

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

In the Matter of:

ERIK M. VIEIRA,

Respondent.

Proceeding No. D2020-31

April 20, 2021

**INITIAL DECISION ON DEFAULT JUDGMENT**

This matter arises from a disciplinary complaint filed by the Director for the Office of Enrollment and Discipline (“OED Director”) for the United States Patent and Trademark Office (“USPTO” or “the Office”) against Erik M. Vieira (“Respondent”) pursuant to 35 U.S.C. § 32 as implemented by 37 C.F.R. Part 11.<sup>1</sup> The OED Director has filed a *Motion for Entry of Default Judgment and Imposition of Disciplinary Sanction and Memorandum in Support* (“Default Motion”) seeking a default judgment and an order excluding Respondent from practice before the Office.

**PROCEDURAL HISTORY**

On October 10, 2020, the OED Director filed a *Complaint and Notice of Proceedings under 35 U.S.C. § 32* (“Complaint”) against Respondent pursuant to 37 C.F.R. §§ 11.32 and 11.34 alleging violations of the USPTO Rules of Professional Conduct (37 C.F.R. §§ 11.101 *et seq.*). The *Complaint* stated that Respondent was required to file an answer within thirty days. Also on October 10, 2020, the OED Director, in accordance with 37 C.F.R. § 11.35(a)(2), attempted to serve Respondent with a copy of the *Complaint* by sending it via certified mail to the La Jolla, California address that Respondent had provided to the Office of Enrollment and Discipline (“OED”) pursuant to 37 C.F.R. § 11.11.<sup>2</sup>

On October 14, 2020, the Court issued a *Notice of Hearing and Order* that, among other things, ordered Respondent to file an answer to the *Complaint* as specified in 37 C.F.R. § 11.36 on or before November 9, 2020. However, Respondent did not file an answer or otherwise enter an appearance before the Court by the specified deadline.

On November 23, 2020, counsel for the OED Director sent an email to Respondent at the last email address Respondent had used to communicate with OED ( [REDACTED] ) in an attempt to determine whether Respondent would accept service of the *Complaint* by email.

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<sup>1</sup> Pursuant to an Interagency Agreement in effect beginning March 27, 2013, Administrative Law Judges of the U.S. Department of Housing and Urban Development are authorized to hear cases brought by the USPTO.

<sup>2</sup> 37 C.F.R. § 11.11(a) requires a registered practitioner such as Respondent to notify the OED Director of the postal address for the practitioner’s office and to provide written notice of any address change within 30 days of the change.

Respondent did not respond to the email.

Because the OED Director had been unable to confirm that Respondent had received a copy of the *Complaint*, the OED Director served notice on Respondent by publication pursuant to 37 C.F.R. § 11.35(b). Notices were published in the USPTO *Official Gazette* for two consecutive weeks, on January 5, 2021, and January 12, 2021. Respondent's answer was due thirty (30) days from the date of publication of the second notice in the *Official Gazette*, see 37 C.F.R. § 11.35(b), thus making his answer due on or before February 11, 2021.

On February 4, 2021, counsel for the OED Director called Respondent and left a voice mail message requesting that Respondent provide an email address that the USPTO could use to send him confidential correspondence. Respondent returned the call and confirmed that he can receive confidential correspondence at [REDACTED], which is the same email address that the OED Director had used in the past to communicate with Respondent.

Also on February 4, 2021, counsel for the OED Director sent a copy of the *Complaint* to [REDACTED] and explained that an answer was due by February 11, 2021, that the answer must be filed with the Administrative Law Judge and served on the OED Director, and that a failure to timely file an answer may result in a default judgment. Later that same day, Respondent called counsel for the OED Director and stated that he had received the *Complaint* and would file an answer by February 11, 2021. However, he did not file an answer by that date.

On March 26, 2021, the OED Director filed the *Default Motion*. Pursuant to the *Notice of Hearing and Order* issued by this Court on October 14, 2020, any party opposing a motion must file his or her opposition within ten days after the motion is docketed. Accordingly, Respondent's response to the *Default Motion* was due on or before April 5, 2021. However, Respondent did not respond to the *Default Motion* by that date.

As of the date of this decision, Respondent has not filed an answer, responded to the *Default Motion*, or otherwise appeared in this matter.

## APPLICABLE LAW

**USPTO Disciplinary Proceedings.** The USPTO 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). This authority flows from 35 U.S.C. § 2(b)(2)(D), which empowers the USPTO to establish regulations governing patent practitioners' conduct before the Office, and 35 U.S.C. § 32, which empowers the USPTO to discipline a practitioner who is “shown to be incompetent or disreputable, or guilty of gross misconduct,” or who violates the USPTO's regulations. The practitioner must receive notice and an opportunity for a hearing before such disciplinary action is taken. 35 U.S.C. § 32. Disciplinary hearings are conducted in accordance with the USPTO's procedural rules at 37 C.F.R. part 11, subpart C, and with section 7 of the Administrative Procedure Act, 5 U.S.C. § 556, by a hearing officer appointed by the USPTO. See 37 C.F.R. §§ 11.39(a), 11.44. The OED Director has the burden of proving any alleged violations by clear and convincing evidence. 37 C.F.R. § 11.49.

