

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

In the Matter of)

Charlena L. Thorpe,)

Respondent)
_____)

Proceeding No. D2016-26

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 Charlena L. Thorpe (“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, Respondent of Duluth, Georgia has been a registered patent attorney (Registration Number 48,035) subject to the USPTO Rules of Professional Conduct, which are set forth at 37 C.F.R. §§ 11.101 through 11.901.

2. The USPTO Director has jurisdiction over this matter pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 C.F.R. §§ 11.19, 11.20, and 11.26.

Stipulated Facts

3. Respondent was registered as a patent attorney by the USPTO on June 22, 2001 (Registration Number 48,035).

4. Respondent was admitted to the State Bar of Georgia on November 21, 2000, where she is an active member in good standing.

5. On July 18, 2013, Dr. Irwin Share and Respondent signed an engagement letter in connection with Dr. Share’s invention, entitled, “[REDACTED]” The agreement set forth a flat fee for a patentability analysis and that Dr. Share would pay an hourly rate for any services outside of the agreed flat fee.

6. On August 1, 2013, Dr. Share paid Respondent \$5,200 via check for "fee towards legal matters."

7. On August 2, 2013, Respondent deposited the \$5,200 check from Dr. Share into her Interest on Lawyer Trust Account ("IOLTA").

8. Respondent believed the agreement set forth that the \$5,200 was an advance fee that would be billed against based on the hourly rate set forth in the June 18, 2013 agreement. Dr. Share believed that \$400 of the \$5,200 would be earmarked for filing fees.

9. On August 26, 2013, Respondent filed Provisional Patent Application No. [REDACTED] ("the [REDACTED] provisional application"), titled "[REDACTED]," naming Dr. Share as the sole inventor.

10. Respondent did not charge a fee for filing the provisional patent application.

11. Dr. Share continued to work on his invention after Respondent filed the provisional application. It was his understanding that Respondent would incorporate any changes and improvements into the nonprovisional patent application that she was to draft and file on Dr. Share's behalf.

12. Respondent and a patent agent, Mr. W.T., employed by Respondent's firm, began working with Dr. Share to prepare his nonprovisional patent application. Although Respondent began providing patent legal services to Dr. Share under the July 18, 2013 agreement, Respondent and Dr. Share attempted to negotiate a flat fee agreement for the nonprovisional application.

13. In March 2014, Dr. Share forwarded to Respondent his numerous improvements and changes to his invention after the provisional application had been prepared and filed. He emailed these improvements to Respondent.

14. After a March 11, 2014 meeting, Respondent re-sent Dr. Share an engagement letter for the nonprovisional application that had been provided to Dr. Share in November 2013.

15. Dr. Share believed that the improvements would be incorporated into the nonprovisional application with no additional fees charged.

16. Respondent and Mr. W.T. believed their communication informed Dr. Share that he would need to pay additional fees in order to include the new matter not the subject of the provisional patent application.

17. After lengthy negotiations on a flat fee arrangement, Respondent retracted the March 11, 2014 engagement letter after the parties failed to negotiate a flat fee agreement. Nevertheless, Dr. Share signed the March 11, 2014 engagement letter on June 17, 2014.

18. The communications between Dr. Share and Mr. W.T. during the drafting of the nonprovisional application led Dr. Share to believe that Mr. W.T. was incorporating his improvements into the final draft of the application.

19. On August 13, 2014, Respondent's office sent the draft nonprovisional patent application to Dr. Share.

20. The August 13, 2014 draft patent application did not include any of the improvements and changes that had been sent by Dr. Share to Respondent.

21. Dr. Share was dissatisfied with the draft patent application he received from Respondent and requested that it be redrafted to include the new matter he had provided to Respondent.

22. On August 21, 2014, Respondent emailed Dr. Share and said that the new matter would be incorporated into the draft application only if Dr. Share paid an additional \$4,000.

23. Dr. Share refused to pay any additional sums, terminated the attorney-client relationship, and demanded a refund of all sums he had paid to Respondent.

