

**UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE ADMINISTRATIVE LAW JUDGE**

In the Matter of:

Joel D. Myers,

Respondent.

Proceeding No. D2015-33

December 31, 2015

**INITIAL DECISION ON DEFAULT JUDGMENT**

On November 25, 2015, the Director of the Office of Enrollment and Discipline (OED Director) for the United States Patent and Trademark Office (USPTO or Office) filed a *Motion for Entry of Default Judgment and Imposition of Disciplinary Sanction* (Default Motion) in this above-captioned matter.<sup>1</sup> By *Order to Show Cause*, dated November 30, 2015, the Court ordered Respondent to show cause, by December 16, 2015, as to why the Court should not grant the *Motion*.

**PROCEDURAL HISTORY**

On September 16, 2015, the OED Director filed a *Complaint and Notice of Proceedings under 35 U.S.C. § 32* (Complaint) against Joel D. Myers (Respondent). The *Complaint* seeks the exclusion or suspension of Respondent for committing violations of the USPTO Code of Professional Responsibility (37 C.F.R. §§ 10.20 *et seq.*) and the USPTO Rules of Professional Conduct (37 C.F.R. §§ 11.100 *et seq.*).<sup>2</sup> The essence of the *Complaint* is that, having agreed to file eleven patent applications on behalf of a client and having received prepaid attorney's fees and filing fees, Respondent failed to submit the filing fees to the USPTO or refund them to the client after the attorney-client relationship was terminated.

A copy of the *Complaint* was sent via U.S. first-class certified mail, return receipt requested, to the address Respondent provided to the OED pursuant to 37 C.F.R. § 11.11. The OED Director also mailed a copy of the *Complaint* via U.S. first-class certified mail, return receipt requested, to an address Respondent provided to counsel for the OED via an email dated July 27, 2015. Per USPS tracking and return receipt postcards, the copies were delivered on September 21, 2015, and October 14, 2015, respectively.

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<sup>1</sup> Pursuant to an Interagency Agreement in effect beginning March 27, 2013, Administrative Law Judges of the U.S. Department of Housing and Urban Development are authorized to hear cases for the U.S. Patent and Trademark Office.

<sup>2</sup> Effective May 3, 2013, the USPTO Rules of Professional Conduct (37 C.F.R. Part 11, subpart D) replaced the Code of Professional Responsibility. However Respondent's alleged misconduct both prior to and after May 3, 2013. As such, both the USPTO Code of Professional Responsibility and USPTO Rules of Professional Conduct are applicable in this case.

By *Notice of Hearing and Order*, issued September 21, 2015, Respondent was required to file an Answer to the Complaint on or before October 16, 2015. Respondent has not answered the *Complaint*, or responded to the Notice of Hearing, or otherwise appeared before the Court in this matter.<sup>3</sup>

### CONSEQUENCES OF FAILURE TO ANSWER COMPLAINT

Section 11.36 of Title 37 of the Code of Federal Regulations (C.F.R.) sets forth the requirement for answering the *Complaint* and the consequences for not doing do. “Failure to timely file an answer will constitute an admission of the allegations in the complaint and may result in entry of default judgment.” 37 C.F.R. § 11.36(e). As a result of Respondent’s failure to answer the *Complaint*, Respondent is deemed to have admitted the allegations in the *Complaint*, which are set below as the Court’s findings of fact.

### FINDINGS OF FACT

1. Respondent has been registered as a patent attorney since February 16, 1999.
2. Respondent’s registration number is 44,253.
3. Respondent is currently suspended from the practice of law in Georgia.
4. Respondent’s acts and omissions leading to the alleged violations of the Code of Professional Responsibility and the Rules of Professional Conduct set forth in the *Complaint* were willful.
5. On February 23, 2009, Respondent entered into an engagement agreement to provide patent legal services to one Client, Mr. H. Stetser Murphy, Jr..
6. In early 2013, Respondent provided patent legal services to the Client.
7. In March 2013, the Client requested that Respondent file eleven patent applications, including nine design patent applications and two utility patent applications, before substantive changes in U.S. patent law (*i.e.*, “first to invent” to “first to file”) took effect as a result of the America Invents Act.
8. On March 15, 2013, Respondent requested that the Client pay him \$4,451.00. This sum consisted of \$1,000.00 for attorney’s fees and \$3,451.00 for filing fees for the eleven applications that the Client had requested Respondent file before the effective date of the changes in patent law.

