

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE ADMINISTRATIVE LAW JUDGE**

In the Matter of)	
)	
Kevin P. Correll,)	Proceeding No. D2018-12
)	
Respondent.)	

INITIAL DECISION

Before: Susan L. Biro
Chief Administrative Law Judge, EPA¹

Issued: October 3, 2019

Appearances:

For Complainant:

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¹ This Initial Decision is issued by the Chief Administrative Law Judge of the United States Environmental Protection Agency. The Administrative Law Judges of the Environmental Protection Agency are authorized to hear cases pending before the United States Department of Commerce, Patent and Trademark Office, pursuant to an Interagency Agreement effective for a period beginning May 15, 2014.

I. PROCEDURAL HISTORY

This action was initiated January 17, 2018, when the Director of the Office of Enrollment and Discipline (“OED” or “Director”), United States Patent and Trademark Office (“USPTO”), issued a Complaint and Notice of Proceedings against Respondent Kevin P. Correll under 35 U.S.C. § 2(b)(2)(D), § 32, and 37 C.F.R. §§ 11.32, 11.34, 11.39. The Complaint charged Respondent with two counts of professional misconduct through violations of the USPTO Code of Professional Responsibility (“USPTO Code”), 37 C.F.R. §§ 10.20-10.112, and the USPTO Rules of Professional Conduct (“USPTO Rules”), 37 C.F.R. §§ 11.101 through 11.901.² The violations all arise from Respondent’s representation of private parties before the USPTO while he was employed by the federal government. For these violations, the OED Director sought in the Complaint an order excluding or suspending Respondent from practice before the USPTO in patent, trademark, and other non-patent matters, and other relief as warranted.

Respondent filed his “Answer Under 37 CFR 11.36, Defenses and Counter Claims” (“Answer”) on February 15, 2018. In the Answer, Respondent admitted the truth of almost all the factual allegations in the Complaint but raised various affirmative defenses and claims to liability, including some based upon the statute of limitations and the U.S. Constitution. Thereafter, the parties participated in this Tribunal’s alternative dispute resolution process for nearly two months but did not resolve the matter. On April 26, 2018, the undersigned was designated to preside over this proceeding, and on May 1, 2018, I issued an Order Scheduling Prehearing Procedures and Hearing. Shortly thereafter, the OED filed a motion for summary judgment and a motion to stay the prehearing deadlines, and Respondent filed a motion to dismiss and a cross-motion for summary judgment. The OED’s motion to stay the prehearing deadlines was granted on May 31, 2018, and the parties then engaged in extensive briefing on the pending dispositive motions. On August 16, 2018, I issued an order denying Respondent’s motion to dismiss based on his statute of limitations defense.³ *See* Order on Respondent’s Motion to Dismiss (Aug. 16, 2018).

² As of May 3, 2013, the USPTO Rules govern attorneys practicing before the USPTO. *See* 37 C.F.R. §§ 11.101-11.901. The USPTO Code applied to misconduct occurring prior to that date. *See* 37 C.F.R. §§ 10.20-10.112 (repealed). The misconduct alleged in the Complaint occurred before and after May 3, 2013, so both the USPTO Code and the USPTO Rules apply in this proceeding. Count I alleges a total of six violations of the USPTO Code under 37 C.F.R. §§ 10.23(a), 10.23(b)(4), 10.23(b)(5), 10.23(b)(6), 10.23(c)(20), and 10.40(b)(2), as well as six violations of the USPTO Rules, 37 C.F.R. §§ 11.111, 11.116(a)(1), 11.505, 11.804(b), 11.804(d) and 11.804(i). Count II alleges two additional violations, one under USPTO Code section 37 C.F.R. § 10.23(b)(6), and one under the USPTO Rules, 37 C.F.R. § 11.804(i).

³ This motion represented the first of two dismissal motions Respondent filed based upon the statute of limitations. The applicable statute of limitations provides that a USPTO disciplinary “proceeding shall . . . commence[] not later than the earlier of either the date that is 10 years after the date on which the misconduct forming the basis for the proceeding occurred, or 1 year after the date on which the misconduct forming the basis for the proceeding is made known to an officer or employee of the Office as prescribed in the regulations established under section 2(b)(2)(D).” 35 U.S.C. § 32. The first motion to dismiss argued that the OED Director had received notice of Respondent’s misconduct in 2003 when he responded to an OED survey indicating he was a government employee. Respondent claimed this triggered both the one- and ten-year deadlines. I rejected those arguments and denied Respondent’s motion. *See* Order on Respondent’s Motion to Dismiss (Aug. 16, 2018).

On September 27, 2018, I issued a lengthy order on the parties' cross-motions for summary judgment. *See* Order on Motions for Summary Judgment (Sept. 27, 2018) ("SJ Order"). The SJ Order resolved all issues of liability, finding Respondent liable for certain violations and not liable for others. It also addressed the myriad "Counter Claims and Defenses" to liability raised by Respondent in this action including those based upon the First Amendment to the U.S. Constitution, statutory misinterpretation, statutory exemption, lack of conflict of interest, Fifth Amendment substantive and procedural due process, privacy act provisions, and 18 U.S.C. §§ 242 and 245. SJ Order at 14-27. I rejected all these defenses and counterclaims, as well as two others Respondent raised in his Answer but either failed to support or abandoned during the motions process. SJ Order at 27. In addition, I denied summary judgment as to sanction, finding that Respondent had raised factual disputes related to the gravity of his misconduct to warrant a hearing. SJ Order at 26.

An Order rescheduling hearing and prehearing proceedings was issued on October 12, 2018. Pursuant thereto, the Director and Respondent filed their initial prehearing statements on December 21, 2018 and January 11, 2019, respectively, with the Director updating his exhibit list thereafter.

On December 28, 2018, Respondent filed a second motion to dismiss the complaint based on the statute of limitations.⁴ *See* Respondent's Motion to Dismiss Complaint (Dec. 28, 2018). About a week later, on January 7, 2019, Respondent also filed a motion seeking interlocutory review of the SJ Order's holding as to the invalidity of his First Amendment defense. *See* Respondent's Motion for Leave to Motion USPTO Director to Review Tribunal's Interlocutory Order and Motion to Suspend Proceeding Pending USPTO Director's Review (Jan. 7, 2019). Both motions were opposed by the OED, and on February 25, 2019, I issued separate Orders denying both motions. *See* Order on Respondent's Second Motion to Dismiss Complaint (Feb. 25, 2019); Order on Respondent's Motion for Interlocutory Appeal and Stay of Proceedings (Feb. 25, 2019).

Subsequently, on March 4, 2019, the OED filed a motion requesting a new hearing date or permission to subpoena and take the deposition of the grievant, its key witness, James M. Kasischke, Esq., due to his unavailability to personally appear at hearing. Respondent advised the OED of his opposition to the motion but filed no written response thereto. I granted the OED's Motion. *See* Order on OED Director's Motion for New Hearing Date or to Subpoena Witness for Deposition (Mar. 6, 2019). With the participation of the Respondent, the Director took Mr. Kasischke's videotaped deposition on April 2, 2019. *See* OED Director's Notice to Take Deposition of James M. Kasischke (Mar. 26, 2019); OED Director's Notice of Filing Deposition Transcript with the Tribunal (Apr. 12, 2019).

⁴ In this second Motion, Respondent asserted that the OED had received notice of his misconduct on September 28, 2016, when the grievant in the case, James M. Kasischke, Esq., learned of his misconduct, arguing that Mr. Kasischke was an "officer" of the USPTO as contemplated by 35 U.S.C. § 2(b)(2)(D). In denying the Motion, I held that merely being authorized to practice before the USPTO did not make Mr. Kasischke an "officer" or employee of the USPTO and, as such, his knowledge of Respondent's misconduct cannot be attributed to the OED prior to Mr. Kasischke's December 19, 2017 email to the OED. *See* Order on Respondent's Second Motion to Dismiss Complaint (Feb. 25, 2019).

On March 26, 2019, the parties filed Joint Stipulations (“Stips.”). The hearing in this matter was held on April 16, 2019 in Providence, Rhode Island.⁵ At hearing, the OED Director elicited the testimony of Respondent and submitted into evidence the written deposition testimony of Mr. Kasischke.⁶ Tr. 13-65. The Tribunal also admitted into evidence 20 Joint Exhibits (“JX”) numbered 1-20 as well as five OED Director’s Exhibits (“DX”) nos. 20, 32-35.⁷ Tr. 15, 39, 43-44, 67. Respondent narratively testified on his behalf at hearing but submitted no additional testimony or documents. Tr. 47-65.

The undersigned received the hearing transcript on May 2, 2019 and provided copies to the parties on May 7, 2019. The Director’s initial post-hearing brief (“DIB”) was filed on June 28, 2019, and the Respondent’s initial post-hearing brief (“RIB”) was filed on July 12, 2019.⁸ Thereafter, reply briefs were filed on August 9, 2019 by the Director (“DRB”) and on August 23, 2019 by the Respondent (“RRB”).⁹ The record closed with that last filing.

II. LEGAL BACKGROUND

Congress has authorized the USPTO to promulgate regulations governing “the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Office[.]” 35 U.S.C. § 2(b)(2)(D). If an attorney does not comply with regulations issued under § 2(b)(2)(D), or if he is “shown to be incompetent or disreputable, or guilty of gross misconduct,” the USPTO may suspend or exclude the attorney from further practice before the USPTO. 35 U.S.C. § 32. *See also Bender v. Dudas*, 490 F.3d 1361, 1365 (Fed. Cir. 2007); *Sheinbein v. Dudas*, 465 F.3d 493, 495 (Fed. Cir. 2006). “Under these statutes, the PTO has the exclusive authority to establish qualifications for admitting persons to practice before it, and to suspend or exclude them from practicing before it.” *Kroll v. Finnerty*, 242 F.3d 1359, 1364 (Fed. Cir. 2001).

⁵ Citation to the hearing transcript will be in the following form: “Tr. __.”

⁶ The transcript of Mr. Kasischke’s deposition testimony, along with the exhibits, acknowledgement and errata sheet thereto, were together admitted into evidence as Joint Ex. 21. Tr. 13-15. The videotape of Mr. Kasischke’s testimony was neither offered nor admitted into evidence.

⁷ Admission of documentary evidence offered by the Director identified as DX 19, DX 38, and DX 39 was denied based on lack of foundation supporting their authenticity. Tr. 26, 29. Testimonial reference specifically to such documentary evidence is hereby stricken from the record and not considered in reaching the determination made herein. *See* Tr. 20-23, 26-27, 44-46.

⁸ Respondent’s initial post-hearing brief, entitled “Reply Brief,” was filed out of time, but nevertheless accepted. *See* Order on OED Director’s Request for Extension of Time (May 10, 2019). The Director then moved to respond to the late-filed brief. The Director’s motion was granted, and Respondent was also given an opportunity to file an additional post-hearing brief. *See* Order on OED Director’s Motion to File a Reply Brief (July 16, 2019). The bulk of Respondent’s reply brief is a regurgitation of his First Amendment argument in defense of his conduct. RRB at 4-12. That issue was ruled upon in the SJ Order, and as Respondent fails to show in his brief that that ruling was clearly erroneous, it is not being reconsidered. SJ Order at 15-17.

⁹ In addition to the Joint Stipulations filed by the parties prior to hearing, the Director’s initial brief contained a numbered “Statement of Proposed Facts.” DIB at 1-13. In his two post-hearing briefs, Respondent indicated that he stipulated to the truth of the facts set forth in paragraphs numbered 1-13, 20-33, 35, 37-49, and 52-66 therein. RIB at 3; RRB at 3. The remaining facts Respondent “denied in whole or in part.” RIB at 3. These additional stipulations agreed to by the parties are cited herein as “DIB Stip. __.”

In 1985, the USPTO issued regulations based on the American Bar Association (“ABA”) Model Code of Professional Responsibility to govern attorney conduct and practice. *See Practice Before the Patent and Trademark Office*, 50 Fed. Reg. 5158 (Feb. 6, 1985) (Final Rule) (codified at 37 C.F.R. §§ 10.20-10.112 (1985-2003)). These regulations set forth the USPTO Code of Professional Responsibility (“USPTO Code”) and “clarif[ied] and modernize[d] the rules relating to admission to practice and the conduct of disciplinary cases.” *Id.* They remained in effect through April 2013.¹⁰ That year, recognizing that most state bar organizations had adopted substantive disciplinary rules based on the newer ABA Model Rules of Professional Conduct, the USPTO repealed its Code of Professional Responsibility and replaced it with the Rules of Professional Conduct (“USPTO Rules”) fashioned on the ABA’s Model Rules. *See Changes to Representation of Others Before the United States Patent and Trademark Office*, 78 Fed. Reg. 20180 (Apr. 3, 2013) (Final Rule) (codified at 37 C.F.R. §§ 11.101-11.901). In making this change, the USPTO sought to “provid[e] attorneys with consistent professional conduct standards, and large bodies of both case law and opinions written by disciplinary authorities that have adopted the ABA Model Rules.”¹¹ *Id.* at 20180.

Both the USPTO Code and the USPTO Rules are relevant in this case. The USPTO Code applies to conduct occurring prior to May 3, 2013, when the USPTO Rules became effective and applicable to conduct occurring after that date. *Id.* The USPTO Code is “mandatory in character and state[s] the minimum level of conduct below which no practitioner can fall without being subjected to disciplinary action.” 37 C.F.R. § 10.20(b); *see Sheinbein*, 465 F.3d at 495-96. The USPTO Rules carry that standard forward. *Changes to Representation of Others Before the United States Patent and Trademark Office*, 78 Fed. Reg. at 20181.

Furthermore, as to federal government employees, both the USPTO Code and USPTO Rules incorporate within them the standards of conduct set forth in federal conflicts of interest laws, regulations and codes of professional responsibility. *See* 37 C.F.R. §10.10(d)(2000-03) (“Practice before the Office by Government employees is subject to any applicable conflict of interest laws, regulations or codes of professional responsibility.”); 37 C.F.R. § 11.10(e)(2004-present) (same).

Federal conflict of interest statutes impose certain prohibitions upon federal employees. *See* 18 U.S.C. §§ 203, 205 (“Conflict of Interest Statutes”). Generally, an employee of the United States may not “accept any compensation for any representational services, as agent or attorney or otherwise, rendered or to be rendered either personally or by another” in “any proceeding, application, [or] request for a ruling or other determination . . . in which the United States is a party or has a direct and substantial interest[.]” 18 U.S.C. § 203(a)(1)(B). Additionally, “an officer or employee of the United States . . . other than in the proper discharge of his official duties” may not “act[] as agent or attorney for anyone before any department [or]

¹⁰ Certain provisions of the USPTO Code were revised and/or renumbered in 2004. *See Changes to Representation of Others Before the United States Patent and Trademark Office*, 69 Fed. Reg. 354280-01 (Jun. 24, 2004). The date of that interim revision is reflected herein where applicable.

¹¹ Also useful to understanding the USPTO Code and USPTO Rules are Comments and Annotations to the ABA Model Rules as well as decisions and opinions issued by state bars. *See Changes to Representation of Others Before the United States Patent and Trademark Office*, 78 Fed. Reg. 20180.

agency . . . in connection with any covered matter in which the United States is a party or has a direct and substantial interest[.]”¹² 18 U.S.C. § 205(a)(2). Violators of sections 203 and/or 205 are subject to criminal and civil penalties under 18 U.S.C. § 216, which authorizes imprisonment for not more than one year, or five years if the conduct is deemed willful, and/or a fine of up to \$50,000 for each violation or “the amount of compensation which the person received or offered for the prohibited conduct, whichever amount is greater.”¹³ 18 U.S.C. § 216(a), (b).

