

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

In the Matter of)
)
Andrew P. Lahser,)
)
Respondent) Proceeding No. D2016-27
)
)
_____)

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 Andrew P. Lahser (“Respondent”) have submitted a Proposed Settlement Agreement (“Agreement”) to the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (“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 conclusion, and sanctions.

Jurisdiction

1. At all times relevant hereto, Respondent of Scottsdale, Arizona, has been a registered practitioner (Registration No. 56,559) and subject to the USPTO Code of Professional Responsibility set forth at 37 C.F.R. § 10.20 *et seq.* and the USPTO Rules of Professional Conduct set forth at 37 C.F.R. § 11.101 *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. § 11.19 and 11.26.

Stipulated Facts

3. Respondent of Scottsdale, Arizona, is a registered patent attorney (Registration Number 56,559).
4. OED received information from a client relating to his representation by Respondent before the USPTO in patent and trademark matters.
5. Respondent was engaged by the client to file three provisional patent applications, including one filed on January 1, 2009, another filed on January 2, 2009, and a third filed on September 22, 2009.

6. Respondent also was engaged to file a non-provisional patent application, which was filed on his client's behalf on December 31, 2009.
7. Respondent received a Notice to File Missing Parts in the non-provisional application, which was mailed by the Office on January 22, 2010; but Respondent did not, at any time, communicate the Notice to his client.
8. Respondent prepared an invoice dated August 5, 2010, which showed improper charges for extra claims and fees not required by the USPTO, in an amount of \$770 for excess independent claims and \$2,288 for total claims, *i.e.*, an overcharge of about \$3,058.
9. Respondent received an Office Action on the merits in the non-provisional application, which was mailed on October 25, 2011, but Respondent (a) failed to communicate the Office Action to his client in a timely manner and (b) failed to respond to the Office Action, which caused the application to become abandoned.
10. The USPTO mailed Respondent a Notice of Abandonment in the non-provisional application on May 8, 2012, which indicated that no reply was received to the Office Action sent October 25, 2011.
11. On July 9, 2012, Respondent filed a Petition for Revival in the non-provisional application, along with additional claims filed in the form of an amendment.
12. Respondent's Petition for Revival was granted, but Respondent received an Office Action mailed on November 6, 2012, providing Notice of Non-Compliant Amendment where he had constructively elected another invention and, thus, the additional claims were not entered.
13. Respondent did not inform his client about the non-compliant amendment, the abandonment, the petition, or the revival of the non-provisional application until January 2013, at which time he advised his client about the original filing error, the steps he had taken to correct the original filing error, the abandonment of the application, and his efforts to revive the application.
14. Respondent did not clearly communicate the dates of the November 6, 2012 Office Action and the October 25, 2011 Office Action, when he discussed prior art applied by the Examiner with his client.
15. Respondent recommended filing a continuation application and offered to only charge USPTO fees to his client. The continuation application was filed on March 15, 2013.
16. The USPTO issued a Notice to File Missing Parts in the continuation application on May 13, 2013 because no fees were submitted with the filing.

17. Respondent received another Office Action in the revived non-provisional application, which was sent by the USPTO on June 19, 2013; but Respondent later incorrectly informed his client on July 23, 2013, that he was “still waiting for action” from the USPTO, and he failed to mention the Office Action or the Notice to File Missing Parts in either pending application.
18. On July 23, 2013, Respondent billed his client for \$3,440 fees in the continuation application, and on August 21, 2013, his client paid him in full for those fees; Respondent, however, improperly billed for more claims than had been filed in the continuation application.
19. Respondent never paid any fees in the continuation application.
20. Respondent sent an October 29, 2013 email to his client where he incorrectly indicated that “there is no action from the Patent Office yet,” despite having received the Office Action dated June 19, 2013.
21. Respondent filed an Office Action Response in the revived non-provisional application sometime in December 2013, but failed to communicate that filing to his client.
22. The USPTO mailed Respondent a Notice of Abandonment in the continuation application on January 22, 2014, which indicated that no reply was received to the Office Action sent May 13, 2013.
23. After the continuation application went abandoned for lack of response, Respondent failed to report the abandonment to his client.
24. Respondent received another Office Action dated March 25, 2014, in the revived non-provisional application, which said his December 2013 response was another non-compliant amendment. Respondent failed to report this to his client.
25. Respondent was also engaged by his client to prepare and file a trademark application. His client paid \$1,075 for the work, but Respondent never filed any such application. Respondent, however, provided his client with a draft trademark search and opinion.
26. Accordingly, Respondent prepared invoices for patent and trademark filings that contained incorrect fee calculations, which resulted in over-charged fees to his client.
27. Respondent stated in mitigation that he made restitution to his client in the form of certain goods, including an automobile, to make up a deficient cash balance for returning over-charged USPTO expenses and legal fees.

28. Respondent also stated in mitigation that he is no longer accepting new clients until the conclusion of the investigation.
29. OED notes in mitigation that Respondent has exhibited a cooperative attitude during the investigation.

