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

IN RE B. PETER BARNDT, RESPONDENT
Disciplinary Proceeding Docket No. D92-3
September 10, 1992

Attorney for Respondent

Jay M. Cantor, Esq.

Attorney for the Director

James T. Carmichael, Esq.

Douglas B. Comer

Acting Commissioner of Patents and Trademarks

MEMORANDUM OPINION AND ORDER

***1** B. Peter Barndt (respondent) appeals [FN1] to the Commissioner from an Initial Decision [FN2] of the Administrative Law Judge (ALJ) entered on June 25, 1992, in the above-identified disciplinary proceeding. In taking the appeal, respondent seeks review only of the sanction imposed by the ALJ.

The comprehensive opinion and findings of fact by the ALJ appear as an appendix to this memorandum opinion and order. Familiarity with the ALJ's opinion and findings of fact are presumed.

Declarations Submitted with the Appeal

Attached to respondent's appeal brief are copies of declarations signed by two individuals. [FN3] An appeal to the Commissioner from an initial decision of the ALJ must take place on the record made before the ALJ, not some new record made on appeal for the first time. [FN4] Accordingly, the two declarations have not been considered and are returned herewith.

Introduction

The ALJ determined that a sanction was appropriate in this case. Specifically, the ALJ ordered that respondent be suspended for a period of five (5) years. However, the ALJ found that respondent was remorseful for the harm he had caused. Accordingly, the ALJ suspended execution of the last four years of the five-year suspension provided

respondent meets certain conditions.

On appeal, respondent contends that he should not be required to serve any suspension. Respondent further contends that the Commissioner should order that the files of this disciplinary proceeding be maintained in confidence. [FN5] For reasons which follow, the decision of the ALJ is affirmed and respondent's confidentiality request is denied.

Background

The record reveals that in September of 1987, respondent approached the Colonial Clinic, Spokane, Washington, and requested "assessment and treatment services for a drinking problem." [FN6] A treatment plan was developed. Respondent "completed this comprehensive program in May of 1988." [FN7]

After May of 1988, respondent engaged in what he admits was unprofessional conduct. The ALJ's findings of fact reveal that a * * * patent application became abandoned in March of 1989, [FN8] when respondent did not reply to a Patent and Trademark Office (PTO) action entered in December of 1988. [FN9] Respondent thereafter offered to draft a response to the PTO action, even though the application was abandoned. [FN10] Finally, in forwarding the December PTO action to * * *, respondent concealed the date the action was mailed. [FN11] Respondent also concealed other date-identifying information on the action. [FN12]

The ALJ's findings also reveal that a PTO "Ex parte Quayle" action [FN13] in connection with a * * * application was entered in November of 1988 with a response being due in January of 1989. [FN14] Respondent did not timely respond to the Quayle action and * * * application became abandoned. [FN15] Respondent admitted that he "failed to notify Mr. * * * later on that his case would go abandoned if further action were not taken." [FN16]

***2** In connection with a * * * patent application, respondent received a notice of allowance and issue fee due which had been mailed in November of 1988. [FN17] A requirement was also made by PTO that drawings be corrected. [FN18] Respondent failed to make the required drawing corrections and did not pay the issue fee. [FN19] Accordingly, the * * * patent application became abandoned.

In March of 1989, respondent left Spokane, Washington, to assume a patent attorney position at TI in Dallas, Texas. [FN20] According to the record, respondent has abstained from alcohol since completing the recovery program at Colonial Clinic. The ALJ found, correctly, that respondent has shown remorse for his actions. [FN21] Copies of letters in the file of this disciplinary proceeding indicate that respondent has contacted his non-TI clients and is making some effort at restitution. [FN22]

It is well established that the Commissioner is primarily responsible for protecting the public from unprofessional behavior of practitioners and for oversight of the bar practicing before PTO in patent cases.

