

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

In the Matter of	)	
	)	
Eric B. Alspaugh,	)	Proceeding No. D2021-09
	)	
Respondent	)	
_____	)	

**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 Eric B. Alspaugh (“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 hereto, Respondent of Aliso Viejo, California, has been a registered practitioner (Registration Number 54,783) and, thus, 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 32 and 37 C.F.R. §§ 11.19, 11.20, and 11.26.

**Joint Stipulated Facts**

3. On July 2, 2012, Respondent entered into a practitioner-client relationship with Dr. Chris Salvino (“Dr. Salvino”). Dr. Salvino engaged Respondent to provide patent services, including, *inter alia*, drafting, filing, and prosecuting patent applications before the USPTO for his

medical device inventions.

4. On August 19, 2013, Respondent formed Eric B. Alspaugh, APC (“Alspaugh APC”), a California Professional Corporation. Respondent practices before the Office in patent matters and specializes in patent prosecution services.

**a. Non-Rebreather Face Mask, U.S. patent application No. 15/394,704.**

5. On December 29, 2016, Respondent filed U.S. patent application No. 15/394,704 (“the ’704 application”) titled “Non-Rebreather Face Mask” on behalf of Dr. Salvino and his co-inventor Mr. Scott White.

6. On January 18, 2017, the USPTO mailed a Notice to File Missing Parts (“Notice”), which identified several substantive issues in the ’704 application as filed. Respondent did not respond to the Notice, and as a result the application became abandoned.

7. The Notice of Abandonment stated that the abandonment was due to applicant’s failure to timely reply to the “Notice to File Missing Parts (Notice) mailed on 1/18/2017.” Respondent did not inform Dr. Salvino of the September 19, 2017 Notice of Abandonment at any time prior to April 11, 2018. The ’704 application became abandoned without Dr. Salvino’s knowledge or consent. Respondent did not revive the application.

8. It was not until April 11, 2018, that Respondent emailed Dr. Salvino regarding the abandonment explaining that he discovered a docketing error. Respondent informed Dr. Salvino of the ’704 application abandonment and suggested a prosecution strategy going forward. He offered two solutions to move forward with the application: either revive the application and proceed as normal or revive the application for the purpose of filing new subject matter.

9. However, on April 19, 2018, Respondent recommended to Dr. Salvino that instead of reviving the ’704 application, Dr. Salvino should pursue international patent protection for his

“Non-Rebreather Face Mask,” the subject matter of the ’704 application. Dr. Salvino agreed to file the PCT application, which became the [REDACTED] (“[REDACTED] application”).

b. [REDACTED], [REDACTED], International Patent Application No. [REDACTED].

10. Respondent prepared the PCT application for the [REDACTED] International Patent application and filed it on [REDACTED], with the USPTO Receiving Office (“RO”), naming Dr. Salvino as the applicant. Respondent did not file the requisite claims. The PCT referenced Respondent’s file number [REDACTED] and was given International Application Number [REDACTED], the [REDACTED] application.

11. On [REDACTED], the RO mailed an “Invitation to Correct the Purported International Application” (“Invitation to Correct”) in the [REDACTED] application to Respondent. The Invitation to Correct identified that the filing did not fulfill the requirement under PCT Article 11 paragraph (1) because “[t]he application does not contain a part which on the face of it appears to be a claim or claims.” The Invitation to Correct stated that if applicant complied with the invitation on or before [REDACTED], then the applicant would receive an international filing date. Respondent did not inform Dr. Salvino of the Invitation to Correct or of the [REDACTED] response due date. He neither forwarded the Invitation to Correct to Dr. Salvino, nor did he respond to it.

12. On [REDACTED], the RO mailed to Respondent’s business address a “notification that the purported international application is not and will not be treated as an international application,” it was not afforded a filing date and Dr. Salvino had lost rights, because Respondent had not replied to the [REDACTED] Invitation to Correct.

13. Although Respondent had terminated the attorney-client relationship on June 14, 2018, he was responsible to forward all correspondence to Dr. Salvino, including the [REDACTED], notification that the [REDACTED] application would not be treated as an international application.

