

**UNITED STATES
PATENT AND TRADEMARK OFFICE**

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Select OED Procedure, Statistics, and Case Law

Office of Enrollment and Discipline
United States Patent and Trademark Office

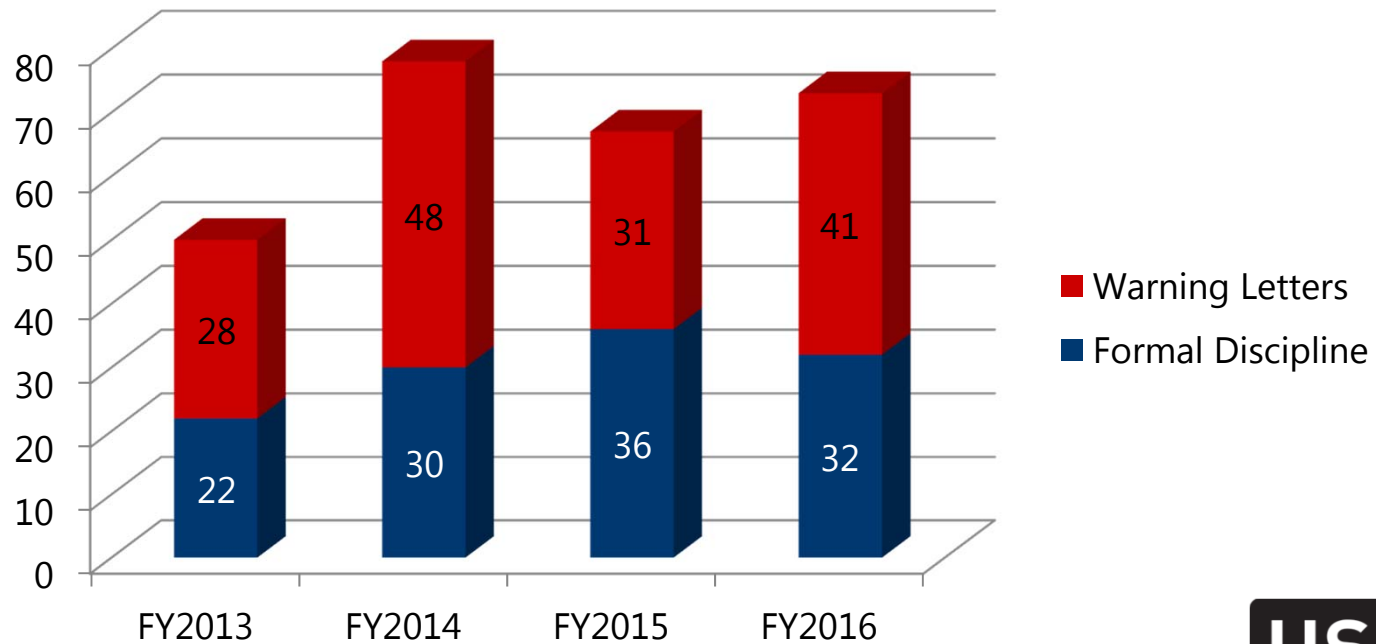
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OED Discipline: Warnings vs. Formal Discipline

- Generally speaking, “formal discipline” at OED is public discipline.
- Formal disciplinary sanctions include:
 - Exclusion from practice before the Office;
 - Suspension from practice before the Office; or
 - Public reprimand.
37 C.F.R. § 11.20(a).
- The OED Director may conclude an investigation with a warning.
37 C.F.R. § 11.21.
 - A warning is neither public nor a disciplinary sanction.

