

UNITED STATES
PATENT AND TRADEMARK OFFICE



Professional responsibility and practice before the USPTO

Office of Enrollment and Discipline
(OED)



UNITED STATES
PATENT AND TRADEMARK OFFICE ®

OED: enrollment

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

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



Design Patent Practitioner Bar

- On November 16, 2023, the USPTO published a final rule establishing new technical criteria for applicants that wish to practice design patent work only.
- The final rule expanded the technical criteria to now *also* include a bachelor's, master's or doctorate of philosophy degree in industrial design, product design, architecture, applied arts, graphic design, fine/studio arts, art teacher education, or a degree equivalent to one of the listed degrees. The application process began January 2, 2024.
- Once scientific and technical criteria are met, design patent practitioner applicants must take and pass the current registration examination and pass a moral character evaluation.
- Upon registration, design patent practitioners may practice in design patent matters only.
 - If an applicant or registered practitioner meets the scientific and technical criteria to sit for admission to the registration examination (Category A, B, & C; see Bulletin for Admission to the Examination for Registration to practice in Patent Cases Before the USPTO here https://www.uspto.gov/sites/default/files/documents/OED_GRB.pdf), then they can also practice design patent matters.
- Additional information about becoming a design patent practitioner may be found at: <https://www.uspto.gov/sites/default/files/documents/OEDDesignBarFlyer.pdf>.



Practice before the USPTO and Artificial Intelligence (AI)

- On April 11, 2024, the USPTO issued a Federal Register notice, [Guidance on Use of Artificial Intelligence-Based Tools in Practice Before the United States Patent and Trademark Office](https://www.federalregister.gov/documents/2024/04/11/2024-07629/guidance-on-use-of-artificial-intelligence-based-tools-in-practice-before-the-united-states-patent-and-trademark-office). See <https://www.federalregister.gov/documents/2024/04/11/2024-07629/guidance-on-use-of-artificial-intelligence-based-tools-in-practice-before-the-united-states-patent>.
- When practicing before the USPTO, practitioners' use of AI may implicate ethical considerations.
- 37 C.F.R. § 11.18 imposes duties on parties and practitioners in connection with submissions before the USPTO, including the practitioner's signature pursuant to 37 C.F.R. §§ 1.4(d)(1), 2.193.
- 37 C.F.R. § 11.18(b), in part, stipulates that parties presenting papers to the Office make a certification, formed after a reasonable inquiry, as to evidentiary support for factual contentions and allegations.
- See <https://www.uspto.gov/initiatives/artificial-intelligence/artificial-intelligence-resources>.



Practice before the USPTO

- Activities that constitute practice before the USPTO are broadly defined in 37 C.F.R. §§ 11.5(b) and 11.14:
 - Includes communicating with and advising a client concerning matters pending or contemplated to be presented before the USPTO (37 C.F.R. § 11.5(b));
 - Consulting with or giving advice to a client in contemplation of filing a **patent application** or other document with the USPTO (37 C.F.R. § 11.5(b)(1)); or
 - Consulting with or giving advice to a client in contemplation of filing a **trademark application** or other document with the USPTO (37 C.F.R. § 11.5(b)(2)).
 - Nothing in this section (37 C.F.R. § 11.5(b)) proscribes a practitioner from employing or retaining non-practitioner assistants under the supervision of the practitioner to assist the practitioner in matters pending or contemplated to be presented before the USPTO.
 - *See also* 37 C.F.R. § 11.14 for details regarding individuals who may practice before the USPTO in trademark and other non-patent matters.



OED: discipline

- Mission: protect the public and the integrity of the patent and trademark systems.
- Statutory authority:
 - 35 U.S.C. §§ 2(b)(2)(D) and 32.
- Disciplinary jurisdiction (37 C.F.R. § 11.19):
 - All practitioners engaged in practice before the USPTO, e.g., TM, pro hac vice in PTAB, Those representing others in OED proceedings, etc.; and
 - Non-practitioners who engage in or offer to engage in practice before the USPTO.
- Governing regulations:
 - USPTO Rules of Professional Conduct 37 C.F.R. §§ 11.101–11.901; and
 - Procedural rules: 37 C.F.R. §§ 11.19–11.60.



