

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL
PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re

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) Decision on Petition
) Under 37 C.F.R. § 11.2(d)
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MEMORANDUM AND ORDER

(Petitioner) seeks review of the June 2, 2008, Final Decision and Memorandum Opinion (Final Decision) of the Director of the Office of Enrollment and Discipline (OED Director) denying Petitioner's application for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases. The OED Director denied Petitioner's request to be registered as a patent attorney under 37 C.F.R. § 11.7(a)(2)(i) because Petitioner failed to demonstrate he presently has the good moral character and reputation required to represent applicants before the USPTO. For the reasons stated below, Petitioner's request to review the OED Director's June 2, 2008, Final Decision is DISMISSED.

I. BACKGROUND AND PROCEDURAL HISTORY

Petitioner submitted an Application for Registration to Practice Before the United States Patent and Trademark Office (Application for Registration), dated December 29, 2007, and passed the registration exam on March 13, 2008. On April 3, 2008, the Office of Enrollment and Discipline (OED) requested further information based on Petitioner's disclosure in his Application for Registration of five arrests for alcohol-related conduct. Petitioner submitted documentation in response along with a reply, dated April 21, 2008.

The OED Director sent Petitioner a Show Cause Requirement, dated April 28, 2008, requiring Petitioner to show cause why his application for registration to practice before the USPTO should not be denied. Petitioner submitted additional documentation in response along with a reply, dated May 20, 2008.

On June 2, 2008, the OED Director issued a Final Decision, denying Petitioner's Application for Registration due to Petitioner's failure to meet his burden of establishing to the satisfaction of the OED Director that he presently possesses the good moral character and reputation required to represent applicants before the USPTO.

Counsel for Petitioner (counsel) filed a Notice of Appearance, dated July 27, 2008, stating that he had been retained to represent Petitioner before the USPTO in this matter. Counsel simultaneously filed a Request for Extension of Time, requesting a one-week extension of the deadline, to file a petition for review of the OED Director's Final Decision. In his Request for Extension of Time, counsel stated that he had switched law firms on July 15, 2008, and that Petitioner was studying for the New York state bar exam, which was scheduled to conclude on July 30, 2008.

On August 1, 2008, counsel was informed by the USPTO Office of General Counsel (OGC) that his Request for Extension of Time (and suspension of the rules under 37 C.F.R. § 11.3) to file a petition for review from August 1, 2008, to August 8, 2008, was granted on behalf of the Director of the USPTO.

On August 8, 2008, counsel signed and filed a Petition to Review the Final Decision and Memorandum Opinion of the OED Director (Petition) under 37 C.F.R. § 11.2(d). The Petition included an instruction to charge the fee due under 37 C.F.R. § 1.21(a)(5)(ii) to Deposit Account 501165.

On August 11, 2008, a second attorney at counsel's law firm (second counsel) filed a supplement to the Petition. The supplement states that, on August 11, 2008, OED informed counsel by telephone that he was not an authorized user on Deposit Account . The supplement included an authorization by second counsel to charge the petition fee due to Deposit Account .

On November 6, 2008, the OGC issued an Order to Show Cause why the Petition should not be dismissed for untimely payment of the fee due under 37 C.F.R. § 1.21(a)(5)(ii). On November 14, 2008, counsel filed a Response to Order to Show Cause, contending that, based on his investigation, counsel was on the list of authorized users for Deposit Account on August 8, 2008, and that the fee required under 37 C.F.R. § 1.21(a)(5)(ii) had been timely paid.

II. LEGAL STANDARD

The Director of the USPTO requires agents, attorneys, or other persons being recognized as representatives of applicants or other persons, to show that they are of good moral character and reputation prior to registration. 35 U.S.C. § 2(b)(2)(D); 37 C.F.R. § 11.7(a)(2)(i).

The OED Director receives and acts on applications for registration, including investigations into moral character and reputation. 37 C.F.R. §§ 11.2(b)(2)-(b)(3). 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 payment of the appropriate fee required under 37 C.F.R. § 1.21(a)(5)(ii), and must be filed with the OED Director 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 shall be dismissed as untimely. 37 C.F.R. § 11.2(d).

A petitioner may seek suspension of any requirement of these rules “[i]n an extraordinary situation.” 37 C.F.R. § 11.3.

III. OPINION

A. The fee was not timely paid.

The fee required for the Petition under 37 C.F.R. § 11.2(d) was not timely paid. Both the Petition and the fee due under 37 C.F.R. § 1.21(a)(5)(ii) were required to be filed by August 8, 2008. 37 C.F.R. § 11.2(d).

On August 8, 2008, counsel included an instruction in the Petition to charge the fee due to Deposit Account . Although counsel contends in the Response to Order to Show Cause that his name was added to the list of authorized users for Deposit Account on July 25, 2008, it was not. The records of the USPTO Office of Financial Management Systems shows that counsel’s name was added to the list of authorized users via the USPTO’s Office of Finance’s Online Shopping Page, a self-service website, at 4:04 PM (ET) on August 11, 2008.

Because counsel’s name was not on the list of authorized users for the Deposit Account, counsel was contacted by the USPTO on August 11, 2008, and was informed that he was not authorized to issue payments therefrom. Second counsel, an authorized user of the Deposit Account, then authorized payment of the required fee for the Petition from the Deposit Account at 3:50 PM on August 11, 2008. Payment for the Petition, therefore, was filed on August 11, 2008.

B. Waiver of rules unwarranted.

No compelling case has been presented for an “extraordinary situation” under 37 C.F.R. § 11.3, warranting a waiver of the requirement for timely fee payment. In the Response to Order to Show Cause, counsel contends that, based on his investigation of the circumstances

surrounding the addition of his name to the list of authorized users for Deposit Account, his name was added to the list of authorized users on July 25, 2008. To support his contention, counsel includes declarations from various staff members of his law firm. However, as explained above, counsel's name was not added to the Deposit Account list of authorized users until August 11, 2008.

Counsel has not shown that the USPTO was in error when it determined that counsel's name was not on the list of authorized users for Deposit Account. Nor has counsel demonstrated that the delay in adding counsel to the list of authorized users for Deposit Account 501165 establishes a basis for a showing of an extraordinary situation. Significantly, counsel had requested, and had been granted, a suspension of the rules under 37 C.F.R. § 11.3 to obtain a one-week extension of time to submit his Petition and the requisite fee. Counsel should have used that time to take all steps necessary to ensure that the Petition and fee were filed in accordance with the requirements found in 37 C.F.R. 11.2(d).

IV. CONCLUSION

For the foregoing reasons, the Petition to Review the Final Decision and Memorandum Opinion of the OED Director is dismissed as untimely. Accordingly, proceedings regarding Petitioner's application dated December 29, 2007, are now concluded. This disposition is without prejudice to any reapplication for registration to practice before the USPTO that applicant may file in accordance with the provisions of 37 C.F.R. § 11.7(k).

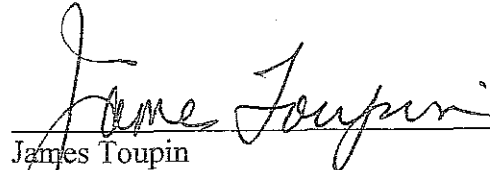
ORDER

Upon consideration of the Response to the Show Cause Order, it is **ORDERED** that the
Petition to Review the Final Decision and Memorandum Opinion of the OED Director is
DISMISSED.

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

FEB 13 2009

Date


James Toupin
General Counsel
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cc:

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