

*PRACTICE BEFORE THE PATENT
AND TRADEMARK OFFICE*

PART 10 [RESERVED]

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Subpart A—General Provisions

GENERAL INFORMATION

§ 11.1 Definitions.

This part governs solely the practice of patent, trademark, and other law before the United States Patent and Trademark Office. Nothing in this part shall be construed to preempt the authority of each State to regulate the practice of law, except to the extent necessary for the United States Patent and Trademark Office to accomplish its Federal objectives. Unless otherwise clear from the context, the following definitions apply to this part:

Attorney or *lawyer* means an individual who is an active member in good standing of the bar of the highest court of any State. A *non-lawyer* means a person who is not an attorney or lawyer.

Belief or *believes* means that the person involved actually supposed the fact in question to be true. A person's belief may be inferred from circumstances.

Confirmed in writing, when used in reference to the informed consent of a person, means informed consent that is given in writing by the person or a writing that a practitioner promptly transmits to the person confirming an

oral informed consent. If it is not feasible to obtain or transmit the writing at the time the person gives informed consent, then the practitioner must obtain or transmit it within a reasonable time thereafter.

Conviction or *convicted* means any confession to a crime; a verdict or judgment finding a person guilty of a crime; any entered plea, including *nolo contendere* or Alford plea, to a crime; or receipt of deferred adjudication (whether judgment or sentence has been entered or not) for an accused or pled crime.

Crime means any offense declared to be a felony or misdemeanor by Federal or State law in the jurisdiction where the act occurs.

Data sheet means a form used to collect the name, address, and telephone information from individuals recognized to practice before the Office in patent matters.

Disqualified means any action that prohibits a practitioner from participating in or appearing before the program or agency, regardless of how long the prohibition lasts or the specific terminology used.

Federal agency means any authority of the executive branch of the Government of the United States.

Federal program means any program established by an Act of Congress or administered by a Federal agency.

Firm or *law firm* means a practitioner or practitioners in a law partnership, professional corporation, sole proprietorship or other association authorized to practice law; or practitioners employed in a legal services organization or the legal department of a corporation or other organization.

Fiscal year means the time period from October 1st through the ensuing September 30th.

Fraud or *fraudulent* means conduct that involves a misrepresentation of material fact made with intent to deceive or a state of mind so reckless respecting consequences as to be the equivalent of intent, where there is justifiable reliance on the misrepresentation by the party deceived, inducing the party to act thereon, and where there is injury to the party deceived resulting from reliance on the misrepresentation. Fraud also may be estab-

lished by a purposeful omission or failure to state a material fact, which omission or failure to state makes other statements misleading, and where the other elements of justifiable reliance and injury are established.

Good moral character and reputation means the possession of honesty and truthfulness, trustworthiness and reliability, and a professional commitment to the legal process and the administration of justice, as well as the condition of being regarded as possessing such qualities.

Grievance means a written submission from any source received by the OED Director that presents possible grounds for discipline of a specified practitioner.

Informed consent means the agreement by a person to a proposed course of conduct after the practitioner has communicated adequate information and explanation about the material risks of and reasonably available alternatives to the proposed course of conduct.

Knowingly, known, or knows means actual knowledge of the fact in question. A person's knowledge may be inferred from circumstances.

Law-related services means services that might reasonably be performed in conjunction with and in substance are related to the provision of legal services, and that are not prohibited as unauthorized practice of law when provided by a non-lawyer.

OED means the Office of Enrollment and Discipline.

OED Director means the Director of the Office of Enrollment and Discipline.

OED Director's representatives means attorneys within the USPTO Office of General Counsel who act as representatives of the OED Director.

Office means the United States Patent and Trademark Office.

Partner means a member of a partnership, a shareholder in a law firm organized as a professional corporation, or a member of an association authorized to practice law.

Person means an individual, a corporation, an association, a trust, a partnership, and any other organization or legal entity.

Practitioner means:

(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 § 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 patent matters under § 11.9(a) or (b); or

(4) An individual authorized to practice before the Office under § 11.16(d).

Proceeding before the Office means an application for patent, an application for reissue, a reexamination, a protest, a public use matter, an *inter partes* patent matter, correction of a patent, correction of inventorship, an application to register a trademark, an *inter partes* trademark matter, an appeal, a petition, and any other matter that is pending before the Office.

Reasonable or *reasonably* when used in relation to conduct by a practitioner means the conduct of a reasonably prudent and competent practitioner.

Reasonable belief or *reasonably believes* when used in reference to a practitioner means that the practitioner believes the matter in question and that the circumstances are such that the belief is reasonable.

Reasonably should know when used in reference to a practitioner means that a practitioner of reasonable prudence and competence would ascertain the matter in question.

Registration means registration to practice before the Office in patent proceedings.

Roster or *register* means a list of individuals who have been registered as either a patent attorney or patent agent.

Screened means the isolation of a practitioner from any participation in a matter through the timely imposition of procedures within a firm that are reasonably adequate under the circumstances to protect information that the isolated practitioner is obligated to protect under these USPTO Rules of Professional Conduct or other law.

Serious crime means:

(1) Any criminal offense classified as a felony under the laws of the United States, any state or any foreign country where the crime occurred, or any

criminal offense punishable by death or imprisonment of more than one year; or

(2) Any crime a necessary element of which, as determined by the statutory or common law definition of such crime in the jurisdiction where the crime occurred, includes interference with the administration of justice, false swearing, misrepresentation, fraud, willful failure to file income tax returns, deceit, bribery, extortion, misappropriation, theft, or an attempt or a conspiracy or solicitation of another to commit a "serious crime."

