

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS

JUL 6 1999

In re)
) Decision on Petition for
) Review of Director Letter
)
_____)

MEMORANDUM AND ORDER

(Petitioner) petitions for review of the Director of Enrollment and Discipline's April 14, 1997, letter to Petitioner. Because the Director's letter is not a final decision, the petition is dismissed as premature and this matter is remanded to the Director for action on the letter.

BACKGROUND

Petitioner passed the Patent Practitioner's Examination held on August 28, 1996, which tested his legal qualifications for being registered to represent others before the Patent and Trademark Office (PTO) in patent cases. The Office of Enrollment and Discipline (OED), however, became aware of possible issues concerning Petitioner's moral character and reputation, which may preclude registration. See 37 C.F.R. § 10.7(a)(2)(i) (an applicant for registration must establish to the satisfaction of the Director of OED that he or she is possessed of good moral character and repute); 35 U.S.C. § 31 (the Commissioner of Patents and Trademarks may require applicants to show that they are of good moral character and reputation).

Pursuant to her authority to investigate moral character and reputation under the above federal regulation and statute, the Director issued on April 14, 1997, a letter to Petitioner informing him that he had passed the Patent Practitioner's Examination held

on August 28, 1996, but “due to pending issues regarding [his] moral character and reputation,” he was not, as of the date of the letter, being granted limited recognition to practice before the PTO in patent cases. The Director’s letter sets forth how the investigation would proceed from that point onward, and expressly instructed Petitioner to provide the Director of OED with a statement concerning specific allegations made against Petitioner and any relevant documents, all within thirty days of the date of the letter. In response to the Director’s letter, Petitioner filed the instant petition requesting that he be registered to practice before the PTO in patent cases.

OPINION

I regret the delay in responding to the petition, however, the petition may not be considered at this time because under 37 C.F.R. § 10.2(c) only a “final decision of the Director refusing to register an individual under [37 C.F.R.] § 10.9 or § 10.14(c) . . . may be reviewed by petition to the Commissioner.” Nowhere in the Director’s April 14, 1997, letter to Petitioner does she state that she has made a final decision refusing to register him. Indeed, expressly in the letter, the Director gave Petitioner an opportunity to provide her with an explanatory statement and any relevant documents within thirty days. The record indicates that Petitioner has not provided the Director with these items.

In sum, there is simply no final decision by the Director, within the meaning of 37 C.F.R. § 10.2(c), and therefore, there can be no proper petition to the Commissioner pursuant to that regulation. Accordingly, the petition is dismissed as premature and this matter is remanded to the Director for action upon her April 14, 1997, letter.

Attached as Exhibit G to the petition for review of the Director's letter is a paper with attachments addressed to the Director of OED, but filed with the petition to the Commissioner. On remand, this exhibit should be considered by the Director as a response by Petitioner to her April 14, 1997, letter.

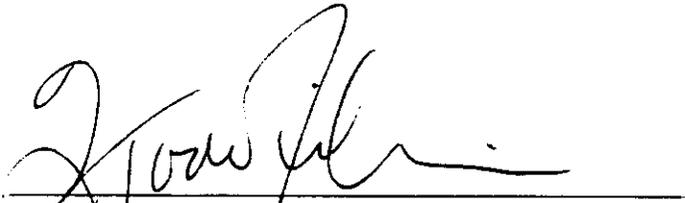
Petitioner argues that OED lacks authority to investigate the moral character and reputation of candidates for registration. Petition at 3-5. As discussed above, an applicant for registration to practice in patent cases before the PTO must establish to the satisfaction of the Director of OED that he or she is possessed of good moral character and repute, 37 C.F.R. § 10.7(a)(2)(i), and the Commissioner may require applicants "to show that they are of good moral character and reputation," 35 U.S.C. § 31. By promulgating 37 C.F.R. § 10.7(a)(2)(i), the Commissioner has, in the first instance, delegated his authority to the Director of OED to inquire into the moral character and reputation of candidates for registration. Thus, the Director has authority to perform those tasks and Petitioner's argument to the contrary is simply unpersuasive.

ORDER

Upon consideration of the petition to the Commissioner, it is

ORDERED that the petition be dismissed, and it is

FURTHER ORDERED that this matter be remanded to the Director for
action on her April 14, 1997, letter to Petitioner.

A handwritten signature in black ink, appearing to read "Q. Todd Dickinson", is written over a horizontal line.

Q. Todd Dickinson
Acting Assistant Secretary of Commerce and
Acting Commissioner of Patents and Trademarks



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
 ASSISTANT SECRETARY AND COMMISSIONER
 OF PATENTS AND TRADEMARKS
 Washington, D.C. 20231

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CERTIFIED MAIL No. P 259 649 685
 RETURN RECEIPT REQUESTED

I am pleased to inform you that you have attained a passing score on the registration examination given on August 28, 1996.

However, due to pending issues regarding your moral character and reputation, at this time your application is not being further processed, and you are not being granted limited recognition to practice before the Patent and Trademark Office in patent cases.

An Order to Show Cause (Order) will follow in due course. The Order will describe one or more issues regarding your moral character, and provide you with an opportunity to be heard on a written record regarding the same. You have the burden of proving that you possess good moral character and repute. You should present all relevant, objective evidence necessary to sustain your burden of proof.

In the registration applications you filed on February 27, and October 27, 1995, you answered question 6 on the applications affirmatively. As part of the explanation for your affirmative answers, you stated that you "have been 'charged' and/or arrested in respect with various

You also state that you may have been charged and/or arrested in regard to an incident with _____ and that the case was dismissed with prejudice in your favor. You suggest that relevant documents

You inquire how you may comply with the requirement for a detailed statement setting forth all relevant facts and dates along with relevant documents." The documents should be sought and obtained from the court or tribunal wherein the matter was heard or settled, or law enforcement authorities responsible for bringing the action(s). You should provide the detailed statement from your knowledge of the matter, as well as the documents obtained from the court or law enforcement authorities.

Please provide the statement and documents within thirty days of the date of this letter in an envelope addressed to the Commissioner of Patents and Trademark, Box OED, Washington, D.C.20231.

Sincerely,

Karen L. Bovard
 Karen L. Bovard, Director
 Office of Enrollment and Discipline

4-14-97
 Date