UNITED STATES PATENT AND TRADEMARK OFFICE



Professional responsibility and practice before the USPTO

Office of Enrollment and Discipline United States Patent and Trademark Office



What's happening at the USPTO and OED? Office of Enrollment and Discipline

Trademarks: local counsel rule

- Increase in foreign parties not authorized to represent trademark applicants improperly representing foreign applicants in Trademarks (TM) matters
- Fraudulent or inaccurate claims of use are burden on trademark system and the public and jeopardize validity of marks
- Effective August 3, 2019:
 - Foreign-domiciled trademark applicants, registrants, and parties to Trademark Trial and Appeal Board proceedings must be represented at the USPTO by an attorney who is licensed to practice law in the United States.
- Final rule: 84 Fed. Reg. 31498 (July 2, 2019)
- Canadian patent agents no longer able to represent Canadian parties in U.S. TM matters
- Canadian TM attorneys and agents will only be able to serve as additionally-appointed practitioners
 - Clients must appoint U.S.-licensed attorney to file formal responses
 - USPTO will only correspond with U.S.-licensed attorney



Proposed annual active patent practitioner fee

- Notice of Proposed Rulemaking (NPRM) issued July 31, 2019
 - 84 Fed. Reg. 37398
- No paper filing option
- Proposed effective date: January 1, 2022
- Voluntary CLE
 - Six hours of CLE every 24 months five hours patent law and practice and one hour ethics



Register of patent practitioners

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

uspto	About Us	Jobs	Contact Us
Office of Enrollment and Discipline			
USPTO Home > About Us > Organizational Offices > Office of the General Counsel > Office of Enrollment and Discipline (OED) > 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)

Pro Bono Programs

- USPTO 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
 - Limited recognition for participating students
 - <u>www.uspto.gov/lawschoolclinic</u>
- USPTO Patent Pro Bono Program
 - Independent regional programs located across the nation work to match financially underresourced inventors and small businesses with volunteer practitioners to file and prosecute patent applications
 - Inventors and interested attorneys can navigate the USPTO website to find links to their regional program: <u>www.uspto.gov/probonopatents</u>



Select OED regulations
Office of Enrollment and Discipline

OED: disciplinary jurisdiction

- Disciplinary jurisdiction of the office (37 C.F.R. § 11.19(a)) all practitioners:
 - Engaged in practice before the office
 - Administratively suspended
 - Registered to practice before the office in patent cases
 - Inactivated
 - Authorized under § 11.6(d) to take testimony
 - Transferred to disability inactive status, reprimanded, suspended, or excluded from the practice of law by a duly constituted authority, including by the USPTO director
- Practitioners who have resigned shall also be subject to such jurisdiction with respect to conduct undertaken prior to the resignation and conduct in regard to any practice before the office following the resignation (37 C.F.R. § 11.19(a)).
- A person not registered or recognized to practice before the office is also subject to the disciplinary authority of the office if the person provides or offers to provide any legal services before the office (37 C.F.R. § 11.19(a)).

OED: disciplinary jurisdiction

• **Practitioner** means:

- An attorney or agent registered to practice before the office in patent matters
- An individual authorized under 5 U.S.C. 500(b), or otherwise as provided by § 11.14(a), (b), and (c), to practice before the office in trademark matters or other non-patent matters
- An individual authorized to practice before the office in a patent case or matters under § 11.9(a) or (b)
- An individual authorized to practice before the office under § 11.16(d)
 (37 C.F.R. § 11.1)

Practice before the office

• Generally – 37 C.F.R. § 11.5(b):

- Includes, but is not limited to, law-related service that comprehends any matter connected with the presentation to the office or any of its officers or employees relating to a client's rights, privileges, duties, or responsibilities under the laws or regulations administered by the office for the grant of a patent or registration of a trademark, or for enrollment or disciplinary matters.
- Such presentations include preparing necessary documents in contemplation of filing the documents with the office, corresponding and communicating with the office, and representing a client through documents or at interviews, hearings, and meetings, as well as communicating with and advising a client concerning matters pending or contemplated to be presented before the office.
- Nothing in this section proscribes a practitioner from employing or retaining nonpractitioner assistants under the supervision of the practitioner to assist the practitioner in matters pending or contemplated to be presented before the office.