**c. The New Chest Tube 2.0.**

14. Respondent and Dr. Salvino discussed the preparing and filing of a new medical invention, the New Chest Tube 2.0 patent application.

15. In certain instances, Respondent and Dr. Salvino had previously agreed to a “capped fee” for his preparing and filing patent applications on behalf of Dr. Salvino.

16. For the Chest Tube 2.0, Dr. Salvino believed that he and Respondent agreed upon a \$5,000 capped fee for the preparing of that single patent application.

17. Dr. Salvino emailed Respondent telling him that he was sending a check specifically for the Chest Tube 2.0. Dr. Salvino then tendered a check for the amount of \$5,000 and designated on the front of the check “chest tube.” Respondent received and negotiated the check.

18. Respondent did not apply the \$5,000 to the Chest Tube 2.0, rather he applied the payment to previously performed work for Dr. Salvino.

19. Respondent did not communicate to Dr. Salvino how the \$5,000 paid by Dr. Salvino would be applied to outstanding balances rather than the new patent application, the Chest Tube 2.0.

20. Respondent also did not provide a clear explanation to Dr. Salvino about the material risks of, and reasonably available alternatives to, applying any new payments to outstanding account balances. He also did not communicate the conflict he had by accepting payments for new patent services, when he had a competing interest to take the new payments and apply them to outstanding balances for prior patent services.

**d. Respondent’s post termination handling of USPTO correspondence regarding Dr. Salvino’s Oxygen Biofeedback Application, U.S. Patent Application No. 15/739,968.**

21. On December 26, 2017, Respondent filed U.S. Patent Application No. 15/739,968

(“the ’968 application”) with the USPTO on behalf of Dr. Salvino, which was entitled “Oxygen Biofeedback Device and Methods.”

22. After Respondent had terminated the attorney-client relationship with Dr. Salvino, on June 17, 2018, Respondent filed a request for withdrawal as attorney in the ’968 application believing he previously filed a power of attorney (POA). However, seven months after filing the request to withdraw on January 14, 2019, the USPTO mailed Respondent a letter stating, “the withdrawal cannot be accepted” and the “change of correspondence address will be considered separately” because there was no prior filed POA in the ’968 application. Respondent did not inform Dr. Salvino regarding this communication from the USPTO.

23. On November 29, 2019, Respondent received a non-final rejection of the ’968 application. Respondent did not forward this communication to Dr. Salvino. Once more, the USPTO sent correspondence to Respondent regarding the ’968 application informing him that “new correspondence is available for the ’968 application.” Respondent did not forward this communication from the USPTO to Dr. Salvino or his new counsel.

24. Respondent had a responsibility to forward communications from the USPTO even after the termination of the attorney-client relationship.

**e. European and Brazilian Annuity Fees.**

25. On March 15, 2018, Respondent’s assistant sent an email to Dr. Salvino with the subject line “Upcoming Annuities.” The email included an overview of charges by “the foreign associates and by our firm” for the upcoming annuity fees due totaling \$1,317. Respondent’s assistant urged Dr. Salvino to pay immediately because the firm would not advance him those fees.

26. The annuity fee charges included the European Patent Office, Filing No. EP16815464.9 due on June 30, 2018 and the Brazil Patent Filing Office, Filing No.

BR1120170278464 due on September 24, 2018.

27. Dr. Salvino asked for clarification as to which applications the fees were associated with, and Respondent informed him they were for the Oxygen Biofeedback patents.

28. Dr. Salvino stated that he would send a check. He did so and earmarked \$1,317.00 for the renewal annuity fees.

29. Thereafter, Dr. Salvino was informed that his payment would be applied to the European and Brazilian annuity fees.

30. Respondent did not communicate the conflict he had by accepting payments for the annuity fee payments, nor did he obtain the requisite informed consent from Dr. Salvino, when he had a competing interest to take those payments and apply them to outstanding balances for prior patent services.

31. Upon termination of the attorney-client relationship with Dr. Salvino, Respondent did not apply the funds to the European and Brazilian annuity fees and, instead, kept and applied the funds to the outstanding account balance owed by Dr. Salvino to Respondent. Dr. Salvino incurred a late fee for the European annuity fee payment.

