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The background of this slide is a light gray technical drawing of a mechanical part, possibly a gear or a component of a machine. The drawing is composed of various lines, curves, and hatching patterns. Several numbers are scattered across the drawing, including 80, 84, 86, 82, 24, 30, 86, 52, 50, and 50. The drawing is centered on a white background that is framed by dark blue borders at the top and bottom.

**An overview of the  
Patent Pro Bono Program**

Office of Enrollment and Discipline  
United States Patent and Trademark Office

The USPTO logo is located in the bottom right corner of the slide. It is a smaller version of the logo seen in the first slide, featuring the text "UNITED STATES PATENT AND TRADEMARK OFFICE" above a white rounded rectangle with "uspto" in lowercase dark blue letters.

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## Patent Pro Bono Program (PPBP)

- Assists financially under-resourced independent inventors and small businesses
  - Section 32 of the Leahy-Smith America Invents Act – The USPTO Director shall work with and support intellectual property law associations across the country in the establishment of pro bono programs designed to assist financially under-resourced independent inventors and small businesses
  - The USPTO 2019 – 2022 Strategic Plan calls for the USPTO to enhance “the assistance we provide to independent inventors and small businesses”
- Regional programs work to match financially under-resourced inventors and small businesses with volunteer practitioners to prepare, file, and prosecute patent applications



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## Regional patent pro bono programs

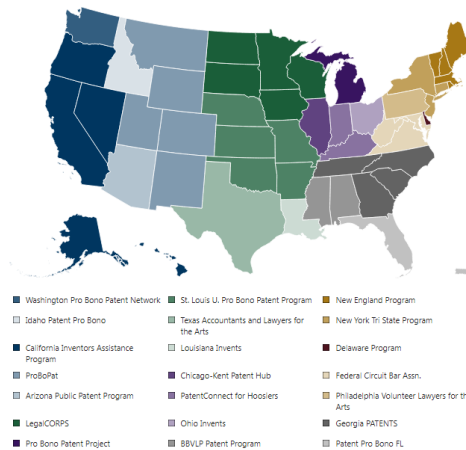
- 21 regional programs across the country provide matching services
- Each regional program covers one or more states
- Regional programs are independent of the USPTO and are operated by
  - Nonprofit organizations that focus on intellectual property
  - Universities
  - Bar associations
- Regional programs follow general guidelines but set their own policies and procedures
- Regional programs ensure that applicants qualify for patent pro bono assistance by screening for
  - Income (less than 3X the poverty guidelines)
    - Regional programs are independent of the USPTO and may vary the guidelines
  - Have a provisional application on file and/or have completed a certificate training course
    - <http://www.uspto.gov/video/cbt/certpck/index.htm> (also available in Spanish)
  - An actual invention (more than an idea)



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## Current nationwide coverage



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## Inventor requirements

- Gross household income – regional program dependent, but usually no more than 300% of the federal poverty guidelines (<https://aspe.hhs.gov/poverty-guidelines>)
  - A single person could have an income of up to \$38,280
  - The limit increases with additional dependents
- Have a provisional application on file and/or complete a certificate training course
  - [www.uspto.gov/video/cbt/certpck/index.htm](http://www.uspto.gov/video/cbt/certpck/index.htm) (also available in Spanish)
- Pay all USPTO fees (micro entity status provides for a 75% reduction)
  - Some regional programs also charge an application fee between \$25-\$150
- Apply directly to regional program (preferred) or through national clearinghouse
  - <http://fedcirbar.org/Pro-Bono-Scholarships/PTO-Pro-Bono/National-Clearinghouse-Application-Submission>

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## Patent practitioners are the linchpin

- More than 1,800 practitioners have signed on to volunteer
  - Need outpaces supply
  - Unlike other forms of pro bono representation, only registered practitioners can represent financially under-resourced inventors to prepare, file, and prosecute patent applications before the USPTO
- Improved patent quality
  - A pro se inventor is now represented
  - The inventor is educated about the patent system
  - Professional advice may help the inventor make better decisions
    - “No” may be what the inventor needs to hear
- Practitioner benefits
  - Patent practitioners can volunteer in their area of expertise
  - State bars increasingly are offering continuing legal education credit for pro bono service
  - Creates a path for inventors to become job creator
  - Inventors may become paying clients



