

**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



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.
- 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

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 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.
 - 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

Register of patent practitioners

oedci.uspto.gov/OEDCI/

Office of Enrollment and Discipline

[USPTO Home](#) > [About Us](#) > [Organizational Offices](#) > [Office of the General Counsel](#) > [Office of Enrollment and Discipline \(OED\)](#)
> [Patent Practitioner Home Page](#) >

 Print

Persons Recognized to Practice in Patent Matters

I want to...



Go

Patent Practitioner Home Page

The listings contain contact information for attorneys and agents with licenses to practice before the US Patent and Trademark Office.

PATENT PRACTITIONER SEARCH:

Currently, there are **12558 active agents** and **35680 active attorneys**. All searches reflect current information available to OED. Information concerning a practitioners status as an attorney is based on records provided to the Office of Enrollment and Discipline and might not reflect the practitioners status in a State Bar. Individuals interested in a practitioners status in a State Bar should contact that State Bar for specific information.


REGISTERED PRACTITIONER PORTAL:

Self-service portal for registered patent attorneys and agents that enables users to update their contact information such as mailing address, e-mail address, phone numbers, security question and answer, and change their password. They may also submit requests to OED and pay fees online. Please refer to our [Document Processing](#) and [Frequently Asked Questions \(FAQs\)](#) pages for more information.

EXAM APPLICANT PORTAL:

Applicants may apply or reapply for Admission to the Examination for Registration, upload pertinent documentation, and pay the application and examination fees online using the Applicant Portal. Applications for Waiver of the Examination 37 CFR § 11.7(d), Reciprocal Recognition 37 CFR § 11.6 (c), and Reciprocal Recognition for Trademarks 37 CFR § 11.14(c) are not currently available through the online portal. Please refer to our [Document Processing](#) and [Frequently Asked Questions \(FAQs\)](#) pages for more information.

 Patent Practitioner Search

 Registered Practitioner Portal

 Exam Applicant Portal



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
- **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



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



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

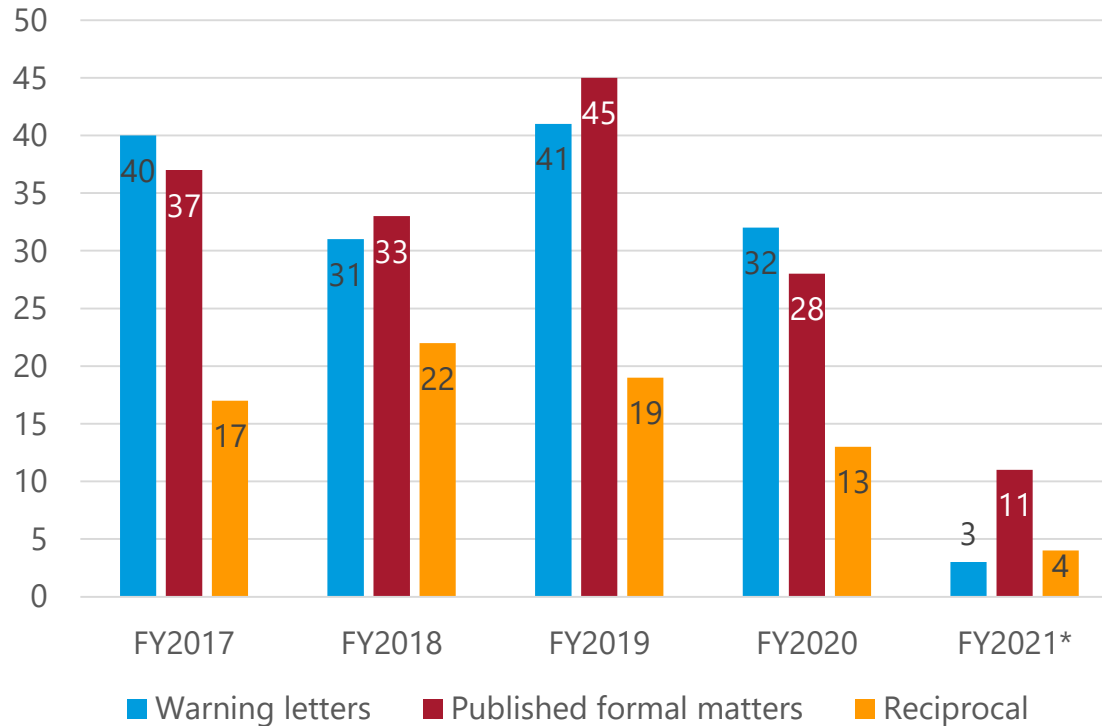
- Upon the conclusion of an investigation, the OED Director may:
 - Close the investigation without issuing a warning or taking disciplinary action
 - Issue a warning to the practitioner
 - Institute formal charges upon the approval of the Committee on Discipline, or
 - Enter into a settlement agreement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

