

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

In the Matter of

William L. Oen,

Respondent

)
)
)
)
)

Proceeding No. D08-05

FINAL ORDER

Director of the Office of Enrollment and Discipline Harry I. Moatz ("OED Director") and William L. Oen ("Respondent") have submitted a settlement agreement to the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office or his designate ("USPTO Director").

The OED Director and Respondent's settlement agreement sets forth certain stipulated facts, legal conclusions, and sanctions to which the OED Director and Respondent have agreed in order to resolve voluntarily this disciplinary proceeding and obviate an administrative hearing. The settlement agreement, which satisfies the requirements of 37 C.F.R. § 10.133(g), resolves all disciplinary action by the United States Patent and Trademark Office ("USPTO") arising from the evidence previously submitted to the USPTO's Committee on Discipline in connection with this disciplinary proceeding.

Pursuant to such settlement agreement, this Final Order sets forth the parties' stipulated facts, joint legal conclusions, and agreed upon sanctions.

Stipulated Facts

1. At all times relevant hereto, William L. Oen of Potomac, Maryland, has been an agent registered to practice patent law before the USPTO (Registration Number 34,492) and is subject to the USPTO Disciplinary Rules set forth at 37 C.F.R. § 10.20 et seq.
2. Respondent had been employed at the USPTO for over seventeen (17) years as of January 6, 2006.
3. While employed at the USPTO, Respondent was required to be placed, and was so placed, in an administrative "inactive" status on the USPTO's roster of registered practitioners.
4. Removal from Federal Service
 - a. On or about August 17, 2005, the USPTO proposed that Respondent be removed from his GS-14 Primary Patent Examiner position and from federal service based on his receipt of approximately \$32,000 in pay for 650 hours in time that he allegedly did not work.

- b. Respondent submitted verbal and written replies to the proposed removal that he believed supported his position that he did not engage in misconduct warranting his removal from his USPTO position or from federal service.
- c. On January 5, 2006, after considering Respondent's written and verbal replies to the proposed removal, Deputy Commissioner for Patent Operations Margaret A. Focarino decided to remove Respondent from his Primary Patent Examiner position and from federal service based on the charged offense.
- d. At the time of his removal, Respondent had no prior disciplinary record with the USPTO.
- e. Respondent appealed Deputy Commissioner Focarino's January 5, 2006, decision via arbitration with the consent of the Patent Office Professional Association.
- f. On May 7, 2007, Arbitrator Laurence M. Evans denied Respondent's request for relief finding that the USPTO had just and sufficient cause to remove Respondent for the charged offense.

5. Request to Move to Active Status on USPTO's Roster of Registered Practitioners

- a. USPTO Form PTO-158, "Application for Registration to Practice Before the United States Patent and Trademark Office," in part, states:

BACKGROUND INFORMATION: Candor and truthfulness are significant elements of fitness relevant to practice before the United States Patent and Trademark Office. You should, therefore, provide the Office of Enrollment and Discipline with all available information, however unfavorable, even if its relevance is in doubt, with regard to the questions asked below. For each question answered "YES," provide a detailed statement setting forth all relevant facts and dates along with verified copies of relevant documents. **Your responses must be updated as necessary, prior to your registration.** Any documents, evidence or proofs previously filed in a prior application need not be resubmitted unless your response to a question must be changed. **Failure to disclose the requested information may result in denial of registration or in disciplinary proceedings under 37 C.F.R. § 10.22 should you become registered.**

(Emphasis in original)

- b. Form PTO-158 also contains the following certification above the applicant's signature line:

Upon the basis of the foregoing information and any attached documents, I hereby apply for registration in patent cases before the United States Patent and Trademark Office. I certify that each and every statement or representation

in this application is true and correct. *(A willfully false statement or certification is a criminal offense and is punishable by law [18 U.S.C. § 1001].)*

(Emphasis in original)

- c. Registered practitioners who are in an inactive status are not permitted to represent others in patent matters before the USPTO.
- d. Registered practitioners who are in an inactive status must return to “active” status in order to be permitted to represent others in patent matters before the USPTO.
- e. In order to switch from inactive to active status, a registered practitioner is to complete USPTO Form PTO-158, sign it, and submit it to the Office of Enrollment and Discipline (OED).
- f. After learning of the January 5, 2006, decision removing him from federal service, Respondent completed Form PTO-158, signed it on January 5, 2006, and submitted it to OED with the goal of being switched from inactive to active status on USPTO’s roster of registered practitioners so that he would be permitted to represent persons in patent matters before the USPTO.
- g. While completing Form PTO-158, Respondent wrote “unemployed” in the box bearing the heading, “Employer, corporation, law firm, U.S. Government Agency. If using home address, leave blank. Indicate if Student or unemployed.”
- h. While completing Form PTO-158, Respondent indicated “No” when answering each of the following questions:
 - 18. Have you ever been disciplined, reprimanded, or suspended in any job for conduct involving dishonesty, fraud, misrepresentation, deceit, or any violation of Federal or State laws or regulations?
 - 19. Have you ever been fired or discharged from any job, or have been asked to resign or quit for conduct involving dishonesty, fraud, misrepresentation, deceit, or any violation of Federal or State laws or regulations?
 - 20. Have you ever resigned or quit a job when you were under investigation or inquiry for conduct which could have been considered as involving dishonesty, fraud, misrepresentation, deceit, or any violation of Federal or State laws or regulations, or after receiving notice or been advised of possible investigation, inquiry, or disciplinary action for such conduct?
- i. OED received Respondent’s signed Form PTO-158 on January 6, 2006.
- j. At the time Respondent signed Form PTO-158 and submitted it to OED, Respondent knew that he had been removed from his Primary Patent Examiner