In 1949, the United States Attorney General issued a formal advisory opinion declaring that -

“[T]he United States is a party or directly or indirectly interested” within the meaning of section 281 of Title 18, United States Code [now codified as 18 U.S.C. § 203], in proceedings involving the filing and prosecution before the United States Patent Office of an application for a patent. This being so, section 281, of course, proscribes the participation in such proceedings of Government employees for compensation on behalf of private parties.

Gov’t Employees Prosecuting Claims for Patents, 41 U.S. Op. Atty. Gen. 21, 23, 1949 WL 1637 (1949). *See also Kearney & Trecker Corp. v. Giddings & Lewis, Inc.*, 452 F.2d 579, 591 (7th Cir. 1971), *cert. denied*, 405 U.S. 1066 (1972) (holding that the United States has a direct and substantial interest in the prosecution of a patent application before the Patent and Trademark Office).

In 1991, the United States Office of Government Ethics (“OGE”)¹⁴ issued an opinion reiterating that “in the case of an executive branch employee, [] the prosecution of a patent application for a private party for compensation is generally subject to the prohibition of [Sections 203 and 205].” JX 11 at 36-37.

Almost a decade later, the United States Court of Appeals for the District of Columbia Circuit similarly interpreted 18 U.S.C. § 205, rejecting the claim that covered prohibited matters were limited to adversarial or formal legal proceedings. The Court held that “the conflicting interests at which § 205 is aimed could be equally present, for example, were a federal employee to represent a private party in its uncontested application for a broadcast license, *patent*, or other valuable benefit.” *Van Ee v. E.P.A.*, 202 F.3d 296, 302 (D.C. Cir. 2000) (emphasis added). Shortly thereafter, in response to an inquiry for clarification submitted by a government attorney

¹² A “covered matter” is defined by the statute as “any judicial or other proceeding, application, request for a ruling or other determination, contract, claim, controversy, investigation, charge, accusation, arrest, or other particular matter.” 18 U.S.C. § 205(h).

¹³ The imposition of a civil penalty under section 216 does not preclude any other civil “statutory, common law, or administrative remedy, which is available by law to the United States or any other person.” 18 U.S.C. § 216(b).

¹⁴ “The U.S. Office of Government Ethics (OGE) was established by the Ethics in Government Act of 1978, Public Law 95-521, 92 Stat. 1824 (1978).” 5 C.F.R. § 2600.101(a). Its mission is “to prevent conflicts of interest on the part of executive branch employees and resolve those conflicts of interest that do occur.” *Id.* OGE serves as “the supervising ethics office for all executive branch officers and employees pursuant to the Ethics Reform Act of 1989, Public Law 101-194, 103 Stat. 1716 (1989), as amended by Public Law 101-280, 104 Stat. 149 (1990).” 5 C.F.R. § 2600.101(b).

in light of *Van Ee*, OGE issued yet another opinion explicitly reiterating that for a regular government employee to “act as a compensated agent for private clients in prosecuting patent applications before the Patent and Trademark Office of the Department of Commerce” “would violate 18 U.S.C. § 203 and 18 U.S.C. § 205.” Letter to a Former Employee,¹⁵ OGE Informal Advisory Letter 01 X 1 (O.G.E.), 2001 WL 34091910, at *1-2 (“OGE Letter”) (“In sum, your proposed conduct falls squarely within the terms of 18 U.S.C. §§ 203 and 205. Accordingly, you are not permitted to act as a compensated agent for private clients in prosecuting patent applications before the Patent and Trademark Office. We concur with the advice given to you by the ethics official at your agency.”).

In addition to the Conflict of Interest Statutes, federal employees are also subject to ethics regulations titled “Standards of Ethical Conduct for Employees of the Executive Branch.” 5 C.F.R. § 2635 *et seq.* Those Standards include prohibitions on outside employment “prohibited by statute or by an agency supplemental regulation” and explicitly reference 18 U.S.C. §§ 203 and 205 as statutes establishing standards to which an employee’s conduct must conform. JX 21, ex. 4; 5 C.F.R. §§ 2635.802(a), 2635.901, 2635.902(c), (d). The Department of Defense (“DOD”), of which the Navy is part, has issued a supplemental ethics regulation requiring its employees who file financial disclosure reports on OGE Form 450 to obtain prior written approval before engaging in outside employment. 5 C.F.R. § 3601.107; JX 10 at 2 (citing DOD 5500.7-R); National Security Act of 1947, Pub. L. No. 80-253, 61 Stat. 495 (making the Department of the Navy part of the DOD). *See also* 5 C.F.R. § 2635.803 (specifically allowing for agencies to issue supplemental regulations requiring their employees to obtain prior approval before engaging in outside employment and requiring those employees to obtain that approval before engaging in outside employment).

III. BURDEN OF PROOF

The OED Director must prove alleged violations by clear and convincing evidence. 37 C.F.R. § 11.49; *Johnson*, PTO Proceeding No. D2014-12, slip op. at 2 (Dec. 31, 2014) (Initial Decision and Order).¹⁶ Likewise, it is Respondent’s burden to prove any affirmative defense by clear and convincing evidence. 37 C.F.R. § 11.49; *Piccone v. United States Patent & Trademark Office*, No. 1:18-cv-00307 (LMB/IDD), 2018 WL 5929631, at *7 (E.D. Va. Nov. 13, 2018). This standard “protect[s] particularly important interests . . . where there is a clear liberty interest at stake.” *Johnson*, PTO Proceeding No. D2014-12 at 3 (quoting *Thomas v. Nicholson*, 423 F.3d 1279, 1283 (Fed. Cir. 2005)) (quotation marks omitted). “Clear and convincing evidence” requires a level of proof that falls “between a preponderance of the evidence and proof beyond a reasonable doubt.” *Id.* (quoting *Addington v. Texas*, 441 U.S. 418, 424-25 (1979)) (internal quotation marks omitted). The evidence produced must be of such weight so that it “produces in the mind of the trier of fact a firm belief or conviction, without hesitancy, as to the truth of the allegations sought to be established.” *Id.* (quoting *Jimenez v. DaimlerChrysler Corp.*, 269 F.3d

¹⁵ The title of the OGE Letter suggests the employee of the unnamed government “Department” left his position before its issuance. The Letter provides no further information regarding the employee’s job title or responsibilities and suggests that such matters are immaterial to the application of the broad prohibition unless the person qualifies as a “special Government employee.” 2001 WL 34091910.

¹⁶ The PTO case decisions cited here are publicly accessible via the search portal available at: <https://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>.

439, 450 (4th Cir. 2001)) (internal quotation marks omitted). “Evidence is clear if it is certain, unambiguous, and plain to the understanding, and it is convincing if it is reasonable and persuasive enough to cause the trier of facts to believe it.” *Id.* (quoting *Foster v. Alliedsignal, Inc.*, 293 F.3d 1187, 1194 (10th Cir. 2002)) (internal quotation marks omitted).

IV. FACTUAL BACKGROUND

Respondent’s undergraduate educational background is in physics and electrical engineering. Tr. 16; JX 5. In 1999, he graduated from Roger Williams University School of Law in Bristol, Rhode Island. Tr. 16-17; JX 5. He was admitted to practice law in Massachusetts on June 14, 1999 and currently remains an active member in good standing of that bar. Stip. 3; Tr. 16; JX 2. On September 12, 2000, Respondent registered as a patent attorney with the USPTO (registration number 46,641). Stips. 1, 2; Tr. 17-18; JX 1. As a condition of registration, Respondent swore an oath to “observe the laws and rules of practice of the [USPTO].” Stip. 4; Tr. 18.

Since September 4, 2002, Respondent has owned and operated a solo law practice under the names “K.P. Correll & Associates, LLC,” “Northeastern Patent Law Associates,” or “Patent Institute.” Tr. 30-32; DIB Stips. 7, 10; JX 10 at 1, 34-37. The “client office” for the practice is in Fall River, Massachusetts, but the business uses a Rhode Island mailing address. Tr. 31; JX 2. Respondent has advertised his law practice via the internet, paper flyers, the yellow book and in two booth diorama displays at the T.F. Green Airport in Warwick, Rhode Island. DIB Stip. 11; Tr. 40-41, 61; JX 6. The practice holds itself out as an “intellectual property law firm serving corporate and individual clients across the country and around the world by protecting their intellectual property assets through patents, federal trademarks, and federal copyrights.” DIB Stips. 7, 12; Tr. 31.

Less than two weeks after establishing his law firm -- that is, beginning on September 16, 2002, and continuing until September 29, 2018 -- Respondent was also employed as a full-time electronics engineer for the United States Department of the Navy, Naval Undersea Warfare Center (“NUWC”) at the Naval Sea Systems Command headquartered in Newport, Rhode Island. Stip. 5; Tr. 29-30; DIB Stip. 6; JX 10 at 1; JX 12 at 3. There, as a “branch head,” he primarily worked on submarine learning technologies, conducting system analyses of submarine training devices and training systems. Tr. 48-52, 54; JX 14 at 1; JX 12 at 3. In his last year with the government, he was temporarily promoted to Chief Technology Officer for the Submarine Learning Center in Groton, Connecticut, an ND 5 (comparable to GS-14) supervisory position and tasked with “investigating new educational concepts for better training, faster training, more economical training.” Tr. 51-52; JX 14 at 1; DX 20. Throughout his government career, Respondent maintained a secret level security clearance, had access to classified information, and worked in a secured facility. Tr. 49-50; JX 12 at 1.

Respondent testified that prior to joining the government “it never occurred to me that it would be a conflict” between continuing his law practice and serving as a federal employee, so he did not inquire into the ethics thereof. Tr. 55. Still, he recalled that shortly after joining the government in 2002, he had a conversation with his then-direct government supervisor, Harold Watt, a division head at NUWC, from which he came away believing that his private law practice did not conflict with his government work and that he had Mr. Watt’s informal, i.e., verbal, approval to continue to engage in such work. Respondent testified that this approval was

never withdrawn. Tr. 23-24, 47-48, 54; JX 8 at 2; JX 10 at 2. Respondent stated that over his career at NUWC he had other supervisors who became aware that he had a law degree and maintained a private law practice, but he never sought from them any type of approval for his outside work activities. JX 10 at 2-3.

Around November 25, 2003, Respondent submitted a signed, dated, certified response to a USPTO Survey. JX 3; Tr. 18-20; DIB Stip. 5. In his response, Respondent hand-marked “YES” to Question 6 on the Survey, which read as follows:

Are you an employee of the United States Government? *PLEASE*
NOTE: U.S. Government employees are not available to accept
private clients or to represent clients other than their agency before
the United States Patent and Trademark Office. 18 U.S.C. § 205;
37 CFR § 10.10(c) and (d).

JX 3 at 1 (italics in original); Tr. 19-20; DIB Stip. 5. Despite this notice, Respondent claimed that even after completing the Survey he remained unaware of the conflict between engaging in both private practice and government work. Tr. 57.

In addition to his regular duties at the NUWC, from approximately 2004 until 2016, Respondent was also a voting member of the base’s Invention Examination Board (“IEB”). Tr. 30; JX 14 at 1; JX 15 at 1; JX 10 at 1-2; JX 21 at 10, 13; DIB Stip. 33. The IEB consists of approximately ten Navy inventors and engineers representing the various technical areas within the Newport laboratory, including sonar, antennas, combat systems, launchers, undersea vehicles, and others. JX 21 at 9-12; JX 14 at 1. The IEB meets several times a year and is overseen by the base’s non-voting Supervising Patent Counsel. JX 21 at 9-10, 12-13, 34; JX 14 at 1. Prior to seeking a patent, all NUWC employees are required to submit disclosures of their inventions to the base’s Patent Counsel’s Office for an initial determination as to whether the invention is owned by the Navy or the employee/inventor, personally. JX 21 at 10-12, 25, 35; JX 14 at 2; JX 15 at 2; JX 17 at 3. If the invention belongs to the Navy, the IEB then reviews it and votes as to whether the Supervising Patent Counsel should seek patent protection for the invention on the Navy’s behalf and the priority thereof. JX 10 at 1-2; JX 14 at 1; JX 21 at 9-11; Tr. 30.

Since 2004, James M. Kasischke, Esq. has been the Supervisory Patent Counsel at the NUWC in Newport, RI. JX 21 at 8-9; JX 14. His position involves overseeing the whole patent program for NUWC laboratory in Newport, including patent applications, patent licensing, patent prosecution, and the IEB. JX 21 at 9-10, 37; JX 14. Mr. Kasischke estimated that since 2004, he has filed more than 500 patents for the government, as he, like Respondent, is a registered PTO patent practitioner. JX 21 at 8, 36. However, other than both being IEB participants, Mr. Kasischke testified his position did not involve working with Respondent. JX 14 at 2; JX 21 at 10.

Sometime around 2005 or 2006, while in a barbershop near NUWC, Mr. Kasischke came across a flyer offering the invention services of Kevin P. Correll or KP Correll Intellectual Property Services. JX 21 at 16; DX 14 at 1. Based upon inquiries he had previously made for himself regarding earning outside income, Mr. Kasischke knew that such outside work activities by Respondent were “wrong” and a “violation.” JX 21 at 16-18, 29-30; JX 14. Explaining that

he “was trying to be a good guy” and recognizing that Respondent “might not have known about the law,” Mr. Kasischke telephoned Respondent and notified him that “you can’t file patent applications if you’re a government employee.” JX 21 at 16-17, 22, 29-30; JX 14. In reply, Respondent reassured Mr. Kasischke that he was aware of the prohibition and that “he wasn’t filing patent applications” but merely “advis[ing] people on what to do with their inventions and advis[ing] them maybe to get somebody else to file the patent applications.” JX 21 at 19; JX 14 at 1. Because he was busy, Mr. Kasischke said he took Respondent at his word and after that “didn’t keep [his] eye on him” or report his outside activities to the USPTO.¹⁷ JX 21 at 26.

Sometime in 2008 or 2009, Respondent filed an OGE Form 450 Financial Disclosure Report for 2008, in which he claims he disclosed his outside work activities.¹⁸ JX 8 at 2; JX 10 at 2, n.6; JX 10 at 3, 21-23; JX 13 at 1, 4 n.5; JX 17 at 4. Respondent had been receiving annual online ethics training from NUWC and was aware that NUWC employees who are required to file OGE 450s must “obtain supervisor’s [written] concurrence before engaging in any business activities outside of their official duties or in any compensated employment.” JX 8 at 2; JX 10 at 2, n.6; JX 10 at 3, 21-23; JX 13 at 1, 4 n.5; JX 17 at 4. Nevertheless, Respondent did not seek or receive written concurrence for his outside work activities either before or after filing the OGE 450 form. Tr. 57.

Mr. Kasischke testified that many years later, around fall 2016, he noticed two large standing glass booths in the Providence, RI airport advertising Respondent’s professional services as Northeastern Patent Associates and another named entity.¹⁹ JX 21 at 14-15; JX 6. Coincidentally, about the same time, some other NUWC employees mentioned the airport advertisements to him as well, as they too recognized them as being connected to Respondent. JX 21 at 14. Among those other employees was the head of the IEB, Dr. Theresa Baus, who advised Mr. Kasischke that “you know, you probably have to do something about that.” JX 21 at 19-20.

