

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Professional responsibility and practice before the USPTO

Office of Enrollment and Discipline (OED)
United States Patent and Trademark Office

UNITED STATES
PATENT AND TRADEMARK OFFICE



OED: disciplinary jurisdiction

- Disciplinary jurisdiction of the office (37 C.F.R. § 11.19(a)) – all practitioners:
 - Engaged in practice before the office
 - Administratively suspended
 - Registered to practice before the office in patent cases
 - Inactivated
 - Authorized under § 11.6(d) to take testimony
 - Transferred to disability inactive status, reprimanded, suspended, or excluded from the practice of law by a duly constituted authority, including by the USPTO director
- Practitioners who have resigned shall also be subject to such jurisdiction with respect to conduct undertaken prior to the resignation and conduct in regard to any practice before the office following the resignation (37 C.F.R. § 11.19(a)).
- A person not registered or recognized to practice before the office is also subject to the disciplinary authority of the office if the person provides or offers to provide any legal services before the office (37 C.F.R. § 11.19(a)).

OED: disciplinary jurisdiction

- **Practitioner** means:
 - An attorney or agent registered to practice before the office in patent matters
 - An individual authorized under 5 U.S.C. 500(b), or otherwise as provided by § 11.14(a), (b), and (c), to practice before the office in trademark matters or other non-patent matters
 - An individual authorized to practice before the office in a patent case or matters under § 11.9(a) or (b)
 - An individual authorized to practice before the office under § 11.16(d)

(37 C.F.R. § 11.1)



Practice before the office

- Generally – 37 C.F.R. § 11.5(b):
 - 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.**
 - Nothing in this section proscribes a practitioner from employing or retaining non-practitioner assistants under the supervision of the practitioner to assist the practitioner in matters pending or contemplated to be presented before the office.

Practice before the office

- In patent matters – 37 C.F.R. § 11.5(b)(1):
 - Preparing and prosecuting any patent application
 - Consulting with or giving advice to a client in contemplation of filing a patent application or other document with the office
 - Drafting the specification or claims of a patent application
 - Drafting an amendment or reply to a communication from the office that may require written argument to establish the patentability of a claimed invention
 - Drafting a reply to a communication from the office regarding a patent application
 - Drafting a communication for a public use, interference, reexamination proceeding, petition, appeal to or any other proceeding before the Patent Trial and Appeal Board, or other proceeding



Practice before the office

- In trademark matters – 37 C.F.R. § 11.5(b)(2):
 - Consulting with or giving advice to a client in contemplation of filing a trademark application or other document with the office
 - Preparing and prosecuting an application for trademark registration
 - Preparing an amendment that may require written argument to establish the registrability of the mark
 - Conducting an opposition, cancellation, or concurrent use proceeding; or conducting an appeal to the Trademark Trial and Appeal Board
- *See also* 37 C.F.R. § 11.14:
 - Individuals who may practice before the office in trademark and other non-patent matters

OED discipline: grievances and complaints

- An investigation into possible grounds for discipline may be initiated by the receipt of a grievance (see 37 C.F.R. § 11.22(a)).
- Grievance: “a written submission from any source received by the OED director that presents possible grounds for discipline of a specified practitioner” (37 C.F.R. § 11.1).
- In the course of the investigation, the OED director may request information and evidence regarding possible grounds for discipline of a practitioner from:
 - The grievant
 - The practitioner
 - Any person who may reasonably be expected to provide information and evidence needed in connection with the grievance or investigation.

(37 C.F.R. § 11.22(f)(1))



