

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Professional Responsibility and Practice Before the USPTO

Office of Enrollment and Discipline
United States Patent and Trademark Office

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Proposed Annual Active Patent Practitioner Fee

- August 1, 2018: Notice of Public Hearing regarding proposed patent fee adjustments pursuant to AIA Section 10. (83 Fed. Reg. 37,487)
 - Patent Public Advisory Committee (PPAC) public hearing - September 6, 2018.
 - Notice of Proposed Rulemaking (NPRM) scheduled for late summer 2019.
- Discount for those who complete voluntary CLE.
- Discount for paying electronically.

	<u>Filed Electronically</u>	<u>Paper Filing</u>
<u>With CLE Certification</u>	\$240	\$310
<u>Without CLE Certification</u>	\$340	\$410

Register of Patent Practitioners

<https://oedci.uspto.gov/OEDCI/>

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Office of Enrollment and Discipline

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> Patent Practitioner Home Page >

Print

Persons Recognized to Practice in Patent Matters

I want to...

Go

Patent Practitioner Home Page

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

Currently, there are **11749 active agents** and **34725 active attorneys**. All searches reflect current information available to OED.

Information concerning a practitioner's status as an attorney is based on records provided to the Office of Enrollment and Discipline and might not reflect the practitioner's status in a State Bar. Individuals interested in a practitioner's status in a State Bar should contact that State Bar for specific information.

Q Patent Practitioner Search

Registered Practitioner Sign In Page (OEDIS-CI)



Law School Clinic Certification Program

- Allows students in a participating law school's clinic program to practice before the USPTO under the strict guidance of a Law School Faculty Clinic Supervisor.
- The OED Director grants participating law students limited recognition to practice before the USPTO.
- Signed into law on December 16, 2014.
- 62 law schools actively participate:
 - 26 trademark only,
 - 6 patent only,
 - 30 both.
- Added 32 new clinic programs in recent 2016-2017 expansion.
- For additional information:
 - <https://www.uspto.gov/learning-and-resources/ip-policy/public-information-about-practitioners/law-school-clinic-1>



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 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.

OED Diversion Program - Criteria

- Willingness and ability to participate in a Diversion program
- No public discipline by the USPTO or another jurisdiction in the past three years
- Misconduct at issue must not:
 - **Involve misappropriation of funds or dishonesty, fraud, deceit, or misrepresentation;**
 - **Result in or be likely to result in substantial prejudice to a client or other person;**
 - **Constitute a “serious crime”; or**
 - **Constitute part of a pattern of similar misconduct or be of the same nature as misconduct for which practitioner has been disciplined within the past five years.**

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:
 - 37 C.F.R. § 11.803.

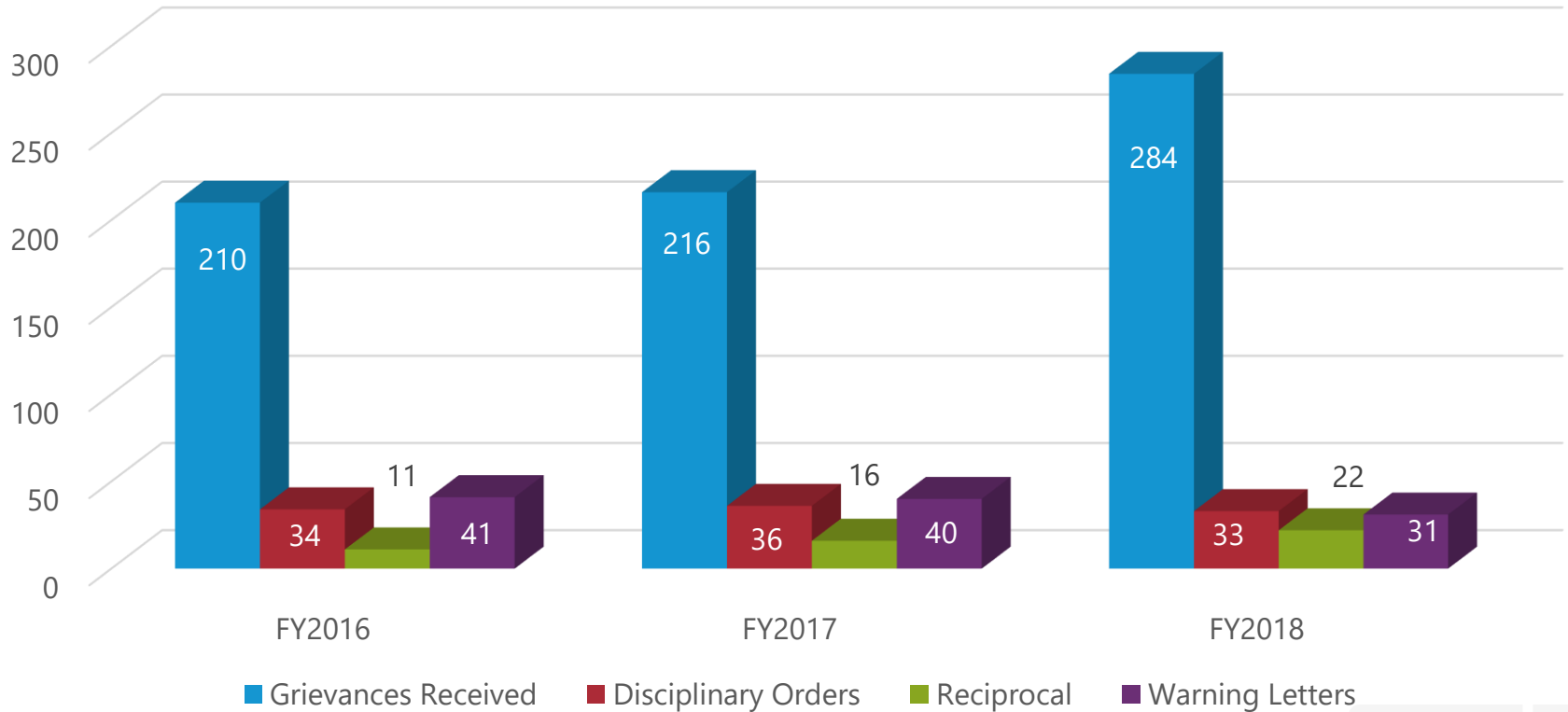
OED Discipline: Grievances and Complaints