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## Practitioner recognition

- The USPTO issues certificates to registered patent practitioners who provide 50+ hours of patent pro bono service in a calendar year
- Patent practitioner name, firm, and regional program are posted on the USPTO website
- Signed by the Commissioner for Patents and the Director for the Office of Enrollment and Discipline
- The USPTO has issued over 250 certificates to patent practitioners



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## Law firm/corporation recognition

- The USPTO recognizes law firms and corporations that support the PPBP
- Certificates awarded annually based on cumulative hours/firm and firm size
- Recipient names are posted on the USPTO website
- The USPTO recognized over 28 firms/corporations in 2020



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## Pro bono certification form

- Practitioner voluntarily certifies filing as pro bono
- Form uploaded by practitioner and included as part of the Image File Wrapper
- Enables the USPTO to track the impact of the PPBP

CERTIFICATION OF PRO BONO REPRESENTATION (Page 1 of 1)			
First Named Inventor			Application Serial Number (if known)
Title of Invention			
THE UNDERSIGNED ATTORNEY HEREBY VOLUNTARILY CERTIFIES THE FOLLOWING:			
<input type="checkbox"/> I am submitting a filing for the above-identified application pro bono.			
Signature			Date
Name (Print/Typed)			Practitioner Registration Number
<small><b>Note:</b> This form must be signed in accordance with 37 CFR 1.33. Please see 37 CFR 1.416 for signature requirements and certifications. Submit multiple forms if more than one signature is required and indicate below the total number of forms submitted.</small>			
<input type="checkbox"/> *Total of _____ forms are submitted.			

[www.uspto.gov/sites/default/files/documents/aia0440.pdf](http://www.uspto.gov/sites/default/files/documents/aia0440.pdf)



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## Patent pro bono graphic



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## How to volunteer

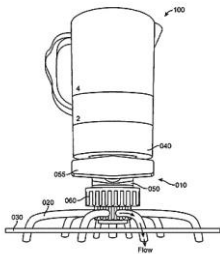
1. Be a registered patent practitioner with the USPTO in good standing
  - Practitioners who are attorneys must also be in good standing in any state(s) in which they are licensed to practice law
2. In general, have at least three years experience prosecuting applications
  - If not, consider teaming up with another practitioner
  - Requirement may vary with your regional program
3. Volunteer
  - Select your state from the U.S. map at [www.uspto.gov/probonopatents](http://www.uspto.gov/probonopatents) and follow the instructions on your regional program's website

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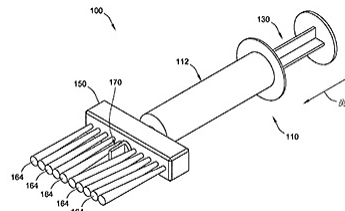
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## Success stories

Beverage Distributor for  
Party Games  
US 10,273,136



Hair Product Applicators  
and Methods of Using the  
Same US 10,104,948



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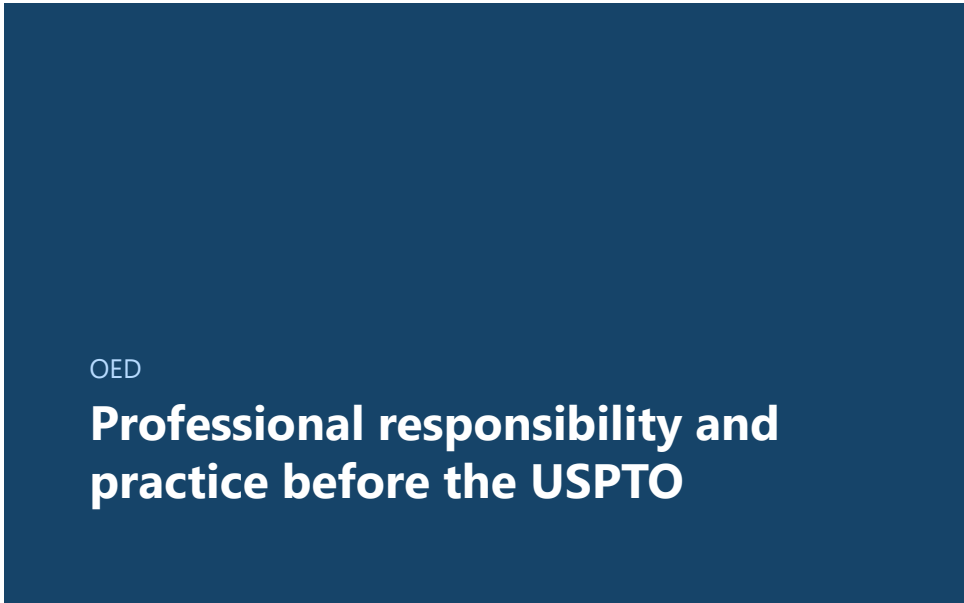
## More information

