

**UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF VIRGINIA
ALEXANDRIA DIVISION**

EDWIN D. SCHINDLER,

Plaintiff,

-v.-

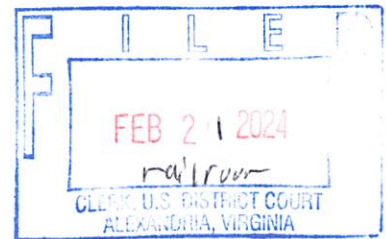
KATHI VIDAL,

**Under Secretary of Commerce for
Intellectual Property and Director
of the United States Patent and
Trademark Office, Sued in Her Official
Capacity Only,**

Defendants.

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Civil Action No.



COMPLAINT

Plaintiff, Edwin D. Schindler, alleges for his Complaint against Defendant Kathi Vidal, Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, Official Capacity Only, as follows:

The Parties

1. Plaintiff Edwin D. Schindler ("Schindler"), a natural person, is a member of the New York Bar and registered to practice as a patent attorney before the United States Patent and Trademark Office in patent cases since 1984 and has obtained the issuance of approximately 800 United States patents for his clientele in his private practice of patent law.

2. Defendant Kathi Vidal, a natural person, is the Under Secretary of Commerce

for Intellectual Property and is Director of the United States Patent and Trademark Office (“Director”) and is being sued in her official capacity only.

COUNT I

**Review of “Final Decision and Order” of a Two-Year Suspension
From Practice Before the Patent and Trademark Office under 35 U.S.C. §32**

3. This is a claim for review of a Final Decision and Order of the Director of the United States Patent and Trademark Office suspending Plaintiff Edwin D. Schindler from practice before the United States Patent and Trademark Office for two years arising from PTO Disciplinary Proceeding No. 2019-43. The Final Decision and Order was entered December 5, 2023; a timely Motion for Reconsideration was filed December 22, 2023. Denial of Plaintiff’s Motion for Reconsideration was entered January 19, 2024. All relevant documents shall be deemed incorporated by reference. This Complaint is being timely filed in view of the intervening Presidents’ Day weekend.

4. This Court has jurisdiction over the subject matter of this claim, pursuant to 28 U.S.C. §§1331, 1338(a) and 35 U.S.C. §32, on the ground that this claim “arises under” the United States Patent Law.

5. Venue is proper and mandated in this district, pursuant to 35 U.S.C. §32.

6. A disciplinary three-count complaint issued against Plaintiff on July 10, 2019, by the Office of Enrollment and Discipline (“OED”) of the United States Patent and Trademark Office (“PTO”) alleging that Plaintiff violated the disciplinary rules of professional responsibility of the PTO; the Complaint was assigned Disciplinary No. 2019-43.

7. No disciplinary grievance was filed by any client.

8. No client appeared at the hearing for adjudicating the OED’s Complaint held

November 20, 2019.

9. No audio or visual recordings were presented of any client testifying or otherwise complaining of the quality of patent legal services rendered by Plaintiff.

10. All “client” allegations were presented in notes taken by Diana Oleska of the OED, and admitted into evidence over Plaintiff’s objection, based upon purported unrecorded telephone calls with several clients.

11. The PTO/OED successfully raised an objection to Plaintiff’s attempts to cross-examine Ms. Oleska regarding her telephone conversations with several clients.

12. The PTO/OED insists that it was permitted to prosecute its Complaint against Plaintiff, even if based entirely on hearsay or double hearsay.

13. In the hearing conducted November 20, 2019, the Administrative Law Judge questioned whether the refusal to allow Plaintiff to cross-examine Diana Oleska about the purported “notes” that she took with only certain clients when speaking on the telephone amounted to a denial of Plaintiff’s constitutional right to due process.

14. In the Initial Decision and Order issued by the Administrative Law Judge (“ALJ”) on June 8, 2023, through it was dated September 23, 2021, the ALJ determined that there was no “actual injury” and “no tangible harm” to any client.

15. The Initial Decision and Order, issued June 8, 2023, was grossly untimely because it was rendered nearly four years after commencement of the disciplinary proceeding and more than three years after the conclusion of all post-hearing briefing.

16. Plaintiff has been prejudiced by the gross delay of the ALJ in rendering the Initial Decision and Order nearly four years after commencement of the disciplinary proceeding.

17. According to the Initial Decision and Order (at 10), issued June 8, 2023, the ALJ wrote that:

“‘Practice before the [PTO] Office’ includes, but is not limited to, any ‘law-related service that comprehends any matter connected with the presentation to the Office or any of its officers or employees relating to a client’s rights, privileges, duties, or responsibilities under the laws or regulations administered by the Office for the grant of a patent or registration of a trademark.’ 37 C.F.R. § 11.5(b) (2020). This includes ‘preparing necessary documents in contemplation of filing the documents with the Office ... as well as communicating with and advising a client concerning matters pending or contemplated to be presented before the Office.’”