Kingsland v. Dorsey, 338 U.S. 318 (1949). Determining an appropriate sanction is, therefore, a matter largely within the discretion of the Commissioner, taking into account the matters mentioned in the rules, [FN23] and applying appropriate burdens of proof. [FN24]

Respondent does not contend that the Director failed to establish his case by clear and convincing evidence. Indeed, respondent admitted all allegations in the complaint. Respondent's defense is not that he did not do what the Director charged. Rather, respondent maintains that he should not be suspended under the circumstances. The ALJ determined that a suspensionand a period of probation was an appropriate sanction in this case. [FN25]

The ALJ's determination was entirely appropriate and is supported by substantial evidence in the record. The evidence is that respondent is a recovering alcoholic. Respondent sought, obtained, and successfully completed treatment in May of 1988. Thereafter, during the December 1988 through March 1989 time period, respondent committed the unprofessional acts in question. During this same time period, respondent sought and obtained employment with TI. The record shows that TI offered respondent employment sometime around February of 1989 and respondent accepted employment "during the last two weeks of February." [FN26] There is some evidence that the effects of alcoholism continue even after completion of successful treatment, [FN27] and Gokee is of the opinion that this is "the case with ... [respondent]." [FN28] However, respondent never established Gokee's qualifications on the record. Likewise, respondent failed to establish, even by a preponderance of evidence, let alone by clear and convincing evidence, that his unprofessional actions were alcohol related. The record reveals that at the time of the unprofessional acts, respondent successfully convinced TI to hire him as a patent attorney. In short, respondent has not shown that the ALJ erred or otherwise abused any discretion in imposing the sanction, or that he should receive "no suspension" in connection with the events involved in this case.

***3** Respondent presents an argument that a suspension will have an adverse impact on TI. This argument has been considered only to the extent that it is based on material in the record before the ALJ and without consideration of the declarations mentioned in note 3, supra. Respondent's argument can be made every time an individual working for a corporation, law firm, or Government agency is sanctioned. If TI believes that respondent is a valuable employee, TI presumably will make every effort to retain respondent in an appropriate position [FN29] during the period of his suspension and probation.

Publication of Decision and Sanction

Respondent requests that the decision in this matter not be published. The request is denied. The ALJ determined that the facts and circumstances of this matter should be made public. [FN30] Respondent's argument is (appeal brief, page 6):

> Furthermore, there should be no publication of the facts and circumstances of this proceeding at this time in order to avoid compromise of Respondent's position in his present supervisory position.

Respondent's argument fails to overcome the provisions of 37 CFR § 10.159(c) (1991), and provides no legitimate basis for the Commissioner to exercise any discretion within the scope of § 10.159(c) to order these particular files maintained confidential. The fact that TI employees working for, or reporting to, respondent may learn of the facts and circumstances here involved is but a natural consequence of what has occurred.

Decision

For the foregoing reasons, as well as those given by the ALJ, the initial decision of the ALJ is affirmed.

Order

Upon consideration of respondent's appeal and the record (except to the two declarations returned herewith), it is

ORDERED that effective October 13, 1992, respondent, B. Peter Barndt, of Plano, Texas, is hereby suspended from practice before the Patent and Trademark Office for a period of five (5) years, and it is

FURTHER ORDERED that execution of the last four (4) years of the period of suspension is suspended provided that during that last four (4) years respondent shall perform all patent associated work under the supervision of his named supervisor and that respondent commit no further violations of the PTO Code of Professional Responsibility, and it is

FURTHER ORDERED that this memorandum opinion and order, accompanied by the initial decision of the ALJ, be published and that an appropriate notice appear in the Official Gazette.

Notice of Restriction on Activities of Suspended Practitioner

Respondent's attention is directed to 37 CFR § 10.158 (1991) concerning the restrictions on a practitioner suspended from practice before PTO.

Reconsideration and Appeal Rights

Any request for reconsideration of this decision must be filed and served within twenty (20) days of the date of entry of this memorandum opinion and order. 37 CFR § 10.156(c) (1991). Any request for reconsideration mailed to the PTO must be addressed as follows and a copy must also be served on the attorney for the Director:

***4** Douglas B. Comer
Acting Commissioner of Patents and Trademarks
Crystal Park II, Suite 906

U.S. Patent and Trademark Office (P.T.O.)
Washington, D.C. 20231

Any request hand-delivered to the PTO must be hand-delivered to the Office of the Commissioner, in which case the service copy for the attorney for the Director shall be hand-delivered to the Office of Enrollment and Discipline.

If a request for reconsideration is not filed, and respondent desires further review, respondent is notified that he is entitled to seek judicial review on the record in the U.S. District Court for the District of Columbia under 35 U.S.C. § 32 and Local Rule 213 of the U.S. District Court for the District of Columbia within thirty (30) days of the date of entry of this memorandum opinion and order.