In response, Mr. Kasischke testified, he undertook a search to determine for himself whether Respondent had “really been filing patent applications” for private clients with the USPTO and found that he had. JX 21 at 14, 20. He also discovered that Respondent was not then identified as a government employee on the USPTO’s register of attorneys, “when I knew he was.” JX 21 at 29; *see also* JX 1 (USPTO computerized registration data extracted Dec. 5, 2017 identifying Respondent as *not* being a federal employee). Mr. Kasischke became “mad” at Respondent “because I warned him, and he’d gone against my advice.” JX 21 at 26. Mr. Kasischke concluded that it was his “duty as a Navy attorney” to report Respondent, “first, you

¹⁷ While Respondent claimed at hearing to not recall the conversation and characterizes Mr. Kasischke’s testimony in his post-hearing reply brief as “perjured,” I credit as truthful Mr. Kasischke’s testimony regarding the conversation he had with Respondent in 2005 or 2006. Tr. 20-24, 27-28; RRB at 3. Mr. Kasischke’s testimony about this event was detailed, reasonable, and consistent, and I see no motive for deceit or bias. JX 21 at 16-17, 22, 29-30; JX 4; JX 14.

¹⁸ A copy of Respondent’s 2008 OGE Form 450 is not in the record. *See* JX 10 at 22 (email indicating NUWC deleted forms filed prior to 2011 from its system).

¹⁹ Respondent testified that he installed the airport displays in January 2016 but ceased paying for them after approximately two years because they were not “cost-effective” in that they did not generate any business for him. Tr. 40, 62-64.

know, as far as the ethics violation to the US government [a]nd then as a US PTO bar member, I had to report to the patent bar.” JX 21 at 20, 28. On December 19, 2016, he emailed OED advising that Respondent was filing patents and trademark applications while employed with the Department of Navy in contravention of 18 U.S.C. §§ 203 and 205. JX 4. In addition, Mr. Kasischke testified that he spoke with Dr. Baus and together they decided that it was no longer appropriate for Respondent to be on the IEB “due to conflicts of interest,” and Dr. Baus removed him from the Board. JX 21 at 20; JX 14 at 1; JX 15 at 1; Tr. 30.

Upon receipt of Mr. Kasischke’s email, the OED opened an investigation. JX 7. As part of that investigation, beginning on February 9, 2017, and continuing through November 2017, the Director sent Respondent a series of four Requests for Information (RFI). Each RFI advised Respondent that:

With a small number of exceptions,²⁰ United States Government employees may not represent anyone other than themselves on any matter before the executive branch. 18 U.S.C. 205. In addition, executive branch employees are prohibited from receiving any form of compensation derived from representation of another before the executive branch. See 18 U.S.C. 203. In addition, 37 C.F.R. § 11.10(e) provides that “[p]ractice before the office by government employees is subject to any applicable conflict of interest laws, regulations or codes of professional responsibility.

JX 7 at 2-3; JX 9 at 3; JX 11 at 5; JX 16 at 5; Tr. 33-34; DIB Stips. at 20, 24, 27, 30.

Respondent submitted written responses to each of the OED’s RFIs. JX 8; JX 10; JX 12; JX 13; JX 17; DIB Stip. 22. Respondent included with his RFI responses lengthy legal memoranda offering his view of the proper statutory interpretation of 18 U.S.C. § 203 and 205 in support of his assertion “that he has been in compliance with the law” and further promising that he would “begin immediate separation from US Government service if OED’s interpretation of 18 USC 205 is averse to the practitioner’s position.”²¹ JX 8; JX 10 at 5; JX 13 at 7; DIB Stips. 22, 26, 29.

Despite the advisement in the RFIs, and despite the on-going USPTO investigation, Respondent continued to both work for the NUWC and file USPTO applications for private

²⁰ In general, the exceptions are for “special government employees” (defined by 18 U.S.C. § 202(a) as essentially short-term employees); employees serving as personal fiduciaries representing family members or estates; employees acting under a grant; employees testifying under oath; and employees representing others in government personnel or labor proceedings. 18 U.S.C. § 203(c)–(f); 18 U.S.C. § 205(c)–(i). Respondent’s conduct here does not fall within the exceptions. See SJ Order at 20-22. See also, JX 11 at 33 (Informal Advisory Letter 88 x 3 (O.G.E.) (Mar. 2, 1988) (advising that a federal employee should obtain supervisors consent to representation under an exception to 18 U.S.C. § 205 to assure representation is not inconsistent with “the faithful performance of [his] duties”); JX 11 at 36 (Informal Advisory Letter 91 x 11 (O.G.E.) (Apr. 4, 1991) (advising that status of “special government employee” is determined a time of appointment and Agency ethics officials be contacted for “ascertaining the impact of [sections 203 and 205 exceptions] have on your situation”).

²¹ In his response to the third RFI, Respondent modified his representation stating that he would begin separation if OED’s contrary opinion is “supported by relevant legal opinions or is finally adjudicated in a court of competent jurisdiction.” JX 13 at 7; DIB Stip. 29. See also Tr. 48 (Respondent stating he told the USPTO “let’s go to court, let’s get a ruling. Once I get a ruling, then . . . I’ll resign from one or the other.”).

clients, professing to believe he “fit within the small number of exceptions” and that “according to case law” he was entitled to “maintain[] the status quo until there was an adjudication.” Tr. 34-35; DIB Stips. 43, 44; DX 32-34. At no time before or after the OED’s investigation was initiated did Respondent ever seek guidance from a government ethics official on the propriety of his dual work activities. Tr. 57; DIB Stips. 21, 25, 28, 31; JX 17 at 4.

On January 17, 2018, the OED Director filed the Complaint initiating this disciplinary proceeding seeking Respondent’s exclusion or suspension as a USPTO practitioner based upon his dual work activities.²² DIB Stip. 55. Still, Respondent continued to engage in both his federal employment and private practice. Stip. 15-18; Tr. 37-38, 54-55; DX 35. However, on September 4, 2018, Respondent notified his supervisor that he would be retiring from the Navy “by the end of the month.” Stip. 9; JX 18; Tr. 41-42; DIB Stip. 60. Respondent’s voluntary separation from the Navy became effective as of September 29, 2018. Stip. 10; DIB Stip. 62; Tr. 43; DX 20. Respondent testified that this proceeding was the driving force in his retirement. Tr. 43-44.

During the time period spanning the violations at issue in this case – between January 17, 2008 (when the statute of limitations began to run) and September 29, 2018 (when Respondent retired) – Respondent filed and/or prosecuted approximately 169 patent applications with the USPTO on behalf of paying clients. JX 19; Stip. 17. According to USPTO records, of those patent applications, Respondent either filed or entered his appearance in approximately 60 provisional applications, 70 non-provisional utility applications, and 40 non-provisional design applications.²³ JX 19; DIB Stip. 41. In addition, during this same period, Respondent filed and/or prosecuted approximately 89 trademark applications.²⁴ JX 20; Stip. 18; DX 32-35.

²² While the factual background regarding Respondent’s overlapping work activities provided here goes back to 2002, the OED Director specified in his Initial Post-Hearing Brief that consistent with the applicable statute of limitations (35 U.S.C. § 32), he seeks discipline only for Respondent’s violative conduct beginning January 17, 2008, ten years prior to the date the Complaint was filed. DIB at 15-16. OED suggests that conduct occurring between September 16, 2002, the date Respondent began working for the federal government, and January 16, 2008, can be considered by this Tribunal as an aggravating factor as to penalty. DIB at 16. The record reflects that Respondent filed approximately 38 patent applications and two trademark applications during that early time period. JX 19 at 1; JX 20 at 7; DIB Stip. 40.

²³ A provisional patent application “provides the means to establish an early effective filing date in a later filed nonprovisional patent application.” It is a non-examined application which allows the term “Patent Pending” to be applied in connection with the description of the invention and lasts no more than 12 months from the date the provisional application is filed. See <https://www.uspto.gov/patents-getting-started/patent-basics/types-patent-applications/provisional-application-patent>. A non-provisional utility patent grants a property right for a period of time to the owner for the exclusive use of the invention. See <https://www.uspto.gov/patents-getting-started/patent-basics/types-patent-applications/nonprovisional-utility-patent#heading-2>. A design application protects the “visual ornamental characteristics embodied in, or applied to, an article of manufacture.” See <https://www.uspto.gov/patents-getting-started/patent-basics/types-patent-applications/design-patent-application-guide#def>. A patent search is a preliminary step involving searching the USPTO database for patents that have been previously filed or issued. See <https://www.uspto.gov/patents-application-process/search-patents>.

²⁴ A trademark typically protects brand names and logos used on goods and services. See <https://www.uspto.gov/trademarks-getting-started/trademark-process>.

For the services rendered to private clients, Respondent acknowledged at hearing that he charged and received financial compensation mostly on a flat-fee basis, “credit[ing] each fee forward.”²⁵ Tr. 39, 57; DIB Stips. 47, 48. Specifically, he charged \$750 for an initial patent search, which would be credited against a \$1,900 fee if the client then hired him to prepare and file a provisional application with the USPTO, a fee that in turn could be credited against a total fee of \$4,500-\$5,500 for preparing and filing a utility application, rates that remained the same over the years, Respondent stated. Tr. 58-59; DIB Stips. 49, 52. Respondent’s fee for preparing and filing design applications ranged from \$1,900 down to \$1,500, as his fees decreased over the years. Tr. 59-60; DIB Stip. 52. The flat fee he charged clients for preparing and filing a trademark application was \$300-\$400. Tr. 59; DIB Stip. 53.

V. VIOLATIONS FOUND

The SJ Order granted summary judgment on liability under Count I, in part, to the Director finding the undisputed facts established that Respondent:

(1) “engaged in disreputable or gross misconduct” in violation of 37 C.F.R. § 10.23(a) by consulting with or giving advice to clients in contemplation of filing patent or trademark applications or other documents with the PTO and preparing and prosecuting patent and trademark applications before the PTO while employed by the U.S. Government;

(2) “engaged in conduct involving dishonesty, fraud, deceit, or misrepresentation” in violation of 37 C.F.R. § 10.23(b)(4) by consulting with or giving advice to clients in contemplation of filing patent or trademark applications or other documents with the PTO and preparing and prosecuting patent or trademark applications before the PTO while employed by the U.S. Government, not withdrawing as attorney of record in numerous patent and trademark matters pending before the PTO after being notified that he could not represent others before the PTO while employed by the U.S. Government, and receiving compensation for representing others before the PTO in violation of federal ethics law while employed by the U.S. Government;

(3) “engaged in conduct that is prejudicial to the administration of justice” in violation of 37 C.F.R. § 10.23(b)(5) by consulting with or giving advice to clients in contemplation of filing patent or trademark applications or other documents with the PTO and preparing and prosecuting patent or trademark applications before the PTO while employed by the U.S. Government, not withdrawing as attorney of record in numerous patent and trademark matters pending before the PTO after being notified that he could not represent others before the PTO while employed by the U.S. Government, and receiving compensation for representing others before the PTO in violation of federal ethics law while employed by the U.S. Government;

(4) engaged in “practice by a Government employee contrary to applicable Federal conflict of interest laws, or regulations of the Department, agency or commission employing” him in violation of 37 C.F.R. § 10.23(c)(20) when, after being notified that his actions violated

²⁵ Respondent testified that charged a flat fee for the “initial” application plus an hourly fee for any “follow-on” work. Tr. 57; DIB Stip. 48.

18 U.S.C. §§ 203(a)(1)(B) and 205(a)(2), Respondent consulted with or gave advice to clients in contemplation of filing patent or trademark applications or other documents with the PTO and prepared and prosecuted patent or trademark applications before the PTO while employed by the U.S. Government, failed to withdraw as attorney of record in numerous patent and trademark matters pending before the PTO after being notified that he could not represent others before the PTO while employed by the U.S. Government, and when he received compensation for representing others before the PTO in violation of federal ethics law while employed by the U.S. Government;

(5) while representing clients before the PTO, failed to withdraw from those clients' employment when he knew or when it was obvious that his continued employment would result in violation of a Disciplinary Rule, in violation of 37 C.F.R. § 10.40(b)(2);

(6) "engaged in conduct which is contrary to applicable Federal ethics law, including conflict of interest statutes and regulations of the department, agency or commission formerly or currently employing said practitioner," in violation of 37 C.F.R. § 11.111, by consulting with or giving advice to clients in contemplation of filing patent or trademark applications or other documents with the PTO and preparing and prosecuting patent or trademark applications before the PTO while employed by the U.S. Government, by not withdrawing as attorney of record in numerous patent and trademark matters pending before the PTO after being notified that he could not represent others before the PTO while employed by the U.S. Government, and by receiving compensation for representing others before the PTO in violation of federal ethics law while employed by the U.S. Government;

(7) failed to withdraw from the representation of clients when it resulted in violation of the PTO Rules or other law, in violation of 37 C.F.R. § 11.116(a)(1);

(8) "practice[d] law in a jurisdiction in violation of the regulation of the legal profession in that jurisdiction," in violation of 37 C.F.R. § 11.505, by consulting with or giving advice to clients in contemplation of filing patent or trademark applications or other documents with the PTO and preparing and prosecuting patent or trademark applications before the PTO while employed by the U.S. Government, by not withdrawing as attorney of record in numerous patent and trademark matters pending before the PTO after being notified that he could not represent others before the PTO while employed by the U.S. Government, and by receiving compensation for representing others before the PTO in violation of federal ethics law while employed by the U.S. Government; and

(9) engaged in conduct that is prejudicial to the administration of justice, in violation of 37 C.F.R. § 11.804(d), by preparing and prosecuting patent or trademark applications before the PTO while employed by the U.S. Government, by not withdrawing as attorney of record in numerous patent and trademark matters pending before the PTO, and by receiving compensation for representing others before the PTO in violation of federal ethics law while employed by the U.S. Government.

SJ Order at 10-14.

The SJ Order also denied summary judgment to the Director, and granted it to Respondent, in regard to Count I, in part, finding Respondent not liable as to the alleged

violations of 37 C.F.R. § 11.804(b), the rule stating that it is professional misconduct for a practitioner to “[c]ommit a criminal act that reflects adversely on the practitioner’s honesty, trustworthiness or fitness as a practitioner” as well as 37 C.F.R. §§ 10.23(b)(6) or 11.804(i), rules forbidding a practitioner from “[e]ngag[ing] in . . . other conduct that adversely reflects on the practitioner’s fitness to practice before the Office.” SJ Order at 14. Further, Respondent was found not liable at all under Count II, which alleged violations of 37 C.F.R. §§ 10.23(b)(6) and 11.804(i). SJ Order at 14-15.

VI. PENALTY FACTORS

Having found that Respondent committed violations of the USPTO Code and USPTO Rules, it falls to me to determine an appropriate sanction. 37 C.F.R. § 11.54(a)(2). Four factors must be considered before sanctioning a practitioner: (1) whether the practitioner has violated a duty owed to a client, to the public, to the legal system, or to 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); *Schroeder*, PTO Proceeding No. D2014-08, slip op. at 10 (May 18, 2015) (Initial Decision on Default Judgment). The analysis of these factors is interrelated. *Burmeister*, PTO Proceeding No. D1999-10, slip op. at 10 (Mar. 16, 2004) (Initial Decision). The ABA Standards for Imposing Lawyer Sanctions (1992) (“ABA Standards”)²⁶ provide guidance as to the existence of aggravating or mitigating factors. *Schroeder*, PTO Proceeding No. D2014-08 at 12; *see also Chae*, PTO Proceeding No. D2013-01, slip op. at 4 (Oct. 21, 2013) (Final Order). According to the ABA Standards, aggravating factors are outlined in black letter rules:

(a) prior disciplinary offenses; (b) dishonest or selfish motive; (c) a pattern of misconduct; (d) multiple offenses; (e) bad faith obstruction of the disciplinary proceeding by intentionally failing to comply with rules or orders of the disciplinary agency; (f) submission of false evidence, false statements, or other deceptive practices during the disciplinary process; (g) refusal to acknowledge wrongful nature of conduct; (h) vulnerability of victim; (i) substantial experience in the practice of law; (j) indifference to making restitution; [and] (k) illegal conduct, including that involving the use of controlled substances.

