

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# Professional responsibility and practice before the USPTO

Office of Enrollment and Discipline  
United States Patent and Trademark Office

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# Register of patent practitioners

[oedci.uspto.gov/OEDCI/](https://oedci.uspto.gov/OEDCI/)

## Patent Practitioner Home Page

Attorneys and agents authorized to practice in patent matters before the United States Patent and Trademark Office (USPTO)

### 🔍 Find a patent agent or attorney

Currently, there are **12808 active agents** and **36085 active attorneys**. All searches reflect current information available to OED.

### 📄 Download practitioner roster

The listings contain contact information for attorneys and agents authorized to practice before the U.S. Patent and Trademark Office. The roster file is updated nightly.

### 📄 Apply to practice in patent matters before the USPTO

Start an application, complete a draft application, view the status of an application, or submit supplemental information to an existing application. A USPTO.gov account is required.

[Start or edit your application](#)

### 🕒 Practitioner disciplinary history

This listing includes information about practitioners who have been publicly disciplined by the USPTO since 1997.

### 🔗 Get help

Resource for tips, troubleshooting, and guides on how to get the most out of our website.

### 👤+ Becoming a practitioner

Learn about applying for registration to practice in patent matters before the USPTO, including requirements, forms, and exam information.

### 📄 OED FAQs

Find answers and general information about OED.


### 🔑 Registered practitioner sign in

Sign in with your OED account credentials

User ID (Not Reg. #)

Password

[Forgot User ID or Password?](#)

I'm not a robot   
reCAPTCHA  
Privacy - Terms

[Sign In](#)

Need an user ID? Contact the Office of Enrollment and Discipline at 571-272-4097.

By signing in, I certify to the [USPTO's Terms of Use](#) and [USPTO Privacy Policy](#).

### 📞 Contact us

For assistance please contact the [Office of Enrollment and Discipline](#)

Phone	571-272-4097	Mailing Address	Mail Stop OED
Fax	571-273-0074		U.S. Patent and Trademark Office
Email	OED@uspto.gov		PO Box 1450
			Alexandria, VA 22313-1450



# GRB Updates

- OED is updating the General Requirements Bulletin (GRB)
  - Request for comments published March 23, 2021: 86 FR 15467.
  - Final changes published September 22, 2021.
- The GRB sets forth guidance for establishing possession of scientific and technical qualifications.
  - The GRB is available at [www.uspto.gov/sites/default/files/documents/OED\\_GRB.pdf](http://www.uspto.gov/sites/default/files/documents/OED_GRB.pdf).
- There are three categories of technical and scientific qualifications that typically make applicants eligible to sit for the registration examination:
  - Category A for specified bachelor's degrees,
  - Category B for other bachelor's degrees with technical and scientific training, and
  - Category C for practical engineering or scientific experience.
- Updates include three significant changes:
  - Adding commonly accepted Category B degrees to Category A.
  - Accepting advanced degrees, such as master's and doctor of philosophy degrees, under Category A.
  - Modified Category B, Options 2 and 4 to accept a combination of core sciences (chemistry, physics or biology), so long as one of the core science courses has a lab component.



# 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 practitioners
  - No active patent practitioner fee
  - Registered practitioners will be required to file a registration statement with OED biennially.
    - *See 37 C.F.R. § 11.11(a)(2)*
  - 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 in Spring of 2022



# 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
- In 2017, the USPTO launched the Diversion Pilot Program



# 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

# 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.
- 60 law schools actively participate:
  - 24 trademark only,
  - 6 patent only,
  - 30 both.
- Program enrollment: Currently accepting applications from law school clinics through December 31, 2022.



# 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: <http://www.uspto.gov/probonopatents>.
- Regional program covering Iowa is LegalCorps: <http://legalcorps.org/volunteers>



Select OED regulations

## **Office of Enrollment and Discipline (OED)**

# 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
- The scope of activities constituting patent legal practice before the USPTO is discussed by U.S. Supreme Court in *Sperry v. Florida*. 83 S.Ct. 1322, 1325 (1963).