Significant evidence of rehabilitation means satisfactory evidence that is significantly more probable than not that there will be no recurrence in the foreseeable future of the practitioner's prior disability or addiction.

State means any of the 50 states of the United States of America, the District of Columbia, and any commonwealth or territory of the United States of America.

Substantial when used in reference to degree or extent means a material matter of clear and weighty importance.

Suspend or *suspension* means a temporary debarring from practice before the Office or other jurisdiction.

Tribunal means the Office, a court, an arbitrator in a binding arbitration proceeding or a legislative body, administrative agency or other body acting in an adjudicative capacity. A legislative body, administrative agency or other body acts in an adjudicative capacity when a neutral official, after the presentation of evidence or legal argument by a party or parties, will render a binding legal judgment directly affecting a party's interests in a particular matter.

United States means the United States of America, and the territories and possessions the United States of America.

USPTO Director means the Director of the United States Patent and Trademark Office, or an employee of the Office delegated authority to act for the Director of the United States Patent and Trademark Office in matters arising under this part.

Writing or *written* means a tangible or electronic record of a communication

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or representation, including hand-writing, typewriting, printing, photostating, photography, audio or video recording and electronic communications. A “signed” writing includes an electronic sound, symbol or process attached to or logically associated with a writing and executed or adopted by a person with the intent to sign the writing.

[69 FR 35452, June 24, 2004, as amended at 73 FR 47687, Aug. 14, 2008; 77 FR 45251, July 31, 2012; 78 FR 20197, Apr. 3, 2013; 81 FR 33596, May 27, 2016; 86 FR 28452, May 26, 2021; 86 FR 32640, June 22, 2021]

§ 11.2 Director of the Office of Enrollment and Discipline.

(a) *Appointment.* The USPTO Director shall appoint a Director of the Office of Enrollment and Discipline (OED Director). In the event of a vacancy in the office of the OED Director, the USPTO Director may designate an employee of the Office to serve as acting OED Director. The OED Director shall be an active member in good standing of the bar of the highest court of a State.

(b) *Duties.* The OED Director shall:

(1) Supervise staff as may be necessary for the performance of the OED Director’s duties.

(2) Receive and act upon applications for registration, prepare and grade the registration examination, maintain the register provided for in § 11.5, and perform such other duties in connection with enrollment and recognition of attorneys and agents as may be necessary.

(3) Conduct investigations into the moral character and reputation of any individual seeking to be registered as an attorney or agent, or of any individual seeking limited recognition, deny registration or recognition of individuals failing to demonstrate possession of good moral character and reputation, and perform such other duties in connection with enrollment matters and investigations as may be necessary.

(4) Conduct investigations of matters involving possible grounds for discipline. Except in matters meriting summary dismissal, no disposition under § 11.22(h) shall be recommended or undertaken by the OED Director until the subject of the investigation

has been afforded an opportunity to respond to a reasonable inquiry by the OED Director.

(5) With the consent of a panel of three members of the Committee on Discipline, initiate disciplinary proceedings under § 11.32 and perform such other duties in connection with investigations and disciplinary proceedings as may be necessary.

(6) Oversee the preliminary screening of information and close investigations as provided for in § 11.22.

(7) [Reserved]

(c) *Petition to OED Director regarding enrollment or recognition.* Any petition from any action or requirement of the staff of OED reporting to the OED Director shall be taken to the OED Director accompanied by payment of the fee set forth in § 1.21(a)(5)(i) of this chapter. Any such petition not filed within sixty days from the mailing date of the action or notice from which relief is requested will be dismissed as untimely. The filing of a petition will neither stay the period for taking other action which may be running, nor stay other proceedings. The petitioner may file a single request for reconsideration of a decision within thirty days of the date of the decision. Filing a request for reconsideration stays the period for seeking review of the OED Director’s decision until a final decision on the request for reconsideration is issued.

(d) *Review of OED Director’s decision regarding enrollment or recognition.* A party dissatisfied with a final decision of the OED Director regarding enrollment or recognition shall seek review of the decision upon petition to the USPTO Director accompanied by payment of the fee set forth in § 1.21(a)(5)(ii) of this chapter. By filing such petition to the USPTO Director, the party waives any right to seek reconsideration from the OED Director. Any petition not filed within thirty days after the final decision of the OED Director may be dismissed as untimely. Briefs or memoranda, if any, in support of the petition shall accompany the petition. The petition will be decided on the basis of the record made before the OED Director. The USPTO Director in deciding the petition will consider no

new evidence. Copies of documents already of record before the OED Director shall not be submitted with the petition. An oral hearing will not be granted except when considered necessary by the USPTO Director. Any request for reconsideration of the decision of the USPTO Director may be dismissed as untimely if not filed within thirty days after the date of said decision. Only a decision of the USPTO Director regarding denial of a petition constitutes a final decision for the purpose of judicial review.

(e) *Petition to USPTO Director in disciplinary matters.* A party dissatisfied with any action or notice of any employee of the Office of Enrollment and Discipline during or at the conclusion of a disciplinary investigation shall seek review of the action or notice upon petition to the OED Director. A petition from any action or notice of the staff reporting to the OED Director shall be taken to the OED Director. A party dissatisfied with the OED Director's final decision shall seek review of the final decision upon petition to the USPTO Director to invoke the supervisory authority of the USPTO Director in appropriate circumstances in disciplinary matters. Any petition under this paragraph must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support of the petition must accompany the petition. Where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition. The OED Director may be directed by the USPTO Director to file a reply to the petition to the USPTO Director, supplying a copy to the petitioner. An oral hearing on petition taken to the USPTO Director will not be granted except when considered necessary by the USPTO Director. The filing of a petition under this paragraph will not stay an investigation, disciplinary proceeding, or other proceedings. Any petition under this part not filed within thirty days of the mailing date of the action or notice from which relief is requested may be dismissed as untimely. Any request for reconsideration of the decision of the OED Director or the USPTO Director may be dis-

missed as untimely if not filed within thirty days after the date of said decision. Only a decision of the USPTO Director regarding denial of a petition constitutes a final decision for the purpose of judicial review.

