

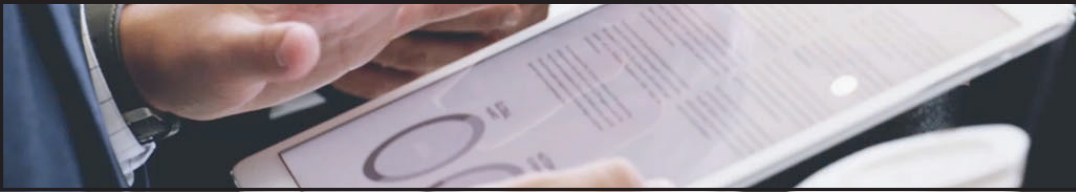
Ethics Issues Facing USPTO Practitioners

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Presented by:
Emil J. Ali
McCabe & Ali LLP

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Objectives

- ▶ Understanding how to implement the requirements under 11.18, including when dealing with foreign intermediaries
- ▶ Understanding who can sign filings with the USPTO
- ▶ Best practices in protecting your clients (and your license)
- ▶ Other recent issues applicable to patent prosecutors



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Hypothetical

- Independent Inventor hires you to file a utility patent application.
- After drafting the application and preparing it for filing, you explain the different entity sizes, and they explain that they are a Micro Entity.
- Who must sign a Micro Entity Certification?
- What question do we ask Independent Inventor prior to filing?
- Must we request any documents or proof from the Independent Inventor?



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OED Final Order

- Practitioner signed and filed Certification of Micro Entity Status
- USPTO claimed the application filing limit was exceeded and issued Notices of Additional Fees Due
- Practitioner later changed the entity designation and paid the fees
- Reprimanded for violations of 11.103 (diligence); 11.804 (conduct prejudicial to administration of justice)
- *In re Chew*, Proceeding No. D2023-08 (January 20, 2023).



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Hypothetical

- Shenzhen IP Services contacts you to file 100 trademark applications and five IPRs before the USPTO on behalf of their clients.
- They provide you with everything you need to file—all you do is review and sign—even the identity of the real party in interest and the proof of use/specimens are ready to go.
- Who is the client?
- What steps should we take prior to signing and filing?
- What steps should we take after filing?



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Hypothetical (continued)

- You ask foreign associate questions regarding the use in commerce of certain marks, as well as the relationship of certain parties for the petition you are filing (IPR). Essentially, you want to confirm facts that don't appear to be supported.
- Minutes later, at what is the middle of the night in China, you get a response from the foreign associate that their client confirmed the facts.



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