

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE**

In the Matter of)	
)	
John L. Isaac,)	Proceeding No. D08-26
)	
Respondent)	
)	

Final Order

Director of the Office of Enrollment and Discipline Harry I. Moatz (“OED Director”) and John L. Isaac (“Respondent”) have submitted a proposed settlement agreement to the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office or his designate (“USPTO Director”). The parties have also submitted an affidavit executed by Respondent pursuant to 37 C.F.R. § 11.27.

The OED Director and Respondent’s proposed settlement agreement sets forth certain stipulated facts, legal conclusions, and sanctions to which the OED Director and Respondent have agreed in order to obviate an administrative hearing. The proposed settlement agreement, which satisfies the requirements of 37 C.F.R. § 11.26 resolves all disciplinary action by the United States Patent and Trademark Office (“USPTO” or “Office”) arising from the evidence previously submitted to the USPTO’s Committee on Discipline in connection with this disciplinary proceeding.

Pursuant to such proposed settlement agreement, this Final Order sets forth the parties’ stipulated facts, joint legal conclusions, and agreed upon discipline.

Stipulated Facts

1. At all times relevant hereto, Respondent of Lakewood, Colorado, has been an attorney registered to practice patent law before the Office (Registration Number 26,282) and is subject to the USPTO Code of Professional Responsibility set forth at 37 C.F.R. § 10.20 et seq.

2. Respondent had been licensed to practice law in the State of Colorado (Bar Number 11,387) and the State of Illinois (date of admission: November 27, 1983). As of the date of this proposed settlement agreement, however, Respondent is not authorized to practice law in either of those jurisdictions for administrative reasons.

3. During the past five years, Respondent was hired by several clients to prepare and prosecute U.S. patent applications on their behalf.

4. In several of those cases, applications became abandoned without the consent of the clients due to Respondent's failure to provide a timely reply to an USPTO office action.

5. In several cases, Respondent did not take adequate steps to inform the clients of the abandoned applications or to revive the abandoned applications.

6. In several cases, Respondent did not take adequate steps to revive the abandoned applications even though Respondent informed the clients and the USPTO that Respondent would do so or had done so.

7. During the relevant time period, Respondent suffered serious health issues to which Respondent attributes, in some part, to the violations of the USPTO Code of Professional Responsibility set forth below.

8. During the relevant time period, a member of Respondent's family also suffered serious health issues to which Respondent attributes, in some part, to the violations of the USPTO Code of Professional Responsibility set forth below.

Legal Conclusions

9. Based on the information contained in paragraphs 1 through 8, above, Respondent acknowledges that his conduct violated the following Disciplinary Rules of the USPTO Code of Professional Responsibility:

- a. 37 C.F.R. § 10.77(c) by allowing applications to go abandoned without the consent of the clients;
- b. 37 C.F.R. §§ 10.23(b)(4) by making misrepresentations to clients and the USPTO about having taken action to revive certain applications;
- c. 37 C.F.R. § 10.23(b)(5) by making misrepresentations to the USPTO during the course of a disciplinary investigation; and
- d. 37 C.F.R. § 10.84(a) by not representing clients zealously.

Sanctions

10. Respondent agreed, and it is ORDERED that:

- a. Respondent be, and hereby is, excluded on consent from practicing patent, trademark, and other non-patent law before the Office beginning on the date of this Final Order;
- b. Respondent be, and hereby is, granted limited recognition to practice before the Office beginning on the date of this Final Order and expiring sixty (60) days after the date of this Final Order;

- c. During the period of limited recognition afforded under this Final Order, Respondent shall wind up all client business before the Office and shall withdraw from employment in all pending proceedings in accordance with 37 C.F.R. § 10.40;
- d. During the period of limited recognition afforded under this Final Order, Respondent shall not accept any new clients having business before the Office;
- e. The OED Director shall publish this Final Order;
- f. The OED Director shall publish the following Notice in the Official Gazette:

Notice of Exclusion on Consent

John L. Isaac of Lakewood, Colorado, a patent attorney whose Registration Number is 26,282, has been excluded on consent by the United States Patent and Trademark Office for violating 37 C.F.R. §§ 10.77(c) by allowing applications to go abandoned without the consent of the clients, 10.23(b)(4) by making misrepresentations to clients and the USPTO about having taken action to revive certain applications, 10.23(b)(5) by making misrepresentations to the USPTO during the course of a disciplinary investigation, and 10.84(a) by not representing clients zealously. This action is taken pursuant to the provisions of 35 U.S.C. § 32 and 37 C.F.R. §§ 11.26, 11.27, and 11.59.

- g. The OED Director shall, in accordance with 37 C.F.R. § 11.59, give notice to the state bars of the State of Colorado and the State of Illinois and to appropriate employees of the Office and to interested departments, agencies, and courts of the United States that Respondent has been excluded on consent from practice before the Office;
- h. Within 60 days of the date of this Final Order, Respondent shall surrender each client's active USPTO case file(s) to each client or another practitioner designated by each client, and shall file proof thereof with the OED Director within the same 60-day period;
- i. Respondent shall cooperate in good-faith with the practitioner to whom a file is surrendered in order to prevent the client's interests from being harmed as a result of the file transfer and shall do so at no charge to the client or practitioner;
- j. Upon expiration of the period of limited recognition afforded by this Final Order, Respondent shall forward immediately any communication relating to a client matter that is addressed to Respondent and/or received by him for the client or the practitioner designated by the client, and, in accordance with 37 C.F.R. §§

11.58(a) and (b)(5), shall take no other legal action in the matter, enter any appearance, or provide any legal advice concerning the matter that is the subject of the communication;

- k. Within 30 days of the date of this Final Order, Respondent shall, in accordance with 37 C.F.R. §§ 11.58(b)(1)(v), return to any client having immediate or prospective business before the Office any unearned legal funds, including any unearned retainer fee, and any securities and property of the client, and shall file proof thereof with the OED Director no later than filing his petition for reinstatement;
- l. Respondent shall: 1) promptly take steps to comply with the provisions of 37 C.F.R. §§ 11.58(b)(1)(vi), (b)(4), and (b)(6); and 2) within 45 days of taking steps to comply with § 11.58(b)(1)(vi), file with the OED Director an affidavit describing the precise nature of the steps taken;
- m. Upon expiration of the period of limited recognition afforded by this Final Order, Respondent shall comply immediately with 37 C.F.R. §§ 11.58(b)(3) and (b)(5);
- n. Except as provided in paragraphs 10.b. and 10.c., above, Respondent shall comply with the provisions of 37 C.F.R. §§ 11.58(a) and (e) as of the date of this Final Order;
- o. Upon filing a petition for reinstatement under 37 C.F.R. § 11.60, Respondent shall submit proof of compliance with §§ 11.58(b)(2), (b)(3), (b)(4), (b)(5), (b)(6), and 11.58(f) with the OED Director and to otherwise comply with 37 C.F.R. § 11.60; and
- p. The OED Director and Respondent shall each bear their own costs incurred to date and in carrying out the terms of this agreement.

11 Dec. 2008

Date



James A. Toupin

General Counsel

United States Patent and Trademark Office

on behalf of

Jon W. Dudas

Under Secretary of Commerce for Intellectual

Property and Director of the United States

Patent and Trademark Office