

In Re: [REDACTED]

MEMORANDUM AND ORDER

I. BACKGROUND AND PROCEDURAL HISTORY

Petitioner then applied for, and after regrade, passed the October 2001 examination. In

order to complete the registration process, Petitioner was required to submit: a completed Data Sheet, Oath, the \$100 registration fee, and a certificate of good standing. Petitioner returned the Data Sheet (indicating registration as an Attorney), the Oath and \$100 registration fee, but did not include a certificate of good standing.

By letter dated April 15, 2002, OED reminded Petitioner of the need to submit a certificate of good standing. In a May 13, 2002, letter to Petitioner, OED noted Petitioner was a member of a Bar and stated, "in order to have your status changed from Agent to Attorney, you must submit a recent certificate of good standing [within the last six (6) months]."

On June 1, 2002, OED completed Petitioner's registration as a Patent Agent, rather than as a Patent Attorney, because OED had not received a certificate of good standing.

In a June 1, 2002, letter to Petitioner notifying him the registration process was complete, OED erroneously categorized Petitioner as a "registered [P]atent Attorney." The notification to Petitioner had a certificate of registration as an Agent attached. On the file copy of the letter, an OED staff member crossed out the word "Attorney" and handwrote the word "Agent," but Petitioner's letter was not so corrected.

Also on June 1, 2002, OED received Petitioner's certificate of good standing (mailed by Petitioner on May 30, 2002). OED then changed Petitioner's registration from Agent to Attorney effective June 1, 2002, and sent Petitioner a new registration certificate reflecting the change.

On the OED roster of registered Patent Attorneys and Agents, Petitioner is shown to have registered as a Patent Agent on June 1, 2002, and as a Patent Attorney on June 1, 2002.

Petitioner requested OED delete the listing showing him as a Patent Agent on June 1, 2002, and change the date of Petitioner's registration as an Attorney from June 1, 2002, to June 1, 2002.

2002. In its December 22, 2006 decision, OED refused to change the information on the roster.

On January 9, 2007, within the appellate period of 60 days, Petitioner filed a petition for review of the OED decision. On April 5, 2007, the OED Director issued his Final Decision denying Petitioner's request to change his registration status. The Petitioner then filed a timely appeal of the OED Director's June 4, 2007, decision.

II. LEGAL STANDARD

A. Recognition.

The Office governs the recognition of Attorneys and Agents for practice before the Office, and may require them to show they are possessed of the necessary qualifications. 35 U.S.C. § 2(b)(2)(D). The Office will not register anyone to practice unless they have submitted all requested information. 37 C.F.R. § 11.7(a)(1). The Office has defined "attorney" as "an individual who is a member in good standing of the bar of any United States court or the highest court of any State." 37 C.F.R. § 10.1(c).

B. Review of OED Director's Final Decision.

An individual dissatisfied with the final decision of the OED Director may petition the USPTO Director for review. 37 C.F.R. § 11.2(d). The petition must be accompanied by the appropriate fee (see 37 C.F.R. § 1.21(a)(5)(ii)), and must be filed within sixty days of the mailing date of the final decision of the OED Director. 37 C.F.R. § 11.2(d). Petitions not filed within sixty days will be dismissed as untimely. 37 C.F.R. § 11.2(d).

III. OPINION

A. Decision to Register as an Agent.

By letter dated April 15, 2002, OED informed Petitioner that in order to complete the registration process (as an Attorney), he must submit certain information within 30 days, to

include submission of a certificate of good standing issued within the past six months. The letter further indicated that a failure to reply in a timely manner would delay processing. Petitioner submitted the other required information, but did not submit the required letter of good standing within 30 days.

On May 13, 2002, upon review of Petitioner's submittal of registration information, OED sent a second letter to Petitioner informing him that registration as an Attorney rather than an Agent, required submittal of a certificate of good standing that had been issued within the past six months.

On June 1, 2002, OED had not received the twice-requested certificate of good standing, and registered Petitioner as an Agent because he had not proven he met the requirements to be registered as an Attorney.

Petitioner does not dispute that he is required to submit a certificate of good standing. He also does not dispute that he failed to do so in a timely manner. While Petitioner attacks the OED Director's decision on other grounds, he ignores the glaring conclusion he has not done what he was required to do in the allotted time.

B. Petitioner's Arguments.

Petitioner makes three arguments in support of his Petition. First, he alleges listing him as an Agent instead of an Attorney is false, confusing, and misleading. Second, he argues listing him as an Agent instead of an Attorney violates the California Rules of Professional Conduct. Third, and finally, he argues that OED had sufficient evidence of his attorney status prior to June 1, 2002. We address these arguments in turn.

Petitioner argues that because the OED website lists Petitioner's status as being registered as a Patent Agent on June 1, 2002, and as a registered Patent Attorney on June 1, 2002, the

website “effectively misleads viewers to consider that Appellant was not an active attorney on 06/02, when in fact Appellant was an active attorney since 05/93.” Petitioner’s Appeal at 2.