ABA Standards at 17-18, Rule 9.2. Similarly, mitigating factors are also outlined in black letter rules:

(a) absence of a prior disciplinary record; (b) absence of a dishonest or selfish motive; (c) personal or emotional problems; (d) timely good faith effort to make restitution or to rectify consequences of misconduct; (e) full and free disclosure to disciplinary board or cooperative attitude toward proceedings; (f) inexperience in

²⁶ The ABA Standards are available on the ABA’s website at: https://www.americanbar.org/content/dam/aba/administrative/professional_responsibility/sanction_standards.pdf. The pages of the ABA Standards are not numbered. Consequently, page numbers in this decision that refer to that document cite the page numbers displayed when the document is viewed in a PDF reader.

the practice of law; (g) character or reputation; (h) physical disability; (i) mental disability or chemical dependency including alcoholism or drug abuse . . . (j) delay in disciplinary proceedings; (k) imposition of other penalties or sanctions; (l) remorse; [and] (m) remoteness of prior offenses.

ABA Standards at 18-19, Rule 9.3. According to the ABA Standards, “[t]he ultimate sanction imposed should at least be consistent with the sanction for the most serious instance of misconduct among a number of violations; it might well be and generally should be greater than the sanction for the most serious misconduct.” ABA Standards at 7.

An important function of disciplinary sanctions is to deter others from similar conduct, and general deterrent effects should be considered when analyzing misconduct. *Hill*, PTO Proceeding No. 2001-06, slip op. at 12 (July 26, 2004) (Final Decision). Indeed, “[w]e start from the premise that protection of the public and bar, not punishment, is the primary purpose of attorney discipline and that we must accordingly consider relevant mitigating and aggravating circumstances.” *Burmeister*, PTO Proceeding No. D1999-10, at 11 (quoting *Coombs v. State Bar of California*, 779 P.2d 298, 306 (Cal. 1989)) (quotation marks omitted). “Honesty and integrity are chief among the virtues the public has a right to expect of lawyers. Any breach of that trust is misconduct of the highest order and warrants severe discipline.” *In re Disciplinary Action Against Peter J. Ruffenach*, 486 N.W.2d 387, 391 (Minn. 1992) (citing *In re Holmay*, 464 N.W.2d 723, 725 (Minn. 1991)). “The ultimate issue to be decided in disbarment proceedings is whether the respondent is fit to practice.” *Id.* (citing *Harary v. Blumenthal*, 555 F.2d 1113, 1116 (2d Cir. 1977) (upholding disbarment of certified public accountant from practice before the Internal Revenue Service)). “Attorneys who practice before the PTO have a duty to represent their clients competently and zealously, and to maintain ‘the integrity and competence of the legal profession.’” *Kang*, PTO Proceeding No. D2012-24, slip op. at 8 (Nov. 26, 2012) (Initial Decision on Default) (citing 37 C.F.R. §§ 10.21, 10.76, 10.83); *see also Robinson*, PTO Proceeding No. D2009-48, slip op. at 12 (May 26, 2010) (Initial Decision). The length of time for which a respondent has engaged in misconduct is also a factor when determining the appropriate severity of a penalty. *Hormann*, PTO Proceeding No. D2008-04, slip op. at 21 (July 8, 2009) (Initial Decision).

VII. DIRECTOR’S ARGUMENTS ON PENALTY

Based upon his evaluation of the four penalty factors, the OED Director suggests in his post-hearing briefs that the appropriate penalty for Respondent’s violations is suspension from practice before the USPTO for 18 months. DIB at 17; DRB at 8.

As to the first factor, the OED Director maintains that Respondent’s “wide-ranging misconduct violated duties he owed to his clients, the public, the legal system, and the profession.” DIB at 20. He recounts that, although prohibited from doing so by virtue of his federal employment, Respondent for compensation consulted with and gave advice to clients in contemplation of filing patent or trademark applications or other documents with the PTO; prepared and prosecuted patent and trademark applications before the PTO; and failed to withdraw as attorney of record in patent and trademark matters pending before the PTO, even after being notified that he could not represent others. DIB at 21, 24. By his actions, Respondent misrepresented to his clients, the public, the legal system, and the profession that he was authorized to engage in such representation, a falsity which also impacts negatively on the

public's perception of attorneys and the legal system, the Director proclaims. DIB at 21-25. Referring to the SJ Order, the Director observes that this Tribunal found that such actions constituted "disreputable or gross misconduct;" "conduct involving dishonesty, fraud, deceit, or misrepresentation;" conduct "prejudicial to the administration of justice;" conduct "contrary to applicable Federal conflict of interest laws" or regulations; a failure to withdraw when required by regulation; and the unauthorized practice of law, in violation of various provisions of the Code and Rules. DIB at 21-25.

Under the second factor, the OED Director designates Respondent as having "knowingly" engaged in the misconduct. DIB at 25-26; DRB at 3, 9. The Director asserts Respondent was placed on notice that he was not permitted to represent private clients as a Federal government employee by the 2003 survey, Mr. Kasischke, the RFIs, and the pleadings in this action. DRB at 3-4. In support, the Director cites the SJ Order's conclusion that Respondent acted "knowingly" when, for compensation, as a government employee, he nevertheless consulted with and gave advice to clients in contemplation of filing patent or trademark applications or other documents with the PTO; prepared and prosecuted patent and trademark applications before the PTO; and failed to withdraw as attorney of record in patent and trademark matters pending before the USPTO, even after being notified that he could not represent others. DIB at 25. Additionally, the Director characterizes Respondent as having "stuck his head in the sand" as he personally undertook no research as to whether it would be ethical to engage in a private practice before the PTO while employed by the Federal government and steadfastly refused to seek ethical guidance from others, even when put on notice that he was violating federal ethics law. DIB at 25-26; DRB at 10.

In contradiction to the rationale offered by Respondent for a good faith belief that his dual activities were permitted, the Director proclaims that a "nexus" between Respondent's government work and his private practice work is not required, stating that "[t]he Office of Government Ethics has made clear that even if a Federal government employee's outside employment is not in direct conflict with his or her government employment, '18 U.S.C. § 205 is very broad in that it applies to all employees regardless of level of responsibility or scope of duties, and to all particular matters regardless of whether those matters are related, or even appear to be related, to the employee's position or duties.'" DRB at 4 (citing Informal Advisory Letter 00 x 11 (O.G.E.), 2000 WL 33943404 at *1 (Oct. 4, 2000) (An activity "conflicts with an employee's official duties" and is prohibited under federal Standards of Conduct "if it is prohibited by statute or by an agency supplemental regulation") and quoting OGE Report to President and to Congressional Committees on the Conflict of Interest Laws Relating to Executive Branch Employment at 7 (Jan. 2006)).²⁷ Moreover, the Director argues that no attorney has a first amendment right to represent a client before a tribunal or to file an application or advocate on behalf of someone else. DRB at 7 (citing *Board of Ed. of City of New York v. Nyquist*, 590 F.2d 1241, 1245-46 (2nd Cir. 1979); *In re Primus*, 436 U.S. 412, 422 (1978) (an attorney does not have a First Amendment right to conduct any particular representation); *Mezibov v. Allen*, 411 F.3d 712, 720-21 (6th Cir. 2005) ("For these reasons, we hold that in the context of the courtroom proceedings, an attorney retains no personal First Amendment rights

²⁷ OGE Report to President and to Congressional Committees on the Conflict of Interest Laws Relating to Executive Branch Employment (January 2006) is accessible at: [https://oge.gov/Web/oge.nsf/0/2992B018CA57C5B985257E96006A91E8/\\$FILE/Report%20to%20the%20President%20and%20Congress%20on%20Ethics.pdf](https://oge.gov/Web/oge.nsf/0/2992B018CA57C5B985257E96006A91E8/$FILE/Report%20to%20the%20President%20and%20Congress%20on%20Ethics.pdf).²⁸ *Turner* involved a constitutional challenge to a government regulation on speech, specifically the "must-carry" of local broadcast stations by cable systems. *Turner*, 512 U.S. at 622.

when representing his client in those proceedings. Therefore, Mezibov has failed to allege that he was engaged in constitutionally protected conduct as the precipitating factor for his alleged retaliation, and his claim under 42 U.S.C. § 1983 was properly dismissed.”)). Finally, OED declares that by continuing his private practice after being notified he was in violation, Respondent was “not maintaining status quo” but engaging in a “continuing violation(s).” DRB at 6.

Regarding the third penalty factor, the OED Director concedes that while Respondent violated multiple ethical rules, “it does not appear that his patent and trademark clients were actually harmed by those violations.” DIB at 26. However, the Director minimizes the significance of this, advising that lack of harm is neither a defense to a violation nor grounds for not imposing a penalty. DIB at 26-27.

Under the fourth factor, the OED Director argues the following seven aggravating factors apply here: (a) selfish motive (financial gain); (b) a pattern of misconduct; (c) multiple offenses; (d) false statements during the disciplinary process; (e) refusal to acknowledge wrongful nature of conduct; (f) substantial experience in the practice of law; and (g) illegal conduct. DIB at 29-39; DRB at 11-16. The OED Director also acknowledges the applicability of the mitigating factor of Respondent not having been previously subjected to discipline. DIB at 39. However, he argues that that mitigating factor should be given little weight in that “Respondent has not be[en] disciplined only because he concealed his misconduct for many years. The fact he ‘got away with it’ does not constitute a mitigating factor.” DIB at 39.

VIII. RESPONDENT’S ARGUMENTS ON PENALTY

Respondent’s position is that his violations do not warrant any suspension. RIB at 13. In support, he challenges the Director’s evaluation of each of the four penalty factors.

First, as to OED’s claim that he violated duties owed to the public, the legal system, and the legal profession, Respondent argues that the “OED fails to identify just how the Respondent’s representational activities, while acting as a private citizen before the USPTO, could undermine the public’s confidence in subsequent patent or trademark registrations” or “how any action by the Respondent decreases the public’s confidence in the integrity of the profession of patent practitioners.” “More is needed,” Respondent posits. RIB at 7-8 and RRB at 17 (citing *Turner Broad. Sys., Inc. v. FCC*, 512 U.S. 622 (1994) (“The Government must demonstrate that the recited harms are real, not merely conjectural, and that the regulation will in fact alleviate these harms in a direct and material way.”)).²⁸

As to whether he acted intentionally, knowingly, or negligently, Respondent proclaims that at the time he checked the “YES” box on the 2003 survey warning of the prohibition on private practice while a government employee, he had a “good faith reason to believe he was in compliance with the statutes and also had, albeit informal, approval to operate a law practice that was not then in conflict with the Respondent’s official duties as a government engineer.” RIB at 8; RRB at 17-18 (citing Tr. 23). In support of his good faith, he cites his belief that the

²⁸ *Turner* involved a constitutional challenge to a government regulation on speech, specifically the “must-carry” of local broadcast stations by cable systems. *Turner*, 512 U.S. at 622.

exceptions to the statutory prohibition applied to him and/or that the prohibition as applied to him by OED violated the First Amendment. RIB at 3; RRB at 12-13. Furthermore, he advises that “the Manual of Patent Examining Procedure (MPEP) and the Trademark Manual of Examining Procedure (TMEP) are the controlling documents for USPTO examiners” and that “[n]owhere in either of these documents is there any mention that the identity of the applicant or the applicant’s representative is a factor in either allowing or not allowing an application.” RIB 8-9; RRB at 18 (citing Tr. 56). As further evidence of his good faith, he cites the promise he made to OED that if his interpretation of the statute was determined to be erroneous, he would begin immediate separation from the government. RIB at 3; RRB at 13. “At no time before the initiation of the present complaint did the OED ever disagree with [his] arguments” as to the inapplicability of the statutory prohibition, Respondent declares. RIB at 3; RRB at 13. Moreover, he avows that his “first inclination” that the issue would be decided against him was the August 16, 2018 order on his motion to dismiss. RIB at 3; RRB at 13. Therefore, on September 4, 2018, “after travel and holidays,” he initiated early retirement from the government, advising his supervisors that he was retiring “due to external factors” and “because of these proceedings.” RIB at 3-4; RRB at 13.

Next, Respondent states he agrees with the OED that his misconduct caused no actual or potential injury. He reiterates his claim that the OED has failed to show how “Respondent’s USPTO representational activity, not associated with his official Navy Department duties, would undermine the public’s confidence in the USPTO’s neutrality” and contends that despite alleging in “inflammatory language” that he represented hundreds of private clients and prosecuted hundreds of applications, “the OED is unable to point to one instance as an actual or potential conflict of interest.” RIB at 9; RRB at 18.

As to factors in aggravation, Respondent offers challenges to most of those identified by the Agency. RIB at 10-12. First, he decries the characterization of the fact that he was paid for his services as evidencing a “selfish motive,” declaring that a “[s]elfish motive is defined as ‘devoted to or caring only for oneself; concerned primarily with one’s own interests, benefits, welfare, etc., regardless of others.’” RIB at 10; RRB at 19. Here, he explains, he was merely compensated for services rendered, extolling that “assisting inventors to prepare and file patent and trademark applications to protect their intellectual property is anything but selfish” and that “[b]y the OED’s interpretation, every single parent working a second job is dishonest and selfish.” RIB at 10; RRB at 19-20.

Second, as to his engaging in a pattern of misconduct and multiple offenses, he points out that in the 2003 OED survey he identified himself as both a “privately practicing patent attorney and a government employee,” explaining he “had no reason to believe at that time that the OED would not have alerted the Respondent if there was an issue.” RIB at 10; RRB at 20. He further justifies his continuing to practice before the USPTO during the pendency of this case as merely an effort to preserve the “status quo” until his “Constitutional counter claims” were “fully adjudicated.” RIB at 10-11, RRB at 20. Respondent predicts that “were [he] to withdraw from patent and trademark practice without some judicial adjudication of the issues presented to the OED then the OED complainant could, and most likely would, interpret such withdrawal as admission that the OED complainant position is valid.” RIB at 11; RRB at 20. He also advises that in response to RFIs, “he provided a Memorandum of Law outlining at least two presumptively valid defensive positions which were not questioned or otherwise contradicted by the OED complainant’s [RFIs].” RIB at 11 (citing JX 9, 11, 16); RRB at 20. Additionally, he

notes that he had also offered to withdraw from government service and received no response from the OED. RIB at 11; RRB at 20.

Third, as to his “refusal to acknowledge the wrongful nature of his conduct,” Respondent proclaims that he “does not yet know for certain that his conduct is wrongful, and won’t really know until the First Amendment issues raised by the Respondent are fully adjudicated in Federal Court.” RIB at 11; RRB at 20. Nevertheless, “in the interim,” he has “separated from government service based upon this Tribunal’s initial interpretation of his defenses,” Respondent adds. RIB at 11; RRB at 20-21. Further, he challenges the Director’s reliance on *Bar v. Germain*, 957 So. 2d 613 (Fla. 2007), stating that the attorney in that case was not relying upon a statute with “exclusion paragraphs” and First Amendment issues. RRB at 21. *See also* DRB at 13-14.

Fourth, Respondent characterizes OED’s designation of his 18 years of experience practicing law as an aggravating factor, as “duplicitousness.” RIB at 11; RRB at 21. “On one hand the OED is claiming pattern of misconduct and multiple offenses spread over years, but then says those same years give rise to sage experience that should have informed the Respondent of his misconduct,” he laments. RIB at 11; RRB at 21. Further, he forcefully challenges OED’s claim that he “concealed his misconduct for many years,” stating “[n]owhere in the record is there any evidence of concealment. In fact, far from it. Advertising in the local airport, online, yellow pages, and flyers, is clearly not the actions of someone trying to conceal their alleged misconduct.” RIB at 12; RRB at 21.

