

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

In the Matter of
BRADLEY P. SYLVESTER,
Respondent

Proceeding No. 05-06

FINAL ORDER

The Director of Enrollment and Discipline (OED Director) of the United States Patent and Trademark Office (USPTO) and Bradley P. Sylvester (Respondent), have submitted a settlement agreement in the above-identified proceeding that meets the requirements of 37 C.F.R. § 10.133(g).

In order to resolve the case without the necessity of a hearing, the OED Director and Respondent have agreed to certain stipulated facts, legal conclusions and sanctions, all of which are set forth below. It was further agreed between the OED Director and Respondent that this agreement resolves any and all disciplinary action by the USPTO arising from the allegations set forth in the Complaint.

Pursuant to that agreement, this Final Order sets forth the following stipulated facts, agreed-upon legal conclusions and sanctions.

STIPULATED FACTS

1. When a patent applicant or the applicant's patent practitioner fails to respond to an outstanding Office action within the prescribed period for response, after the period for which a proper request for an extension of time, if any, could have been made has passed, the application becomes abandoned as of the date the response was originally due. 35 U.S.C. § 133; 37 C.F.R. §§ 1.135-1.136.
2. On or about October 17, 1997, Mr. [] paid Respondent \$1,000 to prepare and file with the USPTO a patent application related to a head restraint.
3. On or about April 15, 1998, Mr. [] paid Respondent another \$3,700 for the preparation and filing of the aforementioned patent application.
4. On July 21, 1998, Respondent sent a letter to Mr. [], in which Respondent told Mr. [] that "[e]nclosed is a copy of the application contents sent to the patent office, and a copy of the document on disk . . . I should be receiving information regarding your application number any time." (Emphasis added.)
5. The USPTO has no record of any patent application naming Mr. [] as an inventor being filed in 1998.

6. More than six months later, on January 27, 1999, the USPTO received a patent application which named Mr. [] as the inventor, U.S. Patent Application No. [] (“Mr. []’ application”), and named Respondent as the party to whom all future correspondence should be sent.
7. On or about February 8, 1999, Respondent sent a letter to Mr. [] informing Mr. [] of the promised application number.
8. The USPTO issued an Office action dated June 26, 2000 in Mr. []’ patent application, which rejected all of Mr. []’ patent claims as anticipated (*i.e.*, not novel and, thus, not patentable) by prior art references. The Office action set a three month shortened-statutory period for response. The three month shortened-statutory period for response could be extended under 37 C.F.R. § 1.136(a) up to a maximum of six months total. Failure to reply within the three month shortened-statutory period or to obtain an extension of time and file a reply within the extended time would result in Mr. []’ application becoming abandoned under 35 U.S.C. § 133.
9. On or about July 11, 2000, Respondent sent a letter to Mr. [], which stated that all of Mr. []’ patent claims had been rejected, and that Respondent would prepare a response to the outstanding Office action. Specifically, Respondent stated, “We can respond to the examiner’s rejection and make amendments to the application,” and estimated that an additional fee of \$600 would be required to prepare a “thorough response.” (Emphasis added.)
10. Respondent sent a bill dated July 11, 2000 to Mr. [] “[f]or work done on preparing response to first office action.” (Emphasis added.). Regarding the date of the bill Respondent states that he used a prior letter (referred to in Paragraph 9) as a template for the bill and forgot to change the date, and otherwise takes the position that the bill was sent to Mr. [] after July 11, 2000.
11. On October 26, 2000, Respondent filed a response to the June 26, 2000 Office action that included an amendment to the patent specification and patent claims, and comments discussing the cited prior art references. The response also included a request for a one month extension of time under 37 C.F.R. § 1.136(a), and the required fee of \$55.
12. On or about December 29, 2000, Respondent sent Mr. [] a receipt for \$600 for payment for “work on the response to the first office action regarding [Mr. []]’ application.”
13. The USPTO issued an Office action dated January 23, 2001 in Mr. []’ application that required a substitute patent specification, and set a one-month period for response. Thus, a timely response was due on February 23, 2001.
14. Respondent admits that he never filed a response to the January 23, 2001 Office action.
15. The USPTO issued a Notice of Abandonment dated August 6, 2001 in Mr. []’ application to Respondent for failure to timely respond to January 23, 2001 Office action.