position and federal service for conduct involving dishonesty, fraud, misrepresentation, deceit, or any violation of Federal or State laws or regulations.

- k. At the time Respondent signed Form PTO-158 and submitted it to OED, Respondent failed to disclose on Form PTO-158 that he had been removed from his Primary Patent Examiner position and federal service for conduct involving dishonesty, fraud, misrepresentation, deceit, or any violation of Federal or State laws or regulations.
- l. Respondent asserts that, when completing, signing, and submitting Form PTO-158, he believed his removal from the USPTO would not be effective or final until the completion of the arbitration process.

6. Following his submission of the signed Form PTO-158, Respondent was not switched from inactive to active status on the USPTO's roster of registered practitioners; he remained in an inactive status.

7. Respondent asserts that he has not practiced before the USPTO as a registered patent agent since being removed from his Primary Patent Examiner position and federal service effective January 6, 2006.

Legal Conclusions

8. Based on the information contained in paragraphs 1 through 7, inclusive, Respondent acknowledges that his conduct violated the following Disciplinary Rules of the USPTO Code of Professional:

- a. 37 C.F.R. §§ 10.23 (a) and (b), as further defined by 37 C.F.R. § 10.23(c)(15), by signing a paper submitted to OED in violation of the provisions of 37 C.F.R. § 10.18;
- b. 37 C.F.R. § 10.23 (b)(4) by engaging in conduct involving dishonesty, fraud, deceit, or misrepresentation;
- c. 37 C.F.R. § 10.23 (b)(5) by engaging in conduct that is prejudicial to the administration of justice; and
- d. 37 C.F.R. § 10.23 (b)(6) by engaging in conduct which adversely reflects on Respondent's fitness to practice before the USPTO.

Sanctions

Based on the foregoing, it is:

9. **ORDERED** that the above stipulated facts and legal conclusions are hereby incorporated by reference.

10. **ORDERED** that Respondent is suspended from practicing patent, trademark, and other non-patent law before the USPTO for three years from the date of this Final Order.

11. **ORDERED** that, subject to the other terms and conditions set forth in this Final Order, after Respondent serves the initial twelve (12) months of his three-year suspension:

- a. the final twenty-four (24) months of Respondent's three-year suspension is immediately stayed; and
- b. Respondent is immediately eligible to request reinstatement to practice before the USPTO as set forth in ¶ 26, below.

12. **ORDERED** that, in the event that the OED Director in his discretion determines that, during the three-year period commencing on the date of this Final Order, 1) Respondent failed to comply with any of the terms of this Final Order and/or 2) Respondent violated any provision of the USPTO Disciplinary Rules, then:

- a. those parts of the settlement agreement and this Final Order entitling Respondent to a twenty-four (24) month stay of his three-year suspension are immediately nullified, and
- b. in the event that any stay of the suspension has, in fact, been accorded to Respondent under the terms of this Final Order, such stay is immediately rescinded and vacated and Respondent is immediately suspended for a period of twenty-four (24) months commencing on the date of the OED Director's determination.

13. **ORDERED** that, prior to OED Director making a determination under paragraph 12, above:

- a. the OED Director shall provide Respondent with an Order to Show Cause why such determination(s) should not be made; and
- b. the Order to Show Cause shall grant Respondent ten (10) days to respond thereto.

14. **ORDERED** that, in the event that Respondent seeks a review under 37 C.F.R. § 11.2(d), or its successor regulation, of the OED Director's determination under paragraph 12, above, any such review shall not operate to postpone or otherwise hold in abeyance i) the immediate voiding of all parts of the settlement agreement and the Final Order entitling Respondent to a stay of his suspension, ii) the immediate rescinding and vacating of any stay of the suspension in fact accorded to Respondent, or iii) the immediate suspension of Respondent for a period of twenty-four (24) months commencing on the date of the OED Director's determination.

15. **ORDERED** that, in the event that Respondent seeks a review under 37 C.F.R. § 11.2(d), or its successor regulation, of the OED Director's determination under paragraph 12, above, the USPTO Director may affirm, reverse or modify the OED Director's determination.

16. **ORDERED** that the OED Director publish this Final Order.