[69 FR 35452, June 24, 2004, as amended at 73 FR 47687, Aug. 14, 2008; 78 FR 20198, Apr. 3, 2013; 86 FR 28452, May 26, 2021]

§ 11.3 Suspension of rules.

(a) In an extraordinary situation, when justice requires, any requirement of the regulations of this Part which is not a requirement of statute may be suspended or waived by the USPTO Director or the designee of the USPTO Director, *sua sponte*, or on petition by any party, including the OED Director or the OED Director's representative, subject to such other requirements as may be imposed.

(b) No petition under this section shall stay a disciplinary proceeding unless ordered by the USPTO Director or a hearing officer.

[73 FR 47688, Aug. 14, 2008]

§ 11.4 Computing time.

Computing time. The following rules apply in computing any time period specified in this part where the period is stated in days or a longer unit of time:

(a) Exclude the day of the event that triggers the period;

(b) Count every day, including intermediate Saturdays, Sundays, and legal holidays; and

(c) Include the last day of the period, but if the last day is a Saturday, Sunday, or legal holiday, the period continues to run until the end of the next day that is not a Saturday, Sunday, or legal holiday.

[86 FR 28452, May 26, 2021]

Subpart B—Recognition To Practice Before the USPTO

PATENTS, TRADEMARKS, AND OTHER NON-PATENT LAW

§ 11.5 Register of attorneys and agents in patent matters; practice before the Office.

(a) *Register of attorneys and agents.* A register of attorneys and agents is kept

in the Office on which are entered the names of all individuals recognized as entitled to represent applicants having prospective or immediate business before the Office in the preparation and prosecution of patent applications. Registration in the Office under the provisions of this part shall entitle the individuals so registered to practice before the Office only in patent matters.

(b) *Practice before the Office.* Practice before the Office includes, but is not limited to, law-related service that comprehends any matter connected with the presentation to the Office or any of its officers or employees relating to a client's rights, privileges, duties, or responsibilities under the laws or regulations administered by the Office for the grant of a patent or registration of a trademark, or for enrollment or disciplinary matters. Such presentations include preparing necessary documents in contemplation of filing the documents with the Office, corresponding and communicating with the Office, and representing a client through documents or at interviews, hearings, and meetings, as well as communicating with and advising a client concerning matters pending or contemplated to be presented before the Office. Nothing in this section 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.

(1) *Practice before the Office in patent matters.* Practice before the Office in patent matters includes, but is not limited to, preparing or prosecuting any patent application; consulting with or giving advice to a client in contemplation of filing a patent application or other document with the Office; drafting the specification or claims of a patent application; drafting an amendment or reply to a communication from the Office that may require written argument to establish the patentability of a claimed invention; drafting a reply to a communication from the Office regarding a patent application; and drafting a communication for a public use, interference, reexamination proceeding, petition, appeal to or any other proceeding before the Patent

Trial and Appeal Board, or other patent proceeding. Registration to practice before the Office in patent matters authorizes the performance of those services that are reasonably necessary and incident to the preparation and prosecution of patent applications or other proceeding before the Office involving a patent application or patent in which the practitioner is authorized to participate. The services include:

(i) Considering the advisability of relying upon alternative forms of protection which may be available under state law, and

(ii) Drafting an assignment or causing an assignment to be executed for the patent owner in contemplation of filing or prosecution of a patent application for the patent owner, where the practitioner represents the patent owner after a patent issues in a proceeding before the Office, and when drafting the assignment the practitioner does no more than replicate the terms of a previously existing oral or written obligation of assignment from one person or party to another person or party.

(2) *Practice before the Office in trademark matters.* Practice before the Office in trademark matters includes, but is not limited to, consulting with or giving advice to a client in contemplation of filing a trademark application or other document with the Office; preparing or prosecuting an application for trademark registration; preparing an amendment that may require written argument to establish the registrability of the mark; preparing or prosecuting a document for maintaining, correcting, amending, canceling, surrendering, or otherwise affecting a registration; and conducting an opposition, cancellation, or concurrent use proceeding; or conducting an appeal to the Trademark Trial and Appeal Board.

[73 FR 47688, Aug. 14, 2008, as amended at 77 FR 46629, Aug. 6, 2012; 86 FR 28452, May 26, 2021]

§ 11.6 Registration of attorneys and agents.

(a) *Attorneys.* Any citizen of the United States who is an attorney and who fulfills the requirements of this part may be registered as a patent attorney to practice before the Office.

When appropriate, any alien who is an attorney, who lawfully resides in the United States, and who fulfills the requirements of this part may be registered as a patent attorney to practice before the Office, provided that such registration is not inconsistent with the terms upon which the alien was admitted to, and resides in, the United States and further provided that the alien may remain registered only:

(1) If the alien continues to lawfully reside in the United States and registration does not become inconsistent with the terms upon which the alien continues to lawfully reside in the United States, or

(2) If the alien ceases to reside in the United States, the alien is qualified to be registered under paragraph (c) of this section. *See also* §11.9(b).

