

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Professional Responsibility and Pro Bono Practice Before the USPTO

William R. Covey

Deputy General Counsel for Enrollment and Discipline and
Director Office of Enrollment and Discipline
United States Patent and Trademark Office

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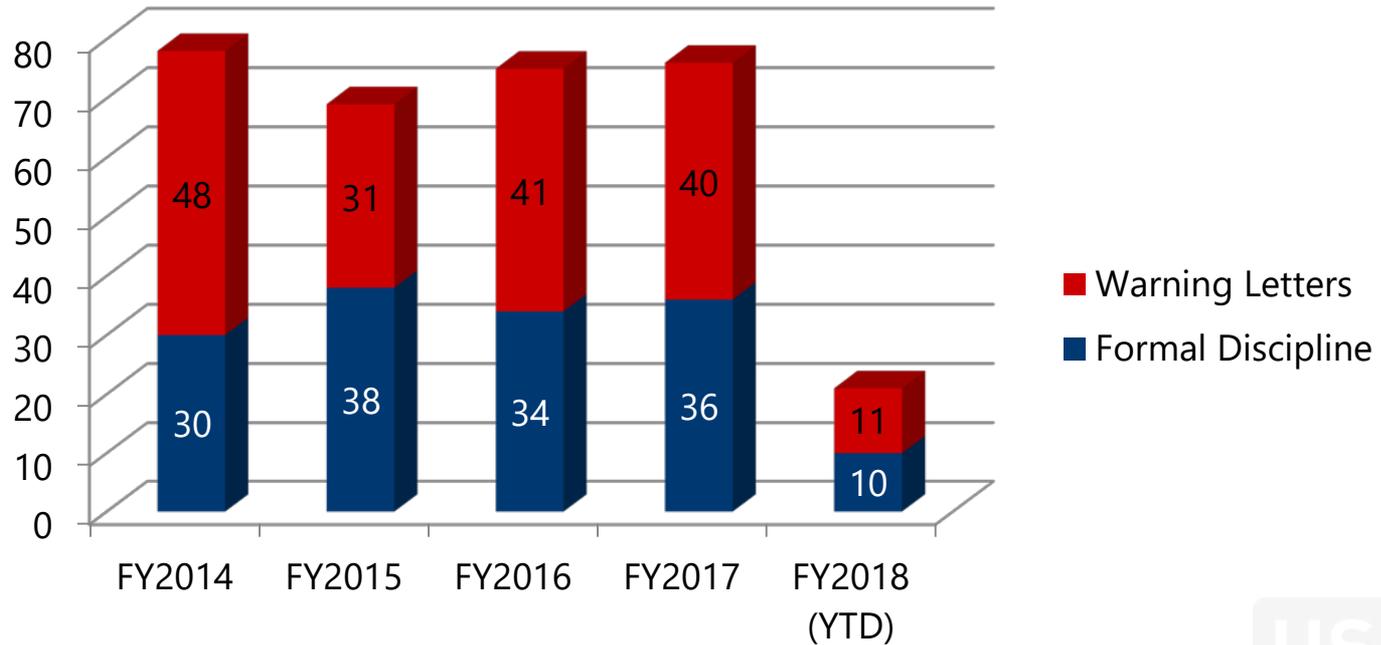
Office of Enrollment and Discipline

Discipline at OED

OED – Diversion Program

- A 2016 ABA Commission on Lawyer Assistance Programs and Hazelden Betty Ford Foundation published a study of 13,000 currently-practicing attorneys and found the following:
 - Between 21-36% qualify as problem drinkers
 - Approximately 28% struggle with some level of depression
 - 19% struggle with anxiety
 - 23% struggle with stress
 - Other difficulties include suicide, social alienation, work addiction, sleep deprivation, job dissatisfaction, and complaints of work-life conflict.
- USPTO announced diversion as two-year pilot program on November 3, 2017.
- Available to practitioners who engaged in minor misconduct resulting from:
 - Physical, mental, or emotional health issues; or
 - Practice management issues.
- Misconduct must have resulted in little to no harm to client.
- Misconduct must not:
 - Involve the misappropriation of funds or dishonesty, deceit, fraud, or misrepresentation;
 - Result in or likely result in substantial prejudice to a client or other person;
 - Constitute a “serious crime” under 37 C.F.R. § 11.1; or
 - Be a part of a pattern of similar misconduct or be of the same nature of misconduct for which the practitioner has been disciplined within the past 5 years.

