

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# Professional Responsibility and Practice Before the USPTO

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# Law School Clinic Certification Program

- Allows students in a participating law school's clinic program to practice before the USPTO under the strict guidance of a Law School Faculty Clinic Supervisor.
- The OED Director grants participating law students limited recognition to practice before the USPTO.
- Signed into law on December 16, 2014.
- 63 law schools actively participate:
  - 27 trademark only,
  - 6 patent only,
  - 30 both.
- Added 32 new clinic programs in recent 2016-2017 expansion.
- For additional information:
  - <https://www.uspto.gov/learning-and-resources/ip-policy/public-information-about-practitioners/law-school-clinic-1>

# Office of Enrollment and Discipline

## Discipline at OED

# OED – Diversion Program

- A 2016 ABA Commission on Lawyer Assistance Programs and Hazelden Betty Ford Foundation published a study of 13,000 currently-practicing attorneys and found the following:
  - Between 21-36% qualify as problem drinkers
  - Approximately 28% struggle with some level of depression
  - 19% struggle with anxiety
  - 23% struggle with stress
  - Other difficulties include suicide, social alienation, work addiction, sleep deprivation, job dissatisfaction, and complaints of work-life conflict.
- USPTO announced diversion as two-year pilot program on November 3, 2017.
- Available to practitioners who engaged in minor misconduct resulting from:
  - Physical, mental, or emotional health issues; or
  - Practice management issues.
- Misconduct must have resulted in little to no harm to client.
- Misconduct must not:
  - Involve the misappropriation of funds or dishonesty, deceit, fraud, or misrepresentation;
  - Result in or likely result in substantial prejudice to a client or other person;
  - Constitute a “serious crime” under 37 C.F.R. § 11.1; or
  - Be a part of a pattern of similar misconduct or be of the same nature of misconduct for which the practitioner has been disciplined within the past 5 years.

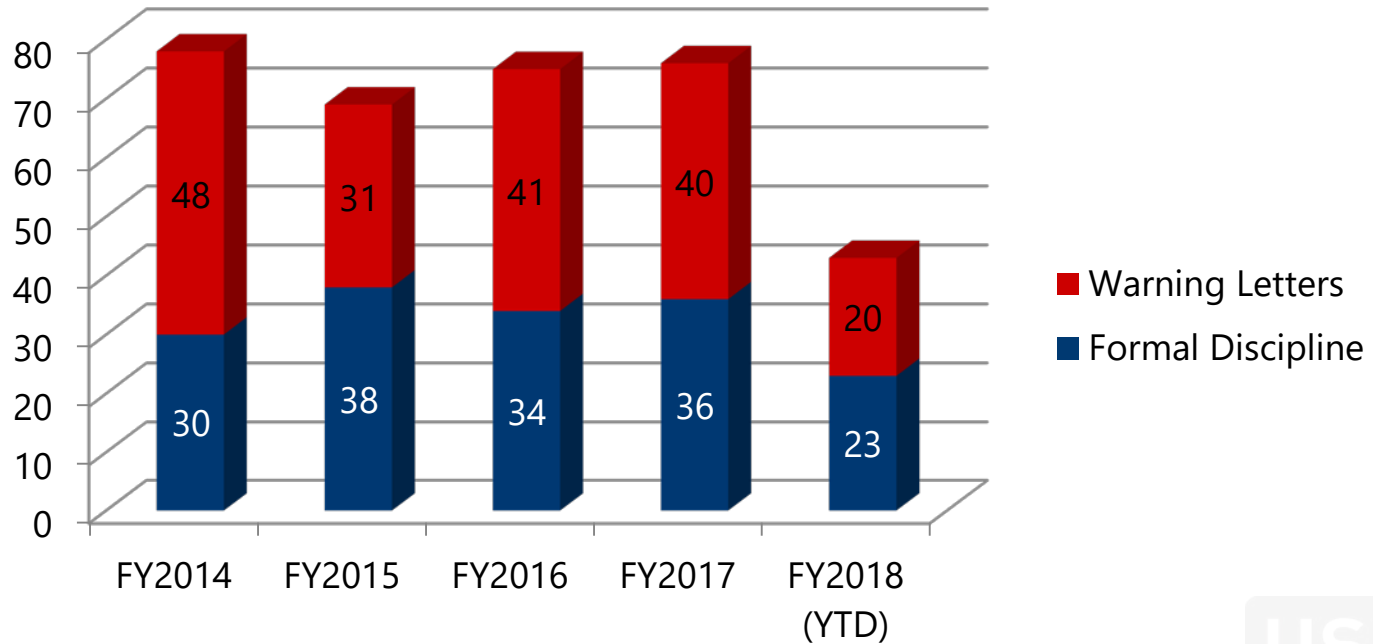
# OED Discipline: Grievances and Complaints