OED Discipline: Warnings vs. Formal Discipline



OED Discipline: Grievances and Complaints

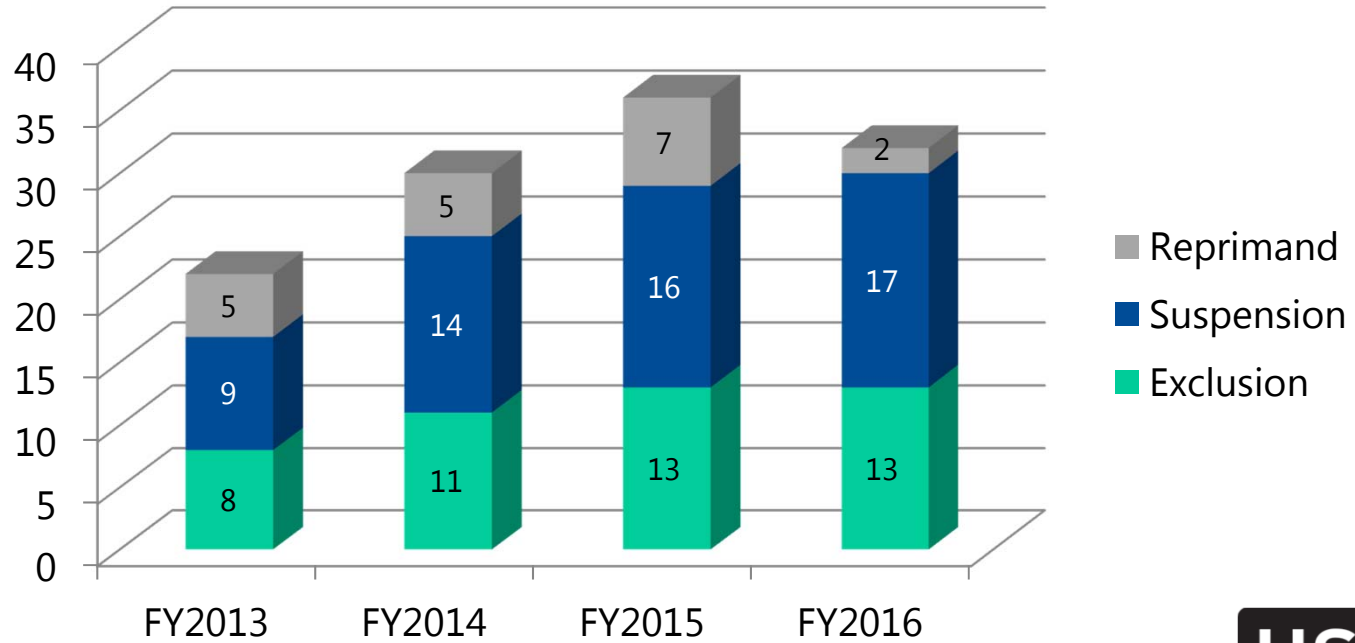
- An investigation of possible grounds for discipline may be initiated by the receipt of a grievance. See 37 C.F.R. § 11.22(a).
- Grievance: “a written submission from any source received by the OED Director that presents possible grounds for discipline of a specified practitioner.” 37 C.F.R. § 11.1.
- Common Sources of Information:
 - External to USPTO: Clients, Colleagues, Others.
 - Internally within USPTO: Patent Corps, Trademark Corps, Other.
- Duty to report professional misconduct:
 - 37 C.F.R. § 11.803.

OED Discipline: Grievances and Complaints

- If investigation reveals that grounds for discipline exist, the matter may be referred to the Committee on Discipline to make a probable cause determination. *See* 37 C.F.R. § 11.32.
- If probable cause is found, OED Director may file a complaint under 37 C.F.R. § 11.34. *See* 37 C.F.R. § 11.32.
- 37 C.F.R. § 11.34(d) specifies that the timing for filing a complaint shall be within one year after the date on which the OED Director receives a grievance.
- 37 C.F.R. § 11.34(d) also states that no complaint may be filed more than 10 years after the date on which the misconduct occurred.