Practice before the office

- In patent matters 37 C.F.R. § 11.5(b)(1):
 - Preparing and prosecuting any patent application
 - Consulting with or giving advice to a client in contemplation of filing a patent application or other document with the office
 - Drafting the specification or claims of a patent application
 - Drafting an amendment or reply to a communication from the office that may require written argument to establish the patentability of a claimed invention
 - Drafting a reply to a communication from the office regarding a patent application
 - Drafting a communication for a public use, interference, reexamination proceeding, petition, appeal to or any other proceeding before the Patent Trial and Appeal Board, or other proceeding



Practice before the office

- In trademark matters 37 C.F.R. § 11.5(b)(2):
 - Consulting with or giving advice to a client in contemplation of filing a trademark application or other document with the office
 - Preparing and prosecuting an application for trademark registration
 - Preparing an amendment that may require written argument to establish the registrability of the mark
 - Conducting an opposition, cancellation, or concurrent use proceeding; or conducting an appeal to the Trademark Trial and Appeal Board
- See also 37 C.F.R. § 11.14:
 - Individuals who may practice before the office in trademark and other non-patent matters

OED discipline: grievances and complaints

- An investigation into 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).
- In the course of the investigation, the OED director may request information and evidence regarding possible grounds for discipline of a practitioner from:
 - The grievant
 - The practitioner
 - Any person who may reasonably be expected to provide information and evidence needed in connection with the grievance or investigation.

(37 C.F.R. § 11.22(f)(1))

OED discipline: grievances and complaints

- Upon the conclusion of an investigation, the OED director may:
 - Close the investigation without issuing a warning or taking disciplinary action
 - Issue a warning to the practitioner
 - Institute formal charges upon the approval of the Committee on Discipline
 - Enter into a settlement agreement with the practitioner and submit the same for approval of the USPTO director.

(37 C.F.R. § 11.22(h))

- 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).
- 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
 - 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



Ethics scenarios and select case law Office of Enrollment and Discipline

Conflicts of interest

- Perry, a partner at SmartFirm, PC represents Carl in the prosecution of a patent application for a ski binding that is easily movable from one ski to another.
- Brenda, another SmartFirm partner, takes over prosecution of a patent application for SkiCorp, for a ski binding that is movably attached to its corresponding ski for the purpose of cross country skiing.
- The claims of the SkiCorp patent, however, arguably read on the described subject matter and potential products from Carl's application.



Conflict of interest

- Maling v. Finnegan, 42 N.E. 3d 199 (Mass. 2015):
 - Civil suit against law firm who simultaneously represented clients in screwless eyeglass technology.
 - Plaintiff's work was done in firm's Boston office; second party's work was done in D.C. office.
 - Plaintiff alleged:
 - Firm belatedly commenced preparation patent application and
 - Plaintiff would not have made investment in developing his product if firm had disclosed its conflict and work on second party's patents.
 - Appellate court: subject matter conflicts do not, standing alone, constitute actionable conflict of interest that violates Mass. Rule of Professional Conduct 1.7 (Conflict of Interest).
 - Did not find that competing for patents in the same space placed clients directly adverse to one another.
 - Court discussed likelihood of interference as a barometer for conflict between two clients in same space.

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 that 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)

Patent agent privilege

- Onyx Therapeutics, Inc. v. Cipla Ltd. et. al., C.A. No. 16-988-LPS (consolidated), 2019 WL 668846 (D. Del. Feb. 15, 2019):
 - U.S. District Court found that a group of documents it inspected *in camera* would "almost certainly be within the scope of attorney-client privilege" but not be "protected by the narrower patent-agent privilege" because they were not "reasonably necessary and incident to" the ultimate patent prosecution.
 - Documents were communications between scientists referencing prior art found by an individual who performed a patent assessment at the direction of a patent agent.
 - Email discussion among the scientists was found to be not protected by the patent-agent privilege "because the assessment was done as part of a plan to develop new chemical formulations, not to seek patent protection for already-developed formulations."



Unauthorized Practice of Law (UPL)

• In re Campbell, Proceeding No. D2014-11 (USPTO Apr. 29, 2014):

- Patent agent represented a person in Colorado on matters involving DUI charges:
 - Attempted to claim he was "attorney in fact" for driver.
 - Identified himself as "an attorney in fact duly appointed, and licensed to practice Federal Law in the United States of America."
 - Arrest warrant was issued for driver for failure to appear.
 - Sued City of Colorado Springs in civil court on behalf of driver.
 - Identified himself before magistrate in civil suit as a "federal attorney" and provided his USPTO registration no. as his "federal attorney registration number."
 - Appeared on behalf of driver in license revocation hearing.
- Excluded from practice before the USPTO
- Rule highlights:
 - Dishonesty, fraud, deceit, or misrepresentation 37 C.F.R. §§ 10.23(b)(4)
 - Conduct prejudicial to the administration of justice 37 C.F.R. § 10.23(b)(5)
 - Holding oneself out to be an attorney or lawyer 37 C.F.R. § 10.31(d)(1)
 - Intentionally or habitually violating disciplinary rules 37 C.F.R. § 10.89(c)(6)











