Commissioner of Patents and Trademarks
Patent and Trademark Office (P.T.O.)

CAMERON WEIFFENBACH, DIRECTOR, OFFICE OF ENROLLMENT AND DISCIPLINE
v.
F. WESLEY TURNER, RESPONDENT
Disciplinary Proceeding D89-6
March 26, 1991

Douglas B. Comer

Deputy Commissioner of Patents and Trademarks

MEMORANDUM OPINION AND FINAL ORDER

BACKGROUND

***1** F. Wesley Turner ("Turner") appeals to the Commissioner of Patents and Trademarks under 37 CFR § 10.155 from an Initial Decision of the Chief Administrative Law Judge of United States Department of Commerce (Hon. Hugh J. Dolan), in a disciplinary proceeding under 37 CFR Part 10.

The Director of the Office of Enrollment and Discipline ("OED") charged Turner with three Counts of misconduct:

Count 1

In holding himself out as a member of a partnership by using the firm name "Turner, Murray & Whisenhunt" on letterhead in a manner implying or stating that a partnership exists or existed, and that members of said partnership were authorized to practice law in the state of New York, Respondent did fail and/or refuse to exercise his duty to refrain from conduct involving dishonesty, fraud, deceit or misrepresentation which is required of those registered to practice before the PTO.

Count 2

In failing or refusing to communicate with and return telephone calls to clients and/or failing or refusing to promptly provide patent searches for which Respondent had been retained by clients, Respondent engaged in unethical conduct.

Count 3

In failing and/or refusing to cooperate with the Office of Enrollment and Discipline in connection with investigations by [not] responding to questions posed to him, Respondent engaged in unethical

conduct.

The Director requested that Turner be suspended or excluded from further practice before the Patent and Trademark Office. The ALJ's Initial Decision was rendered on October 2, 1990, in which the ALJ ordered that Turner be barred from further practice before the Patent and Trademark Office.

The ALJ held in the Initial Decision that Turner never filed a proper Answer. Also, no hearing before the ALJ was ever held. The Initial Decision noted at 8:

> This is essentially a default decision. For more than three years the Respondent has avoided direct and timely responses to the serious questions which have been raised.

The following excerpt from the Initial Decision at 1-2 describes the course of proceedings before the ALJ:

> This is a disciplinary proceeding initiated under 35 U.S.C. § 32 and 37 C.F.R. Part 10 against a patent agent [Footnote omitted.] registered to practice before the Patent and Trademark Office (PTO) (Registration No. 26,059). In the Complaint and Notice of Proceeding under 35 U.S.C. 32 dated October 20, 1989, Respondent is charged with three counts of misconduct. The complaint was returned by the U.S. Postal Service and a second copy was remailed to Respondent on November 22, 1989. Since an answer was not filed within the required 30 days, Respondent was found to be in default by order of the Administrative Law Judge on November 28, 1989. At the request of the Director, the order was withdrawn on December 5, [1989] based upon the failure to effect service. The copy of the complaint also was returned and service was made by publication in the Official Gazette for four weeks starting on January 30, 1990 and ending on February 20, 1990.
>
> ***2** On March 6, 1990, Respondent called Counsel for the Director and requested a copy of the complaint. Another copy of a complaint was mailed by the Director to Respondent on March 9, 1990. On April 4, 1990, Respondent requested a 30-day extension of time to file an answer. On April 5, 1990, Respondent filed a preliminary answer denying all counts. On April 9, 1990, the unopposed request for an extension was granted by the undersigned and Respondent was given until May 10, 1990 to respond indicating that "[n]o further extension should be expected!"
>
> On May 21, 1990, Respondent filed an answer which was rejected together with the two prior answers in an order dated June 18, 1990. The three answers failed to include the information required by 37 C.F.R. part 10 and in particular, 37 C.F.R. § 10.136. Respondent was given until July 16, 1990 to file a proper answer and advised that no further extensions would be granted.
>
> On July 16, 1990, Respondent requested copies of returned correspondence referred to in the order of June 18, 1990 and indicated that he would "continue [his] response after September 3-7, 1990" because he would be traveling from July 16th - September 3, 1990. This response failed to comply with 37 C.F.R. § 10.136(d) and in an order dated July 25, 1990 the specific allegations in the complaint are deemed to be admitted and considered proven.

In his order of July 25, 1990, the ALJ stated that the parties would have 30 days to file their respective pre-adjudication arguments, and would thereafter have an additional 15-days to file any rebuttal. Also, the ALJ stated that the record will close for the Initial Decision as of October 1, 1990.

