

In the Matter of)
)
S. Michael Bender,)
)
Respondent) Proceeding No. D2011-67
)
)

The Deputy General Counsel for Enrollment and Discipline and Director of the Office of Enrollment and Discipline (“OED Director”) for the United States Patent and Trademark Office (“USPTO” or “Office”) and S. Michael Bender (“Respondent”) have submitted a Proposed Settlement Agreement (“Agreement”) to the Acting Under Secretary of Commerce for Intellectual Property and Acting Director of the United States Patent and Trademark Office (“Acting USPTO Director”) for approval.

Jurisdiction

- ### Stipulated Facts

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6. The USPTO rules in effect at the time of Respondent's exclusion from practice before the Office stated, *inter alia*, that a practitioner who is excluded from practice before the Office shall not engage in the unauthorized practice of patent, trademark, and other non-patent law before the Office.

7. To date, Respondent has not sought reinstatement to practice before the Office under any section of the patent statute or rules promulgated thereunder.

8. At all times relevant to this matter, Respondent has been prohibited from practicing patent, trademark, and other non-patent law before the Office.

9. During an investigation of alleged misconduct by Respondent, an Office of Enrollment and Discipline ("OED") Staff Attorney mailed to Respondent a letter dated April 20, 2011 bearing the caption: "REQUEST FOR STATEMENT OF RESPONDENT'S POSITION."

10. The April 20, 2011 letter alleged that Respondent had not complied with the September 2003 Final Order because, while excluded, Respondent practiced before the Office in patent matters.

11. In Respondent's May 19, 2011 response to the OED Staff Attorney's April 20, 2011 letter, Respondent in part stated: "My position is that I have complied with the 'Final Order dated September 3, 2003' referred to in your letter following the effective date thereof."

12. OED considered Respondent's reply, quoted in paragraph 11 above, to comprise a false or misleading statement and on May 19, 2012, filed a disciplinary complaint under 35 U.S.C. § 32 that alleged violations of 37 C.F.R. §§ 10.23(a); 10.23(b)(4); 10.23(b)(5); 10.23(b)(6); and 10.89(c)(6).

Legal Conclusion

13. Respondent acknowledges that, based on the information contained in the above stipulated facts, his May 19, 2011 response to OED violated 37 C.F.R. § 10.23(b)(5) (proscribing engaging in conduct prejudicial to the administration of justice).

Agreed Upon Sanction

14. Respondent agrees, and it is hereby ORDERED that:

- a. Respondent shall be, and hereby is, suspended from practice before the Office in patent, trademark, and other non-patent matters for one year in addition to the previous five-year exclusion, such that Respondent shall be eligible to apply for reinstatement under 37 C.F.R. § 11.60 no earlier than six years from November 3, 2007;
- b. Respondent shall comply with 37 C.F.R. § 11.58;

- c. The OED Director shall comply with 37 C.F.R. § 11.59;
- d. The OED Director shall electronically publish this 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>.
- e. The OED Director shall publish the following notice in the *Official Gazette*:

Notice of Suspension

This notice concerns S. Michael Bender of St. Petersburg, Florida, a registered patent attorney (Registration Number 24,038) who is currently excluded from practice before the United States Patent and Trademark Office ("USPTO" or "Office"). The Acting USPTO Director has suspended Mr. Bender for an additional one year, such that Mr. Bender shall be eligible to apply for reinstatement under 37 C.F.R. § 11.60 no earlier than six years from the effective date of his exclusion.

Mr. Bender's additional one-year suspension is based upon his violation of 37 C.F.R. §10.23(b)(5) (proscribing engaging in conduct prejudicial to the administration of justice). During the course of an Office of Enrollment and Discipline ("OED") investigation, OED alleged that Mr. Bender had violated the terms of his exclusion by continuing to engage in the practice of patent law while excluded. In response, Mr. Bender represented that "it was his position he complied with [the prior Final Order excluding him from practice], following the effective date thereof." OED considered this representation to be false and misleading based on the evidence obtained during its investigation.

This action is the result of a settlement agreement between Mr. Bender 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 and 11.26. 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>.

- f. 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/or

(3) when considering any request for reconsideration submitted by Respondent pursuant to 37 C.F.R. § 11.60;

g. Respondent shall fully comply with 37 C.F.R. § 11.60 upon any request for reinstatement to practice before the Office;

h. Within thirty-five (35) days of the date of this Final Order, the parties shall submit a joint motion to dismiss the USPTO disciplinary proceeding pending against Respondent; and

i. The OED Director and Respondent shall each bear their own costs incurred to date and in carrying out the terms of this Agreement.


JAMES O. PAYNE
Deputy General Counsel for General Law
United States Patent and Trademark Office

APR 25 2013
Date

on behalf of

Teresa Stanek Rea
Acting Under Secretary of Commerce for Intellectual Property and
Acting Director of the United States Patent and Trademark Office

cc:

Director of the Office of Enrollment and Discipline
United States Patent and Trademark Office

S. Michael Bender
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