

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

In the Matter of:

Isaak R. Jama,

Respondent.

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Proceeding No. D2019-13

FINAL ORDER

The Director of the Office of Enrollment and Discipline (“OED Director”) for the United States Patent and Trademark Office (“USPTO” or “Office”) and Isaak R. Jama (“Respondent”) have submitted a Proposed Settlement Agreement (“Agreement”) to the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (“USPTO Director”) for approval.

The Agreement, which resolves all disciplinary action by the USPTO arising from the stipulated facts set forth below, is hereby approved. This Final Order sets forth the parties’ stipulated facts, legal conclusion, and sanctions.

JURISDICTION

1. At all times relevant, Respondent of Federal Way, Washington, has been a registered patent agent (Registration Number 72,173) who is subject to the USPTO Rules of Professional Conduct, which are set forth at 37 C.F.R. §§ 11.101 through 11.901.

2. The USPTO Director has jurisdiction over this matter pursuant to 35 U.S.C. §§ 2(b)(2)(D) and 32, and 37 C.F.R. §§ 11.19, 11.20, and 11.26.

STIPULATED FACTS

3. Respondent registered to practice before the USPTO as a patent agent, Registration No. 72,173, on January 6, 2014.

4. Respondent was contacted in 2017 by Patent Lawyers USA (“PLUSA”) and was offered an opportunity to work with the company preparing and prosecuting patent applications as a contractor.

5. PLUSA’s general business practice was to sell patent and trademark services to inventors. PLUSA would assign the inventors to a practitioner who would perform certain services for the client, such as completing their patent application.

6. In 2017, Respondent began providing services to PLUSA’s patent clients who had contracted with the company.

7. PLUSA issued an email address to Respondent to use in communicating with PLUSA's clients.

8. The client retained PLUSA to provide patent services. One of the services that the client purchased was the preparation and filing of a provisional patent application for his invention.

9. PLUSA assigned Respondent to prepare and file the client's provisional patent application.

10. Respondent did not inform the client that a third party, PLUSA, was paying him to prepare the client's patent application.

11. Respondent did not inform the client of the amount of the fee that PLUSA was paying him to prepare the client's patent application.

12. On July 17, 2017, Respondent sent an email to the client asking him to review the draft of his provisional application and provide comments before he filed the application with the USPTO.

13. Respondent also contacted the client and told him to pay the USPTO filing fee to PLUSA so that the client's patent application could be filed with the Office.

14. The client paid the filing fee to PLUSA.

15. Thereafter, the client sought a status update from Respondent.

16. Respondent provided the client with inconsistent information as to when his patent application was filed.

17. Respondent first told the client that his patent application was filed in November 2017, but this representation was not accurate.

18. The client sought a second status update.

19. Respondent then told the client that his patent application was filed in December 2017, but this representation was not accurate.

20. Two provisional patent applications were filed on the client's behalf for the same invention on January 2, 2018.

21. Respondent did not explain to the client why two provisional patent applications were filed for his one invention on January 2, 2018.

22. On January 17, 2018, a third provisional patent application was filed relating to the client's one invention.

23. Respondent did not explain to the client why a third provisional patent application was filed for his one invention.

24. Respondent did not inform the client that his patent applications were filed with the USPTO on January 2, 2018 and January 17, 2018.

25. Respondent did not provide the client with filing receipts for the patent applications filed on his behalf.

26. Respondent did not provide the client with copies of the provisional patent application filed on his behalf.

27. The client continued to attempt to contact both Respondent and PLUSA but did not receive a response from either.

28. On January 25, 2018, Respondent contacted PLUSA informing them that his PLUSA email address was inaccessible.

29. PLUSA assured Respondent that the problem would be corrected. The problem with Respondent's PLUSA email address was not corrected.

30. Respondent contacted PLUSA two more times over the next two months reporting the problem with his PLUSA email address. Respondent received no communication from PLUSA, and the email address problem was not corrected.

