

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

In the Matter of )  
 )  
Ilya Zborovsky, ) Proceeding No. D2011-62  
 )  
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 Ilya Zborovsky (“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 Dix Hills, New York, has been an agent registered to practice in patent matters 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 28,563.

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**

**Background**

3. Individuals who are not attorneys are not recognized to practice before the Office in trademark and other non-patent matters, and registration as a patent agent does not itself entitle an individual to practice before the Office in trademark matters. See 37 C.F.R. § 11.14(b).<sup>1</sup>

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<sup>1</sup> There is an exception for non-attorneys who were recognized to practice before the Office in trademark matters prior to January 1, 1957, but that exception is not applicable in this disciplinary proceeding.

4. Only an individual qualified to practice under 37 C.F.R. § 11.14 may represent an applicant, registrant, or party to a proceeding before the Office in a trademark case. See 37 C.F.R. § 2.17(a).

5. Practice before the Office in trademark matters includes, but is not limited to, consulting with or giving advice to a client in contemplation of filing a trademark application with the Office; preparing and prosecuting an application for trademark registration; preparing an amendment that may require written argument to establish the registrability of the mark; and conducting an opposition, cancellation, or concurrent use proceeding; and conducting an appeal to the Trademark Trial and Appeal Board. See 37 C.F.R. § 11.5(b)(2).

#### Unauthorized Practice of Trademark Law Before the Office

6. Respondent has been registered as a patent agent since June 13, 1977. His registration number is 28,563.

7. Respondent is not, and has never been, an attorney or lawyer.

8. Respondent is not an individual qualified to practice under 37 C.F.R. § 11.14, nor is he otherwise recognized to practice before the Office in trademark matters.

9. Respondent prepared and filed at least seventy-eight (78) trademark applications in the Office from April 22, 1994, until September 23, 2010, and prepared and filed responses to Office actions in several of those 78 applications.

10. In connection with those 78 trademark filings, Respondent held himself out to clients and to the Office as authorized to practice before the Office in trademark cases.

11. Respondent is over the age of seventy (70) years.

#### **Legal Conclusions**

12. 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(b)(4) (engaging conduct involving dishonesty, fraud, deceit, or misrepresentation) by representing himself to be a person authorized to practice trademark law before the Office; and
- b. 37 C.F.R. § 10.23(b)(6) (engaging in conduct that adversely reflects on a practitioner's fitness to practice before the Office) by intentionally engaging in the practice of trademark law before the Office and/or not realizing that he was not authorized to engage in the practice of trademark law before the Office.

### Agree Upon Sanction

13. Respondent agreed, and it is ORDERED that:

- a. Respondent be, and hereby is, suspended from practicing 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 patent law 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 comply with 37 C.F.R. § 11.58;
- d. At any time after twelve (12) 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. Notwithstanding any such petition, Respondent shall remain suspended from the practice of patent law before the USPTO unless and until the OED Director grants a petition requesting Respondent's reinstatement pursuant to 37 C.F.R. § 11.60(c);
- f. Respondent serve a thirty-six (36) month period of probation beginning on the date 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 an additional twenty-four (24) months for the violations set forth in paragraph 12, 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 (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 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 an additional twenty-four (24) months for the violations set forth in paragraph 12, above;

- h. If, pursuant to the preceding subparagraph, the USPTO Director enters an order amending this Final Order such that Respondent is barred from filing a request for reinstatement during the thirty-six month suspension set forth in subparagraph a., or enters an order immediately suspending Respondent for the violations set forth in paragraph 12, above: (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., or enters an order immediately suspending Respondent for the violations set forth in paragraph 12, 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 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 publish a notice materially consistent with the following Notice of Suspension in the *Official Gazette*;

#### **Notice of Suspension and Probation**

Ilya Zborovsky of Dix Hills, New York, a registered patent agent (Registration No. 28,563). Mr. Zborovsky 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(b)(4) and 37 C.F.R. § 10.23(b)(6) by practicing trademark law before the Office without authorization to do so. Mr. Zborovsky is eligible to request reinstatement after serving twelve (12) months of his 36-month suspension. Mr. Zborovsky has also been placed on a 36-month probationary period.

Mr. Zborovsky is a patent agent. He is not, and has never been, an attorney or lawyer. Consequently, Mr. Zborovsky is not an individual recognized to practice before the Office in trademark matters. Nevertheless, Mr. Zborovsky prepared and filed seventy-eight (78) trademark applications in the Office from April 22, 1994, until September 23, 2010, and prepared and filed responses to Office actions in several of those 78 applications. In connection with those 78 trademark filings, Mr. Zborovsky held himself out to clients and to the Office as authorized to practice before the Office in trademark cases.

This action is the result of a settlement agreement between Mr. Zborovsky 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. Mr. Zborovsky is over 70 years of age, and the terms of the agreed upon settlement took into account the time reasonably expected to be remaining in his career as a patent agent.

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>.



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cc:

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

Ilya Zborovsky  
3 Courtyard Circle  
Centerport, NY 11721

**Notice of Suspension and Probation**

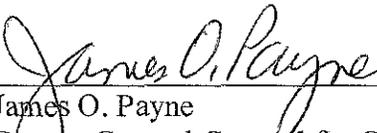
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NOV 17 2011  
Date

  
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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