Petitioner’s argument is without merit; the listing accurately reflects Petitioner’s status, and it is not misleading. The listing is accurate because as of June 1, 2002, Petitioner had completed the requirements for registration as an Agent, but had not submitted a certificate of good standing, and as a result had not met the requirements for registration as an Attorney. When Petitioner submitted the required certificate, his status was accurately and timely updated (to Attorney). Further, the listing is not misleading. The listing reflects each practitioner’s registration status with the Office, not their status with a state bar. Nothing on the OED listing suggests the list reflects state bar status.

Next, Petitioner argues the listing violates the California Rules of Professional Conduct. More specifically, the Petitioner argues that Rule 1-400 of the California Rules of Professional Conduct addresses communications made by or on behalf of a member concerning the availability for professional employment of a member or law firm directed to any former, present, or prospective client. Petitioner’s Appeal at 2. Petitioner argues that, as a result of the OED’s current listing of Petitioner as Patent Agent as of June 1, 2002, and as Patent Attorney as of June 1, 2002, a person viewing this profile is “... misled to incorrectly conclude that [Petitioner] became an Attorney in 2002. Since Appellant was a California Bar member in good standing for eight years prior to this date (inactive 1994 to 1999, because active with IL Bar), this Patent Agent registration listing is false and misleading.” *Id.* at p. 3.

Like Petitioner’s prior argument, this argument ignores the fact that the OED listing reflects registration status with the Office. Petitioner’s suggestion this listing violates the

California Rules of Professional Conduct is specious. First, the Office, as a federal entity, is not subject to ensuring our rules are consistent with those of the California Bar. Second, even with consideration for the California rules, our listing is not a communication made by or on behalf of petitioner; rather, it is simply a reflection of the petitioner's status with our agency. Not only are the Office's rules not required to conform to the California Bar rules, but there is also in fact no conflict in this case.

Finally, Petitioner argues that the OED had sufficient evidence of Petitioner's good standing prior to June 1, 2002. In support thereof, Petitioner attaches his certificate of good standing issued by the State Bar of California on May 28, 2002, which "date is prior to the OED erroneous listing of Appellant's status as a Patent Agent on 06/01/02." Petitioner's Appeal at 4. The Petitioner goes on to cite the June 1, 2002, letter from OED notifying Petitioner that he may properly hold himself out as a Patent Attorney as of June 1, 2002.

Petitioner's argument runs counter to the facts of the case. Petitioner's letter of good standing dated May 28, 2002, and mailed on May 30, 2002, was received by the Office on June 1, 2002. Petitioner was accurately listed as an Agent on June 1, 2002, because he had not submitted sufficient proof he was in good standing until June 1, 2002. In addition, OED informed Petitioner by letter dated April 15, 2002, and again by letter dated May 13, 2002, that petitioner needed to submit a current certificate of good standing. Petitioner failed to respond in the allotted time, and OED registered Petitioner based upon the requirements he had met. Once Petitioner submitted the certificate of good standing, OED posted Petitioner's new status as an Attorney in a timely manner.

As Petitioner points out, OED's June 1, 2002, letter contained an erroneous statement that Petitioner "may now properly hold yourself out as a registered patent attorney." However,

Petitioner fails to point out that the certificate accompanying that letter was a certificate of registration as an Agent, demonstrating the status in the letter was clearly a clerical error. While the erroneous statement is regrettable, the error does not support Petitioner's argument to change his status. An erroneous letter to Petitioner stating he is a registered Patent Attorney does not make him a properly registered Patent Attorney; rather, meeting the requirements of registration is the only method of becoming a properly registered. The relevant inquiry then is whether Petitioner met the requirements of registration as a Patent Attorney. As of June 1, 2002, when OED posted the listing showing Petitioner was a properly registered Patent Agent, that in fact was the correct status.

IV. CONCLUSION

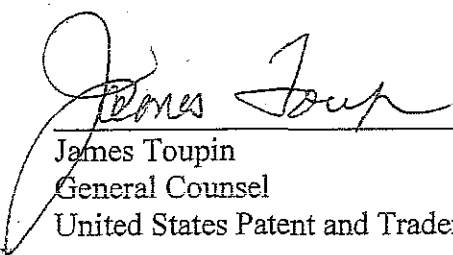
The OED Director properly determined and listed Petitioner as a Patent Agent as of June 1, 2002, and as Patent Attorney as of June 1, 2002. Petitioner's arguments otherwise are unpersuasive. Petitioner's appeal from the final decision of the OED Director should be denied.

ORDER

Upon consideration of the Petitioner's Appeal from the Final Decision of the OED Director under 37 CFR § 11.2(d), it is ORDERED that the OED Director's decision is hereby affirmed.

On behalf of the Under Secretary of Commerce for
Intellectual Property and Director of the United
States Patent and Trademark Office

September 26, 2007
Date


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