

(iv) Other demonstrations or special events are permitted in park areas under permit for the National Celebration Events listed in paragraph (g)(4)(ii) of this section to the extent that they do not significantly interfere with the National Celebration Events. Except for Inaugural ceremony activities, no activity containing structures is permitted closer than 50 feet to another activity containing structures without the mutual consent of the sponsors of those activities.

(v) NPS will issue a permit for a demonstration on the White House sidewalk and in Lafayette Park at the same time only if the requirements of this paragraph are met. The organization, group, or other sponsor of the demonstration must undertake in good faith all reasonable action, including the provision of sufficient marshals, to ensure that the sponsor:  
 (A) Maintains good order and self-discipline in conducting the demonstration and any necessary movement of persons; and

(B) Observes the numerical limitations and waiver provisions described in paragraphs (g)(5)(i) and (ii) of this section.

(vi) NPS will issue permits authorizing demonstrations or special events for the periods shown in the following table. NPS may extend these periods for demonstrations only, unless another application requests use of the particular area and that application precludes double occupancy.

Park area	Permit validity period	Permit validity period for inaugural activities
(A) White House area, except the Ellipse.	7 days .....	Between October 24 through April 1 for reasonable and necessary set-up and take-down activities for the White House Sidewalk and Lafayette Park.
(B) The Ellipse and all other park areas.	4 months .....	Between December 7 through February 10 for reasonable and necessary set-up and take-down activities for Pennsylvania Avenue, National Historic Park and Sherman Park.

\* \* \* \* \*  
 Dated: October 31, 2008.

**Lyle Laverty,**  
*Assistant Secretary of the Interior for Fish and Wildlife and Parks.*  
 [FR Doc. E8-27047 Filed 11-14-08; 8:45 am]  
**BILLING CODE 4312-JK-C**

**DEPARTMENT OF COMMERCE**

**Patent and Trademark Office**

**37 CFR Parts 1 and 11**

[Docket No.: PTO-C-2005-0013]

RIN 0651-AB55

**Changes to Representation of Others Before the United States Patent and Trademark Office**

**AGENCY:** United States Patent and Trademark Office, Commerce.

**ACTION:** Final rule.

**SUMMARY:** The United States Patent and Trademark Office (Office) is adopting new rules governing the conduct of individuals registered to practice before the Office. The Office is adopting a new rule that provides for an annual practitioner maintenance fee for those recognized to practice before the Office in patent cases. These changes will enable the Office to maintain a roster of registered practitioners and, consequently, better protect the public from unqualified practitioners. The Office is also making conforming amendments to 37 CFR 1.21.

**DATES:** *Effective Date:* December 17, 2008.

**FOR FURTHER INFORMATION CONTACT:** Harry I. Moatz, Director of Enrollment

and Discipline (OED Director), directly by phone at (571) 272-6069; by facsimile to (571) 273-6069 marked to the attention of Mr. Moatz; or by mail addressed to: Mail Stop OED-Ethics Rules, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450.

**SUPPLEMENTARY INFORMATION:** Congress granted express authority to the Office to “establish regulations, not inconsistent with law, which \* \* \* may govern the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Office.” 35 U.S.C. 2(b)(2)(D). Congress also provided that the “Director may, after notice and opportunity for a hearing, suspend or exclude, either generally or in any particular case, from further practice before the Patent and Trademark Office, \* \* \* any person, agent, or attorney \* \* \* who does not comply with the regulations established under section 2(b)(2)(D) of this title. \* \* \* The reasons for any such suspension or exclusion shall be duly recorded.” 35 U.S.C. 32. In so doing, Congress vested express and implied authority with the Office to prescribe rules of procedure that are applicable to practitioners recognized to practice before the Office. Section 41(d) of Title 35, United States Code, authorizes the establishment of fees for services related to patents and not otherwise specified.

On December 12, 2003, the Office published *Changes to Representation of Others Before the United States Patent and Trademark Office*, a Notice of Proposed Rule Making in the **Federal Register** (68 FR 69441), 1278 *Off. Gaz. Pat. Office* 22 (Jan. 6, 2004), proposing to amend parts 1 and 2 of the rules and

procedures governing patent and trademark prosecution (Title 37 of the Code of Federal Regulations), reserving part 10 and introducing part 11. Included in the proposed rules for part 11 were rules governing, *inter alia*, an annual fee for practitioners and procedures for both collecting the fee and informing practitioners who do not pay the fee of their situation—principally rules 1.21, 11.8 and 11.11. One hundred sixty-three written comments were received. Ninety of these written comments addressed the proposed annual practitioner fee requirement.

Following receipt and consideration of the comments to the proposed rules in the December 12, 2003 Notice regarding an annual fee and procedures for both collecting the fee and informing practitioners who do not pay the fee of their situation, the Office is prepared to proceed to final rule making. The fee in the final rules is referenced as the annual practitioner maintenance fee. The primary purposes for adopting a fee and procedures for both collecting the fee and informing practitioners who do not pay the fee of their situation is to maintain a roster of registered practitioners, including affording practitioners due process, protecting the public, preserving the integrity of the Office, and maintaining high professional standards.

A registered practitioner in active status is one who is able to represent clients and conduct business before the USPTO in patent cases. To maintain active status, the practitioner would pay the annual practitioner maintenance fee required under §§ 1.21(a)(7)(i) and 11.8(d).

An individual granted limited recognition under § 11.9(b) is one who is able to represent clients and conduct business before the USPTO in patent cases under specified conditions. To maintain limited recognition, the individual would pay the annual practitioner maintenance fee required under §§ 1.21(a)(8) and 11.8(d).

A registered practitioner in administrative inactive status or in voluntary inactive status would be prohibited from representing applicants or other parties and continuing to practice before the Office in patent cases. Administrative inactive status is applied only to a practitioner who is an employee of the USPTO, such as a patent examiner, and to judges. Voluntary inactive status is available to practitioners who have retired or are unable to continue their practice, but still desire to maintain a recognized professional association with the USPTO. Neither administrative inactive status nor voluntary inactive status is available to persons having limited recognition.

A registered practitioner under administrative inactive status is not responsible for payment of the annual practitioner maintenance fee while in this status. A registered practitioner under voluntary inactive status is responsible for paying a reduced annual practitioner maintenance fee during the period of inactivation. For the purposes of this section, the fee for a registered practitioner in voluntary inactive status is \$25. If a condition occurs that automatically terminates a practitioner's administrative inactive status, e.g., separation from the USPTO, it would be permissible for that practitioner to seek a voluntary inactive status where the practitioner does not intend to represent clients and practice before the Office but still desires to maintain a professionally recognized association with the Office.

A registered practitioner who failed to pay the annual practitioner maintenance fee required under § 11.8(d) would be administratively suspended. A registered practitioner under active status can be administratively suspended for failure to comply with payment of the annual practitioner maintenance fee. A registered practitioner under voluntary inactive status can be administratively suspended for failure to comply with payment of the reduced annual practitioner maintenance fee. An individual granted limited recognition who failed to pay the annual practitioner maintenance fee required under § 11.8(d) would be administratively suspended.