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<sup>3</sup> The administrative record reflects that the OED Director attempted to meet and confer with Respondent, and sent multiple copies of a letter to Respondent regarding the OED Director’s intent to file the *Default Motion*. At least one copy was delivered to Respondent by November 4, 2015, as evidenced by the USPS track and confirm and the return receipt postcard.

9. The Client paid Respondent with a personal check dated March 15, 2013, totaling \$4,451.00 and drawn on the Client's [REDACTED] account.
10. Respondent endorsed the Client's personal check on March 15, 2013, and obtained funds on the same date.
11. On March 15, 2013, Respondent filed, on behalf of the Client as the sole inventor, U.S. Design Patent Application No. [REDACTED] (the [REDACTED] application), and U.S. Design Patent Application No. [REDACTED] (the [REDACTED] application).
12. On March 19, 2013, Respondent also filed, on behalf of the Client as the sole inventor, the following applications: U.S. Design Patent Application No. 29/450,555 (the '555 application), U.S. Design Patent Application No. 29/450,556 (the '556 application), U.S. Design Patent Application No. [REDACTED] (the [REDACTED] application), U.S. Design Patent Application No. 29/450,562 (the '562 application), U.S. Design Patent Application No. [REDACTED] (the [REDACTED] application), and U.S. Design Patent Application No. [REDACTED] (the [REDACTED] application).
13. For each of the patent applications filed on March 15, 2013, and March 19, 2013 (collectively "the March applications"), Respondent did not remit the filing fees when the applications were filed.
14. Respondent also did not include a signed oath or declaration from the inventor when he filed the March applications.
15. On April 15, 2013, the USPTO sent Respondent a Notice to File Missing Parts for the '556 application.
16. On April 16, 2013, the USPTO sent Respondent three Notices to File Missing Parts. The Notices to File Missing Parts were for the [REDACTED] application, [REDACTED] application, and [REDACTED] application, respectively.
17. On April 17, 2013, the USPTO sent Respondent four Notices to File Missing Parts. These Notices were for the '555 application, '562 application, [REDACTED] application, and [REDACTED] application, respectively.
18. The April 15, 2013, Notice to File Missing Parts, three April 16, 2013, Notices to File Missing Parts, and four April 17, 2013, Notice to File Missing Parts (collectively "the April Notices") were received by Respondent.
19. Each of the April Notices informed Respondent that the fees for the respective patent application were required to be timely submitted within two months from the date of the Notices to avoid abandonment of the application.
20. Each of the Notices also informed Respondent that he must file the inventor's oath or declaration for the respective application.

21. Despite having received the April Notices, Respondent did not timely inform the Client that they had been sent to Respondent by the USPTO.
22. The fees and oath or declaration missing from each of the applications were due on Monday, June 17, 2013.
23. Respondent did not respond to any of the Notices to File Missing Parts and did not submit any of the filing fees to the USPTO in any of the March applications.
24. Respondent also did not file the inventor's oath or declaration in any of the March applications.
25. On July 17, 2013, Respondent filed, on behalf of the Client as the sole inventor, U.S. Design Patent Application No. [REDACTED] (the [REDACTED] application), and U.S. Design Patent Application No. [REDACTED] (the [REDACTED] application) (collectively "the July applications").
26. As with the March applications, Respondent did not remit the filing fees when he filed the July applications.
27. Respondent also did not include a signed oath or declaration from the inventor for either of the July applications.
28. After having some difficulty contacting Respondent, the Client met with Respondent on July 17, 2013.
29. During this meeting Respondent assured the Client that the patent applications Respondent filed were on schedule.
30. During this meeting, Respondent neither informed the Client that he had received a Notice to File Missing Parts from the USPTO for each of the March applications, nor did he inform the Client that he had not yet paid the filing fees or filed the oaths or declarations for any of the design patent applications he already filed.
31. During the meeting, Respondent failed to provide the Client with satisfactory answers to the Client's inquiries regarding the status of his patent applications.
32. Respondent terminated his attorney-client relationship with Respondent and confirmed the termination on July 18, 2013, in a text message.
33. The Client then contacted the USPTO and discovered that filing fees had not been paid for any of his patent applications filed in March 2013.
34. On July 26, 2013, after being terminated, Respondent replied to the Client's communications and informed him that the filing fees had not been paid and declarations had not been filed in any of his patent applications.
35. Despite Respondent's attorney-client relationship with the Client being terminated, Respondent did not withdraw as the attorney in the [REDACTED] and [REDACTED] applications (pursuant