Investigation and formal complaint process

- OED investigation begins with receipt of a grievance by the OED Director.
 - Grievance: a written submission from any source received by the OED Director that presents possible grounds for discipline of a specified practitioner. See 37 C.F.R. § 11.1.
 - Self-reporting is often considered as a mitigating factor in the disciplinary process.
- Time period for filing formal complaint = 1 year from receipt of grievance but not later than 10 years from date of misconduct.
 - See 35 U.S.C. § 32 and 37 C.F.R. § 11.34(d).
- After investigation, the OED Director may:
 - Terminate an investigation with no action;
 - Issue a warning to the practitioner;
 - Institute formal charges with the approval of the Committee on Discipline; or
 - Enter into a settlement agreement with the practitioner and submit the same to the USPTO Director for approval.

37 C.F.R. § 11.22(h).



USPTO disciplinary proceedings

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

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



OED: other functions

- Pro Bono programs:
 - Law School Clinic Certification Program; and
 - Patent Pro Bono Program.
- Outreach:
 - Speaking engagements: continuing legal education, roundtables/panels, diversion, pro bono, recent rulemaking, etc.

Warnings – 37 C.F.R. § 11.21

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

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

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

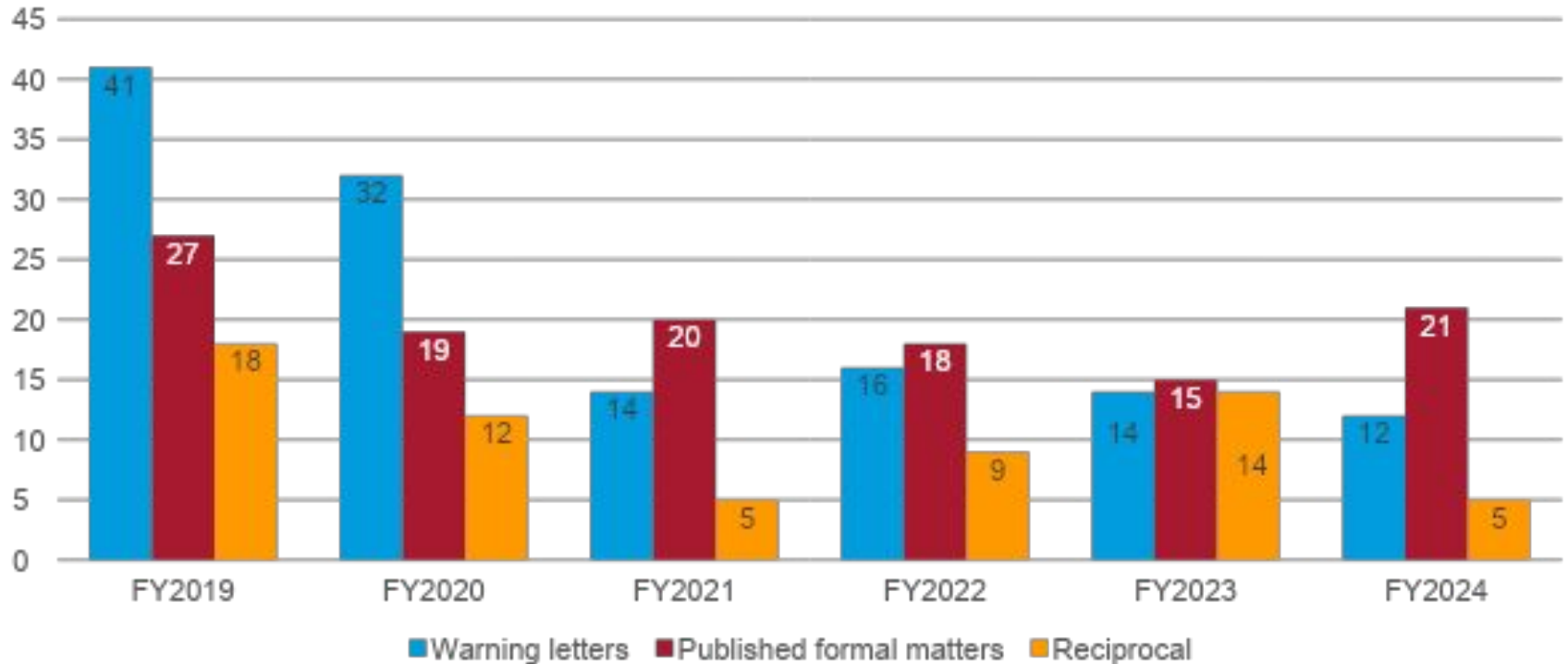
- Exclusion from practice before the USPTO
 - minimum of five years. *See* 37 C.F.R. § 11.60(b)
 - reinstatement only upon grant of petition. *See* 37 C.F.R. §§ 11.58(a), 11.60(a)
- Suspension from practice before the USPTO for an appropriate period
 - reinstatement only upon grant of petition upon expiration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