- An investigation of 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.
- Common Sources of Information:
  - External to USPTO: Clients, Colleagues, Others.
  - Internally within USPTO: Patent Corps, Trademark Corps, Other.
- Duty to report professional misconduct:
  - 37 C.F.R. § 11.803.

# OED Discipline: Grievances and Complaints

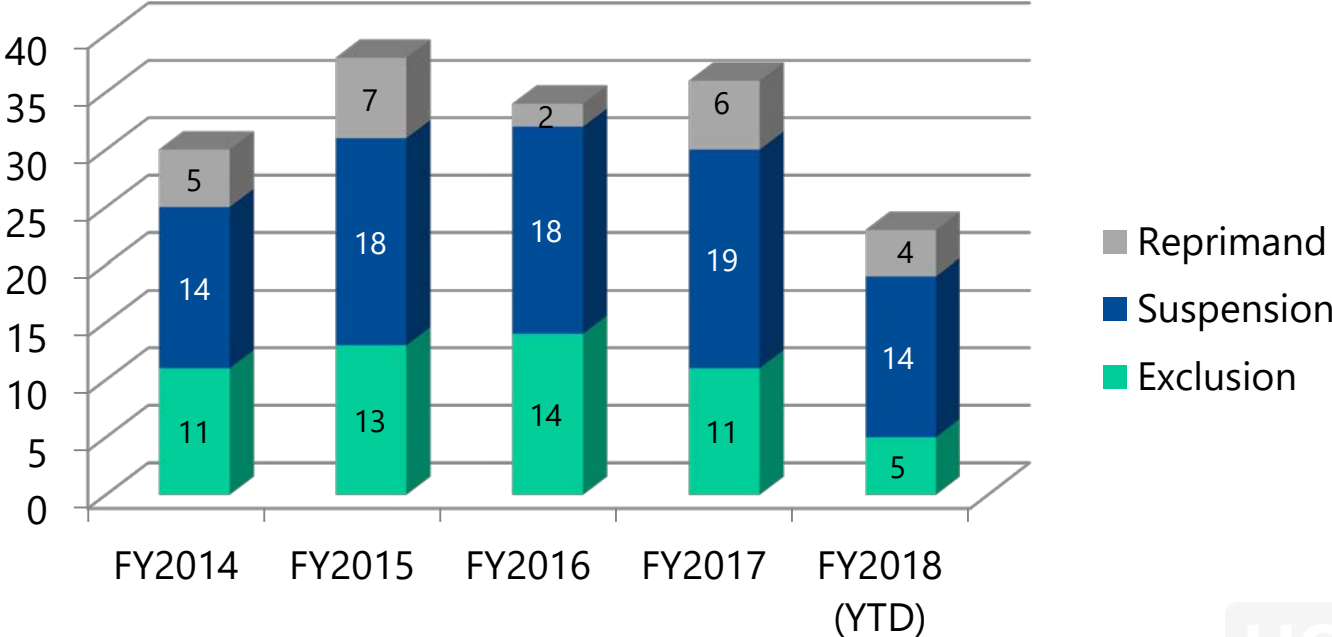
- If investigation reveals that grounds for discipline exist, the matter may be referred to the Committee on Discipline to make a probable cause determination. *See* 37 C.F.R. § 11.32.
- If probable cause is found, OED Director may file a complaint under 37 C.F.R. § 11.34. *See* 37 C.F.R. § 11.32.
- 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.