The final rules will be applied as of the effective date of the final rules, without retroactive effect. For example, a person registered in the fiscal year in which the final rules become effective would not be required to pay the annual practitioner maintenance fee in that fiscal year. A further example is that unless a registered practitioner is in administrative inactive status or voluntary inactive status in the fiscal year in which the final rules become effective, a registered practitioner must pay the annual practitioner maintenance fee for active status. Still, a further example is that if the final rules become effective in fiscal year 2009, no fees under the final rules are due for fiscal year 2008. For purposes of these rules, the fiscal year begins on October 1 and ends on September 30.

#### Discussion of Specific Rules

Title 37 of the Code of Federal Regulations, Part 11, is amended as follows: Paragraph (d) of § 11.8 introduces an annual practitioner maintenance fee to be paid by registered practitioners in active status and persons granted limited recognition under § 11.9(b) to practice in patent cases before the Office. The amount of the fee is set forth in §§ 1.21(a)(7)(i) and 1.21(a)(8), respectively. Adequate notice of the due date for the annual practitioner maintenance fee will be published and sent to practitioners in advance. Failure to comply with these rules would subject a registered practitioner or person granted limited recognition to administrative suspension set forth in § 11.11(b). In the past, the fees paid by applicants and patentees have supported the costs of the activities that maintain the patent practitioner's community reputation for integrity. The annual practitioner maintenance fee is introduced pursuant to 35 U.S.C. 2(b)(2)(D) and 41(d). The annual practitioner maintenance fee will recover the estimated average cost to the Office for the roster maintenance process, including the costs of operating the disciplinary system. Maintaining the roster of registered practitioners up-to-date includes, for example, (i) processing additions to and deletions from the roster, (ii) maintaining current practitioner address/telephone/e-mail information, (iii) daily updating the roster with new changes of address, (iv) conducting investigations of alleged practitioner misconduct, and (v) conducting disciplinary proceedings against practitioners. With an annual practitioner maintenance fee, the Office will fund the disciplinary system as State disciplinary jurisdictions do, by fees from the bar members. Bar

disciplinary activities are generally regarded as being in the interest of maintaining the Bar's reputation for integrity and supporting the willingness of potential clients to engage the services of practitioners. The continual updating of the USPTO roster is also in the interest of assuring that registered practitioners are identified to the public they seek and are authorized to serve. It is problematic to charge patent applicants for this activity since few patent applicants file grievances against practitioners. Many of the filed grievances concern patent applications that were not filed; applications that were filed or prosecuted improperly; applications that should not have been filed in the first place; or patent applicants who have not received the benefit of competent counsel. The anomaly is magnified by the need for disciplinary action concerning practitioners who have been convicted of felonies or have been disciplined by state bars for matters other than practice before the Office. By adopting an annual practitioner maintenance fee to be paid by registered practitioners, the cost of these activities is focused on those served by the roster maintenance and disciplinary system—registered practitioners, not applicants. Thus, USPTO will recover the costs associated with these activities from the practitioners instead of the public in general. The funds received from the annual practitioner maintenance fee would be directed to this process. The annual practitioner maintenance fee would not be imposed on persons during the fiscal year in which they are first registered or recognized to practice before the Office.

Paragraph (a) of § 11.11 provides for requiring practitioners to notify the OED Director of their postal address and telephone number for his or her business, as well as every change thereto. Additionally, it requires practitioners to notify the OED Director of up to three e-mail addresses for their business and every change to their e-mail addresses. Notice of the change of address or telephone number must be given within thirty days of the date of the change. Practitioners are encouraged to provide their business e-mail address to facilitate the Office's ability to communicate with the practitioners. A practitioner who is an attorney in good standing with the bar of the highest court of one or more states is also required to provide the OED Director with the state bar identification number associated with each membership. This will enable the OED Director to distinguish between individual

attorneys having the same or similar names. Further, the section identifies the information that the OED Director will routinely publish on the roster about each registered practitioner recognized to practice before the Office in patent cases.

Paragraph (b) of § 11.11 provides for administrative suspension for failure to comply with the payment of the annual practitioner maintenance fee required by § 11.8(d).

Paragraph (b)(1) of § 11.11 provides that the OED Director will mail a notice to the practitioner advising of noncompliance, stating the consequences of administrative suspension under paragraph (b)(5) of this section if noncompliance is not timely remedied, and the requirements for reinstatement under paragraph (f) of this section. The notice also will demand compliance within sixty days and payment of a delinquency fee. The notice also will be published. Paragraph (b)(1) of § 11.11 introduces payment of the delinquency fee. The amount of the fee is set forth in § 1.21(a)(9)(i). The amount of the fee is set to recover the estimated average cost to the Office for processes associated with a practitioner who is delinquent in payment of the annual practitioner maintenance fee.

Paragraph (b)(2) of § 11.11 provides that upon failure to comply with the notice and demand within the allowed time, the OED Director will send to the attorney, agent or person granted limited recognition a Rule to Show Cause as to why he or she should not be administratively suspended and no longer permitted to practice before the Office in patent matters, or hold himself or herself out as being registered or recognized to practice before the Office in patent matters. The OED Director shall file a copy of the Rule to Show Cause with the USPTO Director.

Paragraph (b)(3) of § 11.11 provides that, within 30 days of the OED Director sending the Rule to Show Cause, the attorney, agent or person granted limited recognition may file a response to the Rule to Show Cause with the USPTO Director and, if so, that the OED Director may file a reply thereto. Under this section the USPTO Director hears the matter on the documentary record and imposes the administrative suspension unless the USPTO Director determines that there is a genuine issue of material fact regarding notice or the failure to pay the requisite fees.

Paragraph (b)(4) of § 11.11 provides that an administratively suspended attorney, agent or person granted limited recognition continues to be responsible for paying his or her annual

practitioner maintenance fee required by § 11.8(d).

Paragraph (b)(5) of § 11.11 provides that an administratively suspended attorney, agent or person granted limited recognition remains subject to investigation and discipline for his or her conduct prior to, during, or after the period he or she was administratively suspended.

Paragraph (b)(6) of § 11.11 provides that an administratively suspended attorney, agent or person granted limited recognition cannot practice before the Office in patent cases while under administrative suspension. An administratively suspended attorney, agent or person granted limited recognition who does not promptly obtain reinstatement must comply with applicable ethics rules concerning withdrawal from representation. An administratively suspended attorney, agent or person granted limited recognition who knows he or she has been administratively suspended will be subject to discipline for failing to comply with the provisions of this paragraph.

Paragraph (c)(1) of § 11.11 provides for administrative inactivation of a registered practitioner who becomes employed by the Office. The practitioner is not responsible for payments of the annual practitioner maintenance fee each complete fiscal year while the practitioner is in administratively inactive status.

Paragraph (c)(2) of § 11.11 provides for administrative inactivation of a registered practitioner who is a judge of a court of record, full-time court commissioner, U.S. bankruptcy judge, U.S. magistrate judge, or a retired judge who is eligible for temporary judicial assignment and is not engaged in the practice of law. The practitioner is not responsible for payments of the annual practitioner maintenance fee each complete fiscal year while the practitioner is in administratively inactive status.