- Visit [www.uspto.gov/probonopatents](http://www.uspto.gov/probonopatents)
- Email [probono@uspto.gov](mailto:probono@uspto.gov)
- OED Phone 571-272-4097

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# Register of patent practitioners

[oedci.uspto.gov/OEDCI/](https://oedci.uspto.gov/OEDCI/)

**Patent Practitioner Home Page**  
Attorneys and agents authorized to practice in patent matters before the United States Patent and Trademark Office (USPTO)

<p><b>Find a patent agent or attorney</b></p> <p>Currently, there are 12898 active agents and 36889 active attorneys. All searches reflect current information available to OED.</p>	<p><b>Download practitioner roster</b></p> <p>The listings contain contact information for attorneys and agents authorized to practice before the U.S. Patent and Trademark Office. The roster file is updated nightly.</p>	<p><b>Apply to practice in patent matters before the USPTO</b></p> <p>Start an application, complete a draft application, view the status of an application, or submit supplemental information to an existing application. A USPTO.gov account is required.</p> <p><a href="#">Start or edit your application</a></p>		
<p><b>Practitioner disciplinary history</b></p> <p>This listing includes information about practitioners who have been publicly disciplined by the USPTO since 1997.</p>	<p><b>Get help</b></p> <p>Resource for tips, troubleshooting, and guides on how to get the most out of our website.</p>	<p><b>Registered practitioner sign in</b></p> <p>Sign in with your OED account credentials.</p> <p>User ID (Not Reg #): <input type="text"/></p> <p>Password: <input type="password"/></p> <p><a href="#">Forgot User ID or Password?</a></p> <p><input type="checkbox"/> I'm not a robot </p> <p><a href="#">Sign in</a></p> <p>Need an user ID? Contact the Office of Enrollment and Discipline at 571-272-4887.</p> <p><a href="#">By signing in, I agree to the USPTO's Terms of Use and USPTO Privacy Policy.</a></p>		
<p><b>Becoming a practitioner</b></p> <p>Learn about applying for registration to practice in patent matters before the USPTO, including requirements, forms, and exam information.</p>	<p><b>OED FAQs</b></p> <p>Find answers and general information about OED.</p>			
<p><b>Contact us</b></p> <p>For assistance please contact the <a href="#">Office of Enrollment and Discipline</a></p> <table border="0"> <tr> <td> <p>Phone: 571-272-4397 Fax: 571-272-6024 Email: <a href="mailto:OED@uspto.gov">OED@uspto.gov</a></p> </td> <td> <p>Mailing Address: Mail Stop OED U.S. Patent and Trademark Office PO Box 1400 Alexandria, VA 22313-1400</p> </td> </tr> </table>			<p>Phone: 571-272-4397 Fax: 571-272-6024 Email: <a href="mailto:OED@uspto.gov">OED@uspto.gov</a></p>	<p>Mailing Address: Mail Stop OED U.S. Patent and Trademark Office PO Box 1400 Alexandria, VA 22313-1400</p>
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## Registration statement/CLE

- Final rule published August 3, 2020: 85 FR 46932
  - Proposed guidelines published October 9, 2020: 85 FR 64128
- Biennial registration statement replaces survey of registered practitioners
  - No active patent practitioner fee
  - Registered practitioners will be required to file a registration statement with OED biennially.
    - See 37 C.F.R. § 11.11(a)(2)
  - Notice will be provided 120 days in advance of due date. Anticipated implementation November 2024.
- Voluntary certification of CLE
  - See 37 C.F.R. § 11.11(a)(3)
  - Recognition of CLE completion in online practitioner directory
  - Certification of six credits of CLE within preceding 24 months: 5 credits in patent law and practice, 1 credit in ethics



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## OED Diversion Pilot Program

