

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

In the Matter of)

Michael I. Kroll,)

Respondent)

Proceeding No. D2008-15

Final Order

Office of Enrollment and Discipline Director Harry I. Moatz (“OED Director”) and Michael I. Kroll (“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.

Jurisdiction

At all times relevant hereto, Respondent of Syosset, New York, has been an attorney registered to practice before the USPTO and is subject to the Disciplinary Rules of the USPTO Code of Professional Responsibility set forth at 37 C.F.R. § 10.20 *et seq.*

The USPTO Director has jurisdiction over this matter pursuant to 35 U.S.C. §§ 2(b)(2)(D) and 32, and 37 C.F.R. §§ 11.20, 11.26 and 11.59

Stipulated Facts

1. Respondent of Syosset, New York, is an attorney registered to practice patent law before the Office (Registration Number 26,755) and is subject to the USPTO Disciplinary Rules set forth at 37 C.F.R. § 10.20 *et seq.*

Representation of Client C.

2. Respondent was hired by Client C. to prepare, submit, and prosecute a patent application before the Office.

3. During the course of his representation of Client C., Respondent did not adequately communicate with the client about the status of the client's patent application and failed to inform her of correspondence from the Office having a significant effect on the application.

4. Respondent neglected the prosecution of the application and, consequently, it became abandoned.

5. After the Office of Enrollment and Discipline contacted Respondent about the manner in which he was handling Client C.'s application, Respondent subsequently took action to revive the application.

Representation of Clients on Whose Behalf Respondent Filed U.S. and Foreign Patent Applications

6. Respondent was hired by numerous clients to prepare, submit, and prosecute U.S. and foreign patent applications.

7. On behalf of those clients, Respondent filed U.S. patent applications containing requests that that the applications not be published.

8. Subsequent to filing the U.S. applications with non-publication requests, Respondent filed patent applications on the same invention claimed in the U.S. patent applications in another country, or under a multilateral international agreement, that required publication of applications 18 months after filing. Respondent, however, did not notify the USPTO Director of the foreign or international applications not later than 45 days after the date of each such foreign or international filing.

9. Because Respondent did not notify the USPTO Director of the foreign or international applications not later than 45 days after the date of each such foreign or international filing, the corresponding U.S. applications became abandoned by operation of 35 U.S.C. § 122(b)(2)(B)(iii).

10. Respondent represents that he was unaware that U.S. applications had become abandoned by operation of law pursuant to 35 U.S.C. § 122(b)(2)(B)(iii).

11. After the Office of Enrollment and Discipline notified Respondent that certain of his clients' applications had become abandoned by operation of law pursuant to 35 U.S.C. § 122(b)(2)(B)(iii), Respondent subsequently took action to revive all but one of the applications, for which a petition to revive is currently being considered by the Office of Petitions.

Other Factors

12. Respondent has been previously disciplined for violating the USPTO Code of Professional Responsibility. See Harry I. Moatz v. Michael I. Kroll, Disciplinary Proceeding D03-07 (February 24, 2004, Final Order).

Legal Conclusions

13. Based on the stipulated facts, Respondent acknowledges that his conduct violated 37 C.F.R. § 10.23(b)(6) by engaging in conduct that adversely reflects on his fitness to practice before the office, 37 C.F.R. § 10.23(c)(8) by failing to inform a client of correspondence from the Office having a significant effect on a matter pending before the Office, and 37 C.F.R. § 10.77(c) by neglecting matters entrusted to him.

Sanction

14. Respondent agreed, and it is ORDERED that:

- a. Respondent is suspended for a period of sixty (60) months from the practice of patent, trademark, and non-patent law before the USPTO commencing on the date the Final Order is signed;
- b. the entirety of the sixty-month suspension is immediately stayed as of the date the Final Order is signed and that the stay remain in effect until further order of the USPTO Director or his designate;
- c. Respondent is placed on probation for a period of sixty (60) months commencing on the date the Final Order is signed;
- d. Respondent shall be permitted to practice patent, trademark, and non-patent law before the USPTO while on probation unless the stay of the suspension is lifted and Respondent is suspended by order of the USPTO Director or his designate as set forth in subparagraph g, below, or Respondent is otherwise suspended or excluded from practice before the USPTO;
- e. (1) if the OED Director is of the opinion that Respondent, during the sixty (60) month period commencing on the date the Final Order is signed, failed to comply with any provision of the Final Order or any Disciplinary Rule of the USPTO Code of Professional Responsibility, the OED Director shall:

(A) issue to Respondent an Order to Show Cause why the USPTO Director or his designate should not enter an order lifting the stay of the suspension and immediately suspend Respondent for up to sixty (60) months for the violations set forth in paragraph 13, above;

