

**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



Polling Question

What does “OED” stand for?

- A. Office of Enforcement and Development
- B. Oxford English Dictionary
- C. Office of Enrollment and Discipline
- D. Operations Enablement and Deployment

Registration statement/CLE

- Final rule published August 3, 2020: 85 FR 46932
 - Proposed guidelines published October 9, 2020: 85 FR 64128
- Biennial registration statement replaces survey of registered patent practitioners
 - No active patent practitioner fee
 - Notice will be provided 120 days in advance of due date
 - Anticipated implementation November 2024
- Voluntary certification of CLE
 - *See* 37 C.F.R. § 11.11(a)(3)
 - Recognition of CLE completion in online practitioner directory
 - Certification of six credits of CLE within preceding 24 months: 5 credits in patent law and practice, 1 credit in ethics (delayed indefinitely)



Pro Bono Programs

- **USPTO 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
 - Limited recognition for participating students
 - www.uspto.gov/lawschoolclinic
- **USPTO Patent Pro Bono Program:**
 - Independent regional programs located across the nation work to match financially under-resourced inventors and small businesses with volunteer practitioners to file and prosecute patent applications
 - Inventors and interested attorneys can navigate the USPTO website to find links to their regional program: www.uspto.gov/probonopatents



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.
- The USPTO launched the Diversion Pilot Program in 2017 and it has been extended until 2022.

OED Diversion Pilot Program – criteria

- Practitioner must have willingness and ability to participate in the program.
- In some circumstances, prior discipline is not a bar to diversion.
- 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 major similar misconduct or be of the same nature as misconduct for which practitioner has been disciplined within the past five years

Select OED regulations

Office of Enrollment and Discipline

Practice before the office

- Activities that constitute practice before the USPTO are broadly defined in 37 C.F.R. §§ 11.5(b) & 11.14:
 - Includes communicating with and advising a client concerning matters pending or contemplated to be presented before the office (37 C.F.R. § 11.5(b))
 - Consulting with or giving advice to a client in contemplation of filing a **patent application** or other document with the office (37 C.F.R. § 11.5(b)(1))
 - Consulting with or giving advice to a client in contemplation of filing a **trademark application** or other document with the office (37 C.F.R. § 11.5(b)(2))
 - Nothing in this section (37 C.F.R. § 11.5(b)) 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
 - *See also* 37 C.F.R. § 11.14 for details regarding 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:
 - i. The grievant,
 - ii. The practitioner, or
 - iii. 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, or
 - 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))



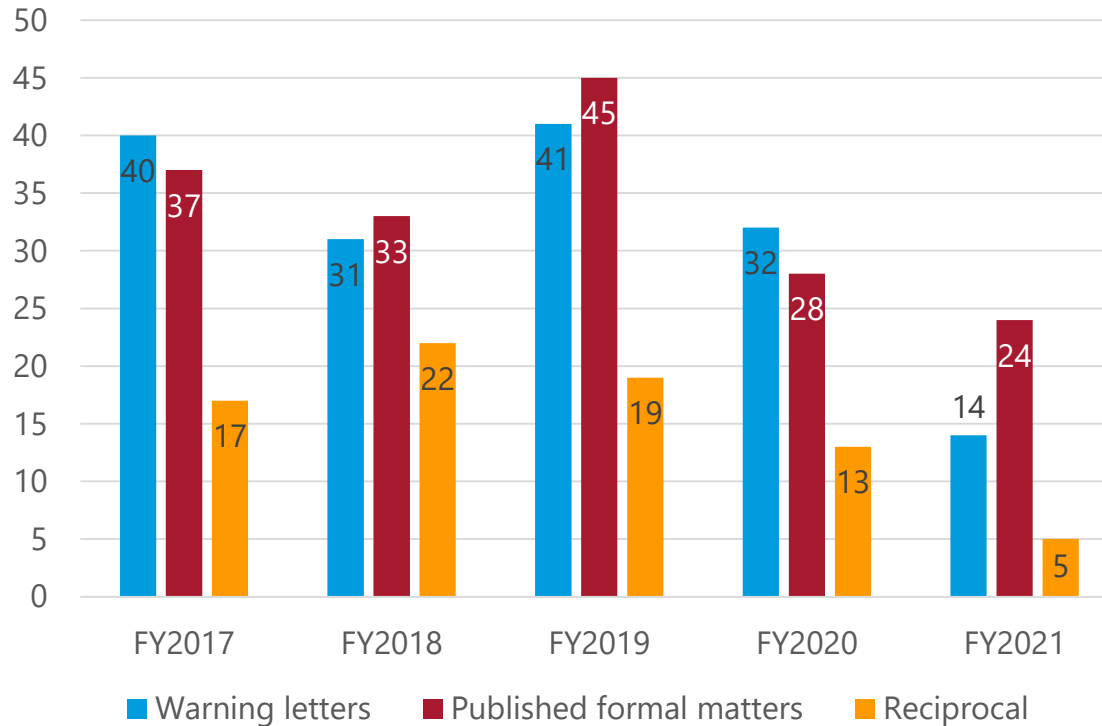
OED discipline: grievances and complaints