- In 2016, the ABA Commission on Lawyer Assistance Programs and the Hazelden Betty Ford Foundation published a study of about 13,000 currently practicing attorneys and found the following:
  - About 21% qualify as problem drinkers
  - 28% struggle with some level of depression
  - 19% struggle with anxiety
  - 23% struggle with stress
- Other difficulties include social alienation, work addiction, sleep deprivation, job dissatisfaction, and complaints of work-life conflict
- In 2017, the USPTO launched the Diversion Pilot Program



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## OED Diversion Pilot Program – criteria

- Willingness and ability to participate in the program
- No public discipline by the USPTO or another jurisdiction in the past three years, unless the discipline is based on the same conduct as the conduct that is the basis for the investigation.
- Misconduct at issue must not:
  - Involve misappropriation of funds or dishonesty, fraud, deceit, or misrepresentation
  - Result in or be likely to result in substantial prejudice to a client or other person
  - Constitute a “serious crime” (see 37 C.F.R. § 11.1)
  - Be part of a pattern of similar misconduct or be of the same nature as misconduct for which practitioner has been disciplined within the past five years, unless the misconduct is minor and related to a chronic health condition or disease.



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## Law School Clinic Certification Program

- Allows students in a participating law school’s clinic program to practice before the USPTO under the strict guidance of a Law School Faculty Clinic Supervisor.
- The OED Director grants participating law students limited recognition to practice before the USPTO.
- Signed into law on December 16, 2014.
- 60 law schools actively participate:
  - 24 trademark only,
  - 6 patent only,
  - 30 both.
- Program enrollment: Currently accepting applications from law school clinics through December 31, 2022.



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## Trademarks: U.S. counsel rule

- Increase in foreign parties not authorized to represent trademark applicants improperly representing foreign applicants in trademark (TM) matters
- Fraudulent or inaccurate claims of use are a burden on the trademark system and the public and jeopardize validity of marks
- Effective August 3, 2019:
  - Foreign-domiciled trademark applicants, registrants, and parties to Trademark Trial and Appeal Board proceedings must be represented at the USPTO by an attorney who is licensed to practice law in the United States.
- Final rule: 84 Fed. Reg. 31498 (July 2, 2019)



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## Trademarks: U.S. counsel rule

Dear,

I would like to rent a U.S. lawyer's license or get granted to use your U.S. attorney licensed information. At same time, I pay you yearly fee.

If you are interested in it and want to discuss more, you can contact me.

.....

Regards,  
Francis



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Select OED regulations

## Office of Enrollment and Discipline (OED)

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## Practice before the office

- Activities that constitute practice before the USPTO are broadly defined in 37 C.F.R. §§ 11.5(b) & 11.14:
  - Includes communicating with and advising a client concerning matters pending or contemplated to be presented before the office (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 office (37 C.F.R. § 11.5(b)(1))
  - Consulting with or giving advice to a client in contemplation of filing a trademark application or other document with the office (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 office
  - *See also* 37 C.F.R. § 11.14 for details regarding individuals who may practice before the office in trademark and other non-patent matters



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## OED discipline: grievances and complaints

- An investigation into possible grounds for discipline may be initiated by the receipt of a grievance (see 37 C.F.R. § 11.22(a))
- Grievance: “a written submission from any source received by the OED Director that presents possible grounds for discipline of a specified practitioner” (37 C.F.R. § 11.1)
- In the course of the investigation, the OED Director may request information and evidence regarding possible grounds for discipline of a practitioner from:
  - i. The grievant
  - ii. The practitioner, or
  - iii. Any person who may reasonably be expected to provide information and evidence needed in connection with the grievance or investigation

(37 C.F.R. § 11.22(f)(1))



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## OED discipline: grievances and complaints

- Upon the conclusion of an investigation, the OED Director may:
  - Close the investigation without issuing a warning or taking disciplinary action
  - Issue a warning to the practitioner
  - Institute formal charges upon the approval of the Committee on Discipline, or
  - Enter into a settlement agreement with the practitioner and submit the same for approval of the USPTO Director.

(37 C.F.R. § 11.22(h))
- Self-reporting is often considered as a mitigating factor in the disciplinary process.