(B) send the Order to Show Cause to Respondent at the last address of record Respondent furnished to the OED Director pursuant to 37 C.F.R. § 11.11(a); and

(C) grant Respondent fifteen (15) days to respond to the Order to Show Cause;

and

(2) in the event after the 15-day period for response and consideration of the response, if any, received from Respondent, the OED Director continues to be of the opinion that Respondent, during the sixty (60) month period commencing on the date the Final Order is signed, failed to comply with any provision of the Final Order or any Disciplinary Rule of the USPTO Code of Professional Responsibility, the OED Director shall:

(A) deliver to the USPTO Director or his designate: (i) the Order to Show Cause, (ii) Respondent's response to the Order to Show Cause, if any, and (iii) evidence causing the OED Director to be of the opinion that Respondent, within sixty (60) months from the date the Final Order is signed, failed to comply with any provision of the Final Order or any Disciplinary Rule of the USPTO Code of Professional Responsibility, and

(B) request that the USPTO Director or his designate enter an order lifting the stay of the suspension and immediately suspend Respondent for up to sixty (60) months for the violation set forth in paragraph 13, above;

f. if Respondent is suspended pursuant to the provisions of subparagraph e., above:

(1) Respondent shall comply with 37 C.F.R. § 11.58;

(2) the OED Director shall disseminate information in accordance with 37 C.F.R. § 11.59;

(3) the USPTO shall promptly dissociate Respondent's name from all USPTO customer numbers and PKI certificates;

(4) Respondent shall not to use any USPTO customer number or PKI certificate unless and until he is reinstated to practice before the USPTO;

and

(5) Respondent may not obtain a USPTO customer number or a PKI certificate unless and until he is reinstated to practice before the USPTO;

- g. nothing in the Proposed Settlement Agreement or the Final Order shall limit the number of times the OED Director or the USPTO Director may act pursuant to the provisions of subparagraph e., above, for Respondent's acts and/or omissions occurring during the sixty (60) month period commencing on the date the Final Order is signed;
- h. in the event that the USPTO Director or his designate enters an order lifting the stay of the suspension and immediately suspending Respondent for up to sixty (60) months, and Respondent seeks a review of the USPTO Director's action, any such review shall not operate to postpone or otherwise hold in abeyance the order of the USPTO Director or his designate;
- i. if Respondent is not suspended pursuant to the provisions of subparagraph e., above, for acts and/or omissions occurring during the sixty (60) month period commencing on the date the Final Order is signed, then Respondent is not required to serve the suspension;
- j. Respondent pay to the client identified as "Client C." in paragraphs 2 through 5, above, the lump sum amount of seven thousand and six hundred dollars (\$7,600.00) within thirty (30) days of the date the Final Order is signed;
- k. Respondent submit an affidavit to the OED Director within forty-five (45) days of the date the Final Order is signed showing that he timely paid to the client identified as "Client C." in paragraphs 2 through 5, above, the lump sum amount of seven thousand and six hundred dollars (\$7,600.00);
- l. within sixty (60) days from the date the Final Order is signed, Respondent provide a copy of the Final Order to all of Respondent's clients who have provisional and/or non-provisional utility and/or design patent applications pending before the Office on the date the Final Order is signed;
- m. Respondent need not provide a copy of the Final Order to clients who are aware that the Office has issued a Notice of Abandonment on their respective patent application and who, with knowledge of the Notice of Abandonment, have instructed Respondent to take no further action on the application;
- n. Respondent submit an affidavit to the OED Director within seventy-five (75) days from the date the Final Order is signed showing that he timely provided a copy of the Final Order to clients required to be so notified;
- o. the OED Director file a motion dismissing the pending disciplinary proceeding within twenty (20) days from the date the Final Order, is signed;

- p. the OED Director publish the Final Order at the Office of Enrollment and Discipline's Reading Room electronically located at:
<http://des.uspto.gov/Foia/OEDReadingRoom.jsp>;
- q. OED Director publish the following Notice of Suspension in the *Official Gazette*:

Notice of Suspension

Michael I. Kroll of Syosset, New York registered patent attorney (Registration Number 26,755). Mr. Kroll has been suspended for sixty (60) months, with the entirety of the suspension stayed and placed on probation for sixty (60) months by the United States Patent and Trademark Office ("USPTO" or "Office") for violating 37 C.F.R. § 10.23(b)(6) by engaging in conduct that adversely reflects on his fitness to practice before the Office, 37 C.F.R. § 10.23(c)(8) by failing to inform a client of correspondence from the Office having a significant effect on a matter pending before the Office, and 37 C.F.R. § 10.77(c) by neglecting matters entrusted to him. Mr. Kroll is permitted to practice before the Office unless the stay of the suspension is lifted and he is suspended by order of the USPTO Director or his designate.