Paragraph (d) of § 11.11 provides for voluntary inactivation of a registered practitioner. This section accommodates a registered practitioner who, at the time of the request, does not represent clients before the USPTO but still desires to maintain a recognized professional association with the USPTO. The USPTO will not inquire into reasons for seeking voluntary inactivation except that voluntary inactivation will be denied if the practitioner is delinquent in paying an annual practitioner maintenance fee or a delinquency fee. Voluntary inactivation will not preclude the USPTO from inquiring or continuing to inquire into possible ethical

violations by the practitioner or imposing discipline therefor. Reasons for seeking voluntary inactivation may include retirement, health condition of the practitioner (long-term illnesses), or a practitioner's decision to practice in another substantive area.

Paragraph (d)(1) of § 11.11 provides that a registered practitioner may seek voluntary inactivation by filing a written request to be endorsed as inactive.

Paragraph (d)(2) of § 11.11 provides that a registered practitioner whose status has been changed to a voluntary inactive status continues to be responsible for paying his or her annual practitioner maintenance fee required by § 11.8(d) for such status. Paragraph (d)(2) of § 11.11 introduces payment of the annual practitioner maintenance fee for inactive status. The amount of the fee, \$25, is set forth in § 1.21(a)(7)(ii). The amount of the fee is set to recover the estimated average cost to the Office for processes associated with a practitioner who is in inactive status.

Paragraph (d)(3) of § 11.11 provides that a registered practitioner in voluntary inactive status is still subject to investigation and discipline for ethical violations during the period of inactivation.

Paragraph (d)(4) of § 11.11 provides that a registered practitioner in arrears in annual practitioner maintenance fees or under administrative suspension for fee delinquency is ineligible to seek or enter into voluntary inactive status.

Paragraph (d)(5) of § 11.11 provides that a registered practitioner may not practice before the Office in patent cases while under voluntary inactive status. A practitioner in voluntary inactive status will be subject to discipline for failing to comply with the provisions of this paragraph. A voluntary inactive practitioner must comply with applicable ethics rules concerning withdrawal from representation.

Paragraph (d)(6) of § 11.11 provides for restoration to active status of a registered practitioner who is in voluntary inactive status in accordance with § 11.11(d). Paragraph (d)(6) of § 11.11 introduces payment of the fee for requesting restoration to active status from voluntary inactive status. The amount of the fee is set forth in § 1.21(a)(7)(iii). The amount of the fee is set to recover the estimated average cost to the Office for processing the request. The Office provides options for practitioners who are no longer attorneys in good standing at their state bars but seek active status before the USPTO. Since practitioners before the USPTO need not be attorneys, a practitioner who has ceased to be a

member in good standing of the bar of the highest court of a state for reasons other than ethical grounds may still seek to represent clients in patent matters before the USPTO as a patent agent. It becomes necessary to ensure that attorneys who are no longer members in good standing in a state bar explain the basis of such status when seeking restoration to active status before the USPTO. This section seeks to avoid the possibility that an attorney under a disciplinary proceeding or investigation in another disciplinary jurisdiction circumvents the obligation of informing the USPTO of any matter that detrimentally impacts the determination of the practitioner's moral character.

Any registered practitioner who is voluntarily inactivated pursuant to paragraph (d) of this section and who is a licensed attorney may comply with the submission of information and material pertaining to the practitioner's moral character on proof of being a member in good standing with the highest court of each state in which the practitioner is licensed to practice. If the registered practitioner is no longer a member in good standing of the highest court of another jurisdiction, the practitioner must submit a signed declaration or affidavit explaining the circumstances surrounding the practitioner's status in the other jurisdiction to the satisfaction of the OED Director that the reason for not being a member in good standing is not predicated on moral character. If the statement submitted is not to the satisfaction of the OED Director, the OED Director may decline restoration to active status on grounds of present lack of good moral character and reputation as set forth in § 11.7. An adverse decision by the OED Director is reviewable under § 11.2. This does not preclude the practitioner from submitting additional evidence to establish the requisite moral character.

Paragraph (d)(6) of § 11.11 also introduces payment of balance due upon restoration to active status from voluntary inactive status. The amount of the fee is set forth in § 1.21(a)(7)(iv). The amount of the fee is set to recover the balance of the estimated average cost to the Office for maintaining the roster. It is the difference between the annual practitioner maintenance fee for registered attorney or agent in active status, \$118, and the annual practitioner maintenance fee for registered attorney or agent in voluntary inactive status, \$25. The annual practitioner maintenance fee has increased from \$100 proposed in December 2003, to \$118 adopted in the final rules. In the nearly five years since the fee was

proposed, the number of registered practitioners has increased from 28,835 in December 2003 to more than 36,400 in July 2008, and the staff of the Office of Enrollment and Discipline has been increased to maintain the enlarging roster of registered practitioners. The increase in the fee is a reflection of changes in the consumer price index and staffing adjustments from the time the rule was proposed.

Paragraph (e) of § 11.11 allows for resignation from practice before the Office of a registered practitioner who is neither under investigation under § 11.22 for a possible violation of the Mandatory Disciplinary Rules identified in § 10.20(b) of Part 10, subject to discipline under § 11.24 or § 11.25, nor subject to an adverse probable cause determination by a panel of the Committee on Discipline under § 11.23(b).

Paragraph (f) of § 11.11 establishes a procedure for administrative reinstatement of a registered practitioner who has been administratively suspended pursuant to § 11.11(b) or who has resigned pursuant to § 11.11(d). Paragraph (f) provides for payment of the annual practitioner maintenance fee set forth § 1.21(a)(7) for registered patent attorneys or agents, or the annual practitioner maintenance fee set forth in § 1.21(a)(8) for persons granted limited recognition. Paragraph (f) of § 11.11 also introduces payment of both the delinquency fee and the administrative reinstatement fee by the practitioner. The amount of the delinquency fee is set forth in § 1.21(a)(9)(i). The amount of the administrative reinstatement fee is set forth in § 1.21(a)(9)(ii). The amount of the delinquency fee is set to recover the estimated average cost to the Office for processes associated with a practitioner who is delinquent in payment of annual practitioner maintenance fee. The amount of the administrative reinstatement fee is set to recover the estimated average cost to the Office for processes associated with an application for reinstatement. A practitioner who resigned or was administratively suspended for two or more years before the date the Office receives a completed application from the person must also pass the registration examination under § 11.7(b)(1)(ii).

*Response to comments:* The Office published a notice proposing changes to the Office's rules governing disciplinary proceedings for attorneys, registered patent agents and persons granted limited recognition to practice before the Office. See *Changes to Representation of Others Before the United States Patent and Trademark*

*Office*; Notice of proposed rulemaking, 68 FR 69442 (Dec. 12, 2003), 1278 *Off. Gaz. Pat. Office* 22 (Jan. 6, 2004) (proposed rule). The Office received one hundred sixty-three comments (from intellectual property organizations and patent practitioners) in response to this notice. The Office's responses to the ninety comments regarding an annual practitioner maintenance fee follow:

*Comment 1:* A number of comments noted that the staggered quarterly schedule of annual fee due dates set forth in the proposed rule would create an undue administrative burden on practitioners, particularly those who practice in large law firms, and would increase the possibility of confusion and inadvertent nonpayment of the fee. The comments indicated a single due date for all practitioners would reduce the administrative burden on practitioners and the Office, and would reduce the risk of inadvertent nonpayment.