USPTO Disciplinary Decisions

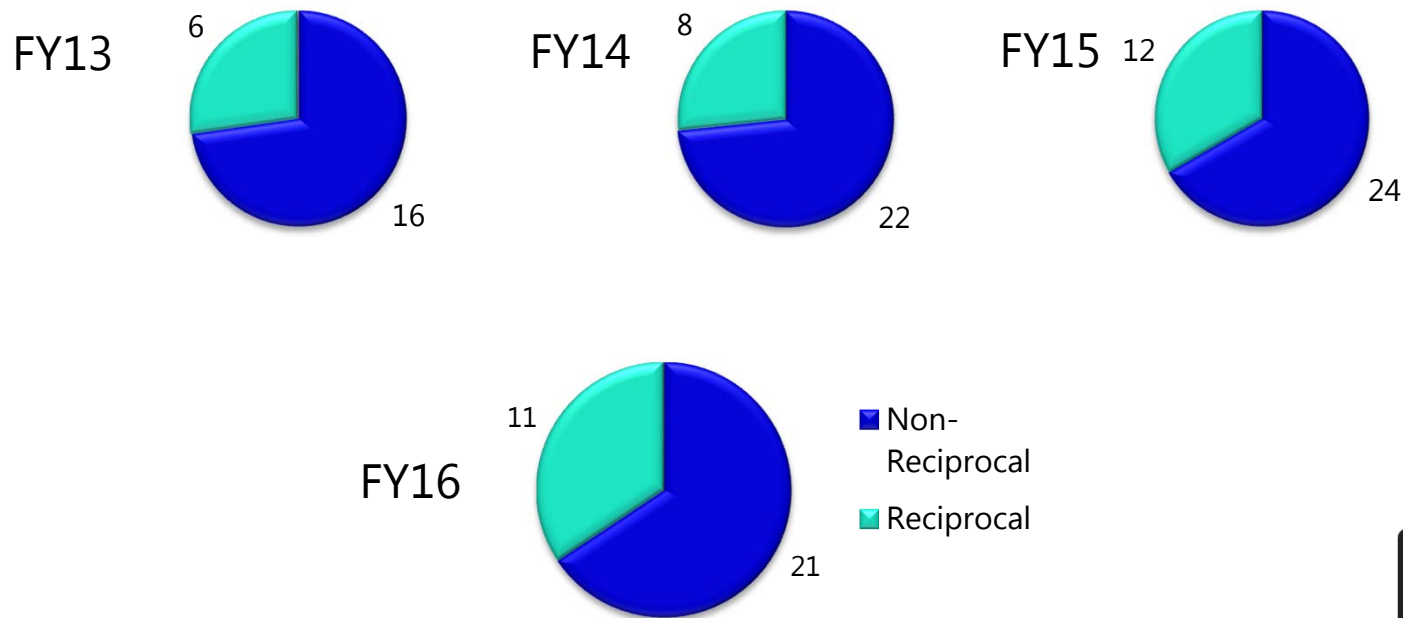


Other Types of Discipline

- Reciprocal discipline. 37 C.F.R. § 11.24.
 - Based on discipline by a state or federal program or agency.
 - Usually conducted on documentary record only.
- Interim suspension based on conviction of a serious crime. 37 C.F.R. § 11.25.

