

FEDERAL MINE SAFETY AND HEALTH REVIEW COMMISSION

OFFICE OF THE CHIEF ADMINISTRATIVE LAW JUDGE
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January 27, 2023

In the Matter of

Thomas Tracy Aquilla,

Proceeding No. D2022-27

Respondent.

INITIAL DECISION OF HEARING OFFICER

The Complaint in this matter was sent to Respondent, Tracy Aquilla, on October 14, 2022. It was referred to me for a formal disciplinary hearing on October 24, 2022. Respondent is charged under Count I—Representation of Res-Q-Jack, Inc.—with violating seven provisions of the United States Patent and Trademark Office (“USPTO”) Rules of Professional Conduct (“Rules”). *See* Compl. & Notice of Proc. Under 35 U.S.C. § 32, at 3, 8–10 (Oct. 14, 2022).

The USPTO Office of Enrollment Discipline (“OED”) alleged:

1. That Respondent failed to abide by a client’s decisions concerning representation objectives;
2. that he failed to act with reasonable diligence and promptness in representing his client;
3. that he failed to keep the client reasonably informed about the status of the matter;
4. that he failed to hold client property in connection with his representation separate from his own property;
5. that he failed to deposit into a client trust account legal fees and expenses paid in advance;
6. that he failed to promptly deliver to his client funds or other property it was entitled to receive; and
7. that he failed to take reasonably practicable steps upon termination of representation to protect a client’s interests. Compl. ¶¶ 57(a)–(g).¹

Respondent admitted to all allegations. Resp’t’s Answer to Compl. Under 35 U.S.C. § 32 (Nov. 11, 2022) (“Respondent hereby admits to COUNT I and paragraphs 1-57 of the Complaint.”). I subsequently ordered the parties to submit information in support of the relief requested or any mitigating facts that should be considered. Order to Provide Proposed Findings and Conclusions, at 1 (Dec. 1, 2022). OED submitted its brief requesting a two-year suspension, probation, and restitution, and providing support for its assessment that Respondent’s

¹ *See* 37 C.F.R. § 11.102(a), 103, 104(a)(3), 115(a), 115(c), 115(d), 116(d) (2023).

misconduct was aggravated. *See* OED Director’s Sanction Br. 12–16 (Dec. 30, 2022) (“Br.”). Respondent did not submit the directed brief to provide any mitigating facts. However, USPTO’s brief noted one significant mitigating factor. *See id.* at 14.

For the reasons below, I impose the requested sanctions against Respondent.

I. FINDINGS OF FACT

Respondent is a patent attorney registered to practice before the USPTO. His registration number is 43,473. Compl. ¶ 5. Respondent was registered by the USPTO as a patent agent in 1999 and was admitted to practice law in the states of New York and New Hampshire in 2000 and 2008, respectively. *Id.* ¶¶ 5, 6, 8. After his admission to the bar of New York, Respondent’s registration status before the USPTO changed from patent agent to patent attorney. *Id.*, ¶ 7.

Respondent began representing Res-Q-Jack in 2001, and he filed patent applications for Patent Nos. 7,338,025 (“025 patent”), 7,296,776 (“776 patent”), and 8,033,527 (“527 patent”), on March 4, 2008, November 20, 2017, and October 11, 2011, respectively. *Id.* ¶¶ 12–15. Maintenance fees are due three-and-a-half, seven-and-a-half, and eleven-and-a-half years after patent grant. *Id.* ¶ 16.

Respondent invoiced Res-Q-Jack \$2,200.00 for the 025 patent maintenance and legal fees in May 2015 and upon receipt, he deposited the sum into an operating account that contained his own funds. Compl. ¶¶ 17–21. He did not remit the maintenance fees to USPTO, and the patent expired on April 4, 2016. *Id.* ¶¶ 21–23. Respondent did the same for the 776 and 527 patents, depositing a total of \$5,990 in funds received from his client into his operating account. He did not forward the funds due to the USPTO, and the 776 and 527 patents also expired due to nonpayment of maintenance fees on December 21, 2015, and November 16, 2015, respectively. *Id.* ¶¶ 24–37.²

Respondent similarly invoiced Res-Q-Jack \$1,140.00 in maintenance, legal, and bank fees for a Canadian Patent—No. 2,206,905 (“905 patent”)—in May 2015 and again placed the received funds in an account containing his own funds. Compl. ¶¶ 39–44. He did not remit the funds to the Canadian Intellectual Property Office (“CIPO”), and the 905 patent expired on May 24, 2016. *Id.* ¶¶ 46–47.