- 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).
- 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.
- Self-reporting is often considered as a mitigating factor in the disciplinary process.

Other types of discipline

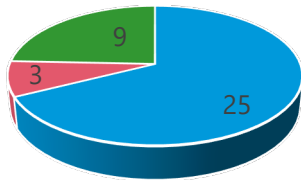
- Reciprocal discipline (37 C.F.R. § 11.24)
 - Based on discipline by a state or federal program or agency
 - Often conducted on documentary record only
- Interim suspension based on conviction of a serious crime (37 C.F.R. § 11.25)
 - Referred to a hearing officer for determination of final disciplinary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

USPTO disciplinary matters

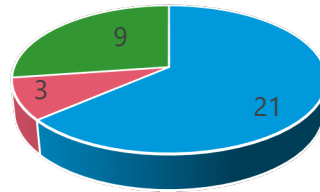


USPTO disciplinary matters

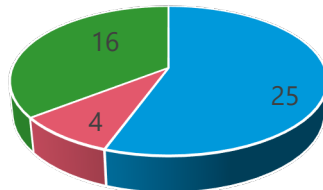
FY 2017



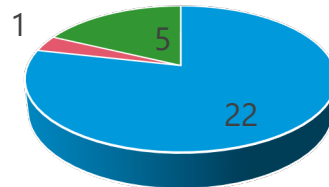
FY 2018



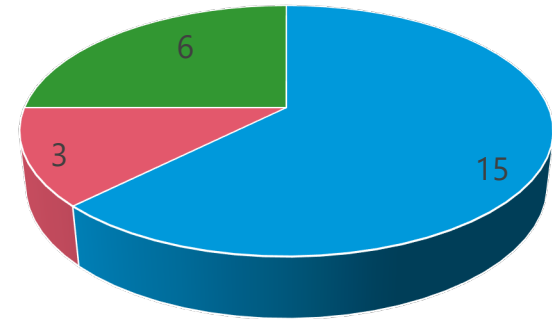
FY 2019



FY 2020



FY 2021



■ Patent Attorneys ■ Patent Agents ■ Trademark Attorneys



Discussion of Select Case Law

Office of Enrollment and Discipline

Conflict of interest

In re Walpert, Proceeding No. D2018-07 (USPTO Apr 29, 2021)

- Disciplinary complaint alleged:
 - Respondent entered into business relationship with his client and was given partial ownership interest in client company as compensation for providing legal services.
 - Did not obtain informed consent from company or disclose any potential risks associated with transacting business with a client.
 - Several patent applications Respondent had worked on for the company became abandoned.
 - Fabricated emails purportedly showing that he notified the company of application filing irregularities.
 - Failed to notify company of the problems with their applications.
- Exclusion from practice before the office.
- Rule highlights:
 - 37 C.F.R. § 10.62 (2012) Refusing employment where the interest of practitioner may impair practitioner's independent judgment
 - 37 C.F.R. § 10.65 (2012) Limiting business relations with a client
 - 37 C.F.R. § 11.108 - Conflict of interest
 - 37 C.F.R. § 11.303(a) – Candor towards the tribunal
 - 37 C.F.R. § 11.804(c) – Conduct that involves dishonesty, fraud, deceit, or misrepresentation