OED discipline: grievances and complaints

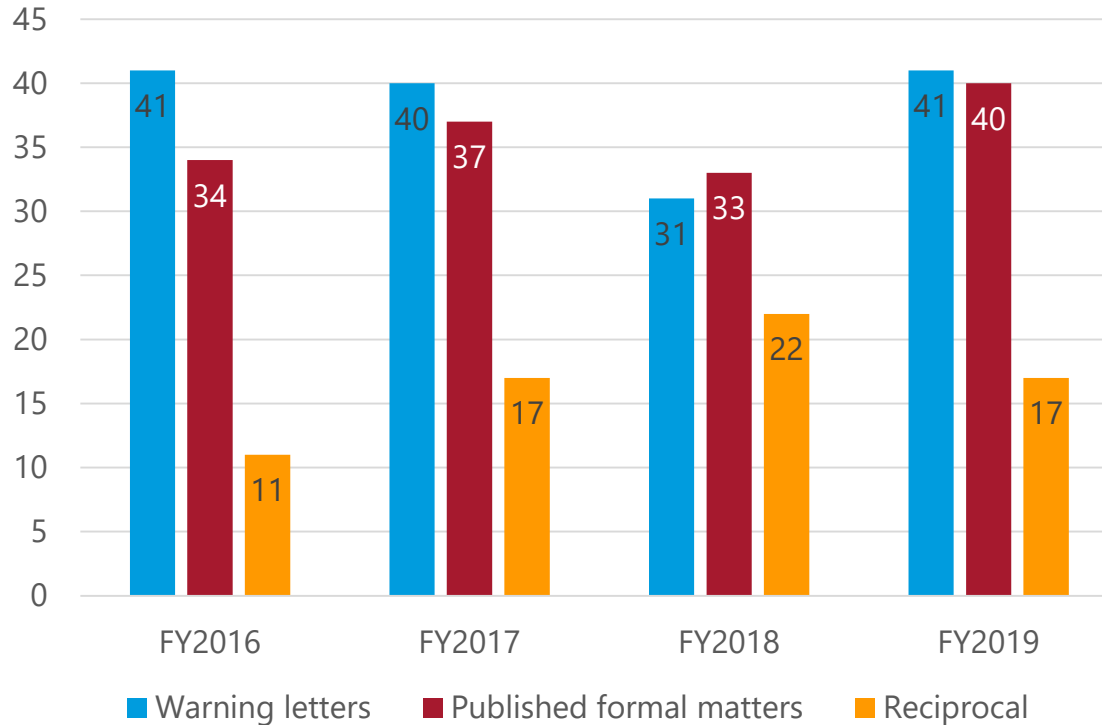
- Upon the conclusion of an investigation, the OED director may:
 - Close the investigation without issuing a warning or taking disciplinary action
 - Issue a warning to the practitioner
 - Institute formal charges upon the approval of the Committee on Discipline
 - Enter into a settlement agreement with the practitioner and submit the same for approval of the USPTO director.

(37 C.F.R. § 11.22(h))
- If investigation reveals that grounds for discipline exist, the matter may be referred to the Committee on Discipline to make a probable cause determination (*see* 37 C.F.R. § 11.32).
- 37 C.F.R. § 11.34(d) specifies that the timing for filing a complaint shall be within one year after the date on which the OED director receives a grievance.
- 37 C.F.R. § 11.34(d) also states that no complaint may be filed more than 10 years after the date on which the misconduct occurred.

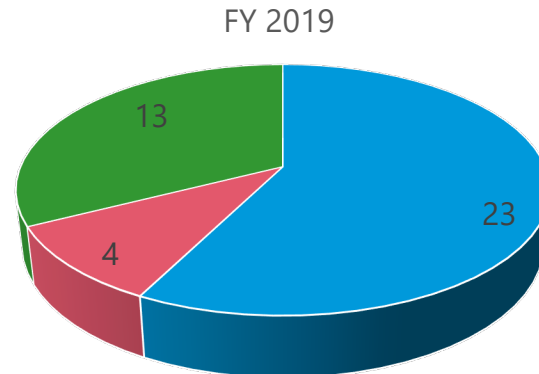
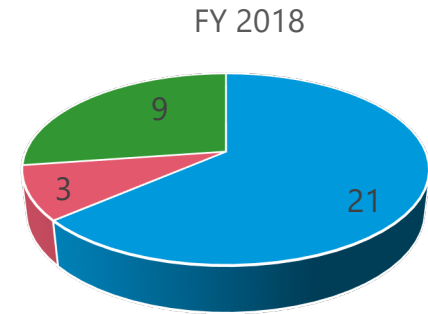
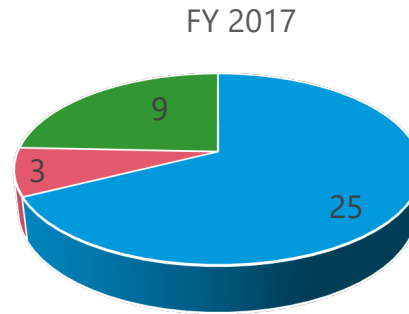
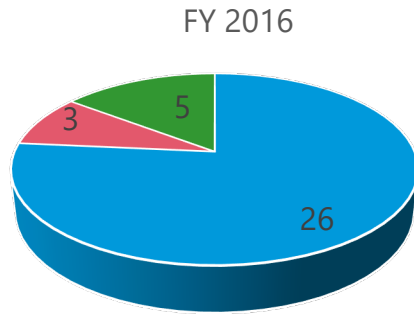
Other types of discipline

