

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL
PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re [Person's Name])
)
) Decision on Petition
) Under 37 CFR § 10.2(c)
)
)
 _____)

MEMORANDUM AND ORDER

[Person's Name] ("Petitioner") seeks review of the decision of the Director of the Office of Enrollment and Discipline ("OED Director") disapproving Petitioner's application for registration to practice before the United States Patent and Trademark Office ("USPTO") in patent cases. The OED Director disapproved Petitioner's application based on his failure to sustain his burden of establishing that he is of good moral character and repute. For the reasons stated below, the OED Director's decision is affirmed.

I.

PROCEDURAL HISTORY

Petitioner filed an application for the October 2000 Patent Practitioner registration examination on July 10, 2000. On August 5, 2000, the [City] Police Department arrested Petitioner following an incident at the apartment of his former girlfriend. He was subsequently charged with Breaking and Entering, Malicious Destruction of Property and Threats. On October 4, 2000, Petitioner withdrew by letter from the examination scheduled for later that month. On January 4, 2001, Petitioner again applied to take the registration examination ("second application"). In response to Question 6 on the application form, Petitioner stated that he had

been arrested for the offenses set forth above. Petitioner subsequently took and passed the registration examination. On August 6, 2001, OED requested additional information from Petitioner regarding the charges against him. Petitioner filed a response to that request on November 21, 2001. On July 27, 2002, OED issued a Show Cause Order in which it informed Petitioner that it was of the opinion that he had failed to meet his burden of demonstrating that he possessed the good moral character needed for registration. The Show Cause Order also granted Petitioner an opportunity to respond to OED's concerns. On August 12, 2002, Petitioner replied to the Show Cause Order. Following Petitioner's submission of his response, OED, on December 19, 2002, issued an Order Scheduling Further Statement and Argument, presenting Petitioner with an opportunity to address certain issues related to his application for registration. On February 17, 2003, Petitioner submitted a response to that Order.

On March 27, 2003, the OED Director issued his decision denying Petitioner enrollment pursuant to 35 U.S.C. § 2 and 37 C.F.R. § 10.7(a)(2)(i) because he failed to sustain his burden of establishing that he is of good moral character and repute. The OED Director based his decision on Petitioner's August 5, 2000, criminal conduct and his lack of candor regarding the incident giving rise to his arrest. The OED Director also determined that Petitioner failed to establish sufficient reform and rehabilitation. Petitioner seeks review by the USPTO Director of the OED Director's Decision.

II.

LEGAL STANDARDS

Title 35 U.S.C. § 2(b)(2) states in pertinent part that the USPTO:

“may require [agents, attorneys, or other persons representing applicants or other parties before the USPTO], before being recognized as representatives of applicants or other persons, to show that they are of good moral character and reputation”

(emphasis added). Pursuant to the statute, Petitioner bears the burden of showing that he is of good moral character and reputation. In accordance with that statute, the USPTO Director promulgated 37 C.F.R. § 10.7, which states in pertinent part:

“(a) No individual will be registered to practice before the Office unless he or she shall:

. . . .

(2) Establish to the satisfaction of the Director [of OED] that he or she is:

(i) Of good moral character and repute”

This regulation effectuates the USPTO Director’s recognized duty to ensure that those representing members of the public before the USPTO in patent cases will do so with the highest degree of candor and good faith in order to protect the public.

“By reason of the nature of an application for patent, the relationship of attorneys to the Patent Office requires the highest degree of candor and good faith. In its relation to applicants, the Office must rely upon their integrity and deal with them in a spirit of trust and confidence’ It was the Commissioner, not the courts, that Congress made primarily responsible for protecting the public from the evil consequences that might result if practitioners should betray their high trust.”