# 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

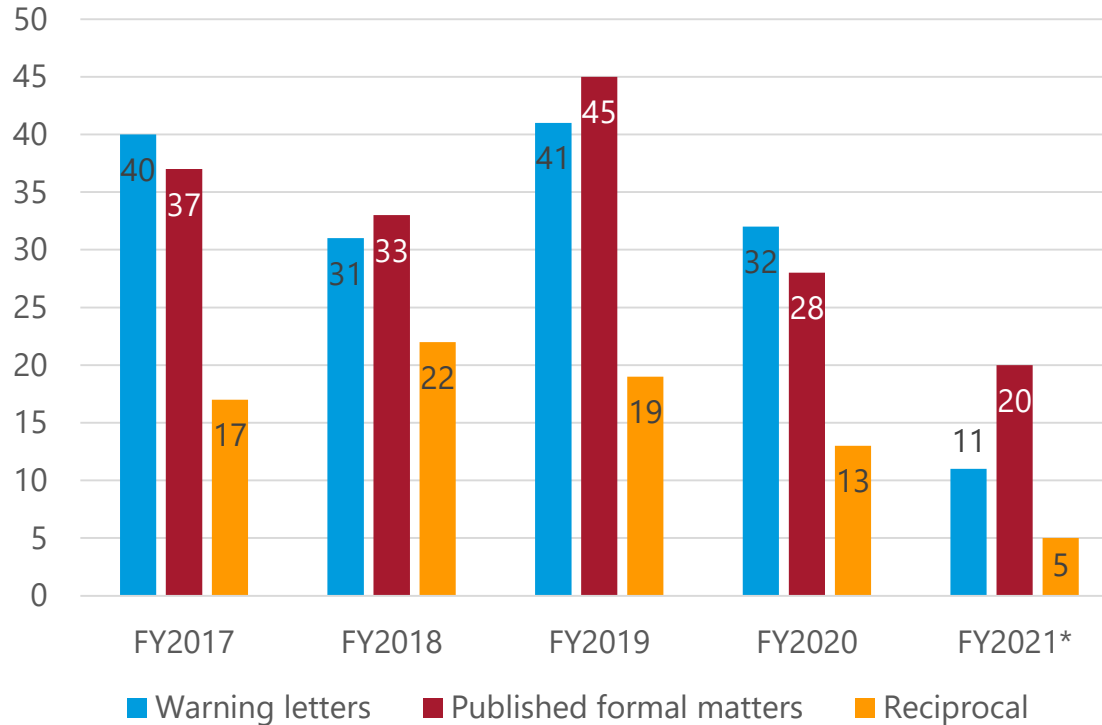
- Upon the conclusion of an investigation, the OED Director may:
  - Close the investigation without issuing a warning or taking disciplinary action
  - Issue a warning to the practitioner
  - Institute formal charges upon the approval of the Committee on Discipline, or
  - Enter into a settlement agreement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

(37 C.F.R. § 11.22(h))
- 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

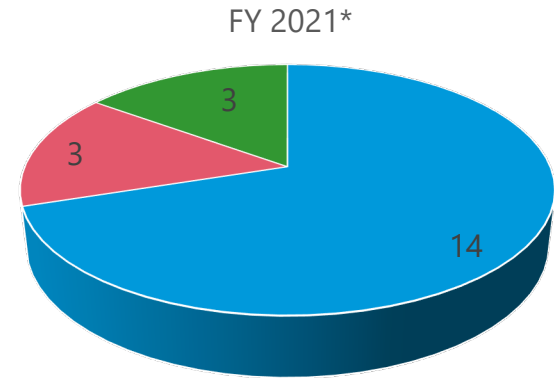
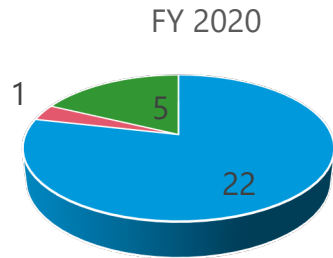
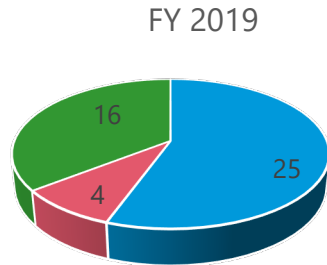
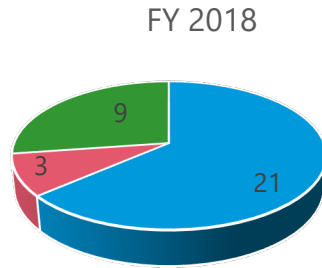
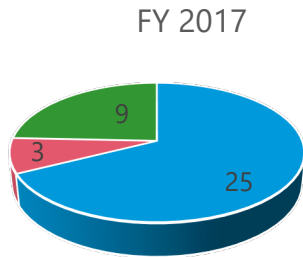
# USPTO disciplinary matters