*Response:* The suggestion in the comments has been adopted. The staggered quarterly schedule has been eliminated in favor of a single annual due date for all practitioners.

*Comment 2:* A large number of comments, citing past history, raised concern that annual practitioner maintenance fee payments would be diverted, and therefore opposed the annual practitioner maintenance fee on the basis that the fees would not be used to operate the roster maintenance process, including the disciplinary system.

*Response:* The USPTO has operated with full access to fee collections for the past four years. Annual practitioner maintenance fees collected under section 11.8(d) will be used to support maintenance of the roster of registered attorneys and agents, including the disciplinary system.

*Comment 3:* Several comments raised concern that proposed section 11.8(d) did not require separate notice to practitioners of the payment due date and, therefore, that practitioners would be more likely to inadvertently overlook payment of the fee.

*Response:* The suggestion to add a specific notice provision in section 11.8(d) has been adopted. Adequate notice of the due date will be sent to each practitioner at the last address provided pursuant to § 11.11(a) and will be published in the Official Gazette as well. It is expected that notice will also be published on the USPTO internet Web site. Pursuant to section 11.11(a), to ensure proper delivery of notices potentially affecting a practitioner's status, practitioners are required to update contact information within 30 days of a change. The USPTO has

implemented an on-line customer interface that will allow a practitioner to access his or her records with a username and password and to directly update address and contact information. Additionally, under 11.11(b)(1), whenever it appears that a registered patent attorney, a registered patent agent or a person granted limited recognition has failed to comply with § 11.8(d), the OED Director shall publish and send a notice to the attorney, agent or person granted limited recognition advising of the noncompliance, the consequence of being administratively suspended under paragraph (b)(5) of this section if noncompliance is not timely remedied, and the requirements for reinstatement under paragraph (f) of this section. The notice shall be published and sent to the attorney, agent or person granted limited recognition by mail to the last postal address furnished under paragraph (a) of this section or by e-mail addressed to the last e-mail addresses furnished under paragraph (a) of this section.

*Comment 4:* Several comments raised concern as to potential prejudice to clients in cases where an attorney handling a matter continues to make submissions to the USPTO after the attorney has been administratively suspended for failure to pay the annual fee and inquired as to how the USPTO would treat such submissions.

*Response:* Individuals representing others before the Office are expected at all times to meet the requirements for practice before the Office. Maintaining good standing and accurate contact information is the responsibility of the practitioner. Practitioners who properly update contact information on file with the Office of Enrollment and Discipline should receive ample notice of deadlines for payment of the annual practitioner maintenance fee and missed payment before the practitioner would be administratively suspended. A practitioner who has been administratively suspended may request an active member in his or her firm to timely file papers requiring a practitioner's signature. Nonetheless, a paper submitted in good faith by a practitioner who does not know that he or she has been administratively suspended for failure to pay the annual practitioner maintenance fee will be treated as unsigned. In the case of a new complete application, the applicant will receive a filing date because the signature of an attorney or agent on transmittal papers is not required. In the case of an unsigned *bona fide* response to an Office action, the submission will be treated in accordance with 37 CFR 1.135(c), and applicant may be given a

new period of time to supply the omission. Practitioners should be aware, however, that submission of a response having an omission may affect patent term adjustment pursuant to 37 CFR 1.704(c)(7). In the case of an issue fee payment, an unsigned issue fee transmittal form may lead to abandonment of the application, in which case a petition to revive would be required.

*Comment 5:* Several comments asserted government patent attorneys and agents earn considerably less than the average annual income of patent attorneys and agents in the United States, and indicated a proposed \$100 annual fee therefore would be excessively burdensome on government patent attorneys and agents. The comment suggested a reduced annual fee for attorneys and agents employed by the government. Similar comments were received with respect to part-time practitioners, solo practitioners and small law firms.

*Response:* The suggestion of a reduced annual practitioner maintenance fee for specific groups of active practitioners has not been adopted. The assertion in the comment that the average annual income for government patent attorneys and agents of approximately \$80,000 is not supported in the comment. In any event, a \$118 annual practitioner maintenance fee for an individual with an annual income of \$80,000 represents about one seventh of one percent of the annual income, which will not have a significant economic impact on a substantial number of practitioners. The costs of maintaining the roster, including conducting disciplinary investigations regarding practitioners in such groups, is independent of the practitioner's income. Accordingly, having a single fee for all active practitioners is appropriate and fair.

*Comment 6:* Several comments suggested the annual practitioner maintenance fee should not be instituted because collection of an annual practitioner maintenance fee would increase the administrative burden on the Office of Enrollment and Discipline, thereby offsetting the collected fees with increased administrative costs.

*Response:* The suggestion has not been adopted. The Office of Enrollment and Discipline has developed a system for payment of annual fees through an on-line customer interface that will allow a practitioner to submit payments directly. Additionally, law firm or corporate administrators will be able to submit payments on behalf of multiple practitioners. The system will minimize

the administrative burden on the Office of Enrollment and Discipline. Moreover, the on-line customer interface will allow a practitioner to directly update address and other contact information, further reducing the administrative burden of the Office by obviating the need for periodic surveys pursuant to § 10.11 and the reinstatement fee previously set forth in § 1.21(a)(3). Annual fee payment also may be submitted by mail or by hand delivery. It is also noted the \$118 annual practitioner maintenance fee is not calculated to pay for the cost of administering a continuing education program for practitioners.

*Comment 7:* Several comments asserted Congress has not provided statutory authorization for the collection of an annual fee assessed against practitioners.

*Response:* The annual practitioner maintenance fee is authorized pursuant to the provisions of 35 U.S.C. 2(b)(2)(D) and 41(d).

*Comment 8:* Several comments suggested State bar associations carry out a broader range of services than does the Office of Enrollment and Discipline, and therefore asserted that an annual practitioner maintenance fee is unwarranted.

*Response:* The \$118 annual practitioner maintenance fee is calculated on the basis of the cost of maintaining the roster, including the disciplinary system. The \$118 figure is not based on services that are not provided by the Office of Enrollment and Discipline.

*Comment 9:* Several comments indicated the annual practitioner maintenance fee discriminates against patent practitioners over trademark attorneys.

*Response:* The Office does not maintain a roster of U.S. attorneys authorized to represent others before the Office in trademark and other non-patent matters, and therefore these individuals impose a lesser administrative burden. The vast majority of disciplinary investigations and actions involve registered practitioners. To the extent an unregistered practitioner is involved in a disciplinary proceeding, the Office has the authority to seek to recover the cost of the proceeding directly from the unregistered practitioner.

*Comment 10:* One comment asserted that many practitioners never practice before the Office, but nonetheless find value in maintaining registration because clients often prefer to have registered patent practitioners handling their matters. The comment suggested such individuals would rarely be the

basis of disciplinary proceedings at the Office and therefore should not have to pay an annual practitioner maintenance fee.

