

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

In the Matter of)
)
Leon I. Edelson,) Proceeding No. D2011-13
)
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 Leon I. Edelson (“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 set forth in the parties’ Proposed Settlement Agreement in order to resolve voluntarily the disciplinary complaint against Respondent.

Jurisdiction

1. At all times relevant hereto, Respondent of Deerfield, Illinois, 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 38,863.
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. Respondent of Deerfield, Illinois, has been an attorney registered to practice before the Office since May 8, 1995. Respondent’s registration number is 38,863.
4. At all relevant times, Respondent represented Gino and Jerome M. (“the client”) in connection with several patent, Patent Cooperation Treaty (“PCT”), and trademark applications Respondent filed in the Office on their behalf.
5. During his representation of the client, the Office sent Respondent correspondence that could have a significant effect on the patent, PCT, and trademark matters entrusted to him, but he did not always inform the client of such correspondence. For example,

Respondent did not always inform the client of Notices of Abandonment he received from the Office.

6. During his representation of the client, Respondent did not always provide accurate information to them about the status of the patent, PCT, and trademark matters entrusted to him. For example, Respondent informed the client, "Everything is fine," when Respondent knew that abandoned patent and trademark applications had not been revived.

7. During his representation of the client, Respondent provided false or misleading information to the client about the status of the patent, PCT, and trademark matters entrusted to him. For example, Respondent informed the client that the Office had mailed correspondence to his "old address" when, in fact, the correspondence was mailed to Respondent's current address.

8. During his representation of the client, Respondent failed to keep himself adequately apprised as to the status of patent, PCT, and trademark applications pending before the Office; allowed patent, PCT, and trademark applications to become abandoned without the client's knowledge and/or consent; and did not take appropriate, timely corrective action to revive or restore the abandoned patent, PCT, and trademark applications.

9. During the Office of Enrollment and Discipline's investigation of Respondent's misconduct, Respondent, through his attorney, provided false or misleading information to the Office of Enrollment and Discipline in connection with its investigation of Respondent's alleged misconduct.

Legal Conclusions

10. Based on the foregoing stipulated facts, Respondent acknowledges that his conduct violated the following Disciplinary Rules of the USPTO Code of Professional Responsibility:

- a. 37 C.F.R. § 10.23(a) via 37 C.F.R. § 10.23(c)(2)(i) by knowingly providing false or misleading information to the client in connection with the patent, PCT, and trademark applications for which he was hired to prepare, file, and prosecute before the Office;
- b. 37 C.F.R. § 10.23(b)(4) (engaging in conduct involving dishonesty, fraud, deceit, or misrepresentation) by providing false or misleading information to the client regarding the status of their patent, PCT, and trademark applications;
- c. 37 C.F.R. §§ 10.23(b)(4) and 10.23(b)(5) (engaging in conduct prejudicial to the administration of justice) by providing false or misleading information to the Office of Enrollment and Discipline in connection with its investigation of Respondent's misconduct;
- d. 37 C.F.R. § 10.23(b)(6) by engaging in conduct that adversely reflects on a practitioner's fitness to practice before the Office;

- e. 37 C.F.R. § 10.77(c) (proscribing neglect of entrusted legal matters) by allowing patent, PCT, and trademark applications to become abandoned and/or to be withdrawn without the client's knowledge and/or consent; by not taking appropriate corrective action to revive or restore the patent, PCT, and trademark applications; by failing to keep himself adequately apprised as to the status of patent, PCT, and trademark applications pending before the Office; and by failing to keep the client timely and accurately informed as to the status of their applications;
- f. 37 C.F.R. § 10.23(a) via 37 C.F.R. § 10.23(c)(8) by not notifying the client of correspondence from the Office that could have had a significant effect on a matter pending before the Office where (a) such correspondence was received by Respondent and (b) a reasonable practitioner would believe under the circumstances the client should be notified; and
- g. 37 C.F.R. § 10.84(a) (proscribing failing to seek the lawful objectives of a client through reasonably available means permitted by law) by allowing the patent, PCT, and trademark applications to become abandoned or withdrawn and/or by not seeking to revive or restore them.

Agree Upon Sanction

11. Respondent agreed, and it is ORDERED that:

- a. Respondent be, and hereby is, suspended from the practice of patent, trademark, and other non-patent law before the USPTO for thirty-six (36) months commencing on the date this Final Order is signed;
- b. Respondent be, and hereby is, granted limited recognition to practice before the Office commencing on the date this Final Order is signed and expiring thirty (30) days after the date this Final Order is signed with such limited recognition being granted for the sole purpose of facilitating Respondent's compliance with the provisions of 37 C.F.R. § 11.58(b);
- c. Respondent shall comply with 37 C.F.R. § 11.58;
- d. At any time after six (6) months from the date this Final Order is signed, Respondent may file a petition for reinstatement pursuant to 37 C.F.R. § 11.60 requesting reinstatement effective prior to the expiration of the 36-month period of suspension set forth in subparagraph a., above;
- e. Respondent shall remain suspended from the practice of patent, trademark, and non-patent law before the USPTO until the OED Director grants a petition requesting Respondent's reinstatement pursuant to 37 C.F.R. § 11.60(c);