24. Respondent did not respond to Dr. Share's demand for a refund of all sums he had paid.

Mitigation

25. Respondent has no prior disciplinary history before the Office during the fifteen years she has been registered as a patent attorney.

Joint Legal Conclusion

26. Respondent acknowledges, based on the above stipulated facts, that she violated 37 C.F.R. § 11.104 (b) (failing to explain a matter to the extent reasonably necessary to permit the client to make informed decisions regarding the representation) by not adequately informing Dr. Share that Respondent believed that Dr. Share had changed the scope of his invention such that additional fees would be required to be paid in advance in order for his improvements to be incorporated into the nonprovisional application.

Agreed Upon Sanction

27. Respondent agrees and it is hereby ORDERED that:

- a. Respondent is hereby publicly reprimanded;
- b. Respondent shall refund \$400 to Dr. Share within one month of the date of this Final Order and provide proof to the OED Director of the payment;

- c. Respondent shall attend a Continuing Legal Education seminar on law practice management within one year of the date of this Final Order and provide proof to the OED Director of the attendance;
- d. The OED Director shall electronically publish the Final Order at OED's electronic FOIA Reading Room, which is publicly accessible at: <http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>;
- e. The OED Director shall publish the following notice in the *Official Gazette*:

Notice of Public Reprimand

This notice concerns Charlena L. Thorpe of Duluth, Georgia, a registered patent practitioner (Registration Number 48,035). The United States Patent and Trademark Office ("USPTO" or "Office") has publicly reprimanded Ms. Thorpe for violating the USPTO Rules of Professional Conduct.

During Ms. Thorpe's representation of a client in connection with a patent application she violated 37 C.F.R. § 11.104(b) (failing to explain a matter to the extent reasonably necessary to permit the client to make informed decisions regarding the representation). Ms. Thorpe represented a client in the preparation of a nonprovisional patent application. Ms. Thorpe failed to adequately inform the client that she believed he had changed the scope of his invention such that additional fees would be required to be paid in advance in order for the representation to continue. After the representation began, neither Ms. Thorpe nor the patent agent working with her made clear to the client that they would only prepare a nonprovisional patent application that included the improvements that the client had made to his invention if he paid an additional fee. The client terminated the representation and sought the return of all of his legal fees including the \$400 he believed were USPTO filing fees, but Respondent did not refund any fees.

Ms. Thorpe will refund \$400 to the client and shall attend a Continuing Legal Education seminar on law practice management.

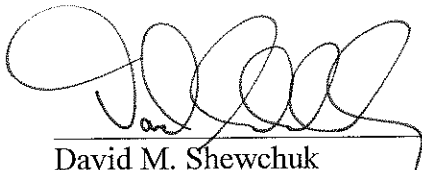
In mitigation, the OED Director considered the fact that Ms. Thorpe has no prior disciplinary history with the Office.

This action is the result of a settlement agreement between Ms. Thorpe and the OED Director pursuant to the provisions of 35 U.S.C. § 2(b)(2)(D) and 37 C.F.R. §§ 11.19, 11.20, and 11.26.

Disciplinary decisions involving practitioners are posted for public reading at the OED Reading Room, available at:

<http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>;

- f. Nothing in this Agreement or the 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 (3) in connection with any request for reinstatement submitted by Respondent pursuant to 37 C.F.R. § 11.60;
- g. Respondent waives all rights to seek reconsideration of the Final Order under 37 C.F.R. § 11.56, waives the right to have the Final Order reviewed under 37 C.F.R. § 11.57, and waives the right otherwise to appeal or challenge the Final Order in any manner; and
- h. The OED Director and Respondent shall each bear their own costs incurred to date and in carrying out the terms of this Agreement and any Final Order.



David M. Shewchuk
Deputy General Counsel for General Law
United States Patent and Trademark Office

7 Sept 2016

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
United States Patent and Trademark Office

Charlena L. Thorpe
Law Offices of Charlena Thorpe
2180 Satellite Blvd.
Duluth, GA 30097

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David M. Shewchuk /
Deputy General Counsel for General Law
United States Patent and Trademark Office

7 Sept 2016

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on behalf of

Michelle K. Lee
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office