OED Discipline: Warnings vs. Formal Discipline



Office of Enrollment and Discipline

Select Case Law Review

Conflict of Interest

In re Mikhailova, Proceeding No. D2017-18
(USPTO June 16, 2017).

- Patent Agent contracted with Desa Industries, Inc d/b/a World Patent Marketing (“WPM”) to prepare, file, and respond to Office actions for clients referred by WPM.
- Permitted WPM to act as full intermediary with clients.
- Settlement: 20 month suspension with 28 months probation.
- Rule highlights:
 - 37 C.F.R. § 11.105(b) – communicating scope of representation/fee.
 - 37 C.F.R. § 11.107(a) – Conflict of interest; current clients.
 - 37 C.F.R. § 11.108(f) – Accepting compensation from third party.
 - 37 C.F.R. § 11.504 – Permitting 3rd party payer to regulate judgment.
 - 37 C.F.R. § 11.505 – Unauthorized Practice of law.

Conflict of Interest

37 C.F.R. § 11.102 Scope of representation and allocation of authority between client and practitioner.

(c) A practitioner may **limit the scope of the representation** if the limitation is reasonable under the circumstances and the client gives **informed consent**.

37 C.F.R. § 11.105 Fees

(b) The **scope of the representation** and the basis or rate of the fee and expenses for which the client will be responsible **shall be communicated to the client**, preferably in writing, before or within a reasonable time after commencing the representation, except when the practitioner will charge a regularly represented client on the same basis or rate. Any changes in the basis or rate of the fee or expenses shall also be communicated to the client.

Conflict of Interest

37 C.F.R. § 11.107(a)

...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.

Conflict of Interest

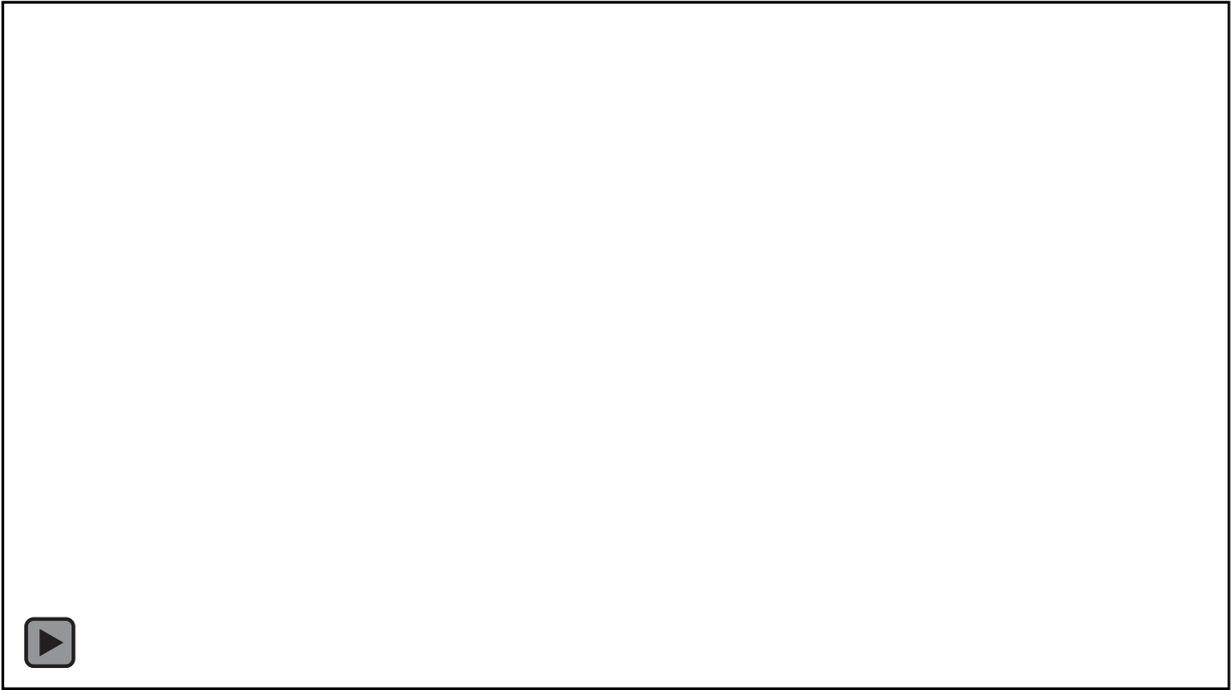
37 C.F.R. § 11.108(f)

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.

