

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

In the Matter of)	
)	
Peter R. Martinez,)	
)	Proceeding No. D09-27
Respondent)	
)	
)	
)	
)	
)	

Final Order

Office of Enrollment and Discipline Director Harry I. Moatz (“OED Director”) and Peter R. Martinez (“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 (“USPTO Director”) or his designate for approval.

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 resolve voluntarily a disciplinary complaint against Respondent. 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 stipulated facts set forth below.

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

Stipulated Facts

1. At all times relevant hereto, Respondent of San Diego, California, has been registered as an attorney to practice before the United States Patent and Trademark Office (“USPTO” or “the Office”) and is subject to the Disciplinary Rules of the USPTO Code of Professional Responsibility set forth at 37 CFR § 10.20 *et seq.* Respondent’s registration number is 42,845.
2. Respondent has been admitted to practice as an attorney in the State of California since June 1, 1998 (Bar Number 195154).
3. In response to a Notice to File Missing Parts dated April 5, 2006 concerning U.S. Patent Application No. XXX,XXX (“664 application”), Respondent submitted on May 22, 2006 to the Office a “Declaration and Power of Attorney for Patent Application.” The “Declaration and Power of Attorney” bears the signed name of an inventor and is dated

March 31, 2006. The "Declaration and Power of Attorney" failed to appoint any registered practitioner to represent the inventor because the power of attorney was left blank.

4. On November 15, 2006, the Office sent a communication to Respondent concerning the '664 application stating that the power of attorney dated March 31, 2006 did not comply with the new Power of Attorney Rules that became effective on June 25, 2004.

5. The Office sent a Notice of Allowance to Respondent dated January 10, 2007. Thereafter, the Office sent a Notice of Abandonment to Respondent dated August 27, 2007 because requirements for drawing corrections set forth in the Notice of Allowance had not been satisfied.

6. On October 23, 2007, Respondent submitted to the Office a petition to revive the '664 application together with a terminal disclaimer. The terminal disclaimer was signed by Respondent. An attorney of record may sign a terminal disclaimer. 37 C.F.R. § 1.321(b)(1)(iv).¹ Respondent was not an attorney of record at the time the terminal disclaimer was filed.

7. The Office sent a Decision to Respondent dated April 8, 2008 dismissing the petition to revive because Respondent was not authorized to sign the terminal disclaimer inasmuch as a power of attorney appointing Respondent had not been filed.

8. Respondent states that he discussed the dismissed petition with his assistant and attempted to convey what was required to the assistant. Respondent states that his assistant apparently added Respondent's name to the already executed "Declaration and Power of Attorney" instead of obtaining a newly executed "Declaration and Power of Attorney" containing an appointment of Respondent to represent the applicant. On April 11, 2008, Respondent submitted a renewed petition to revive the '664 application together with the already executed "Declaration and Power of Attorney" wherein his name had been added in handwriting in the space for a power of attorney. Respondent surmises that he failed to spot the inventor's execution date before submitting the already executed "Declaration and Power of Attorney."

9. In a Decision mailed June 17, 2008, the Office did not accept the power of attorney submitted April 11, 2008, noting the discrepancy in the record that made it unclear as to whether a proper power of attorney existed in the '664 application.

10. In the investigation by OED that followed, Respondent accepted full responsibility for submitting the terminal disclaimer when a power of attorney had not been submitted.

11. A practitioner must give non-practitioner assistants appropriate instruction and supervision concerning the ethical aspects of their employment. The practitioner is

¹ The Proposed Settlement Agreement references 37 C.F.R. § 1.321(d)(3), but it appears that the parties intended to reference § 1.321(b)(1)(iv).

responsible for their work product. Therefore, the measures employed in supervising non-practitioners should account of the fact that they do not have legal training.

Legal Conclusions

12. Based on the information contained in paragraphs 1 through 11, Respondent acknowledges that his conduct violated:

- a. 37 CFR § 10.23(b)(5), which proscribes engaging in conduct prejudicial to the administration of justice, and
- b. 37 CFR § 10.77(b), which proscribes handling a legal matter without preparation adequate in the circumstances.

Sanction

13. Respondent agreed, and it is hereby Ordered that:

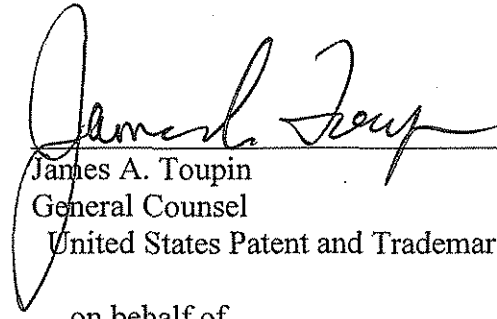
- a. Respondent be, and hereby is, publicly reprimanded;
- b. The OED Director shall publish this Final Order;
- c. The OED Director shall publish the following Notice in the *Official Gazette*:

Notice of Reprimand

Peter R. Martinez of San Diego, California, who is a registered patent attorney (Registration Number 42,845), has been reprimanded by the United States Patent and Trademark Office for violating 37 CFR §§ 10.23(b)(5) and 10.77(b) by submitting to the Office a terminal disclaimer he had signed though he was not an attorney of record at that time, and by resubmitting to the Office a previously executed "Declaration and Power of Attorney" wherein his name was added to the power of attorney portion of the previously executed document apparently by an assistant though the "Declaration and Power of Attorney" had been previously submitted to the Office without appointment of any registered practitioner to represent the applicant, and by failing to adequately supervise non-practitioner staff upon whom he relied. This action is taken pursuant to the provisions of 35 U.S.C. § 2(b)(2)(D) and 37 CFR §§ 11.20(a)(3), 11.26 and 11.59. Disciplinary decisions involving practitioners are posted for public reading at the Office of Enrollment and Discipline's Reading Room located at: <http://des.uspto.gov/Foia/OEDReadingRoom.jsp>.

- d. In accordance with 37 C.F.R. § 11.59, the OED Director shall give notice of public discipline and the reasons for the discipline to disciplinary enforcement agencies in the State where the practitioner is admitted to practice, to courts where the practitioner is known to be admitted, and the public; and
- e. The OED Director and Respondent shall each bear their own costs incurred to date and in carrying out the terms of this agreement.

MAY 1 2009
Date



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

on behalf of

John J. Doll
Acting Under Secretary of Commerce for
Intellectual Property and Acting Director of the
United States Patent and Trademark Office

cc:

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