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## Other types of discipline

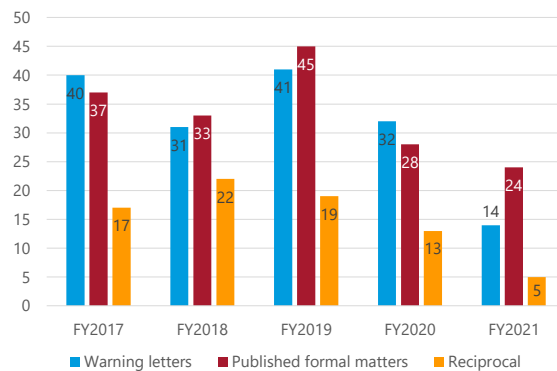
- Reciprocal discipline (37 C.F.R. § 11.24)
  - Based on discipline by a state or federal program or agency
  - Often conducted on documentary record only
- Interim suspension based on conviction of a serious crime (37 C.F.R. § 11.25)
  - Referred to a hearing officer for determination of final disciplinary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

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## USPTO disciplinary matters

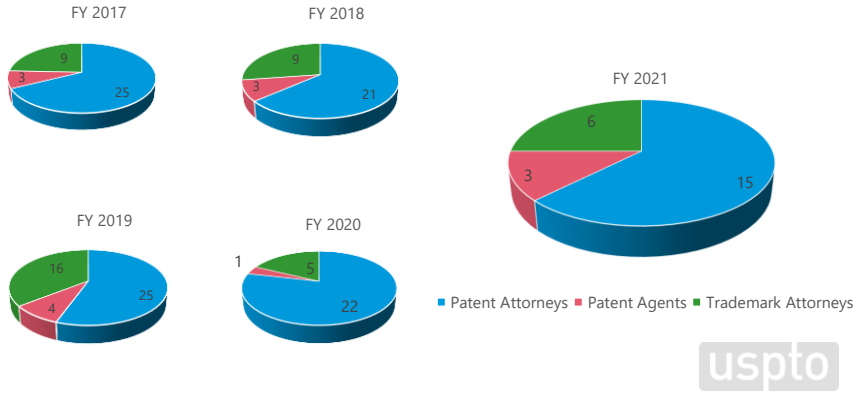


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# USPTO disciplinary matters



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Office of Enrollment and Discipline

## Ethics scenarios and select case law

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## 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)



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## 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 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"



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## 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 no. 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)



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## Misrepresentation/UPL

- ***In re Chow***, Proceeding No. D2018-27 (USPTO April 30, 2019):
  - Patent agent was sole registered practitioner for company that provided patent services to clients.
    - Patent agent’s son operated a second company that provided client referrals.
    - Between August 2012 and December 2017, agent’s customer number was associated with 6,760 patent applications (~105/month, ~5/work day).
    - Non-practitioner employees of son’s company drafted patentability opinions and patent applications and routinely communicated with clients, all with little to no supervision from patent agent.
    - Clients paid son’s company, who would allegedly pass funds along to patent agent. No disclosure to client of payment arrangement.
    - No disclosure to client regarding large referral relationship between companies.
  - Settlement: three-year suspension
  - Rule highlights:
    - Conduct prejudicial to the administration of justice: 37 C.F.R. §§ 10.23(b)(5) & 11.804(d)
    - Aiding UPL: 37 C.F.R. §§ 10.47(a),(c) & 11.505
    - Conflicts: 37 C.F.R. §§ 10.62(a), 10.68(a)(1), 11.107(a)(2), & 11.108(f)



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## Jurisdiction/UPL

- *In re Achterhof*, Proceeding No. D2017-24 (USPTO Nov. 18, 2019)
  - Wyoming licensed attorney/not registered to practice before the USPTO in patent matters
    - Consulted with and advised inventors, prepared and drafted provisional and non-provisional patent applications, and drafted responses to Office actions (applicants signed documents; non-practitioner filed documents).
    - Informed a client that it was not necessary that he be registered with the USPTO as long as he did not appear before the USPTO on client's behalf.
    - Argued that USPTO did not have jurisdiction because he was not a registered patent practitioner, he did not represent patent applicants before the office, and he only assisted pro se applicants who were representing themselves.
  - “[U]nregistered practitioners are subject to the disciplinary jurisdiction of the office if they provide or offer to provide any legal services before the office.”
  - Suspension for 18 months
  - Rule highlights:
    - 37 C.F.R. § 11.19(a) - Jurisdiction
    - 37 C.F.R. §§ 11.505 and 11.116(a)(1) - Unauthorized practice of law
    - 37 C.F.R. §§ 10.23(b)(5) and 11.804(d) - Conduct prejudicial to the administration of justice
    - 37 C.F.R. § 11.701 - False and misleading communications regarding a practitioner's service



