

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# Professional Responsibility and Pro Bono Practice Before the USPTO

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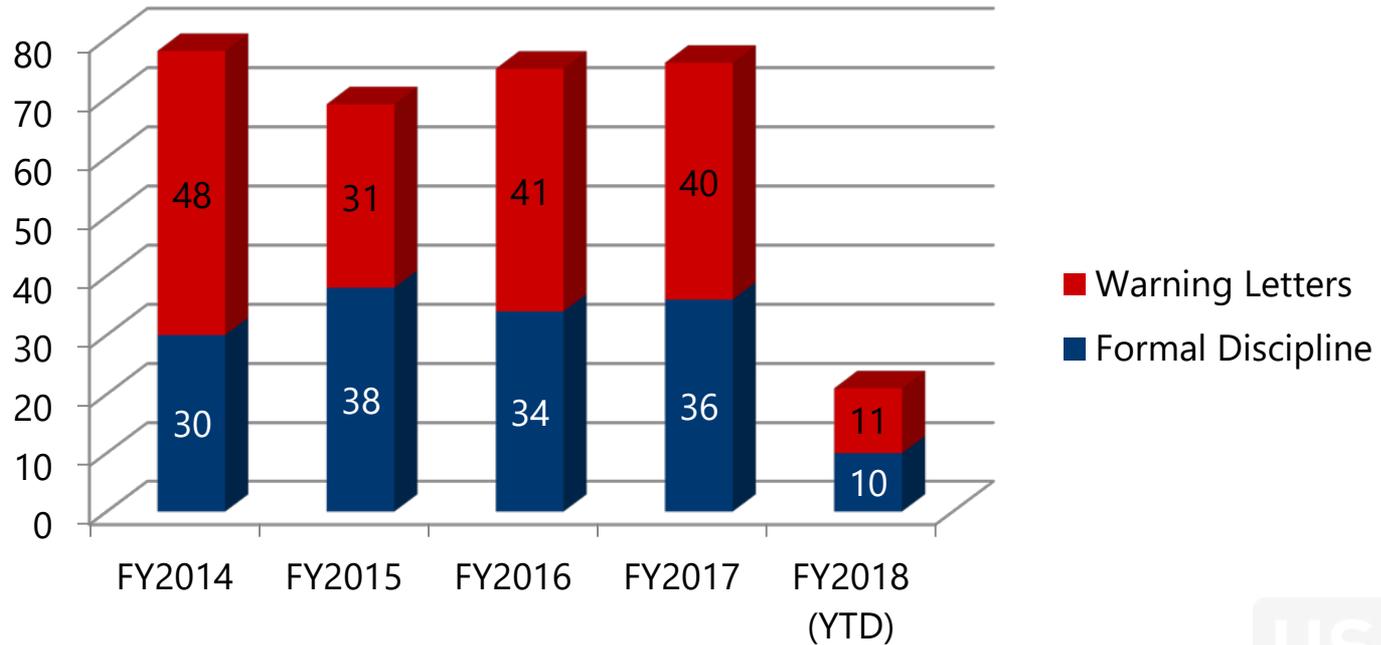
# Office of Enrollment and Discipline

## Discipline at OED

# OED – Diversion Program

- A 2016 ABA Commission on Lawyer Assistance Programs and Hazelden Betty Ford Foundation published a study of 13,000 currently-practicing attorneys and found the following:
  - Between 21-36% qualify as problem drinkers
  - Approximately 28% struggle with some level of depression
  - 19% struggle with anxiety
  - 23% struggle with stress
  - Other difficulties include suicide, social alienation, work addiction, sleep deprivation, job dissatisfaction, and complaints of work-life conflict.
- USPTO announced diversion as two-year pilot program on November 3, 2017.
- Available to practitioners who engaged in minor misconduct resulting from:
  - Physical, mental, or emotional health issues; or
  - Practice management issues.
- Misconduct must have resulted in little to no harm to client.
- Misconduct must not:
  - Involve the misappropriation of funds or dishonesty, deceit, fraud, or misrepresentation;
  - Result in or likely result in substantial prejudice to a client or other person;
  - Constitute a “serious crime” under 37 C.F.R. § 11.1; or
  - Be a part of a pattern of similar misconduct or be of the same nature of misconduct for which the practitioner has been disciplined within the past 5 years.