In mitigation, Respondent identifies numerous factors in addition to the absence of a prior disciplinary record. RIB at 12; RRB at 21. Specifically, he states he “cooperated fully during the yearlong OED investigation, responded fully to all RFIs, is in good standing with the Massachusetts Bar, [initiated] self-imposed separation from government service at significant financial loss . . . , [I] has 30 years of government service, in uniform and out, and that at 63 years old an 18-month suspension is effectively an end to the Respondent’s solo patent practice.” RIB at 12; RRB at 22. Moreover, he advises that “as a result of the OED’s collusion with NUWC,” he would be unlikely to obtain a security clearance “which effectively blocks any meaningful government or government contractor employment near the Respondent’s residence.” RIB at 12; RRB at 22. In addition, Respondent suggests that NUWC was “well aware that [he] was practicing before the USPTO” since 2004. RIB at 12; RRB at 22 (citing Tr. 27). “Yet, although obligated by 37 CFR 11.803 to report any suspected misconduct to the OED, the government waited until 2016 to report suspected misconduct. These proceedings could have been avoided or the penalty much less harsh than an 18-month suspension at age 63 if the government had done its duty.” RIB at 12-13; RRB at 22.

In his Post-Hearing Brief, Respondent raises numerous issues regarding his opponent’s integrity, proclaiming first that the Director’s assertion that he made an “intentional misrepresentation” about the reason for his retirement “is contemptable and should be sanctioned.” RIB at 4; RRB at 14. “[T]he OED’s fixation with this allegation is nothing more than a boldfaced attempt to deflect the Tribunal’s attention from the OED’s false and misleading statements,” he decries. RIB at 4; RRB at 14.

“Most notable amongst the OED’s false and misleading statements,” Respondent continues, “is the OED’s failure to inform this Tribunal that [it] colluded with the Respondent’s

former government employer, the Naval Undersea Warfare Center (NUWC), to initiate a corresponding Department of Defense investigation on March 20, 2018, five months before the Respondent separated from government service.” RIB at 4; RRB at 14. Specifically, Respondent alleges, OED provided NUWC with data “only available to the USPTO in apparent violation of the violated the Computer Matching and Privacy Protection Act of 1988 (CMPAA), Pub. L. No. 100-503, 102 Stat. 2507.” RIB at 4-5; RRB at 14. He alleges that the resulting interim report dated April 18, 2019, “is replete with out of context allegations and inaccuracies,” but nonetheless, recommends it be “used negatively in consideration of any future application for a security clearance.” RIB at 5; RRB at 14. Moreover, “the OED has also failed to inform this Tribunal that the OED remains in collusion with NUWC for NUWC to ‘monitor’ the outcome of these proceedings and reporting the outcome to the Respondent’s state bar if the USPTO ultimately determines, for any reason, not to do so,” Respondent alleges. RIB at 5; RRB at 14. Additionally, he avers that the OED has “also attempted to “fluff” up their case and mislead this Tribunal by introducing patent and trademark applications submitted by the Respondent **after** he retired.” RIB at 5; RRB at 15 (citing Tr. 36-37).

Respondent further proclaims that the Director “exhibits bad faith, abuse of position, and contempt for the Tribunal’s judgment in practical matters with its grossly simplified estimates of Respondent’s earnings over 15 years.” RIB at 5; RRB at 15 (citing DIB at 35). He suggests OED’s calculations “grossly” over-inflate his earnings by failing to account for fees “credited forward” and “the expenses of operating a part time business (insurance, leases, taxes, advertising, travel, office expenses, etc[.]),” which did not result in positive earnings for several years. RIB at 5; RRB at 15. Respondent alleges his tax returns reflect his total net income from his private practice, from 2006-2018, amounts to less than \$34,000, stating that this sum is “[h]ardly indicative of massive greed.” RIB at 5; RRB at 15.

Finally, Respondent argues that the limited caselaw available does not support the imposition of an 18-month suspension and is distinguishable from the present case on the basis that “at no time has there been any matter overlap, potential matter overlap, or matter connection, or other nexus between the Respondent’s government position as an engineer for the Navy and the Respondent’s private work as a patent attorney; nor is there any matter connection between the Respondent’s Navy position as an engineer and the USPTO.” RRB at 16; RIB at 6-7 (citing, *inter alia*, *Moatz v. Kersey*, 67 U.S.P.Q.2d 1291, 2002 WL 32056608 (T.T.A.B. 2002)).

IX. DISCUSSION, FINDINGS, AND CONCLUSIONS

After considering the parties’ arguments, this Tribunal concludes that a 60-month suspension is the appropriate penalty to be imposed in this case. The reasons for this penalty are as follows:

Respondent violated duties he owed to his clients, the public, the legal system, and the profession. Lawyers violate the duties owed to clients by failing to show them loyalty, diligence, competence and candor; violate duties owed to the general public by failing to exhibit the “highest standards of honesty and integrity;” violate duties owed to the legal system by operating illegally or improperly as officers of the court; and violate duties owed to the profession by unauthorized practice and failing to maintain the integrity of the profession. ABA Standards at 5-6. The evidence adduced in this case shows that Respondent failed to act with candor towards his clients, failed to exhibit the highest standards of honesty and integrity, operated improperly as

an officer of the court,²⁹ and engaged in unauthorized practice, thereby diminishing public confidence in the profession and bringing it into disrepute. Specifically, he held himself out to his private clients, the public, and the USPTO as authorized to file patent applications on behalf of private citizens, and he filed such applications despite not being authorized to do so by virtue of the Conflict of Interest Statutes and USPTO Code and Rules. As such, he violated the duties he owed to his clients, the public, the legal system, and the profession. *Quod erat demonstrandum*. See *Ruffenach*, 486 N.W. 2d at 391 (“Honesty and integrity are chief among the virtues the public has a right to expect of lawyers. Any breach of that trust is misconduct of the highest order and warrants severe discipline.”); *In re Lawrence*, 884 So. 2d 561 (La. 2004) (attorney’s false representation violated rule regardless of intent or motive); *State ex rel. Special Counsel v. Shapiro*, 665 N.W.2d 615 (Neb. 2003) (misrepresentation does not require proof of intent to deceive or defraud); *Disciplinary Counsel v. McCord*, 905 N.E.2d 1182 (Ohio 2009) (lawyer’s misleading violated rules even if he did not intend to deceive public); *In re Dann*, 960 P.2d 416 (Wash. 1998) (motive is irrelevant in determining violation; “the question is whether the attorney lied”); *Jaeger*, PTO Proceeding No. D2012-29, slip op. at 13 (Feb. 6, 2013) (Initial Decision) (“Attorneys who practice before the PTO are expected to ‘assist in maintaining the integrity and competence of the legal profession’ and aid in the prevention of the unauthorized practice of law.”); *State Bar of Okl. v. Retail Credit Ass’n*, 37 P.2d 954, 957 (Ok. 1934) (unauthorized practice threatens public confidence and “strongly tends to discredit and bring into disrepute . . . the practice of law and the administration of justice”). In so finding, I reject Respondent’s proposition that the evidence does not establish that he violated duties owed to his clients, the public, the legal system, and the profession because the Agency offered no direct proof that he “undermine[d] the public’s confidence in subsequent patent or trademark registrations” or “decrease[d] the public’s confidence in the integrity of the profession of patent practitioners.” RIB at 7, 8; RRB at 12; *Moatz v. Kersey*, 67 U.S.P.Q.2d 1291 (T.T.A.B. 2002) (holding that “[v]iolations of Federal conflict of interest rules covering all Federal employees . . . negatively impact[s] the integrity of the legal profession” and that direct proof of negative impact is unnecessary).

In addition, I find no merit to Respondent’s defensive claim that he violated no owed duties because he was merely a “private citizen” at the time he submitted the violative filings to the USPTO. RIB at 7. A “private citizen” is defined as “one whose duties are not related to or dependent on one’s official position.” *State v. Laughlin*, 10 Ohio Misc. 219, 223 (Com. Pl. 1966) (holding that because “a prosecuting attorney is charged by law with the performance of certain duties before a Magistrate and in County Courts, he could not be considered a private citizen in regard to any of such duties.”). While it is true that Respondent did not represent the federal government in prosecuting the applications before the USPTO on behalf of private clients, he was registered as a patent attorney before the USPTO, and as such, held a position making him subject to the USPTO Code and Rules. Thus, the remedy for his professional violations fall within the purview of this public disciplinary proceeding, not simply in a private proceeding between citizens. *Renfroe v. Jones & Assocs.*, 947 S.W.2d 285, 287 (Tex. App. 1997) (If an attorney’s conduct violates his professional responsibility, the remedy is public, not private); *Matter of Cushing*, 646 N.E.2d 662, 664 (Ind. 1995) (attempted unauthorized practice in jurisdiction violates duty of diligence owed to client).

²⁹ As a licensed attorney, registered to practice before the USPTO, Respondent was analogous to an “officer of the court” in a federal or state jurisdiction. *People v. Bode*, 119 P.3d 1098, 1100 (Colo. O.P.D.J. 2005) (for disciplinary purposes, “a federal agency such as the PTO can be considered a ‘jurisdiction’”).

Respondent's violative conduct was intentionally undertaken.³⁰ Acting "intentionally" occurs "when the lawyer acts with the conscious objective or purpose to accomplish a particular result." ABA Standards at 6. This mental state is to be contrasted with acting "knowingly," which occurs when a lawyer "acts with conscious awareness of the nature or attendant circumstances" of the conduct but "without the conscious objective or purpose to accomplish a particular result," or acting "negligently," which is "when a lawyer fails to be aware of a substantial risk that circumstances exist or that a result will follow, which failure is a deviation from the standard of care that a reasonable lawyer would exercise in the situation." ABA Standards at 6. The Director has characterized Respondent's conduct as knowing, rather than negligent, based largely upon the fact that Respondent was placed on notice that he was not permitted to represent private clients as a federal government employee by the 2003 Survey, Mr. Kasischke, the RFIs, and the pleadings in this action. DRB at 3 (citing JX 3 at 1; JX 21 at 16-17, 22, 29-30). Further, the Director implicitly characterizes Respondent's conduct as knowing rather than intentional by accepting that in response to such notice, Respondent "stuck his head in the sand" and undertook no research himself nor sought guidance from others as to whether it would be ethical for him to engage in private practice before the USPTO while employed by the federal government. DIB at 25-26; DRB at 3-4.

In this proceeding, Respondent suggests his conduct was undertaken innocently, or at most negligently, claiming that "until this proceeding started," "it never occurred to me that it would be a conflict" to continue his private law practice while a federal government employee, explaining that in his mind "at no time did I have a conflict of interest, real or apparent. It was just two separate jobs, and that's it." Tr. 48, 55, 57; DIB Stip. 8. He further suggests that after the OED investigation and/or this litigation began, he was still acting in good faith when he continued his private practice because he believed his conduct was protected by the First Amendment.

I cannot credit Respondent's arguments. First, as the Director observes, the various events, including completion of the 2003 Survey and Mr. Kasischke's warning, seen in the best light possible, should have, at the very least, raised red flags and been inflection points causing Respondent to inquire into the propriety of his actions. Had Respondent, an attorney, undertaken even the most cursory research of the issue by, for example, reviewing 18 U.S.C.A. § 203, he would have found under annotations thereto reference to the 1949 Attorney General Opinion holding that participation in patent proceedings by government employees for compensation on behalf of private parties is prohibited. 18 U.S.C.A. § 203 (Notes of Decisions §17 (citing 1949, 41 Op. Atty. Gen., July 18)). Alternatively, Respondent could have utilized the free ethics counseling available to him as a government employee and USPTO practitioner and received professional and reliable guidance as to the restrictions imposed upon him.

Second, the footings of Respondent's First Amendment argument appear to be mostly girded by his own unique interpretation of the amendment or broad sweeping statements of its import, rather than narrowly drawn potentially binding legal precedent as would be consistent with his legal training and technical acumen. RRB at 4-12. Respondent faces discipline not for

³⁰ At times prior to this point in the proceeding, Respondent's mental culpability has been described as "knowing." See, e.g., SJ Order at 12. But having received the benefit of additional evidence at hearing, I find it appropriate for purposes of sanction determination to characterize and treat his actions as "intentional."

engaging in protected expression or association, but because he has run afoul of the USPTO's regulations for practicing law before it by not abiding by its rules of ethics. The USPTO has a compelling interest in regulating the attorneys who appear before it, and "[a]ny abridgment of the right to free speech is merely the incidental effect of observing an otherwise legitimate regulation." *Lawline v. American Bar Ass'n*, 956 F.2d 1378, 1386 (7th Cir. 1992). See also *Ohralik v. Ohio State Bar Ass'n*, 436 U.S. 447, 459, 467-68 (1978) (Professional regulation is not invalid, nor is it subject to first amendment strict scrutiny, merely because it restricts some kinds of speech.); *In re Smith*, 123 F. Supp. 2d 351, 359 (N.D. Tex. 2000) (rejecting attorney's First Amendment argument and holding that Tenth Circuit's "interest in maintaining the integrity of the judicial process" by disciplining its attorneys "outweighs any supposed infringement of First Amendment rights"); *Harris v. Quinn*, 134 S. Ct. 2618 (2014) (public employee speech is unprotected if it is not on a matter of public concern); *Fort Wayne Patrolmen's Ben. Ass'n, Inc. v. City of Fort Wayne*, 625 F. Supp. 722, 728 (N.D. Ind. 1986) (First Amendment right to associate with outside employers in the context of part-time employment is not designed to protect employer-employee relationships); *NAACP v. Alabama*, 357 U.S. 449 (1958) (protected freedom of association involves association for the purpose of expression and belief); *Wolfe v. Barnhart*, 354 F. Supp. 2d 1226, 1243-44 (N.D. Okla. 2004), *aff'd*, 446 F.3d 1096 (10th Cir. 2006) (Agency ethics regulation prohibiting Administrative Law Judge from receiving compensation for writing book related to official duties did not impose an impermissible restriction on First Amendment rights); *Deretich v. Office of Admin. Hearings, State of Minn.*, 798 F.2d 1147, 1152 (8th Cir. 1986) (upholding ethics prohibition on state employees acting as an attorney in any matter pending before the employing agency as not violative of associational freedom); *Decker v. City of Hampton, Va.*, 741 F. Supp. 1223 (E.D. Va. 1990) (upholding city restriction on police officers' off-duty work as rationally related to state's legitimate interests in avoiding conflicts of interest and ensuring that off-duty employment activities of police officers did not bring police department into disrepute); *Gosney v. Sonora Indep. Sch. Dist.*, 603 F.2d 522, 525-26 (5th Cir. 1979) (upholding as constitutional school district policy proscribing all "outside employment" as rationally related to the legitimate state interest in assuring that public school employees devote their professional energies to the education of children) (*citing Williamson v. Lee Optical of Oklahoma*, 348 U.S. 483, 487-88 (1955)); *Matal v. Tam*, 137 S. Ct. 1744 (2017) (owner of trademark holds the first amendment right of free speech, not the attorney who assists the applicant in filing a trademark application; an attorney has no first amendment right to represent a client before a tribunal or to file an application or advocate on behalf of someone else); *In re Primus*, 436 U.S. 412, 422 (1978) (an attorney does not have a First Amendment right to conduct any particular representation); *Mezibov v. Allen*, 411 F.3d 712, 720-21 (6th Cir. 2005) (an attorney has no personal First Amendment rights to represent client in proceedings); *Kersey v. Undersecretary of Commerce for Intellectual Prop.*, No. CIV.A. 02-2331 (GK), 2005 WL 486144, at *2 (D.D.C. Jan. 31, 2005), *aff'd sub nom. Kersey v. Under Sec'y of Commerce for Intellectual Prop.*, 221 F. App'x 997 (Fed. Cir. 2007) (USPTO Practitioner sanctioned for engaging in private practice while a government employee).