16. Respondent admits that he did not forward the Notice of Abandonment (or a copy thereof) to Mr. [].
17. Sometime between October 2001 and March 2002, Mr. [] learned from the USPTO that his patent application had gone abandoned for failure to respond to an outstanding Office action.
18. Respondent admits that he did not inform Mr. [] that his patent application had gone abandoned, or discuss the abandonment with Mr. [] until Mr. [] had already learned of the abandonment.
19. On or about March 2, 2002, Mr. [] sent Respondent an email, in which Mr. [] expressed concerns that he had paid Respondent \$600 “to re-write the application.” Mr. [] also expressed concerns that he had recently seen “a head restraint that basically [he] was trying to get protected” in a popular trade magazine, and asked, “what can now be done to either revive the patent [application] or resolve this issue.” Mr. [] asked Respondent to please contact him.
20. On or about March 2, 2002, Respondent sent an email reply to Mr. [], in which Respondent told Mr. [] that he would prepare and file a new patent application for Mr. [] free of charge to resolve the matter:

I talked to the examiner previously, and from what I understood, your patent [application] was not going to be allowed with the present claims, but there might be a chance if we refiled it with some additional material. It is my intent to redraft some of the language, add some discussion, and refile it with the new material. I am not intending to charge you for any of this. (Emphasis added.)

21. Two months later, on or about April 2, 2002, Mr. [] sent Respondent another email, in which Mr. [] complained to Respondent that he had not heard from Respondent regarding his patent application, and noted Respondent’s promise to “do some additional work to try to get it accepted.” Mr. [] also inquired about the ability to protect his invention now that he was sure others were marketing the device.
22. On or about April 2, 2002, Respondent sent an email reply to Mr. [], in which Respondent assured Mr. [] that Respondent would prepare and deliver a new patent application to Mr. [] within the next 10 days:

I am redoing your application, and will either email it to you, or mail it hard copy to you. It will probably be 10 days before you get the new and improved version, due to the fact that I was out of town this week. You can always contact me by email, whether or not I am in the office. (Emphasis added.)

23. Respondent failed to email or send a hard copy of a new patent application to Mr. [] in the next 10 days.

24. On November 15, 2002, Mr. [] sent a letter by certified mail to Respondent, in which Mr. [] reminded Respondent that Respondent had told him that he would revive his patent application, but that Mr. [] had contacted the USPTO and was informed that his patent application was still abandoned. Importantly, Mr. [] also stated that he had not heard from Respondent since Spring 2002, and demanded to know Respondent's intentions with respect to the patent application within five working days:

You told me that you [were] going to mail me the paperwork to revive my patent. As I had contacted the patent office and they [have] told me they requested some information from you and they never received a reply from you. I don't know why you never replied to them but I never told you to stop proceeding with my patent [application]. I have not received any information from you since our conversation last spring and need to know what you plan on doing to get this patent [application] back underway. It has been sometime since I have applied for the patent and I feel that this time frame could have been considerably shorter if you would have followed up on your work. Please let me know in writing what your intentions are within five working days. (Emphasis added.)

25. Ten days later, on November 25, 2002, Respondent sent a letter to Mr. [], in which Respondent told Mr. [] that he would "revise" Mr. []' patent application and send it to Mr. [] for review by December 9th.

I will revise your application, and send it to you for review. I would like to promise it before Thanksgiving, but that is a bit unrealistic, with my current schedule. I believe that the week ending December 9th is a realistic time frame. (Emphasis added.)

26. Respondent's November 25, 2002 letter failed to state whether Respondent intended to file an amendment and response in Mr. []' original application, or a new application. Respondent's letter also failed to inform Mr. [] that, to revive his now-abandoned patent application, he would also have to file a Petition to Revive under 37 C.F.R. § 1.137 along with the required fee, and that the USPTO was not required to grant such a petition.
27. Respondent did not send a patent application to Mr. [] for review by December 9, 2002.
28. Sometime in January 2003, Mr. [] retained the legal services of [other practitioner], a patent attorney in [], Kansas.
29. On January 10, 2003, Mr. [other practitioner] telephoned Respondent to express Mr. []' concerns over Respondent's handling of Mr. []' now-abandoned patent application.
30. On January 12, 2003, Respondent called Mr. [], and stated that he would prepare and file a new patent application for Mr. [].
31. Respondent failed to contact Mr. [] during the next almost four months.

