Select OED Procedure, Statistics, and Case Law
OED Discipline: Warnings vs. Formal Discipline

• Generally speaking, “formal discipline” at OED is public discipline.

• Formal disciplinary sanctions include:
  – Exclusion from practice before the Office;
  – Suspension from practice before the Office; or
  – Public reprimand.
    37 C.F.R. § 11.20(a).

• The OED Director may conclude an investigation with a warning.
  37 C.F.R. § 11.21.
  – A warning is neither public nor a disciplinary sanction.
OED Discipline: Warnings vs. Formal Discipline

<table>
<thead>
<tr>
<th>Year</th>
<th>Warning Letters</th>
<th>Formal Discipline</th>
</tr>
</thead>
<tbody>
<tr>
<td>FY2013</td>
<td>28</td>
<td>22</td>
</tr>
<tr>
<td>FY2014</td>
<td>48</td>
<td>30</td>
</tr>
<tr>
<td>FY2015</td>
<td>31</td>
<td>36</td>
</tr>
<tr>
<td>FY2016</td>
<td>41</td>
<td>32</td>
</tr>
</tbody>
</table>
OED Discipline: Grievances and Complaints

- An investigation of 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.

- Common Sources of Information:
  - External to USPTO: Clients, Colleagues, Others.
  - Internally within USPTO: Patent Corps, Trademark Corps, Other.

- Duty to report professional misconduct:
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.

• If probable cause is found, OED Director may file a complaint under 37 C.F.R. § 11.34. 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.
USPTO Disciplinary Decisions

![Bar chart showing disciplinary decisions from FY2013 to FY2016. The chart includes data for reprimand, suspension, and exclusion.]
Other Types of Discipline

  – Based on discipline by a state or federal program or agency.
  – Usually conducted on documentary record only.

• Interim suspension based on conviction of a serious crime. 37 C.F.R. § 11.25.
USPTO Disciplinary Decisions

Breakdown of Reciprocal vs. Non-Reciprocal Formal Decisions

- FY13: 6 Non-Reciprocal, 16 Reciprocal
- FY14: 8 Non-Reciprocal, 22 Reciprocal
- FY15: 12 Non-Reciprocal, 24 Reciprocal
- FY16: 11 Non-Reciprocal, 21 Reciprocal
USPTO Disciplinary Decisions

Breakdown of Disciplinary Decisions by Practitioner Type

FY13

FY14

FY15

FY16

- Patent Attorneys
- Patent Agents
- Trademark Attorneys
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.
  - Executive Action in February 2014 required the USPTO to expand the programs to all 50 states.
  - 50 state coverage achieved and maintained since August 2015.

- Promote small business growth and development.

- Help ensure that no deserving invention lacks patent protection because of a 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.

- USPTO Pro Bono Contacts:
  - John Kirkpatrick - john.kirkpatrick@uspto.gov, 571-270-3343.
  - Grant Corboy – grant.corboy@uspto.gov, 571-270-3102.
Coverage of Patent Pro Bono Program
October 2016

20 regional non-profits across the nation match inventors with patent attorneys.
Limited Recognition for Visa Holders

• 37 C.F.R. 11.9(b) provides for the grant of limited recognition to practice before the USPTO in patent matters to nonimmigrant aliens residing in the U.S.

• Limited recognition is based on the visa authorizing employment in the U.S.
  – In many instances, visa must explicitly authorize employment or training involving practice before the USPTO in patent matters.

• Practitioners granted limited recognition are not “registered.”
  – Biographical information must indicate their limited recognition status.

• Limited recognition terminates when visa expires; employment authorized under the visa terminates; or practitioner departs the U.S.
  – New or extended visa requires extension or reinstatement from OED.
Register of Patent Practitioners

- Register of persons authorized to practice before the USPTO in patent matters is found on USPTO website: https://oedci.uspto.gov/OEDCI/.

- New web portal enables practitioners to:
  - Indicate whether they are currently accepting new clients;
  - Change official address with OED;
  - Change name;
  - View certain transactions with OED;
  - Add email addresses to receive certain communications and reminders from OED.

- Register now lists persons granted limited recognition.

- More updates to come.
Office of Enrollment and Discipline

Select OED Case Law Review
Neglect/Candor

- **In re Kroll** (USPTO D2014-14)
  - Patent attorney:
    - Attorney routinely offered (and charged $) to post client inventions for sale on his website.
    - Did not use modern docket management system.
    - Client hired Attorney to prepare and file application.
    - Attorney failed to file the application, but posted the invention for sale on his website.
    - Application file was discovered by chance. Attorney determined it had not yet been filed, and filed it 20 months after posting on the website.
      - Did not inform client about delay in filing.
  - Aggravating factors included prior disciplinary history.
  - Received two-year suspension.
Conflict of Interest

• *In re Radanovic* (USPTO D2014-29)
  – Patent attorney:
    • Represented two joint inventors of patent application.
    • No written agreement regarding representation.
    • Attorney became aware of a dispute wherein one inventor alleged that the other did not contribute to allowed claims.
    • Continued to represent both inventors.
    • Expressly abandoned application naming both inventors in favor of continuation naming one.
  – Mitigating factors included clean 50-year disciplinary history.
  – Received public reprimand.
Disreputable or Gross Misconduct

• *In re Schroeder* (USPTO D2014-08)
  
  – 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.
  
  – Suspended from practice before USPTO for 6 months.
Dishonesty, Fraud, Deceit or Misrepresentation

- **In re Throne (USPTO D2015-19)**
  - Investigation alleged that respondent patent attorney:
    - Was entrusted to approve patent-related expenditures for Hunter Douglas, International (HDI).
    - Also incorporated and controlled Patent Services Group, LLC (PSG).
    - Prepared invoices from PSG to HDI; approved payments from HDI to PSG.
    - Falsely represented to HDI that he was not involved with any conflicting activities.
      - HDI paid PSI nearly $5 million under this arrangement.
  - Mr. Throne was excluded on consent.
Fee Issues

- **In re Stecewycz** (USPTO D2014-15)
  - Patent attorney:
    - Client sent attorney a check to cover filing fees for a CIP application.
    - Attorney attempted to pay filing fees for application with debit card.
      - Payment was denied; Missing Parts issued.
    - Payment on Missing Parts by debit card was denied.
    - Third attempt at payment using card was also denied.
    - Application became abandoned.
    - Did not advise client that application had gone abandoned.
      - Told client that application was “still on track.”
  - Received 2 year suspension.
Legal Fees

• *In re Neeser* (USPTO D2015-16)
  – Patent Agent:
    • Formed a partnership w/ non-lawyer practicing patent law.
    • Failed to maintain trust accounts for clients’ funds.
    • Neglected applications.
  – Suspended from practice before USPTO for 12 months.
  – Mitigating factors included remorse, cooperation w/ investigation, and no prior discipline.
Decisions Imposing Public Discipline Available In FOIA Reading Room

- [http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp](http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp)
  - In the field labeled “Decision Type,” select “Discipline” from the drop down menu.
    - To retrieve all discipline cases, click “Get Info” (not the “Retrieve All Decisions” link).

Contacting OED

For Informal Inquiries, Contact OED at 571-272-4097

THANK YOU