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

CAMERON WEIFFENBACH, DIRECTOR OFFICE OF ENROLLMENT AND DISCIPLINE
v.
WILLIAM F. FRANK RESPONDENT
Proceeding No. D91-1
February 22, 1991

Harry F. Manbeck, Jr.

Assistant Secretary and Commissioner of Patents and Trademarks

FINAL ORDER

***1** The Director and William F. Frank (Respondent), being fully advised, desire to settle this disciplinary matter without the need for a hearing before the Administrative Law Judge. The Director and Respondent therefore present to the Commissioner this agreed upon FINAL ORDER as a settlement of the above- identified disciplinary proceeding.

On November 26, 1990, a Complaint and Notice of Proceeding under 35 U.S.C. 32 (Complaint) was filed against the Respondent. Respondent duly filed an answer. The charges against the Respondent were set forth in the following count:

COUNT

Respondent, a practitioner who is not an attorney, represented, for fees, one or more trademark applicants by advising applicant(s) about registrability of proposed trademarks and/or by prosecuting one or more trademark applications including drafting the application(s) and preparing responses to one or more Office actions, all of which Respondent arranged for the applicant to submit as pro se documents. In so doing, Respondent engaged in the unauthorized representation of trademark applicants before the U.S. Patent and Trademark Office, prohibited by 37 CFR 10.14(b), and handled legal trademark matters which the Respondent knew or should have known he was not competent to handle.

1. Respondent has been registered to practice, since 1965, as a patent agent before the PTO. Respondent, as a registered patent agent, being neither an individual who is a member in good standing of the bar of any United States court or the highest court of any State nor recognized to practice before the Office in trademark cases under 37 CFR prior to January 1, 1957, was not and is not authorized to represent trademark applicants before the PTO at any time since he became a patent agent. See 37 CFR 10.14(b), its predecessor, 37 CFR 2.12(b).

2. In response to a Request for Comments, Respondent informed the Office of Enrollment and Discipline in 1988 that, in 1981, Respondent was told by an attorney that the Respondent could not represent

trademark applicants. According to the response, the attorney told Respondent to advise any clients, whose applications were then pending, of this disability and to suggest that the clients obtain the services of a lawyer to take over the applications or represent themselves before the Trademark Office.

3. In 1981, Respondent was representing foreign and domestic trademark applicants directly before the PTO. In 1981, Respondent wrote letters to his trademark clients, advising them that, "the U.S. rules do not permit a non- attorney to practice trademarks before the Patent and Trademark Office," in one letter and, "I recently learned that a patent agent is not permitted to practice before the Trademark Division ...," in a second letter.

***2** 4. Respondent prepared trademark and/or service mark applications after 1985, which were subsequently signed and submitted to the PTO as pro se applications, including:

A. Margaret Hodge Company
Love Fever (R) (stylized)
Perfume, Cologne, Body Lotions, Skin Toners, Bath Oils and Soap.
Application Serial No. 73/609,681, filed 07/16/86
Registration No. 1,455,997, date 09/08/87

B. Steve Lehrhoff DBA Seal-A-Drive
Seal-A-Drive (R)
Coating Driveways, Parking Lots ...
Application Serial No. 73/678,358, filed 08/14/87
Registration No. 1,545,032, date 06/20/89

C. Remembrances, Inc.
Remembrances (R) (stylized)
Reproduction of turn-of-the-century jewelry ...
Application Serial No. 73/719,081, filed 03/28/88
Registration No. 1,514,537, date 10/29/88

The Love Fever (R) Application

5. During the prosecution of the trademark application for Love Fever (R), Respondent prepared the application for Margaret Hodge.She relied on and was charged by Respondent for assistance in preparing the response to the Office action and for representation before the PTO.