Conflict of interest

In re Gray, Proceeding No. D2017-02 (USPTO Feb. 22, 2017)

- Disciplinary complaint alleged:
 - Respondent’s firm had agreement with companies to provide patent legal services to referred clients.
 - Respondent’s relationships posed numerous conflicts of interest issues with respect to referred clients.
 - Directed associate to withhold filing of client applications until client paid 3rd party company \$125 fee.
 - Did not consult with client regarding the appropriate type of protection.
 - Failed to supervise associate to ensure compliance with conflict and other rules.
- Exclusion on consent.
- Rule highlights:
 - 37 C.F.R. § 11.105 – communicating scope of representation/fee
 - 37 C.F.R. § 11.107(a) – Conflict of interest; current clients
 - 37 C.F.R. § 11.108(f) – Accepting compensation from third party
 - 37 C.F.R. § 11.504(c) – Permitting 3rd party payer to regulate judgment
 - 37 C.F.R. § 11.505 – Unauthorized Practice of law

Conflict of interest

In re Mikhailova, Proceeding No. D2017-18 (USPTO June 16, 2017)

- Registered patent agent:
 - Contracted with Desa Industries, Inc d/b/a World Patent Marketing (“WPM”) to prepare, file, and respond to Office actions for clients referred by WPM.
 - Permitted WPM to act as full intermediary with clients.
- Settlement: 20 month suspension with 28 months probation.
- Rule highlights:
 - 37 C.F.R. § 11.105(b) – communicating scope of representation/fee
 - 37 C.F.R. § 11.107(a) – Conflict of interest; current clients
 - 37 C.F.R. § 11.108(f) – Accepting compensation from third party
 - 37 C.F.R. § 11.504 – Permitting 3rd party payer to regulate judgment
 - 37 C.F.R. § 11.505 – Unauthorized Practice of law

Conflict of interest

In re Mikhailova, Proceeding No. D2017-18 (USPTO June 16, 2017)

...under circumstances where a non-practitioner third party refers inventors to registered practitioners to provide the patent legal services purchased by inventors from the third party, the inventor would likely be unable to provide the requisite informed consent absent a meaningful discussion with the practitioner that fully informs the referred inventor of the actual and potential conflicts of interest arising from the fee arrangement between inventor, third party, and practitioner.

Additionally, the practitioner must communicate the scope of the representation and the basis or rate of the fee and expenses for which the client will be responsible, *see* 37 C.F.R. § 11.105(b), and shall obtain informed consent whenever limiting the scope of the representation (e.g., such as when only preparing and filing an application and not prosecuting it), *see* 37 C.F.R. § 11.102(c).

Conflict of interest

In re Mikhailova, Proceeding No. D2017-18 (USPTO June 16, 2017)

Under circumstances where a non-practitioner third party regularly refers inventors to registered practitioners to provide the patent legal services purchased by inventors from the third party, practitioners may unwittingly violate the fee-sharing prohibition if the practitioner does not know the amount the inventor has paid to the third party for patent legal services. If the entire amount received by the third party for the practitioner's compensation is not distributed to the practitioner and any undistributed compensation held by the third party is not returned to the inventor, then the practitioner has likely impermissibly shared fees with a non-practitioner. Hence, a practitioner is reasonably expected to question carefully the inventor and the referring non-practitioner third party about the amounts being charged to the inventor for the patent legal services to ensure the entire amount is remitted to the practitioner.