# OED Discipline: Warnings vs. Formal Discipline



# Office of Enrollment and Discipline

Select Case Law Review

# Conflict of Interest

*In re Mikhailova*, Proceeding No. D2017-18  
(USPTO June 16, 2017).

- Patent Agent contracted with Desa Industries, Inc d/b/a World Patent Marketing (“WPM”) to prepare, file, and respond to Office actions for clients referred by WPM.
- Permitted WPM to act as full intermediary with clients.
- Settlement: 20 month suspension with 28 months probation.
- Rule highlights:
  - 37 C.F.R. § 11.105(b) – communicating scope of representation/fee.
  - 37 C.F.R. § 11.107(a) – Conflict of interest; current clients.
  - 37 C.F.R. § 11.108(f) – Accepting compensation from third party.
  - 37 C.F.R. § 11.504 – Permitting 3<sup>rd</sup> party payer to regulate judgment.
  - 37 C.F.R. § 11.505 – Unauthorized Practice of law.

# Conflict of Interest

37 C.F.R. § 11.102 Scope of representation and allocation of authority between client and practitioner.

(c) A practitioner may **limit the scope of the representation** if the limitation is reasonable under the circumstances and the client gives **informed consent**.

37 C.F.R. § 11.105 Fees

(b) The **scope of the representation** and the basis or rate of the fee and expenses for which the client will be responsible **shall be communicated to the client**, preferably in writing, before or within a reasonable time after commencing the representation, except when the practitioner will charge a regularly represented client on the same basis or rate. Any changes in the basis or rate of the fee or expenses shall also be communicated to the client.

# Conflict of Interest

## 37 C.F.R. § 11.107(a)

...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.

# Conflict of Interest

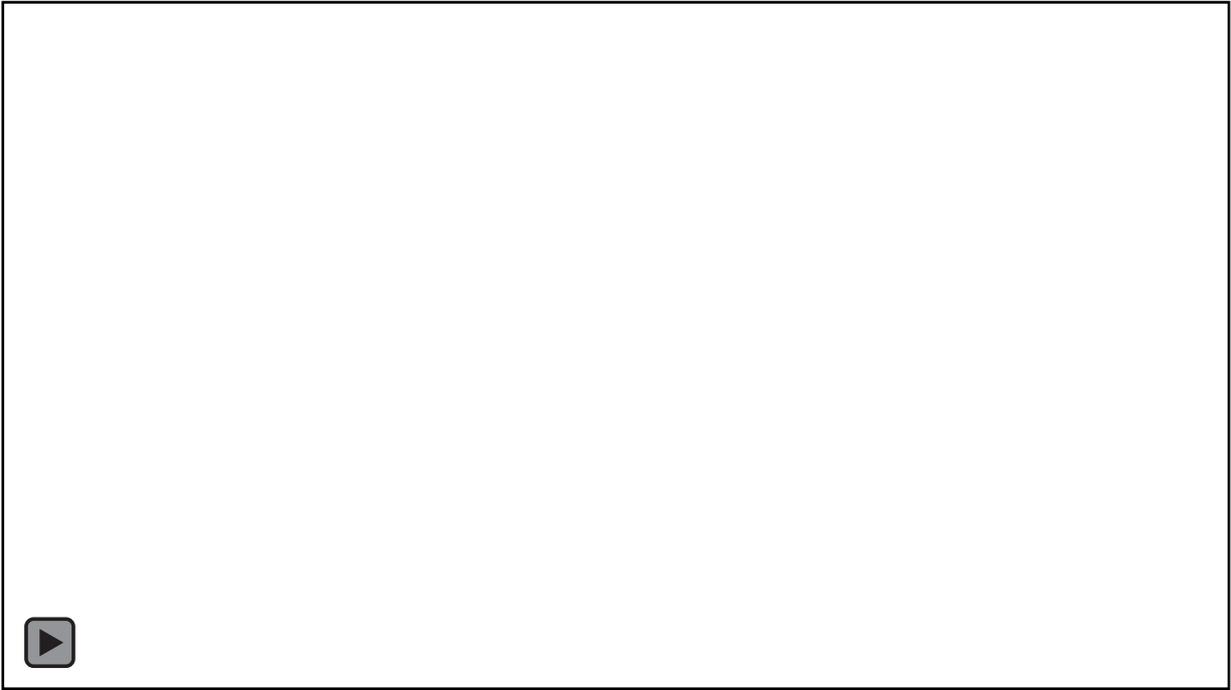
## 37 C.F.R. § 11.108(f)

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.

