

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

In the Matter of)	
)	
Thomas J. Perkowski,)	Proceeding No. D2011-11
)	
Respondent)	

FINAL ORDER

The Director of the Office of Enrollment and Discipline (“OED Director”) for the United States Patent and Trademark Office (“USPTO” or “Office”) and Thomas J. Perkowski (“Respondent”) have submitted a Proposed Settlement Agreement to the Under Secretary of Commerce for Intellectual Property and USPTO Director for approval.

The Proposed Settlement Agreement, which resolves all disciplinary action by the USPTO arising from the stipulated facts set forth below, is hereby approved. This Final Order sets forth the parties’ stipulated facts, legal conclusions, and sanctions to which the OED Director and Respondent have agreed in order to resolve voluntarily the disciplinary complaint against Respondent.

Jurisdiction

1. At all times relevant hereto, Respondent of Darien, Connecticut, 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. Respondent’s registration number is 33,134.
2. 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 and 11.26.

Stipulated Facts

3. At all times relevant hereto, Respondent of Darien, Connecticut, has been an attorney registered to practice before the Office 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. Respondent’s registration number is 33,134. Respondent is also admitted to practice as an attorney in the state of Connecticut (Juris No. 305713).
4. The USPTO charges patent application fees as well as related patent processing, issuance, and maintenance fees. See generally 37 C.F.R. §§ 1.16 through 1.28.
5. Patent application processing fees may be paid by check, cashier’s check, money order, or

credit card. See 37 C.F.R. § 1.23. They may also be paid via electronic funds transfer from U. S. bank accounts or by an authorization to charge a deposit account if a deposit account has been established with the USPTO. See 37 C.F.R. § 1.25.

6. Fees and charges payable to the USPTO are required to be paid in advance; that is, at the time of requesting any action by the USPTO for which a fee or charge is payable. See 37 C.F.R. § 1.22. Under 37 C.F.R. § 1.53, however, applications for patent may be assigned a filing date without payment of the basic filing fee. See 37 C.F.R. § 1.22.

7. As an experienced patent practitioner, Respondent knew or reasonably should have known that the USPTO charges fees that are to be paid in advance.

8. Section 151 of Title 35 of the United States Code states, in part, “If it appears that applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant. The notice shall specify a sum, constituting the issue fee or a portion thereof, which shall be paid within three months thereafter. Upon payment of this sum the patent shall issue, but if payment is not timely made, the application shall be regarded as abandoned. Any remaining balance of the issue fee shall be paid within three months from the sending of a notice thereof and, if not paid, the patent shall lapse at the termination of this three-month period.”

9. OED received information from the USPTO Office of Finance that Respondent had submitted to the Office eighteen (18) checks drawn on his law firm’s checking account that were returned for insufficient funds. The returned checks totaled thirty-four thousand, four hundred, and twenty-one dollars (\$34,421.00). Respondent signed and submitted the checks for payment of required fees on behalf of clients in patent applications between February 2006 and March 2008.

10. Respondent admits that he did not always keep adequate track of the funds deposited into and disbursed from his law firm’s checking account. Consequently, he inadvertently issued the aforementioned checks to the USPTO that were subsequently returned due to insufficient funds.

11. Respondent has made good on the returned checks and informed his clients about the matter.

12. Upon receipt of USPTO’s letter dated August 28, 2008, notifying him of OED’s investigation of the matter, Respondent undertook remedial action to ensure that the conduct described herein should never reoccur, including (i) depositing all client advances in an Interest on Lawyers Trust (“IOLTA”) Account, (ii) only disbursing those USPTO fees that were paid from client advances from Respondent’s IOLTA account, (iii) assigning to a single person responsibility for checks drawn on Respondent’s IOLTA account or law firm checking account and for disbursements from Respondent’s USPTO deposit account, to make certain that there are sufficient funds to cover those checks and disbursements, and (iv) increasing the hours of the firm’s bookkeeper. Respondent also voluntarily completed a four-hour and a three-hour ethics course taught by the Connecticut Bar Association (CBA Course Numbers ET121206 and

ET091807, respectively).

13. Respondent represents that since 1998, when he began his solo practice, he has successfully solicited over 550 U.S. Patent Grants from the USPTO for his clients. Respondent further represents that, since his receipt of the USPTO's August 28, 2008 letter, Respondent has continued to engage in a very active patent prosecution practice before the USPTO, including the grant of over 180 patents, without a recurrence of the conduct that is the subject of this proceeding.

Legal Conclusions

14. Based on the information contained in paragraphs 3 through 13 above, Respondent acknowledges that, by signing and submitting checks to the Office drawn on insufficient funds and subsequently returned when the USPTO presented the checks for payment, he violated disciplinary rules of the USPTO Code of Professional Responsibility, namely: 37 C.F.R. §§ 10.23(b)(5) (proscribing conduct prejudicial to the administration of justice) and 10.23(b)(6) (proscribing engaging in conduct reflecting adversely on a practitioner's fitness to practice).

Mitigating Factors

15. Respondent has no history of discipline before the Office during the twenty-two years he has been registered to practice before the Office. He unequivocally accepts responsibility for his financial bookkeeping errors and has cooperated fully with the OED investigation.

