

**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

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## Office of Enrollment and Discipline

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 Print

Persons Recognized to Practice in Patent Matters

I want to...



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## 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)

# Biennial registration statement

- Final rule published August 3, 2020: 85 FR 46932
- 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 first compliance date: spring 2022

# Continuing legal education (CLE)

- Final rule published August 3, 2020: 85 FR 46932
  - See 37 C.F.R. § 11.11(a)(3)
- Voluntary certification of CLE
- Proposed CLE guidelines published October 9, 2020: 85 FR 64128
  - Comments due January 7, 2021
  - Recognition of CLE completion in online practitioner directory
  - Certification of six credits of CLE within preceding 24 months
    - Five credits in patent law and practice, one credit in ethics
  - Patent credit for CLE on topics listed in 37 C.F.R. § 11.5(b)(1) or litigation relating to such topics
  - One-half hour of credit for 25 minutes of CLE attendance → must attend entire course
  - Up to two hours of CLE credit may be earned by providing *pro bono* legal services through the USPTO Patent Pro Bono Program.
  - Teaching credit available
  - May carry over up to three credits from prior reporting period.

# 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

# 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](http://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](http://www.uspto.gov/probonopatents)





OED

# Select OED regulations

# 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))



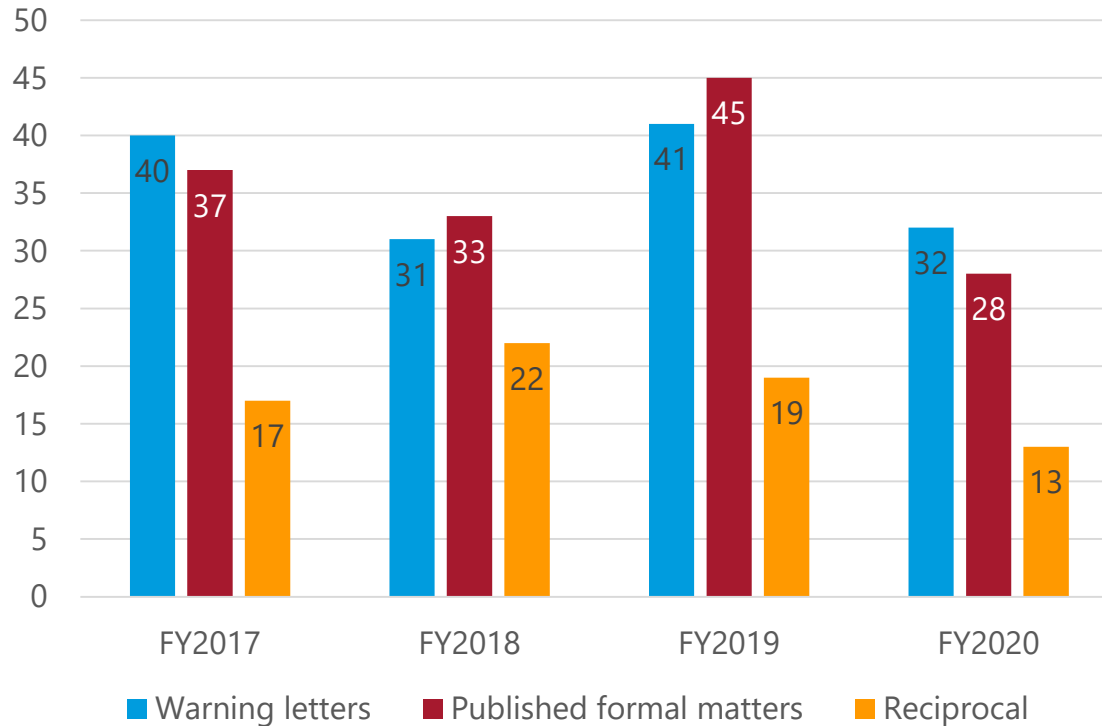
# OED discipline: grievances and complaints

- 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.

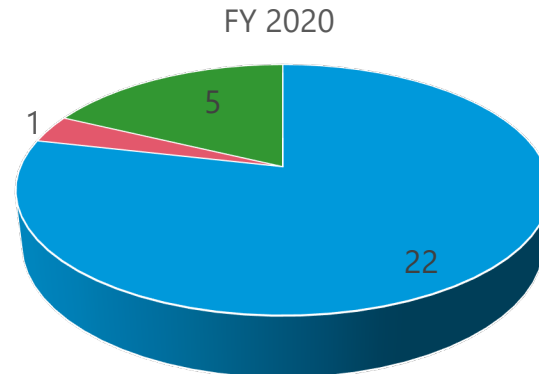
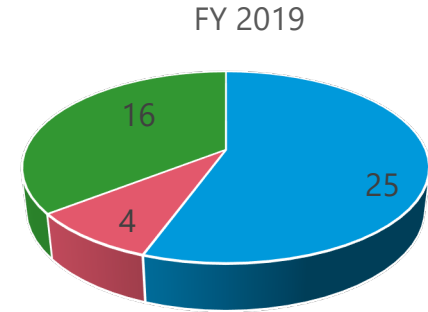
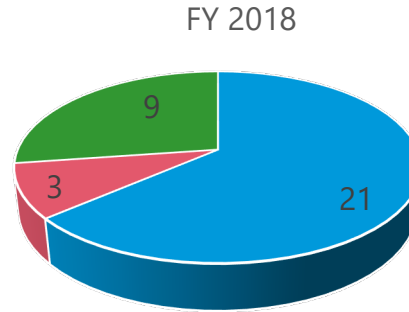
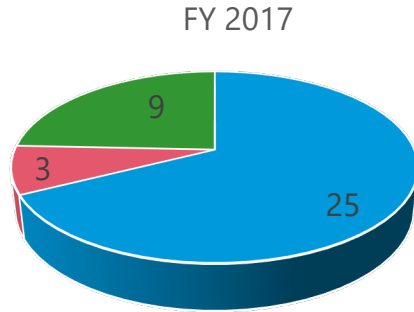
# Other types of discipline

