

¹ References to “Ex.” are to the Exhibits submitted by Petitioner with his June 30, 2021 petition.

2. Over the course of his career, Petitioner received "survey" letters from the OED. Pursuant to prior OED practice (contained in regulations that have since been revised), these letters, which were sent out at irregular intervals, sought to ascertain whether individual practitioners desired to remain on the register of practitioners. Petition (Exs. 2-8). It is uncontroverted Petitioner responded to those survey letters in all instances prior to 2012.

3. On or about July 31, 2012, OED sent a survey letter to 5,000 practitioners, including Petitioner. Petition (Ex. 8). Petitioner asserts that he did not receive the 2012 survey letter and, consequently, did not respond to it. Further, there is no evidence in the record reflecting that Petitioner received the survey letter.

4. On January 8, 2013, a notice was published in the Official Gazette [REDACTED] stating that there were approximately 900 practitioners who had not responded to the July 2012 survey. Petition (Ex. 9). The notice extended the survey response date to January 11, 2013. Petitioner claims he did not see the notice and therefore did not respond to it. On February 26, 2013, USPTO published in its Official Gazette [REDACTED] a notice with a list of practitioners who were administratively suspended for not responding to the survey, including Petitioner, effective January 31, 2013. Petition (Ex. 10); *see* [REDACTED]. Because he claims he did not receive the 2012 survey or see the OG notices, Petitioner continued to practice before the USPTO after January 31, 2013 and claims he was unaware of his removal from the register of patent practitioners until March, 2020, when a prospective client informed him his name was missing from the register of patent practitioners. Petition (Ex. 15).

5. Petitioner filed a reinstatement application with the OED Director on March 19, 2020. Petition (Ex. 11). OED rejected the application March 27, 2020. Petition (Ex. 12). The basis for the rejection was that it had been more than 5 years since Petitioner was removed from the

register for failure to respond to survey. *Id.* OED required that he retake examination or prove he “continue[s] to possess the legal qualifications necessary to render applicants for patent valuable service.” *Id.* OED further noted that there had been “significant changes in the patent laws and in [USPTO] practice and procedures since 2012.” *Id.* After Petitioner provided additional information in response to OED’s request for proof of the necessary legal qualifications, OED Staff Attorney [REDACTED] formally denied Petitioner’s application for reinstatement on April 10, 2020. Petition (Exs. 13, 14). In the April 10, 2020 decision, Petitioner was advised that he could seek review of that decision upon petition to the OED Director within sixty (60) days. *Id.* Petitioner did not file a petition with the OED Director.

6. On August 17, 2020, Petitioner provided additional information in support of his attempts to seek reinstatement. Petition (Ex. 15). OED accepted the filing as a “renewed request for reinstatement from survey removal with additional materials” in support of demonstrating his current qualifications but, on September 9, 2020, the renewed request was rejected by OED Staff Attorney [REDACTED] Petition (Ex. 16). In the September 9, 2020 OED letter, Petitioner was reminded of his right to seek review of the April 10, 2020 decision upon petition to the OED Director. *Id.* He was also advised that the present status of Petitioner’s March 19, 2020 petition for waiver of examination and reinstatement remained denied. *Id.*

7. Petitioner then filed a “Request for Reconsideration of September 9, 2020 [Decision]” on January 25, 2021. Petition (Ex. 23). OED acknowledged the request for reconsideration and OED Staff Attorney [REDACTED] wrote on February 19, 2021 that OED would respond “as soon as practical.” Petition (Ex. 28). The record does not show that OED ever acted on the request for reconsideration.

8. On April 6, 2021, Petitioner filed a “combined Supplemental Petition for Reinstatement After Removal and Responses to OED’s Second [Requests for Information].”² Petition (Ex. 30). Therein, for the first time, and in a manner other than as a background narrative or a passing reference, Petitioner challenged his initial removal from the register of patent practitioners. There is no evidence in the record to show that OED responded to or acted on Petitioner’s “combined supplemental petition.”

9. On June 30, 2021, Petitioner filed the instant Petition with the USPTO Director. No authority for the review by the USPTO Director was cited for the Petition.