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## Conflicts of interest/client communication

- *In re Starkweather*, Proceeding No. D2018-44 (USPTO Oct. 17, 2019)
  - Practitioner received voluminous referrals from marketing company
    - Did not obtain informed consent from clients in light of this arrangement
    - Took direction regarding applications from company
    - When company operations were shut down and payments stopped, practitioner halted client work, including completed applications
    - Signed clients' names on USPTO documents
  - Settlement: three-year suspension, MPRE, 12 hours of ethics CLE
  - Rule highlights:
    - Competence: 37 C.F.R. § 11.101
    - Abiding by client's decisions: 37 C.F.R. § 11.102
    - Diligence: 37 C.F.R. § 11.103
    - Client communication: 37 C.F.R. § 11.104
    - Conflicts: 37 C.F.R. § 11.107
    - False statements to a tribunal: 37 C.F.R. § 11.303
    - Taking direction from 3<sup>rd</sup> party payer: 37 C.F.R. § 11.504(c)



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## Conflict of Interest

### 37 C.F.R. § 11.107

(a) Except as provided in paragraph (b) of this section, a practitioner shall not represent a client if the representation involves a concurrent conflict of interest. A concurrent conflict of interest exists if:

- (1) The representation of one client will be directly adverse to another client; or
- (2) There is a significant risk that the representation of one or more clients will be materially limited by the practitioner's responsibilities to another client, a former client or a third person or by a personal interest of the practitioner.

(b) Notwithstanding the existence of a concurrent conflict of interest under paragraph (a) of this section, a practitioner may represent a client if:

- (1) The practitioner reasonably believes that the practitioner will be able to provide competent and diligent representation to each affected client;
- (2) The representation is not prohibited by law;
- (3) The representation does not involve the assertion of a claim by one client against another client represented by the practitioner in the same litigation or other proceeding before a tribunal; and
- (4) Each affected client gives **informed consent**, confirmed in writing.



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## Conflict of Interest

### 37 C.F.R. § 11.108(f)

A practitioner shall not accept compensation for representing a client from one other than the client unless:

- (1) The client gives **informed consent**;
- (2) There is no interference with the practitioner's **independence of professional judgment** or with the client-practitioner relationship; and
- (3) Information relating to representation of a client is protected as required by §11.106.

### 37 C.F.R. § 11.504(c)

A practitioner shall not permit a person who recommends, employs, or pays the practitioner to render legal services for another to direct or regulate the practitioner's **professional judgment** in rendering such legal services.



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## Conflicts of interest/client communication

- ***In re Starkweather*** - For signing client's name on documents filed with the USPTO:
  - 37 C.F.R. § 11.101 Competence
    - "A practitioner shall provide competent representation to a client. Competent representation requires the legal, scientific, and technical knowledge, skill, thoroughness and preparation reasonably necessary for the representation."
  - 37 C.F.R. § 11.102(a) Scope of representation and allocation of authority between client and practitioner
  - 37 C.F.R. § 11.303 Candor toward the tribunal
    - "(a) A practitioner 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 practitioner;
      - \*\*\*\*\*
      - (3) Offer evidence that the practitioner knows to be false. If a practitioner, the practitioner's client, or a witness called by the practitioner, has offered material evidence and the practitioner comes to know of its falsity, the practitioner shall take reasonable remedial measures, including, if necessary, disclosure to the tribunal.
      - \*\*\*\*\*
    - (d) In an ex parte proceeding, a practitioner shall inform the tribunal of all material facts known to the practitioner that will enable the tribunal to make an informed decision, whether or not the facts are adverse."
  - 37 C.F.R. § 11.804(c) Misconduct: Dishonesty, fraud, deceit, misrepresentation
  - 37 C.F.R. § 11.804(d) Misconduct: Conduct prejudicial to the administration of justice



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## 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), (e), 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.
- 37 C.F.R. § 1.4(d)(2) S-signature.
  - "(i)...the person signing the correspondence must insert his or her own S-signature..."
- 37 C.F.R. § 1.4(d)(4)(ii) Certification as to the signature.
  - "The person inserting a signature under paragraph (d)(2) or (d)(3) of this section in a document submitted to the Office certifies that the inserted signature appearing in the document is his or her own signature."