Kingsland v. Dorsey, 338 U.S. 318, 319-320 (1949) (quoting with approval from Dorsey PTO case.) Accord Cupples v. Marzall, 101 F. Supp. 579, 583, 92 USPQ 169, 172 (D.D.C. 1952) (“primary responsibility for protection of the public from unqualified practitioners before the Patent Office rests in the Commissioner of Patents”), aff’d, 204 F.2d. 58, 97 USPQ 1 (D.C. Cir. 1953, quoted with approval in Gager v. Ladd, 212 F. Supp. 671, 673, 136 USPQ 627, 628 (D.D.C. 1963).

III.

OPINION

A. Background

The [City] Police Department arrested Petitioner on August 5, 2000, following an incident at the apartment of his former girlfriend. He was subsequently charged with Breaking and Entering, Malicious Destruction of Property and Threats. According to the [City] Police Incident Report (“Police Report”), Petitioner broke into and ransacked her apartment, smeared blood throughout the premises, destroyed personal property and scattered the contents of a garbage bag. During the break-in, Petitioner also telephoned his ex-girlfriend, informed her that he had cut his hand breaking into her apartment, ordered her to come to the apartment immediately and threatened to kill her if she failed to do so.

On September 15, 2000, the [State] Bar transferred Petitioner to disability inactive status. He later agreed to a one-year suspension, retroactive to September 15, 2000. On October 27, 2000, Petitioner admitted to facts sufficient for a finding of guilty to the charges set forth above in [City] Municipal Court. That court continued the case without a finding and imposed probation for a period of thirty months.¹

On January 4, 2001, Petitioner submitted an application for registration to practice before USPTO. Question 6 of that application asks applicants, among other things, whether they have ever been arrested or charged with any violation of State law. Petitioner answered that question

¹ There is some confusion as to whether “probation” or “supervision” is the proper term to describe Petitioner’s conditions of release. As the difference is immaterial to the ultimate disposition of the case, this decision will use the term “probation,” given its widespread familiarity and use.

in the affirmative. The application form directs applicants who answer “yes” to Question 6 to “provide a detailed statement setting forth all relevant facts and dates along with verified copies of relevant documents.” The form further directs applicants to provide OED with “all available information, however unfavorable, even if its relevance is in doubt” In a statement accompanying his January 2001 application, Petitioner indicated that he consumed a significant amount of alcohol on the night of his arrest and that he had cut his finger while attempting to hail a taxi to go home. Petitioner further indicated that he had decided to go to the apartment of his ex-girlfriend, a medical student, to have her tend to his cut. Petitioner stated that upon discovering that she was not home, he “entered the apartment.” Petitioner then stated that he did not remember much else except that he had difficulty stopping the bleeding. Along with his application, Petitioner submitted documents related to the [State] Bar proceedings against him and a court document entitled “Tender of Plea or Admission to Sufficient Facts, Waiver of Rights.”

In response to Petitioner’s application, OED requested that Petitioner provide a detailed account of the events surrounding his entry into the apartment and copies of all documents relating to his arrest and the attendant court proceedings against him. Petitioner responded to that request by submitting additional documents related to the relevant court proceedings, as well as a copy of the Police Report. He also submitted a letter indicating that he forced open the door to his former girlfriend’s apartment and damaged some of her belongings in an attempt to find something to help stop the bleeding from his finger. He further indicated that he telephoned his former girlfriend and told her that he needed her help. Petitioner also stated that it is alleged that he threatened her on the night in question, and because he has no memory of the events of the

night in question, he has no basis to contest the allegation.

OED then issued a Show Cause Order to Petitioner. The Show Cause Order indicated that OED had several moral character concerns arising from Petitioner's criminal conduct and his responses contained within his application and other materials submitted to OED. OED gave Petitioner an opportunity to show cause why his application for registration should not be denied.

