

**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
	)	on Sixth Petition for Reinstatement
	)	

**MEMORANDUM AND ORDER**

In a petition for review<sup>1</sup> submitted March 2, 2001, \_\_\_\_\_ Petitioner) requests review by the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (“Director”) under 37 C.F.R. § 10.2(c) of a decision denying Petitioner’s August 9, 2000, Petition for Reinstatement.<sup>2</sup> This was Petitioner’s sixth petition for reinstatement (“Sixth Petition”). The Director of the Office of Enrollment and Discipline (“Director of OED”) denied the Petition for Reinstatement in a “Memorandum Opinion and Final Decision” on January 19, 2001 (“Final Decision”).<sup>3</sup> For the reasons stated in that Final Decision and herein, the decision denying reinstatement is *affirmed*.

Petitioner submitted the following documents in connection with his Sixth Petition:

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<sup>1</sup> Due to the large number of documents submitted by the Petitioner in connection with this matter, they are referred to herein by number for clarity. The petition for review is titled: (1) “Petition for Review under 37 C.F.R. 10.2(c) of the Final Decision by the OED Director Harry Moatz dated February 23, 2001 denying \_\_\_\_\_ Sixth Petition For Reinstatement.”

<sup>2</sup> On January 31, 2002, the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office delegated to the General Counsel the authority to issue final decisions in proceedings under 35 U.S.C. § 32.

<sup>3</sup> The Sixth Petition for reinstatement was submitted by Petitioner one day after the Director issued a Memorandum and Order on August 8, 2000 (in response to a petition similar to the present one) affirming the Director of OED’s decision of June 29, 2000 denying Petitioner’s fifth petition for reinstatement (“Fifth Petition”).

(2) "The Single Submission in Support of the Sixth Petition for Reinstatement and in Response to the Comments filed by Third Parties with OED after publication on October 10, 2000 of the Notice of the Undersigned's Petition for Reinstatement in the Official Gazette of the U.S. Patent and Trademark Office" (submitted Nov. 27, 2000)<sup>4</sup>; and (3) "The Single Response to the 'REQUEST FOR SUPPLEMENTAL INFORMATION' dated 12/14/2000 by the Director of the Office of Enrollment and Discipline" (submitted Dec. 18, 2000).<sup>5</sup> In addition, after notice was published in the Official Gazette, letters regarding the petition were received from the following:

(4) ; (5) ; (6)

Following the January 19 Final Decision, Petitioner submitted the following documents:

(7) "The Single Response to the Order to Show Cause [sic] of the Director of the Office of Enrollment and Discipline dated January 19, 2001" (submitted January 30, 2001); (8) Letter "Re: Response to Order to Show Cause Included in Memorandum and Final Decision of OED dated January 19, 2001" (received Jan. 31, 2001); (9) telefax directed to the Director of OED (February 2, 2001); and (10) telefax directed to the Director of OED (February 3, 2001).

The Director of OED treated Petitioner's January 30, 2001, submission styled "Single

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<sup>4</sup> After submitting his Sixth Request, Petitioner directed thirty-nine communications to the Director of OED over a 33-day period, resulting in confusion as to Petitioner's precise contentions and position. By letter dated September 26, 2000, the Director of OED requested that Petitioner present a single submission, and Petitioner did so on November 27, 2000.

<sup>5</sup> Petitioner's December 18, 2000 submission was in response to a December 14, 2000 Request for Supplemental Information from the Director of OED.

<sup>6</sup> These letters relate to Petitioner's moral character and fitness. Because numerous violations of terms of his suspension preventing reinstatement were found below, the Director of OED has deferred a determination on character and fitness until such time as Petitioner complies with the terms of his suspension. (Final Decision at 36) Thus, these letters are not relevant to this petition.

Response to the Order to Show Cause” as a request for reconsideration of the January 19 Final Decision, which he denied in a “Final Decision on Request for Reconsideration” dated February 23, 2001. The instant petition was then filed on March 2, 2001. On May 24, 2001, Petitioner submitted a (11) “Supplement to Petition for Review under 37 C.F.R. 10.2(c) of the Final Decision by the OED Director Harry Moatz dated February 23, 2001 Denying Sixth Petition for Reinstatement.”

The January 19 Final Decision by the Director of OED denied Petitioner’s Sixth Request under 37 C.F.R. § 10.158 and § 10.160. For the reasons stated in the January 19 Final Decision, and in the February 23, 2001 “Final Decision on Request for Reconsideration,” the decision denying reinstatement is **affirmed**.