A Res-Q-Jack employee emailed Respondent to check on the status of the patents and maintenance fees on March 1, 2017. Compl. ¶ 48. Respondent responded to the email on June 16, 2017, informing the employee he would review and report back. *Id.* ¶ 49. He did not further respond and stopped communicating with his client altogether. *Id.* ¶¶ 50–52. He did not inform Res-Q-Jack that he did not remit maintenance fee payments for any of the four patents, that the patents would expire, or that they would need to be reinstated and what actions were necessary to ensure its interests in the patents were protected. *Id.* ¶¶ 53–55. Respondent did not refund any of the received funds. *Id.* ¶ 56.

² Res-Q-Jack retained new counsel in 2021 and was granted reinstatement of the 527 patent by paying the consolidated unpaid maintenance fees. Compl. ¶ 38.

II. DISPOSITION

Practitioners registered to practice before the USPTO in patent matters are “subject to the disciplinary jurisdiction of the Office.” 37 C.F.R. § 11.19(a) (2023); *see also* 37 C.F.R. § 11.1 (“Office means the [USPTO].”). Violation of any Rule of Professional Conduct is grounds for discipline. § 11.19(b)(1)(iv).

A. Rules Violated

Regarding the scope of representation, “a practitioner shall abide by a client’s decisions concerning the objectives of representation and, as required by § 11.104, shall consult with the client as to the means by which they are to be pursued.” 37 C.F.R. § 11.102(a). Section 104 requires that a practitioner shall:

(1) Promptly inform the client of any decision or circumstance with respect to which the client’s informed consent is required by the [Rules]; (2) Reasonably consult with the client about the means by which the client’s objectives are to be accomplished; (3) *Keep the client reasonably informed about the status of the matter*; (4) Promptly comply with reasonable requests for information from the client; and (5) Consult with the client about any relevant limitation on the practitioner’s conduct when the practitioner knows that the client expects assistance not permitted by the [Rules] or other law.

Id. § 11.104(a) (emphasis added). It further requires a practitioner to “explain a matter to the extent reasonably necessary to permit the client to make informed decisions regarding the representation. *Id.* § 11.104(b). The Rules also require a practitioner to “act with reasonable diligence and promptness in representing a client.” *Id.* § 11.103.

The Rules specify requirements for safekeeping client property. A practitioner must hold client property in its possession in connection with the representation “separate from the practitioner’s own property,” and funds held for the client or third persons must be kept in an account separate from the practitioner’s own property. 37 C.F.R. § 11.115(a). A practitioner must also deposit legal fees and expenses paid in advance into a client trust account, only to be withdrawn as fees are earned or expenses are incurred. *Id.* § 11.115(c). Further, a practitioner must “promptly deliver to the client or third person any funds or other property that the client or third person is entitled to receive.” *Id.* § 11.115(d).

Regarding the termination of representation, a practitioner “shall take steps to the extent reasonably practicable to protect a client’s interests.” 37 C.F.R. § 11.116(d). This can include providing notice, allowing time for obtaining other counsel, surrendering property to which the client is entitled, and refunding advanced fees or expenses not earned or incurred. *Id.*

Respondent admitted to the violation of all seven provisions alleged.

1. Respondent violated Section 11.102(a) by failing to abide by Res-Q-Jack's decisions to maintain its patents.

Practitioners violate Section 102(a) when they fail to submit filing fees remitted by clients and do not communicate with clients while knowing or having reason to know that patent applications have been abandoned. *In re Gibson*, Proc. No. D2020-24, at 2–3, 6 (USPTO May 18, 2020).