Conflict of interest

In re Mikhailova, Proceeding No. D2017-18 (USPTO June 16, 2017)

Where a non-practitioner third party refers inventors to registered practitioners to provide the patent legal services purchased by inventors from the third party, **the practitioner may not merely fill a purchase order. Instead, the practitioner must independently assess the suitability of the sought-after patent protection and communicate his or her assessment to the inventor...**By remaining passive and merely providing the patent legal services purchased by the referred inventor, a practitioner may be found to have formed a *de facto* partnership with the non-practitioner and also may be assisting the company to commit the unauthorized practice of law.

Hence, when a practitioner receives a referral for patent services from a non-practitioner company that aims to assist inventors in protecting and/or marketing their inventions, **the practitioner is reasonably expected to obtain copies of all documents exchanged between the company and the inventor so that the practitioner may understand whether company is engaging in practice before the Office in patent matters as defined in 37 C.F.R. § 11.5(b)(1).**

Conflict of interest

37 C.F.R. § 11.107

(a) Except as provided in paragraph (b) of this section, a practitioner shall not represent a client if the representation involves a concurrent conflict of interest. A concurrent conflict of interest exists if:

(1) The representation of one client will be directly adverse to another client; or

(2) There is a significant risk that the representation of one or more clients will be materially limited by the practitioner's responsibilities to another client, a former client or a third person or by a personal interest of the practitioner.

(b) Notwithstanding the existence of a concurrent conflict of interest under paragraph (a) of this section, a practitioner may represent a client if:

(1) The practitioner reasonably believes that the practitioner will be able to provide competent and diligent representation to each affected client;

(2) The representation is not prohibited by law;

(3) The representation does not involve the assertion of a claim by one client against another client represented by the practitioner in the same litigation or other proceeding before a tribunal; and

(4) Each affected client gives **informed consent**, confirmed in writing.

Conflict of interest

37 C.F.R. § 11.108(f)

A practitioner shall not accept compensation for representing a client from one other than the client unless:

- (1) The client gives **informed consent**;
- (2) There is no interference with the practitioner's independence of professional judgment or with the client-practitioner relationship; and
- (3) Information relating to representation of a client is protected as required by §11.106.

37 C.F.R. § 11.504(c)

A practitioner shall not permit a person who recommends, employs, or pays the practitioner to render legal services for another to direct or regulate the practitioner's professional judgment in rendering such legal services.

Conflicts of interest/improper signatures

In re Starkweather, Proceeding No. D2018-44 (USPTO Oct. 17, 2019)

- Practitioner received voluminous referrals from marketing company.
 - Did not obtain informed consent from clients in light of this arrangement.
 - Took direction regarding applications from company.
 - When company operations were shut down and payments stopped, practitioner halted client work, including completed applications.
 - Signed clients' names on USPTO documents.
- Settlement: three-year suspension, MPRE, 12 hours of ethics CLE
- Rule highlights:
 - 37 C.F.R. § 11.101 – Competence
 - 37 C.F.R. § 11.102 – Abiding by client's decisions
 - 37 C.F.R. § 11.103 – Diligence
 - 37 C.F.R. § 11.104 – Client communication
 - 37 C.F.R. § 11.107 – Conflicts
 - 37 C.F.R. § 11.303 – False statements to a tribunal
 - 37 C.F.R. § 11.504(c) – Taking direction from 3rd party payer



Improper signatures

In re Starkweather - For signing client's name on documents filed with the USPTO:

- 37 C.F.R. § 11.101 Competence
 - "A practitioner shall provide competent representation to a client. Competent representation requires the legal, scientific, and technical knowledge, skill, thoroughness and preparation reasonably necessary for the representation."
- 37 C.F.R. § 11.102(a) Scope of representation and allocation of authority between client and practitioner
- 37 C.F.R. § 11.303 Candor toward the tribunal
 - "(a) A practitioner shall not knowingly:
 - (1) Make a false statement of fact or law to a tribunal or fail to correct a false statement of material fact or law previously made to the tribunal by the practitioner;
 - * * * * *
 - (3) Offer evidence that the practitioner knows to be false. If a practitioner, the practitioner's client, or a witness called by the practitioner, has offered material evidence and the practitioner comes to know of its falsity, the practitioner shall take reasonable remedial measures, including, if necessary, disclosure to the tribunal.
 - * * * * *
 - (d) In an ex parte proceeding, a practitioner shall inform the tribunal of all material facts known to the practitioner that will enable the tribunal to make an informed decision, whether or not the facts are adverse."
- 37 C.F.R. § 11.804(c) Misconduct: Dishonesty, fraud, deceit, misrepresentation
- 37 C.F.R. § 11.804(d) Misconduct: Conduct prejudicial to the administration of justice