18. During (or about) May 2016, Michael I. Kroll (“Kroll”) was “excluded” from practice before the PTO due to a disciplinary violation, but nevertheless retained his status as a “general attorney,” admitted to the New York Bar, and remained in “good standing.”

19. Following Kroll’s exclusion from “Practice before the Office,” but nevertheless retaining his status as an attorney under New York law, Plaintiff commenced representing Kroll’s clientele before the PTO; Kroll never again filed papers in the PTO.

20. In several instances, Kroll’s patent and trademark clients would work directly with Plaintiff and chose to no longer work or associate with Kroll.

21. In many instances, Kroll, as an attorney, would continue to advise his clients on patent and trademark law matters, since even non-patent attorneys are permitted to render such legal advice, and for certain clients, Kroll would prepare initial drafts of papers and obtain patent drawings for the inclusion in U.S. patent applications and forward them to Plaintiff, who would review, revise and exercise absolute discretion as to what was (or was not) to be filed for Kroll’s clients in the PTO.

21. Plaintiff’s filings with the PTO on behalf of Kroll’s clients, without

exception, would be signed by Plaintiff and include solely Plaintiff's contact information; Kroll's name and contact information did not appear on any paper filed by Plaintiff.

22. Plaintiff obtained a signed power-of-attorney from each of Kroll's clients to act on their behalf.

23. At no time did Kroll ever use Plaintiff's PTO registration number or electronic filing authorization to file anything under Plaintiff's name or PTO registration number.

24. Kroll did not file any papers in the PTO subsequent to his exclusion from practice before the PTO.

25. Count I of the OED's Complaint alleged that Plaintiff "assisted Mr. Kroll in the unauthorized practice of law before the USPTO."

26. In the Initial Decision and Order (at 10), issued June 8, 2023, the ALJ wrote that:

"Mr. Kroll's communication with his and Respondent's joint clients constituted 'practice before the Office' because, through these communications, Mr. Kroll continued to counsel and advise clients concerning legal matters pending before the USPTO. As noted above, 'practice before the Office' includes consulting with or giving advice to a client in contemplation of filing documents with the Office."

27. Foreign patent attorneys and patent agents (with the exception of many Canadian patent agents that are permitted to be registered before the PTO) are not registered to practice before the United States Patent and Trademark Office and are therefore not permitted to file and prosecute their foreign clients' U.S. patent applications in the PTO. *See, Willemijn Houdstermaatschaap BV v. Apollo Computer, Inc.*, 707 F.Supp. 1429, 1446-1447 (D. Del. 1989) (British patent agents "are not patent attorneys under U.S. law).

28. Foreign patent attorneys and patent agents not registered to practice before the U.S. Patent and Trademark Office nevertheless counsel, prepare, file and prosecute U.S. patent applications through U.S. patent attorneys and U.S. patent agents; this is true even if the foreign patent attorney or agent is independent, or outside, patent counsel to the foreign patent applicant, as opposed to in-house counsel to a client which deals directly with U.S. patent counsel. *Id.*

29. Foreign patent attorneys and patent agents not registered to practice before the U.S. Patent and Trademark Office consult with, or give advice to, a client in contemplation of filing documents with the PTO and, in fact, initially prepare documents for U.S. patent attorneys and patent agents contemplated to be filed by a U.S. patent attorney or patent agent in the PTO, subject to review and revision, as required, by the U.S. patent attorney or patent agent.

30. Foreign patent attorneys and foreign patent agents not registered to practice before the U.S. Patent and Trademark Office are nevertheless engaged in “practice before the Office,” or the unauthorized practice of patent law before the U.S. Patent and Trademark Office, in accordance with the PTO’s definition of “Practice before the Office,” because unregistered foreign patent attorneys and foreign patent agents consult with, or give advice to, a foreign client contemplating the filing of documents with the Office and, in fact, prepare documents and forward to registered U.S. patent attorneys and patent agents with the expectation that such documents prepared by the foreign patent attorney or foreign patent agent would be filed in the U.S. Patent and Trademark Office by the U.S. patent attorney or U.S. patent agent with, perhaps, necessary revisions in some cases.

31. Foreign patent attorneys and foreign patent agents not registered to practice before the U.S. Patent and Trademark Office are engaged in the unauthorized practice of law before the U.S. Patent and Trademark Office under the expansive and boundless definition of the PTO as to what constitutes “Practice before the Office.”