Res-Q-Jack entrusted responsibility to Respondent to file the applications for and to pay the fees and take the steps necessary to maintain patents 025, 776, 527, and 905 with the respective U.S. and Canadian patent and intellectual property offices. Respondent invoiced Res-Q-Jack for the required funds plus his legal fees for conducting the business. He did not remit the funds received to the appropriate offices. Each patent thereafter expired. Respondent therefore failed to maintain the patents in violation of his agreed-upon representation.

2. Respondent violated Section 11.103 by failing to act diligently and promptly to pay the required maintenance fees.

Respondent acted neither diligently nor promptly. Regarding promptness, Respondent failed to remit the funds prior to the deadlines for maintaining the patents. He further stopped responding to Res-Q-Jack's request regarding the status of its patents.

Diligence is defined as “[c]onstant application to one’s business or duty; persevering effort to accomplish something undertaken,” or “[t]he attention and care required from a person in a given situation.” *Diligence*, BLACK’S LAW DICTIONARY (10th ed. 2014). The language of the Rule mirrors that of the ABA’s Model Rules of Professional Conduct. Both rules direct that a diligent lawyer “pursue a matter on behalf of a client despite . . . personal inconvenience,” and “act with commitment and dedication to the interests of the client.” MODEL RULES OF PROFESSIONAL CONDUCT r. 1.3 cmt.1 (AM. BAR ASS’N 2018) (“MRPC”). Rule 1.3 also cross-references the definition of “Reasonable” as denoting “the conduct of a reasonably prudent and competent attorney.” MRPC r. 1.0(h).

Respondent did not provide the required care, commitment, or dedication to Res-Q-Jack’s interests in maintaining its patents for which it employed Respondent and provided the required fees. This is not the conduct of a reasonably prudent or competent practitioner before the USPTO. *See In re Virga*, Proc. No. D2017-14, at 3–4 (USPTO Mar. 16, 2017) (admitting that he did not act with reasonable diligence when he failed to take action or communicate with his client where the applications would expire). Any personal inconvenience is not a defense to violation, but it may be considered in determining the appropriate sanctions. *See* Section II.B.4., *infra*.

3. Respondent violated Section 11.104(a) by failing to reasonably inform Res-Q-Jack about the expiration of its patents.

Practitioners violate Section 104(a)(3) when they fail to communicate with clients about the status of matters affected by misconduct. *See In re Pasquine*, Proc. No. D2019-39, at 13–15 (USPTO Mar. 28, 2022).

Respondent was required to keep Res-Q-Jack reasonably informed about the status of its patents. He failed to inform it that he did not remit the required maintenance fees or that the patents had expired because he had failed to remit those fees. He compounded these failures by not informing his client of steps necessary for reinstatement of its expired patents. Finally, he failed to inform it of the termination of his representation when he neglected to respond to Res-Q-Jack’s status inquiry.

4. Respondent violated Section 11.115(a) and 11.115(c) by failing to hold Res-Q-Jack’s funds in a client trust account separate from his own funds.

Respondent was required to keep the maintenance fees and legal fees paid in advance by Res-Q-Jack in an account that did not contain his own funds. *See In re Kroll*, Proc. No. D2019-15, at 33, 35 (USPTO Apr. 5, 2021) (admitting that client funds were deposited into a bank account belonging to his wife). He was explicitly required to deposit his client’s funds in a client trust account. *See In re Larson*, Proc. No. D2016-36, at 2 (USPTO Sept. 1, 2016) (suspending practitioner for failure to keep client funds separate from his own funds). Respondent deposited the provided funds into an operating account that contained his own funds.

5. Respondent violated Section 11.115(d) by failing to remit Res-Q-Jack’s provided maintenance fees to the USPTO and CIPO and by retaining in his own account legal fees he had not earned.

Practitioners violate Section 115(d) when they fail to pay USPTO filing fees collected from clients. *In re Hamill*, Proc. No. D2019-16, at 14, 21 (USPTO Nov. 4, 2019). Rule 11.115(d) also “corresponds to ABA Model Rule 1.15[(d)].” *Changes to Representation of Others Before the United States Patent and Trademark Office*, 78 Fed. Reg. 20,180, 20,183 (Apr. 3, 2013).