- 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.

Other Types of Discipline

- Reciprocal discipline. 37 C.F.R. § 11.24.
 - 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.

OED Discipline: Grievances



Discussions of Select Case Law

- 1- Patent Agent Privilege
- 2- Duty of Candor
- 3- Conflicts
- 4- Neglect
- 5- Disreputable/Gross Misconduct

Patent Agent Privilege

In re Queen's University at Kingston, 820 F.3d 1287(Fed. Cir. 2016).

- U.S. District Court granted Samsung's Motion to Compel documents, including communications between Queen's University employees and registered (non-lawyer) patent agents discussing prosecution of patents at issue in suit.
- Federal Circuit recognized privilege **only** as to those activities which Patent Agents are authorized to perform. See 37 C.F.R. § 11.5(b)(1).

In re Silver, 540 S.W.3d 530 (Tex. 2018).

- Lower court ruled that communications between client and patent agent were not protected from discovery because Texas law did not recognize patent agent privilege.
- Supreme Court of Texas overturned, citing patent agents' authorization to practice law.

Rule on Attorney-Client Privilege for Trials Before the Patent Trial and Appeal Board, 82 Fed. Reg. 51570 (Nov. 7, 2017)



Duty of Candor

In re Tendler, Proceeding No. D2013-17 (USPTO Jan. 8, 2014).

- Patent attorney filed Rule 131 declaration re: reduction to practice with USPTO.
- Soon after, attorney learned that the inventor did not review the declaration and that declaration contained inaccurate information.
- Respondent did not advise the Office in writing of the inaccurate information and did not fully correct the record in writing.
- District court held resultant patent unenforceable due to inequitable conduct, in part, because of false declaration. *Intellect Wireless v. HTC Corp.*, 910 F. Supp. 1056 (N.D. Ill. 2012). Federal Circuit upheld.
 - 1st requirement is to expressly advise PTO of existence of misrepresentation, stating specifically where it resides.
 - 2nd requirement is that PTO be advised of misrepresented facts, making it clear that further examination may be required if PTO action may be based on the misrepresentation.
 - It does not suffice to merely supply the Office with accurate facts without calling attention to the misrepresentation.
- 4 year suspension (eligible for reinstatement after 2 years).

Conflicts 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.