32. On or about January 15, 2003, Mr. [other practitioner] sent a letter to Mr. [] cautioning Mr. [] that “some 600,000 U.S. patents have issued since [his] original application was filed. We would therefore, highly recommend a new patentability search prior to filing this new application.”
33. On or about April 16, 2003, Mr. [] sent a letter by certified mail to Respondent, which stated that Mr. [] had not “received any word from you about your attempt to revive my patent. Please inform me of your attempt,” and asked for a response in the next five working days.
34. Over three weeks later, on May 5, 2003, Respondent sent a letter to Mr. [], in which Respondent told Mr. [] that he was “going through [Mr. []]’ application and prior art that [he] located on the web,” and that he “need[ed] a few more days to send everything to [Mr. []] as requested, and a sample filing for the patent office.”
35. Respondent admits that he never sent Mr. [] a copy of either a new or revised patent application for filing with the USPTO.
36. The USPTO has never received a petition to revive Mr. []’ patent application, or any other paperwork in connection with Mr. []’ application from Respondent since it went abandoned on August 6, 2001.
37. In the January 15, 2003 letter from Mr. [other practitioner] to Mr. [], Mr. [other practitioner] warned Mr. [] to get copies of all correspondence between the USPTO and Respondent concerning Mr. []’ patent application.
38. In the April 16, 2003 letter by certified mail from Mr. [] to Respondent, Mr. [] requested copies of all correspondence between the USPTO and Respondent concerning Mr. []’ patent application within the next five working days.
39. In the May 5, 2003 letter from Respondent to Mr. [], Respondent stated that he “need[ed] a few more days to send everything to [Mr. []] as requested, and a sample filing for the patent office.” (Emphasis added.)
40. The May 5, 2003 letter from Respondent to Mr. [] did not include copies of the requested correspondence.
41. Respondent never sent Mr. [] copies of all correspondence between the USPTO and Respondent concerning Mr. []’ patent application.
42. On December 8, 2005, the Kansas Board for Discipline of Attorneys (“Kansas Hearing Board”) of the Kansas Office of the Disciplinary Administrator (“ARDC”) issued a decision in a disciplinary proceeding involving Respondent.
43. The Hearing Board found that Respondent had engaged in the following activities in violation of the Kansas Rules of Professional Conduct (“KRPC”) for the Supreme Court of Kansas:

- a. failing to give competent representation to his client (KRPC 1.1);
 - b. failing to consult with his client regarding the management of his client's case (KRPC 1.2(a));
 - c. failing to act with reasonable diligence and promptness in representing his client (KRPC 1.3);
 - d. failing to keep his client reasonably informed about the status of a matter and promptly complying with reasonable requests for information (KRPC 1.4(a)); and
 - e. engaging in conduct involving dishonesty, fraud, deceit or misrepresentation (KRPC 8.4(c)).
44. Based on these factual findings, the Kansas Hearing Board issued a Final Hearing Report, which recommended that Respondent be suspended from practice in Kansas for 90 days. Respondent's suspension was further conditioned on Respondent providing restitution to Mr. [] in the amount of \$5,800.
45. The Final Hearing Report has been docketed for *de novo* review with the Kansas Supreme Court, but no final decision from the Kansas Supreme Court has issued as of the time this settlement agreement was drafted.