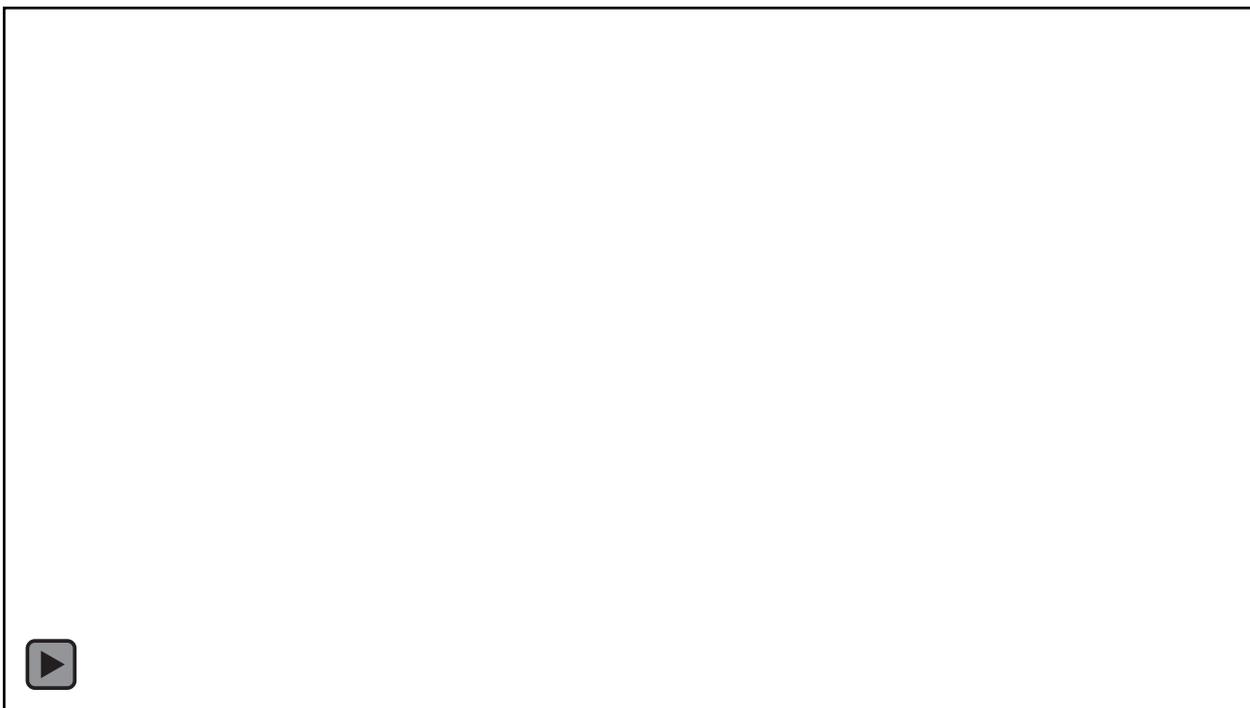


# Disreputable or Gross Misconduct

*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.





# Misrepresentation/UPL

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

- Disciplinary complaint alleged:
  - TM attorney established The Trademark Company, PLLC.
  - Permitted non-attorneys to practice TM law for him with little to no supervision.
  - Multiple fraudulent or digitally manipulated TM specimens were filed with 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.