(b) *Agents.* Any citizen of the United States who is not an attorney, and who fulfills the requirements of this part may be registered as a patent agent to practice before the Office. When appropriate, any alien who is not an attorney, who lawfully resides in the United States, and who fulfills the requirements of this part may be registered as a patent agent to practice before the Office, provided that such registration is not inconsistent with the terms upon which the alien was admitted to, and resides in, the United States, and further provided that the alien may remain registered only:

(1) If the alien continues to lawfully reside in the United States and registration does not become inconsistent with the terms upon which the alien continues to lawfully reside in the United States or

(2) If the alien ceases to reside in the United States, the alien is qualified to be registered under paragraph (c) of this section. *See also* §11.9(b).

(c) *Foreigners.* Any foreigner not a resident of the United States who shall file proof to the satisfaction of the OED Director that he or she is registered and in good standing before the patent office of the country in which he or she resides and practices, and who is possessed of the qualifications stated in §11.7, may be registered as a patent agent to practice before the Office for the limited purpose of presenting and prosecuting patent applica-

tions of applicants located in such country, provided that the patent office of such country allows substantially reciprocal privileges to those admitted to practice before the Office. Registration as a patent agent under this paragraph shall continue only during the period that the conditions specified in this paragraph obtain. Upon notice by the patent office of such country that a patent agent registered under this section is no longer registered or no longer in good standing before the patent office of such country, and absent a showing of cause why his or her name should not be removed from the register, the OED Director shall promptly remove the name of the patent agent from the register and publish the fact of removal. Upon ceasing to reside in such country, the patent agent registered under this section is no longer qualified to be registered under this section, and the OED Director shall promptly remove the name of the patent agent from the register and publish the fact of removal.

(d) *Patent Trial and Appeal Board matters.* For action by a person who is not registered in a proceeding before the Patent Trial and Appeal Board, see §41.5(a) or §42.10(c) of this title.

[69 FR 35452, June 24, 2004, as amended at 69 FR 50003, Aug. 12, 2004; 77 FR 46629, Aug. 6, 2012]

§ 11.7 Requirements for registration.

(a) No individual will be registered to practice before the Office unless he or she has:

(1) Applied to the USPTO Director in writing by completing an application for registration form supplied by the OED Director and furnishing all requested information and material; and

(2) Established to the satisfaction of the OED Director that he or she:

(i) Possesses good moral character and reputation;

(ii) Possesses the legal, scientific, and technical qualifications necessary for him or her to render applicants valuable service; and

(iii) Is competent to advise and assist patent applicants in the presentation and prosecution of their applications before the Office.

(b)(1) To enable the OED Director to determine whether an individual has

the qualifications specified in paragraph (a)(2) of this section, the individual shall:

(i) File a complete application for registration each time admission to the registration examination is requested. A complete application for registration includes:

(A) An application for registration form supplied by the OED Director wherein all requested information and supporting documents are furnished,

(B) Payment of the fees required by § 1.21(a)(1) of this chapter;

(C) Satisfactory proof of scientific and technical qualifications, and

(D) For aliens, provide proof that recognition is not inconsistent with the terms of their visa or entry into the United States;

(ii) Pass the registration examination, unless the taking and passing of the examination is waived as provided in paragraph (d) of this section. Unless examination is waived pursuant to paragraph (d) of this section, each individual seeking registration must take and pass the registration examination to enable the OED Director to determine whether the individual possesses the legal and competence qualifications specified in paragraphs (a)(2)(ii) and (a)(2)(iii) of this section. An individual failing the examination may, upon receipt of notice of failure from OED, reapply for admission to the examination. An individual failing the examination must wait thirty days after the date the individual last took the examination before retaking the examination. An individual reapplying shall:

(A) File a completed application for registration form wherein all requested information and supporting documents are furnished,

(B) Pay the fees required by § 1.21(a)(1) of this subchapter, and

(C) For aliens, provide proof that recognition is not inconsistent with the terms of their visa or entry into the United States; and

(iii) Provide satisfactory proof of possession of good moral character and reputation.

(2) An individual failing the examination may, upon receipt of notice of failure from OED, reapply for admission to the examination. An individual failing

the examination for the first or second time must wait 30 days after the date the individual last took the examination before retaking the examination. An individual failing the examination for the third or fourth time must wait 90 days after the date the individual last took the examination before retaking the examination. An individual may not take the examination more than five times. However, upon petition under § 11.2(c), the OED Director may, at his or her discretion, waive this limitation upon such conditions as the OED Director may prescribe. An individual reapplying shall:

(i) File a completed application for registration form including all requested information and supporting documents not previously provided to OED,

(ii) Pay the fees required by § 1.21(a)(1) of this chapter,

(iii) For aliens, provide proof that registration is not inconsistent with the terms of their visa or entry into the United States, and

(iv) Provide satisfactory proof of good moral character and reputation.

(3) An individual failing to file a complete application for registration will not be admitted to the examination and will be notified of the incompleteness. Applications for registration that are incomplete as originally submitted will be considered only when they have been completed and received by OED, provided that this occurs within 60 days of the mailing date of the notice of incompleteness. Thereafter, a new and complete application for registration must be filed. Only an individual approved as satisfying the requirements of paragraph (b)(1)(i) of this section may be admitted to the examination.

(4)(i) A notice of admission shall be sent to those individuals who have been admitted to the registration examination. This notice shall specify a certain period of time in which to schedule and take the examination.

(ii) An individual may request an extension of this period of time by written request to the OED Director. Such request must be received by the OED Director prior to the expiration of the

period specified in the notice as extended by any previously granted extension and must include the fee specified in § 1.21(a)(1)(iv). Upon the granting of the request, the period of time in which the individual may schedule and take the registration examination shall be extended by 90 days.

(iii) An individual who does not take the registration examination within the period of time specified in the notice may not take the examination without filing a new application for registration, as set forth in paragraph (b)(1)(i) of this section.