31. During the time that Respondent's PLUSA email address was inaccessible, Respondent did not communicate with the client. Respondent did not attempt to contact the client by means other than his PLUSA email account.

32. Respondent failed to adequately communicate with the client.

JOINT LEGAL CONCLUSIONS

33. Respondent acknowledges that, based on the information contained in the Stipulated Facts, above, Respondent's acts and omissions violated the following provisions of the USPTO Rules of Professional Conduct:

- a. 37 C.F.R. § 11.104(a)(2) (failing to reasonably consult with the client about the means by which the client's objectives are to be accomplished) by not consulting with the client as to why three provisional patent applications were filed for the same invention;
- b. 37 C.F.R. § 11.104(a)(3) (failing to keep the client reasonably informed about the status of the matter) by telling the client that his provisional patent application was filed in November 2017, when it was not; telling the client that his patent application was filed in December 2017, when it was not; not informing the client that two provisional patent applications were filed for

his single invention on January 2, 2018; not informing the client that a third provisional patent application was filed for his single invention on January 17, 2018; not providing the client with filing receipts confirming that his provisional patent applications were filed; not providing the client with a copy of his provisional patent applications that were filed with the Office; not using alternate means of communication to respond to the client's inquiries during the time when his PLUSA email account was inaccessible; and

- c. 37 C.F.R. § 11.104(b) (failing to explain a matter to the extent reasonably necessary to permit the client to make informed decisions regarding the representation) by not informing the client that PLUSA, a third party, was paying him to prepare and file the client's provisional patent applications and not informing the client of the amount PLUSA was paying him to prepare and file the client's provisional patent applications; not explaining to the client why three provisional patent applications were filed for his one invention, and not explaining why it was advisable to file three separate applications for the same invention in order for the client to make an informed decision about whether to do so.

ADDITIONAL CONSIDERATIONS

34. Respondent represents that he has expressed contrition, he recognized the seriousness of his actions, he has fully cooperated with the USPTO since the filing of the Complaint, and he has not been previously disciplined by the USPTO.

AGREED UPON SANCTION

35. Respondent agrees and it is hereby ORDERED that:
- a. Respondent is hereby suspended from practice before the Office in patent matters for thirty (30) days, which shall commence fourteen (14) days after the date that the Final Order is signed;
 - b. Respondent shall serve a twenty-four (24) month probationary periods commencing on the signing of the Final Order;
 - c. Respondent shall not engage in the practice of patent matters as defined by 37 C.F.R. § 11.5(b)(1);
 - d. Respondent shall remain suspended from practice before the USPTO until the OED Director grants Respondent's petition for reinstatement pursuant to 37 C.F.R. § 11.60;
 - e. Respondent, at his own expense within twelve (12) months from the signing of the Final Order, shall complete the following:

- (1) Take the Multi-State Professional Responsibility Examination ("MPRE"), attaining a score of 85 or better, and provide a declaration to the OED Director with accompanying corroborating documents verifying compliance with this subparagraph; and
 - (2) Successfully complete three Continuing Legal Education ("CLE") classes on legal ethics where the primary subject matters are (i) communication with clients; (ii) trust accounts and safe keeping property, and (iii) law practice management; and provide the OED Director corroborating proof of successful completion of such courses, including: documentary evidence of his attendance and completion of such courses, a description of the content of the course for which credit was received, and a copy of all written materials provided to the course participants (or other corroborating proof acceptable to the OED Director).
- f. (1) in the event the OED Director is of the opinion that Respondent, during Respondent's probationary period, failed to comply with any provision of the Agreement, the Final Order, or any provision of the USPTO Rules of Professional Conduct, the OED Director shall:
- (A) issue to Respondent an Order to Show Cause why the USPTO Director should not enter an order immediately suspending the Respondent for up to an additional sixty (60) days for the violations set forth in the Joint Legal Conclusions, above;
 - (B) send the Order to Show Cause to Respondent at the last address of record Respondent furnished to the OED Director pursuant to 37 C.F.R. § 11.11(a);
 - (C) grant Respondent fifteen (15) days to respond to the Order to Show Cause; and
- (2) in the event that after the 15 day period for response and consideration of the response, if any, received from Respondent, the OED Director continues to be of the opinion that Respondent, during the probationary period, failed to comply with any provision of the Agreement, the Final Order, or any provision of the USPTO Rules of Professional Conduct, the OED Director shall:
- (A) deliver to the USPTO Director or his designee: (i) the Order to Show Cause; (ii) Respondent's response to the Order to Show Cause, if any; and (iii) argument and evidence supporting the OED Director's position; and