#### BACKGROUND

The Petitioner was registered to practice as an attorney before the Office in 1959. In 1984, the Director of OED brought a disciplinary action charging the Petitioner with professional misconduct.<sup>7</sup> After a hearing before an Administrative Law Judge, the Petitioner was suspended from practice for a period of seven years, with the last five years suspended on the condition that the Petitioner would be placed on probation for those five years.<sup>8</sup> See *In re Klein*, 6 USPQ2d 1547 (Comm’r Pat. 1987). The suspension order further held that, upon a showing of compliance with the requirements of 37 CFR § 10.158 and § 10.160 for a period of two years, the

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<sup>7</sup> The charges included, *inter alia*, that Petitioner intentionally misled the USPTO by representing that papers were mailed on certain dates when they were in fact mailed on later dates. See, e.g., *Klein v. Peterson*, 866 F.2d 412, 414, 9 USPQ2d 1558, 1559 (Fed. Cir. 1989).

<sup>8</sup> In separate proceedings, Petitioner has also been disbarred in the states of New York and Connecticut.

Petitioner would be entitled to reinstatement and the commencement of the five-year probation.

*Id.* Petitioner unsuccessfully challenged the suspension in the federal courts. *See Klein v. Peterson*, 696 F.Supp. 695, 8 USPQ2d 1434 (D.D.C. 1988), *aff'd* 866 F.2d 412, 9 USPQ2d 1558 (Fed. Cir. 1989), *cert. denied*, 490 U.S. 1091.

In short, the requirements of the relevant regulations include: the avoidance of unauthorized practice or holding one's self out as authorized to practice before the Office during the suspension period, notification to all clients of the suspension, and surrender of client files. *See* 37 CFR §§ 10.158 & 10.160. Moreover, it is the burden of the reinstatement petitioner to establish compliance with these requirements by a showing of clear and convincing evidence. 37 CFR § 10.160. Petitioner has filed six sequential petitions for reinstatement to practice before the Office, and each of them has been denied for failure to demonstrate compliance with 37 CFR § 10.158 and § 10.160. (*See Final Decision at 2-7*)

#### **THE JANUARY 19, 2001 DECISION OF THE DIRECTOR OF OED**

In denying the Petitioner's sixth petition for reinstatement, the Director of OED found that the Petitioner has still failed to demonstrate the necessary compliance with 37 CFR § 10.158 and § 10.160. In particular, the Director of OED made the following rulings and findings:

1. Petitioner's request for a waiver of the requirements of § 10.158 was denied (Final Decision at 8-12);
2. Petitioner appears to have engaged in unauthorized practice before the USPTO during his period of suspension in violation of § 10.158(a) (Final Decision at 13-25, citing specific, documented examples of unauthorized practice);
3. Petitioner failed to demonstrate that all clients for whom he is handling matters before the USPTO have been notified in writing of his suspension, as required by § 10.158(b)(1) (Final Decision at 25-26);

4. Petitioner failed to demonstrate that all active USPTO case files were surrendered to the clients, or to other practitioners designated by the clients, as required by § 10.158(b)(2) (Final Decision at 26-29);
5. Petitioner held himself out as being authorized to practice before the USPTO during his period of suspension, in violation of § 10.158(b)(3) (Final Decision at 29);
6. During his period of suspension, Petitioner rendered legal advice and services to persons having immediate, prospective, or pending business before the USPTO in violation of § 10.158(b)(5) &(6), and engaged in the unauthorized practice of law before the USPTO in violation § 10.158(a). (Final Decision at 30-32); and
7. During his period of suspension the Petitioner allegedly performed paralegal services for one or more registered practitioners, but Petitioner did not establish compliance with § 10.158(c), which governs the circumstances under which such paralegal services may properly be provided by a suspended practitioner. (Final Decision at 32-35). Moreover, the practitioners for which the Petitioner allegedly provided such paralegal services did not submit the written statements required by § 10.158(d)(2). (*Id.*)

The Director of OED also noted the numerous specific warnings to the Petitioner that he will not be reinstated until he can demonstrate compliance with the terms of his suspension, and that his previous judicial challenges to his suspension and prior attempts at reinstatement have been unsuccessful. (Final Decision at 13) Furthermore, the Director of OED reminded the Petitioner that, in addition to the compliance problems detailed above, any later decision to reinstate Petitioner would require a determination of whether Petitioner would be required to pass an examination and a determination regarding the Petitioner's moral character and repute. (Final Decision at 36) These determinations were deferred by the Director of OED in light of the above-mentioned compliance problems. (*Id.*)