*Response:* The Office incurs the same administrative cost of maintaining the roster for practitioners who never practice as well as active practitioners. Moreover, disciplinary proceedings are not limited to conduct arising out of practice directly before the Office, and a practitioner who does not practice may have an increased possibility of client complaints stemming from unfamiliarity with Office practice. It is noted that a practitioner has the option of requesting voluntary inactive status under section 11.11(d) if the practitioner is not actively representing others in patent matters before the Office.

*Comment 11:* Several comments suggested there should be no annual practitioner maintenance fee for individuals in voluntary inactive status, and indicated the reduced annual practitioner maintenance fee for voluntary inactive practitioners should be eliminated.

*Response:* The suggestion has not been adopted. The Office continues to incur administrative costs in maintaining voluntary inactive practitioners on the roster, and voluntary inactive practitioners may be the subject of disciplinary investigation.

*Comment 12:* A number of comments asserted the cost of administering the roster and operating the disciplinary system should continue to be funded from application fees because practitioners will simply pass the cost of the annual practitioner maintenance fee on to clients as an overhead expense.

*Response:* The suggestion has not been adopted. Like state bars, the cost of administering the roster, including operating the Office disciplinary system, is properly borne primarily by practitioners rather than *pro se* applicants and other applicants.

*Comment 13:* Several comments asserted registration is a one-time event and suggested the costs of maintaining the roster and operating the disciplinary system should be recovered solely from fees collected at the time a practitioner applies for registration and initial registration fees.

*Response:* The suggestion has not been adopted. Fees collected at the time a practitioner applies for registration (*i.e.*, application fee and examination fee) recover the cost of processing applications for registration and administering the registration examination; the initial registration fee recovers the administrative costs of initial registration. Maintaining the roster, including the disciplinary

system, are not one-time events; they are ongoing processes incurring ongoing costs.

*Comment 14:* One comment indicated the annual practitioner maintenance fee should not be implemented because it would create an economic disincentive discouraging students and unemployed scientists from taking and passing the registration examination.

*Response:* The suggestion has not been adopted. Persons newly registered are not liable for annual practitioner maintenance during the fiscal year in which they are first registered. Individuals may choose to go on voluntary inactive status if they are not practicing.

*Comment 15:* One comment asserted a practitioner may not be administratively suspended for failure to pay an annual practitioner maintenance fee without first being afforded notice and the opportunity for a hearing.

*Response:* Under Sec. 11.11(b), practitioners will be given advance notice of an impending administrative suspension as well as the opportunity for a hearing.

*Comment 16:* One comment suggested administrative suspension for failure to pay an annual practitioner maintenance fee would infringe on the right to free speech by preventing the administratively suspended practitioner from talking to another person about a patent application.

*Response:* An administratively suspended practitioner would be prohibited from practicing before the Office. The administratively suspended practitioner would not be prohibited from talking to another person about a patent application so long as the discussion does not constitute the practice of law before the Office.

#### Rule Making Considerations

*Regulatory Flexibility Act:* The Deputy General Counsel for General Law, United States Patent and Trademark Office, certified to the Chief Counsel for Advocacy, Small Business Administration, that the changes in this final rule will not have a significant impact on a substantial number of small entities (Regulatory Flexibility Act, 5 U.S.C. 605(b)). The provisions of the Regulatory Flexibility Act relating to the preparation of a regulatory flexibility analysis are not applicable to this final rule because the rule will not have a significant economic impact on a substantial number of small entities.

The final rule assesses a \$118 annual practitioner maintenance fee upon registered attorneys and agents in active status and individuals granted limited

recognition under 37 CFR 11.9(b). The Office estimates that approximately 37,000 practitioners will be subject to this fee under the final rule. The Office estimates that, in 2006, the average annual income in the United States of solo practitioners was \$231,777; of patent attorneys who are partners in private firms, \$434,464; of patent attorneys who are associates in private firms, \$152,677; and of corporate IP attorneys, \$198,109; and the average annual salary of patent agents in a firm in the United States was \$92,761. AIPLA Report of the Economic Survey 2007, pp. 10, I-21, I-35, I-58 and F-25 (2007). Because the annual practitioner maintenance fee is less than one seventh of one percent of practitioners having an average annual income of \$92,761 or more, this fee will not have a significant economic impact on practitioners.

It is estimated that annually about 150 practitioners will be in voluntary inactive status. Practitioners who choose voluntary inactive status are not required to pay the \$118 annual practitioner maintenance fee. Rather, these practitioners must pay a \$25 annual practitioner maintenance fee that will be assessed annually to registered attorneys and agents in voluntary inactive status. The Office estimates that the average income of an inactive practitioner in 2006 would have been comparable to the average income of a household the same year, \$66,570. Income, Poverty, and Health Insurance Coverage in the United States: 2006, Current Population Reports, Consumer Income, U.S. Department of Commerce, pp. 27-29 (2007). The \$25 annual practitioner maintenance fee assessed annually to registered attorneys and agents in voluntary inactive status is less than four one-hundredth of one percent of a household's annual income. Thus, this fee does not have a significant economic impact on a substantial number of small entities.

It is estimated that annually about ten practitioners in voluntary inactive status will request restoration to active status. The final rule imposes a \$50 fee for requesting restoration to active status from voluntary inactive status. As previously noted, the Office estimates that, in 2008, the average annual income of patent attorneys in the United States is over \$100,000, and the average annual income of patent agents in the United States is over \$90,000. Thus, the \$50 fee for requesting restoration to active status from involuntary status does not have a significant economic impact on a substantial number of small entities.

It is also estimated that the requests of all practitioners in voluntary inactive status for restoration to active status will

be granted. Thus, these practitioners (the Office estimates that there will be ten) must then pay the balance of the annual practitioner maintenance fee. These practitioners must pay an additional \$93 fee for the balance due upon restoration to active status from voluntary inactive status (\$118 minus the \$25 inactive status fee already paid). As previously noted, the total fee of \$118 will not have a significant economic impact on practitioners because it represents less than one seventh of one percent of practitioners having an average annual income of \$92,761 or more. In addition, since only approximately ten practitioners out of approximately 37,000 practitioners are expected to be affected by this fee, this fee in the final rule will not impact a substantial number of small entities.

It is estimated that about 175 practitioners will be delinquent in paying their annual practitioner maintenance fee. The final rule imposes a \$50 delinquency fee. This fee can be avoided in its entirety by simply paying the annual fee in a timely manner.

It is estimated that about 100 practitioners delinquent in paying their annual practitioner maintenance fee will be administratively suspended and will seek administrative reinstatement. The final rule imposes a \$100 administrative reinstatement fee. Again, this fee can be avoided in its entirety by simply paying the annual fee prior to administrative suspension.

Even assuming that a practitioner chooses to switch from inactive to active status, and chooses to pay the fees late (by incurring a delinquency fee, administrative reinstatement fee and annual practitioner maintenance fee), the highest dollar amount assessed to any practitioner in this situation would be \$268. It is estimated that only about 100 practitioners would be required to pay all of these fees. Given that the Office estimates the average annual income of patent attorneys in the United States is over \$100,000, and the average annual income of patent agents in the United States is over \$90,000, the total impact of all fees in this final rule does not have a significant economic impact on a substantial number of small entities.