32. Because Respondent, or another person in Respondent's firm, informed Dr. Salvino that his payment of \$1,317.00 would be applied to the annuity fee payments, but it was instead applied to outstanding balances, Respondent failed to clearly communicate to Dr. Salvino the basis and rate of the fees for the European and Brazilian annuity payments and how they would be applied.

### **Additional Considerations**

33. Respondent has never been the subject of professional discipline by the USPTO, and Respondent represents that he has never been the subject of any such discipline by any court, or any state bar.

34. Respondent has expressed contrition for his prior lack of understanding of the duties to former clients under the USPTO Rules of Professional Conduct.

35. Respondent voluntarily provided refunds to Dr. Salvino for the annuity fees and late fees.

### **Joint Legal Conclusions**

36. Respondent acknowledges that, based on the information contained in the Joint Stipulated Facts, above, his conduct violated the following provisions of the USPTO Rules of Professional Conduct:

- a. 37 C.F.R. § 11.101 (practitioner shall provide competent representation) by failing to inform Dr. Salvino of the Notice to File Missing Parts in the '704 application, failing to respond to the Notice, then allowing the '704 application to go abandoned, not reviving the '704 application, and failing to timely inform Dr. Salvino of the abandonment; failing to file claims with the [REDACTED] application, receiving an Invitation to Correct from the USPTO's RO and not informing Dr. Salvino of the Invitation to Correct and its due date, and failing to respond to the Invitation to Correct, resulting in the [REDACTED] application not being accorded an international filing date;
- b. 37 C.F.R. § 11.102(a) (practitioner shall abide by a client's decisions concerning the objectives of the representation and failing to consult with a client as to the means by which the client's objectives are to be pursued) by

failing to revive the '704 application that Dr. Salvino wanted revived; failing to submit the annuity fees with the European and Brazilian patent offices that Dr. Salvino thought would be paid;

c. 37 C.F.R. § 11.103 (practitioner shall act with reasonable diligence and promptness in representing a client) by allowing the '704 application to go abandoned and failing to revive such application, failing to timely respond to the Notice to File Missing Parts in the '704 application; failing to include claims in the [REDACTED] application and then failing to respond to the Invitation to Correct in the [REDACTED] application, failing to establish an international filing date in the [REDACTED] application; failing to promptly file the renewal annuity fee payments for the European and Brazilian patent offices after being paid to do so resulting in a late fee for the European annuity fee payment;

d. 37 C.F.R. § 11.104(a)(1) (a practitioner shall promptly inform the client of any circumstance to which the client's informed consent is required by the USPTO Rules of Professional Conduct) by not adequately communicating material information and not providing a clear explanation to Dr. Salvino about the material risks of, and reasonably available alternatives to, applying any new payments to outstanding account balances prior to keeping and applying those newly paid funds to outstanding balances paid by Dr. Salvino, and not obtaining Dr. Salvino's agreement to do so; by taking the \$5,000 flat fee payment from Dr. Salvino specifically earmarked for the Chest Tube 2.0, and applying it to past invoice(s) without

ensuring that Dr. Salvino understood and consented that his new payments would be applied to past invoices; accepting Dr. Salvino's payment for the European and Brazilian annuity fees, not explaining that making those payments were contingent upon payment of outstanding balances, and keeping the funds upon termination of the attorney-client relationship and applying the funds to those outstanding balances without ensuring that Dr. Salvino understood and consented to the use of the annuity fee payments in this manner;

e. 37 C.F.R. § 11.104(a)(2) (a practitioner shall reasonably consult with the client about the means by which the client's objectives are to be accomplished by the USPTO Rules of Professional Conduct) by failing to inform Dr. Salvino of the Notice to File Missing Parts and the abandonment in the '704 application and the consequences of not reviving the application despite Dr. Salvino's wanting the '704 application filed; failing to inform Dr. Salvino of the failure to file claims in the [REDACTED] application resulting in an Invitation to Correct and that the application would not be afforded an international filing date and the implications thereof although Dr. Salvino originally wanted to pursue the [REDACTED] application; failing to consult with and notify Dr. Salvino that upon termination of the attorney-client relationship the fees he paid to Respondent to pay the annuity fees to the European and Brazilian patent offices would not be paid, rather, they would be used for outstanding balances despite Dr. Salvino's belief that the annuity fees would be paid and wanted them paid;