- Reciprocal discipline (37 C.F.R. § 11.24)
 - Based on discipline by a state or federal program or agency
 - Often conducted on documentary record only
- Interim suspension based on conviction of a serious crime (37 C.F.R. § 11.25)
 - Referred to a hearing officer for determination of final disciplinary action

USPTO disciplinary matters



USPTO disciplinary matters



■ Patent Attorneys ■ Patent Agents ■ Trademark Attorneys



OED Diversion Pilot Program

- In 2016 the ABA Commission on Lawyer Assistance Programs and the Hazelden Betty Ford Foundation published a study of about 13,000 currently-practicing attorneys and found the following:
 - About 21% qualify as problem drinkers.
 - 28% struggle with some level of depression.
 - 19% struggle with anxiety.
 - 23% struggle with stress.
- Other difficulties include social alienation, work addiction, sleep deprivation, job dissatisfaction, and complaints of work-life conflict.

OED Diversion Pilot Program – criteria

- Willingness and ability to participate in the program
- No public discipline by the USPTO or another jurisdiction in the past three years
- Misconduct at issue must not:
 - Involve misappropriation of funds or dishonesty, fraud, deceit, or misrepresentation
 - Result in or be likely to result in substantial prejudice to a client or other person
 - Constitute a “serious crime” (see 37 C.F.R. § 11.1)
 - Be part of a pattern of similar misconduct or be of the same nature as misconduct for which practitioner has been disciplined within the past five years

Proposed annual active patent practitioner fee

- Notice of Proposed Rulemaking (NPRM) issued July 31, 2019
 - 84 Fed. Reg. 37398
- No paper filing option
- Proposed effective date: January 1, 2022
- Voluntary CLE
 - Six hours of CLE every 24 months – five hours patent law and practice and one hour ethics

Register of patent practitioners

<https://oedci.uspto.gov/OEDCI/>

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Office of Enrollment and Discipline

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 Print

Persons Recognized to Practice in Patent Matters

I want to...

Go

Patent Practitioner Home Page

The listings contain contact information for attorneys and agents with licenses to practice before the US Patent and Trademark Office.

Currently, there are **11749 active agents** and **34725 active attorneys**. All searches reflect current information available to OED.

Information concerning a practitioner's status as an attorney is based on records provided to the Office of Enrollment and Discipline and might not reflect the practitioner's status in a State Bar. Individuals interested in a practitioner's status in a State Bar should contact that State Bar for specific information.

 Patent Practitioner Search

 Registered Practitioner Sign In Page (OEDIS-CI)

Requirement of U.S. attorney for foreign trademark applicants

- Increase in foreign parties not authorized to represent trademark applicants improperly representing foreign applicants in TM matters.
- Fraudulent or inaccurate claims of use are burden on trademark system and the public and jeopardize validity of marks.
- Effective Aug. 3, 2019:
 - Foreign-domiciled trademark applicants, registrants, and parties to Trademark Trial and Appeal Board proceedings must be represented at the USPTO by an attorney who is licensed to practice law in the United States.
- Final rule: 84 Fed. Reg. 31498 (July 2, 2019).
- Canadian patent agents no longer able to represent Canadian parties in U.S. TM matters.
- Canadian TM attorneys and agents will only be able to serve as additionally-appointed practitioners.
 - Clients must appoint U.S.-licensed attorney to file formal responses.
 - USPTO will only correspond with U.S.-licensed attorney.