In light of the clearly accessible Attorney General's Opinion and OGE letters interpreting the Conflict of Interest Statutes in a manner unfavorable to Respondent, and given the substantial caselaw undermining Respondent's First Amendment defense, it is apparent that he either willfully blinded himself to the import thereof on his conduct or he knew that they applied to him and consciously ignored them to pursue his private practice. After considering Respondent's testimony at hearing in conjunction with the positions he has taken throughout this proceeding, I

simply do not find credible his claim to genuinely believe that his actions were in accordance with the law.

Moreover, I give no import to Respondent's argument alleging that neither the Manual of Patent Examining Procedure (MPEP) or the Trademark Manual of Examining Procedure (TMPEP) mentions that the identity of the applicant or the applicant's representative is a factor in either allowing or not allowing an application. RIB at 8-9 (citing Tr. 56). Respondent did not offer either of those documents at hearing, nor request this Tribunal take administrative notice of them, and thus no inference can rightfully be drawn here from them. I am also unpersuaded by Respondent's claim that his lack of notice and good faith is proven by his engagement in public advertising. Many people who are engaging in improper conduct do so openly, with the expectation that the impropriety lying discretely beneath the public acts will not be recognized and/or reported to those in authority to act.

I also reject the Director's characterization of Respondent's conduct as merely undertaken "knowingly." As indicated above, acting "knowingly" would require a finding that Respondent acted "without the conscious objective or purpose to accomplish a particular result." The record here does not support such a conclusion. In this case, Respondent was explicitly warned in 2003 by the USPTO Survey, and then a year or two later by Mr. Kasischke, that he was prohibited from filing applications before the USPTO on behalf of private clients while a government employee. JX 3 at 1; JX 21 at 16-19. If Respondent truly believed that the USPTO and/or Mr. Kasischke warnings were in error, he could have challenged the warnings and sought clarification from ethics officials in his own agency, the USPTO, or even OGE, as the employee in the OGE Letter had done. Instead, he ignored the USPTO warning, and then lied to Mr. Kasischke, telling him he had not filed such applications in the past when, in fact, he had, and then proceeded unabated to file applications over the next decade. JX 21 at 19; JX 14; JX 19, 20. Moreover, when Respondent's employee status required him to file an OGE 450 form and mandated that he obtain OGC approval for his outside activities, regardless of whether he thought them prohibited or conflicting with his government position, he did not. To me, this evidences a clear consciousness of guilt. Respondent even continued filing applications after the USPTO started an investigation and again warned him four times in writing that such filings were prohibited. JX 19, 20. And he kept filing after the Complaint was issued and while this Tribunal was rejecting his arguments in defense. Stips. 15-18. All of this is clearly indicative that he acted "with the conscious objective or purpose to accomplish a particular result." Therefore, I find for the purposes of determining the penalty in this case that Respondent acted "intentionally."³¹

Respondent's misconduct caused injury. The parties appear to agree that Respondent's conduct caused no injury, and there is no evidence that any of the applications he drafted and filed with

³¹ Although I find Respondent's conduct to be intentional, I exercise my discretion and reject the Director's suggestion that the factor of "illegal conduct" should be considered in aggravation here. The Respondent advises in his post-hearing brief that presently DOD/NUWC is conducting a "corresponding" investigation into the propriety of his conduct that will likely directly address whether he violated 18 U.S.C. §§ 203 and 205 and whether a referral to the Department of Justice is appropriate. RIB at 4. As such, it is inappropriate for this Tribunal to make a finding as to whether Respondent's conduct rises to the level of criminality on the limited record here while that issue is being investigated and determined by another Agency.

the USPTO were substandard, that any client claimed to be aggrieved by his services, or that there was a specific conflict of interest between the subject matter of a private client and that of the government. RIB at 9. Nevertheless, Respondent admitted at hearing that he never informed any of his private clients that he was a federal government employee, which suggests to me that he deprived them of the opportunity to determine for themselves whether he was prohibited from representing them and charging them for his legal services. Tr. 54; DIB Stip. 54. I find this omission injurious to Respondent's clients as they are entitled to have their interests placed above that of their attorney, with whom they have a fiduciary relationship –

The attorney-client relationship constitutes a fiduciary relationship as a matter of law. As fiduciaries, attorneys owe to their clients “the basic obligations of agency: loyalty and obedience.” When, in the course of his professional dealings with a client, an attorney places personal interests above the interests of the client, the attorney is in breach of his fiduciary duty by reason of the conflict, and this is because, in that scenario, the attorney, as an agent of the client, has violated his/her duty “to act solely for the benefit of the principal in all matters connected with his agency.”

In re Carr, 584 B.R. 268, 279 (Bankr. N.D. Ill. 2018) (citations omitted) (*quoting In re Winthrop*, 848 N.E.2d 961 (Ill. 2006)); *see also Horwitz v. Holabird & Root*, 816 N.E.2d 272, 277 (Ill. 2004); RESTATEMENT (SECOND) OF AGENCY § 14N cmt. a, at 80, § 387 (1958); *Doe v. Roe*, 681 N.E.2d 640, 645 (Ill. 1997). Moreover, more tangibly, Respondent's clients arguably wrongly paid him for legal services for which they should not have had to pay, as he was not authorized to provide such services, causing them to suffer financial injury. *Vista Designs, Inc. v. Silverman*, 774 So. 2d 884, 888 (Fla. Dist. Ct. App. 2001) (patent attorney not entitled to fees for services provided in state where he was unlicensed and not involving practice before the USPTO); *Morrison v. West*, 30 So. 3d 561 (Fla. Dist. Ct. App. 2010) (Attorney not licensed to practice law in jurisdiction was not entitled to collect his fee as it violated public policy for a court to award a fee for the unlicensed practice of law); *Bedell v. Marshall*, 508 So.2d 574 (Fla. 4th DCA 1987) (unlicensed real estate agent contract is void and fees may not be collected). Respondent's violative acts also potentially created bases for infringers to challenge the validity of the intellectual property protection his clients obtained by virtue of the applications he filed on their behalf. *See Torrey v. Leesburg Reg'l Med. Ctr.*, 769 So.2d 1040, 1043 (Fla. 2000) (holding pleadings filed by a non-lawyer on behalf of another are a nullity as a product of the policy against the unauthorized practice of law); *Abbott Labs. v. Andrx Pharm., Inc.*, 241 F.R.D. 480, 487 (N.D. Ill. 2007) (inequitable conduct is a defense that may render a patent unenforceable where a patent applicant intentionally breached its “duty of candor and good faith” to the PTO). In addition, Respondent's violative conduct likely caused actual economic injury to other competing registered patent practitioners who were lawfully entitled to provide the same services and charge and collect fees therefor.

Applicable Aggravating Factors

I find that there are six aggravating factors to be taken into account in determining the appropriate penalty in this case: (1) a selfish motive (financial gain); (2) a pattern of misconduct; (3) multiple offenses; (4) refusal to acknowledge wrongful nature of conduct; (5) substantial experience in the practice of law; and (6) false statements during the disciplinary process.

Selfish Motive. There is no dispute that Respondent charged and received financial compensation from private clients for filing and prosecuting hundreds of applications on their behalf before the USPTO. Tr. 39; DIB Stip. 47. Based upon USPTO records reflecting only the numbers and types of applications filed by Respondent for others and Respondent's testimony at hearing as to the fees he routinely charged for preparing such applications, the Director conservatively calculated that Respondent's gross income resulting from the provision of such services between January 17, 2008, when the statute of limitations began to run, and October 25, 2017, when the Director's investigation ended, as being approximately \$550,000.³² DIB at 29-32. In retort, Respondent declares in his initial brief that a selfish motive is defined as "devoted to or caring only for oneself; concerned primarily with one's own interests, benefits, welfare, etc., regardless of others." RIB at 10. He insists that he was merely being compensated for services rendered for helping inventors to file applications and that such acts are "anything but selfish." RIB at 10. Moreover, he argues that OED's calculations are erroneous, alleging that he incurred numerous expenses in connection with his part-time business, that his tax records reflect that he suffered net losses in numerous years between 2006 and 2018, and that cumulatively he netted only \$33,000 in taxable income from the business over the 12 years.³³ RIB at 5. He characterizes this amount as "[h]ardly indicative of massive greed." RIB at 5.

Regardless of the actual amount, gross or net, Respondent earned from his private practice, there is no evidence supporting a claim that he was engaged in such business as a philanthropic or pro bono endeavor. To the contrary, Respondent's part-time business activities were clearly a for-profit business, and he was the profiteer. As the Director notes in his reply brief, "[m]ultiple courts have found that respondents had a selfish motive in cases involving lawyers who acted with motivation to secure a financial advantage." DIB at 29 (citing, *inter alia*, *People v. Calvert*, 280 P.3d 1269 (Colo. O.P.D.J. 2011); *Office of Disciplinary Counsel v. Au*, 113 P.3d 203 (Haw. 2005)). I find that Respondent had such a selfish motive for his violative conduct here.

Pattern of Misconduct. Again, it is undisputed that over the course of more than a decade, despite multiple intermittent warnings, Respondent filed hundreds of applications for private clients with the USPTO. JX 19, 20; Stips. 13, 14. He even continued such activities after being told by OED he was under investigation for his conduct and after the Complaint was filed in this case. Stips. 15-18; DX 32-35. Respondent attempts to militate against a finding of a pattern of misconduct by suggesting that because he honestly completed the 2003 Survey in

³² For this period, which represents less than the full time period at issue in this case, the Director more specifically calculated that Respondent earned from his private practice between \$553,700 and \$655,900. DIB at 39. OED further indicated that these gross income figures did not take into account the following: (1) any services, such as patent searches, Respondent undertook for clients but which did otherwise result in an application being filed by Respondent on the client's behalf; (2) hourly fees charged by Respondent for "follow-on" services; or (3) services provided by Respondent after the OED investigation ended but before his federal retirement occurred approximately one year later. DIB at 29-32; Tr. 57.

³³ As the Director notes in his Reply Brief, Respondent neither offered any tax records into evidence at hearing, nor testified to any business expenses. DRB at 12-13. Moreover, OED observes Respondent withheld from the Director information on his business expenses before the hearing by responding to an inquiry for tax returns in the July 17, 2017 RFI with tax transcripts for only 2013, 2014, 2015, and 2016, with "all financial figures redacted." DRB at 12; JX 12 at 5-24. As such, it is inappropriate, if not impossible, for this Tribunal to give any weight to Respondent's claim as to his net income from his private practice.

which he disclosed he was a federal employee *and* identified his personal business by name and address, he was justified in continuing his activities and relying upon a lack of an alert from the Agency. RIB at 10. However, he fails to delineate how the Agency would be on notice that he was practicing patent law merely from the Survey form, as his business name and address alone, “Correll and Associates LLP,” does not reveal that Respondent could not have been engaged in some other type of part-time business. Furthermore, he also does not cite any authority for the proposition that completing the Survey triggered an obligation on the part of the USPTO to search out and notify practitioners of potential violations. To the extent OED had any duty to warn federal employee practitioners of the of the private practice prohibition, the language of the Survey from question 6 certainly fulfilled that obligation.

I am also not persuaded by Respondent’s argument that he continued to engage in private practice during the pendency of this case merely to preserve the “status quo” until his “Constitutional counter claims” were “fully adjudicated,” as authorized by *Freedman v. Maryland*, 380 U.S. 51 (1965). RIB at 10-11. *Freedman* involved an advance restraint on speech, specifically a state statute requiring submission of a film for review prior to exhibition. 380 U.S. at 51. The Supreme Court held in that case that “[a]ny restraint imposed in advance of a final judicial determination on the merits must similarly be limited to preservation of the status quo for the shortest fixed period compatible with sound judicial resolution” and “the procedure must also assure a prompt final judicial decision, to minimize the deterrent effect of an interim and possibly erroneous denial of a license.” 380 U.S. at 57. Thus, the case held the status quo *prohibiting* the prior restraint on the First Amendment right to free speech was lawfully permitted, not that on-going “speech,” the presentation of the film, could continue through final adjudication of its propriety. As such, *Freedman* does not support Respondent continuing to engage in conduct he claims as protected speech until this case is adjudicated in federal court. Rather, he maintained the status quo of filing applications during the pendency of this case in violation of the USPTO Rules at his own risk.

Moreover, equally hollow is Respondent’s plaintive assertion that “were [he] to withdraw from patent and trademark practice without some judicial adjudication of the issues presented to the OED then the OED complainant could, and most likely would, interpret such withdrawal as admission that the OED complainant position is valid.” RIB at 11. Parties engaged in legal disputes routinely undertake an action with the express caveat that it is being done without an admission of wrongdoing. *See e.g. Wright v. Williams-Sonoma Stores, Inc.*, 2010 WL 8032665 (CA Sup Ct 2010) (parties agreed that neither agreement nor action “may be construed as or may be used as, an admission . . . as to the merits or lack thereof of the claims asserted. . .”). A version of this principle is even enshrined in the Federal Rules of Evidence, which limits the admissibility of evidence that a party has taken steps to correct an identified harm. *See Fed. R. Evid.* 407. But here, Respondent has not shown that he offered to cease filing applications during the litigation of this case with the caveat that he was not admitting wrongdoing and that the OED rejected his offer. Therefore, his claim that he had to continue his misconduct to avoid a legal admission is unsubstantiated.

Based upon all the foregoing, I find the evidence demonstrates repeated instances of similar misconduct, evidencing the aggravating factor of “a pattern of misconduct.” ABA Standards at 17 (§ 9.22(c)); *In re Guttlein*, 378 F. App’x 24, 36 (2d Cir. 2010) (failing to comply with scheduling orders for 3-4 years evidences “pattern of misconduct”); *In re Kestenband*, 366 F. App’x 305, 319 (2d Cir. 2010) (failing to meet deadlines or failing to apply for an extension

before the deadlines have passed is an aggravating circumstance under ABA Standard § 9.22(c)); *People v. Larsen*, 808 P.2d 1265, 1268 (Colo. 1991) (prosecutor failing to report spouse and a friend for drug possession is a “pattern of misconduct”); *In re Gines*, 869 So. 2d 778, 782-83 (La. 2004) (lawyer’s neglect of various client matters demonstrates aggravating factor of pattern of misconduct).

Multiple offenses. The record clearly evidences that Respondent’s actions constituted “multiple offenses,” both in terms of the number of different USPTO Code and Rule provisions violated (nine) as well as repeated violations of the same provisions through the number of applications filed with the USPTO in the more than 10 years prior to the Complaint being filed. As such, Respondent’s commission of multiple offenses can be considered an aggravating factor in determining the penalty. *See Ala. State Bar v. Hallett*, 26 So.3d 1127 (Ala. 2009) (lawyer’s multiple violations of professional misconduct rules supported finding of multiple offenses as aggravating factor under ABA standards). Nevertheless, this Tribunal observes that all the violations essentially arise from the same unlawful activity, Respondent’s private practice of law before the USPTO while a government employee. As such, the aggravation impact of this factor is minimal.