II. LEGAL AUTHORITY

Congress vested the USPTO with plenary, statutory authority to promulgate regulations “govern[ing] the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Office.” 35 U.S.C. § 2(b)(2)(D); *see also Kroll v. Finnerty*, 242 F.3d 1359, 1364 (Fed. Cir. 2001) (stating that the USPTO has the “exclusive authority to establish qualifications for admitting persons to practice before it, and to suspend or exclude them from practicing before it”); *Haley v. Under Sec’y of Com. for Intell. Prop.*, 129 F. Supp. 3d 377, 386-87 (E.D. Va. 2015) (noting that “Congress gave the USPTO wide latitude to govern the conduct of the members of its bar,” and “Congress also *explicitly* gives the USPTO the power to promulgate regulations related to the conduct of its members”). Accordingly, the USPTO Director has authority to regulate practice before the Office in both patent and trademark matters.

In accordance with its statutory authority, the USPTO enacted an entire regulatory scheme that sets forth the processes and requirements for determining who is permitted to practice before

² OED served Petitioner with a first set of Requests for Information on October 7, 2020, to which Practitioner responded on January 13, 2021. Petition (Exs. 17, 22).

the Office. This includes provisions to challenge OED decisions that denies individuals the ability to practice before the USPTO.

“A register of attorneys and agents is kept in the Office on which are entered the names of all individuals recognized as entitled to represent applicants having prospective or immediate business before the Office in the preparation and prosecution of patent applications. Registration in the Office under the provisions of this part shall entitle the individuals so registered to practice before the Office only in patent matters.” 37 C.F.R. § 11.5(a). No individual will be registered to practice before the Office unless he or she “[e]stablishes to the satisfaction of the OED Director that he or she . . . [i]s competent to advise and assist patent applicants in the presentation and prosecution of their applications before the office.” 37 C.F.R. § 11.7(a)(1) and (a)(2)(iii).

“Any petition from any action or requirement of the staff of OED reporting to the OED Director [regarding enrollment or recognition] shall be taken to the OED Director. . . .” 37 C.F.R. § 11.2(c) (Petition to OED Director regarding enrollment or recognition). Any such petition not filed within sixty days from the mailing date of the action or notice from which relief is requested will be dismissed as untimely. *Id.* A petitioner may file a single request for reconsideration of an OED Director decision within thirty days of the date of the decision. *Id.* Filing a request for reconsideration stays the period for seeking review of the OED Director’s decision until a final decision on the request for reconsideration is issued.

“A party dissatisfied with a final decision of the OED Director regarding enrollment or recognition shall seek review of the decision upon petition. . . .” 37 C.F.R. § 11.2(d) (Review of OED Director’s decision regarding enrollment or recognition). Any petition not filed within thirty days after the final decision of the OED Director may be dismissed as untimely. *Id.* By

filing such petition to the USPTO Director, the party waives any right to seek reconsideration from the OED Director. *Id.* Any request for reconsideration of the decision of the USPTO Director may be dismissed as untimely if not filed within thirty days after the date of said decision. *Id.*

The matter for which Petitioner seeks review concerns the OED staff decision denying his application for reinstatement. However, Petitioner did not seek OED Director review of the April 10, 2020 OED staff decision. As a result, there is no OED Director decision at issue for the USPTO Director to review. However, there is an unresolved request for reconsideration that remains pending before OED. Thus, this matter is remanded back to OED to determine if that request is properly filed and, if so, to respond to it on the merits.

III. DISCUSSION

Petitioner states that the June 30, 2021 Petition challenges his administrative suspension and removal from the register of patent practitioners for failure to respond to the July 31, 2012 OED survey. Petition at 25. However, a review of the record provide by Petitioner, which includes OED decisions and Petitioner's filings with OED, reveals that Petitioner did not challenge his removal from the register of practitioners until April 6, 2021, well after OED staff had rejected his application for reinstatement. As detailed further below, the record provided by Petitioner shows that Petitioner only referenced the 2012 survey and his alleged non-receipt of it in filings submitted to OED as a narrative background in support of his application for reinstatement. Additionally, there remains a pending request before OED on the matter of Petitioner's reinstatement application and that request is being remanded back to OED for resolution.

In his attempts to seek reinstatement to practice before the USPTO, Petitioner filed numerous pleadings and requests with OED. He filed a reinstatement application on March 19, 2020.

Petition (Ex. 11). He did not challenge his removal from the register of patent practitioners in that filing. *Id.* OED Staff Attorney [REDACTED] issued a decision that formally rejected Petitioner's reinstatement application on April 10, 2020. Petition (Ex. 14). In that decision, Petitioner was advised that he could seek review of the April 10, 2020 decision upon petition to the OED Director. *Id.* Any such petition was required to be filed within sixty (60) days. *Id.* Petitioner did not file a petition with the OED Director.