Trademark renewals

- Post Registration Proof of Use Audit Program
 - www.uspto.gov/trademarks-maintaining-trademark-registration/post-registration-audit-program
- Permanent audit program launched Nov. 1, 2017
- A registration may be audited if it meets both of these requirements:
 - A Section 8 or 71 declaration of use is filed.
 - The registration includes at least one class with four or more goods or services, or at least two classes with two or more goods or services.
- If audited, proof of use for additional goods/services in the registration will be required.
- 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:
 - All statements made therein of the party's own knowledge are true.
 - To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances ... (iii) [t]he 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) [t]he denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.



Misrepresentation/failure to supervise/UPL

• In re Swyers, Proceeding No. D2016-20 (USPTO Jan. 26, 2017):

- Disciplinary complaint alleged, inter alia:
 - TM attorney established The Trademark Company, PLLC.
 - Permitted non-attorneys to sign TM applications and practice TM law with little to no supervision.
 - Multiple fraudulent or digitally manipulated TM specimens were filed with USPTO.
 - Failed to deposit client advance funds into a client trust account.
 - Failed to cooperate with OED investigation.
- Exclusion on consent
- Rule highlights
 - 37 C.F.R. § 10.23(b)(5) Conduct prejudicial to the administration of justice
 - 37 C.F.R. § 10.23(c)(2)(ii) Giving false or misleading information to the office
 - 37 C.F.R. § 10.47(a) & (c) Aiding the unauthorized practice of law

Failure to supervise/UPL

• In re Crabtree, Proceeding Nos. D2018-31 & D2018-47 (USPTO Apr. 25, 2019):

- Disciplinary complaint alleged, *inter alia*:
 - Attorney was part-owner and general counsel of entity that provided TM-related services.
 - Beginning in 2017 until early 2018, non-practitioner employees used a cut-and-paste procedure to apply applicant signatures from application summaries into TM filings.
 - Non-practitioner employees expressly abandoned application (including client signature) without applicant knowledge.
 - Non-practitioner employees would offer suggestions to customers relating to class, specimen acceptability, and description.
 - After disclosure to and agreement by applicant, company retained \$50 filing fee difference for TEAS Plus applications.
 - Company did not maintain escrow accounts for applicants' fees or USPTO filing fees.
- Exclusion on consent
- Rule highlights:
 - 37 C.F.R. § 11.101 Competence
 - 37 C.F.R. §§ 11.115(a) & (c) Safekeeping property
 - 37 C.F.R. § 11.303(a)(1) Candor toward tribunal
 - 37 C.F.R. § 11.503 Responsibilities regarding non-practitioner assistance
 - 37 C.F.R. § 11.505 Aiding UPL



Misrepresentation/UPL

- In re Chow, Proceeding No. D2018-27 (USPTO April 30, 2019):
 - Patent agent was sole registered practitioner for company that provided patent services to clients.
 - Patent agent's son operated a second company that provided client referrals.
 - Between August 2012 and December 2017, agent's customer number was associated with 6,760 patent applications (~105/month, ~five/work day).
 - Non-practitioner employees of son's company drafted patentability opinions and patent applications and routinely communicated with clients, all with little to no supervision from patent agent.
 - Clients paid son's company, who would allegedly pass funds along to patent agent. No disclosure to client of payment arrangement.
 - No disclosure to client regarding large referral relationship between companies.
 - Settlement: three-year suspension
 - Rule highlights:
 - Conduct prejudicial to the administration of justice: 37 C.F.R. §§ 10.23(b)(5) & 11.804(d)
 - Aiding UPL: 37 C.F.R. §§ 10.47(a),(c) & 11.505
 - Conflicts: 37 C.F.R. §§ 10.62(a), 10.68(a)(1), 11.107(a)(2), & 11.108(f)



Neglect/candor

- In re Kroll, Proceeding No. D2014-14 (USPTO March 4, 2016):
 - Patent attorney
 - Routinely offered (and charged \$) to post client inventions for sale on his website.
 - Did not use modern docket management system.
 - Failed to file client's application but posted the invention for sale on his website.
 - 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 submitting of papers
 - 37 C.F.R. § 10.77(c) Neglect



Deceit/conduct prejudicial

• In re Kroll, Proceeding No. D2016-23 (USPTO Dec. 11, 2017):

