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

In re	Petition for Review of the Decision of the Director of Enrollment and Discipline R00-08

MEMORANDUM AND ORDER

(Petitioner) requests review by the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (Director)[1] under 37 C.F.R. § 10.2(c) of a decision denying Petitioner's March 22, 2000, Petition for Reinstatement. The Director of the Office of Enrollment and Discipline (Director of OED) denied the Petition for Reinstatement on June 28, 2000. This is Petitioner's fifth request for reinstatement. Additionally, Petitioner requests that the review of his petition be expedited under 37 C.F.R. § 10.170(a).

With respect to reinstatement, the Director of OED denied Petitioner's petition under 37 C.F.R. § 10.158 and § 10.160. For the reasons stated in the Director of OED's June 29, 2000, decision, the decision denying reinstatement is *affirmed*.

The following discussion merely supplements the thorough decision by the Director of OED. The primary responsibility for protection of the public from unqualified practitioners before the United States Patent and Trademark Office ("Office") rests in the Director. *Kingsland v. Dorsey*, 338 U.S. 318, 320-321, 83 USPQ 330, 331 (1949); *see also Leeds v. Mosbacher*, 732 F.Supp. 198, 200, 14 USPQ2d 1455, 1456 (D.D.C.), *aff'd*, 918 F.2d 185 (Fed. Cir. 1990). In carrying out this

[1] Effective March 29, 2000, the American Inventors Protection Act, Pub. L. No. 106-113, created the United States Patent and Trademark Office as an "agency of the United States, within the Department of Commerce" (35 U.S.C. § 1(a) (2000)) and changed the title of the head of the agency from "Commissioner" to "Director." See 35 U.S.C. § 3(a)(1) (2000).

duty, the Director has established regulations governing the recognition of agents and attorneys entitled to practice before the Office. 35 U.S.C. § 2(b)(2)(D). These regulations require that one practicing before the Office be competent to assist applicants for patents in the presentation and prosecution of their applications before the Office (37 C.F.R. § 10.7(a)(2)(iii)) and that they be of good moral character (37 C.F.R. § 10.7(b)). These regulations also provide procedures under which a practitioner who has been suspended for unethical conduct may request reinstatement. 37 C.F.R. §§ 10.158, 10.160.

Petitioner has been suspended from practicing before the Office since 1989. Unfortunately, since 1989, Petitioner has failed to comply with the mandatory requirements of 37 C.F.R. § 10.158 which detail how a suspended practitioner should comply with terms of the suspension[2]. Specifically, Section 10.158 requires:

> (b) Unless otherwise ordered by the Commissioner, any practitioner who is suspended or excluded from practice before the Office under § 10.156(b) shall:
>
> (1) Within 30 days of entry of the order of suspension or exclusion, notify all bars of which he or she is a member and all clients of the practitioner for whom he or she is handling matters before the Office in separate written communications of the suspension or exclusion and shall file a copy of each written communication with the Director.
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> (2) Within 30 days of entry of the order of suspension or exclusion, surrender a client's active Office case files to (i) the client or (ii) another practitioner designated by the client.
>
> (3) Not hold himself or herself out as authorized to practice law before the Office.
>
> (4) Promptly 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, and within 30 days of taking those steps, file with the Director an affidavit describing the precise nature of the steps taken.

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[2] Petitioner could have been reinstated to practice after a two-year suspension if he had complied with various provisions in 37 C.F.R. §§ 10.7 and 10.158. *In re Klein*, 6 USPQ2d 1547, 1556 (Comm'r Pat. 1987).

(5) Not advertise the practitioner's availability or ability to perform or render legal services for any person having immediate, prospective, or pending business before the Office.

(6) Not render legal advice or services to any person having immediate, prospective, or pending business before the Office as to that business.

(7) Promptly take steps to change any sign identifying a practitioner's or the practitioner's firm's office and the practitioner's or the practitioner's firm's stationery to delete therefrom any advertisement, statement, or representation which would reasonably suggest that the practitioner is authorized to practice law before the Office.

(8) Within 30 days, return to any client any unearned funds, including any unearned retainer fee, and any securities and property of the client.

. . . .

(d) When a suspended or excluded practitioner acts as a para-legal or performs services under paragraph (c) of this section, the suspended or excluded practitioner shall not thereafter be reinstated to practice before the Office unless:

(1) The suspended or excluded practitioner shall have filed with the Director an affidavit which (i) explains in detail the precise nature of all para-legal or other services performed by the suspended or excluded practitioner and (ii) shows by clear and convincing evidence that the suspended or excluded practitioner has complied with the provisions of this section and all Disciplinary Rules, and

(2) The other practitioner shall have filed with the Director a written statement which (i) shows that the other practitioner has read the affidavit required by subparagraph (d)(1) of this section and that the other practitioner believes every statement in the affidavit to be true and (ii) states why the other practitioner believes that the suspended or excluded practitioner has complied with paragraph (c) of this section.

These provisions of § 10.158 have been set forth to show exactly what type of evidence Petitioner has failed to produce with his application for reinstatement. For example, the Petitioner has produced no evidence that he notified his clients of his suspension and has not provided OED with copies of such notice as required by § 10.158(b)(1). Additionally, Petitioner has failed to produce evidence that he surrendered all active files to his clients or to another attorney designated by his clients as required by § 10.158(b)(2). In his decision denying reinstatement, the Director of OED provided Petitioner with evidence of Petitioner's continued practice before the

Office. In view of this evidence, Petitioner was required by § 10.158(d) to file affidavits regarding his work as a para-legal. Petitioner has provided none.

Despite the unambiguous language of § 10.158 and earlier decisions denying Petitioner reinstatement for violating the provisions of § 10.158, Petitioner still fails to comply. Petitioner had the burden of presenting evidence to the Director of OED that demonstrates that he has complied with § 10.158. 37 C.F.R. § 10.160(d). Instead, Petitioner resorted to presenting unpersuasive arguments and irrelevant documentation in support of his application for reinstatement.

In his Petition for Review, Petitioner requests incorporation by reference of all filings since 1983 relating to this disciplinary proceeding and numerous other matters. Such a request is improper in that this Petition must be decided on the basis of the record made before the Director of OED in connection with *this* request for reinstatement. 37 C.F.R. § 10.2(c). Petitioner has submitted numerous exhibits (A-H) along with his Petition. These exhibits are irrelevant and otherwise insufficient to meet the requirements of § 10.158. In fact, many of these documents were not submitted to the Director of OED for his review on *this* Petition for Reinstatement and, therefore, may not be considered for the first time on review as indicated above. However, even if given consideration, these documents would not be persuasive--all the exhibits are irrelevant to the determination of whether Petitioner has complied with § 10.158.

Because Petitioner has failed to produce evidence to establish that he has served at least a two-year period of suspension that complies with §10.158, his Petition to be reinstated is denied.

Petitioner's request for expedited review is now of no practical significance since his petition for reinstatement has been decided. Therefore, the petition to expedite is dismissed as moot.

ORDERED:

(i) The Director of OED's decision denying Petitioner's Petition for Reinstatement is *affirmed*;

(ii) The Petitioner's request that review of his Petition for Reinstatement be expedited is *dismissed*; and

(iii) The Director of OED shall send a copy of his decision and this decision to the New York and Connecticut bar associations.

THIS IS A FINAL AGENCY ACTION.

AUG - 8 2000

Q. Todd Dickinson
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

Harry Moatz
Director, OED