Refusal to Acknowledge Wrongful Nature of Conduct. Regretfully, throughout this proceeding, Respondent has emphatically refused to acknowledge any wrongdoing. Even after the SJ Order found him liable for most of the alleged violations, Respondent’s position remains that he “does not yet know for certain that his conduct is wrongful, and won’t really know until the First Amendment issues raised by the Respondent are fully adjudicated in Federal Court.” RIB at 11. Respondent’s refusal to accept the error of his ways despite the warnings received, the long-standing and extensive legal authority contradicting his position, and this Tribunal’s decision is very concerning. It reflects arrogance, obstinance, and insolence, and strongly forecasts that Respondent may violate the ethical rules again based solely on his own self-serving interpretation of right and wrong. As such, his refusal to acknowledge his wrongdoing is a strong factor in aggravation of the penalty to be imposed. *See, e.g., In re Stein*, 177 P.3d 513, 529 (N.M. 2008) (disbarment warranted with aggravating factor under ABA Standard 9.22(g) for lawyer who maintained he did nothing wrong but evidence established repeated knowing and intentional misconduct relating to conflicts of interest and misrepresentations; the court noted that “[i]n light of what Respondent knew and what he intentionally did, it is, to say the least, troubling that he steadfastly maintained that he has acted ethically”); *Bar v. Germain*, 957 So. 2d 613, 622 (Fla. 2007) (court approved application of aggravating factor under ABA Standard 9.22(g) when lawyer stipulated to most of the facts yet continued to assert that his actions did not constitute unethical conduct; the court stated that “[t]hese are legal issues. With a minimum of legal research, [respondent] could have discovered that his conduct did constitute unethical conduct and either curtailed his activities or avoided them altogether”). Here, it is indeed troubling that Respondent has maintained that he has done nothing wrong, particularly given the weight of easily discoverable legal precedent that contradicts his position.

Substantial experience in the practice of law. Respondent has been a registered practitioner before the USPTO for more than 18 years and a licensed attorney for 20 years. Stips. 1, 3; DIB Stips. 1-3. As the Director observes, a lawyer with such lengthy experience “should know better than to engage in misconduct.” DIB at 37; see also *Flindt*, PTO Proceeding No. D2016-04, slip op. at 55 (Aug. 4, 2017) (Initial Decision) (finding as an aggravating factor practitioner’s substantial experience in the practice of law with 18 years of experience); *In re*

Disciplinary Proceedings Against Theobald, 786 N.W.2d 834 (Wis. 2010) (practicing law for 14 years found to be aggravating factor in determining sanction for attorney for failing to act with reasonable diligence and promptness in representing bankruptcy client and failing to communicate with client after dismissal of bankruptcy petition). Respondent’s rejoinder characterizes OED’s designation of his experience as an aggravating factor as “duplicitousness.” RIB at 11. “On one hand the OED is claiming pattern of misconduct and multiple offenses spread over years, but then says those same years give rise to sage experience that should have informed the Respondent of his misconduct,” he laments. RIB at 11. However, it is not actually incongruous for an attorney to commit violations even though he is an experienced practitioner who *should know* better. Rather, it is suggestive that the violations were likely knowingly or intentionally committed rather than innocently or negligently, and more negatively reflects on the integrity of the legal profession.

False statements. As the last aggravating factor, the Director suggests that Respondent is “not credible” in that he has made “multiple misrepresentations to the public, OED and this Tribunal.” DIB at 19-20, 34-36 (citing ABA Standards § 9.22(f); *Idaho State Bar v. Malmin*, 78 P.3d 371 (Idaho 2003) (evidence supported findings that lawyer knowingly made false statement in connection with disciplinary proceeding when she provided state bar with three varying accounts over the course of the investigation to account for delay in filing money judgment papers on behalf of divorce client); *Att’y Grievance Comm’n v. Dominguez*, 47 A.3d 975, 985 (Md. 2012) (lawyer’s false statements to disciplinary counsel that she was never assigned to handle a homeless person’s expungement case as a volunteer pro bono attorney despite entering into a pro bono retainer agreement with the client “clearly implicates factor (f)” of Standard 9.22); *In re Solny*, 96 A.D.3d 76 (N.Y. App. Div. 2012) (in imposing two year suspension, court considered in aggravation lawyer’s false testimony in disciplinary proceeding that he had permission to transfer \$600,000 of his uncle’s money just weeks before his uncle’s death)). In support of his claim, the Director cites the following evidence:

- 1) In his original and Amended Notice of Proposed Hearing Location, both filed on November 16, 2018, Respondent represented to this Tribunal that he “separate[ed] from government services as a result of the Tribunal’s September 27, 2018 order.” DIB at 19, 34 (citing DIB Stips. 65, 66). However, Respondent’s retirement from the Navy was initiated on September 4, 2018, 23 days *prior to* the Tribunal’s Order being issued.³⁴ DIB at 19-20, 34 (citing DIB Stip. 60);
- 2) Despite calling his firm K.P. Correll & Associates, Respondent has never had an associate, or another lawyer associated with his firm.³⁵ DIB at 19 (citing Stip. 9; JX 8 at 1; JX 10 at 1; Tr. 30-31; DIB Stip. 9).

³⁴ In clarification, Respondent testified at hearing that his retirement was prompted by this Tribunal’s Order of August 16, 2018 denying his second motion to dismiss on statute of limitations grounds. Tr. 48. “Once your August ruling came out, I suspected your final ruling would not be for me, and based on that, then I initiated my retirement.” Tr. 48. Nevertheless, because of the clear inconsistency between the timeline and the unequivocal statements Respondent made to the Tribunal in his hearing location notices as to the reason for his retirement, I reject Respondent’s suggestion that the Director’s characterizations made in regard thereto are false and/or represents “contemptable” conduct which should be “sanctioned.” RIB at 4.

³⁵ At hearing, Respondent justified his use of the appellation, stating that “I was looking for associates.” Tr. 30.

- 3) Respondent falsely informed Mr. Kasischke that he was not filing patent applications for private clients with the USPTO, when he was filing such applications. DIB at 19 (citing JX 21 at 19; DIB Stips. 16, 40-46);
- 4) Although for many years he served on the IEB, reviewing invention disclosures and voting as to whether NUWC should seek patent protection for them, Respondent represented to the OED that “[a]t no time has there been any overlap between my government position as an engineer for the Navy and my private work as a patent attorney . . . nor is there any connection between my Navy position as an engineer and the USPTO.” DIB at 19 (quoting JX 8 at 1-2 and citing JX 10 at 5; DIB Stips. 23, 33-36);
- 5) Respondent represented to the OED that he had “resigned” from the IEB when in fact he left the Board involuntarily after he had been informed by Dr. Baus that he could no longer participate because he was representing private clients in front of the USPTO while employed by the federal government. DIB at 19 (citing DIB Stips. 36-37; Tr. 30; JX 13 at 5);
- 6) Respondent has consistently argued, both before and after this Tribunal’s September 27, 2018 Order, that he is not violating 18 U.S.C. §§ 203 and 205. DIB at 20 (citing DIB Stips. 22, 26, 29, 32);
- 7) Although Respondent served on the IEB and was aware that base employees must have their inventions pre-evaluated before filing for patent protection to make sure the federal government does not own the invention, Respondent did not submit his own two inventions to the Patent Counsel’s Office and/or the IEB for evaluation.³⁶ DIB at 20 (citing DIB Stips. 33-35, 38, 39; JX 17 at 3; JX 14 at 2; JX 15 at 2; JX 17 at 3).

It is the responsibility of this Tribunal as the factfinder to determine the credibility of witnesses and weight of the evidence. *United States v. Wright*, 428 F.2d 445, 446 (8th Cir. 1970); *United States v. Libous*, 645 F. App’x 78, 79 (2d Cir. 2016) (citing *United States v. LaSpina*, 299 F.3d 165, 180 (2d Cir. 2002)). In assessing the credibility of a witness, I consider “the appropriate factors for judging credibility,” including the following:

the demeanor of the witnesses, any interests, bias, or prejudice the witnesses may have, the opportunity of the witnesses to see, hear, know or remember the facts or occurrences about which the witnesses testified, whether the testimony of the witnesses is reasonable, and whether the testimony is consistent with all other believable evidence in the case.

R.S. v. Bd. of Directors of Woods Charter Sch. Co., No. 1:16-CV-119, 2019 WL 1025930, at *5 (M.D.N.C. Mar. 4, 2019). Further, as the fact-finder, I am “free to believe part and disbelieve

³⁶ Mr. Kasischke testified that after this matter arose, he reviewed Respondent’s patents and spoke with Respondent’s supervisor and found the inventions to be something the government had no interest in and unrelated to his government work activities. JX 21 at 23-24.

part of a [respondent's] trial testimony.” *Libous*, 645 F. App'x at 79 (citing *United States v. Norman*, 776 F.3d 67, 77 (2d Cir. 2015)).

I agree with the Director that there is a persistent scent of mendacity on the part of Respondent which taints this case. Besides the various points mentioned above, there is also Respondent's incredible assertion that he believed in “good faith” for some 16 years that he was given sufficient authorization by the government to engage in outside work activities via a single brief unprompted conversation with his supervisor, shortly after beginning work, even though his superior was neither an attorney nor a designated ethics officer. Tr. 47-48, 54, 57; RIB at 8. It is noted that Respondent offered no records memorializing this significant conversation nor did he call Mr. Watt as a witness in this proceeding or explain his absence, leaving Respondent's self-serving testimony as to the conversation totally uncorroborated. In addition, Respondent repeatedly claimed at hearing that that he could not recall Mr. Kasischke's subsequent conversation with him about engaging in private practice as a federal employee, after having no trouble recalling the substance of his *prior* conversation with Mr. Watt on the same topic. Tr. 23-24, 27-28. There is also the broad, dubious claim made by Respondent that despite undergoing yearly ethics training, completing an OGE 450 disclosure, sitting on the IEB, as well as receiving specific warnings from the 2003 USPTO Survey and Mr. Kasischke, for 16 years he never once realized that his outside work activities might create a conflict of interest and be prohibited, such that he should perhaps, simply as a matter of caution, inquire of ethics counsel. Tr. 57. Respondent proffered this claim even though he admitted to being aware that filers of OGE 450 forms were required to obtain written permission for outside work activities; that in 2008 he was an OGE 450 filer; and that he did not obtain such permission for his outside activities. Tr. 57; JX 10 at 3 and n.11-12; RIB at 8.

Moreover, Respondent testified that he never advised any of his patent clients that he was a government employee, a persistent withholding of commonly exchanged social information that seems inconsistent with his claim that he felt his private practice was authorized and that he performed his private practice work on nights, weekends, and when he was on leave from his government position. Tr. 54. Respondent cast himself to the OED in his RFI responses as a “low grade GS 13 Engineer,” but at hearing indicated that he started his position under Mr. Watt as a “branch chief,” and by 2017, he was in a supervisor role as Chief Technology Officer, an ND 5, earning over \$133,000. JX 8 at 1-2; Tr. 54; JX 14 at 1; DX 20. Respondent stated in this proceeding that he received no response to the legal memoranda he submitted to OED with his RFIs, or to his offer to resign his government position, but the record evidences that OED did respond and provided him with copies of various relevant case decisions and OGE opinions evidencing the error of his legal analysis. RIB at 11; RRB at 20; JX 11 at 11-37; JX 11 at 4 (OED asks Respondent to square his current position with his acknowledgement on the 2003 Survey that government attorneys may not engage in private practice and the prohibition on accepting compensation as well as whether he has begun terminating his law practice or separating from the government). Finally, there is Respondent's claim in this proceeding, unsupported by any documentation, that he only netted \$34,000 in income from his private practice over 12 years, although the Director conservatively calculated Respondent's *gross* income from filing some 250+ USPTO applications as \$550,000. Such a vast discrepancy is difficult to reconcile based on mere normal business expenses, especially as Respondent had no staff and his offices consisted only of a client meeting room. RIB at 5.

All in all, considering his demeanor as well as the lack of detail and pithy explanations he provided, Respondent's testimony in this proceeding does not seem logical, reasonable or credible. *See United States v. Blagojevich*, 614 F.3d 287, 290 (7th Cir.2010) ("Neither juries nor judges are required to divorce themselves of common sense, but rather should apply to facts which they find proven such reasonable inferences as are justified in light of their experience as to the natural inclinations of human beings."); *see also Jackson v. United States*, 353 F.2d 862, 866 (D.C. Cir. 1965)(A number of other factors often considered in judging credibility must be examined, such as whether the witness was interested in the outcome, his reputation, his degree of recall, the internal inconsistencies in his testimony, and the likelihood of his story); *Kramer v. Am. Bank & Tr. Co., N.A.*, 989 F. Supp. 2d 709, 722 (N.D. Ill. 2013) (A judge need not leave experience and common sense at the courthouse door).

Based upon the foregoing findings, I find that there is a basis for considering "false statements" as a factor in aggravation of the penalty.

Applicable Mitigation Factors

Absence of a prior disciplinary record. Respondent has no prior disciplinary proceeding over a rather lengthy career. RIB at 12; RRB at 21. This absence further suggests that Respondent's clients were satisfied with the quality of his legal work and conduct in regard thereto. In light of the number of his private clients for whom he did work, while a full-time government employee, this is a substantial factor in mitigation of the penalty.

Rectifying misconduct/imposition of other sanctions. Respondent claims that he voluntarily separated from government service "at significant financial loss" in response to this Tribunal's rejection of his defenses in this case. RIB at 12; RRB at 22. However, Mr. Kasischke testified that he reported Respondent to NUWC once he discovered he was engaged in private law practice in contravention of 18 U.S.C. §§ 203 and 205, which are criminal statutes. JX 21 at 20. Further, Respondent admits that prior to his retirement, NUWC investigated the allegations and issued an "interim report" recommending it be "used negatively in consideration of any future application for a security clearance," which was a requirement of employment in his position.³⁷ RIB at 5; RRB at 15; Tr. at 49-50. Taken together, these facts, plus his age of 63, suggest that Respondent potentially had reasons, other than this Tribunal's orders, for retiring from his federal position. As such, his voluntary retirement cannot be necessarily attributed to Respondent accepting and mitigating the violations. However, the fact that Respondent has already been sanctioned for his conduct by the NUWC, along with his age, can be considered mitigation factors.

Delay in proceedings. Respondent observes that Mr. Kasischke/NUWC became aware that he was privately practicing law while a federal employee in 2004 but failed to notify OED until 2016. RIB at 12-13; RRB at 22. "[T]hese proceedings could have been avoided or the penalty much less harsh than an 18-month suspension at age 63 if the government had done its duty," Respondent complains. RIB at 13; RRB at 22. However, the record reflects that, in fact,

³⁷ In his Reply Brief, Respondent suggests that he was prevented from entering the interim report into evidence due to it being issued two days after the hearing in this case. RRB at 15. However, Respondent never filed any request to reopen the hearing record to accept such additional evidence. Absent from the record is also any information as to whether a final report of the investigation has been issued and what recommendation, if any, that report made.

Respondent bares all the blame for the delay. In 2004, Mr. Kasischke advised Respondent that patent practice as a government employee was prohibited. JX 21 at 19. Instead of properly acting thereon, Respondent misrepresented his activities to Mr. Kasischke, who then reasonably relied upon the misrepresentation to not report Respondent to OED or NUWC. Tr. 19. Moreover, Respondent had the ability at any time to seek USPTO's opinion about the propriety of his conduct. Any reasonable practitioner acting in good faith would have done so upon receiving the Survey that Respondent received in 2003, when he was younger and much earlier in his career. Instead, the evidence suggests that Respondent hoped to fly under the radar and is now upset that he was caught at this late date. As such, Respondent's complaint regarding the delay will not be heard in this proceeding.³⁸

OED's Deportment. Respondent claims that OED "grossly simplified estimates of Respondent's earnings over 15 years" and in doing so "exhibit[ed] bad faith, abuse of position, and contempt for the Tribunal's judgment in practical matters" RIB at 5; RRB at 15. Respondent is correct regarding OED's "simplification" to the extent that its calculations reflect only a rough estimate of Respondent's gross income from his private practice rather than net income. DIB at 29-32. However, the Director fully and forthrightly explained in his brief the methodology used in his calculations, including the fact that he was limited as a result of Respondent unilaterally redacting detailed tax information on business expenses from documents he provided to the OED. DIB at 29-32; DRB at 12; JX 12 at 8, 13, 18, 23. As such, I do not find that the Director's calculations offered as to Respondent's gross income show "bad faith," "abuse of position," or "contempt," nor do they warrant any mitigation in penalty.