(c) Each individual seeking registration is responsible for updating all information and answers submitted in or with the application for registration based upon anything occurring between the date the application for registration is signed by the individual, and the date he or she is registered or recognized to practice before the Office in patent matters. The update shall be filed within thirty days after the date of the occasion that necessitates the update.

(d) *Waiver of the Registration Examination for Former Office Employees*—(1) *Former patent examiners who by July 26, 2004, had not actively served four years in the patent examining corps, and were serving in the corps at the time of their separation.* The OED Director may waive the taking of a registration examination in the case of any individual meeting the requirements of paragraph (b)(1)(i)(C) of this section who is a former patent examiner but by July 26, 2004, had not served four years in the patent examining corps, if the individual demonstrates that he or she:

(i) Actively served in the patent examining corps of the Office and was serving in the corps at the time of separation from the Office;

(ii) Received a certificate of legal competency and negotiation authority;

(iii) After receiving the certificate of legal competency and negotiation authority, was rated at least fully successful in each quality performance element of his or her performance plan for the last two complete fiscal years as a patent examiner; and

(iv) Was not under an oral or written warning regarding the quality perform-

ance elements at the time of separation from the patent examining corps.

(2) *Former patent examiners who on July 26, 2004, had actively served four years in the patent examining corps, and were serving in the corps at the time of their separation.* The OED Director may waive the taking of a registration examination in the case of any individual meeting the requirements of paragraph (b)(1)(i)(C) of this section who is a former patent examiner and by July 26, 2004, had served four years in the patent examining corps, if the individual demonstrates that he or she:

(i) Actively served for at least four years in the patent examining corps of the Office by July 26, 2004, and was serving in the corps at the time of separation from the Office;

(ii) Was rated at least fully successful in each quality performance element of his or her performance plan for the last two complete fiscal years as a patent examiner in the Office; and

(iii) Was not under an oral or written warning regarding the quality performance elements at the time of separation from the patent examining corps.

(3) *Certain former Office employees who were not serving in the patent examining corps upon their separation from the Office.* The OED Director may waive the taking of a registration examination in the case of a former Office employee meeting the requirements of paragraph (b)(1)(i)(C) of this section who, by petition, demonstrates the necessary legal qualifications to render to patent applicants and others valuable service and assistance in the preparation and prosecution of their applications or other business before the Office by showing that he or she has:

(i) Exhibited comprehensive knowledge of patent law equivalent to that shown by passing the registration examination as a result of having been in a position of responsibility in the Office in which he or she:

(A) Provided substantial guidance on patent examination policy, including the development of rule or procedure changes, patent examination guidelines, changes to the Manual of Patent Examining Procedure, training or testing materials for the patent examining corps, or materials for the registration

examination or continuing legal education; or

(B) Represented the Office in patent matters before Federal courts; and

(ii) Was rated at least fully successful in each quality performance element of his or her performance plan for said position for the last two complete rating periods in the Office and was not under an oral or written warning regarding such performance elements at the time of separation from the Office.

(4) To be eligible for consideration for waiver, an individual formerly employed by the Office within the scope of one of paragraphs (d)(1), (d)(2) or (d)(3) of this section must file a complete application for registration and pay the fee required by § 1.21(a)(1)(i) of this subchapter within two years of the individual's date of separation from the Office. All other individuals formerly employed by the Office, including former examiners, filing an application for registration or fee more than two years after separation from the Office, are required to take and pass the registration examination. The individual or former examiner must pay the examination fee required by § 1.21(a)(1)(ii) of this subchapter within thirty days after notice of non-waiver.

(e) *Examination results.* Notification of the examination results is final. Within 60 days of the mailing date of a notice of failure, the individual is entitled to inspect, but not copy, the questions and answers he or she incorrectly answered. Review will be under supervision. No notes may be taken during such review. Substantive review of the answers or questions may not be pursued by petition for regrade.

(f) *Application for reciprocal recognition.* An individual seeking reciprocal recognition under § 11.6(c), in addition to satisfying the provisions of paragraphs (a) and (b) of this section, and the provisions of § 11.8(b), shall pay the application fee required by § 1.21(a)(1)(i) of this chapter upon filing an application for registration.

(g) *Investigation of good moral character and reputation.* (1) Every individual seeking recognition shall answer all questions in the application for registration and request(s) for information and evidence issued by OED; disclose all relevant facts, dates, and informa-

tion; and provide verified copies of documents relevant to his or her good moral character and reputation. An individual who is an attorney shall submit a certified copy of each of his or her State bar applications and determinations of character and reputation, if available.

(2)(i) If the OED Director receives information from any source that reflects adversely on the good moral character or reputation of an individual seeking registration or recognition, the OED Director shall conduct an investigation into the good moral character and reputation of that individual. The investigation will be conducted after the individual has passed the registration examination, or after the registration examination has been waived for the individual, as applicable. An individual failing to timely answer questions or respond to an inquiry by OED shall be deemed to have withdrawn his or her application, and shall be required to reapply, pass the examination, and otherwise satisfy all the requirements of this section. No individual shall be certified for registration or recognition by the OED Director until, to the satisfaction of the OED Director, the individual demonstrates his or her possession of good moral character and reputation.

(ii) The OED Director, in considering an application for registration by an attorney, may accept a State bar's determination of character and reputation as meeting the requirements set forth in paragraph (a)(2)(i) of this section if, after review, the Office finds no substantial discrepancy between the information provided with his or her application for registration and the State bar application and determination of character and reputation, provided that acceptance is not inconsistent with other rules and the requirements of 35 U.S.C. 2(b)(2)(D).