Other types of discipline

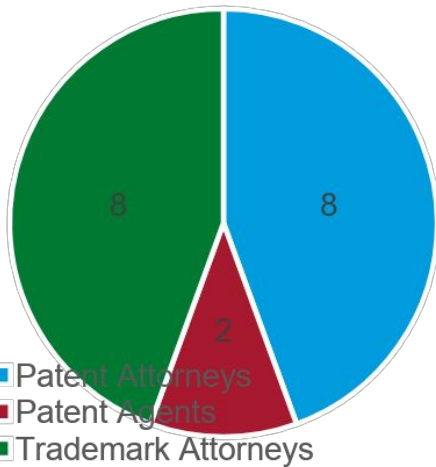
- Reciprocal discipline (37 C.F.R. § 11.24):
 - Based on discipline by a state or federal program or agency, and
 - Often conducted on documentary record only
- Interim suspension based on conviction of a serious crime (37 C.F.R. § 11.25):
 - Referred to a hearing officer for determination of final disciplinary action
- Exclusion on Consent (37 C.F.R. § 11.27)

USPTO disciplinary matters

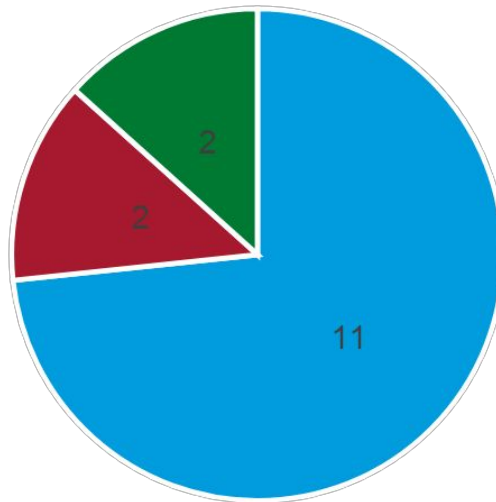


USPTO disciplinary matters

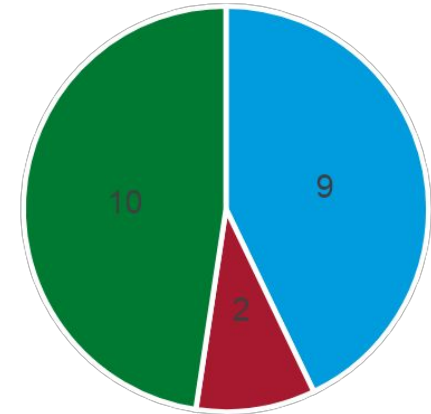
FY 2022



FY 2023



FY 2024



OED

Ethics scenarios and select case law

OED: Examples of misconduct

- Neglect of client matters;
- Failure to communicate with the client;
- Lying to the client;
- Lack of candor to the USPTO;
- Conflicts of interest;
- Unauthorized practice of law;
- Duty of disclosure, candor and good faith; and
- Fee and trust account issues.



Neglect/candor

In re Kroll, Proceeding No. D2014-14 (USPTO Mar. 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;
 - Failed to file client's application, but posted the invention for sale on his website; and
 - 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; and
 - 37 C.F.R. § 10.77(c) – Neglect.





Conflicts between clients

Conflict of interest

- *In re Radanovic*, Proceeding No. D2014-29 (USPTO December 16, 2014)
 - Patent attorney:
 - Represented two joint inventors of patent application.
 - No written agreement regarding representation.
 - Attorney became aware of a dispute where one inventor alleged that the other did not contribute to the allowed claims.
 - Continued to represent both inventors.
 - Expressly abandoned application naming both inventors in favor of continuation naming one.
 - Mitigating factors included clean 50-year disciplinary history.
 - Received public reprimand.

