

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



Professional responsibility and practice before the USPTO

Office of Enrollment and Discipline (OED)
United States Patent and Trademark Office

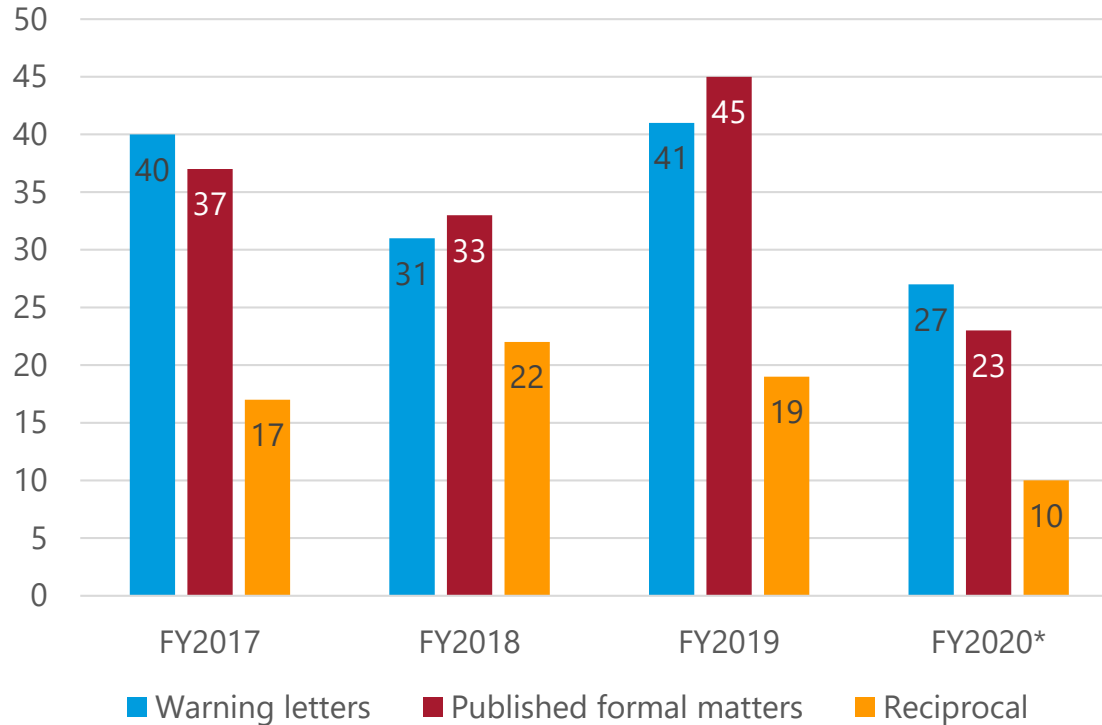
UNITED STATES
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Continuing legal education (CLE)

- Final rule published August 3, 2020: 85 FR 46932
- No active patent practitioner fee at this time
- Voluntary certification of CLE
 - Recognition of CLE completion in online practitioner directory
 - Certification of six credits of CLE within preceding 24 months
 - Five credits in patent law and practice, one credit in ethics
 - Up to two hours of CLE credit may be earned by providing *pro bono* legal services through the USPTO Patent Pro Bono Program
 - Proposed guidelines for voluntary CLE: seeking public comment
- Registration statement
 - Registered practitioners will be required to file a registration statement with OED biennially
 - Notice will be provided 120 days in advance of due date
 - Anticipated first compliance date: spring 2022
 - Replaces survey of registered practitioners

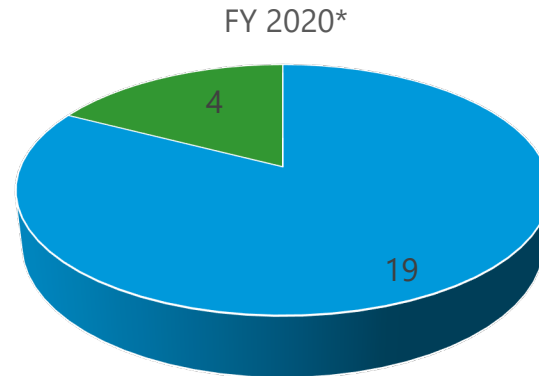
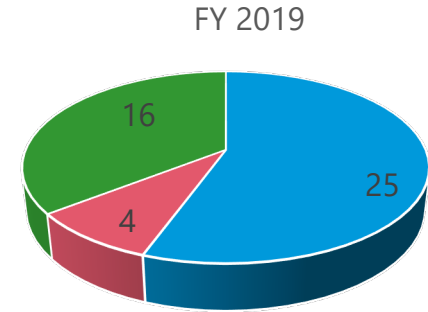
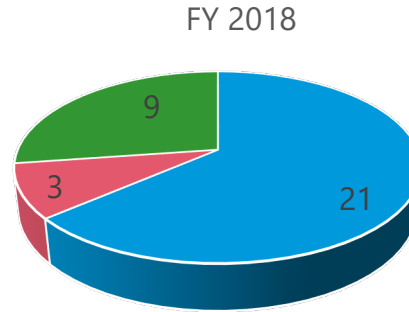
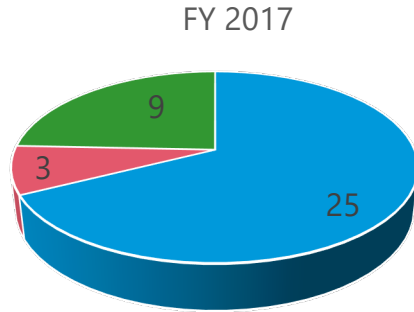
USPTO disciplinary matters