(h) *Good moral character and reputation.* Evidence showing lack of good moral character and reputation may include, but is not limited to, conviction of a felony or a misdemeanor identified in paragraph (h)(1) of this section, drug or alcohol abuse; lack of candor; suspension or disbarment on ethical grounds from a State bar; and

resignation from a State bar while under investigation.

(1) *Conviction of felony or misdemeanor.* An individual who has been convicted of a felony or a misdemeanor involving moral turpitude, breach of trust, interference with the administration of justice, false swearing, misrepresentation, fraud, deceit, bribery, extortion, misappropriation, theft, or conspiracy to commit any felony or misdemeanor, is presumed not to be of good moral character and reputation in the absence of a pardon or a satisfactory showing of reform and rehabilitation, and shall file with his or her application for registration the fees required by § 1.21(a)(1)(ii) and (a)(10) of this subchapter. The OED Director shall determine whether individuals convicted of said felony or misdemeanor provided satisfactory proof of reform and rehabilitation.

(i) An individual who has been convicted of a felony or a misdemeanor identified in paragraph (h)(1) of this section shall not be eligible to apply for registration during the time of any sentence (including confinement or commitment to imprisonment), deferred adjudication, and period of probation or parole as a result of the conviction, and for a period of two years after the date of completion of the sentence, deferred adjudication, and period of probation or parole, whichever is later.

(ii) The following presumptions apply to the determination of good moral character and reputation of an individual convicted of said felony or misdemeanor:

(A) The court record or docket entry of conviction is conclusive evidence of guilt in the absence of a pardon or a satisfactory showing of reform or rehabilitation; and

(B) An individual convicted of a felony or any misdemeanor identified in paragraph (h)(1) of this section is conclusively deemed not to have good moral character and reputation, and shall not be eligible to apply for registration for a period of two years after completion of the sentence, deferred adjudication, and period of probation or parole, whichever is later.

(iii) The individual, upon applying for registration, shall provide satisfac-

tory evidence that he or she is of good moral character and reputation.

(iv) Upon proof that a conviction has been set aside or reversed, the individual shall be eligible to file a complete application for registration and the fee required by § 1.21(a)(1)(ii) of this subchapter and, upon passing the registration examination, have the OED Director determine, in accordance with paragraph (h)(1) of this section, whether, absent the conviction, the individual possesses good moral character and reputation.

(2) *Good moral character and reputation involving drug or alcohol abuse.* An individual's record is reviewed as a whole to see if there is a drug or alcohol abuse issue. An individual appearing to abuse drugs or alcohol may be asked to undergo an evaluation, at the individual's expense, by a qualified professional approved by the OED Director. In instances where, before an investigation commences, there is evidence of a present abuse or an individual has not established a record of recovery, the OED Director may request the individual to withdraw his or her application, and require the individual to satisfactorily demonstrate that he or she is complying with treatment and undergoing recovery.

(3) *Moral character and reputation involving lack of candor.* An individual's lack of candor in disclosing facts bearing on or relevant to issues concerning good moral character and reputation when completing the application or any time thereafter may be found to be cause to deny registration on moral character and reputation grounds.

(4) *Moral character and reputation involving suspension, disbarment, or resignation from a profession.* (i) An individual who has been disbarred or suspended from practice of law or other profession, or has resigned in lieu of a disciplinary proceeding (excluded or disbarred on consent) shall be ineligible to apply for registration as follows:

(A) An individual who has been disbarred from practice of law or other profession, or has resigned in lieu of a disciplinary proceeding (excluded or

disbarred on consent) shall be ineligible to apply for registration for a period of five years from the date of disbarment or resignation.

(B) An individual who has been suspended on ethical grounds from the practice of law or other profession shall be ineligible to apply for registration until expiration of the period of suspension.

(C) An individual who was not only disbarred, suspended or resigned in lieu of a disciplinary proceeding, but also convicted in a court of a felony, or of a crime involving moral turpitude or breach of trust, shall be ineligible to apply for registration until the conditions in paragraphs (h)(1) and (h)(4) of this section are fully satisfied.

(ii) An individual who has been disbarred or suspended, or who resigned in lieu of a disciplinary proceeding shall file an application for registration and the fees required by § 1.21(a)(1)(ii) and (a)(10) of this subchapter; provide a full and complete copy of the proceedings that led to the disbarment, suspension, or resignation; and provide satisfactory proof that he or she possesses good moral character and reputation. The following presumptions shall govern the determination of good moral character and reputation of an individual who has been licensed to practice law or other profession in any jurisdiction and has been disbarred, suspended on ethical grounds, or allowed to resign in lieu of discipline, in that jurisdiction:

(A) A copy of the record resulting in disbarment, suspension or resignation is *prima facie* evidence of the matters contained in the record, and the imposition of disbarment or suspension, or the acceptance of the resignation of the individual shall be deemed conclusive that the individual has committed professional misconduct.

(B) The individual is ineligible for registration and is deemed not to have good moral character and reputation during the period of the imposed discipline.

(iii) The only defenses available with regard to an underlying disciplinary matter resulting in disbarment, suspension on ethical grounds, or resignation in lieu of a disciplinary proceeding are set out below, and must be shown

to the satisfaction of the OED Director:

(A) The procedure in the disciplinary court was so lacking in notice or opportunity to be heard as to constitute a deprivation of due process;

(B) There was such infirmity of proof establishing the misconduct as to give rise to the clear conviction that the Office could not, consistently with its duty, accept as final the conclusion on that subject; or

(C) The finding of lack of good moral character and reputation by the Office would result in grave injustice.