In 1985, the USPTO issued regulations based on the 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). These rules set forth the USPTO Code of Professional Responsibility and “clarif[ied] and modernize[d] the rules relating to admission to practice and the conduct of disciplinary cases.” Id. at 5158. In May 2013, the USPTO replaced the USPTO Code with the USPTO Rules of Professional Conduct, which are fashioned on the ABA’s Model Rules of Professional Conduct. See Changes to Representation of Others Before the United States Patent and Trademark Office, 78 Fed. Reg. 20180 (April 3, 2013) (Final Rule) (codified at 37 C.F.R. §§ 11.101-11.901). By updating its regulations, 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.”<sup>3</sup> Id. at 20180.

**Consequences for Failure to Answer Complaint.** The USPTO’s procedural rules set forth the requirement for answering the *Complaint* and the consequences for failing to do so: “Failure to timely file an answer will constitute an admission of the allegations in the complaint and may result in entry of default judgment.” 37 C.F.R. § 11.36(e). The *Complaint* served upon Respondent also stated: “A decision by default may be entered against Respondent if a written answer is not timely filed.”

## FINDINGS OF FACT

As a consequence of Respondent’s failure to answer the *Complaint*, Respondent is deemed to have admitted the allegations in the *Complaint*, which are set forth below as the Court’s findings of fact.

### A. Background and Prior Warning Letter

The USPTO registered Respondent as a patent agent on January 28, 2003. Respondent was assigned registration number 53,723.

On January 9, 2017, in a matter unrelated to the specific subject matter of the *Complaint*, the OED Director issued a warning letter to Respondent concerning his representation of a client who had paid him to file a provisional patent application. Respondent had filed an application before he sent it to the client for final approval and that intentionally contained a false address for the client. After filing the application, Respondent had failed to pay the application filing fee, causing the USPTO to issue a Notice to File Missing Parts and subsequently a Notice of Abandonment.

The warning letter issued in the earlier matter informed Respondent of the USPTO Rules of Professional Conduct that were implicated by his actions, including 37 C.F.R. §§ 11.103 (lack of diligence); 11.104(a) (adequately communicating with clients); 11.303(a)(1) (false statements

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<sup>3</sup> Thus, the USPTO Code, the Comments and Annotations to the ABA Model Rules, and disciplinary decisions and opinions issued by state boards are useful to understanding the USPTO Rules. See 78 Fed. Reg. at 20180.

to the USPTO); 11.801(a) and (b) (false statements and failure to cooperate with the disciplinary investigations); and 11.804(c) (dishonesty, deceit, fraud, or misrepresentation).

B. Misconduct Related to the Provisional Application (the [REDACTED] application)

On or about August 28, 2018, [REDACTED] (“Inventors”) paid Respondent \$1,100 to prepare and file a provisional application and to pay the associated filing fees. At that time, the Inventors informed Respondent that they wanted him to file a nonprovisional application claiming the benefit of the earlier filing date of the provisional application after the provisional application was filed.

Also on August 28, 2018, one of the Inventors asked Respondent whether the Inventors needed to physically sign the application when it was filed. Respondent answered, “No, no physical signatures are necessary because I am licensed to practice before the United States patent and trademark office I can do an electronic signature on your behalf and all the inventors behaves [sic].”

On [REDACTED], Respondent filed U.S. Provisional Patent Application No. [REDACTED] (“the [REDACTED] application”), titled [REDACTED],” on behalf of the Inventors. On the same date, Respondent informed the Inventors that he had filed the [REDACTED] application and advised them that there is now “one year to follow up and file a nonprovisional patent application ... if we do not file a nonprovisional patent application within one year, this provisional patent application will expire.”

The [REDACTED] application was filed with three undated power of attorney forms bearing the purported electronic signature of each of the Inventors. The Inventors did not sign the power of attorney forms filed with the [REDACTED] application and, instead, relied on Respondent’s prior advice that they did not need to do so. Respondent electronically signed the Inventor’s name on the power of attorney forms by inserting the Inventors’ names between two “/” marks in the signature blocks of the power of attorney forms.

The signature block states, “This form must be signed by the **applicant**.” (Emphasis added). On information and belief, Respondent saw this statement before signing each Inventor’s name in the signature block.

Despite the Inventors’ having given Respondent the funds to pay the [REDACTED] application filing fee, Respondent did not pay the fee when he filed the [REDACTED] application.

On [REDACTED], the USPTO mailed to Respondent a Notice to File Missing Parts in the [REDACTED] application for failure to pay the \$70 filing fee, which set a two month period to respond in order to avoid abandonment of the application. On [REDACTED], the USPTO mailed a postcard to Respondent to remind him that the Notice to File Missing Parts had issued in the [REDACTED] application. Upon information and belief, Respondent received both the Notice to File Missing Parts and the USPTO postcard.