- f. Respondent shall serve a thirty-six (36) month period of probation beginning on the date of this Final Order is signed;
- g. (1) if the OED Director is of the opinion that Respondent, during Respondent's 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) (i) if Respondent has not yet been reinstated: issue to Respondent an Order to Show Cause why the USPTO Director should not enter an order barring Respondent from filing a request for reinstatement during the thirty-six month suspension set forth in subparagraph a., above;

or

- (ii) if Respondent has been reinstated: issue to Respondent an Order to Show Cause why the USPTO Director should not enter an order immediately suspending Respondent for up to thirty-six (36) months for the violations set forth in paragraph 10, 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; and

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

and

(2) in the event after the fifteen-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 Respondent's 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, if any, and (iii) argument and evidence causing the OED Director to be of the opinion that Respondent, during Respondent's probationary period, failed to comply with any provision of this Final Order or any Disciplinary Rule of the USPTO Code of Professional Responsibility, and

- (B) (i) if Respondent has not been reinstated: request that the USPTO Director enter an order barring Respondent from filing a request for

reinstatement during the thirty-six month suspension set forth in subparagraph a., above,

or

(ii) if Respondent has been reinstated: request that the USPTO Director enter an order immediately suspending Respondent for up to thirty-six (36) months for the violations set forth in paragraph 10, above;

- h. If, pursuant to the preceding subparagraph, the USPTO Director enters an order barring Respondent from filing a request for reinstatement during the thirty-six month suspension set forth in subparagraph a., above, or enters an order immediately suspending Respondent for the violations set forth in paragraph 10, above, then: (i) the USPTO shall promptly dissociate Respondent's name from all USPTO Customer Numbers and Public Key Infrastructure ("PKI") certificates and (ii) Respondent may not apply for or obtain a USPTO Customer Number unless and until he is reinstated to practice before the USPTO;
- i. If, pursuant to subparagraph g., above, the USPTO Director enters an order barring Respondent from filing a request for reinstatement during the thirty-six month suspension set forth in subparagraph a., above, or enters an order immediately suspending Respondent for the violations set forth in paragraph 10, above, and Respondent seeks a review of the USPTO Director's action, then any such review shall not operate to postpone or otherwise hold in abeyance the USPTO Director's order;
- j. The OED Director shall publish this Final Order at the Office of Enrollment and Discipline's Reading Room electronically located at:
<http://des.uspto.gov/Foia/OEDReadingRoom.jsp>;
- k. The OED Director shall publish a notice materially consistent with the following Notice of Suspension and Probation in the *Official Gazette*:

Notice of Suspension and Probation

This concerns Leon I. Edelson of Deerfield, Illinois, a registered patent attorney (Registration No. 38,863). Mr. Edelson has been suspended for thirty-six (36) months by the United States Patent and Trademark Office ("USPTO" or "Office") for violating 37 C.F.R. § 10.23(a) via 37 C.F.R. § 10.23(c)(2)(i); 37 C.F.R. § 10.23(b)(4); 37 C.F.R. § 10.23(b)(5); 37 C.F.R. § 10.23(b)(6); 37 C.F.R. § 10.77(c); 37 C.F.R. § 10.23(a) via 37 C.F.R. § 10.23(c)(8); and 37 C.F.R. § 10.84(a). Mr. Edelson is eligible to request reinstatement after serving six months of his 36-month suspension. Mr. Edelson has also been placed on a 36-month probationary period.

During his representation of a certain client before the Office, Mr. Edelson received Office correspondence that could have a significant effect on the patent, Patent Cooperation Treaty (“PCT”), and trademark matters the client entrusted to him, but he did not always inform the client of such correspondence; did not always provide accurate information to the client about the status of the patent, PCT, and trademark matters; provided false or misleading information to the client about the status of the patent, PCT, and trademark matters; failed to keep himself adequately apprised as to the status of patent, PCT, and trademark applications pending before the Office; allowed patent, PCT, and trademark applications to become abandoned without the client’s knowledge or consent; and did not take appropriate, timely corrective action to revive or restore the abandoned patent, PCT, and trademark applications. Additionally Mr. Edelson, through his attorney, provided false or misleading information to Office of Enrollment and Discipline in connection with its investigation of his alleged misconduct.

This action is the result of a settlement agreement between Mr. Edelson and the OED Director pursuant to the provisions of 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 Reading Room located at:
<http://des.uspto.gov/Foia/OEDReadingRoom.jsp>.

- l. 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 USPTO Director to enter an order barring Respondent from filing a request for reinstatement during the thirty-six month suspension or immediately suspend Respondent pursuant to the provisions of subparagraph g., above;
- m. Nothing in the Proposed Settlement Agreement or this Final Order shall prevent the Office from considering the record of this disciplinary proceeding, including the Final Order, (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 (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.

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

DEC 15 2011

Date



JAMES O. PAYNE
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

Cameron Weiffenbach, Esq.
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1751 Pinnacle Drive
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Tysons Corner, VA 22102-3833
Counsel for Respondent

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JAMES O. PAYNE
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