

UNITED STATES PATENT AND TRADEMARK OFFICE
 BEFORE THE UNDER SECRETARY OF COMMERCE FOR
 INTELLECTUAL PROPERTY
 AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK
 OFFICE

)	
)	Decision on Petition
In re [])	Under 37 C.F.R. § 10.2(c)
)	
_____)	

MEMORANDUM AND ORDER

[] (“Petitioner”) seeks review of the decision of the Director of the Office of Enrollment and Discipline (“OED Director”) disapproving Petitioner’s application for registration to practice before the United States Patent and Trademark Office (“USPTO”) in patent cases. The OED Director disapproved Petitioner’s application based on his failure to sustain his burden of establishing that he is of good moral character and repute as required by 37 C.F.R. § 10.7(a)(2)(i). For the reasons stated below, the OED Director’s decision is affirmed.

I. PROCEDURAL HISTORY

Petitioner filed an application for the October 2001 registration examination on July 9, 2001. He took and passed the exam. However, in the application for registration, Petitioner indicated a number of prior arrests and that he had resigned from a job while under investigation.¹ In view of

¹ The exact question which Petitioner answered in the affirmative was: Have you ever resigned or quit a job when you were under investigation or inquiry for conduct which could have been considered as involving dishonesty, fraud, misrepresentation, deceit, or violation

these answers, OED sought and received additional information from Petitioner through a series of Requirements for Information and responses thereto concerning the arrests, the circumstances surrounding them, and Petitioner's application to law school and the Missouri and Illinois state bars. On May 17, 2002, OED issued a Show Cause Requirement to Petitioner to explain why his application should not be disapproved because of his failure to establish that he possessed good moral character and repute. On June 17, 2002, Petitioner responded to the Show Cause Requirement by submitting his record comprised of his academic achievements, work history since 1984, and claiming that OED failed to consider his voluntary work, aside from the court imposed community service associated with a felony arrest in 1997, as proof that he was possessed of good moral character and repute.

On July 29, 2002, the OED Director issued his final decision denying Petitioner's enrollment pursuant to 35 U.S.C. § 2 and 37 C.F.R. § 10.7(a)(2)(i) (2002), because he failed to sustain his burden of establishing that he is of good moral character and repute. Specifically, it was the opinion of the OED Director that Petitioner had not satisfactorily established rehabilitation from previous criminal conduct where Petitioner had not had an employment position of trust since the time of Petitioner's felony arrest, the rehabilitation period relied upon by Petitioner occurred partially during the term of Petitioner's probation, and Petitioner's reliance on his academic record had

of Federal or State laws or regulations, or after receiving notice or been advised of possible investigation, inquiry, or disciplinary action for such conduct?

not prevented criminal conduct. Finally, the OED Director was also of the opinion that the time period over which Petitioner must demonstrate rehabilitation should be commensurate with his period of ineligibility for admission to the Missouri state bar – five years from the termination of Petitioner’s probation (December 2000).

Petitioner seeks review by the USPTO Director of the OED Director’s Decision.

II. LEGAL STANDARD

Title 35 U.S.C. § 2(b)(2) states in pertinent part that the USPTO:

“may require [agents, attorneys, or other persons representing applicants or other parties before the USPTO], before being recognized as representatives of applicants or other persons, to show that they are of good moral character and reputation”

(emphasis added). Pursuant to the statute, Petitioner bears the burden of showing that he is of good moral character and reputation.

37 C.F.R. § 10.7 (2002), which implements the above-cited statute states in pertinent part:

“(a) No individual will be registered to practice before the Office unless he or she shall:

. . . .

(2) Establish to the satisfaction of the Director [of OED] that he or she is:

(i) Of good moral character and repute”

This regulation effectuates the USPTO Director’s recognized duty to ensure that those representing members of the public before the

USPTO in patent cases will do so with the highest degree of candor and good faith in order to protect the public.

