

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

In the Matter of:

William F. Prendergast,

Respondent

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Proceeding No. D2010-02

FINAL ORDER PURSUANT TO 37 C.F.R. § 11.24

Pursuant to 37 C.F.R. § 11.24(d), the exclusion of William F. Prendergast (Respondent) from the practice of patent, trademark, and other non-patent law before the United States Patent and Trademark Office (USPTO or Office) is hereby ordered for violation of the ethical standard set out in 37 C.F.R. § 10.23(b)(6) via 37 C.F.R. §§ 10.23(c)(5) and 11.24(a) (patent practitioner deemed disbarred where practitioner has resigned in lieu of a disciplinary proceeding).

A “Notice and Order Under 37 C.F.R. § 11.24” mailed December 11, 2009, (Notice and Order) informed Respondent that the Director of the Office of Enrollment and Discipline (OED Director) had filed a “Complaint for Reciprocal Discipline Pursuant to 37 C.F.R. § 11.24” (Complaint) requesting that the USPTO Director impose reciprocal discipline upon Respondent, namely: exclusion from the practice of patent, trademark, and other non-patent law before the Office. The request for exclusion of the Respondent in the Complaint was based upon the September 22, 2009, order of the State of Illinois Supreme Court (In re: M.R. 23191) allowing Respondent’s motion to strike his name from the roll of attorneys licensed to practice law in Illinois. The Notice and Order directed that if

Respondent seeks to contest imposition of his exclusion from practice pursuant to 37 C.F.R. § 11.24(d), Respondent shall file, within 40 days, a response containing all information Respondent believes is sufficient to establish a genuine issue of material fact that the imposition of discipline identical to that imposed by the State of Illinois Supreme Court would be unwarranted based upon any of the grounds permissible under 37 C.F.R. § 11.24(d)(1).

Respondent has not filed a response to the Notice and Order. 37 C.F.R. § 11.24(d)(1). Accordingly, the USPTO Director hereby determines that: 1) there is no genuine issue of material fact under 37 C.F.R. § 11.24(d) and 2) exclusion of Respondent from practice before the USPTO is appropriate.

ACCORDINGLY, it is hereby **ORDERED** that:

(a) Respondent is excluded from the practice of patent, trademark, and other non-patent law before the Office, beginning on the date of this Final Order indicated below;

(b) Respondent is granted limited recognition to practice before the Office beginning on the date of this Final Order and expiring thirty (30) days after the date of this Final Order;

(c) Respondent is directed, during the time of his limited recognition to wind up all client business before the Office and to withdraw from employment in all pending proceedings in accordance with 37 C.F.R. § 10.40;

(d) Respondent is directed not to accept any new clients having business before the Office during the 30 days of limited recognition afforded by this Final Order;

(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

William F. Prendergast of Chicago, Illinois, registered patent attorney (Registration Number 34,699). Mr. Prendergast has been excluded from the practice of patent, trademark, and non-patent law before the United States Patent and Trademark Office for violating 37 C.F.R. § 10.23(b)(6) via 37 C.F.R. § 10.23(c)(5) by consenting to have his name stricken from the roll of attorneys licensed to practice in Illinois by the State of Illinois Supreme Court, a duly constituted authority of a State. The State of Illinois Supreme Court granted Mr. Prendergast's motion to have his name stricken from the roll of attorneys licensed to practice law in Illinois at a time when disciplinary charges were pending against him in that jurisdiction. Mr. Prendergast admitted to the State of Illinois Supreme Court that, if disciplinary proceedings were to have been brought against him, the evidence would clearly and convincingly establish violation of that jurisdiction's code of professional responsibility predicated upon, *inter alia*: allowing at least twenty-four (24) patent applications to become abandoned without the consent of the clients, falsely informing his law firm's docketing department that the clients had consented to the abandonments, and concealing the abandonments from the clients via the fabrication of documents and other false pretenses. This action is taken pursuant to the provisions of 35 U.S.C. §§ 2(b)(2)(D) and 32, and 37 C.F.R. §§ 11.24 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>.

(g) Respondent shall comply fully with 37 C.F.R. § 11.58 while excluded;

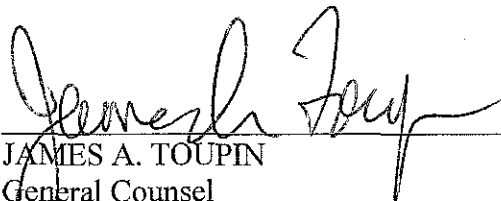
(h) the OED Director, in accordance with 37 C.F.R. § 11.59, shall give notice of the public discipline and the reasons for the discipline to disciplinary enforcement agencies in the State where the practitioner is admitted to practice, to courts where the practitioner is known to be admitted, and the public;

(i) Respondent shall comply fully with 37 C.F.R. § 11.60 upon any request for reinstatement.

[signature page follows]

FEB 18 2010

Date



JAMES A. TOUPIN
General Counsel
United States Patent and Trademark Office

on behalf of

David Kappos
Under Secretary of Commerce For Intellectual
Property and Director of the United States Patent
and Trademark Office

CERTIFICATE OF SERVICE

I certify that the foregoing Final Order Under 37 C.F.R. § 11.24 was mailed first class certified mail, return receipt requested, this day to the Respondent at the following address provided to OED pursuant to 37 C.F.R. § 11.11:

William F. Prendergast

[REDACTED]

and to attorney William J. Harte, who has informed the Office of Enrollment and Discipline that he would accept service of process for Mr. Prendergast, at the following address:

William J. Harte

[REDACTED]

FEB 18 2010

Date



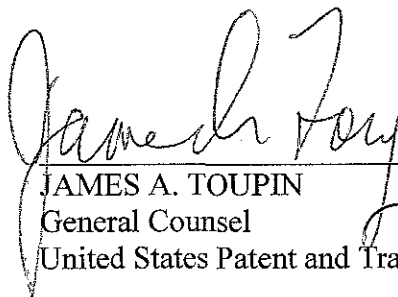
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

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