FN1. 37 CFR § 10.155 (1991).

FN2. 37 CFR § 10.154 (1991).

FN3. The two declarations are dated July 23, 1992, and were signed by Richard L. Donaldson, General Patent Counsel and Senior Vice President of Texas Instruments Incorporated (TI) and Richard J. Agnich, Senior Vice President, Secretary and General Counsel of TI.

FN4. 37 CFR § 10.155(b) (1991).

FN5. See 37 CFR § 10.159(c) (1991).

FN6. Declaration of Gokee dated January 10, 1992, page 1.

FN7. Id.

FN8. ALJ finding number 4.

FN9. ALJ finding number 3.

FN10. ALJ finding number 9, second full paragraph.

FN11. ALJ finding number 10, first full paragraph.

FN12. ALJ finding number 10, second full paragraph.

FN13. See Ex parte Quayle, 1935 Dec.Comm'r Pat. 11 (Comm'r Pat.1935).

FN14. ALJ finding number 16.

FN15. ALJ finding number 17.

FN16. ALJ finding number 19.

FN17. ALJ finding number 24.

FN18. Id.

FN19. ALJ finding number 25.

FN20. Request for Settlement of Complaint, dated November 27, 1991, page 1, paragraph number 4.

FN21. Initial Decision entered June 25, 1992, page 8, fourth full paragraph under CONCLUSION.

FN22. See (1) letter to * * * dated January 8, 1992; (2) letter to * * * of the same date; and (3) letter to * * * of the same date, all attached to respondent's declaration dated January 10, 1992.

FN23. 37 CFR § 10.154 (1991).

FN24. 37 CFR § 10.149 (1991).

FN25. Initial Decision entered June 25, 1992, page 8, fourth full paragraph under CONCLUSION.

FN26. OED, Exhibit 4 (attached to complaint), page 1, paragraph 1.

FN27. Gokee declaration dated January 21, 1992.

FN28. Id. at page 2.

FN29. See 37 CFR § 10.158 (1991).

FN30. Initial Decision entered June 25, 1992, page 9, second full paragraph.

June 25, 1992

Hugh J. Dolah

Administrative Law Judge

APPENDIX TO MEMORANDUM OPINION AND ORDER

INITIAL DECISION

PRELIMINARY STATEMENT

***5** This is a disciplinary proceeding initiated under 35 U.S.C. § 32 and the Regulations promulgated thereunder at 37 C.F.R. Part 10, against B. Peter Barndt, a patent attorney registered to practice before the Patent and Trademark Office (PTO) (Registration Number: 31,587).

In the Complaint and Notice of Proceedings dated October 29, 1991, Respondent is charged with one count of engaging in professional misconduct. The charge arose after Respondent neglected to respond to one or more Office actions; failed to communicate or by inadequately communicating with his client(s) about one or more Office actions affecting their patent applications, and abandoned his clients during the course of prosecuting their applications.

The Office of Enrollment and Discipline seeks to have the Respondent suspended from practice before the Patent and Trademark Office. Respondent submitted his answer to the Complaint in which he admitted all allegations set forth in the Complaint. No hearing was requested. The parties were to submit findings and conclusions and responses by January 21, 1992. Pursuant to a notice of settlement discussions, the record remained open for such filings until February 21, 1992, at which time it became ready for decision.

CHARGE

By neglecting to respond to one or more Office actions and by failing to communicate or by inadequately communicating with his client(s) about one or more Office actions affecting their patent applications, and by abandoning his clients during the course of prosecuting their patent applications, Respondent engaged in professional misconduct.

LAW AND REGULATIONS

The Regulations state that "[a] practitioner shall not engage in disreputable or gross misconduct." 37 C.F.R. § 10.23(a). Nor shall a practitioner "[e]ngage in any other conduct that adversely reflects on

the practitioner's fitness to practice before the Office." 37 C.F.R. § 10.23(b)(6). Further, "[c]onduct which constitutes a violation of paragraphs (a) and (b) of this section includes, but is not limited to: ... (2) Knowingly giving false or misleading information or knowingly participating in a material way in giving false or misleading information to: (i) the Office or any employee of the Office." 37 C.F.R. § 10.23(c)(2)(i). Finally, the regulations state that a practitioner shall not "[n]eglect a legal matter entrusted to the practitioner." 37 C.F.R. § 10.77(c).

