

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE DIRECTOR OF THE UNITED STATES
PATENT AND TRADEMARK OFFICE**

In the Matter of)
)
Matthew J. Peirce) **Proceeding No. D04-04**
)
)
_____)

FINAL ORDER

The Director of Enrollment and Discipline (OED Director) and Matthew Peirce (Respondent), USPTO Registration No. 41,245, have submitted a settlement agreement in the above proceeding that meets the requirements of 37 C.F.R. § 10.133(g).

In order to resolve the case without the necessity of a hearing, Respondent and the OED Director agreed to certain stipulated facts, legal conclusions and a stipulated term of suspension. Pursuant to that agreement this final order sets forth the following stipulated facts, agreed upon legal conclusions and suspension order.

STIPULATED FACTS

[Client I]

- 1 Respondent was engaged to prepare a patentability opinion for [Client I] (“[Client I]”).
- 2 On August 3, 1999, Respondent signed a patentability opinion for [Client I], suggesting that her invention was patentable.
- 3 Respondent’s patentability opinion did not discuss [Client I]’s disclosure of her invention to others nearly three years before contacting Advent, or that such a disclosure could potentially bar [Client I] from obtaining a patent on her invention.

[Client II]

- 4 On September 27, 1999, Respondent signed a patentability opinion for [Client II] (“[Client II]”), suggesting that [Client II]’s invention was patentable.

5 Respondent did not communicate with [Client II] prior to signing his patentability
opinion.

6 Respondent did not disclose to [Client II] what portion of the fees that [Client II] paid to
Advent Development Corporation were for Respondent's legal services.

[Client III]

7 Respondent was engaged to file a patent application on behalf of [Client III].

8 On March 5, 2001, Respondent filed U.S. Patent Application No. [] ("the [Client III]
application") with the USPTO on behalf of [Client III].

9 On April 12, 2001, the USPTO mailed a Notice to File Corrected Application Papers to
Respondent.

10 Respondent did not file a response to the Notice to File Corrected Application Papers
and, as a result, the [Client III] application went abandoned.

11 On August 6, 2002, Respondent filed a petition to revive the [Client III] application
alleging that he never received the Notice to File Corrected Application Papers.

12 On September 12, 2002, the USPTO denied Respondent's Petition.

13 In December 2004, Respondent filed, at his own expense, another petition to revive the
[Client III] application alleging that he never received the USPTO's denial of
Respondent's petition due to negligence of a secretary formerly employed by
Respondent.

[Client IV]

14 On January 2, 2001, Respondent filed U.S. Patent Application No. [] ("the [Client IV]
application") with the USPTO on behalf of [Client IV].

15 On February 15, 2001, the USPTO mailed a Notice to File Corrected Application Papers
to Respondent.

16 Respondent did not file a response to the Notice to File Corrected Application Papers and, as a result, the [Client IV] application went abandoned.

17 On August 14, 2002, Respondent filed a petition to revive the [Client IV] application alleging that he never received the Notice to File Corrected Application Papers.

18 On September 27, 2002, the USPTO denied Respondent's Petition.

19 In December 2004, Respondent filed, at his own expense, another petition to revive the [Client IV] application alleging that he never received the USPTO's denial of his petition due to negligence of a secretary formerly employed by Respondent.

[Client V]

20 On December 26, 2000, Respondent filed U.S. Patent Application No. [] ("the [Client V] application") with the USPTO on behalf of [Client V].

21 On February 16, 2001, the USPTO mailed a Notice to File Corrected Application Papers to Respondent.

22 Respondent did not file a response to the Notice to File Corrected Application Papers and, as a result, the '221 application went abandoned.

23 On August 14, 2002, Respondent filed a petition to revive the [Client V] application alleging that he never received the Notice to File Corrected Application Papers.

24 On September 27, 2002, the USPTO denied Respondent's Petition.

25 In January 2005, Respondent filed, at his own expense, another petition to revive the [Client V] application alleging that he never received the USPTO's denial of Respondent's petition due to negligence of a secretary formerly employed by Respondent.

[Client VI]

26 On June 22, 2001, Respondent filed U.S. Patent Application No. [] ("the [Client VI] application") with the USPTO on behalf of [Client VI].

27 On August 15, 2001, the USPTO mailed a Notice to File Corrected Application Papers to Respondent.

28 Respondent did not file a response to the Notice to File Corrected Application Papers and, as a result, the [Client VI] application went abandoned.

29 In December 2004, Respondent filed, at his own expense, a petition to revive the [Client VI] application alleging that he never received the Notice to File Corrected Application Papers due to negligence of a secretary formerly employed by Respondent.

[Client VII]

30 On June 7, 2001, Respondent filed U.S. Patent Application No. [] (“the [Client VII] application”) with the USPTO on behalf of [Client VII].