# Decisions Imposing Public Discipline Available In FOIA Reading Room

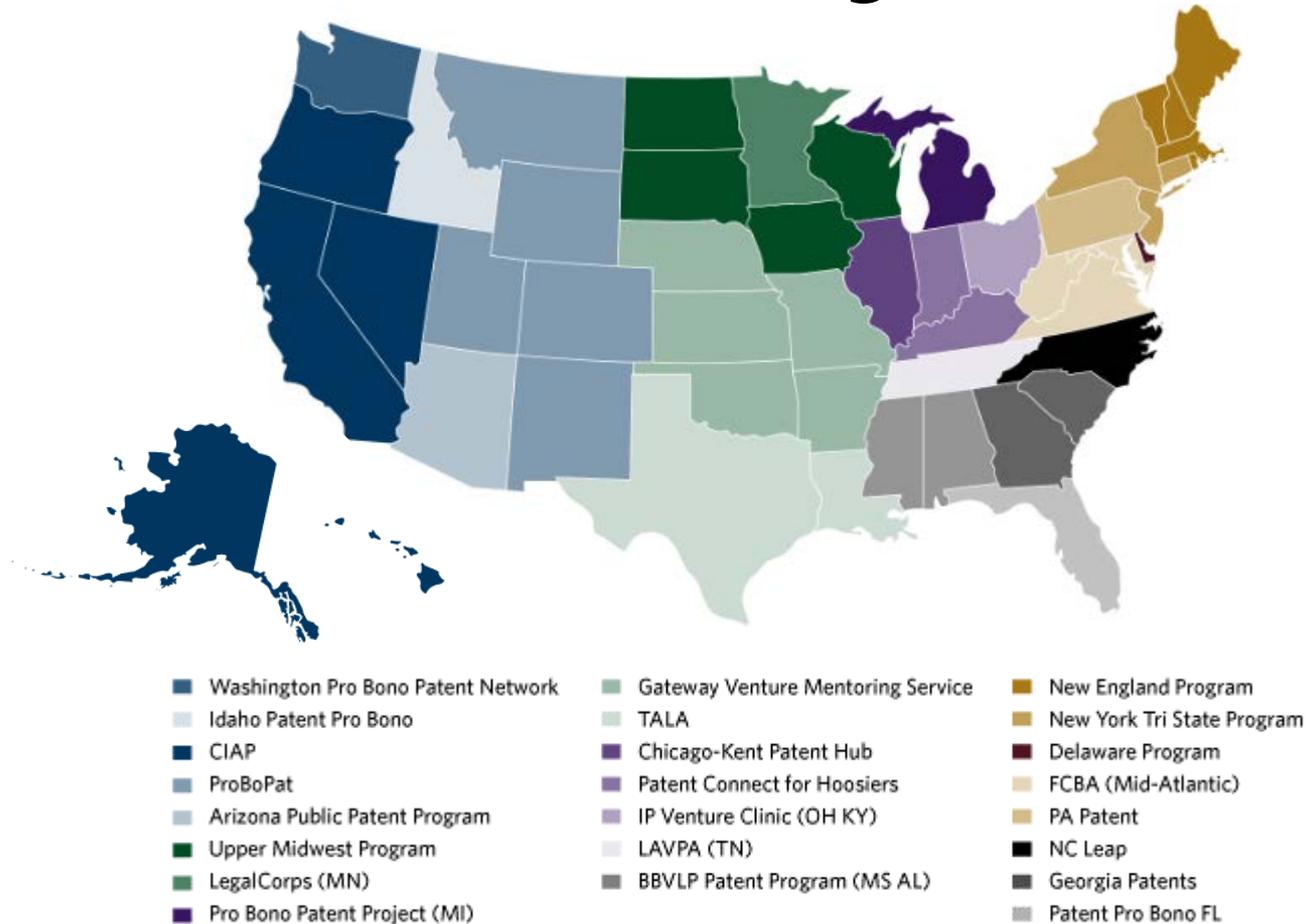
- ▶ <http://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp>
  - ▶ In the field labeled "Decision Type," select "Discipline" from the drop down menu.
    - To retrieve all discipline cases, click "Get Info" (not the "Retrieve All Decisions" link).
- ▶ Official Gazette for Patents
  - [http://www.uspto.gov/news/og/patent\\_og/index.jsp](http://www.uspto.gov/news/og/patent_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.

# 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.
  - 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>.
- Chicago-Kent Patent Hub serves under-resourced inventors in Illinois.
  - Contact: Mary Anne Smith; phone: (312) 906-5379; email: [patenthub@kentlaw.iit.edu](mailto:patenthub@kentlaw.iit.edu)
- USPTO *Pro Bono* Contacts:
  - John Kirkpatrick - [john.kirkpatrick@uspto.gov](mailto:john.kirkpatrick@uspto.gov), 571-270-3343.
  - Grant Corboy – [grant.corboy@uspto.gov](mailto:grant.corboy@uspto.gov), 571-270-3102.



# Patent Pro Bono Program Coverage



# Contacting OED

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

THANK YOU