FINDINGS OF FACT

1. Respondent B. Peter Barndt is an attorney registered to practice before the United States Patent and Trademark Office in patent cases under Registration Number 31,587.

THE * * * PATENT APPLICATION

2. Respondent filed a patent application on behalf of the inventor, * * *, on May 6, 1988. It was assigned Application No. * * *. An Oath and Power of Attorney in Mr. * * *'s patent application provided Respondent with the authority and responsibility to act on this application.

***6** 3. Respondent received a first Office action rejecting all claims directed to the * * * patent application, mailed to Respondent on December 30, 1988, setting a 3-month shortened statutory period for response. A response to this rejection was due on or before March 30, 1989.

4. The Respondent never filed a response to the Office action. the application was abandoned effective March 31, 1989, by operation of law. Respondent received a Notice of Abandonment of the * * * patent application, mailed to the Respondent on July 31, 1989.

5. In a response dated February 15, 1991, to an Office of Enrollment and Discipline (OED) Requirement for Information, Respondent explained that during the period when a response to the Office action was due:

> I physically left Spokane [Washington] on the 9th of March, and started work for a [corporation in Texas] on March 13, 1989.
>
> ...
>
> I notified some of my clients prior to the end of February, 1989[,] in person, or by telephone that I would be leaving Spokane and would be employed full time out of state.

6. In a response dated July 10, 1991, to an OED Request for Comments, Respondent's specifically addressed Mr. * * *'s patent application:

> I admit that I never filed a petition to withdraw [as attorney of record, see 37 C.F.R. § 10.40(a)]. I further admit that I failed to timely notify Mr. * * * that his application was going to go abandoned.

7. The Complaint contains a chronological account of Mr. * * *'s transactions and attempted communications with Respondent. In the middle of his complaint to OED, Mr. * * * alleged that in August 1989,

he called another Spokane attorney and was told by that attorney where to telephone Respondent in Texas. Mr. * * * continued:

8/17/89 Talked to * * *, he said all claims have been rejected and he will send copies out and I should get them by Wednesday of next week. If I don't receive [them] by Friday, I should call back.

8/28/89 Call for * * *, he wasn't in office, left message for him to call. (he did not call).

8/31/89 Called * * *, he says he will work on it this weekend and send it out to me on Tuesday, via Express Mail. Should receive by about Thursday 9/7/89.

9/15/89 Called * * * he says he will give me a phone report on Sunday afternoon and follow it up with a written report on Monday or Tuesday of next week.

9/18/89 He didn't call this week like [he] said he would, I called he was in class all day so would be in and out.

9/19/89 Called in afternoon not there, should be back in morning.

9/20/89 Finally caught him there, gave brief report and his home phone number.

9/27/89 Called * * *, he said I should have gotten it, so he is going to check it and call me at 8:00 a.m. tomorrow.

8. Respondent admitted to having conversations with Mr. * * * in this time frame, but he has no recollection or records of specific dates of conversations. However, Respondent did recall:

***7** I admit that I did not send the information he [Mr. * * *] requested as soon as I had first promised it.

9. Respondent sent an undated letter to Mr. * * * on or about October 2, 1989. Respondent wrote in part:

Enclosed please find copies of the Patent Office Official action and copies of the references cited against your patent application. As I indicated to you, all claims have been rejected by the Patent Office, mainly based upon the Grob, et al, Patent.

...

The broad concept of your invention is disclosed in the Grob patent. However, there are several specific features of your machine and the way it functions, which are different than Grob. As we discussed briefly by telephone, in my opinion patentable claims can be drafted. These claims, however, will necessarily be narrower in scope than the original claims filed.

Respondent offered to prepare an amendment for the already abandoned patent application for $475.00 and to review the patents, cited by the examiner in the Office action, for an additional $50.00. Respondent never disclosed to Mr. * * * that prosecution of the application had been closed, effective March 31, 1989, the date of the abandonment of the * * * patent application, based on Respondent's failure to respond to the Office action dated December 31, 1988.

10. The "Patent Office Official action", submitted by Mr. * * * with his complaint as received from the Respondent with Respondent's letter, has the date of the Office action concealed. In the original document, near the top of the first page is: "date mailed 12/30/88". In the version Mr. * * * submitted to OED, the quoted portion is not present and a hand printed message, "send to * * * ", is in that same location on the page.

