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OED AND USPTO DISCIPLINE

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Introduction

35 U.S.C. § 2(b)(2)(D) authorizes that the U.S. Patent and Trademark Office (hereinafter the “USPTO” or the “Office”) “may establish regulations, not inconsistent with the law, which ... may govern the ... conduct of agents, attorneys, or other persons representing applicants or other parties before the Patent and Trademark Office”¹ These rules are set forth in subpart D of Part 11 of Title 37 of the Code of Federal Regulations and are entitled “USPTO Rules of Professional Conduct.”

35 U.S.C. § 32 provides, in part, that “The Director [the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (hereinafter “the Director of the USPTO”)] may, after notice and opportunity for a hearing, suspend or exclude, either generally or in a particular case, from further practice before the Patent and Trademark Office, any person, agent or attorney shown to be incompetent or disreputable, or guilty of gross misconduct, or who does not comply with the regulations established under section 2(b)(2)(D), or who shall, by word, circular, letter, or advertising, with intent to defraud in any manner, deceive, mislead, or threaten any applicant or prospective applicant, or other person having immediate or prospective business before the [USPTO].”

The USPTO Rules of Professional Conduct govern solely the practice of patent, trademark and other law before the USPTO. The Rules do not preempt the authority of each State to regulate the practice of law within its jurisdiction, except to the extent necessary for the USPTO to accomplish its federal objectives.² The Rules of Professional Conduct apply to attorneys and agents practicing before the USPTO in patent cases as well as to attorneys and grandfathered patent agents³ practicing before the Trademark Office. The Rules are not limited to only registered patent agents⁴ or attorneys practicing before the office. They also apply to any person (attorney or agent) representing persons before the USPTO in non-patent and non-trademark cases.

¹ Under 35 U.S.C. § 2(b)(2), the USPTO may establish regulations, not inconsistent with the law. The enforcement of this power is vested in the Director of the USPTO. 35 U.S.C. § 3(a)(1).

² 37 C.F.R. § 11.1. See the preamble to the definitions.

³ Under 37 C.F.R. § 11.14(b), “individuals not attorneys who were recognized to practice before the Office in trademark matters ... prior to January 1, 1957, will be recognized as agents to continue practice before the Office in trademark matters.”

⁴ Patent agents are entitled to engage in the practice law to prepare and prosecute patent applications for others before the USPTO by virtue of the powers delegated to the Director of the USPTO under 35 U.S.C. § 2(b)(2)(D). *Sperry v. Florida ex rel. Florida Bar*, 373 U.S. 379 (1963).

Establishment of the Office of Enrollment and Discipline and USPTO Disciplinary Rules

The Office of Enrollment and Discipline (hereinafter “OED”) was established in 1984. OED serves two functions: (i) to register persons who meet the requirements to practice before the USPTO in patent cases and (ii) to investigate grievances alleging unethical conduct by practitioners.⁵ Prior to 1984, OED functions were performed by the Office of the Solicitor and before that, by the Patent Office Committee on Enrollment and Discipline.

On March 8, 1985, the USPTO implemented its first set of disciplinary rules, the USPTO Code of Professional Responsibility. Prior to that date, there were no disciplinary rules. The Office relied on ABA published ethics rules. The USPTO rules were set forth in Part 10 of 37 C.F.R. §§ 10.20 through 10.112. The disciplinary rules, for the most part, were taken word for word from the 1980 American Bar Association Model Code. At the time the USPTO Code was adopted, most states were abandoning the 1980 ABA Model Code and adopting the 1984 ABA Model Rules.

It was not until May 3, 2013 that the USPTO adopted and implemented its Rules of Professional Conduct patterned after the ABA Model Rules. The USPTO Model Rules are set forth in 37 C.F.R. §§ 11.101 to 11.804. While the USPTO has indicated that Part 10 of 37 C.F.R. is now “Reserved”, OED still reviews conduct under the old rules of the PTO Code of Professional Responsibility, 37 C.F.R. §§ 10.20 to 10.112, for alleged unethical conduct prior to implementing the new Model Rules.

OED was established with limited resources and no formal rules for conducting investigations or for handling administrative suspensions, reciprocal disciplines, and disabilities. For a number of years resources were limited. In or about 1998, OED staffing was increased to handle pending investigations for alleged ethical misconduct. In 2004, rules specific to the conduct of investigations were implemented.⁶ At about the same time, the conversion to electronic application files enhanced OED’s ability to quickly review files (patent and trademark) and representation data. Also, electronic docket systems used by courts provided means to obtain documents without having to rely on litigating parties to provide copies of documents. In addition to electronic filing systems, OED has always found the internet to be a useful source for obtaining information in investigations. From 1985 to 1998, there were an average of 3 or 4 disciplines per fiscal year.⁷ In 1999, the average number disciplines per fiscal year from 1999 to 2005 increased to 12. Beginning in fiscal year 2006,

⁵ 37 C.F.R. § 11.1 defines “Practitioner” to mean “(1) An attorney or agent registered to practice before the Office in patent matters; (2) An individual authorized under 5 U.S.C. § 500(b), or otherwise as provided by [37 C.F.R.] § 11.14(a), (b), and (c), to practice before the Office in trademark matters or other non-patent matters; (3) An individual authorized to practice before the Office in a patent case or matters under [37 C.F.R.] § 11.9(a) or (b) [limited recognition]; or (4) An individual authorized to practice before the Office under [37 C.F.R.] § 11.16(d) [USPTO Law School Clinic Certification Program].”

⁶ 37 C.F.R. §§ 11.20 to 11.29.

⁷ The USPTO fiscal year begins on October 1 and ends on September 30 the following year.

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