Patent Pro Bono Program

- Assists financially under-resourced independent inventors and small businesses.
 - Section 32 of the AIA calls on the USPTO to work with and support IP law associations to establish *pro bono* programs.
 - 50 state coverage achieved and maintained since August 2015.
- Promotes small business growth and development.
- Helps ensure that no deserving invention lacks patent protection because of lack of money for IP counsel.
- Inventors and interested attorneys can navigate the USPTO website to find links to their regional program: www.uspto.gov/probonopatents.



Ethics scenarios and select case law

Office of Enrollment and Discipline

Patent agent privilege

- *In re Queen's University at Kingston*, 820 F.3d 1287 (Fed. Cir. 2016):
 - U.S. District Court granted Samsung's Motion to Compel documents, including communications between Queen's University employees and registered (non-lawyer) patent agents discussing prosecution of patents at issue in suit.
 - Federal Circuit recognized privilege **only** as to those activities that patent agents are authorized to perform (*see* 37 C.F.R. § 11.5(b)(1)).
- *In re Silver*, 540 S.W.3d 530 (Tex. 2018):
 - Lower court ruled that communications between client and patent agent were not protected from discovery because Texas law did not recognize patent agent privilege.
 - Supreme Court of Texas overturned, citing patent agents' authorization to practice law.
- Rule on attorney-client privilege for trials before the Patent Trial and Appeal Board, 82 Fed. Reg. 51570 (Nov. 7, 2017)