to 37 C.F.R. § 1.36(b); therefore the USPTO continued to send correspondence to Respondent's address of record.

36. On July 30, 2013, the USPTO sent Respondent two Notices to File Missing Parts. The Notices to File Missing Parts were for the [REDACTED] application and [REDACTED] application.
37. Respondent received both Notices to File Missing Parts (collectively "the July Notices").
38. Like the April Notices, the July Notices informed Respondent that the fees for the respective application were required to be timely submitted within two months from the date of the Notice to avoid abandonment of the application.
39. The July Notices also informed Respondent that he must file the inventor's oath or declaration.
40. Respondent did not respond to either of the July Notices and did not submit the filing fees to the USPTO.
41. Respondent also did not file the inventor's oath or declaration for either of the July applications.
42. Respondent never filed the two utility patent applications that the Client prepaid to Respondent the filing fees for Respondent to file in March 2013.
43. On September 2, 2013, the Client hired a new patent attorney at an additional expense to prosecute his patent applications.
44. Through his new attorney, the Client submitted to the USPTO the outstanding filing fees and late fees associated with the March and July applications.
45. On September 19, 2013, the Client requested that Respondent provide an accounting of the fees paid to Respondent, including the prepaid filing fees that the Client had paid to Respondent, but that Respondent did not remit to the USPTO.
46. As of the filing of the *Complaint*, Respondent had neither provided the Client with an accounting of the Client's prepaid filing fees, nor has Respondent returned the USPTO filing fees that he received from the Client.

### CONCLUSIONS OF LAW

Based upon the foregoing findings of fact, the Court concludes, for the reasons that follow, Respondent violated the USPTO Code of Professional Responsibility as alleged for misconduct occurring prior May 3, 2013, and he violated and the USPTO Rules of Professional Conduct as alleged for misconduct occurring on and after May 3, 2013.

## Violations under the USPTO Code of Professional Responsibility

1. 37 C.F.R. §§ 10.23(a) and (b) via 10.23(c)(8) proscribes failing to inform a client of correspondence received from the Office when the correspondence could have a significant effect on a matter pending before the Office, is received by the practitioner on behalf of a client, and is correspondence which a reasonable practitioner would believe under the circumstances that the client should be notified. Respondent received a Notice to File Missing Parts for each of the eight March applications, because each of the applications was missing the filing fees and declarations. However, Respondent did not notify the Client that any of the Notices to File Missing Parts had been received until well after the response date. By failing to notify the Client in a timely manner of the April Notices to File Missing Parts sent to Respondent by the USPTO, Respondent violated 37 C.F.R. §§ 10.23(a) and (b) via 10.23(c)(8).
2. 37 C.F.R. § 10.77(c) proscribes neglecting a legal matter entrusted to the practitioner. Respondent never filed the two utility patent applications he was hired by the Client to file. Respondent also failed to remit the filing fees and requisite declarations for all eight of the March applications despite having been provided with the filing fees in advance by the Client. Even after receiving the April Notices from the USPTO notifying him that the March applications were missing the filing fees and declarations, Respondent still failed submit the missing components or otherwise respond to the April Notices. In so doing, Respondent neglected the legal matters entrusted to him by the Client in violation of 37 C.F.R. § 10.77(c).
3. 37 C.F.R. § 10.84(a)(1) proscribes intentionally failing to seek the lawful objectives of a client through reasonably available means. The Client requested Respondent file eleven patent applications, including nine design patent applications and two utility patent applications before substantive changes in U.S. patent law took effect on March 16, 2013.<sup>4</sup> Respondent filed only filed two of the applications by that deadline. While Respondent eventually filed most of the patent applications the Client hired him to handle, Respondent never submitted complete applications, because they were each missing both the filing fees and the inventor's oath or declarations. By knowingly failing to take action to protect the Client's intellectual property rights in the March applications, and failing to file the two utility patent applications, Respondent violated 37 C.F.R. § 10.84(a)(1).
4. 37 C.F.R. § 10.84(a)(2) proscribes intentionally failing to carry out a contract of employment entered into with a client for professional services. As early as February 2009, Respondent entered into an engagement agreement with the Client to provide patent legal services to the Client. In March 2013, the Client paid Respondent to file eleven patent applications on the Client's behalf. Respondent accepted the payment, but failed to submit complete applications to the USPTO. Respondent was informed that the March applications he had filed were missing components. However, Respondent never completed the applications by the deadline set by the USPTO. By knowingly failing to

