

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

In the Matter of)	
)	
Patrick N. Burkhart,)	Proceeding No. D2011-04
)	
Respondent)	

FINAL ORDER

The Deputy General Counsel for Enrollment and Discipline and Director of the Office of Enrollment and Discipline (“OED DGC”) for the United States Patent and Trademark Office (“USPTO” or “Office”) and Patrick N. Burkhart (“Respondent”) have submitted a Proposed Settlement Agreement (“Agreement”) to the Under Secretary of Commerce for Intellectual Property and USPTO Director for approval.

The 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 as set forth in the Agreement.

Jurisdiction

1. At all times relevant hereto, Respondent of Downers Grove, Illinois, has been an attorney registered to practice before the Office (Registration No. 33,352) and is subject to the USPTO Disciplinary Rules set forth at 37 C.F.R. § 10.20 et seq.
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. § 11.26.

Stipulated Facts

A. Introduction

3. Respondent has been registered as a patent attorney since November 10, 1997. Respondent’s registration number is 33,352.
4. On March 27, 2008, the USPTO Director entered a Final Order approving a proposed settlement agreement between the OED Director at the time and Respondent that resolved an earlier USPTO disciplinary proceeding brought by the OED Director against Respondent. The March 27, 2008 Final Order suspended Respondent for three years but stayed the entirety of the suspension based on Respondent’s continued compliance with the conditions set forth in the March 27, 2008 Final Order.

5. Respondent did not comply with the terms of the March 27, 2008 Final Order. Consequently, on September 3, 2008, the USPTO Director entered an Order (a) vacating the stay of the suspension in the March 27, 2008 Final Order and (b) suspending Respondent for a period of three years effective October 3, 2008.

B. Representation of Brian G.

6. In or around April 2008, Brian G. hired Respondent to prepare and file a patent application on his behalf.

7. Respondent prepared an application and, on numerous occasions over several months, represented to Mr. G. that the application had been filed.

8. In fact, Respondent never filed Mr. G.'s application.

9. Respondent represents that he mistakenly believed that he had filed the application on behalf of Mr. G.

10. Mr. G. terminated the attorney-client relationship with Respondent and hired another patent practitioner to represent him before the Office.

11. Upon terminating the attorney-client relationship with Respondent, Mr. G. instructed Respondent to transfer his client file to his new patent practitioner.

12. Respondent did not transfer Mr. G.'s files to the new patent practitioner until seven weeks after being instructed to do so by Mr. G.

13. The new patent practitioner and an associate in his law firm reviewed the application and familiarized themselves with Mr. G.'s patent protection needs; thereafter, the other patent law firm amended the application and filed it in the Office on behalf of Mr. G.

14. Respondent acknowledges that Mr. G. is entitled to reimbursement of expenses associated with Respondent not having filed the application, and Respondent stipulates, only for purposes of the Agreement and this Final Order, that reimbursement comprises the expenses Mr. G. incurred in having the new practitioner and associate firm familiarize themselves with Mr. G.'s patent application file.¹

C. Representation of Allan O.

15. On April 7, 1999, Respondent filed a U.S. patent application (the '968 application) on behalf of Mr. Alan O. and represented him during its examination by the Office.

¹ Respondent has already refunded \$515.00 in unused USPTO filing fees to the client.

16. On August 12, 2002, the USPTO mailed a Notice of Allowance and Fee(s) Due to Respondent.

17. Respondent received the August 12, 2002 Notice, and responded to it on November 11, 2002.

18. In his November 11, 2002 response, Respondent kept himself as the official correspondence address for subsequent communications from the Office about the patent to be issued on the '968 application.

19. On February 18, 2003, the USPTO issued a patent on the '968 application (the '717 patent).

20. On April 2, 2007, a registered patent practitioner filed a request for *ex parte* reexamination in the USPTO challenging the validity of the '717 patent.

21. Respondent represents that he received the request for *ex parte* reexamination, informed Mr. O. about it in April or May of 2007, and told Mr. O. that he would not represent him in the matter.

22. Although Respondent represents that he informed Mr. O. that he was no longer serving as his patent attorney, Respondent did not inform the Office that he was no longer representing Mr. O. (e.g., did not file a change of correspondence address in the reexamination proceeding or the '717 patent file maintained by the Office).

23. It was not until November 2010 that Respondent caused a change in correspondence notice to be filed in the '717 patent file maintained by the Office.

Legal Conclusions

24. 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. § 10.77(c) by neglecting client matters by not providing a client with accurate information about the status of a patent application and by not timely filing a change of correspondence address after withdrawing from representation of a matter; and
- b. 37 C.F.R. § 10.112(c)(4) by not promptly delivering to the client properties in Respondent's possession that the client was entitled to receive (i.e., the client's application file).