The Model Rules require a lawyer who receives funds in which a third party has an interest to “deliver the funds or property to the . . . third party *when due*.” MRPC r. 1.15, Requirement of Prompt Notification and Delivery (emphasis added); *see In re Nave*, 280 A.3d 86 (D.C. 2018) (failing to promptly disburse settlement funds to client’s medical providers). The USPTO rule is substantially identical to the Model Rule.

Respondent invoiced Res-Q-Jack for maintenance, legal, and bank fees for all four of its patents. The USPTO and CIPO are third parties that were entitled to receive those funds. Respondent did not deliver any of the funds received to the appropriate offices.

The USPTO's own rules, like the MRPC, further provide that "A practitioner shall deposit into a client trust account legal fees and expenses that have been paid in advance *to be withdrawn by the practitioner only as fees are earned or expenses incurred.*" 37 C.F.R. § 11.115(c) (emphasis added).

Respondent has admitted that he did not fulfill his commitment to promptly file the fees with the respective U.S. and Canadian authorities. Because he did not take the actions necessary for the intended representation, his attorney fees, too, were improperly maintained in Respondent's operating account.

6. Respondent violated Section 11.116(d) by failing to notify Res-Q-Jack of the termination of representation or take steps to protect its patent interests.

Practitioners violate Section 116(d) when they terminate representation without providing an accounting or renewal and legal fees, without returning legal fees unearned or renewal fees unpaid, or without cooperating with new counsel in reviving patent applications. *See In re Ries*, Proc. No. D2018-49, at 20 (USPTO Dec. 19, 2018).

Respondent provided no notice for the termination of representation, which he effectively abandoned by not upholding his commitment or continuing to communicate with his client about the matters entrusted to him. This prevented Res-Q-Jack from promptly obtaining new counsel to protect the interests previously entrusted to Respondent.

Further, he provided no instruction on steps needed for reinstatement of the patents he knew to have expired. Finally, he did not refund Res-Q-Jack for the fees paid in advance to maintain its patents.

B. Sanctions

Upon a finding of grounds for discipline, a respondent may be excluded from practice before the USPTO, suspended for an appropriate period, reprimanded or censured, or placed on probation. 37 C.F.R. § 11.20(a). Reinstatement may be conditioned on restitution, successful completion of professional responsibility training, or other measure found appropriate. *Id.* § 11.20(b). The procedural rules provide four factors for a judge to consider in the required explanation for sanctions, stating:

In determining any sanction, the following four factors shall be considered if they are applicable: (1) Whether the practitioner has violated a duty owed to a client, the public, the legal system, or the profession; (2) Whether the practitioner acted intentionally, knowingly, or negligently; (3) The amount of the actual or potential injury caused by the practitioner's misconduct; and (4) The existence of any aggravating or mitigating factors.

37 C.F.R. § 11.54(b).

A practitioner before the USPTO owes a fiduciary duty to his clients. *Moatz v. Bender*, Proc. No. D2000-01, at 20 (USPTO Sept. 30, 2003). He violates that duty by failing to submit filing fees for a client's patent application. *In re Martinez*, Proc. No. D2019-37 (USPTO Feb. 15, 2022).

A practitioner also owes a duty to the public to comply with the Rules, as sworn or affirmed to practice before the USPTO. *In re Chirnomas*, Proc. No. D2020-29, at 10 (USPTO Apr. 29, 2021). Finally, a practitioner owes a duty to the legal profession—specifically, the patent bar—by breaching the public's confidence. *In re Burmeister*, Proc. No. D1999-10, at 12 (USPTO Mar. 16, 2004).

Regarding a practitioner's mental state, "intentional" is defined as "act[ing] with conscious objective or purpose to accomplish a particular result." ANNOTATED STANDARDS FOR IMPOSING LAWYER SANCTIONS § 3.0, Mental State (AM. BAR ASS'N 2d ed. 2019) ("STANDARDS"). "Knowing" is defined as "act[ing] with conscious awareness of the nature or attendant circumstances of his or her conduct both without the conscious objective or purpose to accomplish a particular result." *Id.*

A practitioner acts intentionally by failing to tell a client about important USPTO communications or neglecting the duty to submit filing fees despite knowledge of the requirement. *See In re Shippey*, Proc. No. D2011-27, at 11 (USPTO Oct. 14, 2011); *In re Myers*, Proc. No. D2015-33, at 8 (USPTO Dec. 31, 2015).