# OED Discipline: Warnings vs. Formal Discipline





# USPTO Disciplinary Decisions

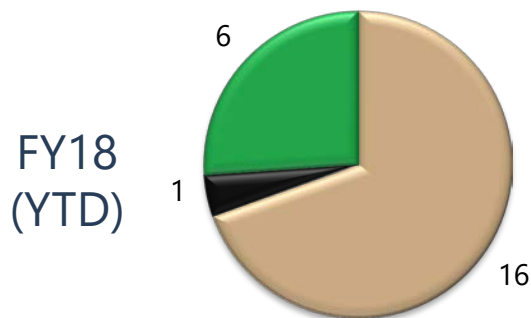
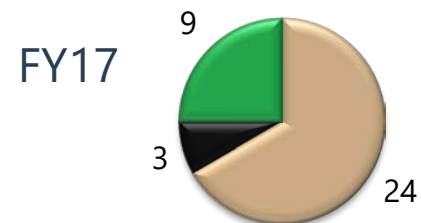
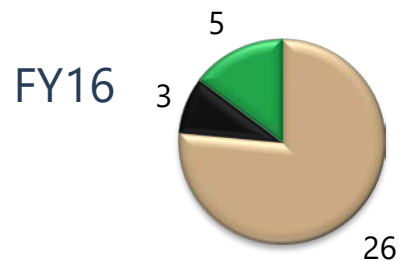
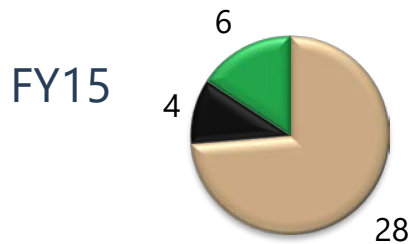
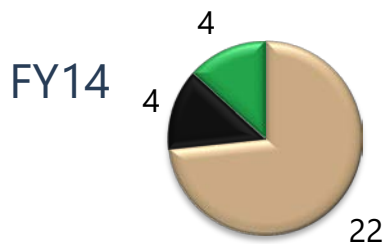


# Other Types of Discipline

- Reciprocal discipline. 37 C.F.R. § 11.24.
  - Based on discipline by a state or federal program or agency.
  - Usually conducted on documentary record only.
- Interim suspension based on conviction of a serious crime. 37 C.F.R. § 11.25.

# USPTO Disciplinary Decisions

## Breakdown of Disciplinary Decisions by Practitioner Type



- Patent Attorneys
- Patent Agents
- Trademark Attorneys

# Office of Enrollment and Discipline

## Discussions of Select Case Law

# Misrepresentations

*In re Anonymous*, Proceeding No. D2014-05  
(USPTO Apr. 1, 2014).

- Trademark Attorney:
  - Submitted sworn statements from himself and his client to the USPTO attesting that the client's mark had acquired distinctiveness and should be registered due to the clients "substantially continuous and exclusive use" of the mark in commerce.
  - Prior to submitting the statements, practitioner was informed that materials provided to him contained evidence contrary to the claim of acquired distinctiveness.
  - Practitioner failed to look at materials or share them with his client before submitting the statements to the USPTO.
- Settlement: Private reprimand
- Actions were deemed inadequate preparation (37 C.F.R. § 10.77(b)) and presenting a paper in violation of 37 C.F.R. § 11.18 (37 C.F.R. § 10.23(c)(15)).