Concluding that the Petitioner failed to provide objective evidence establishing his compliance with the mandatory requirements of his suspension, the Director of OED denied

Petitioner's Sixth Petition for Reinstatement. (Final Decision at 37). The Director of OED also reminded Petitioner once again that any subsequent petition for reinstatement must, at a minimum, establish compliance with all of the requirements of § 10.158 for the two-year period immediately prior to the petition. (*Id.*)

On January 30, 2001, Petitioner submitted a paper (7) entitled "Response to Order to Show Cause [sic] Included in Memorandum Opinion and Final Decision of OED Dated January 19, 2001," in which Petitioner alleged compliance with the client notification requirement of § 10.158. The Director of OED treated this paper and the related correspondence (8), (9), and (10) submitted between January 31 and February 3, 2001, as a request for reconsideration of the January 19 Final Decision, which request was denied on February 23, 2001. (Final Decision on Request for Reconsideration dated February 23, 2001, at 1-3) While the Director of OED observed that the letters submitted by the Petitioner suggested that he may be beginning to comply with at least one of the requirements of his suspension (client notification), the Director of OED denied the request for reconsideration because Petitioner still had not shown full compliance with all of the requirements for a two-year period. (*Id.*)

#### **THE MARCH 2, 2001 PETITION**

In his (1) Petition for Review under § 10.2(c), Petitioner presents the following four arguments:

1. Petitioner appears to argue that he was not engaged in the unauthorized practice of law before the USPTO between March and December of 1989, because he merely acted as a paralegal for [redacted], a registered practitioner. (Petition for Review at 3) The affidavit of

compliance required by § 10.158(d)<sup>9</sup> cannot be obtained from Mr. because he is deceased. (*Id.*) Similarly, Petitioner appears to argue that he was not engaged in the unauthorized practice of law before the USPTO from December 1989 through July of 1991 because he acted in part as a paralegal for a registered practitioner. (Petition for Review at 3-4). Petitioner informs the USPTO that has refused to provide an affidavit as required by § 10.158(d). (*Id.*)

2. Petitioner appears to argue that despite his suspension he was not engaged in the unauthorized practice of patent law before the USPTO because, prior to 1998, he was still licensed to practice law in the state of Connecticut. (Petition for Review at 8-11)

In a so-called (11) “Supplement to Petition for Review under 37 CFR 10.2(c) of the Final Decision by the OED Director Harry Moatz” submitted on May 24, 2001, Petitioner further argues that his dissatisfaction with the USPTO response to a 1994 Freedom of Information Act request somehow compels reversal of the Final Decision.

## DISCUSSION

The Petitioner bears the burden of proving compliance with the reinstatement requirements of § 10.158 and § 10.160 by clear and convincing evidence. 37 CFR § 10.160. Furthermore, this petition for review must be decided on the record that was before the Director of OED – no additional evidence or materials may be considered at this stage. 37 CFR § 10.2(c).

As an initial matter, the Director of OED’s January 19 Final Decision thoroughly discusses (at pp. 8-12) the rationale for refusing Petitioner’s request to waive the requirements of

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<sup>9</sup> Petitioner mistakenly refers to § 10.158(c) rather than (d) for the affidavit requirement. (*Id.*)

37 CFR § 10.158. The Director of OED held that Petitioner's request for a waiver was in fact a request for a modification of the terms of the original suspension order, and that Petitioner has not established an "extraordinary situation" in which "justice requires" waiver of the applicable rules. (Final Decision at 8-12, quoting 37 CFR § 10.170). Nothing in Petitioner's Petition for Review (1) or Supplement to Petition for Review (11) contests or addresses the Final Decision of the Director of OED refusing to waive the requirements of § 10.158. Therefore, that aspect of the Director of OED's Final Decision is not subject to being disturbed in this appeal, and Petitioner's showing must satisfy the requirements of § 10.158.

In Part IV of the January 19, 2001 Final Decision (pp. 13-35), the Director of OED discussed at length whether Petitioner had produced objective evidence of compliance with the mandatory requirements of 37 C.F.R. §§ 10.158 and 10.160. For example, the Director of OED found a lack of proof that Petitioner has notified all of his clients of his suspension, that he has surrendered all client files, and that he has refrained from practicing or holding himself out as authorized to practice before the USPTO. The Final Decision found that Petitioner had not met his burden of proof in this regard, and therefore Petitioner's request for reinstatement was improper and would not be granted. Not only did Petitioner fail to demonstrate that he had notified his clients of his suspension and surrender their files, the record in fact shows that Petitioner continued to engage in various legal activities that violate the terms of his suspension.