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<sup>4</sup> [http://www.uspto.gov/sites/default/files/aia\\_implementation/aia-effective-dates.pdf](http://www.uspto.gov/sites/default/files/aia_implementation/aia-effective-dates.pdf)

take action to protect the Client's intellectual property rights in the Client's patent applications as Respondent was hired to do, Respondent violated 37 C.F.R. § 10.84(a)(2).

#### Violations under the USPTO Rules of Professional Conduct

1. 37 C.F.R. § 11.103 proscribes failing to act with reasonable diligence and promptness in representing a client. By mid-April of 2013, Respondent had been informed that the March applications were not complete and would become abandoned if the requisite filing fees and declarations were not filed by June 17, 2013. Still, Respondent did nothing to resolve the situation. Similarly, Respondent failed to submit the filing fees for the July applications even though the Client had prepaid Respondent to do so. By not remitting the statutory filing fees to the USPTO despite having prepaid these fees by the Client or submitting the inventors oath or declaration in the March applications and July applications, Respondent violated 37 C.F.R. § 11.103.
2. 37 C.F.R. § 11.104(a)(3) proscribes failing to keep the client reasonably informed about the status of the matter. When the Client and Respondent met on July 17, 2013, Respondent did not inform the Client about any of the April Notices Respondent received from the USPTO. Although Respondent knew he had missed the June 17, 2013 deadline to submit the filing fees and inventor's oaths or declarations, Respondent assured the Client that the March applications were on schedule. By failing to inform the Client of the true status of the March applications and that the USPTO had sent Respondent the April Notices during the meeting, Respondent violated 37 C.F.R. § 11.104(a)(3).
3. 37 C.F.R. § 11.115(d) proscribes failing to promptly deliver to a client funds that the client is entitled to receive, and failure to promptly render a full accounting upon request by the client. Although the Client prepaid filing fees to Respondent, Respondent never submitted any of the filing fees to the USPTO. After the Client terminated the attorney-client relationship with Respondent, Respondent did not return the filing fees to the Client. Respondent also ignored the Client's request for an accounting of the fees paid to Respondent, including the prepaid filing fees that the Client had paid to Respondent, but that Respondent did not remit to the USPTO. As of the filing of the *Complaint*, Respondent has neither provided the Client with an accounting of the prepaid filing fees, nor has Respondent returned the filing fees that he received but did not remit to the USPTO. Accordingly, Respondent violated 37 C.F.R. § 11.115(d).
4. 37 C.F.R. § 11.116(d) proscribes failing to refund advance payment of fees or expenses that have not been earned or incurred upon termination of the practitioner-client relationship. As noted *supra*, Respondent failed to refund the prepaid filing fees that were advanced to him by the Client. In addition, Respondent has not refunded any fees or expenses related to the two utility patent applications that the Client hired Respondent to file, but that Respondent never filed. By failing to return to the Client the filing fees in each of the applications that were not forwarded by Respondent to the USPTO, after termination of the practitioner-client relationship, Respondent has violated 37 C.F.R. § 11.116(d).