32. U.S. attorneys registered to practice before the U.S. Patent and Trademark Office as “patent attorneys,” or non-attorneys registered to practice before the U.S. Patent and Trademark Office as “patent agents,” and who file and prosecute U.S. patent applications on behalf of foreign patent attorneys and foreign patent agents, who provide the U.S. patent attorney or U.S. patent agent with documents contemplated to be filed in the U.S. PTO, even if such documents are reviewed and revised by the U.S. patent attorney or patent agent, are aiding the unauthorized practice of law before the U.S. Patent and Trademark Office of foreign patent attorneys and foreign patent agents not registered to practice before the U.S. PTO under the expansive, boundless and vague definition of the PTO as to what constitutes “Practice before the Office.”

33. General attorneys admitted to the bar of at least one United States jurisdiction, but not registered to practice before the PTO as patent attorneys are nevertheless able to litigate patent matters before the federal courts and therefore must be able to advise and counsel their clients in patent law matters, including what might be advisable to file in the U.S. Patent and Trademark Office, such as, but not limited to, requests for reexamination of patents and the initiation and prosecution of *inter partes* proceedings pertinent to ongoing patent litigation.

36. *Sperry v. Fla. ex rel. Fla. Bar*, 373 U.S. 379 (1963), holds that states and other U.S. jurisdictions cannot bar a person registered to practice as a patent attorney or

patent agent from practicing patent law before the U.S. Patent and Trademark Office within the jurisdiction or territorial limitations of the particular state or U.S. jurisdiction when the person registered to practice is not otherwise admitted to the bar as an attorney of that state or U.S. jurisdiction.

37. *Sperry v. Fla. ex rel. Fla. Bar*, 373 U.S. 379 (1963), is a restriction on state bars and the bars of other U.S. jurisdictions from restricting persons registered to practice before the U.S. PTO from practicing before the U.S. PTO, and does not provide a legal basis for allowing the U.S. Patent and Trademark Office to otherwise restrict the practice of general attorneys admitted to state bars and the bars of other U.S. jurisdictions from practicing law under the authority of the bar(s) to which a general attorney is admitted.

38. *Sperry v. Fla. ex rel. Fla. Bar*, 373 U.S. 379 (1963), is a restriction on state bars and the bars of other U.S. jurisdictions from restricting persons registered to practice before the U.S. PTO from practicing before the U.S. PTO, and does not provide a legal basis for allowing the U.S. Patent and Trademark Office to otherwise restrict the practice of general attorneys admitted to state bars and the bars of other U.S. jurisdictions from practicing patent law as may be permissible by the federal court(s) to which general attorneys are admitted.

39. Nothing in *Sperry v. Fla. ex rel. Fla. Bar*, 373 U.S. 379 (1963), allows the U.S. Patent and Trademark Office to regulate the practice of general attorneys admitted to the bar of one or more states or other U.S. jurisdictions from discussing or counseling their clientele regarding patent law or what might be contemplated, or drafted, for eventual filing in the U.S. Patent and Trademark Office, inasmuch as such legal issues are pertinent to patent litigation in the federal courts and may be litigated by general

attorneys not registered to practice before the PTO.

40. Kroll is a general attorney admitted to the New York Bar, and continues to be in “good standing,” and permitted to maintain a legal practice, provide legal advice and collect a reasonable fee for legal service provided to a legal clientele and to litigate patent and trademark matters in various courts.

41. Plaintiff reviewed, revised, as required, within Plaintiff’s professional and legal judgment and exercising absolute discretion of all papers initially prepared by Kroll for eventual filing in the PTO solely by Plaintiff (not Kroll), which papers were solely signed by, and provided solely the contact information of, Plaintiff, and not Kroll.

42. Plaintiff obtained signed powers-of-attorney to act on behalf of all of the joint clients of Plaintiff and Kroll in the prosecution of their patent applications before the U.S. Patent and Trademark Office.

43. The current version of 37 C.F.R. §11.5(b) (2024) (similar in certain respects to earlier versions of the Rule) reads, in pertinent part, as follows:

“(b) *Practice before the Office.* Practice before the Office includes, but is not limited to, law-related service that comprehends any matter connected with the presentation to the Office or any of its officers or employees relating to a client’s rights, privileges, duties, or responsibilities under the laws or regulations administered by the Office for the grant of a patent or registration of a trademark, or for enrollment or disciplinary matters. Such presentations include preparing necessary documents in contemplation of filing the documents with the Office, corresponding and communicating with the Office, and representing a client through documents or at interviews, hearings, and meetings, as well as communicating with and advising a client concerning matters pending or contemplated to be presented before the Office.”

44. Foreign patent attorneys and foreign patent agents not registered to practice before the U.S. Patent and Trademark Office “prepar[e] necessary documents in contemplation of filing the documents with the Office . . . and represent[s] a client

through documents or at interviews, hearings and meetings, as well as communicating with and advising a client concerning matters pending or contemplated to be presented before the Office,” and therefore engage in the “practice” of patent law before the PTO.

