11.7(k) (an applicant who is refused registration for lack of good moral character may reapply two years after the date of the decision refusing registration, and must also retake and pass the registration examination “even though the individual has previously passed a registration examination”); 37 C.F.R. § 8(c) (an individual who does not file a completed Data Sheet, an oath or declaration, and registration fee within two years of the mailing date of a notice of passing registration examination will be required to retake the registration examination); 37 C.F.R. § 11.11(f)(1) (“A practitioner who has resigned or was administratively suspended for two or more years before the date the Office receives a completed application from the person who resigned or was administratively suspended must also pass the registration examination under §11.7(b)(1)(ii).”)

Where, as here, an individual is removed from the register pursuant to 37 C.F.R. § 10.11 (formerly § 10.11(b)) for failing to respond to a survey, the individual may be reinstated on the register “as may be appropriate.” 37 C.F.R. § 10.11. In these situations, the USPTO takes a more lenient approach by generally requiring individuals to retake and pass the registration examination only if five or more years have elapsed since removal from the register. *See Reinstatement of Patent Attorneys and Agents to Practice Before the U.S. Patent and Trademark Office*, 1064 *Off. Gaz. Pat. Office* 12 (March 11, 1986) (“ . . . where the person seeks reinstatement to the register five (5) or more years after his or her name was either removed . . . or endorsed as inactive . . . , that person will be required to again meet the requirements of 37 C.F.R. 10.7 . . . including taking and passing the examination . . . before reinstatement is granted”). Petitioner’s name was removed from the active register in 1988 pursuant to former 37 C.F.R. § 10.11(b). This occurred 24 years ago, well beyond the five year threshold. Petitioner must properly apply for registration and satisfy the registration requirements set forth in 37 C.F.R. § 11.7, including retaking and passing the registration examination.

Petitioner offers no objective evidence – indeed, no evidence whatsoever – to attempt to show that he has remained current with the numerous changes in patent practices and procedures that have occurred since his name was removed from the register in July of 1988. Rather, his sole argument in favor of reinstatement is to challenge the manner in which he was removed from the register in 1988. The argument is unavailing and inapposite as it does not show current competency under 37 C.F.R. § 11.7 to serve as a practitioner. Specifically, he argues that “no notice was ever given that failure to return [the survey] would be grounds for disbarment”⁵ and “[t]he Office of Enrollment and Discipline cannot base current actions upon void occurrences of

⁵ Petitioner incorrectly characterizes his removal from the register as “disbarment.” Petitioner was not disbarred as that action would result from an appropriate disciplinary proceeding. Further, reinstatement after exclusion is governed by 37 C.F.R. § 11.60 and carries with it a different set of reinstatement requirements.

the past.” However, as stated, Petitioner was removed from the register pursuant to former 37 U.S.C. § 10.11(b), which stated:

“A letter may be addressed to any individual on the register, at the address of which notice was last received by the Director, for purposes of ascertaining whether such individual desires to remain on the register. The name of any individual failing to reply and give any information requested by the Director within a time limit specified will be removed from the register and the names of individuals so removed will be published in the *Official Gazette*. The name of any individual so removed may be reinstated on the register as may be appropriate. . . .”

Pursuant to this authority, Petitioner was sent a standard survey letter and data sheet on November 20, 1987 to Petitioner’s last known address on file with the Office. Public Notice of the survey letter was also published in the Official Gazette on December 29, 1987. Having failed to respond, he was removed from the register in July of 1988. Public Notice of his removal from the register was also published in the Official Gazette on July 5, 1988. Petitioner had notice that failure to comply with the survey letter and data sheet would result in his removal from the register. His claims about the manner of his removal are misguided, untimely and irrelevant to the OED Director’s decision.

In sum, if Petitioner wishes to be considered for reinstatement after his 24-year hiatus, he will need to properly reapply and pass the examination. 37 C.F.R. §§ 10.11, 11.7.

III. CONCLUSION

The instant Petition for review of OED Director’s decision dated April 6, 2011, is over 10 months past the appeal date and is untimely filed. Additionally, it is noted that the OED Director considered the administrative record and appropriately denied the petition. Petitioner has not offered any evidence to show that he possesses the required moral and legal qualifications required by 37 C.F.R. §11.7. Nor has Petitioner properly applied for and shown that he appropriately meets the requirements for reinstatement under this rule, including recent passage of the examination. *See* 37 C.F.R. § 10.11.

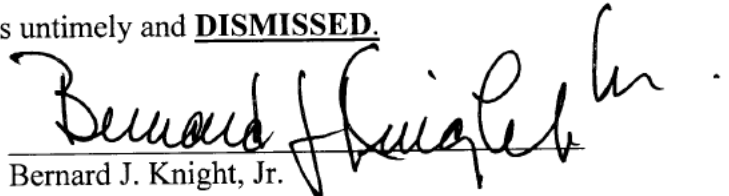
ORDER

Upon consideration of the Petition to the USPTO Director for review under 37 C.F.R.

§ 11.2(d), it is ORDERED that the Petition is untimely and **DISMISSED**.

AUG 13 2012

Date


Bernard J. Knight, Jr.
General Counsel
United States Patent and Trademark Office

on behalf of
David Kappos
Under Secretary of Commerce for
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