OED cites four aggravating factors. It also acknowledged one mitigating factor. Br. 12–14.

The aggravating factors cited by OED include: (1) First, whether a practitioner acted with a "dishonest or selfish motive." STANDARDS § 9.22(b); (2) whether a practitioner engaged in multiple offenses. STANDARDS § 9.22(d); *In re Flindt*, Proc. No. D2016-04, at 56 (USPTO Aug. 4, 2017); (3) whether a practitioner has "substantial experience in the practice of law" (grounded on the understanding that more experience imposes a greater expectation of performance). STANDARDS § 9.22(i); *see In re Anderson*, Proc. No. D2019-03, at 18–19 (USPTO July 1, 2019); (4) whether a practitioner is "indifferen[t] to making restitution." STANDARDS § 9.22(j); *see In re Augenstein*, 871 P.2d 254, 258 (Ariz. 1994).

OED's thorough investigation also discovered one mitigating factor not raised by Respondent. OED's Brief states that Respondent suffered personal or emotional problems, recognized as a mitigating factor by section 9.32(c) of the STANDARDS. Br. 14. Respondent's wife, his sole legal support staff, died as a result of cancer in October 2015; his mother had also passed away six days prior. *Id.*

1. Respondent violated his duty to Res-Q-Jack, the public, and the legal system and profession.

Res-Q-Jack paid Respondent's invoices with the expectation that he would remit the required funds to the appropriate offices to maintain its patents. Respondent deposited the funds in an account with his personal funds and never remitted the fees to the patent offices. The patents expired in contraventions of Res-Q-Jack's intent and efforts. It even attempted to check on the status of the patents with Respondent, but he stopped communicating with his client. Respondent therefore violated his fiduciary duty to his client.

Respondent violated seven Rules. As part of those violations, he failed to maintain a client's interests and received payment for services not performed. He therefore violated his duty to the public and the legal profession by degrading the public's confidence in the integrity of those practicing before the USPTO.

2. Respondent acted intentionally.

Respondent did not submit maintenance fees for his client's patents despite knowing of the requirement to do so—as evidenced by the fact that he invoiced them as the deadline approached. Such action is sufficient to find that Respondent acted intentionally in the admitted violations. Respondent also failed to tell Res-Q-Jack about the expiration of its patents, and when it requested a status update, he did not tell his client that he had not paid the maintenance fees or that Res-Q-Jack's patents had expired. Instead, he ceased communicating with his client.

3. Respondent caused actual injury through his misconduct.

Res-Q-Jack paid Respondent a total of \$8,840.00, which included the maintenance fees for its four patents, legal fees for Respondent's services in support of maintaining the patents, and the reinstatement fees and associated legal fees for the 527 patent. The funds paid to Respondent were not transmitted to the U.S. and Canadian authorities, and Res-Q-Jack's patents expired, even if it was able to later reinstate the 527 patent, which itself required additional fees. Res-Q-Jack therefore suffered monetary damages and loss of its patents. This is sufficient to support a finding of an actual injury.

4. Respondent's misconduct was aggravated, though mitigating factors were also present.

Respondent's circumstances are tragic, and he deserves to be treated with compassion. But the aggravating circumstances and actual harm to his clients are his responsibility and, in this case, outweigh his personal troubles.

The violations occurred in May 2015. Compl. ¶¶ 17, 24, 31, 41. This was five months before his mother's and wife's deaths, and he was presumably dealing with his wife's cancer treatment during that time. He did, however, acknowledge his duty, invoice his client for the funds, and choose not to pay the required fees—keeping the funds in his own account. He also failed to honestly account to his client for his mismanagement of its affairs. Instead, he did

nothing to remedy his failure for nearly two years. When his client contacted him in March of 2017, he essentially ignored its request for an update.