(i) *Factors that may be taken into consideration when evaluating rehabilitation of an individual seeking a moral character and reputation determination.* The factors enumerated below are guidelines to assist the OED Director in determining whether an individual has demonstrated rehabilitation from an act of misconduct or moral turpitude. The factors include:

(1) The nature of the act of misconduct, including whether it involved moral turpitude, whether there were aggravating or mitigating circumstances, and whether the activity was an isolated event or part of a pattern;

(2) The age and education of the individual at the time of the misconduct and the age and education of the individual at the present time;

(3) The length of time that has passed between the misconduct and the present, absent any involvement in any further acts of moral turpitude, the amount of time and the extent of rehabilitation being dependent upon the nature and seriousness of the act of misconduct under consideration;

(4) Restitution by the individual to any person who suffered monetary losses through acts or omissions of the individual;

(5) Expungement of a conviction;

(6) Successful completion or early discharge from probation or parole;

(7) Abstinence from the use of controlled substances or alcohol for not less than two years if the specific misconduct was attributable in part to the use of a controlled substance or alcohol, where abstinence may be demonstrated by, but is not necessarily limited to, enrolling in and complying

with a self-help or professional treatment program;

(8) If the specific misconduct was attributable in part to a medically recognized mental disease, disorder or illness, proof that the individual sought professional assistance, and complied with the treatment program prescribed by the professional, and submitted letters from the treating psychiatrist/psychologist verifying that the medically recognized mental disease, disorder or illness will not impede the individual's ability to competently practice before the Office;

(9) Payment of the fine imposed in connection with any criminal conviction;

(10) Correction of behavior responsible in some degree for the misconduct;

(11) Significant and conscientious involvement in programs designed to provide social benefits or to ameliorate social problems; and

(12) Change in attitude from that which existed at the time of the act of misconduct in question as evidenced by any or all of the following:

(i) Statements of the individual;

(ii) Statements from persons familiar with the individual's previous misconduct and with subsequent attitudes and behavioral patterns;

(iii) Statements from probation or parole officers or law enforcement officials as to the individual's social adjustments; and

(iv) Statements from persons competent to testify with regard to neuropsychiatry or emotional disturbances.

(j) *Notice to Show Cause.* The OED Director shall inquire into the good moral character and reputation of an individual seeking registration, providing the individual with the opportunity to create a record on which a decision is made. If, following inquiry and consideration of the record, the OED Director is of the opinion that the individual seeking registration has not satisfactorily established that he or she possesses good moral character and reputation, the OED Director shall issue to the individual a notice to show cause why the individual's application for registration should not be denied.

(1) The individual shall be given no less than ten days from the date of the notice to reply. The notice shall be given by certified mail at the address appearing on the application if the address is in the United States, and by any other reasonable means if the address is outside the United States.

(2) Following receipt of the individual's response, or in the absence of a response, the OED Director shall consider the individual's response, if any, and the record, and determine whether, in the OED Director's opinion, the individual has sustained his or her burden of satisfactorily demonstrating that he or she possesses good moral character and reputation.

(k) *Reapplication for registration.* An individual who has been refused registration for lack of good moral character or reputation may reapply for registration two years after the date of the decision, unless a shorter period is otherwise ordered by the USPTO Director. An individual, who has been notified that he or she is under investigation for good moral character and reputation may elect to withdraw his or her application for registration, and may reapply for registration two years after the date of withdrawal. Upon reapplication for registration, the individual shall pay the fees required by § 1.21(a)(1)(ii) and (a)(10) of this subchapter, and has the burden of showing to the satisfaction of the OED Director his or her possession of good moral character and reputation as prescribed in paragraph (b) of this section. Upon reapplication for registration, the individual also shall complete successfully the examination prescribed in paragraph (b) of this section, even though the individual has previously passed a registration examination.

(l) *Transfer of status from agent to attorney.* An agent registered under § 11.6(b) may request registration as an attorney under § 11.6(a). The agent shall demonstrate his or her good standing as an attorney and pay the fee required by § 1.21(a)(2)(iii) of this chapter.

[69 FR 35452, June 24, 2004, as amended at 86 FR 28453, May 26, 2021]

§ 11.8 Oath and registration fee.

(a) After an individual passes the examination, or the examination is waived, the OED Director shall promptly publish a solicitation for information concerning the individual's good moral character and reputation. The solicitation shall include the individual's name, and business or communication postal address.

(b) An individual shall not be registered as an attorney under § 11.6(a), registered as an agent under § 11.6(b) or (c), or granted limited recognition under § 11.9(b) unless within two years of the mailing date of a notice of passing registration examination or of waiver of the examination the individual files with the OED Director a completed Data Sheet, an oath or declaration prescribed by the USPTO Director, and the registration fee set forth in § 1.21(a)(2) of this subchapter. An individual seeking registration as an attorney under § 11.6(a) must provide a certificate of good standing of the bar of the highest court of a State that is no more than six months old.

(c) An individual who does not comply with the requirements of paragraph (b) of this section within the two-year period will be required to retake the registration examination.

(d) [Reserved]

[69 FR 35452, June 24, 2004, as amended at 73 FR 67757, Nov. 17, 2008; 78 FR 20198, Apr. 3, 2013]

§ 11.9 Limited recognition in patent matters.

(a) Any individual not registered under § 11.6 may, upon a showing of circumstances that render it necessary or justifiable and that the individual is of good moral character and reputation, be given limited recognition by the OED Director to prosecute as attorney or agent a specified patent application or specified patent applications. Limited recognition under this paragraph shall not extend further than the application or applications specified. Limited recognition shall not be granted to individuals who have passed the examination or to those for whom the examination has been waived while such individual's application for registration

to practice before the Office in patent matters is pending.