- 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



■ Patent Attorneys ■ Patent Agents ■ Trademark Attorneys





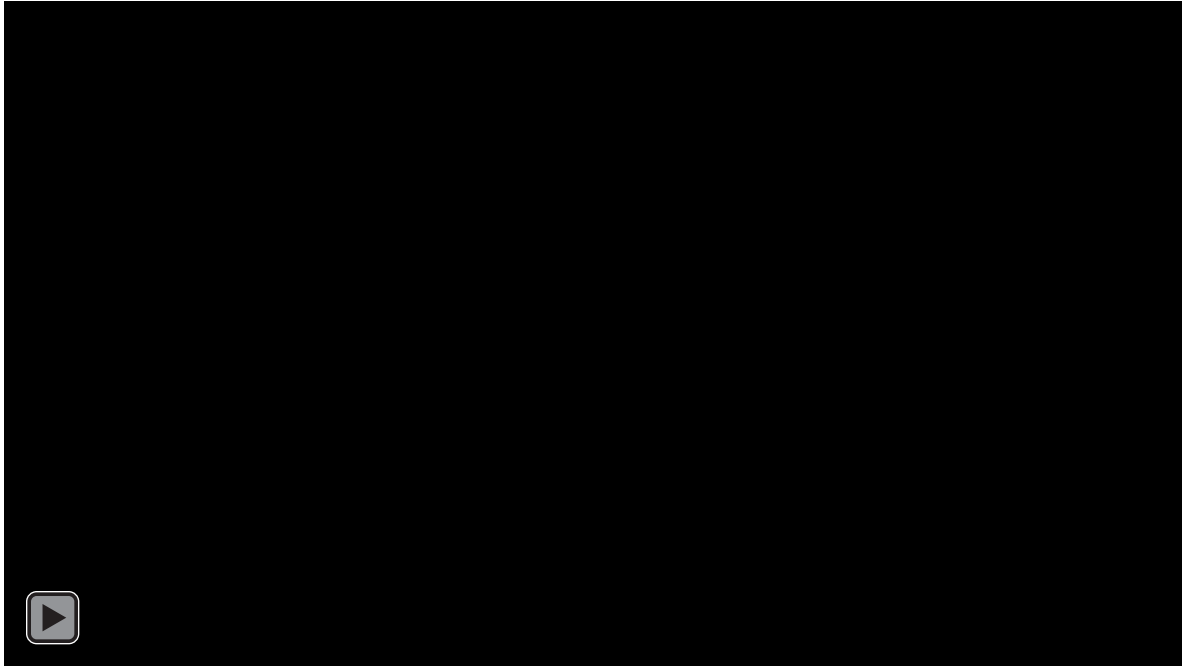
OED

# **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)

# Jurisdiction/UPL

- *In re Achterhof*, Proceeding No. D2017-24 (USPTO Nov. 18, 2019)
  - Wyoming licensed attorney/not registered to practice before the USPTO in patent matters
    - Consulted with and advised inventors, prepared and drafted provisional and non-provisional patent applications, and drafted responses to Office actions (applicants signed documents; non-practitioner filed documents).
    - Informed a client that it was not necessary that he be registered with the USPTO as long as he did not appear before the USPTO on client's behalf.
    - Argued that USPTO did not have jurisdiction because he was not a registered patent practitioner, he did not represent patent applicants before the office, and he only assisted pro se applicants who were representing themselves.
  - **“[U]nregistered practitioners are subject to the disciplinary jurisdiction of the office if they provide or offer to provide any legal services before the office.”**
  - Suspension for 18 months
  - Rule highlights:
    - 37 C.F.R. § 11.19(a) - Jurisdiction
    - 37 C.F.R. §§ 11.505 and 11.116(a)(1) - Unauthorized practice of law
    - 37 C.F.R. §§ 10.23(b)(5) and 11.804(d) - Conduct prejudicial to the administration of justice
    - 37 C.F.R. § 11.701 - False and misleading communications regarding a practitioner's service



# 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 director from 3<sup>rd</sup> party payer: 37 C.F.R. § 11.504(c)



# 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)(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.”

# 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
    - 37 C.F.R. § 11.804(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:
    - Had relationship with Florida attorney with no prior TM experience
    - Florida attorney was named attorney of record in US trademark applications
    - Respondent would enter Florida attorney's signature on documents filed with the USPTO
    - 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(d) – Conduct prejudicial to the administration of justice
    - 37 C.F.R. § 11.804(i) – Other conduct adversely reflecting on fitness to practice

# Trademarks: local counsel rule

- There is an increase in foreign parties not authorized to represent trademark applicants who are improperly representing foreign applicants in trademark 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.



# 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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