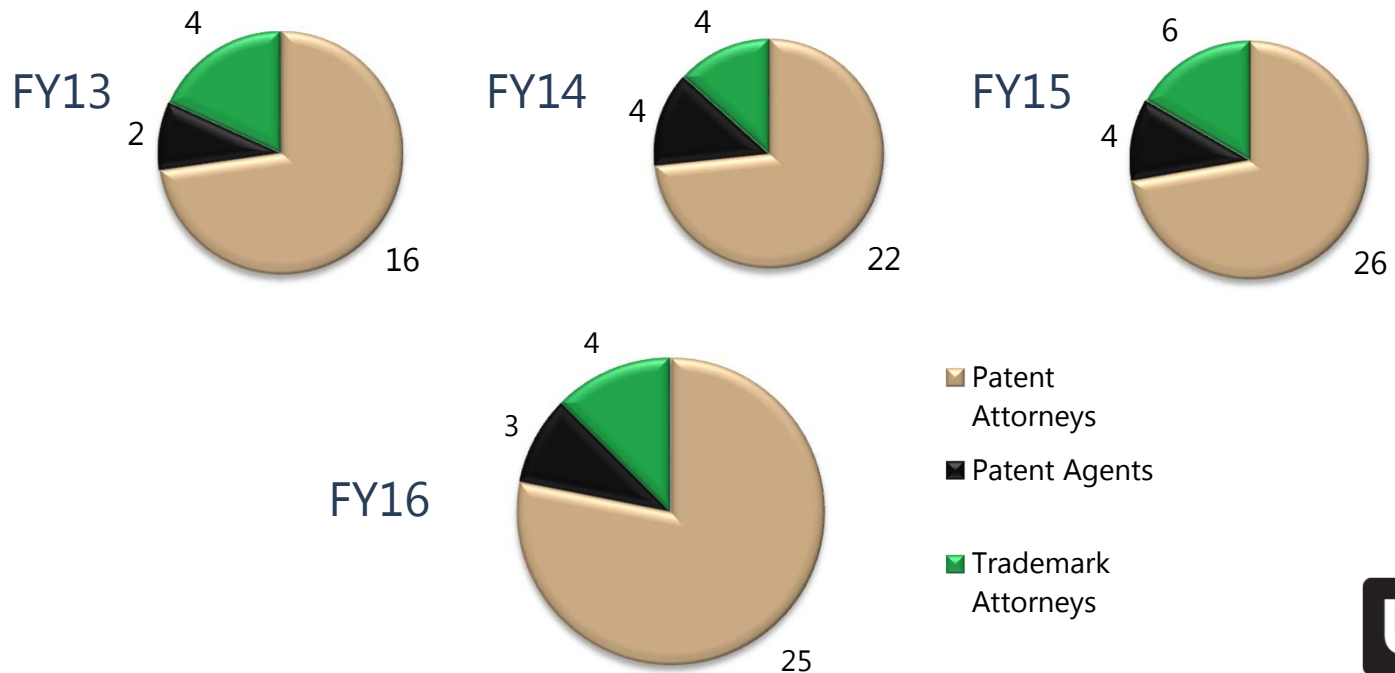
USPTO Disciplinary Decisions

Breakdown of Reciprocal vs. Non-Reciprocal Formal Decisions



USPTO Disciplinary Decisions

Breakdown of Disciplinary Decisions by Practitioner Type



Patent Pro Bono Program

- Assists financially under-resourced independent inventors and small businesses.
 - Section 32 of the AIA calls on the USPTO to work with and support IP law associations to establish pro bono programs.
 - Executive Action in February 2014 required the USPTO to expand the programs to all 50 states.
 - 50 state coverage achieved and maintained since August 2015.
- Promote small business growth and development.
- Help ensure that no deserving invention lacks patent protection because of a lack of money for IP counsel.
- Inventors and interested attorneys can navigate the USPTO website to find links to their regional program: <http://www.uspto.gov/probonopatents>.
- USPTO Pro Bono Contacts:
 - John Kirkpatrick - john.kirkpatrick@uspto.gov, 571-270-3343.
 - Grant Corboy - grant.corboy@uspto.gov, 571-270-3102.



Coverage of Patent Pro Bono Program October 2016



Limited Recognition for Visa Holders

- 37 C.F.R. 11.9(b) provides for the grant of limited recognition to practice before the USPTO in patent matters to nonimmigrant aliens residing in the U.S.
- Limited recognition is based on the visa authorizing employment in the U.S.
 - In many instances, visa must explicitly authorize employment or training involving practice before the USPTO in patent matters.
- Practitioners granted limited recognition are not “registered.”
 - Biographical information must indicate their limited recognition status.
- Limited recognition terminates when visa expires; employment authorized under the visa terminates; or practitioner departs the U.S.
 - New or extended visa requires extension or reinstatement from OED.



