

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

In re

)
)
) Decision on Petition for Review
) Under 37 C.F.R. § 11.2(d)
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)
)

MEMORANDUM AND ORDER

(Petitioner) seeks review of the July 11, 2008, final decision by the Director of the Office of Enrollment and Discipline (OED) of the United States Patent and Trademark Office (USPTO). The OED Director's decision denied Petitioner's request for reconsideration of an OED staff action which deemed Petitioner's application for admission to be incomplete and was therefore denied. For the reasons stated below, the Petition for Review is **DENIED**, and the decision of the OED Director is **AFFIRMED**.

I. BACKGROUND

Petitioner was previously suspended from practice before the Office on ethical grounds. *Klein v. Peterson*, 696 F.Supp. 695 (D.D.C. 1988), *aff'd*, 846 F.2d 77 (C.A.Fed 1988). On May 28, 2008, Petitioner submitted an *Application For Registration To Practice Before the United States Patent and Trademark Office*. In his application, Petitioner did not check any of the boxes for 8a ("Application Fee"), including the box that states "Enclosed is the \$1,600.00 fee set forth in 37 CFR § 1.21(a)(10)." Additionally, Petitioner did not check either of the boxes for 8b ("Registration

Examination Fee”) that designate the method of test administration he would utilize and the accompanying fee to be paid. Further, Petitioner did not submit payment for the \$1600.00 application fee or either one of the examination registration fees (\$200.00/\$450.00) required for previously suspended practitioners. Instead, Petitioner modified the application form with, apparently, his own handwritten notations. In one instance, Petitioner checked the Reinstatement box and altered the form language to read:

Reinstatement: I am applying for reinstatement, ~~or as a former government employee, for a change from inactive to active status.~~ Enclosed is any required fee under 37 CFR § 1.21. (a)(3) (strike through and underline indicating Petitioner’s handwritten notations).

Petitioner submitted one \$40.00 payment with his application.

The OED Director also determined that Petitioner did not provide documentation in response to his “Yes” entries to Questions 15 and 18 of the background information portion of his application.¹ The application instructions state that “for each question answered “Yes,” provide a detailed statement setting forth all relevant facts and dates along with verified copies of relevant documents.” As a result of Petitioner’s application submission, a June 9, 2008, *Notice of Incompleteness and Denial of Admission* was issued by OED staff.

¹ Both Questions 15 and 18 are relevant to assessing whether an applicant may have the necessary moral character and competence to represent others before the Office. Question 15 asks: “Have any charges ever been preferred against you in connection with your practice before any Federal or State court, or municipal bureau, commission, office or agency, of any kind or character?” Question 18 asks: “Have you ever been disciplined, reprimanded, or suspended in any job, or have been asked to resign or quit for conduct involving dishonesty, fraud, misrepresentation, deceit, or any violation of federal or State laws or regulations?”

II. ANALYSIS

The Director of the USPTO is given statutory authority to require a showing by patent practitioners that they are “possessed of the necessary qualifications to render applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office.” 35 U.S.C. § 2(b)(2)(D). 37 C.F.R. § 11.7(a)(2) states that an applicant must establish to the satisfaction of the OED Director that he or she possess good moral character and reputation; possess the legal scientific, and technical qualifications necessary for him or her to render applicants valuable service; and is competent to advise and assist patent applicants in the presentation and prosecution of their application before the Office. With respect to reinstatement to practice before the USPTO after suspension, 37 C.F.R. § 11.7(h)(4)(ii) states that:

An individual who has been disbarred or suspended, or who resigned in lieu of a disciplinary proceeding shall file an application for registration and the fees required by § 1.21(a)(1)(ii) and (a)(10) of this subchapter; provide a full and complete copy of the proceedings that led to the disbarment, suspension, or resignation; and provide satisfactory proof that he or she possess good moral character and reputation.

In Petitioner’s case, he provides no basis to warrant a grant of his petition for review of the OED Director’s decision. The OED Director noted that Petitioner was

previously suspended from practice before the Office on ethical grounds, which Petitioner does not deny.² Petitioner appears to assume, mistakenly, that he is only required to pay one fee for admission to practice before the USPTO—the 37 C.F.R. § 1.21(a)(3) \$40.00 reinstatement fee. However, it is clear that in accordance with 37 C.F.R. § 11.7, any previously suspended practitioner that files an application for registration is required, among other criteria, to pay the fee schedule as set forth in 37 C.F.R. § 1.21(a)(1)(ii) and (a)(10). Petitioner failed to check either of the applicable 8a and 8b entries or pay the required fees for a previously suspended applicant. Additionally, Petitioner has been repeatedly informed in previous USPTO decisions of the need to take and pass the registration examination.