6. In the Love Fever (R) trademark application, prepared by the Respondent, the trademark examining attorney rejected the trademark application: (a) because it was indefinite whether the person, Margaret Hodge, or the Margaret Hodge Company was the applicant, (b) because the identification of goods covered by the application as filed was indefinite, (c) because the application did not address (i.e., it omitted) labelling information required under the Federal Food, Drug and Cosmetic Act, and (d) because the application omitted the required "now in use" statement. For reasons stated by the trademark examining attorney, this application was improperly prepared by the Respondent.

7. Respondent wrote to the Office of Enrollment and Discipline:

> Since 1986, I have prepared and filed the following trademark applications after carefully and thoroughly explaining during telephone conversations the options of applicants representing themselves, or

being represented by an attorney; thoroughly advising the prospective applicants that if they filed the application the Trademark Office would correspond with them and they could talk or write to the Trademark Attorney or have an attorney do so; as well as stressing the requirements for continuous use in interstate commerce for a federal registration.

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That I received a copy of a letter from Miss Hodge to Trademark Attorney Mandir.... I telephoned her reminded her I could not talk to any attorney in the Trademark Office and suggested she consult an attorney in New York.

8. Even if Respondent phoned Margaret Hodge as he claimed, and "carefully and thoroughly" explained her options of representing herself or having an attorney represent her, Margaret Hodge wrote to the Respondent on November 5, 1986: "The brief [the Office Action] sent, indicates that we must answer each item paragraphed, so that we do not lose the application for this failure in complying with their itemized request. POSSIBLY A CALL TO MR. MANDIR [the trademark examiner] WOULD BE BEST.... I do owe you monies and would appreciate an update bill."

***3** 9. Notwithstanding the telephone reminder in which the Respondent states that he told Ms. Hodge, the applicant, that he, "could not talk to any attorney in the [Patent and] Trademark Office and suggested she consult an attorney in New York," Ms. Hodge wrote to the trademark examiner on February 6, 1987, "Following my telephone conversation of today, I am herewith attaching a copy of a brief sent to Mr. William Frank [Respondent] who is handling this property for me. It is my [applicant's] understanding that Mr. Frank will be in communication with you [the Trademark Attorney] to cover the matter of the items outlined in your correspondence with me." Applicant's communication with the Office occurred approximately three months after the applicant's letter to Respondent, cited in paragraph 8 above.

The Seal-A-Drive (R) Application

10. On December 7, 1987, an attorney representing the applicant for a service mark registration for Seal-A-Drive (R), provided information under 37 CFR 10.24 about alleged misconduct of the Respondent in searching, preparing, filing and prosecuting the original application for the applicant's mark. Respondent performed a "Trademarkability" search, analyzed and reported the results, prepared the application and filed the application.

11. Respondent charged the applicant fees, inter alia, for Respondent's "Trademarkability" search and analysis, and for preparation and filing of the service mark application.

12. Respondent prepared and filed the service mark application for Seal-A- Drive (R). In the Seal-A-Drive (R)service mark application, the trademark examining attorney rejected the application: (a) because it

omitted a required statement of citizenship, (b) because the description of services covered by the mark as filed was indefinite, and (c) because the application, as filed, was improperly classified. For reasons stated by the trademark examining attorney, this application was improperly prepared by the respondent.

13. Respondent testifies: "That as to why I 'gave Mr. Lehrhoff's address (not your (my)) address as the correspondence addressee [sic] in his trademark application', I believe the Patent and Trademark Office requires correspondence to be sent to an applicant at his address, or to the attorney transmitting the application, or the attorney designated in a power of attorney. Since I did not qualify as any one of the two alternatives to the applicant, giving Mr. Lehrhoff's address was in compliance with the rules."

14. The Respondent was conscious of limitations on his authority to practice before the U.S. Patent and Trademark Office as a patent agent. To practice in the trademarks and service marks field before the PTO, Respondent intentionally and with deliberation concealed his impermissible practice by using the applicant's address as the correspondence address to evade these limitations.