*Through FY 2020 Q3



USPTO disciplinary matters



■ Patent Attorneys ■ Patent Agents ■ Trademark Attorneys

*Through FY 2020 Q3



OED

Ethics scenarios and select case law

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

In re Starkweather (cont.)

- 37 C.F.R. § 11.102(a) Scope of representation and allocation of authority between client and practitioner
- 37 C.F.R. § 11.103 Diligence
- 37 C.F.R. § 11.104 Communication
- 37 C.F.R. § 11.107 Conflict of interest; current clients
- 37 C.F.R. §11.504(c) Professional Independence

In re Starkweather (cont.)

- 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

In re Starkweather (cont.)

- For signing client's name on documents filed with the USPTO:
 - 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

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.”

Signatures on trademark documents

- 37 C.F.R. § 2.193(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."

Signatures on trademark documents

- TMEP § 611.01(b) 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.”

Improper signatures/failure to supervise

- *In re Crabtree*, Proceeding Nos. D2018-31 & D2018-47 (USPTO Apr. 25, 2019)
 - Disciplinary complaint alleged, inter alia:
 - Attorney was part-owner and general counsel of entity that provided TM-related services.
 - Beginning in 2017 until early 2018, non-practitioner employees used a cut and paste procedure to apply applicant signatures from application summaries into TM filings.
 - Non-practitioner employees expressly abandoned application (including client signature) without applicant knowledge.
 - Non-practitioner employees would offer suggestions to customers relating to class, specimen acceptability, and mark description.
 - After disclosure to and agreement by applicant, company retained \$50 filing fee difference for TEAS Plus applications.
 - Company did not maintain escrow accounts for applicants' fees or USPTO filing fees.
 - Exclusion on consent
 - Rule highlights:
 - 37 C.F.R. § 11.101–Competence
 - 37 C.F.R. §§ 11.115(a) & (c)–Safekeeping property
 - 37 C.F.R. § 11.303(a)(1)–Candor toward tribunal
 - 37 C.F.R. § 11.503–Responsibilities regarding non-practitioner assistance
 - 37 C.F.R. § 11.505–Aiding UPL



Improper signatures

- *In re Caldwell II*, Proceeding No. D2020-12 (USPTO March 17, 2020)
 - Respondent was U.S. attorney working for Canadian company that provided trademark services.
 - Was attorney of record for company's clients before the USPTO.
 - Allowed company employee to sign his name on documents filed with the USPTO.
 - Did not have prior experience in trademark legal work.
 - Mitigating factors:
 - No prior discipline.
 - Fully and diligently cooperated with OED investigation.
 - Terminated his employment with company and informed company and new attorney of record of potential consequences of failing to comply with USPTO signature regulations.
 - 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. § 11.804(c)–Misrepresentation
 - 37 C.F.R. § 11.804(d)–Conduct prejudicial to the administration of justice



Improper signatures

- *In re Bashtanyk*, Proceeding No. D2020-09 (USPTO April 17, 2020)
 - Respondent was Canadian trademark agent reciprocally recognized under 37 C.F.R. § 11.14(c)
 - Disciplinary complaint alleged:
 - Respondent had relationship with Florida attorney with no prior TM experience.
 - Florida attorney was named attorney of record in U.S. trademark applications.
 - Respondent would enter Florida attorney's signature on documents filed with the USPTO.
 - Respondent failed to cooperate with OED investigation.
 - Exclusion on consent
 - Rule highlights:
 - 37 C.F.R. § 11.101–Competence
 - 37 C.F.R. § 11.801(b)–Failure to cooperate with disciplinary investigation
 - 37 C.F.R. § 11.804(c)–Misrepresentation
 - 37 C.F.R. § 11.804(d)–Conduct prejudicial to the administration of justice
 - 37 C.F.R. § 11.804(i)–Other conduct adversely reflecting on fitness to practice

Trademarks: local counsel rule

- Increase in foreign parties not authorized to represent trademark applicants improperly representing foreign applicants in trademark 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)
- Canadian patent agents are no longer able to represent Canadian parties in U.S. TM matters.
- Canadian TM attorneys and agents will only be able to serve as additionally appointed practitioners.
 - Clients must appoint U.S.-licensed attorney to file formal responses.
 - The USPTO will only correspond with U.S. licensed attorney.



Decisions imposing public discipline available in “FOIA Reading Room”

- foiadocuments.uspto.gov/oed/
- Official Gazette for Patents
 - 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 webpage.



Thank you!

OED

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