f. 37 C.F.R. § 11.104(a)(3) (a practitioner shall keep the client reasonably informed about the status of the matter) by failing to inform Dr. Salvino of the Notice of Missing Parts and the Notice of Abandonment in the '704 application; failing to inform Dr. Salvino of the Invitation to Correct, in the [REDACTED] application, failing to inform Dr. Salvino of the Notification of Non-treatment as International Application in the [REDACTED] application, not timely transmitting to Dr. Salvino the Notification of Non-treatment as International Application in the [REDACTED] application; not forwarding communications from the USPTO for the '968 application to either Dr. Salvino or his new counsel after terminating the attorney-client relationship; failing to timely inform Dr. Salvino that Respondent had not paid the renewal annuity fee payments to the European and Brazilian patent offices including failing to timely inform him of the deadline for the European annuity fee;

g. 37 C.F.R. § 11.105(b) (communicate with the client the scope of the representation and the basis or the rate of the fee and expenses for which the client will be responsible) by during the course of the attorney-client relationship with Dr. Salvino, failing to clearly communicate, such that Dr. Salvino understood, that all of his new payments would be applied to outstanding balances first; failing to communicate to Dr. Salvino how the \$5,000 payment, that he earmarked for the Chest Tube 2.0, would be applied to outstanding balances rather than the new application - Chest Tube 2.0; by requesting, and receiving payment from Dr. Salvino, for the European

and Brazilian annuity fees and informing Dr. Salvino that those fees would be paid to the European and Brazilian patent offices, but upon termination of the attorney-client relationship keeping the annuity fees to pay outstanding balances without explaining to Dr. Salvino that the fees would be so applied rather than refunded;

h. 37 C.F.R. § 11.107(a)(2) and (b) (a practitioner shall not represent a client if the representation involves a significant risk that the representation will be materially limited by the personal interest of the practitioner, absent informed consent confirmed in writing on the part of the client) by not adequately communicating material information and not providing a clear explanation to Dr. Salvino about the material risks of, and reasonably available alternatives to, applying any new payments to outstanding account balances prior to keeping and applying those newly paid funds to outstanding balances, in particular where Respondent's representation of Dr. Salvino for any new patent prosecution work would be materially limited by his own interest in applying those new payments to prior outstanding balances, in particular with the Chest Tube 2.0 and the European and Brazilian annuity fees; and,

i. 37 C.F.R. § 11.116(d) (upon termination of representation, a practitioner shall take steps to the extent reasonably practicable to protect a client's interests, such as giving reasonable notice to the client, allowing time for employment of other counsel, surrendering papers and property to which the client is entitled and refunding any advance payment of fee or

expense that has not been earned or incurred) by after the termination of the attorney-client relationship, Respondent did not forward to Dr. Salvino the [REDACTED] RO notice that the [REDACTED] application would not be treated as an international application; not informing Dr. Salvino of, or forwarding to him, correspondence from the USPTO concerning the '968 application, Respondent did not forward to Dr. Salvino the USPTO communications concerning the '968 application, a) stating that the withdrawal of the POA was not accepted, b) the non-final rejection, and (c) the notice that new correspondence was available;

#### **Agreed-Upon Sanction**

37. Respondent agrees and it is hereby ORDERED that:

- a. Respondent shall be, and hereby is, suspended from practice before the Office for a period of thirty (30) days commencing fourteen (14) days from the date of the Final Order;
- b. Respondent shall serve a probationary period beginning on the date of the Final Order and extending twelve (12) months from the date of the order granting a petition reinstating Respondent to practice before the USPTO; and, before or during the probationary period, Respondent shall (1) take the Multistate Professional Responsibility Exam ("MPRE") and attain a score of 86 or higher; and (2) take at least three (3.0) hours of continuing legal education credit concerning law firm management and client trust accounts;
- c. Respondent shall provide to the OED Director, before the end of the probationary period, a sworn affidavit or verified declaration attesting, and

supporting documentary evidence demonstrating, that he has (1) taken the Multistate Professional Responsibility Exam (“MPRE”) and attained a score of 86 or higher; and (2) taken at least three (3.0) hours of continuing legal education credit concerning law firm management and client trust accounts;

d. (1) if the OED Director is of the opinion that Respondent, during his suspension or probationary period, failed to comply with any provision of the USPTO Rules of Professional Conduct, 37 C.F.R. § 11.58, or any of the above conditions of probation identified in items b. and c., the OED Director shall:

(A) issue to Respondent an Order to Show Cause why the USPTO Director should not enter an order immediately suspending the Respondent up to an additional eleven (11) months for the violations set forth in the Joint Legal Conclusions, above;

(B) send the Order to Show Cause to Respondent at the last address of record Respondent furnished to the OED Director;

(C) grant Respondent fifteen (15) days to respond to the Order to Show Cause; and

(2) in the event that after the 15-day period for response and consideration of the response, if any, received from Respondent, the OED Director continues to be of the opinion that Respondent, during Respondent’s suspension or probationary period, failed to comply with the USPTO Rules of Professional Conduct, 37 C.F.R. § 11.58, the provisions of the Proposed Settlement Agreement, or any of the above conditions of probation identified above, the OED Director shall:

- (A) deliver to the USPTO Director: (i) the Order to Show Cause;
- (ii) Respondent's response to the Order to Show Cause, if any; and
- (iii) argument and evidence supporting the OED Director's position;
- and
- (B) request that the USPTO Director enter an order immediately suspending Respondent for up to an additional eleven (11) months for the violations set forth in the Joint Legal Conclusions above;
- e. Nothing herein shall prevent the OED Director from seeking discipline for any misconduct that formed the basis for an Order to Show Cause issued pursuant to the preceding subparagraph;
- f. In the event the Respondent seeks a review of any action taken pursuant to subparagraph d., above, such review shall not operate to postpone or otherwise hold in abeyance the suspension;
- g. The OED Director shall electronically publish the Final Order at the OED's electronic FOIA Reading Room, which is publicly accessible through the Office's website at: <https://foiadocuments.uspto.gov/oed/>;
- h. The OED Director shall publish a notice in the *Official Gazette* that is materially consistent with the following:

#### **Notice of Suspension and Probation**

This notice concerns Mr. Eric Alspaugh, a registered patent practitioner (Registration No. 54,783) and attorney licensed in the state of California, who resides in Aliso Viejo, California. Mr. Alspaugh is hereby suspended from practice before the Office for a period of thirty (30) days and Mr. Alspaugh shall serve a probationary period during which he is to (1) take the Multistate Professional Responsibility Exam ("MPRE") and attain a score of 86 or higher; and (2) take at least three (3.0) hours of continuing legal education credit concerning law firm management and client trust accounts.

Mr. Alspaugh violated 37 C.F.R. §§ 11.101 (practitioner shall provide competent representation); 11.102 (practitioner shall abide by a client's decisions regarding the scope of the representation); 11.103 (practitioner shall act with reasonable diligence and promptness in representing a client); 11.104(a)(1), 11.104(a)(2), 11.104(a)(3) (a practitioner shall: promptly inform the client of any circumstance to which the client's informed consent is required by the USPTO Rules of Professional Conduct, reasonably consult with the client about the means by which the client's objectives are to be accomplished, and keep the client reasonably informed about the status of the matter); 11.105(b) (practitioner shall communicate with the client the scope of the representation and the basis or the rate of the fee and expenses for which the client will be responsible); 11.107(a)(2) and (b) (a practitioner shall not represent a client if the representation involves a significant risk that the representation will be materially limited by the personal interest of the practitioner, absent informed consent confirmed in writing on the part of the client); and 37 C.F.R. § 11.116(d) (upon termination of representation, a practitioner shall take steps to the extent reasonably practicable to protect a client's interests, such as surrendering papers and property to which the client is entitled and refunding any advance payment of expenses that has not been incurred).

Mr. Alspaugh entered into a practitioner-client relationship with Dr. Chris Salvino. Dr. Salvino engaged Respondent to provide patent legal services for Dr. Salvino's medical device inventions. Throughout Mr. Alspaugh's representation of Dr. Salvino, Respondent did not clearly communicate the basis or rate of the fees and expenses that would be applied to outstanding balances before payments would be applied to new patent services in violation of USPTO disciplinary rules. Mr. Alspaugh also did not explain the conflict with regard to his taking new payments for new patent services when he had a competing interest to take those payments and apply them to outstanding balances for prior patent services.

