

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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# Office of Enrollment and Discipline

## 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 non-practitioner 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, and
  - 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 which may require written argument to establish the registrability of the mark and
  - 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



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Title search: Professional responsibility and practice before the USPTO

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First appeared as part of the conference materials for the 15<sup>th</sup> Annual Advanced Patent Law Institute session

"Ethics Issues Facing USPTO Practitioners: A View from the Inside"