Respondent again did not pay the [REDACTED] application filing fee in response to the Notice to File Missing Parts. On [REDACTED], the USPTO mailed to Respondent a Notice of Abandonment in the [REDACTED] application due to Respondent's failure to respond to the Notice to File Missing Parts. Respondent did not notify the Inventors of the Notice to File Missing Parts, the USPTO postcard about the Notice to File Missing Parts, or the Notice of Abandonment.

C. Misconduct Related to the Nonprovisional Application (the [REDACTED] application)

On January 15, 2019, the Inventors provided Respondent with comments regarding the planned nonprovisional application based on their review of the [REDACTED] application. On January 28, 2019, the Inventors paid Respondent \$975 as the first payment for work on the nonprovisional application and associated filing fees, and on February 28, 2019, the Inventors paid Respondent an additional \$975 as the final payment for the nonprovisional application and associated filing fees.

On April 23, 2019, the Inventors asked Respondent for an update of the status of the nonprovisional application. Two days later, on April 25, 2019, the Inventors again asked Respondent for an update. The Inventors explained that they were starting to install their invention in gyms and had "a number of customers in Russia willing to equip their gym." On April 29, 2019, the Inventors yet again asked Respondent about the status of the nonprovisional application.

On May 2, 2019, the Inventors again sought an update from Respondent regarding the current status of the application. The Inventors stated to Respondent, "[a]s you know our aim was to get the official US PATENT as fast as possible without expediting it ... We currently have a pilot installation and a number of customers in the US and in Russia interested in our device, so it's crucial for [ ] to have the patent before we start to commercialize the project."

Between March 1, 2019 and May 20, 2019, Respondent did not update the Inventors with the status of the nonprovisional application. On May 20, 2019, the Inventors expressed to Respondent that "[i]t's been quite disappointing that since the 2<sup>nd</sup> part of our payment was submitted we received no updates on the status. It's been more than 3 months and we don't understand where we are standing ... This is not alright."

On May 21, 2019, Respondent finally provided the Inventors with a draft nonprovisional application. On June 13, 2019, the Inventors edited the claims and application and informed Respondent that they would like him to file the application "by the end of next week."

On June 24, 2019, Respondent sent the Inventors another draft of the nonprovisional application. The next day, the Inventors notified Respondent that he had used an incorrect version of the invention description and that his prior note in his June 24, 2019 email regarding an added figure had already been addressed. The Inventors provided Respondent with the correct description and reiterated that they "will be waiting for the updated draft in hope that we can submit the application this week."

On July 1, 2019, the Inventors informed Respondent that they were “[l]eaving for Russia next week for a month and we want to have the patent submitted before that.” On July 3, 2019, Respondent sent the Inventors a revised draft of the nonprovisional application.

On July 6, 2019, the Inventors provided their edits to the latest draft and declared to Respondent their belief that “it’s time to submit.” However, Respondent did not file a nonprovisional application on July 6, 2019. On July 25, 2019, the Inventors stated to Respondent that “[i]t’s been almost 3 weeks since we have sent [f]inal version. [We] cannot believe it can take that long to finalize and submit ... it seems ... that NOTHING HAS BEEN DONE since our last conversation that happened first week of July.”

Between July 25, 2019 and August 15, 2019, the Inventors made several unsuccessful attempts to reach Respondent via telephone to receive an update about the nonprovisional application. Respondent knew that the Inventors were attempting to call him on the telephone, but he did not respond to the Inventors’ many requests for an update about the nonprovisional application or their telephone calls.

On August 16, 2019, the Inventors terminated Respondent’s representation and demanded a full refund of the \$1,950 paid to Respondent for the nonprovisional application.

Despite Respondent having been terminated by the Inventors, on [REDACTED], Respondent filed nonprovisional U.S. Patent Application No. [REDACTED] (“the application”), titled [REDACTED],” on behalf of the Inventors. The [REDACTED] application was not filed with a claim of priority. Before filing the [REDACTED] application, Respondent did not inform the Inventors that he was going to file the [REDACTED] application on [REDACTED], or consult with the Inventors about filing the [REDACTED] application without a claim of priority to the filing date of the [REDACTED] application. Also on [REDACTED], Respondent apologized to the Inventors for the delay in filing the [REDACTED] application, explaining that he had been “dealing with system migration issues on the new USPTO website, which has substantially changed the system.”

When Respondent filed the [REDACTED] application, he did not include the application filing fee that he had received from the Inventors, an Application Data Sheet, or an oath/declaration for any of the three Inventors. Respondent filed the [REDACTED] application with three power of attorney forms that purported to bear the Inventors’ signatures. However, the Inventors did not sign the power of attorney forms. Instead, Respondent electronically signed the names of the Inventors on the power of attorney forms by inserting the Inventors’ names between two “/” marks in the signature blocks of the power of attorney forms.