OED's Collusion. In his post-hearing briefs, Respondent additionally alleges that OED failed to disclose to this Tribunal that it "colluded" with NUWC "to initiate a corresponding Department of Defense investigation on March 20, 2018, five months before [he] separated from government service." RIB at 4; RRB at 14. Further, that OED provided NUWC with "data only available to the USPTO in apparent violation of . . . the Computer Matching and Privacy Protection Act of 1988 (CMPAA), Pub. L. No. 100-503, 102 Stat. 2507." RIB at 4-5; RRB at 14. *But cf.* JX 3 at 2 (USPTO 2003 Survey Privacy Act Advisory Statement). The resulting DOD investigation report, Respondent claims, "is replete with out of context allegations and inaccuracies," but nonetheless, "recommends the report it be used negatively in consideration of any future application for a security clearance." RIB at 5; RRB at 14. As such, he is unlikely to be able "to obtain a security clearance which effectively blocks any meaningful government or government contractor employment near the Respondent's residence." RIB at 12; RRB at 22. Moreover, Respondent suggests OED has also failed to inform this Tribunal that it "remains in collusion with NUWC for that agency to 'monitor' the outcome of these proceedings and report[] the outcome to Respondent's state bar if the USPTO ultimately determines, for any reason, not to do so." RIB at 5; RRB at 14. However, Respondent offered no proof nor argument on these "collusion" claims during the hearing held in this matter, nor has he requested the record be reopened to include supplementary evidence in support of these claims. As such, I cannot and do not credit these arguments as factors in mitigation.

³⁸ Colloquially, Respondent's argument that Mr. Kasischke should not have given him the benefit of the doubt and reported him sooner is analogous to the comment that Otter makes to Flounder in the movie *Animal House*: "You f--ed up. You trusted [me]!" NATIONAL LAMPOON'S ANIMAL HOUSE (NBC Universal 1978), *available at* <https://www.youtube.com/watch?v=zOXtWxhlsUg> (last visited Oct. 2, 2019).

Respondent's Cooperation. Respondent further offers in mitigation the fact that during the yearlong OED investigation, he responded fully to all the Director's RFIs. RIB at 12; RRB at 22. While it does appear that Respondent did respond to all four lengthy RFIs, there is no evidence that he did more than what was required of him under the duty to cooperate set forth in 37 C.F.R. § 11.801. Thus, at most, his cooperation with the OED during the investigation would be a very modest factor in mitigation.

X. PENALTY DETERMINATION

In support of its proposal of an 18-month suspension as an appropriate penalty in this case, the Agency identifies "four published cases related to professional misconduct associated with violations of 18 U.S.C. " 203 and 205." DIB at 39. Three of those cases reflect settlements OED entered into with practitioners rather than adjudicated decisions. DIB at 39-40 (*citing Ryznic*, PTO Proceeding No. D2001-16, slip op. (Feb. 3, 2003) (Final Order), *Seto*, PTO Proceeding No. D2009-38, slip op. (Oct. 11, 2011) (Final Order), and *Laux*, PTO Proceeding No. D2016-39, slip op. (Mar. 9, 2017) (Final Order)). This Tribunal does not view such settlement orders as authoritative and will not consider them in reaching its decision on penalty in this matter.

The one adjudicative decision cited as analogous by the Agency is *Moatz v. Kersey*, 67 U.S.P.Q.2d 1291, 2002 WL 32056608 (Final Decision) (T.T.A.B. 2002).³⁹ JX 11 at 16-29; JX 11 at 29-31. In *Kersey*, the practitioner was found to have filed three documents with the USPTO on behalf of private clients while employed for less than a year by the Air Force as a (civilian) Patent Advisor, despite being specifically notified that such activity was a conflict of interest and prohibited. *Kersey*, 2002 WL 32056608, at *1. He also failed to notify the USPTO of brief state suspensions of his license to practice law. *Id.* at *1-2. The ALJ who heard the case found the practitioner in violation of two provisions of the USPTO Code and determined that a reprimand was an appropriate sanction. *Id.* at *3. The USPTO appealed the sanction. *Id.* at *1. On appeal, the USPTO General Counsel considered a variety of mitigating penalty factors including the practitioner's age (62), length of experience, contributions to the patent system as a patent attorney, brief federal employment (suggesting the violations were not longstanding and not likely to be repeated in the future) and lack of "actual conflict of interest in the traditional sense." *Id.* at *5. He also considered aggravating factors such as the seriousness of the violations and that the practitioner had ignored the advice of his supervisor, shown a lack of remorse or recognition of the seriousness of the offense, and the need to deter other practitioners from violations. *Id.* at *6. Based thereon, the General Counsel determined that the appropriate penalty was a six-month suspension. *Id.*

³⁹ The Final Decision in *Kersey* was issued by the USPTO's General Counsel, to whom the USPTO Director had delegated such authority pursuant to 35 U.S.C. § 3(b)(3)(B), and who subsequently denied the Respondent's request for reconsideration. JX 11 at 16-29; JX 11 at 29-31. The U.S. District Court for the District of Columbia upheld the Final Decision on appeal. *Kersey v. Undersecretary of Commerce for Intellectual Property, et al.*, No. CIV.A. 02-2331 (GK), 2005 WL 486144 (D.D.C. 2005). Mr. Kersey's challenge to the District Court's decision before the Federal Circuit was initially dismissed for failure to prosecute, 128 Fed. Appx. 771 (Fed. Cir. 2005), but that order was subsequently vacated, 193 Fed. Appx. 965 (Fed. Cir. 2006). Ultimately, his appeal was considered by the Court of Appeals for the Federal Circuit and the decision affirmed. *Kersey*, 221 F. App'x 997, 2007 WL 1107740 (Fed. Cir. 2007).

In his initial brief, Respondent suggests that no suspension is warranted in this case because “at no time has there been any matter overlap, potential matter overlap, or matter connection, or other nexus between the Respondent’s government position as an engineer for the Navy and the Respondent’s private work as a patent attorney; nor is there any matter connection between the Respondent’s Navy position as an engineer and the USPTO.” RIB at 7. He advises that all the cases cited in support of the 18-month suspension involve a “nexus” between the government employee’s official duties and the alleged wrong doing. RIB at 6 (citing *Kersey*; *Brown v. Dep’t of the Navy*, 229 F.3d 1356, 1361 (Fed. Cir. 2000) (Marine base civilian employee having adulterous affair with deployed servicemember’s spouse); *Rueckert v. IRS*, 775 F.2d 208 (7th Cir. 1985) (State revenue employee reprimanded for outside legal employment absent expressly required approval from department director); *Moffer v. Watt*, 690 F.2d 1037, 1040 (D.C. Cir. 1982) (Bureau of Indians Affairs employee dismissed for trading with Indians prohibited by 25 U.S.C. § 68); *Hoover v. United States*, 513 F.2d 603, 646-47 (Ct. Cl. 1975) (Revenue employee dismissed for submitting fraudulent tax returns); *Laux*, PTO Proceeding No. D2016-39 at 1-2 (USPTO employee sanctioned for undertaking representation of relative’s interests before the USPTO); *Seto*, PTO Proceeding No. D2009-38 at 1-2 (USPTO employee suspended for filing patent applications while employed by the USPTO); *Ryznic*, PTO Proceeding No. D2001-16 at 1-2 (USPTO employee suspended for two years for filing patent applications while employed by the USPTO)).

Respondent’s argument here is unpersuasive for two reasons. First, there is no requirement that there be a “nexus” for a sanction to be imposed for violating the USPTO Code and Rules. *See Kersey*, 2002 WL 32056608 at *5 (“whether there was a direct conflict between Respondent’s work for the Air Force and his work for private individuals before the USPTO” has “no direct bearing on this case.”); *Moatz v. Reynolds*, PTO Proceeding No. D1999-12, slip op. at 23 (Apr. 4, 2001) (Initial Decision) (rejecting lack of nexus argument; practitioner excluded for DWI convictions) (citing *In re Kelly*, 801 P. 2d 1126 (Cal. 1990)).

Second, there *is* a likely a “nexus” between Respondent’s federal employment and his private practice. As a federal employee, Respondent served as a voting member on the IEB which evaluated whether NUWC should seek to patent the inventions of NUWC employees. JX 21 at 10-12; DIB Stip. 33; Tr. 30; JX 17 at 3; JX 14 at 1. If the IEB found the government did not own the invention, then the employee had the right to patent the invention on his or her own. JX 15 at 2; JX 21 at 11-12. Such employee/inventors were arguably part of the pool of potential clients from which Respondent’s private practice drew, although admittedly there is no evidence in the record as to whether any of Respondent’s clients were NUWC employees.

After careful consideration of all the penalty factors and aggravating and mitigating circumstances discussed above, I find the suspension of 18 months requested by the OED Director to be inadequate. Respondent was found to have violated nine different USPTO Code and Rules provisions over a period of more than ten years and involving hundreds of separate unethical acts. *See* SJ Order. “Courts have repeatedly held that attorneys who continuously violate disciplinary rules over a lengthy period of time should receive a substantial suspension if not exclusion.” *Hormann*, PTO Proceeding No. D2008-04, at 21 (citing *In the Matter of McAllister*, 265 Ga. 420, 420-21 (1995) (disbarring attorney engaged in multiple violations of state disciplinary rules over three years, including abandoning legal matters entrusted to him, engaging in conduct involving dishonesty, fraud, deceit, or misrepresentation, and failing to respond to state disciplinary authorities)).

In this case, Respondent's conduct "represents stretching and exceeding the limits of trustworthiness, honesty and candor in several contexts over several years." *Kelber*, PTO Proceeding No. D2006-13, slip op. at 64 (Sept. 23, 2008) (Initial Decision) (practitioner suspended six months for misrepresentation). Respondent was informed by the 2003 USPTO Survey and Mr. Kasischke/NUWC in or around 2005-2006 that he was not allowed to represent private parties in patent matters while a government employee. He ignored both the warnings, and worse yet, misrepresented his activities to Mr. Kasischke. He then failed to seek permission for his outside activities even when required to do so in 2008-2009 in association with filing an OGE 450. Respondent continued his violative activities while under OED investigation although OED notified him they were prohibited and persisted still to violate the law even while this proceeding was pending. Many of his representations to OED and this Tribunal do not ring truthful. To this day, Respondent remains arrogant and unrepentant about his conduct.

While he has no prior history of violations, the record here evidences that Respondent knowingly violated the USPTO Code and Rules and successfully engaged in the private practice of patent law while a government employee, likely for the full 16 years that he worked for the federal government. As such, his present request for leniency to continue to engage in private practice unimpeded post-retirement, when he may finally do so without violating the USPTO Rules incorporating the Conflict of Interest Statutes, falls on deaf ears. *Hormann*, PTO Proceeding No. D2008-04, at 21 ("Serious and willful violations of disciplinary rules, even when an attorney holds a record free of violations, may justify disbarment."); *In the Matter of Shehane*, 276 Ga. 168, 170 (2003) (disbarring attorney and holding that even though "respondent has not been the subject of any prior disciplinary action during his eight-year membership in the State Bar of Georgia, we take very seriously his deliberate, deceitful acts to obfuscate the truth").

Consequently, I find a 60-month suspension is more appropriate considering the factors of 37 C.F.R. § 11.54(b) and the above considerations. This Tribunal finds that the penalty assessed will adequately punish Respondent, while also protecting the public and the profession and deterring future violations. *See Hill*, PTO Proceeding No. 2001-06, at 12 (an important aspect of penalties is deterrence); *Burmeister*, PTO Proceeding No. D1999-10, 11 (it is important when considering penalties to start with the idea that the ethical guidelines are in place to protect the public and the Bar). Moreover, this penalty seems appropriate, if not lenient, compared to *Kersey*, where the federal employee practitioner was suspended for six months for filing with the USPTO just three documents in less than a year. Here, Respondent submitted far more filings to the USPTO over a much longer time period. Approximating six months of suspension for each of ten of those years is entirely reasonable. *See Ruffenach*, 486 N.W.2d at 391 (penalty assessed should be proportionate to the violation committed); *In Re Disciplinary Proceedings Against Kuvara*, 149 Wn.2d 237, 256 (Wash. 2003) (proportionality of a penalty to the violation of ethical rules is a factor to be considered in assessing the penalty).

Finally, Respondent asks in his briefs that, in the event a suspension is imposed, that this Tribunal recommend the suspension be stayed while he "seeks judicial review of the First Amendment issues raised earlier in Federal Court, particularly in light of the Supreme Court's rulings in *Matal v. Tam*, 137 S. Ct. 1744 (2017) and *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019)."⁴⁰

⁴⁰ In *Tam*, the Supreme Court held that the disparagement clause under the Lanham Act, 15 U.S.C. § 1052(a), prohibiting registration of trademarks disparaging any person, violated the Free Speech Clause of the First

RIB at 13. The PTO Rules provide that this Tribunal's decision may be initially appealed to the USPTO Director and doing so stays the effective date of sanction order. 37 C.F.R. §§ 11.55, 11.56. In turn, the USPTO Director's decision may be appealed to the U.S. District Court for the Eastern District of Virginia, however "except on proof of exceptional circumstances," such appeal does not stay the order of discipline. 37 C.F.R. §§ 11.57; 35 U.S.C. § 32. As such, it is both premature and not within this Tribunal's purview to determine if exceptional circumstances exist to stay the case in the event of an appeal of the decision to the federal courts.

ORDER

After careful and deliberate consideration of the above facts and conclusions as well as the factors identified in 37 C.F.R. § 11.54(b):

IT IS HEREBY ORDERED that Respondent Kevin P. Correll, PTO Registration No. 46,641, is suspended for a period of **60 months** from practice before the Patent and Trademark Office.

Respondent's attention is directed to 37 C.F.R. § 11.58 regarding the duties of excluded practitioners, and 37 C.F.R. § 11.60 concerning petition for reinstatement.

The facts and circumstances of this proceeding shall be fully published in the U.S. Patent and Trademark Office's official publication.

Under 37 C.F.R. § 11.55, any appeal by Respondent from this Initial Decision, issued pursuant to 35 U.S.C. § 32 and 37 C.F.R. § 11.54, must be filed with the U.S. Patent and Trademark Office at the address provided in 37 C.F.R. § 1.1(a)(3)(ii) within 30 days after the date of this Initial Decision. Such appeal must include exceptions to the Administrative Law Judge's Decision and supporting reasons therefor. Failure to file such an appeal in accordance with 37 C.F.R. § 11.55 will be deemed both an acceptance by Respondent of the Initial Decision and that party's waiver of rights to further administrative and judicial review.

SO ORDERED.



Susan L. Biro
Chief Administrative Law Judge

Dated: October 3, 2019
Washington, D.C.

Amendment, in that trademarks are private, not government speech, and that the statute discriminated based upon viewpoint. In *Brunetti*, the Supreme Court held that the immoral or scandalous clause provision of the Lanham Act, 15 U.S.C. § 1052(a), also violated the First Amendment as it "too disfavors certain ideas." 139 S. Ct. at 2297. Respondent does not enunciate in his brief how his situation is analogous to the facts of these free speech cases and their relevance here is far from self-evident.