*Executive Order 13132:* This notice of final rule making does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (August 4, 1999).

*Executive Order 12866:* This notice of final rule making has been determined to be significant for purposes of Executive Order 12866 (September 30, 1993).

*Paperwork Reduction Act:* This notice of final rule making involves information collection requirements which are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*). This notice of final rule making contains revisions governing the payment of an annual practitioner maintenance fee by patent practitioners to recover the costs of maintaining a roster of persons authorized to practice in patent cases before the USPTO and the costs of operating the USPTO disciplinary system. The principal impact of the changes in this notice of final rule making is on registered practitioners and individuals otherwise recognized to practice in patent cases before the USPTO. The information collections involved in this proposed rule have been previously reviewed and approved by OMB under OMB control number 0651-0012. The proposed revisions do not affect the information collection requirements for 0651-0012, so the USPTO is not resubmitting the collection to OMB for review and approval.

The title, description, and respondent description of the currently approved information collections for 0651-0012 are shown below with estimates of the annual reporting burdens. Included in the estimates is the time for reviewing instructions, gathering and maintaining the data needed, and completing and reviewing the collection of information.

*OMB Number:* 0651-0012.

*Title:* Admittance to Practice and Roster of Registered Patent Attorneys and Agents Admitted to Practice Before the Patent and Trademark Office (USPTO).

*Form Numbers:* PTO-158, PTO-158A, PTO-275, PTO-107A, PTO-1209, PTO-2126, PTO-2149, and PTO-2150.

*Type of Review:* Approved through December of 2010.

*Affected Public:* Individuals or households, businesses or other for-profit, Federal Government, and state, local, or tribal governments.

*Estimated Number of Respondents:* 72,122.

*Estimated Time per Response:* 5 minutes to 40 hours.

*Estimated Total Annual Burden Hours:* 89,475 hours.

*Needs and Uses:* The public uses the forms in this collection to ensure that all of the necessary information is provided to the USPTO and to request inclusion on the Register of Patent Attorneys and Agents.

*Comments are Invited on:* (1) Whether the collection of information is necessary for proper performance of the

functions of the agency; (2) the accuracy of the agency's estimate of the burden; (3) ways to enhance the quality, utility, and clarity of the information to be collected; and (4) ways to minimize the burden of the collection of information to respondents.

Interested persons are requested to send comments regarding these information collections, including suggestions for reducing this burden, to Harry I. Moatz, Director of Enrollment and Discipline, Mail Stop OED-Ethics Rules, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450, or to the Office of Information and Regulatory Affairs, Office of Management and Budget, New Executive Office Building, Room 10202, 725 17th Street, NW., Washington, DC 20503, Attention: Desk Officer for the United States Patent and Trademark Office.

Notwithstanding any other provision of law, no person is required to respond to nor shall a person be subject to a penalty for failure to comply with a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid OMB control number.

## List of Subjects

### 37 CFR Part 1

Administrative practice and procedure, Patents.

### 37 CFR Part 11

Administrative practice and procedure, Inventions and patents, Lawyers, Reporting and recordkeeping requirements.

■ For the reasons set forth in the preamble, the United States Patent and Trademark Office is amending 37 CFR Parts 1 and 11 as follows:

## PART 1—RULES OF PRACTICE IN PATENT CASES

■ 1. The authority citation for 37 CFR part 1 continues to read as follows:

**Authority:** 35 U.S.C. 2(b)(2), unless otherwise noted.

■ 2. In § 1.21, remove and reserve paragraph (a)(3), and add paragraphs (a)(7), (a)(8) and (a)(9) to read as follows:

### § 1.21 Miscellaneous fees and charges.

(a) \* \* \*

(3) [Reserved]

\* \* \* \* \*

(7) Annual practitioner maintenance fee for registered attorney or agent.

(i) Active Status—\$118.00.

(ii) Voluntary Inactive Status—\$25.00.

(iii) Fee for requesting restoration to active status from voluntary inactive status—\$50.00.

(iv) Balance due upon restoration to active status from voluntary inactive status—\$93.00.

(8) Annual practitioner maintenance fee for individual granted limited recognition—\$118.00.

(9)(i) Delinquency fee—\$50.00.

(ii) Administrative reinstatement fee—\$100.00.

\* \* \* \* \*

## PART 11—REPRESENTATION OF OTHERS BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE

■ 3. Revise the authority citation for 37 CFR part 11 to read as follows:

**Authority:** 5 U.S.C. 500, 15 U.S.C. 1123, 35 U.S.C. 2(b)(2), 32, 41.

■ 4. Amend § 11.8 by adding paragraph (d) to read as follows:

### § 11.8 Oath, registration fee, and annual practitioner maintenance fee.

\* \* \* \* \*

(d) *Annual practitioner maintenance fee.* A registered patent attorney or agent shall annually pay to the USPTO Director a practitioner maintenance fee in the amount set forth in § 1.21(a)(7) of this subchapter. Individuals granted limited recognition under paragraph (b) of § 11.9 shall annually pay to the USPTO Director a practitioner maintenance fee in the amount set forth in § 1.21(a)(8) of this subchapter. Adequate notice shall be published and sent to practitioners in advance of the due date for payment of the annual practitioner maintenance fee. Payment shall be for the fiscal year in which the annual practitioner maintenance fee is assessed. Payment shall be due by the last day of the payment period. Persons newly registered or granted limited recognition shall not be liable for the annual practitioner maintenance fee during the fiscal year in which they are first registered or granted limited recognition. Failure to comply with the provisions of this paragraph (d) shall require the OED Director to subject a practitioner to a delinquency fee penalty set forth in § 11.11(b)(1), and further financial penalties and administrative suspension as set forth in § 11.11(b)(2) and (b)(3).

■ 5. Revise § 11.11 to read as follows:

### § 11.11 Administrative suspension, inactivation, resignation, and readmission.

(a) A registered attorney or agent must notify the OED Director of his or her postal address for his or her office, up

to three e-mail addresses where he or she receives e-mail, and business telephone number, as well as every change to any of said addresses or telephone numbers within thirty days of the date of the change. A registered attorney or agent shall, in addition to any notice of change of address and telephone number filed in individual patent applications, separately file written notice of the change of address or telephone number to the OED Director. A registered practitioner who is an attorney in good standing with the bar of the highest court of one or more States shall provide the OED Director with the State bar identification number associated with each membership. The OED Director shall publish from the roster a list containing the name, postal business addresses, business telephone number, registration number, and registration status as an attorney or agent of each registered practitioner recognized to practice before the Office in patent cases.

(b) *Administrative suspension.* (1) Whenever it appears that a registered patent attorney, a registered patent agent or a person granted limited recognition under § 11.9(b) has failed to comply with § 11.8(d), the OED Director shall publish and send a notice to the attorney, agent or person granted limited recognition advising of the noncompliance, the consequence of being administratively suspended under paragraph (b)(5) of this section if noncompliance is not timely remedied, and the requirements for reinstatement under paragraph (f) of this section. The notice shall be published and sent to the attorney, agent or person granted limited recognition by mail to the last postal address furnished under paragraph (a) of this section or by e-mail addressed to the last e-mail addresses furnished under paragraph (a) of this section. The notice shall demand compliance and payment of a delinquency fee set forth in § 1.21(a)(9)(i) of this subchapter within sixty days after the date of such notice.