In the original document, near the bottom of the last page is the

hand written signature of Frederick R. Schmidt and the hand written date, "12/30/88", immediately above Mr. Schmidt's name and title stamp. In the version Mr. * * * submitted to OED, the hand written signature and date are not present.

In the original document, in the lower left corner of the last page, the following block is typed

B. Shideler:klw
12-21-88
12-29-88 [in hand printing]
(703) 557-6518

In the version Mr. * * * submitted to OED, the quoted portion is not present and a hand printed message, "send to * * * ", is in that same location on the page.

11. When OED presented the Respondent with the evidence of the original and altered Office actions, the Respondent admitted that he had altered the Office Action, "to conceal that the Office Action was not sent to him [Mr. * * *] when it should have been." Mr. * * * learned about the abandonment of his patent application from the PTO on October 6, 1989.

12. Because Respondent did not file a petition to withdraw as counsel of record for Mr. * * * under 37 C.F.R. § § 1.36, 10.40(a) and 10.40(c), Respondent had a duty to continue prosecution of the * * * application and request further consideration of patentable subject matter. See 37 C.F.R. § 1.111. In neglecting to timely prosecute the * * * patent application after a first Office action, Respondent neglected a legal matter.

***8** 13. By telling Mr. * * * that his patent application had patentable subject matter which he would prosecute for $475.00, without informing Mr. * * * that the application had already been abandoned and that prosecution on the application was then closed, and/or by concealing the date of the Office action on the patent application from Mr. * * * which Mr. * * * could have used to determine that his application was abandoned, Respondent knowingly gave false or misleading information to the client in connection with immediate, prospective or pending business before the Office.

14. In failing and/or refusing to communicate with the client during the course of prosecution of a patent application and in failing to inform the client that the patent application had been abandoned, Respondent engaged in gross misconduct.

THE * * * PATENT APPLICATION

15. The Respondent filed patent application on behalf of the inventor, * * * on April 4, 1988. It was assigned Application No. * * *. The Oath and Power of Attorney in Mr. * * *s' patent application provided Respondent with the authority and responsibility to act on this application.

16. Respondent received an ex parte Quayle action directed to the Belles patent application, mailed to Respondent on November 28, 1988.

The action stated that all fourteen claims in the application were allowable. It did require that the Abstract be shortened, a lead line be added to one figure in a drawing, and minor corrections be made to words in the specification and in five of the fourteen claims. Two months were allowed to complete these requirements as provided for by 35 U.S.C. § 133. A response was due on or before Monday, January 30, 1989.

17. The Respondent failed to respond to the ex parte Quayle action and the * * * patent application was abandoned effective January 31, 1989. Respondent received a Notice of Abandonment of the * * * patent application mailed to the Respondent on July 24, 1989.

18. On December 5, 1989, * * * wrote to the PTO that he previously received a call from his attorney, the Respondent, that his application had been "excepted" (sic, accepted). He waited for further word and then decided to call the Respondent on December 5, 1989. Mr. * * *s' letter stated that he called the Respondent's office telephone and his home telephone and was informed that both numbers were no longer in service. The * * *s' letter to the PTO examiner also asked the patent examiner how he could get his (then abandoned) Patent application to be issued.

19. Respondent commented on the letter sent by Mr. * * *, as follows:

> To the best of my recollection[,] Mr. * * * was informed of the status of the case when the claims were allowed. Hoever (sic), I admit that I failed to notify Mr. * * * later on that his case would go abandoned if further action were not taken. I did not petition to withdraw or properly notify the Office of my change of address in this case.

***9** 20. The * * *s' patent application status, with fourteen claims which the PTO said were allowable, remains abandoned. The records of the PTO disclose that this was the only application that * * * submitted for on his invention.

21. Because Respondent did not file a petition to withdraw as counsel of record for Mr. * * * under 37 C.F.R. § § 1.36, 10.40(a) and 10.40(c), Respondent had a duty to continue prosecution of Mr. * * *s' patent application. In neglecting to timely prosecute the * * *s' patent application with fourteen claims which the PTO stated were allowable, Respondent neglected a legal matter.