- Patent attorney
 - Offered money-back guarantee to obtain patent for client's invention.
 - Amended claims during prosecution of first application to add specific features without authorization from client.
 - First application issued as a patent.
 - Filed second application on another aspect of client's invention, and again offered money-back guarantee.
 - The prior patent presented an obstacle to broad protection in the second application.
 - Prior to filing second application, attorney inserted additional features into specification without informing client.
 - During prosecution, the additional features were 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
- Rule highlights:
 - 37 C.F.R. § 10.23(c)(2)(i) Giving false or misleading information to a client in connection with USPTO business
 - 37 C.F.R. §§ 10.23(b)(5) & 11.804(d) Conduct prejudicial to the administration of justice

Decisions imposing public discipline available in "FOIA Reading Room"

- <u>https://foiadocuments.uspto.gov/oed/</u>
- Official Gazette for Patents
 - <u>www.uspto.gov/news/og/patent_og/index.jsp</u>
 - Select a published issue from the list, and click on the "Notices" link in the menu on the left side of the webpage.





Thank you!

OED

571-272-4097 www.uspto.gov

UNITED STATES PATENT AND TRADEMARK OFFICE



An overview of the Patent Pro Bono Program Office of Enrollment and Discipline Patent Pro Bono Team

UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Pro Bono Program (PPBP)

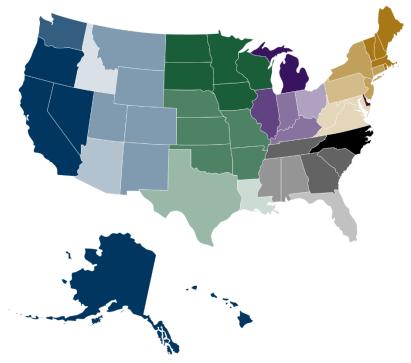
- Assists financially under-resourced independent inventors and small businesses
 - Section 32 of AIA The USPTO Director shall work with and support intellectual property law associations across the country in the establishment of pro bono programs designed to assist financially under-resourced independent inventors and small businesses
 - The USPTO 2019 2022 Strategic Plan calls for the USPTO to enhance "the assistance we provide to independent inventors and small businesses"
- Regional programs work to match financially under-resourced inventors and small businesses with volunteer practitioners to prepare, file, and prosecute patent applications



Regional patent pro bono programs

- 22 regional programs across the country provide matching services
- Each regional program covers one or more states
- Regional programs are independent of the USPTO and are operated by
 - Nonprofit organizations that focus on intellectual property
 - Universities
 - Bar associations
- Regional programs follow general guidelines but set their own policies and procedures
- Regional programs ensure that applicants qualify for patent pro bono assistance by screening for
 - Income
 - Knowledge of the patent system
 - An actual invention (more than an idea)

Current nationwide coverage



- Washington Pro Bono Patent Network
- Idaho Patent Pro Bono
- CLA
- ProBoPat
- Arizona Public Patent Program
- LegalCorps (MN)
- Pro Bono Patent Project (MI)

- Gateway Venture Mentoring Service
- TALA
- The Ella Project
- Chicago-Kent Patent Hub PatentConnect for Hoosiers (IN KY)
 - Ohio Invents
 - BBVLP Patent Program (MS AL)
 - New England Program

- New York Tri State Program
- Delaware Program
- FCBA (Mid-Atlantic)
- PA Patent
- NC Leap
- Georgia Patents
- Patent Pro Bono FL



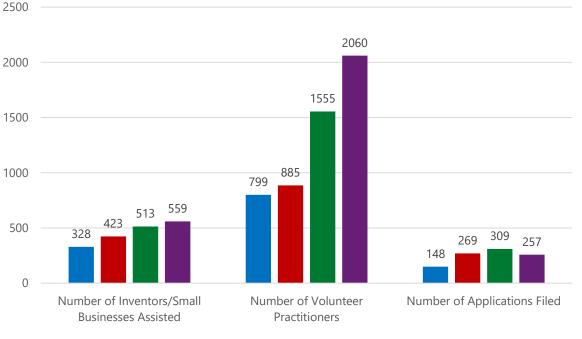


Inventor requirements

- Gross household income regional program dependent, but usually no more than 300% of the federal poverty guidelines (<u>https://aspe.hhs.gov/poverty-guidelines</u>)
 - A single person could have an income of up to \$37,470
 - The limit increases with additional dependents
- Have a provisional application on file and/or complete a certificate training course
 - <u>www.uspto.gov/video/cbt/certpck/index.htm</u> (also available in Spanish)
- Pay all USPTO fees (micro entity status provides for a 75% reduction)
 - Some regional programs also charge an application fee between \$25-\$150
- Apply directly to regional program