Signatures on patent documents

- 37 C.F.R. § 1.4(d)(1) Handwritten signature.
 - “Each piece of correspondence, except as provided in paragraphs (d)(2), (d)(3), (d)(4), (e), and (f) of this section, filed in an application, patent file, or other proceeding in the Office which requires a person's signature, must:
 - (i) Be an original, that is, have an original handwritten signature **personally signed**, in permanent dark ink or its equivalent, **by that person**; or
 - (ii) Be a direct or indirect copy, such as a photocopy or facsimile transmission (§1.6(d)), of an original. In the event that a copy of the original is filed, the original should be retained as evidence of authenticity. If a question of authenticity arises, the Office may require submission of the original.
- 37 C.F.R. § 1.4(d)(2) S-signature.
 - “(i)...the person signing the correspondence must insert his or her own S-signature...”
- 37 C.F.R. § 1.4(d)(4)(ii) Certification as to the signature.
 - “The person inserting a signature under paragraph (d)(2) or (d)(3) of this section in a document submitted to the Office certifies that the inserted signature appearing in the document is his or her own signature.”
- Note: recent removal of of 37 C.F.R. § 1.4(e) (original handwritten signatures in permanent dark ink for OED correspondence and non EFS credit card payments).
 - See 86 FR 35226 (July 2, 2021).

Signatures on trademark documents

- 37 C.F.R. § 2.193 Trademark correspondence and signature requirements
 - “(a)...Each piece of correspondence that requires a signature must bear:
 - (1) A handwritten signature **personally** signed in permanent ink by the person named as the signatory, or a true copy thereof; or
 - (2) An electronic signature that meets the requirements of paragraph (c) of this section, **personally entered by the person named as the signatory....**
 - ***
 - (c) Requirements for electronic signature. A person signing a document electronically must:
 - (1) **Personally enter** any combination of letters, numbers, spaces and/or punctuation marks that the signer has adopted as a signature, placed between two forward slash (“/”) symbols in the signature block on the electronic submission; or
 - (2) Sign the document using some other form of electronic signature specified by the Director.”

Signatures on trademark documents

37 C.F.R. § 2.193(f) Signature as certification. The presentation to the office (whether by signing, filing, submitting, or later advocating) of any document by any person, whether a practitioner or non-practitioner, constitutes a certification under §11.18(b) of this chapter. **Violations of §11.18(b) of this chapter may jeopardize the validity of the application or registration, and may result in the imposition of sanctions under §11.18(c) of this chapter.** Any practitioner violating §11.18(b) of this chapter may also be subject to disciplinary action. See §11.18(d) and §11.804 of this chapter."

Signatures on trademark documents

- TMEP § 611.01(b) Requirements for signature
 - “All documents must be personally signed. 37 C.F.R. §§2.193(a)(1), (c)(1), 11.18(a). The person(s) identified as the signatory must manually enter the elements of the electronic signature. Another person (e.g., paralegal, legal assistant, or secretary) may not sign the name of a qualified practitioner or other authorized signatory. See *In re Dermahose Inc.*, 82 USPQ2d 1793 (TTAB 2007); *In re Cowan*, 18 USPQ2d 1407 (Comm’r Pats. 1990). Just as signing the name of another person on paper does not serve as the signature of the person whose name is written, typing the electronic signature of another person is not a valid signature by that person.”