Legal Conclusions

30. Respondent acknowledges that, based on the information contained in the Stipulated Facts, above, Respondent's acts and omissions violated the following provisions of the USPTO Code of Professional Responsibility: 37 C.F.R. §§ 10.23(a) and (b) via 10.23(c)(8) (failing to inform a client of correspondence received from the Office), and 10.77(c) (neglecting a legal matter).
31. Respondent also acknowledges that, based on the information contained in the Stipulated Facts, above, Respondent's acts and omissions also violated the following provisions of the USPTO Rules of Professional Conduct: 37 C.F.R. §§ 11.101 (practitioner shall represent client with thoroughness and preparation reasonably necessary for the representation), 11.103 (practitioner shall be diligent in representing a client), 11.104 (practitioner shall communicate with a client as to the matter), and 11.115 (safekeeping client property and funds).

Agreed Sanction

32. Respondent agrees and it is hereby ORDERED that:
 - a. Respondent is suspended from practice before the USPTO in patent, trademark and other non-patent matters for twelve (12) months commencing on the date a Final Order approving this Agreement is signed;
 - b. After completing nine (9) months of his suspension, Respondent may seek reinstatement pursuant to 37 C.F.R. § 11.60, but Respondent shall remain suspended from practice before the Office in patent, trademark, and other non-patent matters until the OED Director grants a petition reinstating Respondent pursuant to 37 C.F.R. § 11.60;
 - c. The OED Director's granting of any petition for reinstatement for Respondent to practice before the Office in patent matters is additionally predicated upon Respondent retaking and passing the Examination for Registration to Practice in Patent Cases Before the USPTO pursuant to 37 C.F.R. § 11.60(c)(1), demonstrating good moral character and reputation, competency, and learning in the law;

- d. The OED Director's granting of any petition for reinstatement for Respondent to practice before the Office in patent matters is additionally predicated upon Respondent retaking and passing the Multistate Professional Responsibility Examination, obtaining a scaled score equal to or greater than 85, and presenting such results to OED;
- e. The Respondent shall comply with 37 C.F.R. § 11.58;
- f. The OED Director shall comply with 37 C.F.R. § 11.59;
- g. The USPTO shall promptly dissociate Respondent's name from all USPTO Customer Numbers and Public Key Infrastructure ("PKI") certificates;
- h. Respondent shall not apply for or obtain a USPTO Customer Number unless and until he is reinstated to practice before the USPTO;
- i. The OED Director shall electronically publish the Final Order at the OED's electronic FOIA Reading Room, which is publicly accessible through the Office's website at: <http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>;
- j. The OED Director publish a notice in the *Official Gazette* that is materially consistent with the following:

Notice of Suspension

This notice concerns Andrew P. Lahser of Scottsdale, Arizona, a registered patent attorney (Registration Number 56,559) who is currently admitted to practice before the United States Patent and Trademark Office ("USPTO" or "Office"). The USPTO Director has suspended Mr. Lahser from practice before the Office in patent, trademark, and other non-patent matters for twelve (12) months. After completing nine (9) months of his suspension, Mr. Lahser may seek reinstatement pursuant to 37 C.F.R. § 11.60, but Respondent shall remain suspended from practice before the Office in patent, trademark, and other non-patent matters until the OED Director grants a petition reinstating Respondent pursuant to 37 C.F.R. § 11.60. In addition, Mr. Lahser must retake and pass (a) the Examination for Registration to Practice in Patent Cases Before the USPTO and (b) the Multistate Professional Responsibility Examination, as conditions of reinstatement.

Mr. Lahser violated the USPTO Code of Professional Responsibility – 37 C.F.R. §§10.23(a) and (b) via 10.23(c)(8) (failing to inform a client of correspondence received from the Office), and 10.77(c) (neglecting a legal matter); and Mr. Lahser

violated the USPTO Rules of Professional Conduct – 37 C.F.R. §§ 11.101 (requiring thoroughness and preparation reasonably necessary for the representation), 11.103 (diligence), 11.104 (communication), and 11.115 (safekeeping property and funds). Mr. Lahser violated the above rules by failing to adequately communicate important Office correspondence to a client, by allowing applications to become abandoned without the client's knowledge or consent, and by preparing invoices for patent and trademark filings that contained incorrect fee calculations, which resulted in over-charged fees. Prior to any disciplinary proceeding, Mr. Lahser voluntarily made restitution to the client.

This action is the result of a settlement agreement between Mr. Lahser and the OED Director pursuant to the provisions of 35 U.S.C. §§ 2(b)(2)(D) and 32, and 37 C.F.R. §§ 11.19, 11.20, 11.26, and 11.59. Disciplinary decisions involving practitioners are posted at OED's electronic FOIA Reading Room, which is publicly accessible through the Office's website at: <http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>.

- k. Nothing in the 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 concerning Respondent brought to the attention of the Office; (2) in any future disciplinary proceeding against Respondent (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
- l. The OED Director and Respondent shall each bear their own costs incurred to date and in carrying out the terms of this Agreement and the Final Order.



SARAH HARRIS
General Counsel for General Law
United States Patent and Trademark Office

6/3/16

Date

on behalf of

Michelle K. Lee
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

Andrew P. Lahser
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Scottsdale, AZ 85250