On [REDACTED], the USPTO mailed Respondent: (a) a Notice to File Missing Parts in the [REDACTED] application due to Respondent’s failure to include, among other things, the application filing fee and an Application Data Sheet naming each inventor or an oath/declaration; and (b) a Notice Regarding Power of Attorney in the [REDACTED] application, which stated that “the power of attorney in this application is not accepted” due to a failure to properly identify the party giving power. On [REDACTED], the USPTO mailed Respondent a Notice of Abandonment in the [REDACTED] application due to a failure to respond to the Notice to File Missing Parts.

Respondent did not notify the Inventors of the Notice to File Missing Parts, the Notice Regarding Power of Attorney, or the Notice of Abandonment. To date, Respondent has not provided a refund to the Inventors.

D. Respondent's Failure to Cooperate with the OED Investigation

On November 19, 2019, OED sent Respondent a Request for Information and Evidence under 37 C.F.R. § 11.22(f) ("RFI") via Certified Mail and U.S. Postal Service First-Class mail to his mailing address of record with OED. The RFI requested, among other things, that Respondent explain the circumstances surrounding his failure to respond to the Notice to File Missing Parts in the [REDACTED] application, his failure to timely file the [REDACTED] application, and whether, when, and how he obtained client signatures for the power of attorney forms in the [REDACTED] application.

Between November 19, 2019 and December 11, 2019, OED made several attempts to inform Respondent that an RFI was waiting for him in the P.O. Box mailing address of record. On December 20, 2019, Respondent informed OED that he had received the RFI and that he was "working on a response."

On January 21, 2020, OED mailed Respondent a Lack of Response Notice due to his failure to respond to the RFI, and on January 23, 2020, OED emailed Respondent about the Lack of Response Notice and asked him to confirm receipt.

On February 4, 2020, Respondent stated to OED that he was "working through the requests for information" and that he "will send [OED] a more detailed response" to the RFI. As of the filing date of the *Complaint*, Respondent had not provided OED a response to the RFI.

## CONCLUSIONS OF LAW

Based upon the foregoing findings of fact, the Court concludes that Respondent violated the following USPTO Rules of Professional Conduct, for the following reasons.

1. 37 C.F.R. § 11.103 provides that a practitioner "shall act with reasonable diligence and promptness in representing a client." Respondent violated this rule by (i) failing to pay the filing fee in the [REDACTED] application; (ii) failing to respond to the Notice to File Missing Parts in the [REDACTED] application; (iii) failing to file the [REDACTED] application with properly signed signatures on power of attorney forms; (iv) allowing the [REDACTED] application to become abandoned; (v) failing to respond to the Inventors' request for updates on the [REDACTED] application; (vi) failing to file the [REDACTED] application by the date the Inventors requested; (vii) failing to file the [REDACTED] application with the filing fee; (viii) failing to file the [REDACTED] application with properly signed signatures on power of attorney forms; (ix) failing to file the [REDACTED] application with an Application Data Sheet or an oath/declaration; and (x) failing to timely file the [REDACTED] application with a claim of priority to the [REDACTED] application.

2. 37 C.F.R. § 11.104(a)(2) provides that a practitioner shall "reasonably consult with the client about the means by which the client's objectives are to be accomplished."

Respondent violated this rule by failing to consult with the Inventors about filing the [REDACTED] application without claiming priority to the [REDACTED] application.

3. 37 C.F.R. § 11.104(a)(3) provides that a practitioner shall “[k]eep the client reasonably informed about the status of the matter.” Respondent violated this rule by (i) failing to notify the Inventors of the Notice to File Missing Parts, the USPTO postcard reminding Respondent to reply to the Notice to File Missing Parts, and the Notice of Abandonment in the [REDACTED] application; (ii) failing to provide the Inventors with updates on the status of the [REDACTED] application prior to its being filed after repeated requests to do so; (iii) failing to return the Inventors’ telephone calls; (iv) failing to inform the Inventors that the [REDACTED] application would be filed on [REDACTED]; and (v) failing to notify the Inventors of the Notice to File Missing Parts and the Notice Regarding Power of Attorney in the [REDACTED] application.

4. 37 C.F.R. § 11.104(b) provides that a practitioner “shall explain a matter to the extent reasonably necessary to permit the client to make informed decisions regarding the representation.” Respondent violated this rule by (i) failing to explain to the Inventors the substance of the Notice to File Missing Parts in the [REDACTED] application, the USPTO postcard reminding Respondent to reply to the Notice to File Missing Parts, and the Notice of Abandonment in the [REDACTED] application; (ii) failing to provide the Inventors with updates on the status of the [REDACTED] application prior to its being filed after repeated requests to do so; (iii) failing to return the Inventors’ telephone calls; (iv) failing to explain to the Inventors that the [REDACTED] application would be filed on [REDACTED]; and (v) failing to explain to the Inventors the substance of the Notice to File Missing Parts and the Notice Regarding Power of Attorney in the [REDACTED] application.

5. 37 C.F.R. § 11.116(a)(3) provides that “a practitioner shall not represent a client, or where representation has commenced, shall withdraw from the representation of a client if ... the practitioner is discharged.” Respondent violated this rule by failing to terminate representation by knowingly filing the [REDACTED] application after the Inventors had terminated his representation.