Conduct Prejudicial to the Administration of Justice

In re Jie Yang, Proceeding No. D2024-04 (USPTO Feb 2, 2024)

- Registered patent agent was practitioner of record in approximately 4000 patent applications, many of which contained false assertions of micro-entity status under 37 C.F.R. 1.29(a)(2).
- Yang's electronic signature had been entered on filings without her knowledge or consent:
 - Yang entered into professional association with nonpractitioner.
 - Yang was unaware of filings prepared by nonpractitioner, did not review or file the documents, and had no contact with the applicants.
 - Nonpractitioner gained access to practitioner's USPTO.gov account, directed all notices to his own email, and changed the password to the account.



Conduct Prejudicial to the Administration of Justice, *cont'd*

– Applicable regulations:

- A patent document must be signed by the named signatory per 37 C.F.R. 1.4(d)(4)(ii).
- A party presenting or signing a paper to the USPTO represents that all statements are true per the certification requirements of 37 C.F.R. 11.18. A certification violation in a paper filed with the USPTO “may jeopardize the probative value” of the filing. 37 C.F.R. 11.18(b)(1).
- 11.804(d) prohibits conduct prejudicial to the administration of justice.

– Mitigating factors:

- Practitioner cooperated fully with OED and had no prior discipline.
- Practitioner notified the affected applicants or their representatives of these acts.

– Sanction and Outcome:

- Practitioner received public reprimand and 12 months’ probation
- Final order terminating proceedings in approximately 3100 applications with fraudulent signatures (*In re Application of [Redacted], et al.*, Final Order and Imposition of Sanctions, Oct. 1, 2024)



U.S. Counsel Rule and Limited Recognition

In re Weitao Chen, Proceeding No. 2024-21 (USPTO Sept 11, 2024)

- Mr. Chen's representation of foreign-domiciled trademark applicants:
 - U.S.-licensed attorney, engaged by foreign entities to serve as the practitioner of record in approximately 7,100 trademark applications filed on behalf of foreign applicants.
 - 3,777 trademark applications contained falsified handwritten signatures.
 - Numerous applications contained falsified specimens that did not show actual use in commerce.
- Mr. Chen's employment and application for limited recognition:
 - Separately, Mr. Chen entered into an employment agreement with a family and immigration law firm. The firm did not employ any registered patent practitioners.
 - The firm applied for a U.S. visa to employ Chen on a part-time basis, working on trademark and patent matters.
 - Based on his employment with the firm, Mr. Chen applied for limited recognition to represent others in patent matters before the USPTO.
 - Mr. Chen updated his law firm's website to advertise and offer patent legal services, and eventually filed 175 patent applications with the USPTO.
 - In his application for limited recognition, Mr. Chen falsely stated that the firm employed a registered patent practitioner who served as the attorney of record in the applications.



U.S. Counsel Rule and Limited Recognition, *cont'd*

- Applicable rules and violations:
 - The U.S. Counsel Rule: Effective August 3, 2019, foreign-domiciled trademark applicants must be represented before the USPTO by a U.S.-licensed attorney (84 Fed. Reg. 31498).
 - 37 CFR 11.18 provides that a party who signs or presents a paper to the USPTO represents that all statements are true based upon inquiry reasonable under the circumstances.
 - 37 CFR 11.101 and 11.103: Mr. Chen failed to provide competent representation and act with due diligence vis-à-vis applicant signatures, dates of use in commerce, and specimens.
 - 37 CFR 11.303, 11.801(a), 11.804(c) and 11.804(d): Mr. Chen made false statements to a tribunal, engaged in dishonesty, and engaged in conduct prejudicial to the administration of justice by submitting trademark filings with falsified signatures and specimens and by submitting false information in support of his application for limited recognition.
 - 37 CFR 11.505: Mr. Chen engaged in unauthorized practice of law by representing patent applicants before the USPTO when he was not registered.
- Sanction:
 - Mr. Chen was suspended from practice before the USPTO for 36 months, with 24 months of probation after any reinstatement.
 - Mr. Chen's pending application for registration was deemed withdrawn.





Patent agent privilege

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 would 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 not to be 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 number 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)



Inequitable conduct

In the Matter of Robert 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.
 - First requirement is to expressly advise the USPTO of existence of misrepresentation, stating specifically where it resides.