In response to the Show Cause Order, Petitioner argued that he possessed sufficient moral character to warrant admission. Petitioner asserted that his criminal conduct was aberrational and explained by extraneous forces in his life, including his unusual consumption of alcohol and extra dosages of prescribed drugs on the night in question. Petitioner also claimed that he has accepted full responsibility for his actions, expressing remorse for his actions, and that sufficient time has elapsed without further incident for Petitioner to demonstrate that he has requisite good moral character. Petitioner also disputed OED's assertion that he had not been candid in his submissions. In this regard, Petitioner argued that he had disclosed to OED his arrest, the charges against him, and the disposition of his case. Petitioner also argued that in response to OED's original request for additional information, Petitioner submitted a more detailed description of the events leading to his arrest, as well as additional documentation.

Following OED's receipt of Petitioner's response to the Show Cause Order, Petitioner's probation was terminated on November 15, 2002. OED then issued an Order Scheduling Further Statement and Argument, requesting that Petitioner respond to concerns raised by OED concerning certain issues relevant to Petitioner's application for admission. Among other information, OED asked Petitioner for: information relating to his failure to submit certain documentation without prompting; apparent inconsistencies between various statements to OED;

and apparent inconsistencies between Petitioner's statements to OED and his statements to other jurisdictions considering his conduct. On March 3, 2003, Petitioner was readmitted to the [State] Bar. Petitioner then responded to OED's last Order by submitting responses to each of the questions posed, as well as additional pertinent documentation.

On March 27, 2003, the OED Director issued his Final Decision and Memorandum denying Petitioner's application for registration on the grounds that he did not possess sufficient good moral character to practice before the USPTO in patent cases. In reaching that conclusion, the OED Director relied on both Petitioner's criminal conduct and his lack of complete candor before OED. With regard to the former, the OED Director found that Petitioner's voluntary use of prescription drugs and alcohol on the night of the pertinent events did not excuse his behavior because Petitioner did not demonstrate that his use of the drugs and alcohol that night was aberrational or that such use impaired his ability to appreciate the wrongfulness of his conduct.

With regard to lack of candor, the OED Director first noted Petitioner's failure to provide details related to his forced entry into his former girlfriend's apartment, the destruction of her and the landlord's property, and the threats he leveled against her in his first submissions to OED. Next, the OED Director noted several inconsistencies in Petitioner's explanations as to how he came to be in the neighborhood of his former girlfriend on the relevant night. Further, the OED Director noted that Petitioner only sent in a number of documents after he had been requested to submit additional documentation and that those submissions do not account for discrepancies and evasions in Petitioner's statements. The OED Director then cited a number of inconsistencies in Petitioner's submissions, including inconsistencies related to his alcohol use and how his finger was cut.

Finally, the OED Director found that the Petitioner was not sufficiently rehabilitated. In making this ruling, the OED Director noted the psychotherapy treatment Petitioner has undertaken, his volunteer work, his employment record, the restitution he has paid to the victim, and the regret over the sorrow he caused. However, the OED Director noted that a number of these activities occurred when Petitioner was under court-ordered supervision and thus is entitled to less weight. The OED Director further found that Petitioner had not met his burden of demonstrating that he has been rehabilitated because he had not demonstrated proof of good moral character for a significant period of time when he was not under court-ordered supervision. Accordingly, he denied Petitioner's application for registration.

B. [State] Bar Proceedings

Petitioner argues that deference should be granted to the decisions of the [State] Bar and of the [State] Highest Court finding that Petitioner is of good moral character. Such deference is unwarranted. First, USPTO and [State] require different levels of proof of good moral character. [State] employs a flexible standard of proof in determining whether or not an individual has good moral character, (citation omitted), while USPTO uses a "clear and convincing" standard of proof in determining whether an individual has sufficient moral character for admission. *See In re Boe*, 26 USPQ2d 1809, 1993 WL 216460 (USPTO 1993). [States]' standard is more flexible than the standard employed by USPTO. *See* (citation omitted), 661 N.E.2d at 95. Thus, an individual could gain admission under [States]' more flexible standard, and yet be denied admission under USPTO's more stringent clear and convincing evidence standard.

Further, USPTO considers factors not relied on by [State] in determining moral character.