45. Kroll referred patent prosecution work to Plaintiff in the identical manner by which unregistered foreign patent attorneys and foreign patent agents refer patent applications for filing, and prosecution, in the U.S. Patent and Trademark Office to U.S. patent attorneys and U.S. patent agents, and if such unregistered foreign patent attorneys and foreign patent agents are not engaged in the practice of law before the PTO, then neither would Kroll be engaged in the unauthorized practice of law before the Office, and Plaintiff could not be aiding Kroll in the unauthorized practice of law before the Office.

46. Alternatively, if Kroll were engaged in the unauthorized practice of law before the Office, pursuant to 37 C.F.R. §11.5(b), then the same would be true of all foreign patent attorneys and foreign patent agents not registered to practice before the PTO by sending documents to registered U.S. patent attorney and patent agents for eventual filing in the PTO, and those registered U.S. patent attorneys and patent agents would be aiding the unregistered foreign patent attorneys and patent agents in the unauthorized practice of law before the Office.

47. Kroll was not engaged in the unauthorized practice of law before the PTO when referring work and clients to Plaintiff who had absolute discretion as to what was filed, how it was filed, whether it was filed, and Plaintiff solely signed all papers filed in the PTO and Plaintiff’s contact information was the only contact information provided in all such PTO filings, and all joint clients of Plaintiff and Kroll knew (or should have known) that Plaintiff prepared, signed and filed their patent documents with the PTO by

virtue of such documents carrying only Plaintiff's signature and contact information.

48. Plaintiff was not aiding Kroll in the unauthorized practice of law before the PTO because Kroll was not engaged in the unauthorized practice of law before the PTO.

49. The ALJ characterized Count II of the OED Complaint by stating in the Initial Decision and Order (at 9), issued June 8, 2023, that the OED Director alleges that Plaintiff "engaged in the impermissible division of fees without client consent by sharing legal fees with Mr. Kroll."

50. Plaintiff obtained a signed power-of-attorney from each client referred to Plaintiff by Kroll to act on behalf of such clients before the PTO in the prosecution of their respective patent applications.

51. The PTO Rules of Practice do not define what association of attorneys constitutes a "law firm."

52. Upon information and belief, numerous large law firms, which may include both general attorneys and registered patent attorneys, are known to have multiple offices, which do not list all attorneys of the law firm on letterhead or other firm material.

53. Patent clients referred to Plaintiff by Kroll signed a power-of-attorney received from Kroll which provided Plaintiff with the agency to act on behalf of all such patent clients referred to Plaintiff by Kroll, thereby placing all of the clients referred to Plaintiff by Kroll on reasonable notice that Plaintiff would be receiving a portion of any legal fee for legal work performed for all such joint clients of Plaintiff and Kroll.

53. Plaintiff was not a "ghostwriter" working for Kroll's patent clients.

54. Plaintiff did not engage in so-called overflow work unbeknownst to Kroll's patent clients.

55. Plaintiff and Kroll formed a “law firm” for the clients referred to Plaintiff by Kroll and all such clients knew, or should have known, that Plaintiff would receive a portion of any legal fee for legal services performed; particularly since there is no established definition of that which constitutes a “law firm.”

56. No joint client of Plaintiff and Kroll paid an “unreasonable” fee and no contention was made by either the OED or any joint client of having paid anything other than a “reasonable” fee for legal services authorized by, and performed for, clients referred to Plaintiff by Kroll.

57. All clients of Kroll referred to Plaintiff had the option of working directly, and solely, with Plaintiff and several clients elected to work solely with Plaintiff and have no further dealings with Kroll, while other clients elected to continue working with Kroll, many of whom knew Kroll and worked with him for many years; other clients chose to retain entirely new patent counsel to perform their patent legal work.

57. The ALJ determined that Plaintiff’s alleged “misconduct” caused no actual harm or injury to any client, no client filed any grievance against Plaintiff, and no client appeared at the hearing in the OED disciplinary proceeding to testify against Plaintiff, notwithstanding efforts by the OED to seek the appearance of various clients to appear at the hearing to provide testimony in support of the OED’s Complaint.

58. Plaintiff and Kroll did not improperly split fees and did form a “law firm” by virtue of the signed power-of-attorney provided to Plaintiff, which were obtained by Kroll, thereby providing all joint clients with knowledge that Plaintiff and Kroll were working together on their patent prosecution work.

59. The ALJ characterized Count III of the OED Complaint by stating in the

Initial Decision and Order (at 9), issued June 8, 2023, that the OED Director alleges that Plaintiff “engaged in misconduct by failing to adequately communicate with his clients.”