\* Through August 2021



# USPTO disciplinary matters



■ Patent Attorneys ■ Patent Agents ■ Trademark Attorneys

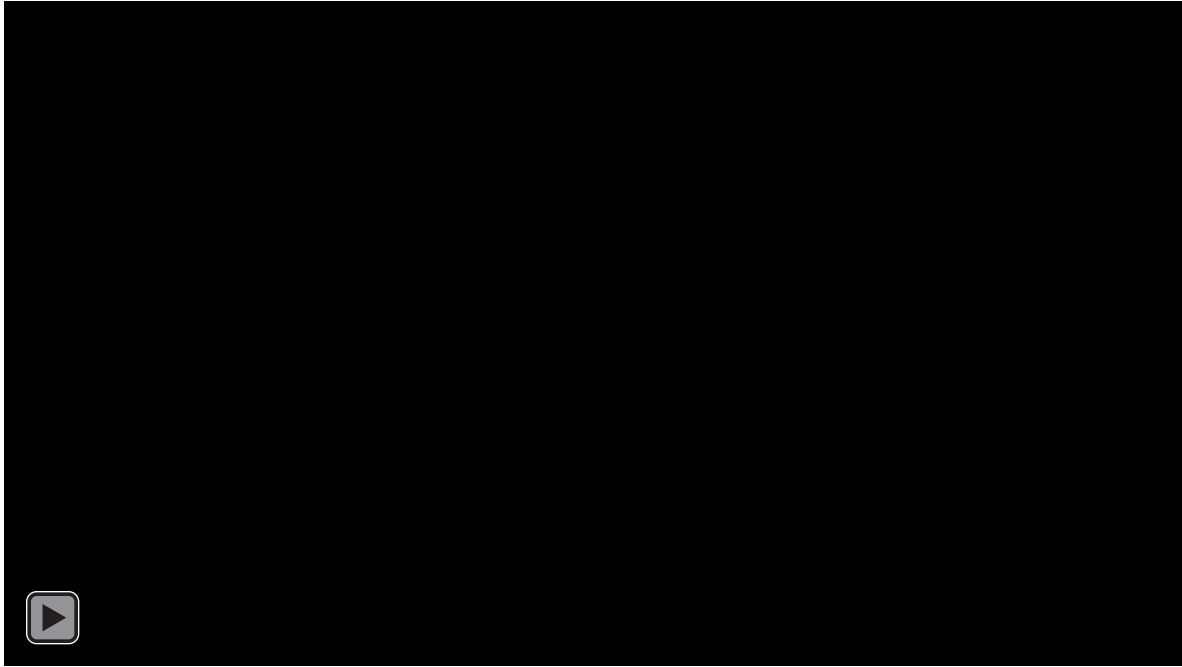
\* Through August 2021





Office of Enrollment and Discipline

# **Ethics scenarios and select case law**



# 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 not to be 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)



# 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, ~5/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)

# Conflicts of interest/client communication

- *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:
    - Competence: 37 C.F.R. § 11.101
    - Abiding by client's decisions: 37 C.F.R. § 11.102
    - Diligence: 37 C.F.R. § 11.103
    - Client communication: 37 C.F.R. § 11.104
    - Conflicts: 37 C.F.R. § 11.107
    - False statements to a tribunal: 37 C.F.R. § 11.303
    - Taking direction from 3<sup>rd</sup> party payer: 37 C.F.R. § 11.504(c)

# 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/client communication

- ***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.”

# Signatures on patent documents

- MPEP § 502.02
  - (I) Handwritten signature: “The word original, as used herein, is defined as correspondence which is personally signed in permanent dark ink or its equivalent by the person whose signature appears thereon.”
  - (II) S-Signature:
    - “The person signing the correspondence must insert his or her own S-signature...”
    - “The ‘must insert his or her own signature’ requirement is met by the signer directly typing his or her own signature using a keyboard. **The requirement does not permit one person (e.g., a secretary) to type in the signature of a second person (e.g., a practitioner) even if the second person directs the first person to do so.**”