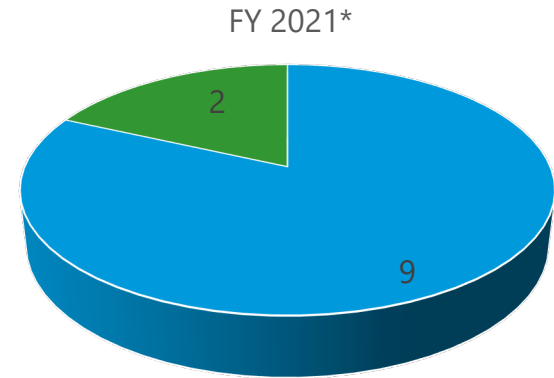
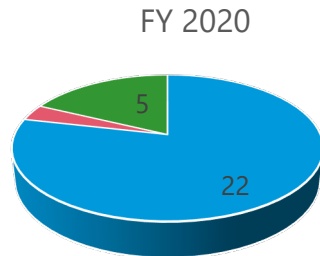
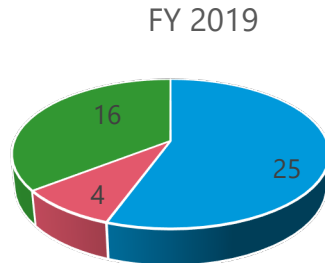
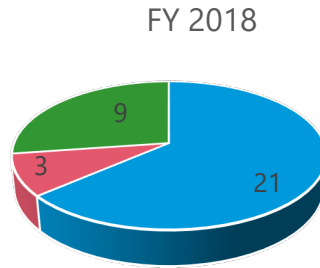
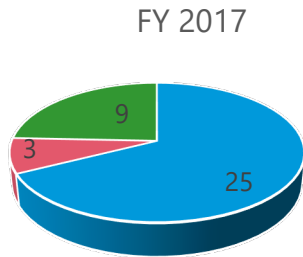
USPTO disciplinary matters



* Through March 2021



USPTO disciplinary matters



■ Patent Attorneys ■ Patent Agents ■ Trademark Attorneys

* Through March 2021



Office of Enrollment and Discipline

Ethics scenarios and select case law

Breakout scenario #1

- Carey invents an improved widget.
- Carey brings a prototype to patent agent Felicia, who has extensive experience in the art.
- Felicia studies the prototype and informs Carey that certain features of the widget are likely patentable but that the prototype likely infringes a patent owned by Globocorp.
- Carey returns to the lab and redesigns the widget.
- After examining the redesign, Felicia informs Carey that it no longer infringes the Globocorp patent.
- After Carey begins production and sale of the widget, Globocorp sues for infringement of its patent.
- Globocorp seeks discovery regarding Carey's communications with Felicia.

Breakout scenario #1: discussion questions

- If Globocorp requests production of documents relating to Carey's consultation with Felicia regarding the design-around, does "attorney"-client privilege apply?
- If Felicia helps Carey obtain a patent for the widget and sues Globocorp for infringement, does "attorney"-client privilege apply to documents relating to Carey's consultation with Felicia regarding patentability or prosecution of the patent?
- Would it make a difference to either of the above questions if Felicia was part of a group of practitioners (including patent attorneys) working on Carey's IP?

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”

Poll question #1

Poll question #1

- Q: Are there any ethics rules implicated in scenario #1?
- A: Yes:
 - 37 C.F.R. § 11.101 (competence)
 - 37 C.F.R. § 11.505 (unauthorized practice of law)

Breakout scenario #2

- Rhonda is a registered patent attorney. She is licensed to practice law in Illinois.
- She took a TM law class in law school, but has no practical trademark prosecution experience.
- She is approached by a Max, owner of the German company MarkMaxx, to assist with his clients' U.S. trademark needs.
- At the beginning of their arrangement, Max prepares trademark applications and provides them to Rhonda for her review, signature, and filing.
- A few months later, Max provides Rhonda with a link to each application. After her review, Max signs Rhonda's name and files the applications.