60. Title 37 C.F.R. §11.104 requires a practitioner to reasonably consult with his clients regarding the means by which the clients’ objectives are to be accomplished.

61. In the Initial Decision and Order (at 15), the ALJ determined that:

“Although [Plaintiff] could have improved his client communications in the ways discussed above, the evidence does not establish a general failure to reasonably consult with clients regarding their objectives or to abide by their decisions regarding how to accomplish those objectives. The record indicates that [Plaintiff] consulted with clients through Mr. Kroll, who relayed instructions to Respondent based on his discussions with the clients.”

62. Foreign patent attorneys and foreign patent agents not registered to practice before the prosecuting U.S. patent applications are almost always exclusively the attorney or agent that corresponds and consults with the actual client of both the U.S. patent attorney/agent and the foreign patent attorney/agent with the U.S. patent attorney and U.S. patent agent very infrequently having direct correspondence with the ultimate client.

63. Based upon the finding of the ALJ, Plaintiff “reasonably consult[ed]” with the patent clients referred to Plaintiff by Kroll and therefore complied with 37 C.F.R. §11.104 according to the findings of the ALJ finding the hearing conducted November 20, 2019, and the determination of the PTO to the contrary is against the factual findings of the ALJ, particularly in light of the absence of any tangible harm or actual injury to any client.

COURT II

Count for Declaratory Judgment that the Limits and Bounds of Patent and Trademark Office's Definition of "Practice Before the Office" Should Be Held Void for Vagueness and its Application is Arbitrary and Capricious

64. This is a claim for declaratory judgment that 37 C.F.R. §11.5(b) which defines legal practice before the PTO is lacking in any discernable boundaries or limits and deems "Practice before the Office" that unlawfully, or without constitutional or lawful authority, regulates or improperly restricts the lawful practice of general attorneys admitted to the bar of at least one state or U.S. jurisdiction, while seemingly permitting "Practice before the Office" by foreign patent attorneys and foreign patent agents not registered to practice law before the U.S. Patent and Trademark Office.

65. This Court has subject matter over the jurisdiction of this claim under the Declaratory Judgment Act, 28 U.S.C. §§2201, 2202, in combination with 28 U.S.C. §§1331, 1338(a), on the ground that this claim "arises under" the federal Patent Law, including 35 U.S.C. §32.

66. Plaintiff incorporates by reference the allegations of ¶¶ 1-65 of this Complaint, as if fully set forth herein.

67. Title 37 C.F.R., §11.5(b) (2024) (similar in certain respects to earlier versions of the Rule) reads, in pertinent part, as follows:

"(b) Practice before the Office. Practice before the Office includes, but is not limited to, law-related service that comprehends any matter connected with the presentation to the Office or any of its officers or employees relating to a client's rights, privileges, duties, or responsibilities under the laws or regulations administered by the Office for the grant of a patent or registration of a trademark, or for enrollment or disciplinary matters. Such presentations include preparing necessary documents in contemplation of filing the documents with the Office, corresponding and communicating with the Office, and representing a client through documents or at

interviews, hearings, and meetings, as well as communicating with and advising a client concerning matters pending or contemplated to be presented before the Office.”

68. The definition of the PTO of “Practice before the Office” is defined as including, “but not limited to” a wide range of activities termed “law-related service” which might include a “thought crime” as one who might “comprehend[] any matter connected with the presentation” of documents, etc., for obtaining “the grant of a patent or registration of a trademark.”

69. Acts not mentioned in 37 C.F.R. §11.5(b) could still conceivably constitute the practice of law before the PTO because that which is recited in 37 C.F.R. §11.5(b) is “not limited to” that mentioned in the foregoing provision and could include other unspecified activities not recited therein rendering it difficult, if not impossible, for a reasonably intelligent person to ascertain whether his or her activities do not constitute “Practice before the Office” and therefore are not in violation of that which may nevertheless later be deemed the unauthorized practice of law before the PTO, thereby rendering 37 C.F.R. §11.5(b) void for vagueness.

70. Foreign patent attorneys and foreign patent agents not registered to practice before the U.S. Patent and Trademark Office “prepar[e] necessary documents in contemplation of filing the documents with the Office,” in addition to other activities mentioned in 37 C.F.R. §11.5(b).

71. Foreign patent attorneys and foreign patent agents not registered to practice before the U.S. Patent and Trademark Office are engaged in “Practice before the Office,” as defined by 37 C.F.R. §11.5(b), yet this is understood to be permissible by the PTO.

72. General attorneys not registered to practice before the PTO as patent

attorneys are nevertheless permitted to litigate patent matters in the federal courts and, in doing so, will often “contemplate[e] . . . the filing of documents with the Office,” such as requests for reexamination, *inter partes* reviews, and the filing of continuation patent applications in furtherance of, *e.g.*, patent infringement litigation, yet this is understood to be permissible by the PTO.