“By reason of the nature of an application for patent, the relationship of attorneys to the Patent Office requires the highest degree of candor and good faith. In its relation to applicants, the Office . . . must rely upon their integrity and deal with them in a spirit of trust and confidence . . .’ It was the Commissioner, not the courts, that Congress made primarily responsible for protecting the public from the evil consequences that might result if practitioners should betray their high trust.”

Kingsland v. Dorsey, 338 U.S. 318, 319-320 (1949) (quoting with approval from Dorsey PTO case.) Accord Cupples v. Marzall, 101 F. Supp. 579, 583, 92 USPQ 169, 172 (D.D.C. 1952) (“primary responsibility for protection of the public from unqualified practitioners before the Patent Office rests in the Commissioner of Patents”), aff’d, 204 F.2d. 58, 97 USPQ 1 (D.C. Cir. 1953, quoted with approval in Gager v. Ladd, 212 F. Supp. 671, 673, 136 USPQ 627, 628 (D.D.C. 1963).

III. OPINION

A. Background

Petitioner, in a statement accompanying his application for registration to practice before the USPTO, identified several instances of arrest ranging from traffic infractions to forgery. The latter arrest in 1977 resulted in a suspended imposition of sentence, the placement of the Petitioner on probation for a period of three years, required restitution, and the performance of eighty (80) hours of community service. Petitioner completed his probation on December 4, 2000.

After Petitioner applied for registration to the Missouri State Bar as a law student in 1998, the Missouri Board of Law Examiners (“Missouri Board”) on March 8, 1999, entered an initial decision denying his application based upon the conviction for forgery. Petitioner appealed the decision arguing that he had not been convicted of a felony, as the imposition of his sentence was suspended. The Missouri Board rendered a decision on June 19, 2000, affirming its initial determination and ruling that Petitioner was ineligible for admission for five years following completion of the probation.

Petitioner also filed an application dated February 22, 2001, with the Illinois Board of Admissions to the Illinois Bar. So far as the record indicates, the application is still pending.

B. Issues

Petitioner has raised three issues in his petition: 1) the Director of OED discounted certain volunteer work provided by the Petitioner as “compelled” even though such voluntary work was performed separate and apart from the court-imposed community service which Petitioner was required to serve as part of his suspended sentence; 2) that denial of admission by the Missouri Board should not preclude Petitioner’s admission and practice before the USPTO as each state had its own rules for bar admission; and 3) that the Director of OED failed to give sufficient weight to testimonials of Petitioner’s previous employers.

C. Discussion

1. Lack of Sufficient Rehabilitation

Petitioner asks that his volunteer work for the [redacted] Tax Assistance Program be considered as proof of sufficient rehabilitation. As part of the imposition of the suspended sentence, Petitioner was required to perform 80 hours of community service. Petitioner completed the community service by working weekends at the [redacted] Community Center Association facility from January to March 1998. Following three rounds of Requirement for Information, in response to the Show Cause Notice, Petitioner stated for the first time that he also provided help to low-income tax payers by volunteering “five or six Saturdays with the [redacted] Tax Assistance Program” while attending law school at night. Petitioner attended law school from August 24, 1998, until graduation in 2002.

Petitioner began his court-ordered community service on or about January of 1998. The eighty hours was completed two months later. The record indicates that Petitioner performed other community service, for which he now requests consideration as proof of rehabilitation, during the four years while he attended law school (1998-2002). As the OED Director’s Final Decision indicated, at least two of these four years covered a period of time while Petitioner was on probation (December 4, 1997 – December 4, 2000).

Good conduct is normally demanded of a prisoner and a parolee. *In re Menna*, 905 P.2d 944, 952 (Calif. 1995). “It is not enough that petitioner kept out of trouble while being watched on probation; he must affirmatively demonstrate over a prolonged period his sincere regret and rehabilitation.” *Seide v. Committee of Bar Examiners*, 782 P.2d 602 (Calif. 1989). In those instances where the question of whether sufficient rehabilitation has occurred (in the context of application for admission to a state bar), it has been held that the following criteria are relevant:

“(1) [C]ommunity service and achievements, as well as the opinions of others regarding present character; (2) candor before the court; (3) the age of the applicant at the time of the offenses; (4) the amount of time which has passed since the last offense; (5) the nature of the offenses; and (6) the applicant’s current mental state.”