During the course of his representation of a client for whom Mr. Kroll had been hired to prepare, submit, and prosecute a patent application before the Office, Mr. Kroll did not adequately communicate with the client about the status of the client's patent application and failed to inform her of correspondence from the Office having a significant effect on the application. Moreover, he neglected the prosecution of the application and, consequently, it became abandoned. After the Office of Enrollment and Discipline contacted Mr. Kroll about the matter, Mr. Kroll subsequently revived the application. Also, Mr. Kroll was hired by numerous clients to prepare, submit, and prosecute U.S. and foreign patent applications. On behalf of those clients, Mr. Kroll filed U.S. patent applications containing requests that the applications not be published. Subsequent to filing the U.S. applications with non-publication requests, he filed foreign patent applications on the same invention claimed in the U.S. patent applications. Mr. Kroll, however, did not notify the USPTO Director of the foreign or international applications not later than 45 days after the date of each such foreign or international filing and, therefore, the corresponding U.S. applications became abandoned by operation of 35 U.S.C. § 122(b)(2)(B)(iii). Mr. Kroll represents that he was

unaware that the U.S. applications had become abandoned by operation of law. After the Office of Enrollment and Discipline notified Mr. Kroll about the matter, Mr. Kroll subsequently revived all but one of the applications, for which a petition to revive is currently being considered by the Office of Petitions.

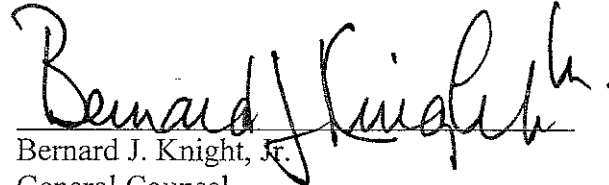
This action is taken pursuant to a settlement agreement between Mr. Kroll and the USPTO pursuant to the provisions of 35 U.S.C. §§ 2(b)(2)(D) and 32, and 37 C.F.R. §§ 11.26 and 11.59. Disciplinary decisions regarding practitioners are posted at the Office of Enrollment and Discipline's Reading Room electronically located at:
<http://des.uspto.gov/Foia/OEDReadingRoom.jsp>.

- r. pursuant to 37 C.F.R. § 11.59, the OED Director give notice of the public discipline and the reasons for the discipline to disciplinary enforcement agencies in the state(s) where Respondent is admitted to practice, to courts where Respondent is known to be admitted, and to the public;
- s. nothing in the Proposed Settlement Agreement or the Final Order shall prevent the Office from seeking discipline against Respondent in accordance with the provisions of 37 C.F.R. §§ 11.34 through 11.57 for Respondent's acts and/or omissions upon which an Order to Show Cause is issued by the OED Director under subparagraph e., above;
- t. (1) a violation of any Disciplinary Rule occurring prior to the date the Final Order is signed is not subject to the provisions of subparagraph e., above;
(2) a violation of any Disciplinary Rule occurring during the probationary period is subject to the provisions of subparagraph e., above; and
(3) should a grievance filed in the future against Respondent involve more than one violation of a Disciplinary Rule or Rules occurring over a period of time, then the violation(s) of Disciplinary Rules occurring prior to the date the Final Order is signed are not subject to the provisions of subparagraph e., above, but the violations occurring during the probation are subject to the provisions of subparagraph e., above;
- u. the record of this disciplinary proceeding, including the Final Order, be considered (1) when addressing any further complaint or evidence of the same or similar misconduct brought to the attention of the Office, and/or (2) in any future disciplinary proceeding (a) as an aggravating factor to be taken into consideration in determining any discipline to be imposed and/or (b) to rebut any statement or representation by or on Respondent's behalf; and

- v. the OED Director and Respondent bear their own costs incurred to date and in carrying out the terms of this agreement.

MAY 25 2010

Date



Bernard J. Knight, Jr.
General Counsel
United States Patent and Trademark Office

on behalf of

David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of United States Patent and Trademark Office

cc:

Harry I. Moatz
Director Office of Enrollment and Discipline
U.S. Patent and Trademark Office
Mail Stop OED
P.O. Box 1450
Alexandria, Virginia 22313-1450

Michael I. Kroll
115 Eileen Way
Suite 105
Syosset, NY 11791

Edwin D. Schindler
Five Hirsch Avenue
P.O. Box 966
Coram, NY 11727
Counsel for Respondent

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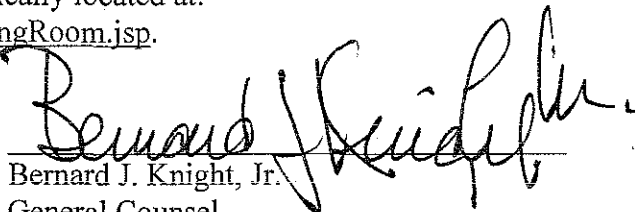
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