22. In failing to tell the client, Mr. * * *, that his patent application would become abandoned if the Office action requirements for issue of the patent were not addressed in the time allowed, where the application became abandoned for failing to inform the client that his patent application was subsequently abandoned, Respondent engaged in gross misconduct.

THE * * * PATENT APPLICATION

23. The Respondent filed a patent application on behalf of the inventor, * * *, on December 4, 1987. It was assigned Application No. * * *. An Oath and Power of Attorney in Mr. * * *'s patent application

provided Respondent with the authority and responsibility to act on this application.

24. Respondent received a Notice of Allowance and Issue Fee Due for the patent application, allowing all six claims in the case, mailed November 28, 1988. Respondent was required to file new drawings on the required size paper, with unblurred lines and to pay the issue fee of $280.00 within three months of the Notice of Allowance. See 35 U.S.C. § § 133 and 151.

25. The Respondent failed to correct the drawings and failed to pay the issue fee and the * * * patent application was abandoned, effective March 1, 1989. A Notice of Abandonment of the * * * [or * * *] patent application was mailed to the Respondent on July 24, 1989.

26. Respondent stated:

With respect to Mr. * * *'s application[,] he was notified of the status of his case when the claims were indicated as being allowable. I failed to notify him that the case was going abandoned if the issue fee was not paid."

27. Respondent never filed a petition to withdraw as attorney of record in the * * * patent application.

28. The * * * patent application, with all of its claims, which the PTO stated were allowable, remains abandoned. The records of the PTO disclose that this was the only application that * * * applied for on this invention.

29. Because Respondent did not file a petition to withdraw as counsel of record for Mr. * * * under 37 C.F.R. § § 1.36, 10.40(a) and 10.40(c), Respondent had a duty to continue prosecution of Mr. * * *'s application. In neglecting to timely prosecute the patent application with its claims which the PTO stated were allowable, Respondent neglected a legal matter.

***10** 30. In failing to inform the client, Mr. * * *, of the conditions necessary to have the allowed * * * patent application issue, which application subsequently became abandoned for failure to comply with those conditions, Respondent engaged in gross misconduct.

CONCLUSION

Respondent's failure to fully communicate with one or more clients about the status of their applications with allowed or allowable claims and/or allowable subject matter, which failure contributed to the abandonment of the applications; Respondent's neglect of legal matters, by failing to file one or more amendments or drawing corrections, and/or by failing to pay one or more issue fees as required to keep one or more patent applications that he was the attorney of record on from going abandoned; and/or by Respondent's concealing from one or more clients that their application had become abandoned (through Respondent's neglect); constitutes professional misconduct which justifies suspension or exclusion under 37 C.F.R. § § 10.23(a), 10.23(b)(6), 10.23(c)(2)(i), and 10.77(c).

Respondent has admitted to the facts as established by the PTO and the charge in this cases is uncontested. By neglecting to respond to one or more Office actions and by failing to communicate or by inadequately communicating with his clients about one or more Office actions affecting their patent applications, and by abandoning his clients during the course of prosecuting their patent applications, Respondent engaged in professional misconduct.

Respondent has submitted numerous declarations and affidavits discussing his problem with alcohol and his efforts to make restitution to parties injured by his misconduct. Respondent has also submitted that he is employed by a major corporation where he has made considerable advancement in his three years and that his position does not involve contact with the general public. His supervisor has also declared that he will act as both a practice monitor and substance abuse monitor of the activities of Respondent, checking on respondent's attendance at Alcoholics Anonymous and closely monitoring his professional activities.

Contrary to Agency assertions, I find that the Respondent does recognize the seriousness of the charges and has demonstrated remorse for his conduct. Additionally, Respondent has shown that through his supervised employment, he does not have the opportunity to represent the general public in their patent applications. Nevertheless, the unprofessional conduct cannot go unpunished. Therefore, I find that a period of suspension from practice and an additional probationary period is appropriate in this case.

ORDER

That B. Peter Barndt of 2221 Covington Lane, Plano, Texas whose Patent and Trademark Office Registration is 31,587, be suspended from practice as an attorney before the Patent and Trademark Office for five (5) years from the date of the final action, four (4) years of that suspension period will also be suspended, on condition that the Respondent perform all patent associated work under the supervision of his named supervisor and that Respondent commit no further violations of the above cited Disciplinary Rules. In such event the four (4) years balance will then be remitted without further order or action.