(2) In the event a registered patent attorney, registered patent agent or person granted limited recognition fails to comply with the notice of paragraph (b)(1) of this section within the time allowed, the OED Director shall publish and send in the manner provided for in paragraph (b)(1) of this section to the attorney, agent, or person granted limited recognition a Rule to Show Cause why his or her registration or recognition should not be administratively suspended, and he or she no longer be permitted to practice before the Office in patent matters or in any way hold himself or herself out as

being registered or authorized to practice before the Office in patent matters. The OED Director shall file a copy of the Rule to Show Cause with the USPTO Director.

(3) Within 30 days of the OED Director's sending the Rule to Show Cause identified in § 11.11(b)(2), the registered patent attorney, registered patent agent or person granted limited recognition may file a response to the Rule to Show Cause with the USPTO Director. The response must set forth the factual and legal bases why the person should not be administratively suspended. The registered patent attorney, registered patent agent or person granted limited recognition shall serve the OED Director with a copy of the response at the time it is filed with the USPTO Director. Within ten days of receiving a copy of the response, the OED Director may file a reply with the USPTO Director that includes documents demonstrating that the notice identified in § 11.11(b)(1) was published and sent to the practitioner in accordance with § 11.11(b)(1). A copy of the reply by the OED Director shall be served on the registered patent attorney, registered patent agent or person granted limited recognition. When acting on the Rule to Show Cause, if the USPTO Director determines that there are no genuine issues of material fact regarding the Office's compliance with the notice requirements under this section or the failure of the person to pay the requisite fees, the USPTO Director shall enter an order administratively suspending the registered patent attorney, registered patent agent or person granted limited recognition. Otherwise, the USPTO Director shall enter an appropriate order dismissing the Rule to Show Cause. Nothing herein shall permit an administratively suspended registered patent attorney, registered patent agent or person granted limited recognition to seek a stay of the administrative suspension during the pendency of any review of the USPTO Director's final decision.

(4) An administratively suspended attorney, agent or person granted limited recognition remains responsible for paying his or her annual practitioner maintenance fee required by § 11.8(d).

(5) An administratively suspended attorney, agent or person granted limited recognition is subject to investigation and discipline for his or her conduct prior to, during, or after the period he or she was administratively suspended.

(6) An administratively suspended attorney, agent or person granted limited recognition is prohibited from

practicing before the Office in patent cases while administratively suspended. An attorney, agent or person granted limited recognition who knows he or she has been administratively suspended under this section will be subject to discipline for failing to comply with the provisions of this paragraph.

(c) *Administrative Inactivation.* (1) Any registered practitioner who shall become employed by the Office shall comply with § 10.40 of this subchapter for withdrawal from the applications, patents, and trademark matters wherein he or she represents an applicant or other person, and notify the OED Director in writing of said employment on the first day of said employment. The name of any registered practitioner employed by the Office shall be endorsed on the roster as administratively inactive. The practitioner shall not be responsible for payments of the annual practitioner maintenance fee each complete fiscal year while the practitioner is in administratively inactive status. Upon separation from the Office, the practitioner may request reactivation by completing and filing an application, Data Sheet, signing a written undertaking required by § 11.10, and paying the fee set forth in § 1.21(a)(1)(i) of this subchapter. Upon restoration to active status, the practitioner shall be responsible for paying the annual practitioner maintenance fee for the fiscal year in which the practitioner is restored to active status. An administratively inactive practitioner remains subject to the provisions of the Mandatory Disciplinary Rules identified in § 10.20(b) of this subchapter, and to proceedings and sanctions under §§ 11.19 through 11.58 for conduct that violates a provision of the Mandatory Disciplinary Rules identified in § 10.20(b) of this subchapter prior to or during employment at the Office. If, within 30 days after separation from the Office, the practitioner does not request active status or another status, the practitioner will be endorsed on the roster as voluntarily inactive and be subject to the provisions of paragraph (d) of this section.

(2) Any registered practitioner who is a judge of a court of record, full-time court commissioner, U.S. bankruptcy judge, U.S. magistrate judge, or a retired judge who is eligible for temporary judicial assignment and is not engaged in the practice of law may request, in writing, that his or her name be endorsed on the roster as administratively inactive. Upon acceptance of the request, the OED Director shall endorse the name of the

practitioner as administratively inactive. The practitioner shall not be responsible for payment of the annual practitioner maintenance fee for each complete fiscal year the practitioner is in administratively inactive status.

Following separation from the bench, the practitioner may request restoration to active status by completing and filing an application, Data Sheet, signing a written undertaking required by § 11.10, and paying the fee set forth in § 1.21(a)(1)(i) of this subchapter. Upon restoration to active status, the practitioner shall be responsible for paying the annual practitioner maintenance fee for the fiscal year in which the practitioner is restored to active status.

(d) *Voluntary Inactivation.* (1) Except as provided in paragraph (d)(4) of this section, any registered practitioner may voluntarily enter inactive status by filing a request, in writing, that his or her name be endorsed on the roster as voluntarily inactive. Upon acceptance of the request, the OED Director shall endorse the name as voluntarily inactive.

(2) A registered practitioner in voluntary inactive status shall be responsible for payment of the annual practitioner maintenance fee for voluntary inactive status set forth in § 1.21(a)(7)(ii) of this subchapter for each complete fiscal year the practitioner continues to be in voluntary inactive status.

(3) A registered practitioner who seeks or enters into voluntary inactive status is subject to investigation and discipline for his or her conduct prior to, during, or after the period of his or her inactivation.

(4) A registered practitioner who is in arrears in paying annual practitioner maintenance fees or under administrative suspension for annual practitioner maintenance fee delinquency is ineligible to seek or enter into voluntary inactive status.

(5) A registered practitioner in voluntary inactive status is prohibited from practicing before the Office in patent cases while in voluntary inactive status. A practitioner in voluntary inactive status will be subject to discipline for failing to comply with the provisions of this paragraph. Upon acceptance of the request for voluntary inactive status, the practitioner must comply with the provisions of § 10.40 of this subchapter.

(6) Any registered practitioner whose name has been endorsed as voluntarily inactive pursuant to paragraph (d)(1) of this section and is not under investigation, not subject to a disciplinary proceeding, and not in

arrears for the annual practitioner maintenance fee for voluntary inactive status may be restored to active status on the register as may be appropriate provided that the practitioner files a written request for restoration, a completed application for registration on a form supplied by the OED Director furnishing all requested information and material, including information and material pertaining to the practitioner's moral character and reputation under § 11.7(a)(2)(i) during the period of inactivation, a declaration or affidavit attesting to the fact that the practitioner has read the most recent revisions of the patent laws and the rules of practice before the Office, and pays the fees set forth in §§ 1.21(a)(7)(iii) and (iv) of this subchapter.

