



UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF ENROLLMENT AND DISCIPLINE

STATEMENT TO TRADEMARK PUBLIC ADVISORY COMMITTEE REGARDING THE UNAUTHORIZED PRACTICE OF LAW

The Trademark Public Advisory Committee (TPAC) has asked the Office of Enrollment and Discipline (OED) to provide information regarding situations that may involve the unauthorized practice of law (UPL) in trademarks in situations including online non-attorneys and/or non-attorneys working for online services. It may be helpful to provide a general overview of OED's role in these types of situations and the actions it takes. As to the facts of a specific individual(s), it would not be appropriate for me to discuss these matters. For the most part, reports of UPL come from trademark examining attorneys through their supervisors. There are, however, instances where members of the public contact OED regarding alleged UPL. Generally, these situations involve a non-attorney who is not a registered patent agent and is not an attorney in any state, the District of Columbia, or any territory of the United States.

When OED is contacted, the first step to determine if the individual is an attorney or a non-attorney. If the individual is a non-attorney, the records and evidence are reviewed to ascertain if the non-attorney's actions involve UPL. For example, USPTO rules permit individuals to represent applicants in particular trademark and non-patent matters as set forth in 37 Code of Federal Regulations section 11.14(e). If the non-attorney is permitted to

represent the applicant pursuant to section 11.14(e), or if the actions do not involve UPL, OED informs Trademark operations accordingly.

Practice before the Office is defined in 37 CFR § 11.5. If the actions involve or appear to involve UPL, OED sends a letter to the individual explaining that the conduct involves the practice of law or appears to involve the practice of law, that the non-attorney is not authorized to practice law, that the applicant must be represented by an attorney inasmuch as the non-attorney has undertaken to represent the applicant, and that the non-attorney cannot continue to represent the applicant or otherwise continue to engage in UPL. The letter requests the non-attorney cease and desist from representing the applicant and otherwise engaging in UPL. At the conclusion of OED's inquiry with the non-attorney, OED consults with Trademark operations about its results.

If the non-attorney agrees to cease and desist, the file is closed and no further action is taken by OED. There is no Federal statute imposing sanctions for UPL in trademark cases, nor any other statute empowering the USPTO/OED to discipline non-attorneys engaged in UPL in trademark cases. OED's authority to take disciplinary action is limited to a "practitioner." See 37 CFR § 11.19(a) and (b). A "practitioner" is defined in 37 CFR 11.1, in pertinent part, as a registered attorney or agent, and as an attorney. Therefore, OED has no jurisdiction to proceed against non-attorneys who do not cease and desist from UPL. If the non-attorney does not agree to cease and desist, OED reports the non-attorney's conduct to the authority responsible for addressing UPL in the state where the non-attorney practices law.

Once notified, OED understands that Trademark operations has procedures in place to cease communication with non-attorneys representing the applicant, to communicate only with applicant, not to accept the non-attorney's signature on documents representing the applicant, and not to conduct interviews with the non-attorney. OED further understands that Trademark operations has procedures in place for the treatment of various papers that are signed by the non-attorney. OED works together with Trademark operations to implement measures to address UPL.