In response the ALJ's Order, the Director timely filed his pre-adjudication arguments, while Turner filed only a fourth "Answer" after business hours on October 1, 1990. Regarding Turner's submission, the Initial Decision at 8 n. 7, stated:

After business hours on October 1, 1990, a fourth filing titled "Answer To A Complaint And Notice of Proceeding Under 35 U.S.C. 32" was received by facsimile in the Office of the Administrative Law Judge. It does not constitute an Answer to the Complaint under the applicable regulation 37 C.F.R. § 10.136 and, as such, it is rejected. The filing is principally a complaint that the Agency has not furnished him with copies of his own records which he apparently has not maintained. He has not shown any follow up nor made a request to this Tribunal to obtain these documents for over three months. Nor did he file exception to the Order of July 25, 1990 which set the schedule for processing this matter. His untimely request for a further extension is denied.

The telephone log of this office reflects that Respondent placed calls to the Office of the Administrative Law Judge on September 28 and October 1, 1990. The Administrative Law Judge was not in the office on September 28. On October 1, the calls were returned by a staff member. Respondent should have been and was made aware that "ex parte" conversations are avoided and all communications relating to the substance of the proceeding should be by written submission and placed in the record. The most recent filing by Respondent contains no basis for deferring the decision in this matter.

***3** The ALJ made the following findings and conclusions of law (Initial Decision at 7-8):

Findings

1. F. Wesley Turner (Respondent) is an agent registered to practice (Registration No. 26,059) before the Patent and Trademark Office (PTO).

(Charge 1)

2. During May, 1985, Respondent used letterhead of the law firm of Turner, Murray and Whisenhunt.

3. The law firm of Turner, Murray and Whisenhunt does not exist.

4. During May, 1985, Respondent knowingly held himself out as a partner of a non-existent law firm.

5. During May, 1985, Respondent knowingly held himself out as a partner of a non-existent law firm to several clients for whom he agreed to perform a patentability search and prepare a patent application.

(Charge 2)

6. Respondent did not promptly conduct a patentability search for the

Schwartzes.

7. Respondent did not promptly return telephone calls from the Schwartzes.

8. When he failed to perform the search, respondent did not return the full amount of the retainer fee to Dr. Schwartz.

9. Respondent did not promptly return telephone calls from Mr. Armel.

10. When he failed to perform the search, Respondent did not promptly return the retainer fee to Mr. Armel.

(Charge 3)

11. Respondent failed to return the completed questionnaire from the Office of Enrollment and Discipline.

## Conclusions of Law

(Charge 1)

1. Respondent's letterhead referring to a non-existent law firm violated 37 C.F.R. § 10.35(b).

2. Respondent's use of the name of a non-existent law firm was conduct involving dishonesty, fraud, deceit and misrepresentation in violation of 37 C.F.R. § 10.23(b)(4).

3. Respondent's knowingly giving false and misleading information about the status of his law firm to two clients in connection with conducting a patent search and preparing a patent application violated 37 C.F.R. § 10.23(c)(2)(i).

(Charge 2)

4. Respondent's failure to promptly perform a patent search for the Schwartzes, to promptly return their telephone calls and to promptly return their retainer fee violated 37 C.F.R. § 10.84.

5. Respondent's failure to promptly perform a patent search for Mr. Armel, to promptly return his telephone calls and to promptly return his retainer fee violated 37 C.F.R. § 10.84.

(Charge 3)

6. Respondent's willful failure to promptly return to the Office of Enrollment and Discipline a completed questionnaire violated 37 C.F.R. § 10.23(c)(16).

General

7. The three charges are supported by clear and convincing evidence. 37 C.F.R. § 10.149.

The ALJ also concluded (Initial Decision at 9) that Turner violated disciplinary rules DR1-102(A)(4) and DR2-102(C) of the Code of Professional Conduct of the American Bar Association.

OPINION

***4** Chapter 1, Part 10, of Title 37 of the Code of Federal Regulations governs the conduct of practitioners before the Patent and Trademark Office, and was first promulgated in 1985. The effective date of all provisions of Part 10 was March 8, 1985. See 50 Fed.Reg. 5158 (Feb. 6, 1985). Since Turner's conduct underlying all three Counts occurred subsequent to the effective date of Part 10, review will be limited to solely the applicable provisions of Part 10. Thus, whether Turner's conduct also separately violates certain disciplinary rules of the Code of Professional Conduct of the American Bar Association is not at issue. Since the ALJ applied the applicable provisions of 37 CFR Part 10, his further discussion of DR1-102(A)(4) and DR2-102(C) of the Code of Professional Conduct of the American Bar Association was necessary.

A decision in this appeal is based on the administrative record before the ALJ. 37 C.F.R. § 10.155(b) Accordingly, submission of new evidence not previously before the ALJ is inappropriate.