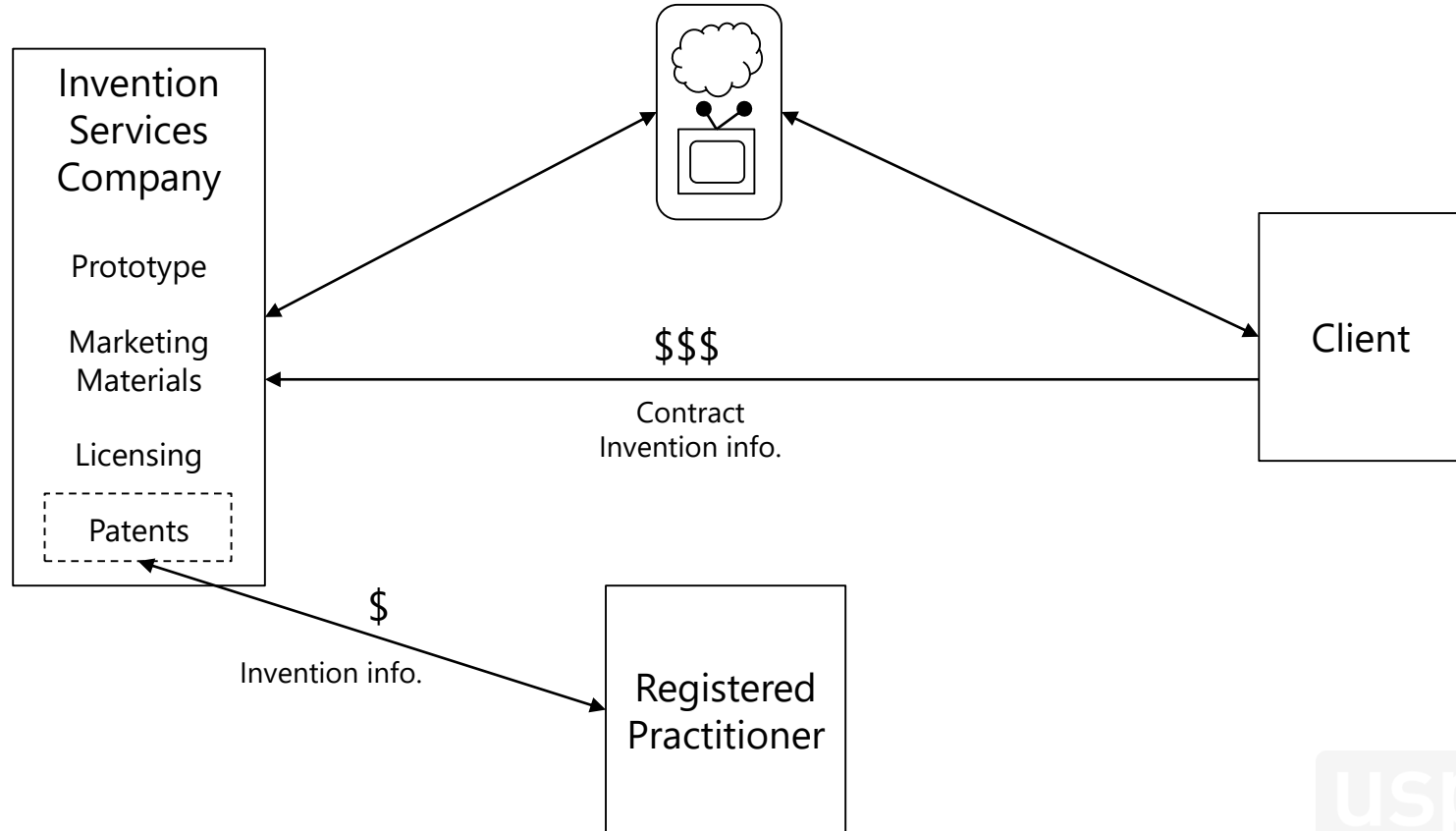
Conflicts of Interest

37 C.F.R. § 11.107(b)

Notwithstanding the existence of a concurrent conflict of interest under paragraph (a) of this section, a practitioner may represent a client if:

- (1) The practitioner reasonably believes that the practitioner will be able to provide competent and diligent representation to each affected client;
- (2) The representation is not prohibited by law;
- (3) The representation does not involve the assertion of a claim by one client against another client represented by the practitioner in the same litigation or other proceeding before a tribunal; and
- (4) **Each affected client gives informed consent, confirmed in writing.**

Conflict of Interest – Third Parties



Conflicts 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.

Scope of Representation

37 C.F.R. § 11.102

(a) Subject to paragraphs (c) and (d) of this section, a practitioner shall abide by a client's decisions concerning the objectives of representation and, as required by §11.104, **shall consult with the client as to the means by which they are to be pursued.** A practitioner may take such action on behalf of the client as is impliedly authorized to carry out the representation. A practitioner shall abide by a client's decision whether to settle a matter.

* * *

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

Conflicts of Interest – Third Parties

- ***In re Gray***, Proceeding No. D2017-02 (USPTO Feb. 22, 2017).
 - Exclusion on consent.
- ***In re Virga***, Proceeding No. D2017-14 (USPTO Mar. 16, 2017).
 - 5-year suspension
- ***In re Mikhailova***, Proceeding No. D2017-18 (USPTO Jun. 16, 2017).
 - 20 month suspension.
- ***In re Montgomery***, Proceeding No. D2018-02 (Jan. 10, 2018).
 - 4-year suspension.
- ***In re Lavenda***, Proceeding No. D2018-21 (Feb. 27, 2018).
 - Exclusion on consent.