Improper signatures/failure to supervise

In re Sapp, Proceeding No. D2019-31 (USPTO May 15, 2019)

- Trademark (TM) attorney was attorney of record or responsible attorney for numerous trademark applications for law firm.
 - Had TM documents filed with USPTO where non-practitioner assistants signed the documents instead of the named signatory.
 - Did not take reasonable steps to learn whether non-practitioner assistants were obtaining signatures properly.
 - After learning of impermissible signatures, did not notify clients of improper signatures or potential consequences.
 - After learning of impermissible signatures (including on declaration relied upon by TM examiners), did not notify the USPTO.
- Mitigating factors:
 - Fourteen-year practice with no prior disciplinary history.
 - Acknowledged ethical lapses and understands seriousness of submitting impermissible signatures to USPTO.
 - Cooperated with OED investigation.
 - Upon learning of impermissible signatures, retrained practitioners and non-practitioner assistants to ensure future compliance.
- Settlement: public reprimand and one-year probation.
- Rule highlights:
 - 37 C.F.R. § 11.101–Competence
 - 37 C.F.R. § 11.103–Diligence
 - 37 C.F.R. § 11.503–Responsibilities regarding non-practitioner assistance
 - 37 C.F.R. § 11.104(a) & (b)–Client communication
 - 37 C.F.R. § 11.303–Candor toward tribunal
 - 37 C.F.R. §§ 11.804(c) (misrepresentation) and (d) (conduct prejudicial to the administration of justice)

Improper signatures

In re Bashtanyk, Proceeding No. D2020-09 (USPTO April 17, 2020)

- Respondent was Canadian trademark agent reciprocally recognized under 37 C.F.R. § 11.14(c).
- Disciplinary complaint alleged:
 - Respondent had relationship with Florida attorney with no prior TM experience.
 - Florida attorney was named attorney of record in U.S. trademark applications.
 - Respondent would enter Florida attorney's signature on documents filed with the USPTO.
 - Respondent failed to cooperate with OED investigation.
- Exclusion on consent.
- Rule highlights:
 - 37 C.F.R. § 11.101 – Competence
 - 37 C.F.R. § 11.801(b) – Failure to cooperate with disciplinary investigation
 - 37 C.F.R. § 11.804(c) – Misrepresentation
 - 37 C.F.R. § 11.804(i) – Other conduct adversely reflecting on fitness to practice

Improper signatures

In re Caldwell II, Proceeding No. D2020-12 (USPTO March 17, 2020)

- Respondent was U.S. attorney working for Canadian company that provided trademark services.
 - Was attorney of record for company's clients before the USPTO.
 - Allowed company employee to sign his name on documents filed with the USPTO.
 - Did not have prior experience in trademark legal work.
- Mitigating factors:
 - No prior discipline.
 - Fully and diligently cooperated with OED investigation.
 - Terminated his employment with company and informed company and new attorney of record of potential consequences of failing to comply with USPTO signature regulations.
- Settlement: public reprimand and 1-year probation
- Rule highlights:
 - 37 C.F.R. § 11.101 – Competence
 - 37 C.F.R. § 11.103 – Diligence
 - 37 C.F.R. § 11.804(c) – Misrepresentation



Trademarks: local counsel rule

- Increase in foreign parties not authorized to represent trademark applicants improperly representing foreign applicants in trademark (TM) matters.
- Fraudulent or inaccurate claims of use are a burden on the trademark system and the public and jeopardize validity of marks.
- Effective August 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 are 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.
 - The USPTO will only correspond with U.S. licensed attorney.



Trademarks: local counsel rule

Dear,

I would like to rent a U.S. lawyer's license or get granted to use your U.S. attorney licensed information. At same time, I pay you yearly fee.

If you are interested in it and want to discuss more, you can contact me.

Regards,
Francis

Hijacking of U.S. practitioner data

- Since the implementation of the local counsel rule, the Office has encountered several instances of co-opting/hijacking of U.S. practitioner's name, address, and/or bar number.
- Referral to state bars and other agencies that address fraud and consumer protection.