6. 37 C.F.R. § 11.116(d) provides that “[u]pon termination of representation, a practitioner shall take steps to the extent reasonably practicable to protect a client’s interests, such as giving reasonable notice to the client, allowing time for employment of other counsel, surrendering papers and property to which the client is entitled and refunding any advance payment of fee or expense that has not been earned or incurred.” Respondent violated this rule by (i) knowingly filing the [REDACTED] application after the Inventors terminated his representation; (ii) failing to file the [REDACTED] application properly with the application fee, proper identification of the inventors, and the correct attorney signatures on the power of attorney forms; and (iii) failing to return the funds for the USPTO filing fees paid to him by the Inventors and not paid to the USPTO.

7. 37 C.F.R. § 11.303(a)(1) provides that a practitioner shall not knowingly “[m]ake a false statement of fact or law to a tribunal or fail to correct a false statement of material fact or law previously made to the tribunal by the practitioner.” Respondent violated this rule by (i) knowingly applying the Inventors’ signatures to the power of attorney forms that



he filed in the [REDACTED] and [REDACTED] applications; and (ii) knowingly filing the [REDACTED] application after the Inventors terminated his representation.

8. 37 C.F.R. § 11.303(a)(3) provides that practitioner shall not knowingly “[o]ffer evidence that the practitioner knows to be false. If the practitioner ... has offered material evidence and the practitioner comes to know of its falsity, the practitioner shall take reasonable remedial measures, including, if necessary, disclosure to the tribunal.” Respondent violated this rule by (i) knowingly applying the Inventors’ signatures to the power of attorney forms that he filed in the [REDACTED] and [REDACTED] applications; and (ii) knowingly filing the [REDACTED] application after the Inventors terminated his representation.

9. 37 C.F.R. § 11.801(b) provides that Respondent shall not “fail to cooperate with the Office of Enrollment and Discipline in an investigation of any matter before it, or knowingly fail to respond to a lawful demand or request for information from an admissions or disciplinary authority.” Respondent violated this rule by failing to respond to the November 19, 2019 RFI.

10. 37 C.F.R. § 11.804(c) provides that Respondent shall not “engage in conduct involving dishonesty, fraud, deceit or misrepresentation.” Respondent violated this rule by (i) filing the [REDACTED] application after Respondent knew that the Inventors had terminated his representation; (ii) applying the Inventors’ names as purported signatures to the power of attorney forms filed in the [REDACTED] and [REDACTED] applications; and (iii) representing to the Inventors that he would submit the filing fees for the [REDACTED] and [REDACTED] applications, but failing to submit the fees to USPTO or to return the funds to the Inventors.<sup>4</sup>

11. 37 C.F.R. § 11.804(d) provides that Respondent shall not “engage in conduct that is prejudicial to the administration of justice.” Respondent violated this rule by (i) applying the Inventors’ names as purported signatures to the power of attorney forms filed in the [REDACTED] and [REDACTED] applications; (ii) filing the [REDACTED] application without authorization after being terminated; and (iii) failing to respond to the November 19, 2019 RFI.

## SANCTION

The OED Director has asked the Court to sanction Respondent by entering an order excluding him from practice before USPTO in patent, trademark, and other non-patent matters. The primary purpose of legal discipline is not to punish, but rather “to protect the public and the administration of justice from lawyers who have not discharged, will not discharge, or are unlikely properly to discharge their professional duties to clients, the public, the legal system,

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<sup>4</sup> The OED Director asserts that Respondent also violated § 11.804(c) by “concealing from the Inventors the Notice to File Missing Parts, the USPTO postcard reminding Respondent to reply to the Notice to File Missing Parts, and the Notice of Abandonment in the [REDACTED] and [REDACTED] applications.” However, the facts admitted on default are insufficient to establish that Respondent intentionally concealed the USPTO notices; if he merely neglected to inform his clients about them due to incompetence and/or lack of diligence, this conduct may not rise to the level of a violation of § 11.804(c). Because Respondent violated § 11.804(c) on other grounds, and because the Court has already found that his conduct in neglecting to inform his clients of the USPTO notices violated other provisions of the USPTO Rules of Professional Conduct, the Court deems it unnecessary to decide whether the conduct also violated § 11.804(c).

and the legal profession.” *In re Hormann*, Proceeding No. D2008-04, slip op. at 20 (USPTO July 8, 2009).<sup>5</sup>

In determining an appropriate sanction, USPTO regulations require this Court to consider the following four factors: (1) whether the practitioner has violated a duty owed to a client, the public, the legal system, or the profession; (2) whether the practitioner acted intentionally, knowingly, or negligently; (3) the amount of the actual or potential injury caused by the practitioner’s conduct; and (4) the existence of any aggravating or mitigating factors. See 37 C.F.R. § 11.54(b); see also *In re Morishita*, Proceeding No. D2017-25 (USPTO Sept. 28, 2018); *In re Lau*, Proceeding No. D2016-37 (USPTO May 1, 2017); *In re Schwedler*, Proceeding No. D2015-38 (USPTO Mar. 21, 2016).