PPBP growth



■ 2015 **■** 2016 **■** 2017 **■** 2018



Patent practitioners are the linchpin

- More than 2,000 practitioners have signed on to volunteer
 - Need outpaces supply
 - Unlike other forms of pro bono representation, only registered practitioners can represent financially under-resourced inventors to prepare, file, and prosecute patent applications before the USPTO
- Improved patent quality
 - A pro se inventor is now represented
 - The inventor is educated about the patent system
 - Professional advice may help the inventor make better decisions
 - "No" may be what the inventor needs to hear

- Practitioner benefits
 - Inventors may become paying clients
 - State bars increasingly are offering continuing legal education credit for pro bono service
 - USPTO certificate for those who provide 50+ hours of patent pro bono service in calendar year
 - Contact your regional program for more information



Practitioner recognition

- The USPTO issues certificates to registered patent practitioners who provide 50+ hours of patent pro bono service in a calendar year
- Patent practitioner name, firm, and regional program are posted on the USPTO website
- Signed by the Commissioner for Patents and the Director for the Office of Enrollment and Discipline
- The USPTO has recognized over 160 patent practitioners





Law firm/corporation recognition

- The USPTO recognizes law firms and corporations that support the PPBP
- Certificates awarded annually based on cumulative hours/firm and firm size
- Recipient names are posted on the USPTO website
- The USPTO recognized over 20 firms/corporations in 2018



Pro bono certification form

- Practitioner voluntarily certifies filing as pro bono
- Form uploaded by practitioner and included as part of the Image File Wrapper
- Enables the USPTO to track the impact of the PPBP

CERTIFICATION OF PRO BONO REPRESENTATION (Page 1 of 1)								
First Named Inventor				cation Serial er (if known)				
Title of Invention								
THE UNDERSIGNED ATTORNEY HEREBY VOLUNTARILY CERTIFIES THE FOLLOWING:								
Signature			Date					
Name (Print/Type	id)			Practitioner Registration Number				
<u>Note</u> : This form must be signed in accordance with 37 CFR 1.33. Please see 37 CFR 1.4(d) for signature requirements and certifications. Submit multiple forms if more than one signature is required and indicate below the total number of forms submitted.*								
Total of forms are submitted.								

uspto

www.uspto.gov/sites/default/files/documents/aia0440.pdf

Patent pro bono graphic









Malpractice Insurance Availability

Malpractice Insurance	States
Arts and Business Council of Greater Boston	Massachusetts, Vermont, New Hampshire, Rhode Island and Maine
Arts and Business Council of Miami	Florida
California Lawyers for the Arts	California, Nevada, Hawaii, Alaska, and Oregon
Center for Intellectual Property Research	Indiana and Kentucky
Delaware Law School	Delaware
Georgia Lawyers for the Arts	Georgia, South Carolina, and Tennessee
Idaho Patent Pro Bono	Idaho
LegalCORPS	Minnesota, Wisconsin, Iowa, North Dakota, and South Dakota
Mi Casa Resource Center	Colorado, New Mexico, Montana, and Wyoming
New York Volunteer Lawyers for the Arts	New York, New Jersey, and Connecticut
North Carolina Bar Association	North Carolina
Ohio Invents	Ohio
Texas Accountants and Lawyers for the Arts	Texas

How to volunteer

1. Be a registered patent practitioner with the USPTO in good standing

 Practitioners who are attorneys must also be in good standing in any state(s) in which they are licensed to practice law

2. In general, have at least 3 years experience prosecuting applications

- If not, consider teaming up with another practitioner
- Requirement may vary with your regional program

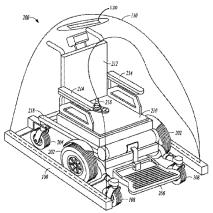
3. Volunteer

 Select your state from the U.S. map at <u>www.uspto.gov/probonopatents</u> and follow the instructions on your regional program's website

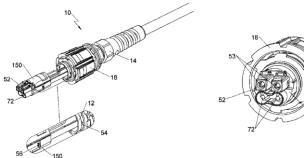


Success stories

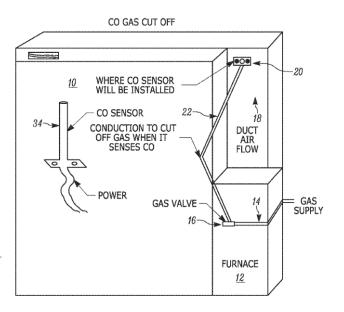
Wheelchair Protector US 9,943,455



Optical Fiber Connector US 10,396,512



Carbon Monoxide Detector US 10,101,027





More information

- Visit <u>www.uspto.gov/probonopatents</u>
- Email probono@uspto.gov