[State] considers the following factors in assessing good moral character in reinstatement hearings: the nature of the original offense leading to disbarment; the petitioner's character, maturity, and experience at the time of his disbarment; the petitioner's occupation and conduct in the time since his disbarment; the time elapsed since disbarment; and the petitioner's present competence in legal skills. *Id.* at 92. In assessing the moral fitness of applicants whose backgrounds are tainted by criminal convictions, the USPTO considers a number of factors similar to those used in [State] in reinstatement proceedings. *See In re Manville*, 538 A.2d 1128, 1133 n.4 (D.C. 1988). However, the USPTO also considers the applicant's candor in the filings and proceedings on character and fitness in determining whether an individual with criminal convictions should be admitted. *Id.* Moreover, even if, as Petitioner asserts, the [State] proceeding would encompass questions of candor if presented, the facts that gave rise to the OED Director's questions about Petitioner's candor were not before the [State] Bar. The OED Director properly took into account the Bar's conclusions but was not required to defer to them.

C. Petitioner's Moral Fitness

Under USPTO precedent, the following factors are pertinent in assessing the moral fitness of applicants whose backgrounds are tainted by criminal conduct:

1. The nature and character of the offenses committed.
2. The number and duration of the offenses.
3. The age and maturity of the applicant when the offenses were committed.
4. The social and historical context in which the offenses were committed.
5. The sufficiency of the punishment undergone and the restitution made in connection with the offenses.

6. The grant or denial of a pardon of offenses committed.
7. The number of years that have elapsed since the last offense was committed, and presence or absence of misconduct during that period.
8. The applicant's current attitude about the prior offenses (*e.g.*, acceptance of responsibility for and renunciation of past wrongdoing, and remorse.)
9. The applicant's candor, sincerity and full disclosure in the filings and proceedings on character and fitness.
10. The applicant's constructive activities and accomplishment subsequent to the criminal convictions.
11. The opinions of character witnesses about the applicant's moral fitness.

In re Manville, 538 A.2d at 1133 n.4.

As a preliminary matter, the OED Director did not determine whether Petitioner's criminal conduct or lack of candor standing alone is sufficient to deny him admission. It is unnecessary to determine whether the criminal conduct alone or the lack of candor alone is sufficient to deny Petitioner registration. *See id.* For the reasons that follow, the decision of the OED Director that Petitioner has failed to demonstrate the good moral character necessary for registration is affirmed.

The first factors that must be considered pertain to the nature of Petitioner's conduct. *Id.* *See also Application of Allan S.*, 282 Md. 683, 690, 387 A.2d 271, 275 (1978) (nature of offense must be taken into consideration in assessing present moral character). Here, Petitioner's criminal activity was quite violent and disturbing, even though it occurred only over the course of one evening. Petitioner forcibly broke into a former girlfriend's apartment by breaking the door off its hinges. Once Petitioner gained entry to the apartment, he proceeded to ransack it by destroying the occupant's personal property and scattering the contents of a garbage bag

throughout the apartment. Petitioner also smeared blood that had come from his cut hand throughout the apartment. Finally, Petitioner phoned his former girlfriend from the scene of the crime, ordered her to come home and threatened to kill her and her friend. Thus, on the night in question, it is uncontested that Petitioner engaged in a series of serious criminal activities.

Petitioner committed these crimes at the age of 33. It is uncontested that Petitioner voluntarily consumed a significant amount of alcohol and prescription drugs. Although Petitioner was under the influence of alcohol and prescription drugs, however, the psychiatrist who examined him shortly after the incident found that he appreciated the wrongfulness of his conduct at the time he committed the crimes. Moreover, Petitioner engaged in the criminal activity while he was already serving as an attorney in the [State]. Thus, Petitioner was of sufficient age and maturity to appreciate the wrongfulness of his conduct. Accordingly, the factors related to the context of his criminal activity do not provide a basis for mitigating the penalty under the circumstances.²