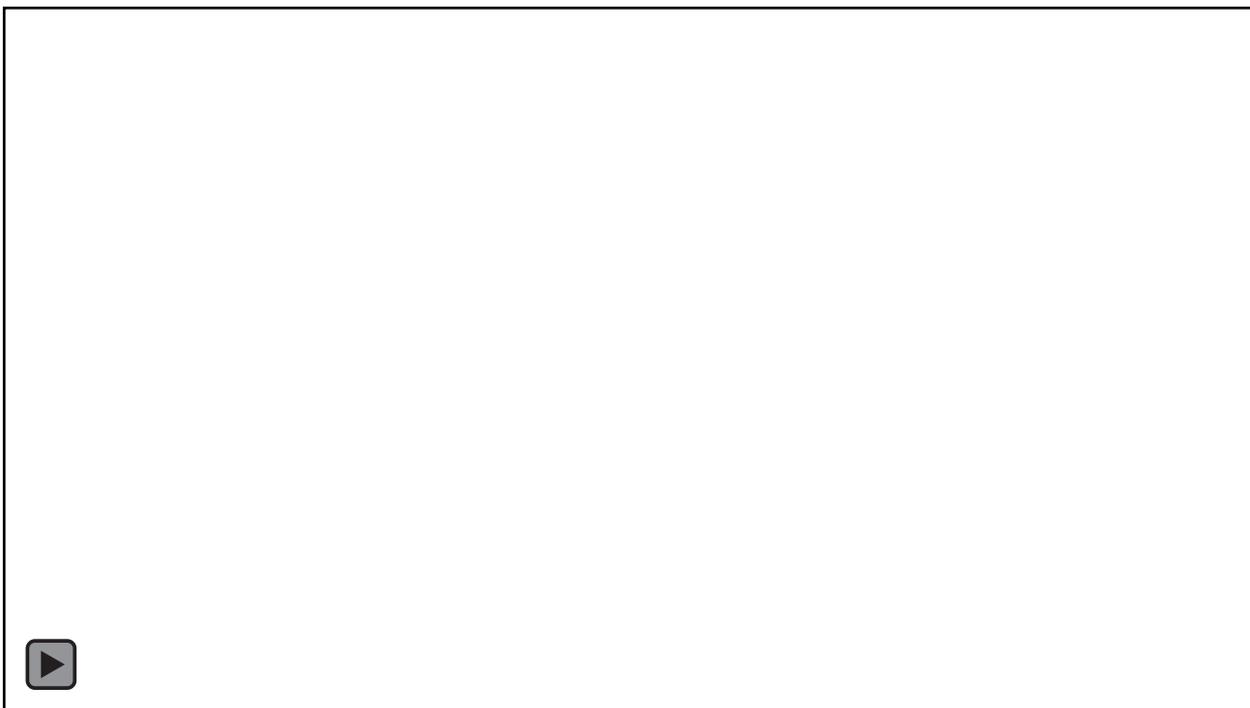


Disreputable or Gross Misconduct

In re Schroeder, Proceeding No. D2014-08
(USPTO May 18, 2015).

- 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.
- Default: 6-month suspension.
- Rule highlights:
 - 37 C.F.R. § 10.23(a) – Disreputable or gross misconduct.
 - 37 C.F.R. § 10.89(c)(5) – Discourteous conduct before the Office.
 - 37 C.F.R. § 10.23(b)(5) – Conduct prejudicial to the administration of justice.
 - 37 C.F.R. § 11.18 – Certification upon filing of papers.





Misrepresentation/UPL

In re Swyers, Proceeding No. D2016-20
(USPTO January 26, 2017).

- Disciplinary complaint alleged:
 - TM attorney established The Trademark Company, PLLC.
 - Permitted non-attorneys to practice TM law for him with little to no supervision.
 - Multiple fraudulent or digitally manipulated TM specimens were filed with 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.