LEGAL CONCLUSIONS

46. Based upon the foregoing stipulated facts, Respondent acknowledges that his conduct violated the following Disciplinary Rules of the USPTO Code of Professional Responsibility:
- a. 37 CFR § 10.23(c)(8), by failing to inform Mr. [] of the Notice of Abandonment received from the USPTO when the correspondence (i) could have a significant effect on a matter pending before the Office, (ii) was received by the practitioner on behalf of a client, and (iii) was correspondence of which a reasonable practitioner would believe under the circumstances the client should be notified;
 - b. 37 CFR § 10.77(c), by neglecting the patent application that was entrusted to him by Mr. [];
 - c. 37 CFR § 10.84(a)(2), by failing to carry out the contract of employment with Mr. [] to prosecute a patent application;
 - d. 37 CFR § 10.84(a)(3), by prejudicing and damaging Mr. [] during the attorney-client relationship; and
 - e. 37 C.F.R. § 10.112(c)(4), by failing to promptly deliver Mr. []' property to him as requested.

SANCTIONS

Based on the foregoing, it is:

47. **ORDERED** that the Final Order incorporates the facts stipulated in Paragraphs 1 - 45 above.
48. **ORDERED** that Respondent is suspended from practicing patent, trademark and other non-patent law before the USPTO for six months from the date of this Final Order.
49. **ORDERED** that the OED Director publish the following Notice in the Official Gazette:

Notice of Suspension

Bradley P. Sylvester, of Wichita, Kansas, a patent attorney whose registration number is 36,944, has been suspended from practice before the Office for a period of six months. This action is taken pursuant to the provisions of 35 U.S.C. § 32 and 37 C.F.R. § 10.133(g).

50. **ORDERED** that the OED Director give notice to appropriate employees of the USPTO, courts, and authorities of Kansas and any other state in which Respondent is known to be a member of the bar; and any appropriate bar association. 37 C.F.R. § 10.159(a).
51. **ORDERED** that within 30 days of the date of this Final Order, Respondent shall, in accordance with 37 C.F.R. § 10.158(b)(2), surrender each client's active USPTO case file(s) to (1) each client or (2) another practitioner designated by each client, and shall file proof thereof with the OED Director within the same 30 day period.
52. **ORDERED** that during the period Respondent is suspended any communication relating to a client matter that is addressed to Respondent and/or received by him shall be immediately forwarded to the client or the practitioner designated by the client, and that Respondent will take no other legal action in the matter, enter any appearance, or provide any legal advice concerning the matter that is the subject of the communication, all in accordance with 37 C.F.R. §§ 10.158(a), (b)(2), (b)(6).
53. **ORDERED** that within 30 days of the date of this Final Order, Respondent shall, in accordance with 37 C.F.R. §§ 10.158(b)(8) and 10.160(d), return to any client having immediate or prospective business before the Office any unearned legal funds, including any unearned retainer fee, and any securities and property of the client, and shall file a proof thereof with the OED Director no later than filing his petition for reinstatement.
54. **ORDERED** that after the date of this Final Order, Respondent shall promptly take steps to comply with the provisions of 37 C.F.R. §§ 10.158(b)(3), (b)(4), (b)(5), (b)(6), and (b)(7), and further, within 30 days of taking steps to comply with § 10.158(b)(4) Respondent shall file with the OED Director an affidavit describing the precise nature of the steps taken, and still further directing that Respondent shall submit proof of compliance with §§ 10.158(b)(3), (b)(5), (b)(6), and (b)(7) with the OED Director upon filing a petition for reinstatement under 37 C.F.R. § 10.160.

55. **ORDERED** that after the date of this Final Order, Respondent shall promptly take steps to fully comply with the provisions of 37 C.F.R. §§ 10.158(c) and (d).
56. **ORDERED** that following the suspension for six months in compliance with the foregoing provisions, Respondent may apply for reinstatement to practice effective upon filing a petition for reinstatement and an affidavit showing compliance with the following conditions:
- a. Respondent demonstrates compliance with 37 CFR §§ 10.158 and 10.160;
 - b. Respondent successfully takes and passes the Registration Examination to practice patent law before the USPTO; and
 - c. Respondent successfully completes the terms for readmission to practice before the Kansas Supreme Court once there is a final decision by that court.
57. **ORDERED** that all parties shall bear their own costs.

On behalf of Jon W. Dudas
*Under Secretary of Commerce For Intellectual
Property and Director of the United States Patent
And Trademark Office*

3/15/06
Date

/s/
James A. Toupin
*General Counsel
United States Patent and Trademark Office*

cc: Harry I. Moatz
OED Director

Bradley P. Sylvester
□