Inequitable conduct

In the Matter of Robert Tendler, Proceeding No. D2013-17 (USPTO Jan. 8, 2014), cont'd

- Second requirement is that the USPTO be advised of misrepresented facts, making it clear that further examination may be required if USPTO 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.
- Settlement: Four-year suspension (eligible for reinstatement after two years).



Candor toward tribunal

In the Matter of James Hicks, Proceeding No. D2013-11 (USPTO Sept. 10, 2013)

- Attorney sanctioned by EDNY for non-compliance with discovery orders.
- Federal Circuit affirmed sanction and found appellate brief to contain “misleading or improper” statements.
 - Brief reads, “Both the Magistrate and the District Court Found that RTI's and its Litigation Counsel Hicks' Pre-Filing Investigation Was Sufficient.” However, neither the magistrate judge nor the district court ultimately found that RTI's or Mr. Hicks's pre-filing investigation was “sufficient.”
 - Mr. Hicks also failed to inform the court that a case citation was non-precedential and therefore unavailable to support his legal contentions aside from “claim preclusion, issue preclusion, judicial estoppel, law of the case, and the like.”
 - *Rates Technology, Inc. v Mediatix Telecom, Inc.*, 688 F.3d 742 (Fed. Cir. 2012).
- Settlement: public reprimand and one-year probation.



Signatures on patent documents

- 37 C.F.R. § 1.4(d)(1) Handwritten signature.
 - “Each piece of correspondence, except as provided in paragraphs (d)(2), (d)(3), (d)(4), and (f) of this section, filed in an application, patent file, or other proceeding in the Office which requires a person's signature, must:
 - (i) Be an original, that is, have an original handwritten signature **personally signed**, in permanent dark ink or its equivalent, **by that person**; or
 - (ii) Be a direct or indirect copy, such as a photocopy or facsimile transmission (§1.6(d)), of an original. In the event that a copy of the original is filed, the original should be retained as evidence of authenticity. If a question of authenticity arises, the Office may require submission of the original.

Fees and trust account issues

- *In the Matter of Everitt Beers, Proceeding No. D2016-8* (USPTO June 10, 2016)
 - Registered patent attorney:
 - Client hired Respondent to file eight TM applications.
 - Respondent billed for and received \$2,600 advanced costs as filing fees.
 - Respondent failed to deposit any of the \$2,600 in a trust account.
 - Respondent then billed and received \$5,005 advanced fees to prepare and file eight TM applications, neither of which he did.
 - Respondent then sent a list of work purportedly performed – eight fictitious TM applications.
 - Converted all advanced costs and fees for his own use and failed to deposit unearned legal fees and USPTO fees in a trust account.
 - Mitigating factors included no prior disciplinary history during 12 years of practice.
 - Suspended for four months.



Dealings with foreign entities

- *In the Matter of Tung-Yun McNally, Proceeding No. D2023-22* (USPTO April 7, 2023)
 - Registered patent agent:
 - Submitted more than 688 design patent applications on behalf of applicants between Aug 2019 and Sept 2021.
 - USPTO issued a Notice of Payment Deficiency for 21 of these applications where Respondent signed, executed and submitted a Certification of Micro Entity Status.
 - Respondent signed certifications based upon representations made to her by a foreign associate for the applicants.
 - Except for one application, Respondent claimed she was not aware of the Notices of Deficiency, changes in certifications, or the payment of the deficiency amounts until she received communication from OED.



Dealings with foreign entities, *cont'd*

- Respondent relied upon the foreign associate's representations, with whom Respondent's law firm had an existing relationship.
 - No firm procedures or guidelines were in place to personally verify the underlying basis for Certification of Micro Entity status.
- Mitigating factors:
- Respondent *sua sponte* investigated at least one filing made prior to receiving any communication from OED.
 - Worked with firm and foreign associate to implement new procedures for micro entity status certification and adopted law firm protocols to verify an applicant's claim of micro entity status.
 - No prior discipline and cooperation with OED's investigation.
- Reprimanded.

Decisions imposing public discipline available in “FOIA Reading Room”

- foiadocuments.uspto.gov/oed/
- Official Gazette for Trademarks:
 - www.uspto.gov/learning-and-resources/official-gazette/trademark-official-gazette-tmog



Thank you!

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