(e) *Resignation.* A registered practitioner or a practitioner recognized under § 11.14(c), who is neither under investigation under § 11.22 for a possible violation of the Mandatory Disciplinary Rules identified in § 10.20(b) of Part 10 of this subchapter, subject to discipline under §§ 11.24 or 11.25, nor a practitioner against whom no probable cause has been found by a panel of the Committee on Discipline under § 11.23(b), may resign by notifying the OED Director in writing that he or she desires to resign. Upon acceptance in writing by the OED Director of such notice, that registered practitioner or practitioner under § 11.14 shall no longer be eligible to practice before the Office but shall continue to file a change of address for five years thereafter in order that he or she may be located in the event information regarding the practitioner's conduct comes to the attention of the OED Director or any grievance is made about his or her conduct while he or she engaged in practice before the Office. The name of any registered practitioner whose resignation is accepted shall be removed from the register, endorsed as resigned, and notice thereof published in the Official Gazette. Upon acceptance of the resignation by the OED Director, the practitioner must comply with the provisions of § 10.40 of this subchapter.

(f) *Administrative reinstatement.* (1) Any registered practitioner who has been administratively suspended pursuant to paragraph (b) of this section, or who has resigned pursuant to paragraph (e) of this section, may be reinstated on the register provided the practitioner has applied for reinstatement on an application form supplied by the OED Director, demonstrated compliance with the provisions of §§ 11.7(a)(2)(i) and (iii), and paid the fees set forth in §§ 1.21(a)(7)(i), (a)(9)(i) and (a)(9)(ii) of

this subchapter. Any person granted limited recognition who has been administratively suspended pursuant to paragraph (b) of this section may have their recognition reactivated provided the practitioner has applied for reinstatement on an application form supplied by the OED Director, demonstrated compliance with the provisions of §§ 11.7(a)(2)(i) and (iii), and paid the fees set forth in §§ 1.21(a)(8)(i), (a)(9)(i) and (a)(9)(ii) of this subchapter. A practitioner who has resigned or was administratively suspended for two or more years before the date the Office receives a completed application from the person who resigned or was administratively suspended must also pass the registration examination under § 11.7(b)(1)(ii). Any reinstated practitioner is subject to investigation and discipline for his or her conduct that occurred prior to, during, or after the period of his or her administrative suspension or resignation.

(2) Any registered practitioner whose registration has been administratively inactivated pursuant to paragraph (c) of this section may be reinstated to the register as may be appropriate provided within two years after his or her employment with the Office ceases or within two years after his or her employment in a judicial capacity ceases the following is filed with the OED Director: a request for reinstatement, a completed application for registration on a form supplied by the OED Director furnishing all requested information and material, and the fee set forth in § 1.21(a)(9)(ii) of this subchapter. Any registered practitioner inactivated or reinstated is subject to investigation and discipline for his or her conduct before, during, or after the period of his or her inactivation.

Dated: November 10, 2008.

**Jon W. Dudas,**

*Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.*

[FR Doc. E8-27208 Filed 11-14-08; 8:45 am]

**BILLING CODE 3510-16-P**

## DEPARTMENT OF COMMERCE

### Patent and Trademark Office

#### 37 CFR Parts 2, 3, 6 and 7

[Docket No. PTO-T-2005-0018]

RIN 0651-AB89

#### Miscellaneous Changes to Trademark Rules of Practice

**AGENCY:** United States Patent and Trademark Office, Commerce.

**ACTION:** Final rule.

**SUMMARY:** The United States Patent and Trademark Office (“Office”) is amending the Trademark Rules of Practice to clarify certain requirements for applications, intent to use documents, amendments to classification, requests to divide, and Post Registration practice; to modernize the language of the rules; and to make other miscellaneous changes. For the most part, the rule changes are intended to codify existing practice, as set forth in the *Trademark Manual of Examining Procedure* (“TMEP”).

**DATES:** This rule is effective January 16, 2009.

**FOR FURTHER INFORMATION:** Contact Mary Hannon, Office of the Commissioner for Trademarks, by telephone at (571) 272-9569.

**SUPPLEMENTARY INFORMATION:** A proposed rule was published in the *Federal Register* on June 12, 2008 at 73 FR 33356, and in the Official Gazette on July 8, 2008. The Office received comments from one law firm and one organization. These comments are posted on the Office’s Web site at [http://www.uspto.gov/web/offices/pac/dapp/opla/comments/tm\\_comments2008aug20/index.htm](http://www.uspto.gov/web/offices/pac/dapp/opla/comments/tm_comments2008aug20/index.htm), and are addressed below.

References below to “the Act,” “the Trademark Act,” or “the statute” refer to the Trademark Act of 1946, 15 U.S.C. 1051 *et seq.*, as amended. References to “TMEP” or “*Trademark Manual of Examining Procedure*” refer to the 5th edition, September 2007. References to the “TBMP” or “*Trademark Trial and Appeal Board Manual of Procedure*” refer to the 2nd edition, Rev. 1, March 12, 2004.

Where appropriate, the Office has reworded or reorganized the rules for clarity, and added headings to facilitate navigation through the rules.

On August 14, 2008, the Office published a final rule that, *inter alia*, removed §§ 10.14 and 10.18 of this chapter and replaced them with new §§ 11.14 and 11.18; added a definition of “attorney” to § 11.1 of this chapter;

and changed cross-references in several of the rules in parts 2 and 7 of this chapter. The rule change was effective September 15, 2008. See notice at 73 FR 47650 (Aug. 14, 2008). The cross-references in this notice have been changed accordingly.

#### Applications for Registration

The Office is amending § 2.21(a) to require that an application under section 1 or section 44 of the Trademark Act must be in the English language to receive a filing date.

*Comment:* One comment requested clarification as to whether the rule applies to applications under section 66(a) of the Trademark Act.

*Response:* The preamble of § 2.21 explicitly states that the rule applies only to “an application under section 1 or section 44 of the Act.” In a section 66(a) application (*i.e.*, a request for extension of protection of an international registration to the United States pursuant to the Madrid Protocol), the minimum filing requirements are set forth in section 66(b) of the Act, and compliance with these requirements is determined by the International Bureau of the World Intellectual Property Organization (“IB”) prior to sending to the Office the request for extension of protection to the United States. See TMEP section 1904.01(b) for further information about the filing date of a section 66(a) application.

The Office is removing § 2.21(c) because it is unnecessary. While it remains true that applicants who file on paper may resubmit the application documents and receive a new filing date as of the date of resubmission, it is unnecessary to say so in a rule.

The Office is amending § 2.23(a)(2), which requires that a TEAS Plus applicant continue to receive communications from the Office by electronic mail during the pendency of the application, to add a requirement that a TEAS Plus applicant maintain a valid e-mail correspondence address in order to maintain TEAS Plus status. If the e-mail address changes, the applicant must notify the Office of the new e-mail address. If an applicant chooses to receive correspondence on paper, the applicant will have to pay the processing fee required by §§ 2.6(a)(1)(iv) and 2.23(b).

The Office is amending § 2.32(a)(3)(iii) to indicate that the requirement for inclusion of the names and citizenship of the general partners in an application by a partnership applies only to domestic partnerships. Similarly, the Office is adding § 2.32(a)(3)(iv) to provide that if the applicant is a domestic joint venture,