# 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**....

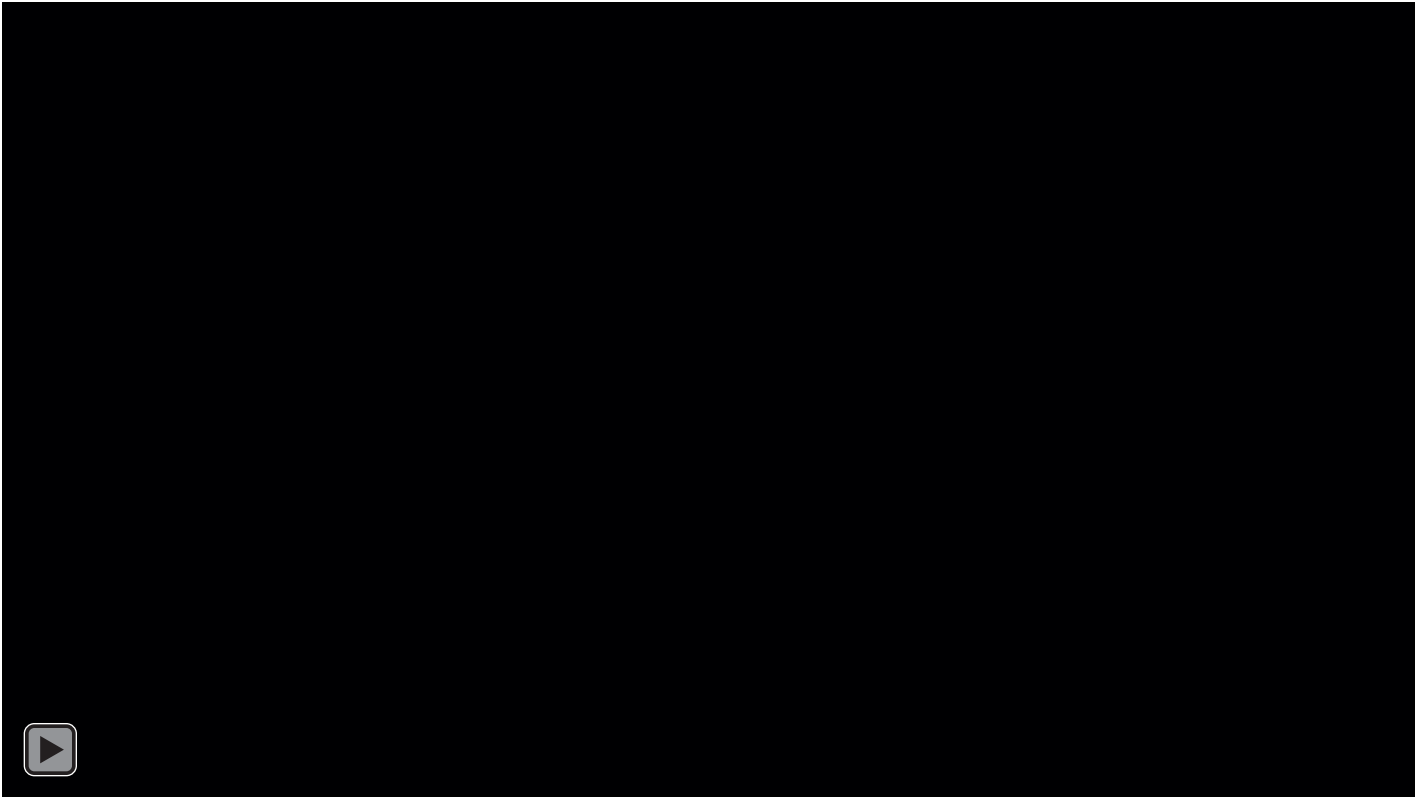
\* \* \* \* \*
  - (c) Requirements for electronic signature. A person signing a document electronically must:
    - (1) **Personally enter** any combination of letters, numbers, spaces and/or punctuation marks that the signer has adopted as a signature, placed between two forward slash (“/”) symbols in the signature block on the electronic submission; or
    - (2) Sign the document using some other form of electronic signature specified by the Director.

\* \* \* \* \*
  - (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(c) 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.”



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# 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 the 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





# 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/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



# Trademarks: U.S. 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

# 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



# 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

# 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.

# 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



# Trademarks: U.S. 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 no longer able to represent Canadian parties in U.S. TM matters
- Canadian TM attorneys and agents are only 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.





# Decisions imposing public discipline available in “FOIA Reading Room”

- [foiadocuments.uspto.gov/oed/](https://foiadocuments.uspto.gov/oed/)
- Official Gazette for Patents
  - [www.uspto.gov/news/og/patent\\_og/index.jsp](https://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.



# Thank you!

**OED**

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