Respondent does lack a prior disciplinary record—at least, one has not been presented by OED. STANDARDS § 9.32(a). Such has been afforded little weight by courts, particularly where respondents have engaged in the same injurious activities. *See Chirnomas*, D2020-29 at 12; *In re Hamill*, Proc. No. 2019-16, at 21 (USPTO Nov. 4, 2019). I agree that Respondent’s disciplinary history adds little, as OED has already appropriately considered Respondent’s personal problems in its sanctions request.

a. Respondent acted with a dishonest and selfish motive by keeping his client’s money.

Courts have found dishonest and selfish motive where a lawyer personally or financially benefitted from misconduct. STANDARDS § 9.22, Dishonest or Selfish Motive; *see People v. Braham*, 409 P.3d 655, 663 (Colo. O.P.D.J., 2017) (ordering disbarment where lawyer retained client funds he did not earn); *Off. of Disciplinary Couns. v. Au*, 113 P.3d 788 (Colo. O.P.D.J. 2005) (finding aggravated conduct where lawyer deposited unearned fees in his office account). It is also a violation to receive funds from clients under the assumption of paying a third party and failing to do so. STANDARDS § 9.22, Dishonest or Selfish Motive; *see In re Shores*, 279 P.3d 710 (Kan. 2012) (ordering disbarment where lawyer received funds, in a check to himself, on the fraudulent promise he would pay the state in reimbursement of client’s Medicaid fraud).

It is possible that Respondent’s initial motivation was not selfish, but that he was simply overwhelmed by the loss of his wife (who managed his office) and mother. But he has not denied, and the record makes clear, that he concealed his misconduct from his client, and never sought to make restitution of the funds he wrongfully retained.

Taken together, the facts demonstrate that Respondent intended to keep Res-Q-Jack’s money for services he did not intend to perform, as well as the funds intended for patent maintenance. Respondent knew of the maintenance fee requirement and timely invoiced his client for the proper amounts, plus his legal fees. He deposited those funds in an account that contained his personal funds, in violation of the Rules. He then failed to remit the funds as required, and he later terminated his representation upon inquiry about the patents’ statuses.

b. Respondent engaged in multiple offenses, having admitted to seven violations of the Rules.

Multiple offenses in a single disciplinary proceeding may be an aggravating factor. STANDARDS § 9.22, Multiple Offenses (citing *Ala. State Bar v. Hallett*, 26 So. 3d 1127 (Ala. 2009)); *see In re McNeely*, 98 So. 3d 275 (La. 2012) (finding aggravating circumstances where lawyer committed multiple counts of neglect, failure to communicate, and failure to return unearned fees).³

³ Some courts have declined to apply this aggravating factor where only one event or offense violates multiple rules. Standards § 9.22, Multiple Offenses; *see People v. Kanwal*, 357 P.3d 1236, 1243 (Colo. O.P.D.J. 2015) (noting that lawyer did not engage in “more than two distinct

Respondent admitted to seven violations of the Rules in conjunction with this dishonest behavior. *See* Section II.A., *supra*. Such an amount has been found sufficient for aggravated conduct. I find that the misconduct here is properly designated as aggravating as multiple offenses because it resulted in both monetary and patent-ownership injury to Res-Q-Jack. Additionally, there are distinct offenses. In addition to three separate instances of improper management of his client's funds and failure to attend to his client's business, Respondent transgressed again in 2017 when he failed to disclose or remedy his misconduct when his client inquired about it.

c. Respondent had substantial experience with the law at the time of the offenses.

Substantial experience is an aggravating factor because an experienced lawyer “should know better than to engage in misconduct. STANDARDS § 9.22, Substantial Experience in the Practice of Law; *see In re Disciplinary Procs. Against Theobald*, 786 N.W.2d 834 (Wis. 2010) (finding sufficient experience where a lawyer with 14 years of experience failed to act with reasonable diligence and promptness in representing her bankruptcy client and failed to communicate with client after dismissal).

Respondent had been practicing before the USPTO for approximately 16 years before engaging in these violations. More than nine years of experience has been found sufficient for an aggravating factor. *In re Anderson*, D2019-03 at 18–19. He was aware of his fee payment responsibilities, and his duties to communicate with his client and hold its funds separately. Respondent therefore had sufficient experience to know that his actions, and inaction, violated multiple Rules.

d. Respondent was indifferent to making restitution because he failed to refund Res-Q-Jack the funds it provided.

