

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

In re

)
)
) Decision on Request for
) Reconsideration Under
) 37 C.F.R. § 11.2(d)
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)
)

MEMORANDUM AND ORDER

(Petitioner) seeks review of the decision of the Director of the United States Patent and Trademark Office (USPTO) upholding the Director of the Office of Enrollment and Discipline's (OED) decision disapproving Petitioner's Eighth Petition for Reinstatement to practice before the United States Patent and Trademark Office (USPTO). For the reasons stated below, the Petition for Review is **DENIED**, and the decision of the USPTO Director is **AFFIRMED**.

I. BACKGROUND AND PROCEDURAL HISTORY

The background and procedural history of the USPTO Director's December 19, 2007, decision on this matter is incorporated herein.

The following subsequent events have occurred. First, Petitioner made several improper attempts to have the USPTO Director's decision reconsidered. The first two attempts were on December 27, 2007, and January 2, 2008, at which time Petitioner faxed a Petition, purportedly pursuant to 37 C.F.R. § 10.170, requesting reconsideration of the USPTO Director's December 19, 2007, decision. The USPTO informed Petitioner by letter dated January 4, 2008, that it would not accept those faxed Petitions because

neither complied with the USPTO's rules set forth in Title 37 of the Code of Federal Regulations. Then on January 9, 2008, Petitioner sent by Express Mail, his third Petition for Reconsideration and the required fee. Within days, on January 14, 2008, Petitioner filed his fourth Petition requesting reconsideration of the December 19, 2007 Decision of the Director. Petitioner stated this submittal was because the January 9, 2008 petition contained typographical errors. The January 14, 2008 petition, entitled "Revised Petition under 37 C.F.R. § 10.170 to have the General Counsel of the U.S. Patent and Trademark Office James A. Toupin reconsider his Memorandum and Order dated December 19, 2007," is the version that we address herein.

II. LEGAL STANDARDS

The legal standards recited in the USPTO Director's December 19, 2007, Decision on this matter are correct, and incorporated herein. To supplement this information, we note that a Request for Reconsideration must be filed within 30 days after the mailing date of the USPTO Director's initial decision. 37 C.F.R. § 11.2(d).

III. ANALYSIS

Petitioner provides no basis to warrant a grant of his petition for reinstatement, or to set aside the USPTO Director's prior decision. In his Revised Petition, Petitioner advances six arguments why he should be reinstated to practice before the Office.¹ The first five arguments, were made by Petitioner in his request for the USPTO Director to review the OED Director's decision on Petitioner's Eighth Petition for Reinstatement. Those five arguments are readdressed here, briefly. Petitioner's sixth argument is new,

¹ Note that Petitioner numbers both his 5th and 6th arguments as "5."

and, while irrelevant to the USPTO Director's decision, is addressed below. Each argument is addressed in the order presented by Petitioner.

1. Petitioner herewith accepts Toupin's invitation to take the USPTO registration examination in order to be reinstated to the USPTO bar.

One condition precedent to Petitioner's reinstatement to practice before the Office is taking and passing the registration examination. 37 C.F.R. § 10.160(c)(1). In his Revised Petition for Reconsideration, Petitioner indicates that he accepts the invitation to take the registration examination, provided he be reinstated once he has passed. Petition at 2.

As the USPTO has previously informed Petitioner numerous times, taking and passing the registration examination is but one condition of his reinstatement. Petitioner's "acceptance" of USPTO's "offer" to take the test is of no legal effect. The USPTO will reinstate _____ if he meets all the requirements for reinstatement as previously outlined to him.

2. Petitioner Respectfully Points out to Toupin a Number of Omissions and Distortions of the Record in his BACKGROUND AND PROCEDURAL HISTORY of the Order, all of Which Should be Considered as "Mitigating Circumstances" Leading to _____'s Prompt USPTO Reinstatement.

Petitioner argues that there are mitigating circumstances that the USPTO should take into consideration relative to his reinstatement. These mitigating circumstances involve the fact, as stated by Petitioner, that the USPTO issued two final orders related to his case, and that only the first order, which he would have accepted, followed the recommendation of the Administrative Law Judge (ALJ). As Petitioner is well aware,

and as was pointed out in the USPTO Director's prior decision on this matter, the first order is not in effect, and the courts have upheld the order that Petitioner references here as the second order. *Klein v. Toupin*, No. CIV. 05-647(GK), 2006 WL 1442611, at *1 (D.D.C. May 24, 2006); *aff'd*, 208 Fed. Appx. 906 (Fed. Cir. 2006) (citations omitted) (*Klein*).