Decisions Imposing Public Discipline Available In FOIA Reading Room

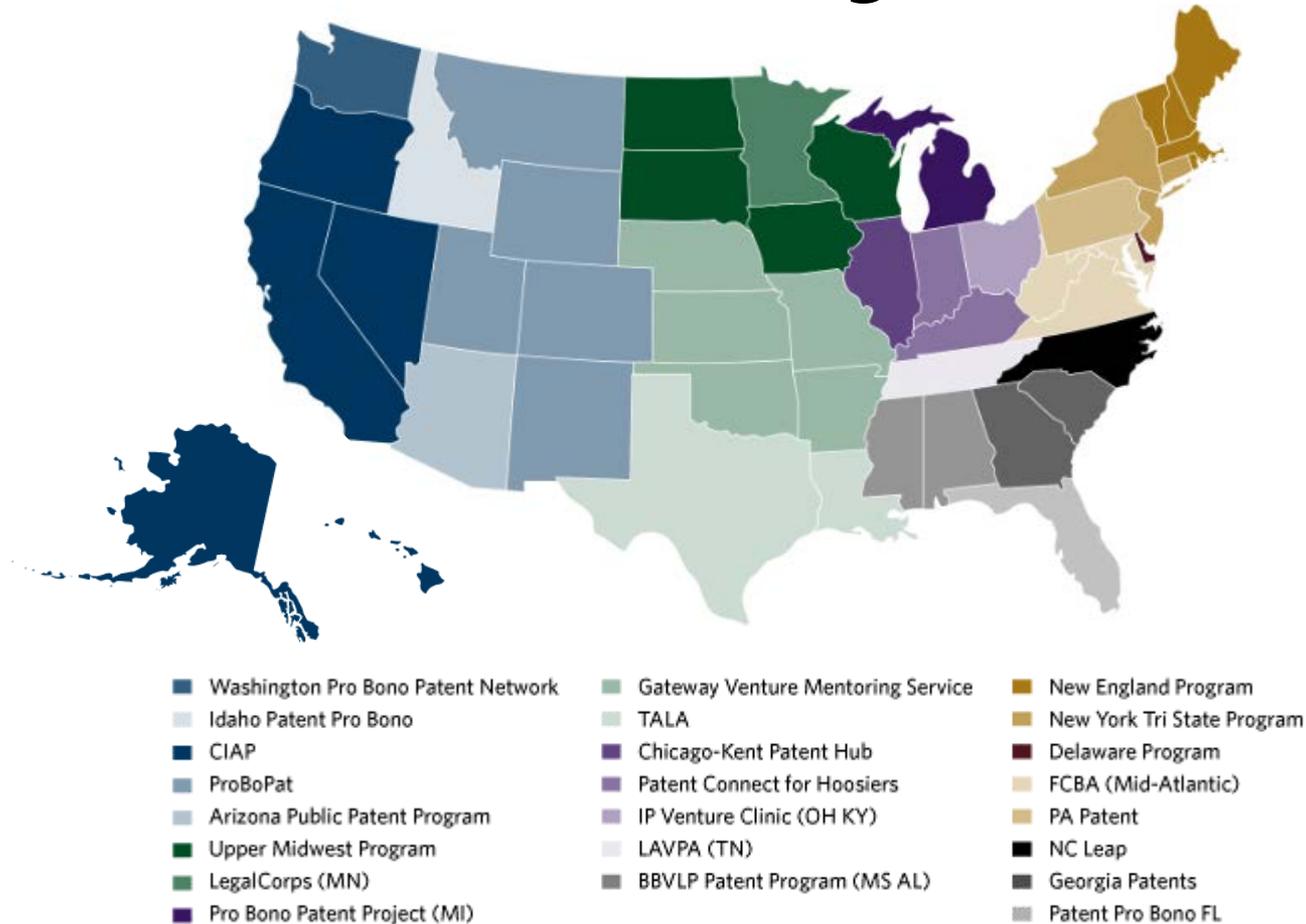
- ▶ <http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>
 - ▶ In the field labeled "Decision Type," select "Discipline" from the drop down menu.
 - To retrieve all discipline cases, click "Get Info" (not the "Retrieve All Decisions" link).
- ▶ Official Gazette for Patents
 - http://www.uspto.gov/news/og/patent_og/index.jsp Select a published issue from the list, and click on the "Notices" link in the menu on the left side of the web page.

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.
- 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>.
- Chicago-Kent Patent Hub serves under-resourced inventors in Illinois.
 - Contact: Mary Anne Smith; phone: (312) 906-5379; email: patenthub@kentlaw.iit.edu
- USPTO *Pro Bono* Contacts:
 - John Kirkpatrick - john.kirkpatrick@uspto.gov, 571-270-3343.
 - Grant Corboy – grant.corboy@uspto.gov, 571-270-3102.



Patent Pro Bono Program Coverage



Contacting OED

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

THANK YOU