Of the twenty-six Respondent's Exhibits (1 through 26) submitted by Turner in connection with this appeal, only eight are part of the administrative record before the ALJ--Respondent's Exhibit 1 (included in Government's Exhibits 1 and 3); Respondent's Exhibit 2 (included in Government's Exhibit 4); Respondent's Exhibit 3 (Respondent's submission of May 21, 1990, to the ALJ); Respondent's Exhibit 6 (same as Government's Exhibit 18); Respondent's Exhibit 8 (same as Government's Exhibit 15 before the ALJ); Respondent's Exhibit 11 (same as Government's Exhibit 9); Respondent's Exhibit 23 (same as portions of Government's Exhibit 9); and Respondent's Exhibit 25 (same as Government's Exhibit 19).

For purposes of this appeal, only Respondent's Exhibits 1, 2, 3, 6, 8, 11, 23, and 25 have been considered. All other Respondent's Exhibits are not a part of the administrative record before the ALJ; accordingly, they have been sealed and have not been considered. In contrast, all of the Government's Exhibits were properly before the ALJ and thus have been considered.

There is no legitimate reason to reopen the disciplinary proceeding in order to have the ALJ consider Turner's new submissions. The submissions are not of the "newly discovered" type which might justify granting of new trials, and Turner has not demonstrated that the evidence could not have been submitted earlier and also would have been

of significance.

Nevertheless, the following comments pertain to Respondent's Exhibits 9 and 10 which are both discussed in papers submitted on appeal from the ALJ's decision.

Respondent's Exhibit 9 is a copy of a photograph of Turner's office [[submitted to show that it would be clear to new clients that Turner was a sole practitioner]; it does not help Turner's cause. Nothing requires that all partners in a law firm practice at the same address, and the charge against Turner stems from improper use of letterhead, not from any allegation that the office setting caused a false impression.

***5** Respondent's Exhibit 10 is a copy of United States Patent No. 4,485,152, in which only Turner's name is identified in the place for Attorney, Agent, or Firm, and which is allegedly customarily shown to new clients[[submitted to show indication to new clients that Turner was a sole practitioner]. It also does not help Turner's cause. On the face of any issued patent, at the location designated for identification of Attorney, Agent, or Firm, an attorney or agent of record is free to list his or her own name rather than the name of the partnership in which he or she practices. Also, whatever the patent shows, the use of letterhead which falsely suggest the existence of a non-existent partnership is nevertheless improper.

A. Count 1, Non-Existent Partnership

Turner has not denied that on or about May 9, 1985, he prepared a retainer agreement subsequently executed by Dr. Sidney Schwartz and his son Paul ("Schwartzes"), on a letterhead which bears the firm name Turner, Murray & Whisenhunt. The agreement refers to services to be rendered including a patentability search and preparation of a patent application. The copy of the retainer agreement in the record (Government Exhibit 1) reflects that the wording "Attorneys at Law" immediately follows the name Turner, Murray & Whisenhunt on the letterhead.

Turner also has not denied that in May, 1985, he prepared a retainer agreement subsequently executed by Mr. Armel, on a letterhead which bears the firm name Turner, Murray & Whisenhunt. The agreement refers to services including a patentability search and preparation of a patent application. The copy of the retainer agreement in the record (Government Exhibit 2) reflects that the wording "Attorneys at Law" immediately follows the name Turner, Murray & Whisenhunt on the letterhead.

Turner has not denied that the Schwartzes pursuant to their retainer agreement gave Turner a personal check, dated May 8, 1985, made out to Turner, Murray & Whisenhunt as an advance payment, and that the check was cashed and endorsed with the firm's name and Turner's name (Government Exhibit 3). Turner also has not denied that pursuant to Mr. Armel's retainer agreement, Mr. Armel gave Turner a check made out to Turner, Murray & Whisenhunt as an advance payment, and that the check was cashed and endorsed with the firm's name and Turner's name

(Government Exhibit 5).

The ALJ found that during May, 1985, Turner used letterhead of the law firm of Turner, Murray and Whisenhunt. The retainer agreement with the Schwartzes and the retainer agreement with Mr. Armel constitute direct and more than sufficient evidence in support of that finding. In addition, the designation of Turner, Murray & Whisenhunt as the payee on the checks made by the Schwartzes and by Mr. Armel, and the endorsement of those checks by the firm name, give further support for the ALJ's finding.

Turner admits that there is no business relationship between himself and Messrs. Murray and Whisenhunt (Answer, May 21, 1990, page 5). That admission manifestly supports the ALJ's finding that the law firm of Turner, Murray & Whisenhunt does not exist.