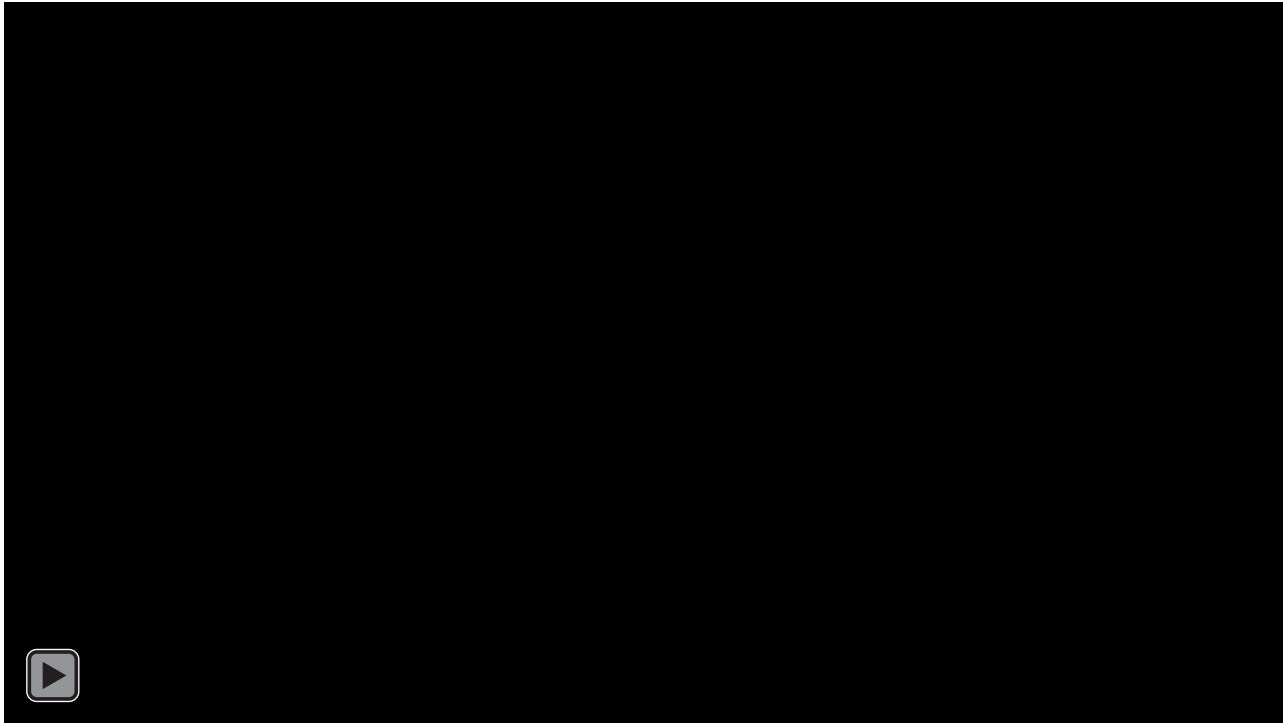
Patent agent privilege

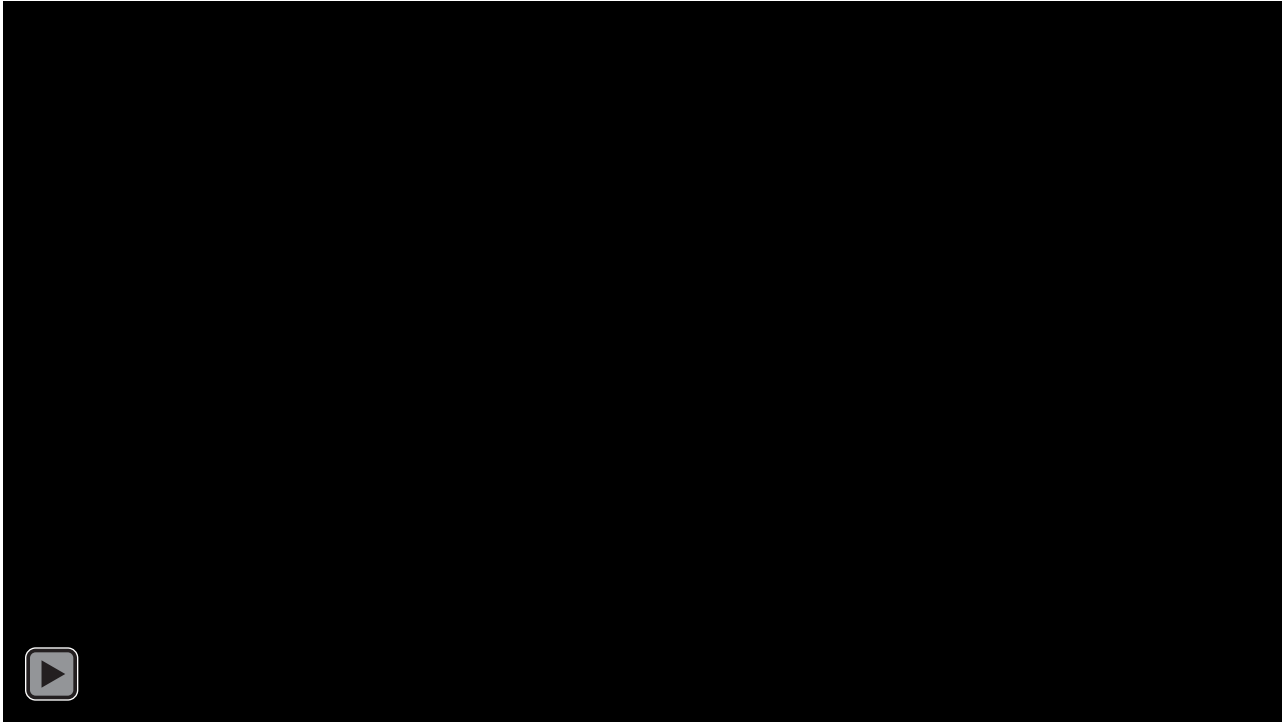
- *Onyx Therapeutics, Inc. v. Cipla Ltd. et. al.*, C.A. No. 16-988-LPS (consolidated), 2019 WL 668846 (D. Del. Feb. 15, 2019)
 - U.S. District Court found that a group of documents it inspected *in camera* would “almost certainly be within the scope of attorney-client privilege” but not be “protected by the narrower patent-agent privilege” because they were not “reasonably necessary and incident to” the ultimate patent prosecution.
 - Documents were communications between scientists referencing prior art found by an individual who performed a patent assessment at the direction of a patent agent.
 - Email discussion among the scientists was found to be not protected by the patent-agent privilege “because the assessment was done as part of a plan to develop new chemical formulations, not to seek patent protection for already-developed formulations.”