Mr. Alspaugh also violated disciplinary rules that included failing to act with diligence and promptness, along with failing to keep his client reasonably informed about the status of his matters. In the '704 patent application, Mr. Alspaugh received a Notice to File Missing Parts and he did not inform Dr. Salvino of the Notice; he also did not respond to the Notice. As a result, the application went abandoned without Dr. Salvino's knowledge or consent. In the [REDACTED] patent application, Mr. Alspaugh did not file claims when filing that application. Mr. Alspaugh terminated his attorney-client relationship on June 14, 2018. But he did not inform Dr. Salvino of the Invitation to Correct or of the [REDACTED] response due date in the [REDACTED] patent application or that the application was not afforded an international filing date.

Mr. Alspaugh violated the disciplinary rules pertaining to obligations to former clients. Mr. Alspaugh did not forward communications from the USPTO in the '968 application. Further, Mr. Alspaugh's office requested and received payment from Dr. Salvino to pay European and Brazilian annuity fees. Upon termination of the attorney-client relationship, Dr. Salvino was confused and Mr. Alspaugh did not clearly communicate that those annuity fee payments would first be applied to outstanding invoices rather than paying the annuity fees.

Mr. Alspaugh has not been previously disciplined by the USPTO, and he represents that he has never been the subject of professional discipline by any court or any state bar. He represents that he now understands, and has expressed contrition for, his prior lack of understanding of the duties to former clients under the USPTO Rules of Professional Conduct. Mr. Alspaugh voluntarily refunded the annuity fee payments and the late fee.

This action is the result of a settlement agreement between Mr. Alspaugh 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, 11.20, and 11.26. Disciplinary decisions involving practitioners are posted for public reading at the Office of Enrollment and Discipline Reading Room accessible at: <https://foiadocuments.uspto.gov/oed>;

- i. Nothing in 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;

#### **Respondent's Duties and Responsibilities Under 37 C.F.R. § 11.58**

- j. Respondent shall have the following duties and responsibilities as a consequence of being suspended:

- (1) Respondent shall provide notice of his suspension to all State and Federal jurisdictions and administrative agencies to which the practitioner is admitted to practice as set forth in 37 C.F.R. § 11.58(c)(2);
- (2) Respondent shall provide notice of his suspension to all clients the practitioner represents having immediate or prospective business before the Office as set forth in 37 C.F.R. § 11.58(c)(3)(i), and shall make appropriate arrangements for legal services to be rendered on behalf of his clients, as appropriate, during the period of his suspension;
- (3) Respondent shall provide notice of his suspension to the practitioners for all opposing parties (or, to the parties in the absence of a practitioner representing the parties) in matters pending before the Office as set forth in 37 C.F.R. § 11.58(c)(4);
- (4) Respondent shall not hold himself out as authorized to practice law before the Office as set forth in 37 C.F.R. § 11.58(b)(2) until he is reinstated to practice before the Office; and
- (5) Respondent shall not render legal advice or services to any person having immediate or prospective business before the Office as set forth in 37 C.F.R. § 11.58(b)(1) until he is reinstated to practice before the Office;

**Duties and Responsibilities Respondent Does Not Have Unless a Petition for  
Reinstatement of Respondent is Not Granted  
Within 90 Days of the Final Order**

- k. Respondent shall not have the following duties and responsibilities as a consequence of being suspended, unless a petition for reinstatement of Respondent is not granted within 90 days of the Final Order:
- (1) Respondent is not required to file a notice of withdrawal in each pending application as set forth in 37 C.F.R. § 11.58(c)(1);
  - (2) Respondent is not required to deliver to all clients documents as set forth in 37 C.F.R. § 11.58(c)(3)(ii);
  - (3) Respondent is not required to relinquish to the client, or other practitioner designated by the client, all funds for practice before the Office, including any legal fees paid in advance that have not been earned and any advanced costs not expended as set forth in 37 C.F.R. § 11.58(c)(3)(iii);
  - (4) Respondent is not required to remove any telephone, legal, or other directory advertisement, statement or representation as set forth in 37 C.F.R. § 11.58(d)(5);
  - (5) Respondent is not required to change any existing advertising regarding his availability or ability to perform or render legal services for any person having immediate or prospective business before the Office as set forth in 37 C.F.R. § 11.58(b)(2); and
  - (6) Respondent is not required to take steps to change any sign identifying Respondent's or the Respondent's firm's office and Respondent's or Respondent's firm's stationery to delete therefrom any advertisement, statement, or representation which would reasonably suggest that the