Indifference to making restitution can be overt or implicit. STANDARDS § 9.22, Indifference to Making Restitution. Such indifference is implied where a lawyer acknowledges the amount of damages incurred but makes no offer to reimburse prior to hearing. *Id.*; *see In re Barker*, 321 P.3d 767 (Kan. 2014).

This Court has already acknowledged that Respondent acted dishonestly, intending to keep Res-Q-Jack's provided funds. He maintained these funds in a personal account and did not inform his client about the patent statuses for nearly two years. *See* Section II.A., *supra*. Upon request from his client, he severed communication and did not refund to them the maintenance fees not remitted or the legal fees for services not performed.

types of misconduct”); *In re Disciplinary Proc. Against Longacre*, 122 P.3d 710, 726 (Wash. 2005) (holding that commonly charging multiple counts because discrete behaviors often violate more than one rule does not constitute multiple offenses).

III. ORDER

OED has provided sufficient authority demonstrating the appropriateness of the requested sanction. *See* Br. 14–16. This Court agrees with the comparisons to previous violations and their sanctions, and it believes that OED has properly considered the proposed sanctions’ appropriateness for Respondent. *See Chirnomas*, D2020-29 at 14; *Hamill*, D2019-16 at 22; *In re Stecewycz*, Proc. No. D2015-09, at 19 (USPTO Dec. 16, 2015) (excluding respondent from practice for failure to communicate and separate funds); *see also In re Walker*, Proc. No. D2018-04, at 9–10 (USPTO Mar. 23, 2018); *In re Montgomery*, Proc. No. D2018-02, at 10 (USPTO Jan. 10, 2018) (ordering four-year suspensions for similar behavior). Regarding restitution specifically, this Court notes that the requested restitution includes funds never applied to its patents’ maintenance fees and the cost of reinstating the 527 patent.

I do believe that it is appropriate that justice be tempered with mercy in this case. The tragedies that befell respondent in 2015 present a compelling mitigating factor. In addition to the grief that must naturally have attended the loss of his wife and mother in quick succession, it is reasonable to infer that his wife’s terminal cancer prevented her from properly managing Respondent’s business affairs. However, I believe that OED has taken that into account in its recommendation. These offenses are serious, and strike at the very heart of the trust and integrity that legal professionals must strive to uphold.

In light of that, the sanctions imposed could be more severe. *See Chirnomas*, D2020-29 at 7-8, 14 (recognizing that substantially similar facts led to exclusion from practice, where only mitigating factor was lack of prior disciplinary record).⁴ I therefore find that OED has properly balanced the interests of justice, the integrity of the legal profession, and Respondent’s potential for rehabilitation.

Respondent is hereby SUSPENDED from practice before the USPTO for two years.

Respondent will be placed on PROBATION for two years upon reinstatement.

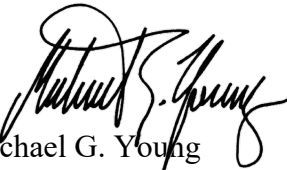
Before being reinstated to practice before the Office, Respondent will demonstrate that he has paid restitution to Res-Q-Jack, Inc. in the amount of \$8,840.00.

The OED Director shall GIVE NOTICE pursuant to 37 C.F.R. § 11.59 of the public discipline and the reasons for the discipline to disciplinary enforcement agencies in the state(s)

⁴ I note that unlike Mr. Chirnomas, Respondent in this case did not fail to cooperate in the proceedings but admitted his wrongdoing.

where Respondent is admitted to practice, to courts where Respondent is known to be admitted, and to the public.

So **ORDERED**,


Michael G. Young
Administrative Law Judge⁵

Notice of Appeal Rights: Within thirty (30) days of this initial decision, either party may appeal to the USPTO Director. 37 C.F.R. § 11.55(a).

Distribution:

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⁵ The Federal Mine Safety and Health Review Commission, pursuant to an Interagency Agreement with U.S. Patent and Trademark Office, is providing administrative law judge services to the extent required under the regulations in connection with this matter.