Unauthorized Practice of Law (UPL)

- *In re Campbell*, Proceeding No. D2014-11 (USPTO Apr. 29, 2014):
 - Patent agent represented a person in Colorado on matters involving DUI charges.
 - Attempted to claim he was “attorney in fact” for driver.
 - Identified himself as “an attorney in fact duly appointed, and licensed to practice Federal Law in the United States of America.”
 - Arrest warrant was issued for driver for failure to appear.
 - Sued City of Colorado Springs in civil court on behalf of driver.
 - Identified himself before magistrate in civil suit as a “federal attorney” and provided his USPTO registration no. as his “federal attorney registration number.”
 - Appeared on behalf of driver in license revocation hearing.
 - Excluded from practice before the USPTO.
 - Rule highlights:
 - Dishonesty, fraud, deceit, or misrepresentation – 37 C.F.R. §§ 10.23(b)(4)
 - Conduct prejudicial to the administration of justice – 37 C.F.R. § 10.23(b)(5)
 - Holding oneself out to be an attorney or lawyer – 37 C.F.R. § 10.31(d)(1)
 - Intentionally or habitually violating disciplinary rules – 37 C.F.R. § 10.89(c)(6)







Trademark renewals

- Post Registration Proof of Use Audit Program
 - www.uspto.gov/trademarks-maintaining-trademark-registration/post-registration-audit-program
- Permanent audit program launched Nov. 1, 2017.
- A registration may be audited if it meets both of these requirements:
 - A Section 8 or 71 declaration of use is filed.
 - The registration includes at least one class with four or more goods or services, or at least two classes with two or more goods or services.
- If audited, proof of use for additional goods/services in the registration will be required.
- 37 C.F.R. § 11.18(b): By presenting to the office ... any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that:
 - All statements made therein of the party's own knowledge are true.
 - To the best of the party's knowledge, information and belief, **formed after an inquiry reasonable under the circumstances ...** (iii) [t]he allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and (iv) [t]he denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.



Misrepresentation/failure to supervise/UPL

- *In re Swyers*, Proceeding No. D2016-20 (USPTO Jan. 26, 2017):
 - Disciplinary complaint alleged, *inter alia*:
 - TM attorney established The Trademark Company, PLLC.
 - Permitted non-attorneys to sign TM applications and practice TM law with little to no supervision.
 - Multiple fraudulent or digitally manipulated TM specimens were filed with USPTO.
 - Failed to deposit client advance funds into a client trust account.
 - Failed to cooperate with OED investigation.
 - Exclusion on consent
 - Rule highlights
 - 37 C.F.R. § 10.23(b)(5) – Conduct prejudicial to the administration of justice
 - 37 C.F.R. § 10.23(c)(2)(ii) – Giving false or misleading information to the office
 - 37 C.F.R. § 10.47(a) & (c) – Aiding the unauthorized practice of law



Two Poll Questions

Attorney, with assistance from Paralegal, prepared a Response to a TM application that is ready to be filed electronically but forgot to sign it. Attorney is out of office. Response is due today. What can Attorney do? Attorney has email access.

Authorize the paralegal to sign her name on her behalf and then send the response to the USPTO **A**

Have her paralegal forward her the electronic response for her signature **B**

Sign and submit the response when she returns, accompanied with a request for an extension of time to respond from the USPTO **C**

Authorize her law partner to sign her name on her behalf **D**

Saying the following to an examiner in a telephonic interview may implicate the USPTO Rules of Professional Conduct:

Thanks sweetheart, I'll make that change to the claim.

Hey honey, how's your day going?

Do you really have to go final on me babe?

You sound young, how long have you been examining?

Hey big guy, what can you do for me to get this movin' along?

All of the above

Failure to supervise/UPL

- *In re Crabtree*, Proceeding Nos. D2018-31 & D2018-47 (USPTO Apr. 25, 2019):
 - Disciplinary complaint alleged, *inter alia*:
 - Attorney was part-owner and general counsel of entity that provided TM-related services.
 - Beginning in 2017 until early 2018, non-practitioner employees used a cut-and-paste procedure to apply applicant signatures from application summaries into TM filings.
 - Non-practitioner employees expressly abandoned application (including client signature) without applicant knowledge.
 - Non-practitioner employees would offer suggestions to customers relating to class, specimen acceptability, and description.
 - After disclosure to and agreement by applicant, company retained \$50 filing fee difference for TEAS Plus applications.
 - Company did not maintain escrow accounts for applicants' fees or USPTO filing fees.
 - Exclusion on consent
 - Rule highlights:
 - 37 C.F.R. § 11.101 – Competence
 - 37 C.F.R. §§ 11.115(a) & (c) – Safekeeping property
 - 37 C.F.R. § 11.303(a)(1) – Candor toward tribunal
 - 37 C.F.R. § 11.503 – Responsibilities regarding non-practitioner assistance
 - 37 C.F.R. § 11.505 – Aiding UPL