A. Respondent violated duties owed to his clients, the public, and the legal profession.

The practitioner-client relationship is a fiduciary relationship in which the practitioner owes the client a duty to represent his or her interests diligently and in good faith. See *Moatz v. Bender*, Proceeding No. D2000-01, slip op. at 20 (USPTO Sept. 30, 2003) (“Respondent owed a fiduciary duty individually to each of his clients.”); *Carter v. ALK Holdings, Inc.*, 605 F.3d 1319, 1325 (Fed. Cir. 2010) (referencing patent practitioner’s expected fiduciary duties to clients); see also *In re Law Examination of 1926*, 210 N.W. 710, 711 (Wis. 1926) (“An attorney occupies a fiduciary relationship towards his client. It is one of implicit confidence and of trust ... There is no field of human activity which requires fuller realization with respect to a fiduciary relationship than that which exists between the lawyer and his client.”).

The record overwhelmingly demonstrates that Respondent breached his duty to diligently and faithfully represent his clients’ interests by generally not acting in the best interest of the Inventors. Rather, he acted in his own interest. Respondent filed applications with false signatures, failed to pay the application fees, failed to inform the Inventors of the Notice to File Missing Parts, and allowed the [REDACTED] application to go abandoned.

Further, after accepting \$1,950 to file the [REDACTED] application and being told that the application was needed “as fast as possible” so that the Inventors could commercialize the patent to prospective customers, Respondent repeatedly failed to timely respond to the Inventors’ requests for status updates and failed to file the [REDACTED] application on the date that they requested. Respondent’s inattention to the [REDACTED] application caused the Inventors to terminate their relationship with Respondent, demand a refund, and hire new counsel. Inexplicably, after the termination, and without authority from the Inventors, Respondent filed the [REDACTED] application. To make matters worse, Respondent filed the [REDACTED] application without a claim for priority to the [REDACTED] application as requested by the Inventors.

Respondent also violated duties he owed to the public and the legal system by failing to follow basic procedures for this proceeding. After Respondent received a copy of the *Complaint*, he failed to file an answer or otherwise participate in the proceedings before this Court, thereby imperiling the orderly functioning of the disciplinary process. See *In re Lau*, *supra*.

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<sup>5</sup> All USPTO disciplinary decisions cited in this opinion are available at <https://foiadocuments.uspto.gov/oed/>.

B. Respondent acted intentionally and knowingly.

Respondent's acts and omissions were intentional and knowing. First, Respondent applied the Inventors' names as purported signatures to the power of attorney forms filed in the [REDACTED] and [REDACTED] applications. Respondent knew or should have known that this was not allowed, given his status as a registered patent practitioner and given the express statement in the signature block that "[t]his form must be signed by the applicant." And although Respondent received funds from the Inventors to pay the filing fees for the [REDACTED] and [REDACTED] applications, he did not pay these fees. As a registered patent agent since 2003, Respondent knew or should have known of the need to pay the filing fees.

Although Respondent received from the USPTO a Notice to File Missing Parts due to the missing filing fees for the [REDACTED] application, a postcard reminding him to respond to the Notice to File Missing Parts, and, later, a Notice of Abandonment, Respondent failed to inform the Inventors of these notices or to pay the filing fees, resulting in the [REDACTED] application becoming abandoned. Thus, Respondent knowingly failed to keep his clients informed about the status of the [REDACTED] application and knowingly allowed the application to become abandoned.

The USPTO has excluded practitioners for allowing patent applications to go abandoned. See, e.g., *In re Hormann*, supra (excluding practitioner for, among other things, allowing patent applications to go abandoned without the clients' consent and failing to notify clients of abandonments); *In re Iussa*, Proceeding No. D2020-25 (USPTO Nov. 2, 2020). Practitioners have also been excluded for knowingly, intentionally, or negligently failing to advise a client of important Office communications in violation of the ethics rules. See, e.g., *In re Myers*, Proceeding No. D2015-33 (USPTO Dec. 31, 2015) (excluding practitioner for, *inter alia*, allowing multiple patent applications to go abandoned without client consent and failing to notify the client of important Office communications); *Moatz v. Rosenberg*, Proceeding No. D2006-07 (USPTO Mar. 7, 2007) (excluding practitioner for failing to inform client of important Office communications). Accordingly, Respondent's knowing misconduct in relation to the [REDACTED] application, alone, could be sufficient to support a sanction of exclusion.

Furthermore, Respondent engaged in additional knowing and intentional misconduct in relation to the [REDACTED] application. Respondent accepted \$1,950 from the Inventors to prepare and file the [REDACTED] application as quickly as possible. But despite the Inventors' repeated inquiries about the status of the [REDACTED] application, Respondent repeatedly ignored their requests for updates and knowingly failed to file the application by the date requested. Then, when the Inventors specifically asked for a refund and notified Respondent that they were terminating his representation, Respondent ignored their request for a refund, kept the unearned funds, and, without authorization, filed the [REDACTED] application. This misconduct can only be described as intentional. Intent is the highest level of culpability. Respondent's intentional misconduct further warrants a sanction of exclusion.