- (B) request that the USPTO Director enter an order immediately suspending Respondent from practice before the USPTO for up to an additional 60 days for the violations set forth in the Joint Legal Conclusions, above;
- g. Nothing in the Agreement or the Final Order shall prevent the Office from seeking discipline against Respondent pursuant to 37 C.F.R. §§ 11.19 through 11.57 for any misconduct engaged in by Respondent prior to, during, or after his probationary period including that which formed the basis for an Order to Show Cause issued pursuant to the preceding paragraph “f” above, or which led to the imposition of an additional suspension pursuant to paragraph “f” above;
- h. In the event the USPTO Director takes any such action against Respondent pursuant to paragraph “f” above, and Respondent seeks a review of any such action taken pursuant to paragraph “f” above, such review shall not operate to postpone or otherwise hold in abeyance such action;
- i. Respondent shall comply with 37 C.F.R. §§ 11.58 and 11.60 except as expressly addressed by the Agreement and the Final Order;

Respondent’s Duties and Responsibilities Under 37 C.F.R. § 11.58

- j. Respondent shall have the following duties and responsibilities as a consequence of being suspended:
 - (1) Respondent shall provide notice of his suspension to all clients he represents having immediate or prospective business before the Office as set forth in 37 C.F.R. § 11.58(b)(1)(ii), and shall make appropriate arrangements for legal services to be rendered on behalf of his clients, as appropriate, during the period of his suspension;
 - (2) Respondent shall provide notice of his suspension to the practitioners for all opposing parties (or, to the parties in the absence of a practitioner representing the parties) in matters pending before the Office as set forth in 37 C.F.R. § 11.58(b)(1)(iii);
 - (3) Respondent shall not hold himself out as authorized to practice law before the Office as set forth in 37 C.F.R. § 11.58(b)(3) until he is reinstated to practice before the Office;
- and

- (4) Respondent shall not render legal advice or services to any person having immediate or prospective business before the Office as set forth in 37 C.F.R. § 11.58(b)(5) until he is reinstated to practice before the Office;

Duties and Responsibilities with which Respondent Does Not Have to Comply Unless a Petition for Reinstatement of Respondent is Not Granted Within 90 Days of the Final Order

- k. Respondent shall not have to comply with the following duties and responsibilities as a consequence of being suspended, unless a petition for reinstatement of Respondent is not granted within 90 days of the Final Order:
 - (1) Respondent does not have to file a notice of withdrawal in each pending application as set forth in 37 C.F.R. § 11.58(b)(1)(i);
 - (2) Respondent does not have to deliver to all clients documents as set forth in 37 C.F.R. § 11.58(b)(1)(iv);
 - (3) Respondent does not have to relinquish to the client, or other practitioner designated by the client, all funds for practice before the Office, including any legal fees paid in advance that have not been earned and any advanced costs not expended as set forth in 37 C.F.R. § 11.58(b)(1)(v);
 - (4) Respondent does not have to remove any telephone, legal or other directory advertisement, statement or representation as set forth in 37 C.F.R. § 11.58(b)(1)(vi);
 - (5) Respondent does not have to change any existing advertising regarding his availability or ability to perform or render legal services for any person having immediate or prospective business before the Office as set forth in 37 C.F.R. § 11.58(b)(4); and
 - (6) Respondent does not have to take steps to change any sign identifying Respondent's or the Respondent's firm's office and Respondent's or Respondent's firm's stationery to delete therefrom any advertisement, statement, or representation which would reasonably suggest that the practitioner is authorized to practice law before the Office as set forth in 37 C.F.R. § 11.58(b)(6);