Improper signatures/communication

In re Lou, Proceeding No. D2021-04 (USPTO May 12, 2021)

- Trademark Attorney had business relationship with foreign company that provided IP services to merchants.
- Over the course of their relationship, attorney reviewed up to 500 applications per month and received over \$10,000 in compensation.
- As of Oct. 12, 2020, all of the attorney's TM cases were received from the foreign company.
- Attorney impermissibly gave a company employee authorization to enter his electronic signature in the applications and attendant declarations.
 - Did not subsequently inform applicants that their applications were impermissibly signed.
- Provided the foreign company's email address as correspondence address in applications.
 - Did not monitor the email address; relied on the foreign company to provide him with updates on USPTO correspondence.
- Did not conduct conflicts checks for clients received from the foreign company.
- Settlement: three-month suspension
- Rule highlights:
 - 37 C.F.R. § 11.101 – Competence
 - 37 C.F.R. §§ 11.104(a) & (b) – Client communications
 - 37 C.F.R. §§ 11.303(a)(1), (a)(2), (b) & (d) – Candor toward tribunal
 - 37 C.F.R. § 11.503(b) – Responsibilities regarding non-practitioner assistance
 - 37 C.F.R. § 11.505 – Aiding UPL

Competence, informed consent, dishonesty

In re Caraco, Proceeding No. D2019-50 (USPTO Sept. 12, 2019)

- TM attorney:
 - Worked with a reciprocally-recognized Canadian practitioner to represent clients located in Canada before the USPTO in trademark matters.
 - Reviewed TM applications and related documents prior to filing, but never consulted or spoke with clients.
 - Allowed Canadian practitioner and her non-practitioner assistants to enter his signature on TM filings.
 - Failed to notify any of the TM clients that he failed to personally sign any of the declarations in TM filings or any of the potential adverse consequences.
 - Failed to notify trademark operations at USPTO of the impermissible signatures.
 - Excluded.
- Rule highlights:
 - 37 C.F.R. § 11.303(a)(1) - False statements of fact or law to the USPTO.
 - 37 C.F.R. § 11.303(a)(3) - Requiring a practitioner to take reasonable remedial measures if practitioner becomes aware of falsity of material evidence.

Neglect/candor

In re Kroll, Proceeding No. D2014-14 (USPTO Mar. 4, 2016)

- Patent attorney
 - 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 1st application to add specific features without authorization from client.
 - 1st application issued as a patent.
 - Filed 2nd 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 2nd application.
 - Prior to filing 2nd 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 paid the 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



Unauthorized practice of law/ commingling funds

In re Kroll, Proceeding No. D2019-15 (USPTO April 5, 2021)