# Misrepresentations

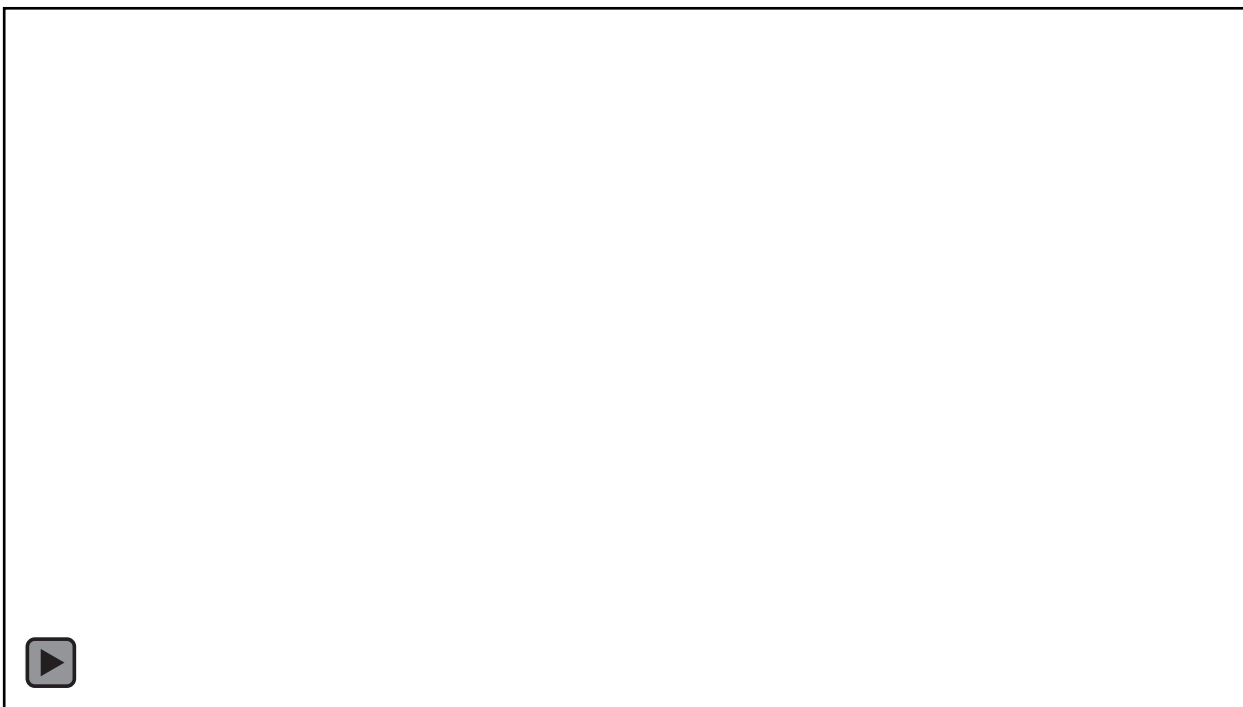
*In re Gozlan*, Proceeding No. D2013-16  
(USPTO Jan. 30, 2014).

- Canadian attorney:
  - Authorized under 37 C.F.R. § 11.114(c) to represent clients located in Canada before the USPTO in trademark matters.
  - Submitted applications on behalf of clients that are not located in Canada.
  - Submitted and signed a declaration stating: “[t]he signatory has confirmed that he/she is a Canadian attorney/agent, or an associate thereof, who represents an applicant located in Canada...”
  - Respondent contended that he was acting in good faith but was mistaken as to the limitations on his authorization.
  - Settlement: Public reprimand and 1-year probation.
- Actions were deemed conduct prejudicial to the administration of justice pursuant to 37 C.F.R. §§ 10.23(b)(5) and 11.804(d).

# Misrepresentations - UPL

*In re Shia*, Proceeding No. D2014-31  
(USPTO April 22, 2015).

- Patent Agent:
  - Not licensed to practice law in any state.
  - Acted as domestic representative for foreign TM applicants located in Taiwan and China.
  - When issued a show cause letter, respondent denied that she was engaged in the unauthorized practice of TM law.
  - When issued an order excluding her from acting as correspondent or domestic representative, she continued to do so.
  - Respondent went beyond the role of domestic representative and actively practiced before the USPTO in TM matters.
  - Improperly signed signatories' names to filings with the USPTO.
  - Improperly filed TM documents prepared by foreign attorneys.
- Excluded from practice before the USPTO.





# Misrepresentation/UPL

*In re Swyers*, Proceeding No. D2016-20  
(USPTO January 26, 2017).