Finally, Respondent acknowledged receipt of both the RFI sent to him during the disciplinary investigation and the *Complaint* that initiated this disciplinary proceeding, but knowingly failed to participate in the investigation or in the proceeding before this Court. This additional knowing misconduct supports imposition of a severe sanction. See, e.g., *In re Ho*,

Proceeding No. D2009-04, slip op. at 8 (USPTO Jan. 30, 2009) (excluding practitioner on default after he “knowingly failed to provide information requested by OED and intentionally failed to cooperate with OED’s investigation”).

C. The Inventors suffered actual injuries.

Although “[t]he harm from the violation need not be actual,” *In re Fuess*, Proceeding No. D2015-08, slip op. at 64 (USPTO July 21, 2017), Respondent did cause actual injury to the Inventors in this case by allowing the [REDACTED] application to become abandoned, filing the [REDACTED] application after he was terminated, failing to have the [REDACTED] application claim priority to the [REDACTED] application, failing to communicate the status of the [REDACTED] application to the Inventors upon request, and failing to file the [REDACTED] application by the date requested. As a result of Respondent’s conduct, the Inventors had to pay to retain new counsel to adequately prosecute the [REDACTED] application. Despite a request for a refund of unearned filing fees, Respondent did not provide the Inventors with a refund. Respondent’s harmful misconduct warrants a lengthy sanction. *See, e.g., In re Coyle*, Proceeding No. D2016-16, slip op. at 8 (USPTO July 26, 2016) (excluding practitioner who caused actual injury when he abandoned a patent application and failed to return payment for services that he did not perform).

D. Aggravating factors exist which support imposition of the sanction of exclusion.

The STANDARDS FOR IMPOSING LAWYER SANCTIONS, (“STANDARDS”), published by the American Bar Association, set forth aggravating and mitigating factors for the Court to consider in determining an appropriate sanction. Citing § 9.22 of the STANDARDS, the OED Director contends that the following seven aggravating factors warrant a more severe sanction in this case: a dishonest or selfish motive; a pattern of misconduct; multiple violations; bad faith obstruction of the disciplinary proceeding; refusal to acknowledge the wrongful nature of the conduct; substantial experience in the practice of law; and indifference to making restitution.

The first factor for consideration is a “dishonest or selfish motive.” *See* STANDARDS § 9.22(b). The OED Director argues that Respondent acted with a dishonest and selfish motive when he failed to pay the filing fees for the [REDACTED] and [REDACTED] applications and instead kept his clients’ money for himself; filed the [REDACTED] application after the Inventors had terminated his representation, presumably in an attempt to avoid having to refund the money they had given him to file the application; and ignored the Inventors’ repeated requests for updates on the [REDACTED] application, which allowed him to conceal his failure to address the Notice to File Missing Parts in the [REDACTED] and [REDACTED] applications and the abandonment of the [REDACTED] application.

Although this conduct appears dishonest and selfish, on default judgment, there is not enough evidence to determine Respondent’s motives with certainty. *Cf. In re Goucher*, Proceeding No. D2019-36, slip op at 13 (USPTO Feb. 5, 2020) (“The record [on default] does not shed light on Respondent’s motives in engaging in misconduct during client representations and failing to participate in the disciplinary proceeding. Accordingly, the Court cannot fairly find that Respondent acted with a dishonest or selfish motive or engaged in bad faith obstruction of the disciplinary proceeding.”). But it is clear Respondent committed knowing and intentional misconduct and achieved a dishonest and self-serving result.

Similarly, although Respondent has failed to participate in the disciplinary proceedings against him, the evidence regarding his motives is insufficient to show intentional, bad faith obstruction. Nonetheless, Respondent's failure to cooperate in the disciplinary investigation or in the proceedings before this Court demonstrates a knowing disregard of his obligations to the USPTO and the Court; indifference toward the disciplinary system; and a want of professional responsibility.

The OED Director asserts that Respondent's "pattern of misconduct" is an aggravating factor in this case. See STANDARDS § 9.22(c). The Court agrees that Respondent has displayed a pattern of engaging in similar misconduct over time. In 2017, in a separate matter, Respondent filed an application containing false information (a false address for the inventor), failed to pay the filing fees for the application, failed to adequately communicate with the inventor, allowed the application to go abandoned, and failed to cooperate with OED when it investigated his misconduct. Respondent committed very similar misconduct in 2018-2019 while representing the Inventors. Respondent filed the [REDACTED] and [REDACTED] applications with improperly signed power of attorney forms, failed to pay the filing fees for these applications, and failed to adequately communicate with the Inventors about their applications, and his actions led to the [REDACTED] application becoming abandoned. Also, Respondent did not cooperate with OED's investigation. Respondent's pattern of misconduct is an aggravating factor in this case. See *In re Halling*, Proceeding No. D2019-10, slip op. at 9 (USPTO June 13, 2019) (finding pattern of misconduct where respondent repeatedly failed to communicate with one client).