Breakout scenario #2: discussion questions

- Can Rhonda take Max's word for it with respect to an applicant's use in commerce?
- Does it matter if Rhonda never directly communicates with the TM applicants?
- Does it matter if MarkMaxx is a legal service provider in Germany (i.e., a foreign associate)?

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



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



Poll question #2

Poll question #2

- Q: If Rhonda were not a registered patent attorney, would the USPTO have disciplinary jurisdiction in this matter?
- A: Yes.
 - See 37 C.F.R. § 11.19 and
 - *In re Achterhof*, Proceeding No. D2017-08 (USPTO Nov. 18, 2019)

Jurisdiction/UPL

- *In re Achterhof, Proceeding No. D2017-08 (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

Breakout scenario #3

- Registered patent attorney Clint agrees to prepare and file a U.S. patent application for his neighbor Jackie and her co-worker Archie for their method of purifying used motor oil.
- The parties orally agree that Clint will receive a flat fee for the work, to be paid by Jackie. They do not execute any written agreement.
- Clint files a patent application for the invention, listing Archie and Jackie as co-inventors.
- As the application nears allowance, Clint learns that Jackie and Archie disagree as to whether Archie should be considered an inventor.
- Clint enlists an independent third-party attorney to evaluate inventorship.
- The independent attorney concludes that Jackie is the sole inventor of the application.

Breakout scenario #3: discussion questions

- Once it is clear that Jackie and Archie disagree with respect to inventorship, can Clint consult with Jackie about the subject?
- If Clint is convinced by the third-party evaluation that Jackie is the sole inventor, can he abandon the application in favor of a continuation application naming only Jackie?
- Can Clint continue to represent Jackie in the continuation application?

Conflicts of interest

In re Radanovic, Proceeding No. D2014-29 (USPTO Dec. 16, 2014).

- Represented joint inventors of patent application.
- No written agreement regarding representation.
- Sought independent inventorship opinion when dispute arose among inventors.
- Consulted with one inventor to the exclusion of the other.
- Continued to represent both inventors after dispute arose.
- Expressly abandoned application naming both inventors in favor of a continuation naming only one.
- Settlement: Public reprimand.
 - Mitigating factors included clean 50-year disciplinary history.

Conflicts of interest

In re Radanovic (cont.)

- Respondent indicated that he did not believe there were differing interests or that his representation of first co-inventor was directly adverse to second co-inventor because there was no evidence from second co-inventor that he made a contribution to the allowed subject matter.
- Rules:
 - 37 C.F.R. § 10.66(b): no multiple employment if practitioner's independent professional judgment is or is likely to be adversely affected or if it would be likely to involve representing differing interests.
 - 37 C.F.R. § 11.107(a): no representation if it will be directly adverse to another client or if there is a significant risk that representation will be materially limited by responsibilities to another client.
 - 37 C.F.R. § 11.109(a): no representation of a client in a substantially related matter in which client's interests are materially adverse to the interests of a former client – without informed consent.

Conflicts of interest

In re Ramberg, Proceeding No. D2017-12 (USPTO Feb. 14, 2017).

- Patent attorney undertook joint representation of two clients who he listed as co-inventors on a provisional patent application.
- A company owned by Inventor #1 is listed as the “Applicant” on the provisional.
- Attorney later filed trademark application for company of Inventor #2.
- Did not advise regarding potential conflicts or obtain consent for undertaking the TM matter.
- Filed utility application naming only Inventor #1.
- Continued representation of both parties
- Failed to inform Inventor #2 that he was left off of the utility application.
- Public reprimand, CLE attendance, and MPRE passage.
- Rule highlights:
 - 37 C.F.R. §§ 11.107(a)(1) & (2) and (b)(3) & (4).
 - 37 C.F.R. §§ 11.104(a)(1)-(5) and (b).

Poll question #3

Poll question #3

- Q: If Jackie and Archie never had a disagreement, would any ethics rules still be implicated in scenario #3?
- A: Yes. Informed consent is arguably necessary under 37 C.F.R. § 11.107(b) for the joint representation and for the 3rd party payment under 37 C.F.R. § 11.108(f).

Decisions imposing public discipline available in “FOIA Reading Room”

- foiadocuments.uspto.gov/oed/
- Official Gazette for Patents
 - 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

571-272-4097

www.uspto.gov