***6** The ALJ found that during May, 1985, Turner knowingly held himself out as a partner of a non-existent law firm; the ALJ also found that during May, 1975, Turner knowingly held himself out as a partner of a non-existent law firm to several clients for whom he agreed to perform a patentability search and prepare a patent application. The two retainer agreements, one with the Schwartzes and one with Mr. Armel, together with Turner's admission that there is no business relationship between he and Messrs. Murray and Whisenhunt, constitute more than sufficient evidence in support of those findings. In addition, the designation of Turner, Murray & Whisenhunt as the payee on the checks made by the Schwartzes and by Mr. Armel, and the endorsement of those checks by the firm name, given further support for those ALJ findings.

Turner incorrectly argues that his use of the letterhead at issue is protected by the first amendment right to freedom of speech under the first amendment (Br. 1, January 10, 1991). Protected commercial speech under the first amendment does not include that which is false, deceptive, or misleading. Zauderer v. Office of Disciplinary Counsel of the Supreme Court of Ohio, 471 U.S. 626, 638 (1985); the letterhead involved in this case falsely suggests that Turner practices in a non-existent partnership.

Furthermore, in the administrative record there is a firm resume (Government Exhibit 15) furnished by Turner to Dr. Schwartz (Initial Decision at 3 n. 2). The resume indicates that Turner is in a law partnership with Messrs. Murray and Whisenhunt, and that the firm includes two other associate attorneys and a support staff of four non-lawyers. Turner has not denied giving Dr. Schwartz the firm resume. Nor has he taken a definite position on why the resume was given to Dr. Schwartz. Rather, he argues (Br. 5, November 9, 1990):

> It is possible that Respondent shared Respondents private and personal conception of the type of persons and an organization that Respondent had thought could be of value to the local business interest, i.e., a 1983-84 association/organizational that included Robert Murray and Fred Whisenhunt among others. Please Note: Respondent's Exhibit 8 (which appears to be a duplicate of the PO's Exhibit 15). [Emphasis in original].

The argument is without merit. There is no evidence in the record to support the notion that Turner informed Dr. Schwartz that the information on the firm resume is only a failed plan. Insofar as Turner refers only to possibilities, it is equally possible that the firm

resume was given to Dr. Schwartz to establish a false impression that Turner practiced in a partnership.

Turner argues that the firm resume "lacks credibility as a possible or probable 1985 publication since the foreign associate list does not describe the foreign patent correspondents used by the Respondent-Appellant in 1985" (Br. 4 January 10, 1991). The argument is without merit. While the firm resume lists a number of foreign associates in other countries, whether Turner actually used any of the listed foreign associates in 1985 is not at issue. Nothing requires that the list include every foreign associate with which Turner has an on-going business relationship, and nothing prevents Turner from sending work to someone not appearing on the list. Furthermore, there is nothing in the administrative record to show whether none of the listed foreign associates was used by Turner in 1985.

***7** In any event, Turner was not charged with improper distribution of the firm resume. The resume evidence is consistent with and thus supports the ALJ's findings concerning Turner's improper use of letterhead.

Turner argues that throughout the period 1982-1986, he held himself out as a sole practitioner by consistently using the following name and business address for all patent matters when corresponding with clients and various Patent and Trademarks Offices including the United States Patent and Trademark Office (Br. 5, January 10, 1991):

> F. Wesley Turner
> 125 Wolf Road, 5th Floor
> Executive Law Offices 503-8
> Albany, New York 12205

The argument has no merit, because the charge relates to false suggestion stemming from Turner's improper use of letterhead, and not how Turner signed correspondence, or how his address was designated. In addition, the administrative record does not include all of Turner's correspondence in patent matters from 1982-1986.

Based on the foregoing evidence, the ALJ correctly concluded that: (1) Turner's letterhead referring to a non-existent law firm violated 37 C.F.R. § 10.35(b); (2) Turner's use of the name of a non-existent law firm was conduct involving dishonesty, fraud, deceit and misrepresentation in violation of 37 C.F.R. § 10.23(b)(4); and (3) Turner's knowingly giving false and misleading information about the status of his law firm to two clients in connection with conducting a patent search and preparing a patent application violated 37 C.F.R. § 10.23(c)(2)(i).

Section 10.35(b) of Title 37, Code of Federal Regulations, states:

> (b) Practitioners may state or imply that they practice in a partnership or other organization only when that is the fact.

Section 10.23(b)(4) of Title 37, Code of Federal Regulations, prescribes that a practitioner shall not:

> Engage in conduct involving dishonesty, fraud, deceit, or misrepresentation.

Section 10.23(c)(2)(i) prohibit a practitioner from:

> Knowingly giving false or misleading information or knowingly

participating in a material way in giving false or misleading information, to [a] client in connection with any immediate, prospective, or pending business before the Office.