For example, the January 19, 2001, Final Decision discusses (at pp. 13-20) Petitioner's involvement in representing a foreign applicant in a patent application ("the Bulgarian-origin application") pending before the USPTO between the time period of June 15, 1998 to May 28, 1999, during the period of his suspension. The Director of OED found that Petitioner was either



engaged in the unauthorized practice of law before the USPTO, in violation of 37 C.F.R. §§ 10.158(a) and 10.158(b)(6), or that he was aiding another practitioner as a paralegal without being in or demonstrating compliance with the requirements of 37 C.F.R. §§ 10.158(c) and 10.158(d). It is uncontested on appeal that the other named practitioners, Messrs \_\_\_\_\_ and \_\_\_\_\_ were not involved at all in the Bulgarian-origin application before the USPTO, that Petitioner was not acting as a paralegal for either one of them, that Petitioner was not supervised by either one of them, and that Petitioner was not employed by either one of them in connection with that application. *See* 37 CFR § 10.158.

Petitioner's activities in connection with the Bulgarian-origin application were alone sufficient to sustain the denial of his Sixth Petition for reinstatement. Similarly uncontested is the finding of the January 19, 2001 Final Decision (at pp. 21-22) that Petitioner was substantively involved in the prosecution of patent application serial no. 08/999,566, leading to issuance of U.S. Patent No. 5,967,879. The Director of OED found violations of 37 C.F.R. §§ 10.158 and 10.160 on the part of Petitioner. Despite a specific admonition in the OED Director's final decision denying Petitioner's previous (fifth) petition for reinstatement, the materials submitted by Petitioner in support of his Sixth Petition did not address his involvement in the prosecution of '879 patent. This uncontested finding is likewise a sufficient basis to sustain the OED Director's decision.

In addition, Petitioner admits that he has not complied with the terms of his suspension. The Director of OED reiterated in the Final Decision (at p. 37) the rule that Petitioner must show full compliance with the terms of his suspension for a period of two years:

In accordance with § 10.160(d), any suspended practitioner who has

violated the provisions of § 10.158 during his period of suspension shall not be entitled to reinstatement until such time as the Director of Enrollment and Discipline is satisfied that a period of suspension equal in time to that originally ordered by the Commissioner has passed during which the suspended practitioner has complied with the provisions of § 10.158. As noted in the above discussion concerning surrender of client files, Petitioner has not complied with § 10.158 as of December 17, 2000, and it appears Petitioner could not come into compliance with § 10.158 for a two-year period until December 18, 2002 at the earliest. Accordingly, if Petitioner submits another petition for reinstatement prior to December 18, 2002, he will be required to show cause why any evidence of compliance for two years immediately preceding December 17, 2000, or any other two year period, was not previously presented.

In Petitioner's "Single Response to the Order to Show Cause [sic]" (7) submitted on January 31, 2001, Petitioner conceded (at pages 5-6) that he has not been in compliance with §§ 10.158 and 10.160:

Had the Petitioner previously received the information on pages 30 and 31 of the [January 19, 2001 Final] Decision from OED during the past twelve years, he would have avoided some of the activities which the OED Director has now identified as being improper.

\* \* \*

In view of certain rulings and clarifications by the OED Director on pages 30 and 31 of his latest Decision, *it is now clear that, since March 1989 to the present, the Petitioner has, from time to time, not complied with 37 C.F.R. §§ 10.158 and 10.160.* (Emphasis added.)

Because, on appeal, Petitioner does not seek waiver of these requirements, he has presented no basis for reversal of the OED Director's holding that these activities should bar his reinstatement. Petitioner has attempted belatedly to cure the deficiencies found by the Director of OED by, *e.g.*, submitting copies of letters to some clients informing of his suspension. (*See, e.g.*, Letter dated February 2, 2001, \_\_\_\_\_ to Patent Attorneys \_\_\_\_\_ and \_\_\_\_\_

, attached to February 2, 2001 telefax (9)) However, these submissions are inadequate on their face to demonstrate the required 2-year period of compliance, and they are also irrelevant to the other specific examples of non-compliance discussed in the Final Decision. Thus, I am in agreement with the Final Decision On Request For Reconsideration (dated February 23, 2001), wherein the Director of OED found that Petitioner's request for reconsideration (7) "does not demonstrate that a period of suspension equal in time to that ordered by the Commissioner has passed during which Petitioner has complied with the provisions of 37 CFR § 10.158." And, as noted above, Petitioner admits this as well.