The Remembrances (R) Application

***4** 15. Respondent prepared the trademark application for Remembrances (R) for which he charged applicant.

16. By engaging in conduct described in paragraphs 4 through 15 inclusive (drafting one or more trademark applications and drafting applicant's responses to Office Actions or advising applicants on "trademarkability" and/or advising them on the form and content of their application(s) and response(s) to Office Actions), Respondent extended the scope of his practice beyond the scope of his representational authority as a patent agent. The totality of his conduct in connection with his trademark practice adversely reflects on his fitness to practice before the Office, proscribed by 37 CFR 10.23(b)(6).

17. By engaging in conduct described in paragraphs 4 through 15 inclusive Respondent handled one or more legal trademark matters which he knew or should have known that he was not competent to handle, because it required the Respondent to be engaged in the unauthorized practice of trademark law under the standard imposed by PTO Rule 37 CFR 10.14(b). Practice of trademark law by non-attorneys, even if they are patent agents, is one form of incompetence, prohibited by 37 CFR 10.77(a).

SETTLEMENT

For purposes of settling this disciplinary matter without any determination by the Administrative Law Judge, and without a hearing, The Director and the Respondent have agreed as follows:

1. Respondent acknowledges that he is aware of the charges and that he is guilty of violations of the Patent and Trademark Office Code of Professional Responsibility as set forth in the Count of the Complaint.

2. Respondent acknowledges that he is entitled to have a hearing in this proceeding and that he hereby waives his rights thereto.

3. Respondent acknowledges that he freely and voluntarily enters into this settlement and accepts this FINAL ORDER.

4. Respondent further acknowledges that he is not acting under duress or coercion from the Patent and Trademark Office.

5. Respondent further acknowledges that he is fully aware of the implications of entering into settlement and accepting this FINAL ORDER.

6. The Director and the Respondent shall bear their own costs.

7. The Director and the Respondent request that the Commissioner enter the FINAL ORDER.

8. The Respondent agrees, henceforth, that he will not participate in any way whatsoever, in assisting others, directly or indirectly, in connection with any immediate, prospective or pending business before the Patent and Trademark Office in trademark matters, including but not necessarily limited to searching trademarks, drafting documents, filing documents, paying fees, offering advice or opinions, and making referrals to other practitioners. Respondent further agrees to promptly return all documents received from clients or other persons in non-terminated trademark matters and all funds received for any such trademark matter now in his possession or which shall come into his possession in the future. Respondent further agrees to promptly inform such clients or other persons, or anyone who in the future inquires, that he is not authorized to work on trademark matters. The word "trademark" as used in this paragraph shall include any activity which is subject to the jurisdiction of the Patent and Trademark Office under 15 U.S.C. 1051 et. seq.

***5** 9. Respondent shall comply with all PTO Disciplinary Rules.

10. Respondent shall be publicly reprimanded for his conduct as specified in the Count. This public reprimand shall take place upon the approval and entry of the FINAL ORDER.

11. The following notice will be published in the OFFICIAL GAZETTE

PUBLIC REPRIMAND

William F. Frank of Arlington, Virginia, whose registration number is 22,626, has been publicly reprimanded. This action is taken under the provisions of 35 U.S.C. 32 and 37 CFR 10.130(a)(1) and 10.133(g).

12. The Director and the Respondent agree that the FINAL ORDER may be published in its entirety, and the Director shall give notice of the

FINAL ORDER, SETTLEMENT and information in investigative files in the Office of Enrollment and Discipline, concerning Respondent, to appropriate authorities in the State of Virginia.

Agreed to:
William F. Frank, Respondent
Date: February 14, 1991

Agreed to:
Ellsworth H. Mosher, Attorney for Respondent
Date: February 14, 1991

Agreed to:
Cameron K. Weiffenbach, Director, Office of Enrollment and Discipline
Date: February 19, 1991

Agreed to:
Harris A. Pitlick, Associate Solicitor Counsel for the Director
Date: February 19, 1991

Approved and FINAL ORDER Entered:

18 U.S.P.Q.2d 1397

END OF DOCUMENT