Turner cites a discussion of the Court of Appeals of New York, New York Criminal and Civil Courts Bar Association v. Jacoby, 61 N.Y. 2d 130, 460 N.E.2d 1325 (1984). He argues that under Jacoby, the use of an institutional name composed of surnames is not representing that there are lawyers bearing those names and admitted in a particular jurisdiction, or even that there are lawyers in the institution who bear such surnames, admitted to practice anywhere.

Jacoby is not apposite to this case. It does not involve an administrative regulation such as 37 C.F.R. § 10.35(b) which prescribes that a practitioner state or imply that he is in a partnership only when that is a fact. Moreover, while there was an actual partnership of lawyers in Jacoby by the Institutional name, no such partnership exists under the facts of this case. The issue here is whether the institutional name appearing on Turner's letterhead, Turner, Murray & Whisenhunt, identifies a real partnership, not whether there are persons named Murray and Whisenhunt, and if so, where they are admitted to practice law.

***8** In contrast, Florida Bar v. Hastings, 523 So.2d 571 (Fla.Sup.Ct.1988) is more pertinent. Florida Bar is a disciplinary case involving DR 2-102(C), a disciplinary rule of the former Code of Professional Responsibility of the Florida Bar, which provides:

> A lawyer shall not hold himself out as having a partnership with one or more other lawyers or professional corporations unless they are in fact partners.

The respondent in Florida Bar, Hastings, stipulated that by practicing law under the firm name of Hastings and Goldman without actually having a partnership relation with Mr. Goldman insofar as ownership was concerned, he violated DR 2-102(C).

Turner points out that in the retainer agreements he signed his own name without also printing the institutional name before his signature. Though that is true, the charges stem from the use of improper letterhead, not from representations arising from how Turner's signature was signed. That the firm name does not again appear immediately before Turner's signature does not negate the false suggestion arising from the improper letterhead that Turner practices in a partnership.

Turner argues that the designation of Turner, Murray & Whisenhunt as the payee on checks from Dr. Schwartz and Mr. Armel and his endorsement of those checks by the firm name may well be for reasons other than noting that Turner was in a partnership. It is not necessary, however, to guess, or to have findings on the precise reasons, why the firm name was designated as the payee and why the checks were so endorsed. Nevertheless, Turner's endorsement of the checks is consistent with the false impression, if any, that Turner practices in a partnership, conveyed through improper use of letterhead, and does not undermine the ALJ's findings.

Turner's Answer of May 20, 1990, stated that "[Turner] advised referrals that [he] was a sole practitioner who was registered to

practice before the US Patent and Trademark office in regard to patent matters." Turner argues that his Answer of May 20, 1990, also stated that he specifically pointed out to new referrals that the surnames Murray and Whisenhunt merely reflected knowledgeable contacts in Arlington, Virginia. Turner also argues that his Answer of May 20, 1990, indicated that he frequently shared with new referrals the information that Messrs. Murray and Whisenhunt were only acquaintances who agreed to work with Turner in being supportive at their discretion of Turner's patent activities on a case-by-case basis.

Turner does not assert that he specifically informed either Dr. Schwartz or his son, or Mr. Armel, that he was a sole practitioner. Turner also does not assert that he specifically informed either Dr. Schwartz or his son, or Mr. Armel, that Messrs. Murray and Whisenhunt were not in any partnership with Turner. What Turner does assert is with respect to new referrals as a group. Even as to new referrals as a group, however, Turner submitted no evidence to show that he customarily explained that he was a sole practitioner or that Messrs. Murray and Whisenhunt were merely acquaintances, not partners. Even if there were such evidence, the improper use of letterhead in the particular instances of the Schwartzes and Mr. Armel suggests that on those two occasions Turner departed from any such customary practice.

***9** Turner argues that the administrative record includes no evidence that any client has ever been actually misled. The argument is without merit. First, 37 C.F.R. § 10.35(b) prohibits conduct on the part of the practitioner falsely stating or implying that he practices in a partnership, without regard to whether a client actually relied on that misinformation. Similarly, a violation of neither 37 C.F.R. § 10.23(b)(4) nor 37 C.F.R. § 10.23(c)(2)(i) requires actual reliance by a client on false or misleading information originating from a practitioner. Thus, even if Turner otherwise informed the Schwartzes and Mr. Armel that he is a sole practitioner, the use of a letterhead suggesting the existence of a non-existent partnership is nevertheless a violation of the regulations. And if actual reliance is required for establishing a violation of the regulations, Turner's improper use of letterhead supports a rebuttable presumption that there was such reliance. Turner has submitted no evidence to rebut the presumption.

B. Count 2, Unzealous Representation

Section 10.84 of Title 37 of the Code of Federal Regulations states:

§ 10.84 Representing a client zealously.

(a) A practitioner shall not intentionally:

(1) Fail to seek the lawful objectives of a client through reasonably available means permitted by law and the Disciplinary Rules, except as provided by paragraph (b) of this section....