In re Loss, 119 Ill.2d 186, 196, 518 N.E.2d 981, 985 (1987). Quoted with approval in *In re Childress*, 138 Ill.2d 87, 100, 561 N.E.2d 614, 620 (1990). Accord *In re Application of G.L.S.*, 292 Md. 378, 397-98, 439 A.2d 1107, 1117-18 (1982).

The record indicates the OED Director was well aware of the time periods during which all of Petitioner’s community service was performed. Thus, the OED Director did consider the length of time during which Petitioner’s good behavior was compelled as well as the length of time during

which the additional un compelled community service was performed by Petitioner. It is therefore reasonable for the OED Director to determine that Petitioner has not yet demonstrated sufficient rehabilitation to establish good moral character and reputation.

2. USPTO May Consider Petitioner's Ineligibility for Admission to the Missouri State Bar

Although Petitioner has correctly pointed out in his Petition that each state bar has its own rules of admission, it was reasonable for the OED Director to consider Petitioner's period of ineligibility for admission to the Missouri state bar. As stated in the Final Decision, it would be incongruous for Petitioner to be allowed to practice before the PTO representing persons or parties while the same state bar bars his admission to practice representing those very same people. Just as the USPTO Code of Professional Responsibility recognizes as misconduct the suspension or debarment of an attorney from a state bar (37 C.F.R. § 10.23(c)(5)), the OED Director may similarly take into account a state bar's standard for eligibility in making a judgment on a period of sufficient rehabilitation. Petitioner may seek admission to practice law in a jurisdiction other than the state of Missouri and the Final Decision also stated that Petitioner may request that the OED Director consider any such admission to another bar in a further submission to the USPTO. To date, so far as the record shows, Petitioner has not made an additional submission on the basis of admission to any other bar.

3. Sufficient Weight Has Been Attributed To Testimonials of Previous Employers

Petitioner claims that the Director has given little weight to recommendations provided by Petitioner's previous employers upon Petitioner's application to law school. The record indicates that Petitioner submitted his application to the [redacted] School of Law on December 29, 1997. The application required that the applicant submit two letters of recommendation. In response to the First Requirement for Information, Petitioner submitted a copy of his application to law school that identified the names of two individuals who would provide recommendations. The letters of recommendation, however, were not attached to the copy of the application submitted to the Director of OED. In response to the Show Cause Requirement, Petitioner pointed out that his ability to practice before the USPTO is demonstrated by the fact that his present employers provided letters of recommendation in his law school and Missouri and Illinois state bar applications. The problem with this argument, however, is that it is not clear in the record what facts were in the possession of these two individuals when the letters of recommendation were submitted with Petitioner's applications. In the circumstances, the Director gave appropriate weight to submissions in light of his evaluation of the weight to be accorded to the other facts that were of record before him. Accordingly, the Director attributed sufficient weight to Petitioner's claimed ability as attested to by his employers.

CONCLUSION

In light of Petitioner's lack of sufficient rehabilitation as discussed above, the OED's Director's decision is reasonable and well-based on the evidence in the record. The OED Director's decision is hereby affirmed.

ORDER

Upon consideration of the Petition to the USPTO Director for registration to practice before the USPTO in patent cases, it is

ORDERED that the petition is denied.

Apr 11 2003

/s/
James Toupin
General Counsel
United States Patent and Trademark Office

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E R R A T U M

April 23, 2003

Memorandum and Order on Decision on Petition of []

Decided: April 11, 2003

On page 4, line 22, make the following change:

Change “1977” to “1997.”

_____/s/
James Toupin
General Counsel
United States Patent and Trademark Office

April 23, 2003