- Disciplinary complaint alleged:
  - TM attorney established The Trademark Company, PLLC.
  - Permitted non-attorneys to practice TM law for him 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.

# Communication/Cooperation/UPL

***In re Terzo***, Proceeding No. D2016-35 (USPTO November 2, 2016).

- Exclusion on consent of registered patent attorney.
- Disciplinary complaint alleged:
  - Took over the representation of a suspended practitioner's trademark clients without informing the clients.
  - Did not consult with the clients prior to filing their applications.
  - Relied on a "Trademark Questionnaire" filled out by the clients.
    - Did not determine the accuracy of the information set forth in the questionnaire.
  - Directed non-practitioner assistants to provide clients with legal advice.
    - Directed one paralegal to prepare, sign his (Terzo's) name, and file TM applications without direct supervision.
    - Allowed paralegal to approve examiner's amendments.
    - Directed non-lawyer assistants to provide patent legal advice and legal services to clients.
  - Required advance payment for services; deposited payments into operating account before earning fees or incurring expenses.
  - Did not cooperate with the disciplinary investigation.

# Communication/Cooperation/UPL

*In re Terzo*, Proceeding No. D2016-35 (USPTO November 2, 2016).

- 37 C.F.R. § 11.104 Communication:

(a) A practitioner shall:

- (1) Promptly inform the client of any decision or circumstance with respect to which the client's informed consent is required by the USPTO Rules of Professional Conduct;
- (2) Reasonably consult with the client about the means by which the client's objectives are to be accomplished;
- (3) **Keep the client reasonably informed about the status of the matter;**
- (4) Promptly comply with reasonable requests for information from the client; and
- (5) Consult with the client about any relevant limitation on the practitioner's conduct when the practitioner knows that the client expects assistance not permitted by the USPTO Rules of Professional Conduct or other law.

(b) **A practitioner shall explain a matter to the extent reasonably necessary to permit the client to make informed decisions regarding the representation.**

# Communication/Cooperation/UPL

*In re Terzo*, Proceeding No. D2016-35 (USPTO November 2, 2016).

- 37 C.F.R. § 11.115 Safekeeping property:

(a) A practitioner shall hold property of clients or third persons that is in a practitioner's possession in connection with a representation **separate from the practitioner's own property...**

- 37 C.F.R. § 11.505 Unauthorized practice of law:

**A practitioner shall not practice law in a jurisdiction in violation of the regulation of the legal profession in that jurisdiction, or assist another in doing so.**

- 37 C.F.R. § 11.801 Registration, recognition, and disciplinary matters:

An applicant for registration or recognition to practice before the Office, or a practitioner in connection with an application for registration or recognition, or a practitioner in connection with a disciplinary or reinstatement matter, shall not:

(a) Knowingly make a false statement of material fact; or

(b) Fail to disclose a fact necessary to correct a misapprehension known by the person to have arisen in the matter, **fail to cooperate with the Office of Enrollment and Discipline in an investigation of any matter before it**, or knowingly fail to respond to a lawful demand or request for information from an admissions or disciplinary authority, except that the provisions of this section do not require disclosure of information otherwise protected by §11.106.