(2) Fail to carry out a contract of employment entered into with a client for professional services, but a practitioner may withdraw as permitted under § § 10.40, 10.63, and 10.66.

(3) Prejudice or damage a client during the course of a professional relationship, except as required under this part.

(b) In representation of a client, a practitioner may:

(1) Where permissible, exercise professional judgment to waive or fail to assert a right or position of the client.

(2) Refuse to aid or participate in conduct that the practitioner believes to be unlawful, even though there is some support for an argument that the conduct is legal.

The charge of Count 2 pertains to Turner's efforts, or lack thereof, in providing the patentability search as noted in the retainer agreement with the Schwartzes and also the patentability search as noted in the retainer agreement with Mr. Armel. The facts involving the case of the Schwartzes, as stated by the ALJ, are as follows (Initial Decision at 4-5):

[Turner] entered into a retainer agreement with the Schwartzes on May 9, 1985 and was paid $500 in advance for conducting a patentability search and $250 towards the preparation of a patent application. (Govt.Exh. 1, pg. 3, Item A). After waiting eight weeks without hearing from Turner, Dr. Schwartz called Turner's office and left a message with Turner's secretary, who promised that Turner would return the call. Turner did not return that call nor several other calls from the Schwartzes. Finally, when Turner answered the telephone himself, he promised the Schwartzes that he would complete the patent search. In late September 1985, Turner reported to the Schwartzes that he had completed the search and that the results looked favorable for obtaining a patent. However, he said that the Schwartzes must wait one more week.

***10** Dr. Schwartz called again several times but was told each time that [ [Turner] was in Washington, D.C. After calling on October 5, 1985 and being told that [Turner] was in Washington, Dr. Schwartz visited [Turner's] office in Albany minutes later and found [Turner] there. At that time, [Turner] admitted that he had done no work on the patent search and at the demand of Dr. Schwartz, gave him a check for $500.

In this appeal, Turner does not deny that in the five month period from May to October, 1985, he did not perform a patentability search for the Schwartzes and he does not deny that the Schwartzes were nevertheless charged $250.

The facts involving the case of Mr. Armel, as stated by the ALJ, are as follows (Initial Decision at 5-6):

[Turner] entered into a retainer agreement with Mr. Jack Armel on May 16, 1985 and was paid $1,500 in advance for conducting a patentability search and preparing a patent application (Govt.Exh. 2). Between May 16th and June 12, 1985, Mr. Armel made a number of telephone calls to [Turner], who did not answer and so Mr. Armel left messages with the answering service. [Turner] did not return any of Mr. Armel's calls.

On June 12, 1985, Mr. Armel sent [Turner] a letter terminating [Footnote omitted] his services and requesting return of his retainer (Govt.Exh. 6). However, after receiving some material from [Turner], who advised him that the search had been ordered, Mr. Armel authorized [Turner] to complete the search in a letter dated June 14, 1985 (Govt.Exh. 7). In a response to OED [ [Office of Enrollment and Discipline] dated October 6, 1986, [Turner] provided a copy of a letter dated June 18, 1985, which he claims forwarded a search report to Mr. Armel (enclosure to Govt.Exh. 9.) Mr. Armel denied ever receiving the report but mentioned that he had sued [Turner] in the City Court of Albany for the return of the retainer fee (Govt.Exh. 11). [Turner] did not make an appearance in court and Mr. Armel was awarded a default judgment of $1,560.20 on December 9, 1985. [Footnote omitted.]

The ALJ noted that the OED had inquired Turner about the report but that Turner did not respond to the inquiry (Initial Decision at 6). The ALJ stated that there is no evidence to establish that Turner actually mailed the report on June 18, 1985, and concluded that Turner never sent the report (Initial Decision at 6).

Turner argues he did fully perform the professional services Mr. Armel contracted for (Br. 10, January 10, 1991), but points to noevidence in the administrative record which would show that the ALJ erred in concluding that Turner never sent the search report to Mr. Armel. There is no reason to question the ALJ's finding in that regard.

Turner argues that the retainer agreement with the Schwartzes did not give the Schwartzes any right to manage or to supervise Turner's time and work schedule. The argument has no merit, because the charge against Turner does not depend on any such right possessed by either the Schwartzes or Mr. Armel. Though Turner may have certain discretion in the day to day scheduling of his work, he nevertheless must comply with the requirements of 37 C.F.R. § 10.84, which he has not done.

***11** Turner further argues that the retainer agreement with the Schwartzes stated that the specific time and length of service within the work periods provided by the agreement is determined on the basis of mutual satisfaction of the parties. That argument also has no merit, because regulatory provisions governing the conduct of practitioners cannot be waived by clients. The PTO establishes the level of acceptable conduct of practitioners, and the standard is the same for all practitioners alike. The fact that some clients may demand less from their attorney and/or agent does not mean the practitioner need not meet the standard of conduct as required under PTO regulations. Moreover, it is evident that neither the Schwartzes nor Mr. Armel were satisfied with how Turner handled their work.

