

Professional responsibility and practice before the USPTO

Office of Enrollment and Discipline
(OED)



UNITED STATES
PATENT AND TRADEMARK OFFICE ®

OED: enrollment

- Authorization to practice before the USPTO in patent matters:
 - Attorneys, agents, limited recognition.
- 3 factors for registration:
 - Scientific and technical qualifications;
 - Legal competence: registration exam; and
 - Moral character.

See 37 C.F.R. § 11.7 and General Requirements Bulletin.



Practice before the USPTO

- Activities that constitute practice before the USPTO are broadly defined in 37 C.F.R. §§ 11.5(b) and 11.14:
 - Includes communicating with and advising a client concerning matters pending or contemplated to be presented before the USPTO (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 USPTO (37 C.F.R. § 11.5(b)(1)); or
 - Consulting with or giving advice to a client in contemplation of filing a **trademark application** or other document with the USPTO (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 USPTO.
 - *See also* 37 C.F.R. § 11.14 for details regarding individuals who may practice before the USPTO in trademark and other non-patent matters.



OED: discipline

- Mission: protect the public and the integrity of the patent and trademark systems.
- Statutory authority:
 - 35 U.S.C. §§ 2(b)(2)(D) and 32.
- Disciplinary jurisdiction (37 C.F.R. § 11.19):
 - All practitioners engaged in practice before the USPTO, *e.g.*, TM, pro hac vice in PTAB, Those representing others in OED proceedings, etc.; and
 - Non-practitioners who engage in or offer to engage in practice before the USPTO.
- Governing regulations:
 - USPTO Rules of Professional Conduct 37 C.F.R. §§ 11.101-11.901; and



Investigation and formal complaint process

- OED investigation begins with receipt of a grievance by the OED Director.
 - Grievance: a written submission from any source received by the OED Director that presents possible grounds for discipline of a specified practitioner. *See* 37 C.F.R. § 11.1.
 - Self-reporting is often considered as a mitigating factor in the disciplinary process.
- After investigation, the OED Director may:
 - Terminate an investigation with no action;
 - Issue a warning to the practitioner;
 - Institute formal charges with the approval of the Committee on Discipline; or
 - Enter into a settlement agreement with the practitioner and submit the same to the USPTO Director for approval.

37 C.F.R. § 11.22(h).



USPTO disciplinary proceedings

- Referral to the Committee on Discipline (COD)
 - OED presents the results of investigation to the COD
 - COD determines if probable cause of misconduct exists
- If probable cause is found, the Solicitor's Office, representing the OED Director, files formal complaint with hearing officer
 - Hearing officer issues an initial decision; and
 - Either party may appeal initial decision to USPTO Director, otherwise it becomes the final decision of the USPTO Director.

See 37 C.F.R. §§ 11.22, 11.23, 11.32, 11.34, 11.40, 11.54 and 11.55.



Disciplinary sanctions -37 C.F.R. § 11.20

- Exclusion from practice before the USPTO
 - minimum of five years. *See* 37 C.F.R. § 11.60(b)
 - reinstatement only upon grant of petition. *See* 37 C.F.R. §§ 11.58(a), 11.60(a)
- Suspension from practice before the USPTO for an appropriate period
 - reinstatement only upon grant of petition upon expiration of suspension period. *See id.*
- Reprimand or censure
- Probation (in lieu of or in addition to other sanctions)
- Possible conditions

Other types of discipline

- Reciprocal discipline (37 C.F.R. § 11.24):
 - Based on discipline by a state or federal program or agency, and
 - 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
- Exclusion on Consent (37 C.F.R. § 11.27)

Warnings – 37 C.F.R. § 11.21

“A warning is neither public nor a disciplinary sanction. The OED Director may conclude an investigation with the issuance of a warning. The warning shall contain a statement of facts and identify the USPTO Rules of Professional Conduct relevant to the facts.”

- A warning will not be an option if a formal complaint has been filed with a hearing officer.



37 C.F.R. § 1.3

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; and
 - Aggravating factor: did not accept responsibility or show 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; and
 - 37 C.F.R. § 11.18 – Certification upon filing of papers



Disreputable or gross misconduct

In re Tassan, Proceeding No. D2003-10 (USPTO Sept. 8, 2003):

- Registered practitioner who became upset when a case was decided against his client, and left profane voicemails with TTAB judges.
- Called and apologized one week later; said he had the flu and was taking strong cough medicine.
- Also had a floral arrangement and an apology note sent to each judge.
- Mitigating factors: private practice for 20 years with no prior discipline; cooperated fully with OED; showed remorse and voluntarily sought and received counseling for anger management.
- Settlement: Reprimanded and ordered to continue attending anger management and have no contact with Board judges for 2 years.

USPTO discipline-related records

- Contact OED with questions:

Phone: 571-272-4097

Fax: 571-273-0074

Email: OED@uspto.gov

Postal Mail:

Mail Stop OED

U.S. PTO

P.O. Box 1450

Alexandria, VA 22313-1450

- Disciplinary Decisions may be found at:

foiadocuments.uspto.gov/oed





Thank you!

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