The arguments raised in the current Petition for Review do not compel a reversal of the Final Decision. First, Petitioner's arguments that he was merely a paralegal under the supervision of various other registered practitioners from 1989 to 1991, even if accepted, are unpersuasive. As explained in great detail in the Final Decision, Petitioner has not demonstrated compliance with all of the requirements of his suspension for any period of time since he was suspended. Even if Petitioner was merely a paralegal in the 1989-91 period, these unsupported allegations do not address his failure to notify his clients in writing of his suspension and return their files during that time frame. Even more troubling is the uncontested evidence that, as recently as 1999-2000, Petitioner engaged in the unauthorized practice of law before the USPTO. Alleging compliance with some of the requirements of his suspension for some periods of time does not meet Petitioner's burden of producing objective evidence of full compliance for the entire 2-year suspension period.

Further, Petitioner's argument that he was not engaged in unauthorized practice before the USPTO because he was registered to practice in the State of Connecticut until 1998 is also

misplaced. The USPTO exercises, through the Director of OED, independent authority to regulate the practice of patent law before the agency. 35 USC § 2. Regardless of whether or not one is licensed to practice law by one or more states, only practitioners who have complied with the USPTO regulations and requirements may represent patent applicants before the USPTO.

Petitioner erroneously attempts to distinguish the cases cited in the Director of OED's Final Decision. (Petition for Review at 9-11). For example, Petitioner argues that in *In re Cowgill*, 181 USPQ 103 (Ohio App. 1973), the respondent was restrained from representing inventors before the USPTO only because he was both not registered to practice before the USPTO, and because he was not licensed to practice law in Ohio. (*Id.*) Petitioner appears to argue that, as long as one is licensed to practice law in a state, one is entitled to practice patent law before the USPTO, even if suspended. None of the cases cited by Petitioner stand for this proposition. For example, in *Cowgill*, the practitioner, who was neither licensed by the state of Ohio nor registered before the USPTO, was charged with unauthorized practice of law in Ohio for providing legal services to patent applicants. *Id.* at 103. *Cowgill* argued that because the regulation of practice before the USPTO was governed by the USPTO exclusively, the state of Ohio could not properly discipline him for unauthorized practice of law. *Id.* at 104-05. The Court rejected that argument, holding that since he was not even registered to practice before the USPTO, the issue raised by *Cowgill* was irrelevant, and his unauthorized legal activity was punishable by the state. *Id.* Nothing in *Cowgill* or any other cited case supports Petitioner's argument that his license to practice law in Connecticut authorized him to violate the terms of his USPTO suspension. Moreover, even if Petitioner's legally erroneous reasoning were adopted, it does not justify his continued unauthorized practice in 1999-2000, after his license to practice

law in Connecticut was suspended in 1998.

Finally, Petitioner argues in his Supplement to Petition for Review (11) that the rules should be suspended and he should be reinstated because new information has allegedly come to light regarding a Freedom of Information Act request Petitioner made several years ago. This additional evidence, if any, may not properly be considered for the first time by the Director of the USPTO during a review under § 10.2(c), which is limited by regulation to the record before the Director of OED. Furthermore, even if it were considered, it is irrelevant to the issues of Petitioner's lack of compliance, and fails to otherwise undermine the soundness of the January 19, 2001, Final Decision by the Director of OED.

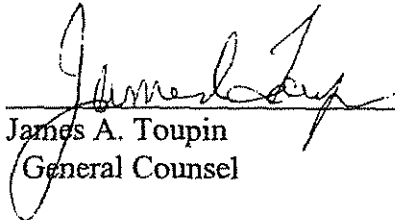
**ORDERED:**

(i) The Director of OED's decision and decision on reconsideration denying Petitioner's Sixth Petition for reinstatement is *affirmed*;

(ii) The Director of OED shall send a copy of his decision, his decision on reconsideration, and this decision to the New York and Connecticut state bar disciplinary bodies.

**THIS IS A FINAL AGENCY ACTION.**

April 5, 2002

  
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James A. Toupin  
General Counsel

Harry Moatz  
Director, OED