73. The application of 37 C.F.R. §11.5(b) by the PTO/OED which permits foreign patent attorneys/agents to prepare “necessary documents” for filing with the PTO through a U.S. patent attorney or patent agent, and which permits general attorneys, those not registered to practice before the PTO, to engage in “law-related service that comprehends . . . matter[s] connected with the presentation to the Office” or “necessary documents,” is arbitrary and capricious, thereby rendering the definition of “Practice before the Office” by the PTO to be void for vagueness, and improper and inconsistent application.

COURT III

Count for Declaratory Judgment of Denial of Plaintiff’s Constitutional Right to Due Process under the “Equal Protection Component” of the Fifth Amendment by the PTO

74. This is a claim for declaratory judgment that the Patent and Trademark Office has violated Plaintiff’s constitutional right to Due Process under the “Equal Protection Component” of the Fifth Amendment by treating Plaintiff differently when handling the patent work of Kroll’s clientele from other U.S. patent attorneys and patent agents in their professional dealings with foreign patent attorneys/agents; the latter of which are not registered to practice before the PTO.

75. This Court has subject matter over the jurisdiction of this claim under the

Declaratory Judgment Act, 28 U.S.C. §§2201, 2202, in combination with 28 U.S.C. §§1331, 1338(a), on the ground that this claim “arises under” the federal Patent Law, including 35 U.S.C. §32.

76. Plaintiff incorporates by reference the allegations of ¶¶ 1-73 of this Complaint, as if fully set forth herein.

77. Foreign patent attorneys and patent agents not registered to practice before the PTO, yet prepare “necessary documents,” as recited in 37 C.F.R. §11.5(b), which are forwarded to U.S. patent attorneys and patent agents for eventual filing in the PTO, which the PTO deems to be a permissible practice.

78. Kroll is an attorney admitted to the New York Bar and in “good standing,” but is not registered to practice before the PTO, who would prepare documents for review, revision and eventual filing (if appropriate) in the PTO by Plaintiff, yet the PTO considers Kroll to be engaged in the unauthorized practice of law, and Plaintiff to be assisting in Kroll’s unauthorized practice before the PTO, while the practice of U.S. patent attorneys and patent agents, in collaboration with their foreign counterpart patent attorneys and patent agents, is deemed acceptable to the PTO, thereby treating Plaintiff differently and unequally vis-à-vis U.S. patent attorneys and patent agents in their professional dealings with their respective foreign patent attorneys and agents, and thus depriving Plaintiff of Equal Protection under the “Equal Protection Component” of the Fifth Amendment.

COUNT IV

Count for Declaratory Judgment of Denial of Plaintiff's Constitutional Right to Due Process under the Fifth Amendment by the PTO Resulting for the Use of Hearsay Evidence and Denial of the Right to Cross-Examine the OED's Witness Diana Oleska Concerning Her Communications with Clients

79. This is a claim for declaratory judgment that the Patent and Trademark Office has violated Plaintiff's constitutional right to Due Process under the Fifth Amendment by the use of hearsay evidence and denial of the right to cross-examine Diana Oleska of the OED, who testified from her notes of telephone conversations with clients, thereby depriving Plaintiff of constitutional Due Process under the Fifth Amendment.

80. This Court has subject matter over the jurisdiction of this claim under the Declaratory Judgment Act, 28 U.S.C. §§2201, 2202, in combination with 28 U.S.C. §§1331, 1338(a), on the ground that this claim "arises under" the federal Patent Law, including 35 U.S.C. §32.

81. Plaintiff incorporates by reference the allegations of ¶¶ 1-78 of this Complaint, as if fully set forth herein.

82. The U.S. Supreme Court held in Schwabe v. Board of Bar Examiners of New Mexico, 353 U.S. 232, 238-239 (1957), that:

"A State cannot exclude a person from the practice of law or from any other occupation in a manner or for reasons that contravene the Due Process or Equal Protection Clause of the Fourteenth Amendment."

83. The PTO considers the right to practice before the PTO to be a mere "privilege" (whatever that is?), as opposed to be protectable property right which cannot be denied, withheld or taken without due process under the Fifth Amendment, as applicable to the federal government.

84. It is the position of the PTO/OED that it may freely use hearsay, irrespective of whether an exception allowing for its admissibility might exist under the Federal Rules of Evidence.

85. The OED primarily relied upon hearsay (or double hearsay) evidence introduced by Diana Oleska of the OED to purportedly “say” what hand-picked clients of Plaintiff and Kroll regarding Plaintiff.

86. Purportedly, Diana Oleska telephone various joint clients of Plaintiff and Kroll and supposedly Ms. Oleska took “notes” of what selected clients said during the various telephone interviews.