***11** Respondent's attention is directed to 37 C.F.R. § § 10.158 and 10.160 regarding responsibilities in the case of suspension or exclusion.

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

This Initial Decision is rendered pursuant to the provisions of 35 U.S.C. § 32 and 37 C.F.R. § 10.154. Any appeal of this Initial Decision to the Commissioner must be filed in duplicate with the Director within 30 days of the date of this Decision, as provided in 37 C.F.R. § 10.155.

Douglas B. Comer

Acting Commissioner of Patents and Trademarks

MEMORANDUM OPINION AND ORDER ON RECONSIDERATION

B. Peter Barndt (respondent) seeks reconsideration [FN1] of the decision entered September 10, 1992. In the request, respondent raises the following principal points:

1. whether RESPONDENT'S REPLY TO DIRECTOR'S REPLY, received by the Patent and Trademark Office on August 31, 1992, was considered in rendering the decision of September 10, 1992;

2. whether Gokee's qualifications were improperly raised in making the decision of September 10, 1992;

3. whether the opinion in support of the decision of September 10, 1992, improperly made a reference to respondent "convincing" TI to hire him; and

4. whether the ALJ's decision and the Commissioner's decision should be published.

Discussion

RESPONDENT'S REPLY TO DIRECTOR'S REPLY was part of the file, and was considered at the time the decision was rendered on September 10, 1992. None of the arguments presented in RESPONDENT'S REPLY, however, were persuasive.

It is a fact that respondent did not establish in the record Gokee's precise qualifications to render opinions. It is also a fact that respondent accepted employment with TI during the last two weeks of February in 1989. It is a further fact that respondent engaged in unprofessional conduct in the same general time frame that respondent accepted employment with TI. Thus, respondent was able to look after his own interests (obtaining a job) while at the same general time ignore the interests of his clients (the unprofessional conduct). Even assuming that Gokee is qualified to give an opinion on respondent's behavior and alcoholism in general, his letters of January 10, 1992, and January 21, 1992, fail to make out a clear and convincing case that respondent did not know in the late 1988 to early 1989 time frame that his unprofessional conduct was wrong. Whether one views the matter as respondent being able to "convince" TI to hire him or as respondent simply being hired is irrelevant. The fact is that, on this record, respondent essentially simultaneously sought employment and committed unprofessional acts. Under the facts of this case, and based on the material placed in the record before the ALJ by respondent, it cannot be said that alcoholism, or the Gokee letters, should totally excuse respondent's unprofessional acts or that respondent has shown that the ALJ erred in entering his decision. Gokee's letters do not comprehensively or specifically discuss respondent's simultaneous unprofessional conduct and success in seeking employment.

***12** The request for reconsideration repeats the argument presented in the appeal that the decisions in this case should not be published. The

request, therefore, presents no justification for modifying the opinion of September 10, 1992, with regard to publication.

Decision

For the foregoing reasons, respondent's request for reconsideration is denied.

Order

Upon consideration of the entire record, it is

ORDERED that effective November 13, 1992, respondent, B. Peter Barndt, of Plano, Texas, is hereby suspended from practice before the Patent and Trademark Office for a period of five (5) years, and it is

FURTHER ORDERED that execution of the last four (4) years of the period of suspension is suspended provided that during that last four (4) years respondent shall perform all patent associated work under the supervision of his named supervisor and that respondent commits no further violations of the PTO Code of Professional Responsibility, and it is

FURTHER ORDERED that the memorandum opinion and order of September 10, 1992, this memorandum and opinion on reconsideration, and the initial decision of the ALJ, be published and that an appropriate notice appear in the Official Gazette.

Notice of Restriction on Activities of Suspended Practitioner

Respondent's attention is again directed to 37 CFR § 10.158 (1991) concerning the restrictions on a practitioner suspended from practice before PTO.

Appeal Rights

Respondent is entitled to seek judicial review on the record in the U.S. District Court for the District of Columbia under 35 U.S.C. § 32 and Local Rule 213 of the U.S. District Court for the District of Columbia within thirty (30) days of the date of entry of this memorandum opinion and order on reconsideration.

FN1. 37 CFR § 10.156(c) (1991).

27 U.S.P.Q.2d 1749

END OF DOCUMENT