Agreed Upon Sanction

16. Respondent agreed, and it is ORDERED that:

- a. Respondent be, and hereby is, suspended for a period of twenty-four (24) months from the practice of patent, trademark, and non-patent law before the USPTO commencing on the date this Final Order is signed and (ii) the suspension be immediately stayed as of the date this Final Order is signed and that the stay remain in effect until further order of the USPTO Director;
- b. Respondent shall serve a twenty-four month probationary period commencing on the date this Final Order is signed;
- c. Respondent shall be permitted to practice patent, trademark, and other non-patent law before the USPTO during his probationary period unless the stay of the suspension is lifted by order of the USPTO Director;
- d. If the stay of the suspension is not lifted by order of the USPTO Director by the end of the probationary period, Respondent is not required to serve the suspension and this matter will be concluded;
- e. 37 C.F.R. §§ 11.58 and 11.60 do not apply unless the USPTO Director lifts the

stay of the suspension.

- f. (1) in the event that the OED Director is of the opinion that Respondent, during the probationary period, failed to comply with any provision of this 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 should not order that the stay of the suspension be lifted and Respondent be immediately suspended for up to twenty-four (24) months for the violations set forth in paragraph 14, 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 twenty-four month probationary period, failed to comply with any provision of this Final Order or any Disciplinary Rule of the USPTO Code of Professional Responsibility, the OED Director shall

(a) deliver to the USPTO Director: (i) the Order to Show Cause, (ii) Respondent's response to the Order to Show Cause, and (iii) evidence causing the OED Director to be of the opinion that Respondent failed to comply with any provision of this Final Order or any Disciplinary Rule of the USPTO Code of Professional Responsibility during the probationary period, and

(b) request that the USPTO Director immediately lift the stay of the suspension and suspend Respondent for up to twenty-four (24) months for the violations set forth in paragraph 14, above;

- g. Directs that, if, Respondent is suspended pursuant to the provisions of subparagraph f, 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) USPTO shall promptly dissociate Respondent's name from all USPTO customer numbers and Public Key Infrastructure (PKI) certificates;

(4) Respondent shall not use any USPTO customer number or a 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;

- h. In the event that the USPTO Director lifts the stay of the suspension and Respondent seeks a review of the USPTO Director's decision to lift the stay, any such review shall not operate to postpone or otherwise hold in abeyance the immediate suspension of Respondent;
- i. Nothing in the Proposed Settlement Agreement or this 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 the misconduct that caused the stay of the suspension to be lifted;
- j. The OED Director shall publish this Final Order at the Office of Enrollment and Discipline's Reading Room electronically;
- k. The OED Director shall publish the following Notice of Stayed Suspension in the *Official Gazette*;

Notice of Stayed Suspension

Thomas J. Perkowski of Darien, Connecticut, is a registered patent attorney (Registration Number 33,134). Mr. Perkowski has been suspended for twenty-four (24) months with the entirety of the suspension stayed and placed on probation for a period of twenty-four (24) months by the United States Patent and Trademark Office ("Office") for violating 37 C.F.R. §§ 10.23(b)(5) and 10.23(b)(6). Mr. Perkowski is permitted to practice before the Office during his probation unless the stay of the suspension is lifted.

The violations are predicated upon Mr. Perkowski having signed and submitted to the Office eighteen (18) checks totaling thirty-four thousand, four hundred, and twenty-one dollars (\$34,421.00) that were returned for insufficient funds. Mr. Perkowski has made good on the returned checks. He maintains an Interest on Lawyers Trust Account ("IOLTA") and has assigned responsibility for monitoring payments from his IOLTA account and firm checking account, and disbursements

from his USPTO deposit account, to a single individual in his office; and he has completed a four-hour and a three-hour ethics course taught by the Connecticut Bar Association. No clients appear to have been harmed.

Mr. Perkowski represents that since 1998 he has successfully solicited over 550 U.S. Patent grants for his clients as a solo practitioner; and, since his receipt of the Office's August 28, 2008, letter notifying him of the pendency of the investigation of this matter by OED, he has engaged in a very active patent prosecution practice before the Office, including the grant of over 180 patents, without a recurrence of the conduct that is the subject of this action.

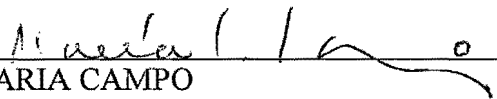
Mitigating factors reflected in the agreed-upon discipline are that Mr. Perkowski has been a registered patent practitioner for over 22 years without prior disciplinary history. Mr. Perkowski has unequivocally accepted responsibility for his financial bookkeeping errors and has cooperated fully with the OED investigation.

This action is the result of a settlement agreement between Mr. Perkowski and the OED Director pursuant to 35 U.S.C. §§ 2(b)(2)(D) and 32, and 37 C.F.R. §§ 11.20, 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>

- l. Pursuant to 37 C.F.R § 11.59, the OED Director shall 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;
- m. Nothing in this Proposed Settlement Agreement shall prevent the Office from considering the record of this disciplinary proceeding, including this Final Order, (1) when addressing any further complaint or evidence of similar misconduct brought to the attention of the Office, and/or (2) in any future disciplinary proceeding (i) as an aggravating factor to be taken into consideration in determining any discipline to be imposed and/or (ii) to rebut any statement or representation by or on Respondent's behalf; and
- n. The OED Director and Respondent shall each bear their own costs incurred to date and in carrying out the terms of this agreement.

JUN 17 2011

Date



MARIA CAMPO

Acting Deputy General Counsel for General Law
United States Patent and Trademark Office

on behalf of

David M. Kappos

Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

cc:

Director of the Office of Enrollment and Discipline
U.S. Patent and Trademark Office

Madeleine F. Grossman, Esq.
Levett Rockwood P.C.
33 Riverside Avenue, Westport CT 06880
Counsel for Respondent

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