Register of Patent Practitioners

- Register of persons authorized to practice before the USPTO in patent matters is found on USPTO website:
<https://oedci.uspto.gov/OEDCI/>.
- New web portal enables practitioners to:
 - Indicate whether they are currently accepting new clients;
 - Change official address with OED;
 - Change name;
 - View certain transactions with OED;
 - Add email addresses to receive certain communications and reminders from OED.
- Register now lists persons granted limited recognition.
- More updates to come.





Office of Enrollment and Discipline

Select OED Case Law Review



Neglect/Candor

- ***In re Kroll*** (USPTO D2014-14)
 - Patent attorney:
 - Attorney routinely offered (and charged \$) to post client inventions for sale on his website.
 - Did not use modern docket management system.
 - Client hired Attorney to prepare and file application.
 - Attorney failed to file the application, but posted the invention for sale on his website.
 - Application file was discovered by chance. Attorney determined it had not yet been filed, and filed it 20 months after posting on the website.
 - Did not inform client about delay in filing.
 - Aggravating factors included prior disciplinary history.
 - Received two-year suspension.



Conflict of Interest

- ***In re Radanovic*** (USPTO D2014-29)
 - Patent attorney:
 - Represented two joint inventors of patent application.
 - No written agreement regarding representation.
 - Attorney became aware of a dispute wherein one inventor alleged that the other did not contribute to allowed claims.
 - Continued to represent both inventors.
 - Expressly abandoned application naming both inventors in favor of continuation naming one.
 - Mitigating factors included clean 50-year disciplinary history.
 - Received public reprimand.

Disreputable or Gross Misconduct

- ***In re Schroeder*** (USPTO D2014-08)
 - 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.
 - Suspended from practice before USPTO for 6 months.



Dishonesty, Fraud, Deceit or Misrepresentation

- ***In re Throne*** (USPTO D2015-19)
 - Investigation alleged that respondent patent attorney:
 - Was entrusted to approve patent-related expenditures for Hunter Douglas, International (HDI).
 - Also incorporated and controlled Patent Services Group, LLC (PSG).
 - Prepared invoices from PSG to HDI; approved payments from HDI to PSG.
 - Falsely represented to HDI that he was not involved with any conflicting activities.
 - HDI paid PSI nearly \$5 million under this arrangement.
 - Mr. Throne was excluded on consent.

Fee Issues

- ***In re Stecewycz*** (USPTO D2014-15)
 - Patent attorney:
 - Client sent attorney a check to cover filing fees for a CIP application.
 - Attorney attempted to pay filing fees for application with debit card.
 - Payment was denied; Missing Parts issued.
 - Payment on Missing Parts by debit card was denied.
 - Third attempt at payment using card was also denied.
 - Application became abandoned.
 - Did not advise client that application had gone abandoned.
 - Told client that application was “still on track.”
 - Received 2 year suspension.



Legal Fees

- ***In re Neeser*** (USPTO D2015-16)
 - Patent Agent:
 - Formed a partnership w/ non-lawyer practicing patent law.
 - Failed to maintain trust accounts for clients' funds.
 - Neglected applications.
 - Suspended from practice before USPTO for 12 months.
 - Mitigating factors included remorse, cooperation w/ investigation, and no prior discipline.

Decisions Imposing Public Discipline Available In FOIA Reading Room

- ▶ <http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>
 - ▶ In the field labeled "Decision Type," select "Discipline" from the drop down menu.
 - To retrieve all discipline cases, click "Get Info" (not the "Retrieve All Decisions" link).

- ▶ Official Gazette for Patents
 - http://www.uspto.gov/news/og/patent_og/index.jsp Select a published issue from the list, and click on the "Notices" link in the menu on the left side of the web page.





Contacting OED

For Informal Inquiries, Contact OED at
571-272-4097

THANK YOU