# Conflicts of Interest

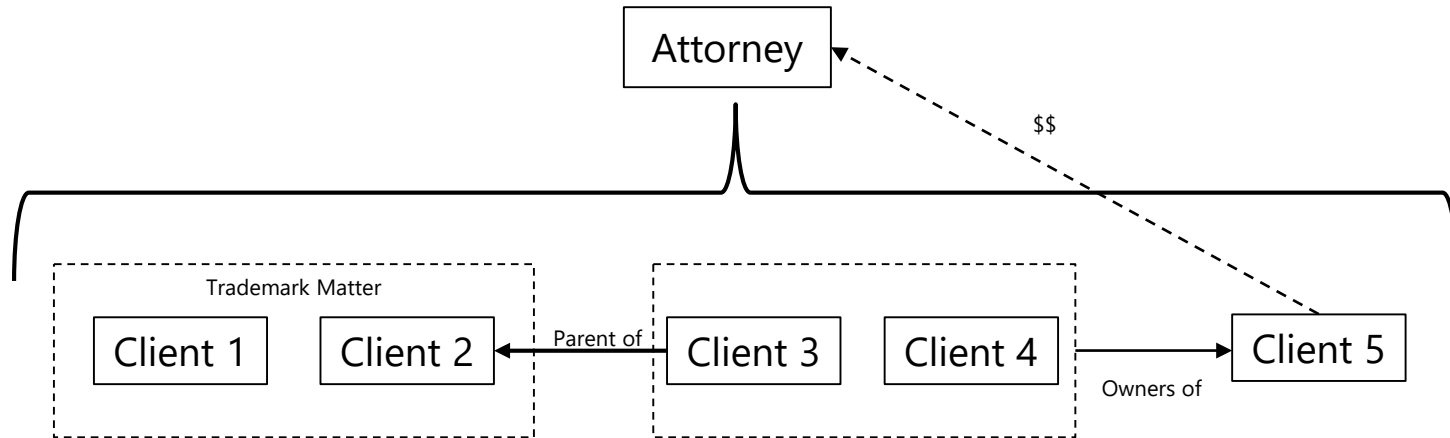
***In re Blackowicz***, Proceeding No. D2015-13 (USPTO May 11, 2015).

***In re Newman***, Proceeding No. D2015-14 (USPTO Nov. 12, 2015).

- Newman (Partner) asks Blackowicz (Associate) to represent Client 1 & Client 2, who co-own TM application.
- Newman and Blackowicz also represent Client 2's father (Client 3), Client 2's uncle (Client 4), and the uncle's company (Client 5).
- No disclosures to Clients 1 & 2 regarding potential effects of co-representation or in light of representation of Clients 3, 4 & 5.
- Work on Client 1 & 2's application is billed to Client 5.
  - No disclosures are made regarding possible issues with this arrangement.
- Clients 3 and 4 were copied on confidential emails with Clients 1& 2.
- Dispute develops between Client 1 and Client 2.



# Conflicts of Interest



# Conflicts of Interest

***In re Blackowicz***, Proceeding No. D2015-13 (USPTO May 11, 2015).

***In re Newman***, Proceeding No. D2015-14 (USPTO Nov. 11, 2015).

- Blackowicz and Newman correspond with Client 2 and Client 3 regarding the TM application and the dispute between Client 1 and Client 2.
  - Discussed abandonment of joint application in favor of new applications for the same mark owned by Client 3's company (Client 6).
- Blackowicz abandoned co-owned application. Did not consult with Client 1.
- Filed new applications on behalf of Client 3's company (Client 6) for same mark.
- Client 1 complained and Blackowicz filed petition to reinstate the co-owned application, even though, if granted, the co-owned application would have been directly adverse to Client 6 applications.