Conflicts of Interest - Clients

- ***In re Radanovic***, Proceeding No. D2014-29 (USPTO Dec. 16, 2014).
 - Public Reprimand.
- ***In re Ramberg***, Proceeding No. D2017-12 (USPTO Feb. 14, 2017).
 - Public reprimand.
- ***In re Blackowicz***, Proceeding No. D2015-13 (USPTO May 11, 2015).
 - 30-day suspension.
- ***In re Newman***, Proceeding No. D2015-14 (USPTO Nov. 12, 2015).
 - 30-day suspension.

Conflicts of Interest

37 C.F.R. § 11.109(a)

A practitioner who has formerly represented a client in a matter shall not thereafter represent another person in the same or a substantially related matter in which that person's interests are materially adverse to the interests of the former client **unless the former client gives informed consent, confirmed in writing.**

Neglect/Candor

In re Kroll, Proceeding No. D2014-14
(USPTO March 4, 2016).

- Patent attorney:
 - Attorney routinely offered (and charged \$) to post client inventions for sale on his website.
 - Did not use modern docket management system.
 - Attorney failed to file client's application, but posted the invention for sale on his website.
 - Attorney filed application 20 months after posting on the website.
- Aggravating factors included prior disciplinary history.
- Received two-year suspension.
- Rule highlights:
 - 37 C.F.R. § 10.23(a) – Disreputable or gross misconduct.
 - 37 C.F.R. § 11.18(b) – Certification upon filing of papers.
 - 37 C.F.R. § 10.77(c) – Neglect.

Neglect/Candor

In re Kroll, Proceeding No. D2014-14 (USPTO March 4, 2016).

- 37 C.F.R. § 11.18(b): By presenting to the Office...any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that—
 - (1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true...
 - (2) To the best of the party's knowledge, information and belief, **formed after an inquiry reasonable under the circumstances**,
 - (i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding before the Office;
 - (ii) The other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;
 - (iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and
 - (iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

“Nobody wants to read about the honest lawyer down the street who does real estate loans and wills. If you want to sell books, you have to write about the interesting – the guys who steal all the money and take off. That’s the fun stuff.”

- John Grisham

“I busted a mirror and got seven years bad luck, but my lawyer thinks he can get me five.”

“99% of lawyers give the rest a bad name.”

- Steven Wright

“Lawyers – a profession it is to disguise matters.”

- Sir Thomas More



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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.

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.

Deceit/Conduct Prejudicial to the Administration of Justice

In re Kroll, Proceeding No. D2016-23 (USPTO March 4, 2016).

- Patent attorney:
 - Offered money back guarantee to obtain patent for client's invention.
 - Amended claims during prosecution of 1st application to add specific features without authorization from client.
 - 1st application issues as a patent.
 - Filed 2nd application on another aspect of clients invention. Again offers money back guarantee.
 - The prior patent presented an obstacle to broad protection in the 2nd application.
 - Prior to filing 2nd application, attorney inserts additional features into specification without informing client.
 - During prosecution, the additional features are added to claims to overcome rejection using prior patent without client authorization.
 - On multiple occasions, attorney offered to pay – and did pay – client not to file an ethics grievance.
- Aggravating factors included prior disciplinary history.
- Excluded from practice.

Deceit/Conduct Prejudicial to the Administration of Justice

In re Kroll, Proceeding No. D2016-23 (USPTO March 4, 2016).

On the attempt to avoid ethical complaint via payment:

Respondent additionally violated his duty to the public, the legal system, and the legal profession by prejudicing the administration of justice through his efforts to conceal his client's grievances through quid pro quo arrangements. As noted above, his actions to avoid full restitution and to hide his malfeasance are contrary to the public's interest in promoting transparency regarding an attorney's professionalism; undermine the legal profession's ability to self-police its membership; and, frustrate the administration of justice by preventing the proper adjudication of ethical complaints.

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.

20 ways to be a good lawyer

1. Behave yourself.
2. Answer the phone.
3. Return your phone calls.
4. Pay your bills.
5. Keep your hands off your clients' money.
6. Tell the truth.
7. Admit ignorance.
8. Be honorable.
9. Defend the honor of your fellow attorneys.
10. Be gracious and thoughtful.
11. Value the time of your fellow attorneys.
12. Give straight answers.
13. Avoid the need to go to court.
14. Think first.
15. Remember: You are first a professional and then a businessman. If you seek riches, become a businessman and hire an attorney.
16. Remember: There is no such thing as billing 3,000 hours a year.
17. Tell your clients how to behave. If they can't, they don't deserve you as their attorney.
18. Solve problems - don't become one.
19. Have ideals you believe in.
20. Don't do anything you wouldn't be proud to tell your mother about.



For confidential assistance in
coping with professional stress or
burnout, contact MOLAP at
1-800-688-7859

Contacting OED

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

THANK YOU