Agree Upon Sanction

25. Respondent agrees, and it is ORDERED that:

- a. Respondent be, and hereby is, publicly reprimanded;
- b. Respondent shall serve an eighteen-month probationary period commencing on the date a petition for reinstatement seeking Respondent's reinstatement pursuant to 37 C.F.R. § 11.60 is granted by the OED DGC;
- c. (1) in the event that the OED DGC 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 DGC shall:

- (A) issue to Respondent an Order to Show Cause inquiring why the USPTO Director should not order that Respondent be immediately suspended for up to eighteen months for the violations set forth in paragraph 24, above;

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

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

and

- (2) if, after the fifteen-day period for response and consideration of any response received from Respondent, the OED DGC continues to be 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 DGC 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) evidence and argument supporting the OED DGC's conclusion that Respondent failed to comply with 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 suspend Respondent for up to eighteen months for the violations set forth in paragraph 24, above;

- d. The OED DGC 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>;
- e. The OED DGC shall publish a notice in the *Official Gazette* materially consistent with the following:

Notice of Reprimand and Probation

This notice concerns Patrick N. Burkhart of Downers Grove, Illinois, a registered patent attorney (Registration Number 33,352). The United States Patent and Trademark Office ("USPTO" or "Office") has publicly reprimanded Mr. Burkhart for violating 37 C.F.R. §§ 10.77(c) and 10.112(c)(4). Mr. Burkhart violated § 10.77(c) by not providing a client with accurate information about the status of a patent application and by not timely filing a change of correspondence address after withdrawing from representation of a matter so that a client would receive future correspondence directly from the Office about an issued patent (e.g., a request for reexamination). He violated 37 C.F.R. § 10.112(c)(4) by not promptly delivering a former client's property in Mr. Burkhart's possession that the client was entitled to receive (i.e., the client's application file).

Mr. Burkhart, who is currently suspended from practice before the Office, will be placed on probation for eighteen months upon successfully petitioning for reinstatement to practice before the Office. If reinstated and while on probation, Mr. Burkhart will be permitted to practice before the Office in patent matters (and in trademark and non-patent matters provided he satisfies the requirements of 37 C.F.R. § 11.14(a)) unless he is subsequently suspended or excluded by the USPTO Director. In addition, because Mr. Burkhart did not file a client's patent application, Mr. Burkhart agreed to reimburse the client for expenses in having another practitioner familiarize himself with the client's file.

This action is the result of a settlement agreement between Mr. Burkhart and the OED DGC pursuant to the provisions of 35 U.S.C. §§ 2(b)(2)(D) and 37 C.F.R. §§ 11.20, 11.26, and 11.59. Disciplinary decisions involving practitioners are posted at the Office of Enrollment and Discipline's Reading Room located at: <http://des.uspto.gov/Foia/OEDReadingRoom.jsp>.

- f. Respondent shall pay restitution in the amount of \$1,350.00 to Brian G. in strict compliance with the following payment schedule:
 - i. \$500.00 on or before, January 1, 2012;
 - ii. \$500.00 on or before, March 1, 2012; and
 - iii. \$350.00 on or before, May 1, 2012;

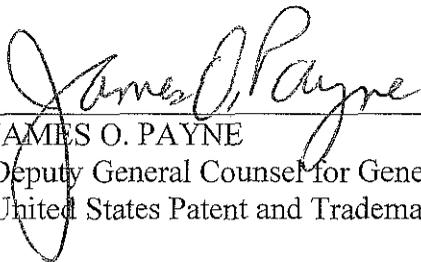
- g. Within fifteen days of the due date of each payment identified in the subparagraph f., above, Respondent shall provide the OED DGC with an affidavit and corroborating document(s) (e.g., a copy of the payment letter, a copy of the check mailed to the client, etc.) demonstrating his compliance with his restitution payment obligation;
- h. Respondent shall be deemed in violation of the terms of the Agreement and this Final Order if any check issued in payment of monies required by this Final Order is returned for insufficient funds;
- i. Respondent shall be deemed in violation of the terms of the Agreement and this Final Order if the payment of monies required by this Final Order is made after the due date for any reason;
- j. Within thirty days of the date on which this Final Order is signed, Respondent shall provide a copy of this Final Order to the person to whom payments are to be paid under this Final Order and, within forty-five days of the date on which this Final Order is signed, Respondent shall provide the OED DGC with an affidavit and corroborating document(s) (e.g., a copy of the letter mailed to such person) demonstrating his compliance with this subparagraph;
- k. If Respondent is suspended pursuant to the provisions of subparagraph c., above:
 - (1) the USPTO shall promptly dissociate Respondent's name from all USPTO customer numbers and Public Key Infrastructure ("PKI") certificates;
 - (2) Respondent shall not use any USPTO customer numbers or PKI certificates unless and until he is reinstated to practice before the USPTO;and
 - (3) Respondent may not obtain a USPTO customer number or a PKI certificate unless and until he is reinstated to practice before the USPTO;
- l. In the event that the USPTO Director suspends Respondent pursuant to subparagraph c., above, any review of the suspension shall not operate to postpone or otherwise hold in abeyance the suspension;
- m. Within thirty days of the date on which this Final Order is signed, the OED DGC shall file a motion to dismiss the disciplinary proceeding currently pending against Respondent;
- n. Nothing in the 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 Respondent to be suspended pursuant to subparagraph c., above;
- o. Nothing in the Settlement Agreement or this Final Order changes Respondent's obligations under 37 C.F.R. § 11.58 in connection with his current suspension

obligations or alters the required showings under 37 C.F.R. § 11.60 when, and if, Respondent seeks reinstatement to practice before the Office;

- p. Nothing in the Agreement or this Final Order prevents the Office from considering the record of this disciplinary proceeding, including this 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 (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
- q. The OED DGC and Respondent shall bear their own costs incurred to date and in carrying out the terms of this agreement.

JAN 10 2012

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.
Miles & Stockbridge
1751 Pinnacle Drive, Suite 500
McLean, VA 22102-3833
Counsel for Respondent

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