practitioner is authorized to practice law before the Office as set forth in 37 C.F.R. § 11.58(b)(3);

**Affidavit of Compliance Under 37 C.F.R. § 11.58**

- l. Respondent shall provide an affidavit of compliance in accordance with 37 C.F.R. § 11.58(d), certifying that he has complied with the provisions of this Agreement. Appended to the affidavit shall be:

- (1) a copy of each form of notice, the names and addresses of the clients, practitioners, courts, and agencies to which notices were sent, and all return receipts or returned mail received up to the date of the affidavit as set forth in 37 C.F.R. § 11.58(d)(1); and
- (2) a list of all other State, Federal, and administrative jurisdictions to which the practitioner is admitted to practice as set forth in 37 C.F.R. § 11.58(d)(4);

- m. Respondent's affidavit need not append the following:

- (1) a schedule showing the location, title and account number of every bank account designated as a client or trust account, deposit account in the Office, or other fiduciary account, and of every account in which Respondent holds or held as of the entry date of the order any client, trust, or fiduciary funds for practice before the Office as set forth in 37 C.F.R. § 11.58(d)(2);
- (2) a schedule describing Respondent's disposition of all client and fiduciary funds for practice before the Office in Respondent's possession, custody, or control as of the date of the order or thereafter as set forth in 37 C.F.R. § 11.58(d)(3);

- (3) proof of the proper distribution of funds and the closing of such accounts as has been requested by the OED Director, including copies of checks and other instruments as set forth in 37 C.F.R. § 11.58(c)(3)(iii); or
- (4) an affidavit describing the precise nature of the steps taken to remove from any telephone, legal, or other directory any advertisement, statement, or representation which would reasonably suggest that the practitioner is authorized to practice patent, trademark, or other non-patent law before the Office as set forth in 37 C.F.R. § 11.58(d)(5);

#### **No Limited Recognition**

- n. Respondent's suspension shall commence fourteen (14) days after the date that the Final Order is signed, Respondent shall not be granted limited recognition under 37 C.F.R. § 11.58(f);

#### **Petition For Reinstatement Under 37 C.F.R. § 11.60**

- o. (1) Respondent shall not resume practice of patent, trademark, or other non-patent law before the Office until reinstated by order of the OED Director or the USPTO Director as set forth in 37 C.F.R. § 11.60(a);
- (2) After the term of Respondent's suspension and compliance with the applicable provisions of 37 C.F.R. § 11.58 as set forth in this Agreement, Respondent may file a petition for reinstatement as set forth in 37 C.F.R. § 11.60(b);

(3) Any petition for reinstatement shall be filed with the OED Director and shall be accompanied by the required fee as set forth in 37 C.F.R. § 11.60(c);

(4) Upon filing of a petition for reinstatement by Respondent, such petition shall comply with the applicable provisions of 37 C.F.R. §§ 11.60(c)(1)-(3), and shall attest to his compliance with the applicable provisions of 37 C.F.R. § 11.58 set forth in this Agreement, including a sworn declaration that he has complied with 37 C.F.R. § 11.58(a) affirming that he has not engaged in the practice of patent, trademark law, or other non-patent matters before the Office during his suspension;

(5) The OED does not have to publish any notice of Respondent's petition for reinstatement as set forth in 37 C.F.R. § 11.60(h)(1);

- p. 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
- q. The parties shall bear their own costs incurred to date and in carrying out the terms of the Final Order.

(signature page follows)

(signature page for Final Order, Alspaugh- D2021-09)

Users,  
Shewchuk,  
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David Shewchuk  
Acting General Counsel  
United States Patent and Trademark Office

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Date

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