Communication before the USPTO

Practical Guidance for Patent and Trademark Practitioners

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About Us

Ira Domnitz

Education:
Boston University School of Law, JD, May 2000

University of Wisconsin-Milwaukee, Dec. 1995

Admissions:
U.S. Patent and Trademark Office – Patent Attorney
Texas Bar – 2002
Massachusetts Bar – 2001
United States Federal District Courts of Texas
        - Northern, Southern, and Eastern
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Matthew Juren

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University of Houston Law Center, JD, May 2008

University of Houston-Clear Lake, BS Computer Systems Engineering, Dec. 2004

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Topics

- Duties and Candor
  - Where do they come from?
  - What do they cover?

- How do we communicate with the USPTO?
  - Written
  - Oral

- Who do we communicate with at the USPTO?
  - Staff
  - Examiners
  - Supervisors
  - Board (TTAB/PTAB)
  - Office of Enrollment and Discipline

General Duties and Candor

ABA Model Rules of Professional Conduct

State Rules and Regulations

USPTO Rules of Professional Conduct, *see* 37 C.F.R. §§11.101-11.901

Other USPTO Regulations and Sources
- 37 C.F.R. §1.56
- 37 C.F.R. §42.11
- Manual of Patent Examining Procedure
- Trademark Manual of Examining Procedure
- Trademark Trial and Appeal Board Manual of Procedure
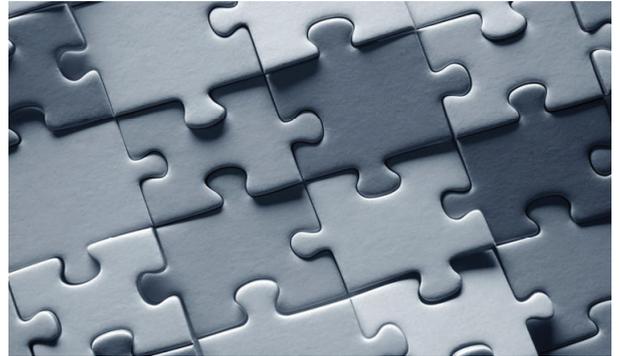- Office Patent Trial Practice Guide

Duties and Candor

Candor toward the tribunal
◦ ABA Model Rules of Professional Conduct 3.3
◦ Texas Disciplinary Rules of Professional Conduct 3.03
◦ USPTO Rules of Professional Conduct §11.303

Notice a pattern?

Duties and Candor – ABA

Rule 3.3: Candor Toward the Tribunal
Advocate

(a) A lawyer shall not knowingly:

(1) make a false statement of fact or law to a tribunal or fail to correct a false statement of material fact or law previously made to the tribunal by the lawyer;

(2) fail to disclose to the tribunal legal authority in the controlling jurisdiction known to the lawyer to be directly adverse to the position of the client and not disclosed by opposing counsel; or

(3) offer evidence that the lawyer knows to be false. If a lawyer, the lawyer's client, or a witness called by the lawyer, has offered material evidence and the lawyer comes to know of its falsity, the lawyer shall take reasonable remedial measures, including, if necessary, disclosure to the tribunal. A lawyer may refuse to offer evidence, other than the testimony of a defendant in a criminal matter, that the lawyer reasonably believes is false.

(b) A lawyer who represents a client in an adjudicative proceeding and who knows that a person intends to engage, is engaging or has engaged in criminal or fraudulent conduct related to the proceeding shall take reasonable remedial measures, including, if necessary, disclosure to the tribunal.

(c) The duties stated in paragraphs (a) and (b) continue to the conclusion of the proceeding, and apply even if compliance requires disclosure of information otherwise protected by Rule 1.6.

(d) In an ex parte proceeding, a lawyer shall inform the tribunal of all material facts known to the lawyer that will enable the tribunal to make an informed decision, whether or not the facts are adverse.

Title search: Communication before the USPTO

Also available as part of the eCourse
Communication before the USPTO

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