An additional aggravating factor is the commission of "multiple offenses." See STANDARDS § 9.22(d). Multiple offenses committed in the context of a single disciplinary proceeding may be an aggravating factor. See *In re Flindt*, Proceeding No. D2016-04 (USPTO Aug. 4, 2017) (finding that practitioner committed "multiple offenses" when he violated six separate provisions of the Rules); *In re Fuess*, supra (considering practitioner's violation of multiple Rules to be an aggravating factor). Here, Respondent's misconduct violated eleven provisions of the disciplinary rules.

Another aggravating factor is Respondent's refusal "to acknowledge the wrongful nature of his ... conduct." See STANDARDS § 9.22(g). A practitioner's lack of remorse warrants a more severe sanction. See *In re Stecewycz*, Proceeding No. D2014-15, slip op. at 37 (USPTO May 5, 2016) ("[F]ailure to acknowledge the wrongful nature of [the] misconduct or show any remorse for [the] conduct is a weighty factor in aggravation."). Respondent has not displayed any remorse for his actions. He never apologized to the Inventors for his inattention to their [REDACTED] and [REDACTED] applications. Nor has Respondent expressed any remorse for intentionally disregarding OED's RFIs during the investigation of this matter.

"[S]ubstantial experience in the practice of law" is an additional aggravating factor in this case, as a lawyer with a great deal of experience should know better than to engage in misconduct. See STANDARDS § 9.22(i); *In re Anderson*, Proceeding No. D2019-03, slip op. at 18-19 (USPTO July 1, 2019) (finding that practitioner's more than nine years of experience was an aggravating factor). The USPTO registered Respondent as a patent agent in 2003. Thus, Respondent had been licensed to practice before the Office for approximately fifteen years when

he committed the misconduct at issue here. In light of Respondent's many years of experience, Respondent surely knew better than to engage in the misconduct described herein. See, e.g., *In re Vickers*, 729 S.E.2d 355, 356 (Ga. 2012) (finding that several aggravating factors, including lawyer's six years of experience, warranted disbarment).

A final aggravating factor in this case is an "indifference to making restitution." See STANDARDS § 9.22(j); *In re Myers*, Proceeding No. D2015-33 (USPTO Dec. 31, 2015) (finding practitioner's failure to return prepaid filing fees to be an aggravating factor supporting exclusion); *In re Goucher*, supra (USPTO Feb. 5, 2020) (recognizing aggravating factor where practitioner made no effort to compensate clients for abandoned applications or to reimburse client \$3,000 for patent application that was never filed). Although the Inventors have sought a refund from Respondent, he has shown an indifference to making restitution and, to date, has not provided the Inventors with any refund. See *In re Gilboy*, Proceeding No. D2019-56, slip op. at 40 (USPTO July 20, 2020) (finding indifference to making restitution where practitioner, *inter alia*, failed to reimburse clients for services never provided).

Although the STANDARDS identify mitigating factors which, if they exist, may justify a reduction in the degree of discipline to be imposed, see STANDARDS § 9.31, Respondent has chosen not to participate in this proceeding. Therefore, he has presented no evidence of any mitigating factors.

The foregoing aggravating factors, along with the actual injury Respondent caused to his client, the knowing and intentional nature of his conduct, and the fact that he violated duties owed to the client, the public, and his profession, warrant the sanction of exclusion in this case.

## CONCLUSION

Because Respondent has failed to answer the *Complaint* or otherwise appear in this matter, Respondent is found to be in **DEFAULT** and to have admitted all the allegations in the *Complaint*.

Based on the facts hereby admitted, this Court finds that Respondent has violated the USPTO Rules of Professional Conduct as discussed above.

After analyzing the factors enumerated in 37 C.F.R. § 11.54(b), this Court concludes that Respondent's misconduct warrants the sanction of exclusion. Accordingly, Respondent shall be **EXCLUDED** from practice before the U.S. Patent and Trademark Office in patent, trademark, and other non-patent matters.<sup>6</sup>

So **ORDERED**,

**ALEXANDER  
FERNANDEZ**

Digitally signed by: ALEXANDER  
FERNANDEZ  
DN: CN = ALEXANDER FERNANDEZ  
C = US O = U.S. Government OU =  
Department of Housing and Urban  
Development, Office of the Secretary  
Date: 2021.04.20 13:43 20 -04'00'

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Alexander Fernández  
United States Administrative Law Judge

**Notice of Required Actions by Respondent:** Respondent is directed to refer to 37 C.F.R. § 11.58 regarding his responsibilities in the case of suspension or exclusion.

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

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<sup>6</sup> An excluded practitioner is eligible to apply for reinstatement no earlier than five years from the effective date of the exclusion. See 37 C.F.R. § 11.60(b). Eligibility is predicated upon full compliance with 37 C.F.R. § 11.58.