In addition to the serious criminal activity in which Petitioner engaged, he also failed to be fully candid with OED in the second application and his subsequent submissions. As noted above, the application form directs applicants to provide a detailed statement setting forth all relevant facts, copies of relevant documents and all available information even if its relevance is in doubt. Petitioner, however, did not provide all of the relevant facts surrounding the events of

² Petitioner makes much of the fact that his conduct on the evening in question was an isolated occurrence and that it was an aberration from his normally law-abiding behavior. While that is true, it does not change the egregious nature of Petitioner's criminal conduct on that evening. *See Attorney Grievance Comm. of Md. v. Protokowicz*, 329 Md. 252, 263, 619 A.2d 100, 105 (1993) (aberrational criminal conduct warranted significant sanction in light of its egregious nature).

August 5, 2000. In this connection, Petitioner did not, in his second application, provide sufficient details concerning how he entered the apartment of his former girlfriend. The statement appended to the second application states only that he entered the apartment. It did not, for example, explain, as the Police Report does, that he had smashed in the door with such force as to remove it from its hinges. Further, it did not explain the charge concerning the threats he made against his former girlfriend. Thus, Petitioner failed to provide full documentation and withheld pertinent information about aggravating circumstances relevant to the determination of moral character.

Petitioner does not claim that he fails to remember breaking down the door, only that he subsequently provided the details of his forced entry into the apartment to the [State] Bar authorities and subsequently submitted the Police Report to OED. However, neither of these actions explain nor mitigate his failure to provide all of the relevant documentation with his second application. He does not, and cannot, contest that that application instructions called for them. Indeed, he should have realized that it was important for him to provide such third party documentation, especially when he recognized that his own recollection of the events on the night in question were incomplete.

Petitioner's failure to provide full documentation at the time of his second application is all the more egregious in view of his statement in his application that he tried to find something to stop the bleeding and damaged some of his former girlfriend's belongings. This account of how and why some of his former girlfriend's belongings were damaged does not explain the full extent of the damage to the apartment, as revealed in the document he withheld. The uncontested Police Report states: "Officers found the phone smashed, glasses smashed and a pocketbook

emptied of all its contents covered w/ blood. Officers also observed on the back deck a garbage bag w/ its contents scattered around as someone had searched it.” Petitioner’s explanation that he was trying to find something to stop the bleeding from his hand does not in any way explain, nor is it consistent with, the wanton destruction of property described above. Thus, contrary to the instructions governing the application, Petitioner withheld information that would have cast doubt on the affirmative statements he made in the application. It seem highly doubtful, given his self-confessed imperfect recollection of the events, that Petitioner would have given such an unqualified account of the events if he had anticipated that the OED Director would require additional disclosures.

Further, Petitioner’s statement in his application that he cut his finger before arriving at his former girlfriend’s apartment also evinces a lack of candor. By all accounts, the cut Petitioner sustained on the night in question was severe as it resulted in the loss of a significant amount of blood (that was smeared on the walls of his former girlfriend’s apartment) and required medical attention, including suturing. The evidence, as the OED Director found, strongly suggests that he cut his finger while smashing the door of that apartment and forcing it off its hinges. The uncontested statement of Petitioner’s former girlfriend that, in his menacing phone call, he informed her that he cut that finger breaking into her apartment bolsters this conclusion. At the time, Petitioner’s former girlfriend was under no incentive to fabricate to such a detail and Petitioner’s contemporaneous statement is likely to have been unguarded given his condition. His admitted lack of recall of the events of the evening does not suggest that

credence should be given to his retrospective account.³ Although Petitioner would have the OED Director make different findings, the OED Director quite properly found Petitioner's alternative account lacking in credibility.