87. There were no recordings of the telephone interviews and no clients appeared at the hearing conducted November 20, 2019, to testify, which would have allowed for verification of the content of such telephone interviews and cross-examination by Plaintiff.

88. The “notes” taken by Diana Oleska were introduced and accepted into evidence at the hearing on November 20, 2019, over the objection of Plaintiff.

89. Plaintiff later sought to cross-examine Diana Oleska regarding the veracity of the notes taken during the various clients’ telephone interviews, however the OED objected to permitting cross-examination and the objection was sustained by the ALJ.

90. The use of inadmissible hearsay by the OED at the hearing held November 2019, constituted a deprivation of due process of a “property right” that which is the practice of law before the PTO.

91. The use of hearsay otherwise inadmissible under the Federal Rules of Evidence and the inability to cross-examine Diana Oleska of the OED resulted in the

deprivation of a fair hearing for Plaintiff and constituted a denial of constitutional due process in violation of Plaintiff's Due Process rights under the Fifth Amendment.

COUNT V

Count for Declaratory Judgment of Denial of Plaintiff's Rights Under The Administrative Procedure Act Resulting in a Delay of More Three Years for Issuance of the Initial Decision and Order on June 8, 2023, Thereby Requiring Dismissal Due to a Failure of the PTO to Follow Its Own Rules

92. This is a claim for declaratory judgment that the Patent and Trademark Office violated its own rules under the Administrative Procedure Act by unreasonably and inexplicably delaying issuance of the Initial Decision and Order, issued June 8, 2023, which was nearly four years after filing of the OED Complaint and more than three years after the completion of all post-trial briefing.

93. This Court has subject matter over the jurisdiction of this claim under the Declaratory Judgment Act, 28 U.S.C. §§2201, 2202, in combination with 28 U.S.C. §§1331, 1338(a), on the ground that this claim "arises under" the federal Patent Law, including 35 U.S.C. §32, the Administrative Procedure Act and 37 C.F.R. §11.39.

94. Plaintiff incorporates by reference the allegations of ¶¶ 1-91 of this Complaint, as if fully set forth herein.

95. PTO disciplinary proceedings are statutorily governed by both the formal hearing provisions of the Administrative Procedure Act ("APA"), as well as PTO specific regulations. *Ass'n of Nat'l Advertisers, Inc. v. FTC*, 627 F.2d 1151, 1160 (D.C. Cir. 1979); *see*, 5 U.S.C. §§ 554, 556 and 557; 37 C.F.R. Part 11.

96. Section 555(b) of the Administrative Procedure Act imposes upon the agency involved in an adjudication the affirmative duty ("shall") to conclude an adjudication within "a reasonable time."

97. The OED Complaint was filed on July 10, 2019, while the Initial Decision and Order issued June 8, 2023; nearly four years after the Complaint was filed.

98. The delay in issuing the Initial Decision and Order violated Section 555(b) of the Administrative Procedure Act because the PTO failed to conclude this adjudication within a “reasonable time,” as the statute requires.

99. Title 37, C.F.R. §11.39(d) requires “circumstances” set forth in the ALJ’s “opinion” that “preclude issuance of an initial decision within nine months of filing the complaint.”

100. The Initial Decision and Order of the ALJ is silent as to the identity of any “circumstances” significant enough that they rendered it impossible for the ALJ to have issued his Initial Decision and Order within nine months; nothing “precluded” the ALJ from issuing the Initial Decision and Order in less than the nearly four years it took in this case.

101. The Final Order of the PTO is inherently based upon the Initial Decision and Order and, as such, the disciplinary proceeding against Plaintiff was, itself, an administrative proceeding conducted contrary to statute and should therefore be nullified.

COUNT VI

Claim for Declaratory Judgment for a Declaration that Local Civil Rule 83.5 of the United States District Court for the Eastern District of Virginia is Void as Unconstitutional under Article III, Contrary to the Doctrine of “Separation of Powers” and the Non-Delegation Doctrine, and Contrary to the Federal Rules of Civil Procedure and a Deprivation of Due Process under the Fifth Amendment

102. This is a claim for a declaratory judgment that Local Civil Rule 83.5 of the United States District Court for the Eastern District of Virginia is void as unconstitutional under Article III, contrary to the “Separation of Power” Doctrine and the “Non-Delega-

tion” Doctrine, is contrary to the Federal Rules of Civil Procedure and therefore is a deprivation of due process under the Due Process Clause of the Fifth Amendment.

103. This Court has subject matter over the jurisdiction of this claim under the Declaratory Judgment Act, 28 U.S.C. §§2201, 2202, in combination with 28 U.S.C. §§1331, 1338(a), on the ground that this claim “arises under” the federal Patent Law, including 35 U.S.C. §32.