17. **ORDERED** that the OED Director publish the following Notice in the Official Gazette:

Notice of Suspension

William L. Oen (Oen) of Potomac, Maryland, is a patent agent whose registration number is 34,492. The Director of the United States Patent and Trademark Office has ordered Oen be suspended for three years from practice before the United States Patent and Trademark Office in patent, trademark, and non-patent law cases. The last two years of the suspension, however, will be stayed so long as Respondent complies with the terms and conditions of the Final Order. This action is taken pursuant to the provisions of 35 U.S.C. § 32, and 37 C.F.R. §§ 10.133(g) and 10.159.

18. **ORDERED** that, in accordance with 37 C.F.R. § 10.158(b)(1), Respondent, to the extent he is a member of any such bar or has any such clients, shall within 30 days of entry of this Final Order: a) notify in separate written communications all bars of which Respondent is a member and all his clients for whom he is handling matters before the USPTO of the suspension and b) file a copy of each written communication with the OED Director.

19. **ORDERED** that, in accordance with 37 C.F.R. § 10.158(b)(2), Respondent, to the extent he has any such files, shall within 30 days of the date of this Final Order: a) surrender each client's active USPTO case file(s) to each client or to another practitioner designated by each client and b) file proof thereof with the OED Director.

20. **ORDERED** that, in accordance with 37 C.F.R. §§ 10.158(b)(4) and (b)(7), Respondent, to the extent any such expressions or indications exist, shall promptly take any necessary and appropriate steps to remove from any telephone book, legal directory, sign, letterhead, and other media all advertisements, statements, representations, and all other expressions and indications that would reasonably suggest that the practitioner is authorized to practice law before the USPTO, and, within 30 days of taking those steps, shall file with the OED Director an affidavit describing the precise nature of the steps taken.

21. **ORDERED** that, in accordance with 37 C.F.R. §§ 10.158(b)(8) and 10.160(d), Respondent, to the extent he has any such funds, shall within 30 days of the date of this Final Order return to any client having immediate or prospective business before the Office any unearned legal funds, including any unearned retainer fee, and any securities and property of

the client, and shall file a proof thereof with the OED Director no later than filing his petition for reinstatement.

22. **ORDERED** that, in accordance with 37 C.F.R. §§ 10.158(a) and (b), Respondent, during the period of any suspension directed by this Final Order, shall: a) not engage in unauthorized practice of patent, trademark and other non-patent law before the USPTO; b) not hold himself out as authorized to practice before the USPTO; c) not advertise his availability or ability to perform or render legal services for any person having immediate, prospective, or pending business before the USPTO; and d) not render legal advice or services to any person having immediate, prospective, or pending business before the USPTO as to that business.

23. **ORDERED** that, in accordance with 37 C.F.R. §§ 10.158(a), (b)(2), and (b)(6), Respondent, during the period of any suspension directed by this Final Order, shall: a) suspend all communication relating to a client matter, b) immediately forward to the client or the practitioner designated by the client all communication relating to a client matter that is addressed to, or received by, Respondent, and c) take no legal action, enter any appearance, or provide any legal advice concerning any matter that is the subject of the client communication.

24. **ORDERED** that, in the event that Respondent acts as a paralegal or aids or endeavors to aid another practitioner in any way in the other practitioner's practice of law before the USPTO during the period of any suspension directed by this Final Order, Respondent shall comply with 37 C.F.R. §§ 10.158(c) and (d).

25. **ORDERED** that nothing in the Settlement Agreement or this Final Order shall operate to prevent the USPTO from seeking and imposing discipline against Respondent for the same violation(s) of the USPTO Disciplinary Rules upon which the OED Director's determination set forth in paragraph 12, above, was based.

26. **ORDERED** that, upon completing his three-year suspension or upon completing a shorter period of suspension where a stay of a part of the three-year suspension takes effect under the terms of this Final Order, Respondent may apply for reinstatement to practice before the USPTO by filing a petition for reinstatement and an affidavit showing compliance with the following conditions:

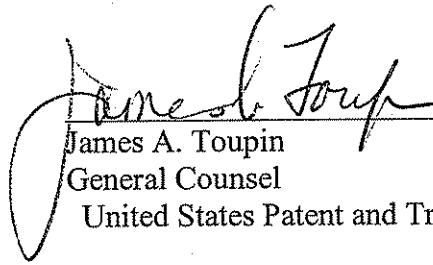
- a. Respondent satisfies the requirements of 37 C.F.R. § 11.8 for being moved from administrative inactive to active status on the USPTO roster of registered practitioners; and
- b. Respondent demonstrates compliance with 37 CFR §§ 10.158 and 10.160.

27. **ORDERED** that the parties shall bear their own costs.

[signature page follows]

April 29, 2007

Date



James A. Toupin

General Counsel

United States Patent and Trademark Office

on behalf of

Jon W. Dudas

Under Secretary of Commerce for Intellectual

Property and Director of the United States

Patent and Trademark Office