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## Signatures on patent documents

- MPEP § 502.02
  - (I) Handwritten signature: “The word original, as used herein, is defined as correspondence which is personally signed in permanent dark ink or its equivalent by the person whose signature appears thereon.”
  - (II) S-Signature:
    - “The person signing the correspondence must insert his or her own S-signature...”
    - “The ‘must insert his or her own signature’ requirement is met by the signer directly typing his or her own signature using a keyboard. **The requirement does not permit one person (e.g., a secretary) to type in the signature of a second person (e.g., a practitioner) even if the second person directs the first person to do so.**”

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## Signatures on trademark documents

- 37 C.F.R. § 2.193 Trademark correspondence and signature requirements
  - “(a)...Each piece of correspondence that requires a signature must bear:
    - (1) A handwritten signature **personally** signed in permanent ink by the person named as the signatory, or a true copy thereof; or
    - (2) An electronic signature that meets the requirements of paragraph (c) of this section, **personally entered by the person named as the signatory**...

\*\*\*\*\*
  - (c) Requirements for electronic signature. A person signing a document electronically must:
    - (1) **Personally enter** any combination of letters, numbers, spaces and/or punctuation marks that the signer has adopted as a signature, placed between two forward slash (“/”) symbols in the signature block on the electronic submission; or
    - (2) Sign the document using some other form of electronic signature specified by the Director.

\*\*\*\*\*
  - (f) Signature as certification. The presentation to the Office (whether by signing, filing, submitting, or later advocating) of any document by any person, whether a practitioner or non-practitioner, constitutes a certification under §11.18(b) of this chapter. **Violations of §11.18(b) of this chapter may jeopardize the validity of the application or registration, and may result in the imposition of sanctions under §11.18(c) of this chapter.** Any practitioner violating §11.18(b) of this chapter may also be subject to disciplinary action. See §11.18(d) and §11.804 of this chapter.



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## Signatures on trademark documents

- TMEP § 611.01(c) Requirements for signature
  - “All documents must be personally signed.  
37 C.F.R. §§2.193(a)(1), (c)(1), 11.18(a). The person(s) identified as the signatory must manually enter the elements of the electronic signature. Another person (e.g., paralegal, legal assistant, or secretary) may not sign the name of a qualified practitioner or other authorized signatory. *See In re Dermahose Inc.*, 82 USPQ2d 1793 (TTAB 2007) ; *In re Cowan*, 18 USPQ2d 1407 (Comm’r Pats. 1990). Just as signing the name of another person on paper does not serve as the signature of the person whose name is written, typing the electronic signature of another person is not a valid signature by that person.”



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## Misrepresentation/failure to supervise/UPL

### *In re Swyers*, Proceeding No. D2016-20 (USPTO Jan. 26, 2017)

- Disciplinary complaint alleged, *inter alia*:
  - TM attorney established The Trademark Company, PLLC.
  - Permitted non-attorneys to sign TM applications and practice TM law with little to no supervision.
  - Multiple fraudulent or digitally manipulated TM specimens were filed with the USPTO.
  - Failed to deposit client advance funds into a client trust account.
  - Failed to cooperate with OED investigation.
- Exclusion on consent.
- Rule highlights:
  - 37 C.F.R. § 10.23(b)(5) – Conduct prejudicial to the administration of justice
  - 37 C.F.R. § 10.23(c)(2)(ii) – Giving false or misleading information to the office
  - 37 C.F.R. § 10.47(a) & (c) – Aiding the unauthorized practice of law



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## Improper signatures/failure to supervise