This argument was thoroughly addressed in the USPTO Director's prior decision on this matter. Petitioner has presented nothing that warrants a change to that decision. Despite Petitioner's many challenges, the second order remains in effect. Petitioner must comply, and provide satisfactory proof of that compliance, before he will be reinstated.

3. Petitioner relied in good faith on Associate USPTO Solicitor Sidney Johnson's suggestion to withdraw his Eighth Petition for Reinstatement in order to expedite his USPTO reinstatement.

Petitioner argues that the USPTO should consider his reliance on Associate Solicitor Sydney Johnson's suggestion to be a mitigating factor. Once again, this argument was addressed in the USPTO Director's prior decision on this matter. As noted there, even if representations were made, Petitioner has not demonstrated any detrimental reliance on Mr. Johnson's alleged representations. Petitioner has presented nothing that warrants a change to the prior decision.

4. Petitioner requests that Toupin Take Administrative Notice of Commonly Known Facts such as Current Events or the Contents of Official Documents as are Listed by Klein Herein Below.

While the argument is quite convoluted, it appears Petitioner is asking the USPTO to take administrative notice that Petitioner was unaware of the "Clopper Memorandum"

until May 2002.² As noted in the USPTO Director's prior decision on this matter, it is fully settled that Petitioner was aware of the Clopper Memoranda in 1985, because Petitioner referenced the "Clopper Memoranda" in his own reply brief in October 1985.

We consider this finding conclusive on the issue.

5. Petitioner has been in full compliance with the provisions of Rules 158 and 160 for some time and objective evidence support this conclusion.

Petitioner argues, without supporting evidence, that he has been in compliance with Rules 158 and 160 for "quite some time." Specifically, Petitioner argues that he has presented sufficient objective evidence to show his compliance with Rule 158. The OED Director reviewed that evidence and concluded the Petitioner had not demonstrated compliance. The USPTO Director's prior review addressed this issue and found the OED Director's decision was correct. Petitioner has presented nothing here to warrant altering that conclusion.

Nor has the Petitioner proven his compliance with Rule 160. In fact, in this Revised Petition, Petitioner acknowledges he has not taken the registration examination, a fact which by itself establishes his non-compliance. 37 C.F.R. § 10.160(c)(1).

As the OED Director found, and the USPTO Director agreed, Petitioner has the burden of demonstrating compliance with rules 158 and 160, and he has not satisfied his burden.

² In the USPTO Director's prior decision on this matter, Petitioner asked for judicial notice, and in this request, asks for administrative notice of the same facts.

6. _____’s compliance with 37 C.F.R. §§ 1.1, 1.4, 1.6, 1.8, 1.21 (a)(5)(ii), 10.18, 11, and 11.2.

Petitioner asserts that he will comply with certain provisions of 37 CFR Parts 1, 10, and 11. It is unclear what point Petitioner is making with this assertion since Petitioner is already obligated to follow these rules in order to do business with the USPTO. Nothing in this assertion is relevant to, or alters the conclusion of the USPTO Director’s prior decision.

IV. CONCLUSION

Petitioner’s arguments do not provide a basis to grant his Revised Petition for Review of the USPTO Director’s December 19, 2007, Decision. Both the USPTO Director’s and the OED Director’s Decisions correctly determined that Petitioner failed to demonstrate compliance with Rules 158 and 160, and thus, properly denied his petition for reinstatement.

ORDER

Upon consideration of the Petitioner's Request For Review of the OED Director's Decision under 37 CFR § 11.2(d), it is **ORDERED** that the Petitioner's Request is **DENIED.**

On behalf of the Under Secretary of Commerce for
Intellectual Property and Director of the United
States Patent and Trademark Office

April 16, 2008
Date

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

cc:

Director
Office of Enrollment and Discipline
Mailstop OED
USPTO
P.O. Box 1450
Alexandria, VA 22313-1450