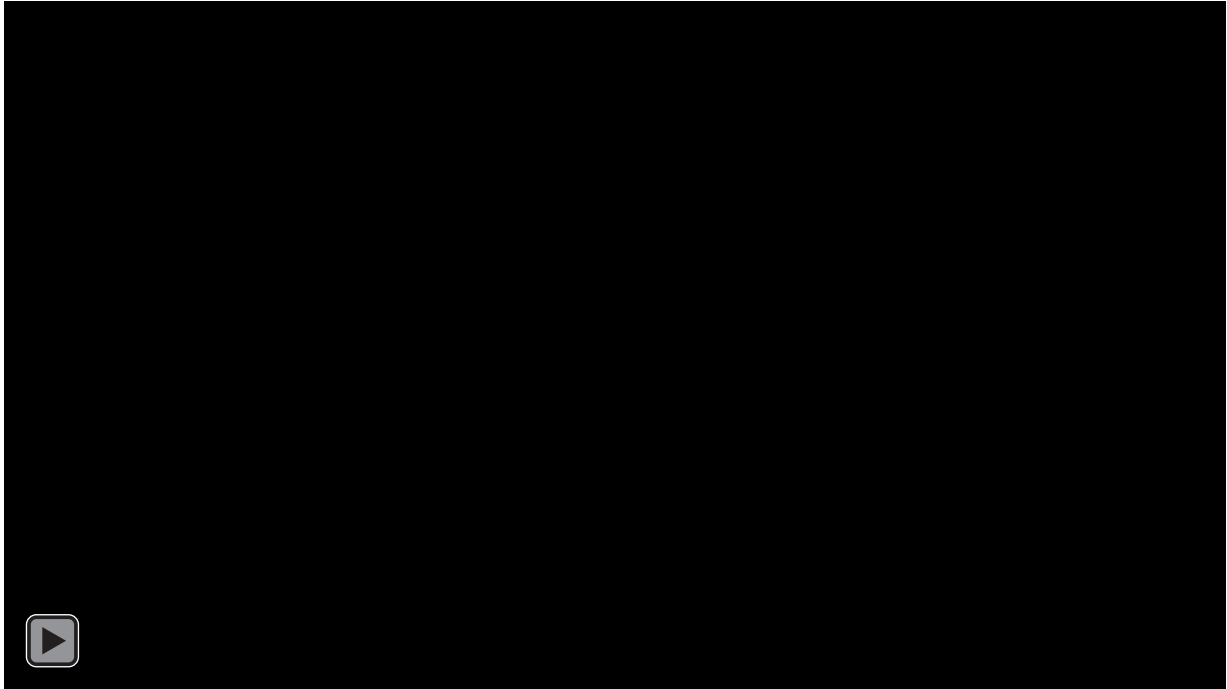
- Respondent was excluded patent attorney
 - Failed to withdraw from patent applications after suspension (2016) and exclusion (2017).
 - Continued to receive USPTO correspondence for client cases.
 - Continued to communicate with and advise clients on patent matters before the USPTO.
 - Also signed and filed TM documents and participated in interview with TM examiner.
 - Maintained “working relationship” with registered attorney from separate legal practice.
 - Respondent would draft patent applications and registered attorney would sign and file applications with the USPTO.
 - Respondent claimed that because he still held a state law license, he was entitled to communicate with clients.
 - Respondent collected fees from clients and paid a portion to registered attorney.
 - Clients did not consent to this fee-sharing arrangement.
 - Personal account held by respondent’s wife held client funds.
- Excluded from practice.
- Rule highlights:
 - 37 C.F.R. § 11.58(e) (now 37 C.F.R. § 11.58(h)) – Aiding a registered practitioner while suspended/excluded
 - 37 C.F.R. § 11.804(d) – Conduct prejudicial to the administration of justice
 - 37 C.F.R. § 11.105(e) – Division of fees between practitioners not in the same firm
 - 37 C.F.R. §§ 11.115(a), (c), & (f) – Safekeeping property

Commingling funds/neglect

In re Chirnomas, Proceeding No. D2020-29 (USPTO Apr 29, 2021)

- Disciplinary complaint alleged:
 - Respondent retained by foreign client to prepare and file a national stage utility patent application with the USPTO.
 - Filed the application but did not submit payment to the USPTO for any of the filing fees.
 - Invoiced client for fees associated with filing the application and Respondent's legal services.
 - Had client wire funds for the total amount of fees (including an advance payment of expenses) to personal bank account.
 - Failed to notify the client of Notice of Insufficient Basic National Fee Required and subsequent Notice of Abandonment sent by USPTO.
 - Client attempted to contact Respondent on several occasions regarding the abandonment but Respondent never responded.
- Exclusion from practice before the Office.
- Rule highlights:
 - 37 C.F.R. § 11.103 – Diligence and promptness in representing a client
 - 37 C.F.R. §§ 11.104(a)(3) & (a)(4) – Client communication
 - 37 C.F.R. §§ 11.115(a), (c) & (d) – Safekeeping property
 - 37 C.F.R. § 11.116 – Protecting client's interests on termination
 - 37 C.F.R. § 11.804(c) – Dishonesty, fraud, deceit or misrepresentation





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.



Decisions imposing public discipline available in “FOIA Reading Room”

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- Official Gazette for Trademarks:
 - www.uspto.gov/learning-and-resources/official-gazette/trademark-official-gazette-tmog



Thank you!

OED

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