### *In re Sapp*, Proceeding No. D2019-31 (USPTO May 15, 2019)

- Trademark (TM) attorney was attorney of record or responsible attorney for numerous trademark applications for law firm.
  - Had TM documents filed with USPTO where non-practitioner assistants signed the documents instead of the named signatory.
  - Did not take reasonable steps to learn whether non-practitioner assistants were obtaining signatures properly.
  - After learning of impermissible signatures, did not notify clients of improper signatures or potential consequences.
  - After learning of impermissible signatures (including on declaration relied upon by TM examiners), did not notify the USPTO.
- Mitigating factors:
  - Fourteen-year practice with no prior disciplinary history.
  - Acknowledged ethical lapses and understands seriousness of submitting impermissible signatures to USPTO.
  - Cooperated with OED investigation.
  - Upon learning of impermissible signatures, retrained practitioners and non-practitioner assistants to ensure future compliance.
- Settlement: public reprimand and one-year probation.
- Rule highlights:
  - 37 C.F.R. § 11.101 – Competence
  - 37 C.F.R. § 11.103 – Diligence
  - 37 C.F.R. § 11.503 – Responsibilities regarding non-practitioner assistance
  - 37 C.F.R. § 11.104(a) & (b) – Client communication
  - 37 C.F.R. § 11.303 – Candor toward tribunal
  - 37 C.F.R. §§ 11.804(c) (misrepresentation) and (d) (conduct prejudicial to the administration of justice)



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## Improper signatures/communication

### *In re Lou*, Proceeding No. D2021-04 (USPTO May 12, 2021)

- Trademark Attorney had business relationship with foreign company that provided IP services to merchants.
- Over the course of their relationship, attorney reviewed up to 500 applications per month and received over \$10,000 in compensation.
- As of Oct. 12, 2020, all of the attorney's TM cases were received from the foreign company.
- Attorney impermissibly gave a company employee authorization to enter his electronic signature in the applications and attendant declarations.
  - Did not subsequently inform applicants that their applications were impermissibly signed.
- Provided the foreign company's email address as correspondence address in applications.
  - Did not monitor the email address; relied on the foreign company to provide him with updates on USPTO correspondence.
- Did not conduct conflicts checks for clients received from the foreign company.
- Settlement: three-month suspension
- Rule highlights:
  - 37 C.F.R. § 11.101 – Competence
  - 37 C.F.R. §§ 11.104(a) & (b) – Client communications
  - 37 C.F.R. §§ 11.303(a)(1), (a)(2), (b) & (d) – Candor toward tribunal
  - 37 C.F.R. § 11.503(b) – Responsibilities regarding non-practitioner assistance
  - 37 C.F.R. § 11.505 – Aiding UPL



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## Competence, informed consent, dishonesty

### *In re Caraco*, Proceeding No. D2019-50 (USPTO Sept. 12, 2019)

- TM attorney:
  - Worked with a reciprocally-recognized Canadian practitioner to represent clients located in Canada before the USPTO in trademark matters.
  - Reviewed TM applications and related documents prior to filing, but never consulted or spoke with clients.
  - Allowed Canadian practitioner and her non-practitioner assistants to enter his signature on TM filings.
  - Failed to notify any of the TM clients that he failed to personally sign any of the declarations in TM filings or any of the potential adverse consequences.
  - Failed to notify trademark operations at USPTO of the impermissible signatures.
  - Excluded.
- Rule highlights:
  - 37 C.F.R. § 11.303(a)(1) - False statements of fact or law to the USPTO.
  - 37 C.F.R. § 11.303(a)(3) - Requiring a practitioner to take reasonable remedial measures if practitioner becomes aware of falsity of material evidence.



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## Disreputable or Gross Misconduct

***In re Schroeder***, Proceeding No. D2014-08 (USPTO May 18, 2015).

- Patent Attorney:
  - Submitted unprofessional remarks in two separate Office action responses.
  - Remarks were ultimately stricken from application files pursuant to 37 C.F.R. § 11.18(c)(1).
  - Order noted that behavior was outside of the ordinary standard of professional obligation and client's interests.
  - Aggravating factor: has not accepted responsibility or shown remorse for remarks.
- Default: 6-month suspension.
- Rule highlights:
  - 37 C.F.R. § 10.23(a) – Disreputable or gross misconduct.
  - 37 C.F.R. § 10.89(c)(5) – Discourteous conduct before the Office.
  - 37 C.F.R. § 10.23(b)(5) – Conduct prejudicial to the administration of justice.
  - 37 C.F.R. § 11.18 – Certification upon filing of papers.

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## Decisions imposing public discipline available in “FOIA Reading Room”

- [foiadocuments.uspto.gov/oed/](https://foiadocuments.uspto.gov/oed/)
- Official Gazette for Patents
  - [www.uspto.gov/news/og/patent\\_og/index.jsp](https://www.uspto.gov/news/og/patent_og/index.jsp)
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- OED Phone 571-272-4097

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