104. Plaintiff incorporates by reference the allegations of ¶¶ 1-101 of this Complaint, as if fully set forth herein.

105. Local Civil Rule 83.5 of the United States District Court for the Eastern District of Virginia provides, in pertinent part, that:

“Within 60 days after service of the summons and petition on the U.S. Attorney, the Director [of the U.S. Patent and Trademark Office] shall respond to the petition [Complaint] and file a certified copy of the record and proceedings before the USPTO, which shall constitute the sole basis for the Court’s review. The Court may, in its discretion, require briefing and argument prior to the making of a decision on the petition.”

106. Local Civil Rule 83.5 is void as unconstitutional under Article III of the United States Constitution because the role of the District Court is reduced to that of strictly an appellate function in its review of administrative proceedings before the United States Patent and Trademark Office and appellate judicial review, without an opportunity for proper judicial consideration at the district court level, has been held to be unconstitutional as amounting to a deprivation of an Article III forum for judicial review.

107. Statutes and rules that provide for “only traditional appellate review by Art. III courts” of the decisions of administrative tribunals are unconstitutional as contrary to

Article III, as held by the United States Supreme Court in Northern Pipeline Constr. Co. v. Marathon Pipe Line Co., 458 U.S. 50, 87, 91 (1982).

108. Local Civil Rule 83.5 is an unconstitutional delegation of judicial authority and power to the Executive Branch, namely, the United States Patent and Trademark Office as an agency of the Department of Commerce and is therefore contrary to the “Separation of Powers” Doctrine and the “Non-Delegation” Doctrine.

109. Local Civil Rule 83.5 constitutes a violation of “Separation of Powers” and the Non-Delegation Doctrine by delegating authority to resolve legal questions and factual issues to an administrative agency of the Executive Branch, namely, the United States Patent and Trademark Office, and is therefore unconstitutional.

110. Local Civil Rule 83.5 is void as contrary to the Federal Rules of Civil Procedure which allow for motion practice and for the presentation of argument of legal questions and factual issues, as a matter of right by a plaintiff, which Local Civil Rule 83.5 bars, except at the “discretion” of the Court.

111. Local Civil Rule 83.5 deprives plaintiffs of an Article III forum for the consideration of legal questions or factual determinations by an Article III judicial officer and thereby constitutes a violation of due process contrary to the Due Process Clause of the Fifth Amendment.

112. Local Civil Rule 83.5 of the United States District Court for the Eastern District of Virginia should be declared unconstitutional and contrary to the Federal Rules of Civil Procedure and therefore void and that Plaintiff should be provided a full and fair opportunity in an Article III forum to litigate the record and issues raised in the administrative disciplinary proceeding conducted against Plaintiff.

WHEREFORE, Plaintiff Edwin D. Schindler requests that:

I. Judgment be entered in Plaintiff's favor reversing, or vacating, in its entirety the Final Decision and Order, issued January 19, 2024, by the Director of the United States Patent and Trademark Office and that the finding of professional misconduct and the disciplinary sanction issued against Plaintiff be vacated and nullified in its entirety.

II. Entry of a declaratory judgment that the limits and bounds of Patent and Trademark Office's definition of "Practice Before the Office" is void for vagueness and its application is arbitrary and capricious.

III. Entry of a declaratory judgment that Plaintiff's constitutional right to equal protection under the "Equal Protection Component" of the Due Process Clause of the Fifth Amendment has been violated by the United States Patent and Trademark Office.

IV. Entry of a declaratory judgment that Plaintiff's constitutional right to due process under the Due Process Clause of the Fifth Amendment has been violated by the U.S. Patent and Trademark Office due to the use of hearsay evidence and denial of the the right to cross-examine the OED's witness Diana Oleska concerning her communications with clients.

V. Entry of a declaratory judgment that the U.S. Patent and Trademark Office that the disciplinary proceeding was conducted contrary to the Administrative Procedure Act to the unreasonable and unexplained delay of more than three years for issuance of the Initial Decision and Order, issued June 8, 2023, and the absence of any explanation for such an unreasonable delay.

VI. Entry of a declaratory judgment that Local Civil Rule 83.5 is unconstitutional because statutes and rules that provide for "only traditional appellate review by Art. III

courts” of the decisions of administrative tribunals are contrary to Article III, as held by the United States Supreme Court in Northern Pipeline Constr. Co. v. Marathon Pipe Line Co., 458 U.S. 50, 87, 91 (1982).

VII. Plaintiff Edwin D. Schindler be awarded such further relief as this Court deems justified and appropriate under the circumstances.

Respectfully submitted,

EDWIN D. SCHINDLER

Dated: February 20, 2024

By /Edwin D. Schindler/

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