31 On August 8, 2001, the USPTO mailed a Notice to File Corrected Application Papers to Respondent.

32 Respondent did not file a response to the Notice to File Corrected Application Papers and, as a result, the [Client VII] application went abandoned.

33 In December 2004, Respondent filed, at his own expense, a petition to revive the [Client VII] application alleging that he never received the Notice to File Corrected Application Papers due to negligence of a secretary formerly employed by Respondent.

[Client VIII]

34 On June 8, 2001, Respondent filed U.S. Patent Application No. [] (“the [Client VIII] application”) with the USPTO on behalf of [Client VIII].

35 On August 8, 2001, the USPTO mailed a Notice to File Corrected Application Papers to Respondent.

36 Respondent did not file a response to the Notice to File Corrected Application Papers and, as a result, the [Client VIII] application went abandoned.

37 In December 2004, Respondent filed, at his own expense, a petition to revive the [Client VIII] application alleging that he never received the Notice to File Corrected Application Papers due to negligence of a secretary formerly employed by Respondent.

[Client IX]

38 On May 25, 2001, Respondent filed U.S. Patent Application No. [] (“the [Client IX] application”) with the USPTO on behalf of James Ainsworth.

39 On July 20, 2001, the USPTO mailed a Notice to File Corrected Application Papers to Respondent.

40 Respondent did not file a response to the Notice to File Corrected Application Papers and, as a result, the [Client IX] application went abandoned.

41 In December 2004, Respondent filed, at his own expense, a petition to revive the [Client IX] application alleging that he never received the Notice to File Corrected Application Papers due to negligence of a secretary formerly employed by Respondent.

[Client X]

42 On September 15, 2000, Respondent filed U.S. provisional patent application No. [] (the [Client X] provisional application) on behalf of [Client X].

43 On September 20, 2001, Respondent filed U.S. patent application No. [] (“the [Client X] application”) with the USPTO on behalf of [Client X]. The [Client X] application claimed priority to the [Client X] provisional application.

44 Respondent filed the [Client X] application five (5) days after the deadline for claiming priority to the [Client X] provisional application.

45 On December 6, 2001, the USPTO mailed an Office action for the [Client X] application to Respondent, rejecting the claims based upon several prior art references, including prior patents issued to Powell and Hammons.

- 46 Had Respondent filed the [Client X] provisional application within the statutory deadline, the Powell and Hammons references could not have been used by the examiner as prior art against the [Client X] application.
- 47 On June 6, 2002, Respondent filed a reply to the December 6th Office action, amending the claims and specification in the [Client X] application.
- 48 On July 31, 2002, the USPTO mailed a Notice of Non-Compliant Amendment to Respondent.
- 49 Respondent did not file a reply to the Notice of Non-Compliant Amendment and, as a result, the [Client X] application went abandoned.
- 50 Respondent has agreed to refund his attorneys fees in the amount of \$1,500 to [Client X].

LEGAL CONCLUSIONS

- 51 Based upon the foregoing, Respondent acknowledges that his conduct violated the following Disciplinary Rule of Professional Conduct as outlined in Section 10 of 37 C.F.R.:

Rule 10.68(a)(1) in that Respondent accepted compensation from someone other than his client without first giving the client full disclosure and then getting the client's consent; and

Rule 10.77 in that Respondent handled a legal matter without adequate preparation and/or neglected a legal matter entrusted to him.

SUSPENSION ORDER

- 52 Based upon the foregoing, it is:
- a. ORDERED that Respondent be suspended from practice of patent, trademark and other non-patent law before the USPTO for two years beginning June 1, 2005.

- b. ORDERED that the OED Director will publish the following Notice:

NOTICE OF SUSPENSION

Matthew J. Peirce (“Respondent”) of Las Vegas, Nevada, a patent attorney, Registration No. 41,245. In settlement of a disciplinary proceeding, the OED Director suspended Respondent from practice before the United States Patent and Trademark Office in patent, trademark, and other non-patent law cases for a period of two years. This action by the Director is taken pursuant to the provisions of 35 U.S.C. § 32, and 37 C.F.R. § 10.133(g).

- c. ORDERED that pursuant to 37 C.F.R. § 10.159(a), the OED Director will give notice of the final decision to appropriate employees of the USPTO and to interested departments, agencies, and courts of the United States, and will also give notice to appropriate authorities of the any State in which Respondent is known to be a member of the bar.

REINSTATEMENT ORDER

53 Further, it is:

- a. ORDERED that after complying with 37 C.F.R. § 10.158 for two years, Respondent may petition for reinstatement in accordance with 37 C.F.R. § 10.160 for suspended practitioners.

Date April 8, 2005

/s/
James A. Toupin
General Counsel
United States Patent and Trademark Office
on behalf of
Jon W. Dudas
Under Secretary of Commerce For Intellectual
Property and Director of the United States
Patent and Trademark Office

cc: Harry I. Moatz
Director of Enrollment and Discipline
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