Instead of petitioning the OED Director as advised in the April 10, 2020 decision, Petitioner provided additional information in support of his attempts to seek reinstatement on August 17, 2020, Petition (Ex. 15), which OED treated as a "renewed request for reinstatement from survey removal with additional materials." Petition (Ex. 16). Again, he did not challenge his removal from the register of patent practitioners in that filing. Petition (Ex. 15). OED's September 9, 2020 response letter rejected the renewed petition for reinstatement and request for a waiver of the registration examination. Petition (Ex. 16). The basis for the rejection was that Petitioner continued to not provide sufficient evidence of his qualifications. *Id.* In the September 9, 2020 letter, OED reminded Petitioner of his right to seek review of the April 10, 2020 decision by filing a petition with the OED Director. *Id.* Petitioner was also advised that the status of his March 19, 2020 application for waiver of examination and reinstatement remained denied. *Id.*

On January 25, 2021, and without citing any authority for the filing, Petitioner filed a "Request for Reconsideration of September 9, 2020 [Decision]" and he provided additional information in support of the request for reinstatement. Petition (Ex. 23). Once again, he did not challenge his removal from the register of patent practitioners in the request for reconsideration. *Id.* Petitioner only mentioned his removal in a background narrative of how he came to be removed from the register and that he was unaware he was removed. *Id.* OED acknowledged the

request for reconsideration on February 19, 2021 and stated that OED would respond “as soon as practical.” Petition (Ex. 28). However, there is nothing to indicate OED ever issued a decision on Petitioner’s request for reconsideration.

Thereafter, Petitioner filed a Supplemental Petition in support of his request for reinstatement on April 6, 2021. Petition (Ex. 30). It was in this filing, well after OED’s decision on his reinstatement application, that Petitioner first substantively challenged his 2013 removal from the register of patent practitioners, raising a variety of challenges on the basis of violations of due process, of his constitutional rights, and of the USPTO’s own rules. *Id.*

The instant Petition was filed on June 30, 2021 and, as of that date, Petitioner still had not sought OED Director review of the April 10, 2020 OED staff attorney decision. Additionally, there has been no decision or response from OED regarding the January 25, 2021 request for reconsideration, which OED indicated at the time that it would respond to as soon as practical.

Based on this record, an OED staff attorney issued a decision on Petitioner’s application for reinstatement on April 10, 2020. Upon an enrollment or recognition decision of OED staff reporting to the OED Director, individuals may petition the OED Director for review of that decision. 37 C.F.R. § 11.2(c). If dissatisfied with a final decision of the OED Director under § 11.2(c), an individual may seek review of the decision upon petition to the USPTO Director. 37 C.F.R. § 11.2(d). Here, Petitioner had 60 days from April 10, 2020 to seek review of the OED staff decision via a petition to the OED Director. Petitioner was advised of that right of review in the April 10, 2020 decision. Petition (Ex. 14). Those rights were reiterated in the September 9, 2020 letter to Petitioner. Petition (Ex. 16). However, based on the record provided by Petitioner, he did not petition the OED Director. As a result, there is no OED Director decision to review at this time. 37 C.F.R. § 11.2(c).

In addition to having no OED Director decision to review at this time, the status of the January 25, 2021 request for reconsideration is unclear. OED both accepted and acknowledged that filing, and stated it would respond “as soon as practical.” Petition (Ex. 28). However, no order was issued on that request. Consequently, this matter is remanded back to OED to consider Petitioner’s request for reconsideration.

IV. CONCLUSION

Petitioner challenges his administrative suspension and removal from the register of patent practitioners for failure to respond to the July 31, 2012 survey. However, Petitioner never challenged his removal in any of the pleadings submitted in support of his application for reinstatement. Those pleadings were focused on his qualifications and he argued for his reinstatement to the register of patent practitioners without having to take the registration examination. Petitioner’s attempts to seek reinstatement were rejected by an OED staff attorney,

and that decision was not reviewed by the OED Director. As a result, there is no OED Director decision to review here. Further, the record reveals there is an outstanding request for reconsideration filed by Petitioner that is still pending before OED. This matter is remanded back to OED to consider that request.

IT IS SO ORDERED.

09/03/2021

Date

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David Berdan
General Counsel
United States Patent and Trademark Office

on delegated authority by
Andrew Hirshfeld
Performing the Functions and Duties of the
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark
Office