Misrepresentation/UPL

- *In re Chow*, Proceeding No. D2018-27 (USPTO April 30, 2019):
 - Patent agent was sole registered practitioner for company that provided patent services to clients.
 - Patent agent's son operated a second company that provided client referrals.
 - Between August 2012 and December 2017, agent's customer number was associated with 6,760 patent applications (~105/month, ~five/work day).
 - Non-practitioner employees of son's company drafted patentability opinions and patent applications and routinely communicated with clients, all with little to no supervision from patent agent.
 - Clients paid son's company, who would allegedly pass funds along to patent agent. No disclosure to client of payment arrangement.
 - No disclosure to client regarding large referral relationship between companies.
 - Settlement: Three-year suspension
 - Rule highlights:
 - Conduct prejudicial to the administration of justice: 37 C.F.R. §§ 10.23(b)(5) & 11.804(d)
 - Aiding UPL: 37 C.F.R. §§ 10.47(a),(c) & 11.505
 - Conflicts: 37 C.F.R. §§ 10.62(a), 10.68(a)(1), 11.107(a)(2), & 11.108(f)

Neglect/candor

- *In re Kroll*, Proceeding No. D2014-14 (USPTO March 4, 2016):
 - Patent attorney
 - Routinely offered (and charged \$) to post client inventions for sale on his website.
 - Did not use modern docket management system.
 - Failed to file client's application but posted the invention for sale on his website.
 - Filed application 20 months after posting on the website.
 - Aggravating factors included prior disciplinary history.
 - Received two-year suspension.
 - Rule highlights
 - 37 C.F.R. § 10.23(a) – Disreputable or gross misconduct
 - 37 C.F.R. § 11.18(b) – Certification upon submitting of papers
 - 37 C.F.R. § 10.77(c) – Neglect

Deceit/conduct prejudicial

- *In re Kroll*, Proceeding No. D2016-23 (USPTO Dec. 11, 2017):
 - Patent attorney
 - Offered money-back guarantee to obtain patent for client’s invention.
 - Amended claims during prosecution of first application to add specific features without authorization from client.
 - First application issued as a patent.
 - Filed second application on another aspect of client’s invention, and again offered money-back guarantee.
 - The prior patent presented an obstacle to broad protection in the second application.
 - Prior to filing second application, attorney inserted additional features into specification without informing client.
 - During prosecution, the additional features were added to claims to overcome rejection using prior patent without client authorization.
 - On multiple occasions, attorney offered to pay – and did pay – client not to file an ethics grievance.
 - Aggravating factors included prior disciplinary history.
 - Excluded from practice.
 - Rule highlights:
 - 37 C.F.R. § 10.23(c)(2)(i) – Giving false or misleading information to a client in connection with USPTO business
 - 37 C.F.R. §§ 10.23(b)(5) & 11.804(d) – Conduct prejudicial to the administration of justice

Decisions imposing public discipline available in “FOIA Reading Room”

- <https://foiadocuments.uspto.gov/oed/>
- Official Gazette for Patents
 - www.uspto.gov/news/og/patent_og/index.jsp
 - Select a published issue from the list, and click on the “Notices” link in the menu on the left side of the webpage.

Two Poll Questions

During an interview, an attorney approaches an examiner and does the following. Which most likely implicates the USPTO Rules of Professional Conduct?

Kisses on each cheek

Hugs

Asks "What time do you get off from work?"

Asks where she can hangout for a drink after the interview

All of the above

"I just received a notice from the USPTO that it's time to file a Section 8 showing continued use." As a practitioner, how do you proceed?

Ask the client's permission to file a Section 8. Once you receive the go-ahead from the client, file a Section 8 with the USPTO.

Ask the client if all goods contained in the registration are being used in commerce. Once the client says "yes", then you can file the Section 8.

Ask the client if all the goods contained in the registration are being used in commerce, with a specimen for each good to submit to the USPTO, if requested.

Call Ghostbusters.

Call me maybe...

Call Jenny at 8-6-7-5-3-0-9.



Thank you!

OED

571-272-4097

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