Rather, in his petition, Petitioner appears to claim that he is entitled to a waiver of these fee or examination requirements. In support, his petition refers to arguments made in previous letters filed with OED. In one such letter, Petitioner requests:

a waiver UNDER 37 CFR 11.2(c) of the requested fees and the taking of the examination (Attachment B) on the following grounds: a) Klein is a 60% disabled World War II veteran (see for example, “VIII. REASONABLE ACCOMODATIONS” of the “General Registration to Practice in Patent Cases”); b) [redacted] has previously passed the USPTO examination; c) the payment of the fees listed herinabove is beyond [redacted] financial capabilities; d) [OED Staff attorney] [redacted] reliance on Toupin having sustained OED Director Moatz’s requirement for [redacted] to take the USPTO examination is not as clear as [redacted] has stated.

² Although Petitioner does not dispute the fact that he was suspended by the Office from practice on ethical grounds, he apparently believes, *inter alia*, that the process by which he was suspended was “inherently unethical and unconstitutional.” Petitioner’s July 15, 2008, Petition for Review.

submits page 3 of Toupin's MEMORANDUM AND ORDER dated 4/16/08 (Attachment C) in which Toupin ruled that: "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 the USPTO "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." Consequently, even after _____ has paid the requested fees and passed the USPTO examination, the OED and or Toupin have not committed themselves to reinstate _____. e) there are presently pending the the Office of the Inspector General of the U.S. Department of Commerce (OIG) Hotline Complaints Nos. 2, 4, 5, 6 and 7 none of which have been acted on by OIG; and f) _____'s FOIA Request No. 08-029 has only been partially answered by OIG and is still pending before the OIG. [sic] Petitioner's May 28, 2008, letter to Office of the Inspector General.

Petitioner's claims are without merit. First, there is no waiver provision under 37 C.F.R. § 11.2(c). Second, there is no waiver provision available from such requirements based on either military or disability status. Nor is there any waiver of fee requirements based on an alleged inability to pay such fees. Petitioner argues that he has previously passed the USPTO examination, but provides no further explanation. USPTO has no record of Petitioner passing the registration test following his suspension. Any claim that Petitioner had passed the examination when he first became registered (before his

suspension) is of no consequence to complying with 37 C.F.R. § 10.160. There is also no dispute, contrary to Petitioner's claim, that the terms of any reinstatement clearly require Petitioner to pass the registration examination ("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)." April 16, 2008, USPTO Decision on Request for Reconsideration. Finally, Petitioner apparently references a number of alleged "Hotline Complaints" he made to the Department of Commerce's Inspector General. It appears that Petitioner has claimed the process by which he was suspended was somehow improper, though the nature of his claim is unclear. Whatever the nature of Petitioner's argument, it cannot absolve his requirement to pay the required fees or pass the registration examination. Furthermore, in the event that Petitioner is somehow contesting the nature or outcome of his initial suspension for practice before the Office, all such issues have long since been finally resolved and have no bearing on his present petition.

As a previously suspended practitioner, Petitioner is required to submit payment of \$1600.00 under 37 C.F.R. § 1.21 (a)(10) and one of the examination fees under 37 C.F.R. § 1.219a)(1)(ii). Petitioner is also required to take and pass the registration examination as part of a condition of reinstatement. As the OED Director appropriately noted, petitioner's failure to pay the requisite \$1600.00 application fee for a previously suspended practitioner results in Applicant's underlying application not being further considered. Petitioner's application also remains incomplete because of the failure to

remit the examination fee, and the failure to provide further documentary information related to his affirmative responses for Questions 15 and 18 of his application form.³

III. CONCLUSION

The OED Director's Decision correctly determined that Petitioner failed to demonstrate compliance with all of the necessary fee requirements of 37 C.F.R. § 1.21(a)(1)(ii) and (a)(10) and failed to complete all of the application information sufficient to establish compliance with the requirements of 37 C.F.R. 11.7. Accordingly, the OED Director properly denied his petition for admission.

³ The OED Director found that, although the Petitioner referenced his previous suspension in discussing his response to questions 15 and 18, he did not provide any documentation as required. For a further description of the documentary requirements see the General Requirements Bulletin at Pg. 13.

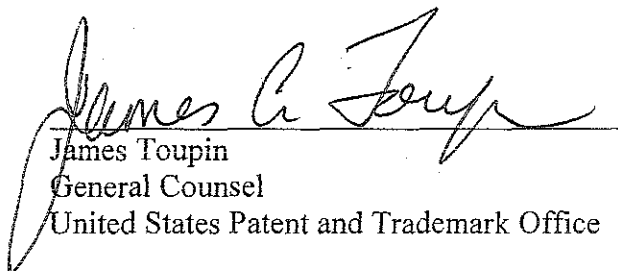
ORDER

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

OCT 21 2008

Date


James Toupin
General Counsel
United States Patent and Trademark Office

cc:

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