## SANCTIONS

Having found the Respondent violated of the USPTO Code of Professional Responsibility, and USPTO Rules of Professional Conduct, the Court must determine an appropriate sanction. Before sanctioning a practitioner, the Court must consider the following four factors:

- (1) whether the practitioner has violated a duty owed to client, to the public, to the legal system, or to the profession;
- (2) whether the practitioner acted intentionally, knowingly, or negligently;
- (3) the amount of the actual or potential injury caused by the practitioner's misconduct; and
- (4) the existence of any aggravating or mitigating factors.

37 C.F.R. § 11.54(b)

1. Respondent violated his duties to the Client, and the patent bar.

Respondent entered into an engagement agreement with the Client and accepted the Client's prepayment of attorney's fees and filing fees. As such, Respondent had a fiduciary duty to the Client, which he violated by failing to remit the prepaid filing fees to the USPTO, failing to inform the Client of Respondent's receipt of the Notices of Missing Parts, and failing to respond to the Notices of Missing Parts in a timely manner. In addition, Respondent also violated his fiduciary duty by completely failing to file two utility patents for which he was hired to file. Finally, Respondent violated his fiduciary duty to the Client by ignoring the Client's request for an accounting of the prepaid fees given to Respondent, and failing to return the filing fees that that Respondent never remitted to the USPTO.

Respond also violated his duty to the patent bar by willfully violating its disciplinary rules. Respondent's neglect of the numerous legal matters the Client entrusted to him harms the Client and possibly the public's confidence in members of the patent bar. Last, Respondent's dishonesty in lying to the Client and refusing to return the Client's prepaid filing fees tarnishes the reputation of the patent bar as a whole.

2. Respondent acted knowingly and intentionally

Respondent's actions were knowing and intentional. Each of the Notices to File Missing Parts reminded Respondent that he had yet to submit the filing fees and inventor's oath or declaration for patent applications he filed on behalf of the Client. And yet, he did not act on that information or otherwise respond to the Notices. Respondent also intentionally lied to the Client by telling the Client the applications were on schedule, even though Respondent knew he had already missed the deadline to submit the filing fees and inventor's oath. It was not until the Client terminated the attorney-client relationship that Respondent admitted that patent applications were missing critical components.



Respondent also intentionally withheld the filing fees the Client prepaid to him. The Client requested an accounting of the fees that were prepaid to Respondent. Respondent knew that he never remitted the filing fees to the USPTO and yet he did not return them to the Client or provide the Client with the requested accounting. Respondent's knowing and intentional misconduct warrants a stern sanction.

3. Respondent's misconduct caused actual and potential injury.

Respondent's misconduct caused actual injury to the Client. The Client prepaid the attorney's fees and filing fees to Respondent. However, Respondent never remitted the filing fees to the USPTO, nor did Respondent file two of the patent applications that he was hired to file. Although the attorney-client relationship was terminated, Respondent did not return the filing fees that the Client prepaid but were not submitted to the USPTO, nor did Respondent return any unearned attorney's fees for the two patent applications that were never filed. This has caused an actual injury to the Client who was forced to hire alternative counsel and pay late fees on top of the filing fees to complete the patent applications. Having caused the Client actual injury, Respondent should receive a severe sanction.

4. Aggravating factors exist in this case.

The Court often looks to the American Bar Association's Standards for Imposing Lawyer Sanctions (2005) when determining whether aggravating or mitigating factors exist. See In re Lane, No. D2013-07, at 19. A review of the record reveals that aggravating and mitigating factors exist in this case.

Respondent's misconduct occurred in ten patent applications that he filed on behalf of the Client. For each of the applications, he failed to submit filing fees and an inventor's oath or declaration upon filing the applications and later after the USPTO sent a Notice to File Missing Parts. Respondent also failed to inform the Client about the Notices to File Missing Parts that were sent to him even after the Client inquired into the status of the applications. Respondent's neglect of the Client's legal matters was consistent. Accordingly, the Court finds the aggravating factors of multiple violations and a pattern of misconduct exist.

Respondent also failed to remit the filing fees that were prepaid by the Client and ignored the Client's request for an accounting of the fees he paid to Respondent. After the Client terminated the attorney-client relationship, Respondent did not return the prepaid filing fees or remit them to the USPTO. Instead, he kept them. Even after the OED began its investigation and the present *Complaint* was filed, Respondent did not return the prepaid filing fees. Such misconduct demonstrates a selfish or dishonest motive, or at least an indifference to making restitution, all which are aggravating factors.