Turner points out that in the retainer agreement signed by the Schwartzes, the patentability search was associated with a marker placed in a column indicating "1985" next to a column indicating "1986-92." On that basis, Turner appears to make the argument that the Schwartzes had agreed that Turner can delay providing a search report to the Schwartzes until the end of 1985. To the extent that Turner actually makes that argument, it is rejected. As already discussed, notwithstanding any private agreement, Turner nevertheless must conform his conduct to the requirements of law, specifically PTO regulations governing the conduct of practitioners before the PTO. Moreover, the construction Turner would advocate is based on a tortuous and strained characterization of ambiguous markings and associations, not on any wording of the agreement; under the familiar principle of contra proferentum in contract interpretation, the agreement should be interpreted in favor of the Schwartzes, i.e., that the Schwartzes did not agree that Turner could delay providing the search report until the end of 1985. The marking associated with "1985" need not be construed to mean that anything less than prompt service is expected of Turner by the Schwartzes.

Turner argues:

> As the PTO knows--as long as diligence is shown (First-in First-Out) based on the normal and routine activities of an individual patent applicant including his patent agent in accord with present U.S.

Interference Law there is no harm suffered by a U.S. patent applicant regarding the order of patent processing.

Turner's argument fails to note the existence of 37 C.F.R. § 10.84 concerning zealous representation without regard to any separate showing on whether a client has been harmed. This case concerns violation of PTO administrative regulations governing the conduct of practitioners, not recovery for damages. It may be that in a civil action for malpractice, harm to the client must be separately shown and even quantified, but this is not such a case.

To the extent that Turner is arguing that he has been diligent in the handling of matters for the Schwartzes and for Mr. Armel, in light of his workload and the sequence in which the work was received, Turner did not submit to the ALJany evidence tending to establish such diligence. Furthermore, because Turner did not argue to the ALJ that he had been diligent, he may not make that argument in this appeal, especially when there is no evidence in the record pertaining to Turner's workload, docket entries, and time schedule during the period in question.

***12** Lastly, lack of diligence can be prejudicial to an applicant who ends up a junior party in an interference where the applicant may need to establish diligence from a time prior to the senior party's effective filing date up to the junior party's own filing date. See e.g., Bey v. Kollonitsch, 806 F.2d 1024, 1026, 231 USPQ 967, 968 (Fed.Cir.1986).

In any event, representing to the Schwartzes that the patentability search has been done when in fact the search was not performed cannot be made any less culpable by an argument that Turner had been diligent.

Turner argues that he had not received proper notice about Mr. Armel's civil action against him in Albany's City Court. But this is not the forum to litigate whether Turner indeed had proper notice. Until the City Court's default judgment against Turner is overturned, it is what it is, a judgment in favor of Mr. Armel in connection with the service agreement underlying Count 2 of this disciplinary proceeding. It is further noted that Turner has not asserted that he had made any attempt to overturn the City Court's default judgment on the basis of inadequate notice.

For the foregoing reasons, these ALJ findings are more than sufficiently supported by the evidence: (1) Turner did not promptly conduct a patentability search for the Schwartzes; (2) Turner did not promptly return telephone calls from the Schwartzes; (3) when Turner failed to perform the search, he failed to return the full amount of the retainer fee to the Schwartzes; (4) Turner did not promptly return telephone calls from Mr. Armel; and (5) when Turner failed to perform the search, he did not promptly return the retainer fee to Mr. Armel.

The ALJ's conclusion that Turner violated 37 C.F.R. § 10.84 is also correct. The evidence of record more than sufficiently establish that Turner failed to achieve the lawful objectives of the Schwartzes and Mr. Armel through reasonable available means. Those objectives include expectations of (a) timely preparation of patentability search reports; (b) prompt return of telephone inquiries; (c) to be informed of

truthful information; and (d) prompt return of the retainer fee.

Even if Turner could not have himself performed the patentability searches in a timely manner, he could have informed his clients and arranged for other competent professionals to perform the work. In that regard, it is noted that though Messrs. Murray and Whisenhunt are known to Turner to be competent professionals who have agreed to support Turner at their own discretion on a case-by-case basis, Turner evidently did not request their assistance. There also can be no excuse for informing a client that work has been done when it has not been performed.

C. Count 3, Failure to Answer OED's Questionnaire

Section 10.23(c)(16), Title 37, Code of Federal Regulations, prohibits willful refusal to reveal or report knowledge or evidence to the OED pursuant to an investigation under 37 C.F.R. § 10.131.