Petitioner claims that he failed to submit the Police Report and other documentation without prompting because, acting under the advice of counsel, he thought that it was not required. This explanation is unconvincing. First, the instructions accompanying the application form are straightforward and Petitioner does not contest that they call for submission of the kind of document withheld. Second, the nature of the offenses committed must be taken into account in assessing moral character. Even if one accepted at face value the second application's explanation of other events, it is silent as to the circumstances giving rise to the charge of threats against his former girlfriend. An independent and full account of the events giving rise to the concerns about an applicant's good moral character is undoubtedly relevant evidence of Petitioner's moral character.⁴ Third, preparation by counsel provides no justification for failing to be candid during the registration process as Petitioner bears the ultimate responsibility for documents submitted under his name or on his behalf. This responsibility is particularly important in the context of an inquiry into the moral character of an applicant for registration as a practitioner authorized to represent others before the USPTO. One of a practitioner's duties is to advise applicants on adherence to the duty of candor in the prosecution of patent applications.

³ Petitioner makes much of the statement in the Police Report that there was blood "leading up to" the apartment of his former girlfriend. However, that blood could just have easily been smeared on the way down from that apartment, after he smeared blood throughout the apartment.

⁴ Petitioner argues that his eventual submission of the Police Report and other documents that he failed to originally submit demonstrates his candor. However, belated disclosure of relevant information is not persuasive evidence of good moral character. *See Application of Greenburg*,

Petitioner hardly demonstrates his moral character to provide such advice when he exercises his own lack of candor by reliance on the advice of another.

Thus, the evidence demonstrates Petitioner's lack of candor in the registration process. This lack of candor is particularly troublesome in light of the unique nature of practicing before USPTO. Unlike many other legal proceedings, the patent application process is primarily *ex parte* in nature. Thus, USPTO must rely heavily on the honesty and integrity of the attorneys practicing before it. No moral character qualification for registration is more important than truthfulness and candor. *Application of Allan S.*, 282 Md. at 689-90.

Balancing against the egregious nature of Petitioner's criminal conduct and his troubling lack of candor are the steps that Petitioner has undertaken to rehabilitate himself following his criminal activity. He has refrained from further criminal activity, successfully completed the terms of his probation, paid restitution to both his former girlfriend and his former girlfriend's former landlord, and gained readmission to the [State] Bar. Additionally, as noted and considered by the OED Director, Petitioner regrets the sorrow he has caused. Further, Petitioner has submitted several references from members of the [State] Bar, testifying to his present good moral character. Petitioner also expresses his apologies for omissions in his submissions to the USPTO.

However, Petitioner's attempts at rehabilitation from his criminal acts all came either during, or in connection with, the terms of his probation or in the time period immediately following the termination of his probation in November 2002 and his reinstatement to the [State] Bar in March 2003. Rehabilitation should be demonstrated for a significant period of time when

126 Ariz. 290, 292, 614 P.2d 832, 834 (1980).

Petitioner is not on probation. *See Seide v. Committee of Bar Examiners of State Bar of California*, 264 Cal.Rptr. 361, 366, 49 Cal.3d 933, 942, 782 P.2d 602,607 (1989). Here, Petitioner's probation ended on November 15, 2002, and he was reinstated to the [State] Bar on March 3, 2003. Thus, only a matter of months have passed since he has been released from probation. Indeed, at the time of his application in January 2001, Petitioner was still on probation and remained suspended from the [State] Bar. This short period of time following the commission of his crimes and his release from probation has not allowed Petitioner to demonstrate his current good moral character. *See In re Mustafa*, 631 A.2d 45 (D.C. Court of Appeals 1993) (applicant denied admission to D.C. Bar two years after misconduct based largely on recency of misconduct). Moreover, the USPTO must take into account the aggravating fact of Petitioner's lack of candor in his January 5, 2001, application in considering his rehabilitation. Petitioner has failed to demonstrate that he has been rehabilitated.

IV.

CONCLUSION

In light of Petitioner's criminal conduct, his lack of candor and his lack of sufficient rehabilitation, the OED Director's decision is well-based on the evidence in record. The OED Director's decision is hereby affirmed for the reasons set forth in this opinion.

ORDER

Upon consideration of the petition to the USPTO Director for registration to practice before the PTO in patent cases, it is

ORDERED that the petition is denied.