The OED Director notes that Respondent has not been disciplined during the nearly 16 years since his registration with the patent bar. A lack of prior disciplinary record may be a mitigating factor, even though practitioners are expected to follow the rules. Respondent may have had a good record prior to this disciplinary proceeding, but his failure to appear in this matter and his disregard of the Court's orders demonstrates that Respondent may no longer be

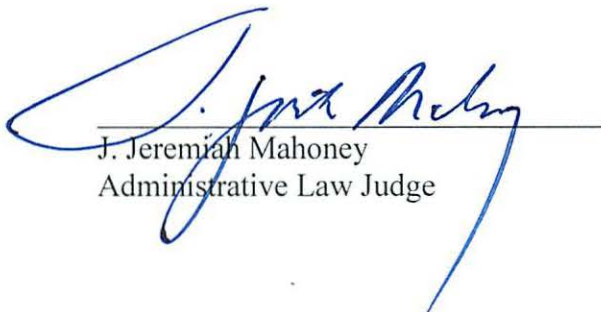
capable of professionally representing his Clients. To the extent Respondent's prior record is mitigating, it is insufficient to offset the aggravating factors in this case.

### CONCLUSION

Respondent has failed to answer the *Complaint* or otherwise appear in this matter. Respondent is found in **DEFAULT**. On the basis of the facts thereby admitted, the Court finds Respondent has violated the foregoing Rules of Professional Conduct and Professional Responsibility, as alleged. The OED Director requests that the Court sanction Respondent by excluding him from practice before the USPTO in patent, trademark, or other non-patent cases or matters. Based upon its foregoing analysis of all four enumerated sanction factors, the Court concludes that Respondent's misconduct warrants the sanction of exclusion.

Accordingly, Respondent shall be **EXCLUDED** from practice before the U.S. Patent and Trademark Office in patent, trademark, and other non-patent matters.<sup>5</sup>

So **ORDERED**,



J. Jeremiah Mahoney  
Administrative Law Judge

**Notice of Required Actions by Respondent:** Respondent is directed to 37 C.F.R. § 11.58 regarding responsibilities in cases of suspension or exclusion.

**Notice of Appeal Rights:** Within thirty (30) days of this initial decision, either party may file an appeal to the USPTO Director. 37 C.F.R. § 11.55(a).

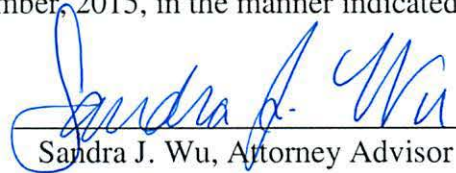
**Notice of Right to Petition for Reinstatement:** 37 C.F.R. § 11.60 concerning petitions for reinstatement.

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<sup>5</sup> If Respondent petitions for reinstatement, reinstatement may be conditioned, *inter alia*, upon restitution to the Client in this matter.

**CERTIFICATE OF SERVICE**

I hereby certify that copies of the foregoing **INITIAL DECISION ON DEFAULT JUDGMENT**, issued by J. Jeremiah Mahoney, Administrative Law Judge, in D2015-33, were sent to the following parties on this 31<sup>st</sup> day of December, 2015, in the manner indicated:

  
Sandra J. Wu, Attorney Advisor

**VIA FIRST CLASS MAIL:**

Mr. Joel D. Myers  
Myers & Associates  
Intellectual Property Law, PC  
400 Galleria Parkway, Suite 240  
Atlanta, GA 30339

Mr. Joel D. Myers  
501 Gardenia lane  
Marietta, GA 30339

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**VIA FIRST CLASS MAIL AND E-MAIL**

Melinda M. DeAtley  
Elizabeth Ullmer Mendel  
Associate Solicitor  
Mail Stop 8  
Office of the Solicitor  
P.O. Box 1450  
U.S. Patent and Trademark Office  
Alexandria, VA 22313-1450

████████████████████

P.O. Box 1450, Mail Stop 8  
Office of the Solicitor  
USPTO  
Alexandria, VA 22313-1450

████████████████████