# Conflicts of Interest

***In re Blackowicz***, Proceeding No. D2015-13 (USPTO May 11, 2015).

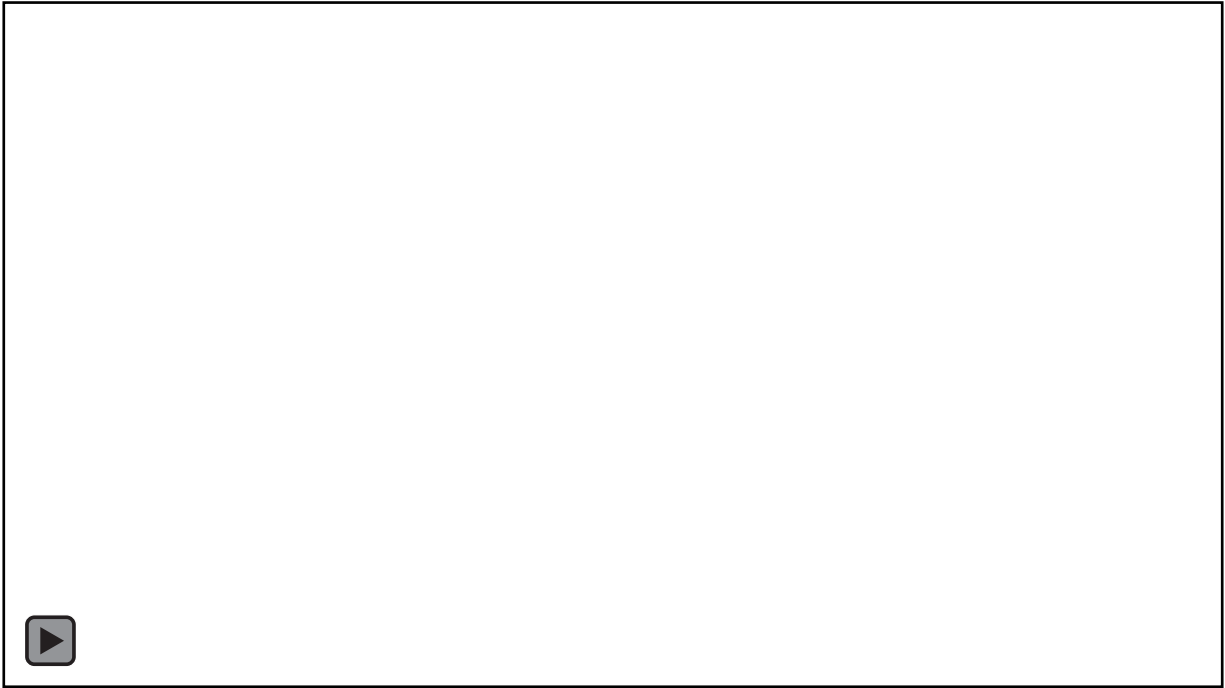
- Settlement.
- 30-day suspension.
- Required to take MPRE & attain score of 85 or better.
- 13-month probation with practice monitor.
- Mandatory conflicts CLE attendance.

***In re Newman***, Proceeding No. D2015-14 (USPTO Nov. 11, 2015).

- Settlement.
- 30-day suspension.
- Required to take MPRE and attain score of 85 or better.
- 18-month probation.
- Mandatory practice management or conflicts CLE attendance.







# Disreputable or Gross Misconduct

*In re Schroeder*, Proceeding No. D2014-08  
(USPTO May 18, 2015).

- Patent Attorney:
  - Submitted unprofessional remarks in two separate Office action responses.
  - Remarks were ultimately stricken from application files pursuant to 37 C.F.R. § 11.18(c)(1).
  - Order noted that behavior was outside of the ordinary standard of professional obligation and client's interests.
  - Aggravating factor: has not accepted responsibility or shown remorse for remarks.
- Default: 6-month suspension.
- Rule highlights:
  - 37 C.F.R. § 10.23(a) – Disreputable or gross misconduct.
  - 37 C.F.R. § 10.89(c)(5) – Discourteous conduct before the Office.
  - 37 C.F.R. § 10.23(b)(5) – Conduct prejudicial to the administration of justice.
  - 37 C.F.R. § 11.18 – Certification upon filing of papers.



# Disreputable or Gross Misconduct

*In re Tassan*, Proceeding No. D2003-10 (USPTO Sept. 8, 2003).

- Registered practitioner who became upset when a case was decided against his client, and left profane voicemails with TTAB judges.
- Called and apologized one week later; said he had the flu and was taking strong cough medicine.
- Also had a floral arrangement and an apology note sent to each judge.
- Mitigating factors: private practice for 20 years with no prior discipline; cooperated fully with OED; showed remorse and voluntarily sought and received counseling for anger management.
- Settlement: Reprimanded and ordered to continue attending anger management and have no contact with board judges for 2 years.

# Decisions Imposing Public Discipline Available In FOIA Reading Room

- ▶ <http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>
  - ▶ In the field labeled "Decision Type," select "Discipline" from the drop down menu.
    - To retrieve all discipline cases, click "Get Info" (not the "Retrieve All Decisions" link).
- ▶ Official Gazette for Patents
  - [http://www.uspto.gov/news/og/patent\\_og/index.jsp](http://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 web page.

# Contacting OED

For Informal Inquiries, Contact OED at  
571-272-4097

THANK YOU