***13** The facts involving the charge of failing to cooperate with OED, are stated in the Initial Decision, is as follows:

OED asked Respondent a number of questions about his conduct in a questionnaire dated June 25, 1987 (Govt.Exh. 12). Respondent was given one month to answer (Govt.Exh. 12, page 1). Respondent acknowledged receipt of the questionnaire in his letter dated August 3, 1987 and promised that the questionnaire would be completed and forwarded shortly (Govt.Exh. 13).

Since no response was received, on January 11, 1988, OED sent a follow-up letter with another copy of the questionnaire by certified mail requiring a response within 15 days or else it would be grounds for disciplinary action (Govt.Exh. 14). The return mail receipt bore Respondent's signature and was dated January 22, 1988 (Govt.Exh. 14, last page). No response was received by OED (Director's Brief).

The OED's questionnaire was sent to Turner in June, 1987, to obtain more information about the misconduct with which Turner had been charged. Thus, the questionnaire elicits information pursuant to an investigation under 37 C.F.R. § 10.131. Moreover, the ALJ is correct in stating (Initial Decision at 6):

The detailed questionnaire was necessary because Respondent's answers in his three prior letters were considered to be incomplete (Govt.Exh. 12, page 1). Additional information was required to resolve the complaints against Respondent.

Before the ALJ, Turner generally asserted (Answer, May 20, 1990) that his prior correspondences answered the inquiries of the OED. In this appeal, Turner does not challenge ALJ's finding that he never returned a completed OED questionnaire, but continues to assert that the questionnaire has been answered by prior correspondences. Insofar as Turner believes he had already provided the information sought by the questionnaire, he should have either (1) reiterated the information in an answer to the questionnaire, or (2) pointed out specifically where in prior communications the information sought by particular inquiries of the questionnaire had already been provided. There is no evidence in the record tending to show that Turner has made any such effort.

Though 37 C.F.R. § 10.23(c)(16) requires willful intent in refusing

to provide information to the Director of OED, the ALJ properly could infer willful intent from Turner's persistent conduct over a course of three years in failing to return an answered questionnaire to the OED. Accordingly, the ALJ's conclusion that 37 C.F.R. § 10.23(c)(16) has been violated is supported by the record.

D. Decision

Turner will be suspended from practice before the Patent and Trademark Office in all cases (patents, trademarks, and others). This suspension against Turner is imposed under 35 U.S.C. § 32 (as to Patent cases) and the Commissioner's authority to suspend attorneys from practice in trademark and other cases. See Small v. Weiffenbach, 10 U.S.P.Q.2d 1898, 1905 (Comm'r Pat.1989).

***14** Considering all relevant factors (37 CFR § 10.154) supported by the record, it is apparent that there are no extenuating circumstances. The violations, particularly those of Counts 1 and 2, are serious. Accordingly, the following s3anctions are hereby imposed, running concurrently:

Count 1 (non-existent partnership)

Suspended from practice in all matters before the Patent and Trademark office for a period of two years;

Count 2 (unzealous representation)

Suspended from practice in all matters before the Patent and Trademark Office for a period of two years;

Count 3 (failure to cooperate with OED)

Suspended from practice in all matters before the Patent and Trademark Office for a period of six months.

ORDER

Upon consideration of the entire record, it is

ORDERED that, effective immediately upon entry of this order, F. Wesley Turner, of Muskogee, Oklahoma, whose OED Registration No. is 26,059, is suspended from practice before the Patent and Trademark office in all cases (patent, trademark, and other cases), for a period of two years and it is

FURTHER ORDERED that Turner is given limited recognition under 37 C.F.R. § 10.9(a) for a period of thirty (30) days from the date of

this ORDER in which to conclude any pending matters before the Patent and Trademark Office.

Cameron Weiffenbach

Director

By: John Raubitschek

Associate Solicitor

By: John Raubitschek

Associate Solicitor

MOTION TO CORRECT THE MEMORANDUM OPINION AND FINAL ORDER

I call to your attention the following clerical g clerical errors in the MEMORANDUM OPINION AND FINAL ORDER in the above-referenced proceeding.

1. At page 9, in the last sentence of the first incomplete paragraph, between the words "was" and "necessary", the word "not" is missing.

2. At page 13, in the middle paragraph, the expression "nonexistent" is deleted.

3. At page 28, in the second sentence of last complete paragraph on the page, "establish" should be changed to "establishes".

4. At page 31, in the last sentence of the second paragraph under "Decision", "sanctions" should be changed to "sanctions".

Entry of an appropriate erratum is recommended.

Respectfully submitted,

Cameron Weiffenbach

Director

By: John Raubitschek

Associate Solicitor

20 U.S.P.Q.2d 1103

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