**Respondent Shall Provide an Affidavit of Compliance
Under 37 C.F.R. § 11.58**

- l. Respondent shall provide an affidavit of compliance in accordance with 37 C.F.R. §§ 11.58(b)(2) certifying that he has complied with the provisions of the Agreement and the Final Order. Appended to the affidavit shall be a copy of each form of notice, the names and addresses of the clients, practitioners, courts, and agencies to which notices were sent, and all return receipts or returned mail received up to the date of the affidavit as set forth in 37 C.F.R. § 11.58(b)(2)(i);
- m. Respondent's affidavit need not include the following:
 - (1) a schedule showing the location, title and account number of every bank account designated as a client or trust account, deposit account in the Office, or other fiduciary account, and of every account in which Respondent holds or held as of the entry date of the order any client, trust, or fiduciary funds for practice before the Office as set forth in 37 C.F.R. § 11.58(b)(2)(ii);
 - (2) a schedule describing Respondent's disposition of all client and fiduciary funds for practice before the Office in Respondent's possession, custody or control as of the date of the order or thereafter as set forth in 37 C.F.R. § 11.58(b)(2)(iii);
 - (3) proof of the proper distribution of funds and the closing of such accounts as has been requested by the OED Director, including copies of checks and other instruments as set forth in 37 C.F.R. § 11.58(b)(2)(iv); or
 - (4) an affidavit describing the precise nature of the steps taken to remove from any telephone, legal, or other directory any advertisement, statement, or representation which would reasonably suggest that the practitioner is authorized to practice patent, trademark, or other non-patent law before the Office as set forth in 37 C.F.R. § 11.58(b)(2)(vi);

Respondent is Not Afforded Limited Recognition

- n. Because Respondent's suspension shall commence fourteen (14) days after the date that the Final Order is signed, Respondent shall not be granted limited recognition under 37 C.F.R. § 11.58(c);

**Respondent is to Submit a Petition For Reinstatement
Under 37 C.F.R. § 11.60**

- o. Respondent shall not resume practice in patent matters before the Office until reinstated by order of the OED Director or the USPTO Director as set forth in 37 C.F.R. § 11.60(a);
- p. After the term of Respondent's suspension and compliance with the applicable provisions of 37 C.F.R. § 11.58 as set forth in the Final Order, Respondent may file a petition for reinstatement as set forth in 37 C.F.R. § 11.60(b);
- q. Any petition for reinstatement shall be filed with the OED Director and shall be accompanied by the required fee as set forth in 37 C.F.R. § 11.60(c);
- r. Upon filing of a petition for reinstatement by Respondent, such petition shall comply with the applicable provisions of 37 C.F.R. §§ 11.60(c)(1)-(3) and shall attest to his compliance with the applicable provisions of 37 C.F.R. § 11.58 set forth in the Final Order, including a sworn declaration that he has complied with 37 C.F.R. § 11.58(a) affirming that he has not engaged in the practice of patent matters before the Office during his suspension;
- s. The OED Director does not have to publish a notice of Respondent's petition for reinstatement as set forth in 37 C.F.R. § 11.60(g);

Other Considerations

- t. Nothing in the Agreement or the Final Order shall prevent the Office from considering the record of this disciplinary proceeding, including the Final Order: (1) when addressing any further complaint or evidence of the same or similar misconduct concerning Respondent brought to the attention of the Office; and/or (2) in any future disciplinary proceeding against Respondent (i) as an aggravating factor to be taken into consideration in determining any discipline to be imposed, and/or (ii) to rebut any statement or representation by or on Respondent's behalf, and/or (3) in connection with any request for reconsideration submitted by Respondent pursuant to 37 C.F.R. § 11.60;
- u. The OED Director shall electronically publish the Final Order at OED's electronic FOIA Reading Room, which is publicly accessible at:
<http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>;
- v. The OED Director publish a notice in the *Official Gazette* that is materially consistent with the following:

Notice of Suspension and Probation

This notice regards Isaak R. Jama of Federal Way, Washington, who is a registered patent agent (Registration No. 72,173). In settlement of a disciplinary proceeding, the Director of the United States Patent and Trademark Office ("USPTO" or "Office") has suspended Mr. Jama from practice before the Office in patent, trademark and non-patent matters for thirty (30) days and placed him on probation for twenty-four (24) months from the date of the Final Order for violating 37 C.F.R. §§ 11.104(a)(2), 11.104(a)(3), and 11.104(b) (communication).

Mr. Jama is also required to take the Multi-state Professional Responsibility Exam ("MPRE") and acquire a score of 85 or better. He must also take three Continuing Legal Education ("CLE") classes.

The suspension and probation are predicated upon Mr. Jama's violations of provisions of the USPTO Rules of Professional Conduct concerning communication in connection with his providing patent services for a client. Mr. Jama agreed to contract with Patent Lawyers USA ("PLUSA") to accept client referrals, and to provide patent legal services to those clients. Mr. Jama prepared a provisional patent applications for a client. Respondent did not inform the client that PLUSA, a third party, was paying Respondent and did not inform the client of the amount PLUSA paid him to prepare the patent application. Respondent prepared the provisional patent application and sent it to the client asking the client to review it before he would file the application with the USPTO. Mr. Jama told the client to pay PLUSA the filing fee for his provisional patent application, so that it could be filed. The client did so. The client sought from Mr. Jama a status update on his patent application. Mr. Jama informed him that the application was filed in November 2017, but it was not filed in November. The client again sought the status of his patent application. Mr. Jama told the client that it was filed in December 2017, but it was not filed in December. The client's provisional patent application was filed twice on January 2, 2018. The client's patent application, for the same invention, was filed a third time on January 17, 2018. Mr. Jama neither explained to his client why his provisional patent application was filed three times nor did he explain why it might be advantageous to do so. Mr. Jama did not provide the client with filing receipts for his patent applications, and did not provide him with a copy of the applications that were filed with the Office. The client continued attempting to contact Mr. Jama regarding his patent application, but did not receive a response. Mr. Jama's email address assigned by PLUSA to communicate with his PLUSA clients became inaccessible. Despite Mr. Jama's attempts to have PLUSA fix the issue with his email account, the company did not do so. Over a three month period of time, Mr. Jama did not have access to his PLUSA email account. As a result, Mr. Jama did not communicate with the client and did not use alternative means of

communication during this time. Mr. Jama did not adequately communicate with his client.

In reaching this settlement agreement, the OED Director considered the following: (1) Mr. Jama expressed contrition; (2) he recognized the seriousness of his actions; (3) he fully cooperated with the USPTO since the filing of the Complaint; and (4) he has not been previously disciplined by the USPTO.

This action is the result of a settlement agreement between Mr. Jama and the OED Director pursuant to the provisions of 35 U.S.C. §§ 2(b)(2)(D) and 32 and 37 C.F.R. §§ 11.19, 11.20, and 11.26. Disciplinary decisions involving practitioners are posted for public reading at the OED Reading Room, available at: <http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>.

- w. Respondent waives: (i) seeking reconsideration of the Final Order under 37 C.F.R. § 11.56, (ii) having the Final Order reviewed under 37 C.F.R. § 11.57, and (iii) otherwise appealing or challenging the Final Order in any manner; and
- x. The OED Director and Respondent shall each bear their own costs incurred to date and in carrying out the terms of the Agreement and this Final Order.

4/15/19
Date



Sarah T. Harris
General Counsel
United States Patent and Trademark Office

on delegation by

Andrei Iancu
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

cc:

OED Director
U.S. Patent and Trademark Office

Mr. Isaak R. Jama
30819 2nd Avenue, South
Federal Way, WA 98003