(b) A nonimmigrant alien residing in the United States and fulfilling the provisions of paragraphs (d) and (e) of this section may be granted limited recognition if the nonimmigrant alien is authorized by the United States Government to be employed or trained in the United States in the capacity of representing a patent applicant by presenting or prosecuting a patent application. Limited recognition shall be granted for a period consistent with the terms of authorized employment or training. Limited recognition shall not be granted or extended to a non-United States citizen residing abroad. If granted, limited recognition shall automatically expire upon the nonimmigrant alien's departure from the United States.

(c) An individual not registered under § 11.6 may, if appointed by an applicant, prosecute an international patent application only before the United States International Searching Authority and the United States International Preliminary Examining Authority, provided that the individual has the right to practice before the national office with which the international application is filed as provided in PCT Art. 49, Rule 90 and § 1.455 of this subchapter, or before the International Bureau when the USPTO is acting as Receiving Office pursuant to PCT Rules 83.1 bis and 90.1.

(d) No individual will be granted limited recognition to practice before the Office under paragraph (b) of this section unless he or she has:

(1) Applied to the USPTO Director in writing by completing an application form supplied by the OED Director and furnishing all requested information and material; and

(2) Established to the satisfaction of the OED Director that he or she:

(i) Possesses good moral character and reputation;

(ii) Possesses the legal, scientific, and technical qualifications necessary for him or her to render applicants valuable service; and

(iii) Is competent to advise and assist patent applicants in the presentation and prosecution of their applications before the Office.

(e)(1) To enable the OED Director to determine whether an individual has the qualifications specified in paragraph (d)(2) of this section, the individual shall:

(i) File a complete application for limited recognition each time admission to the registration examination is requested. A complete application for limited recognition includes:

(A) An application for limited recognition form supplied by the OED Director wherein all requested information and supporting documents are furnished;

(B) Payment of the fees required by § 1.21(a)(1) of this chapter;

(C) Satisfactory proof of scientific and technical qualifications; and

(D) Satisfactory proof that the terms of the individual's immigration status or entry into the United States authorize employment or training in the preparation and prosecution of patents for others; and

(ii) Pass the registration examination. Each individual seeking limited recognition under this section must take and pass the registration examination to enable the OED Director to determine whether the individual possesses the legal and competence qualifications specified in paragraphs (d)(2)(ii) and (d)(2)(iii) of this section.

(2) An individual failing the examination may, upon receipt of notice of failure from OED, reapply for admission to the examination. An individual failing the examination for the first or second time must wait 30 days after the date the individual last took the examination before retaking the examination. An individual failing the examination for the third or fourth time must wait 90 days after the date the individual last took the examination before retaking the examination. An individual may not take the examination more than five times. However, upon petition under § 11.2(c), the OED Director may, at his or her discretion, waive this limitation upon such conditions as the OED Director may prescribe. An individual reapplying shall:

(i) File a complete application for limited recognition form, including all requested information and supporting documents not previously provided to OED;

(ii) Pay the application fee required by § 1.21(a)(1) of this chapter;

(iii) Provide satisfactory proof that the terms of the individual's immigration status or entry into the United States authorize employment or training in the preparation and prosecution of patents for others; and

(iv) Provide satisfactory proof of good moral character and reputation.

(3) An individual failing to file a complete application will not be admitted to the examination and will be notified of such deficiency. Applications for limited recognition that are incomplete will be considered only when the deficiency has been cured, provided that this occurs within 60 days of the mailing date of the notice of deficiency. Thereafter, a new and complete application for limited recognition must be filed. An individual seeking limited recognition under paragraph (b) of this section must satisfy the requirements of paragraph (e)(1)(i) of this section to be admitted to the examination.

(4)(i) A notice of admission shall be sent to those individuals who have been admitted to the registration examination. This notice shall specify a certain period of time in which to schedule and take the examination.

(ii) An individual may request an extension of this period of time by written request to the OED Director. Such request must be received by the OED Director prior to the expiration of the period specified in the notice, as extended by any previously granted extension, and must include the fee specified in § 1.21(a)(1)(iv). Upon the granting of the request, the period of time in which the individual may schedule and take the examination shall be extended by 90 days.

(iii) An individual who does not take the examination within the period of time specified in the notice may not take the examination without filing a new application for limited recognition as set forth in paragraph (e)(1)(i) of this section.

(f) *Applications for reinstatement of limited recognition.* (1) A person whose grant of limited recognition expired less than five years before the application for reinstatement may be reinstated provided the person:

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(i) Files a complete application that includes:

(A) A request for reinstatement with the fee required by § 1.21(a)(9)(ii); and

(B) Satisfactory proof that the terms of the individual's immigration status or entry into the United States authorize employment or training in the preparation and prosecution of patents for others; and

(ii) Provides satisfactory proof of good moral character and reputation.

(2) Persons whose grant of limited recognition expired five years or more before filing a complete application for reinstatement must comply with paragraph (f)(1) of this section and provide objective evidence that they continue to possess the necessary legal qualifications to render applicants valuable service to patent applicants.

[69 FR 35452, June 24, 2004, as amended at 78 FR 20198, Apr. 3, 2013; 86 FR 28453, May 26, 2021]

§ 11.10 Restrictions on practice in patent matters; former and current Office employees; government employees.

(a) Only practitioners registered under § 11.6; individuals given limited recognition under § 11.9(a) or (b) or § 11.16; or individuals admitted *pro hac vice* as provided in § 41.5(a) or 42.10(c) of this chapter are permitted to represent others before the Office in patent matters.

(b) *Post employment agreement of former Office employee.* No individual who has served in the patent examining corps or elsewhere in the Office may practice before the Office after termination of his or her service, unless he or she signs a written undertaking agreeing:

(1) To not knowingly act as agent or attorney for or otherwise represent any other person:

(i) Before the Office,

(ii) In connection with any particular patent or patent application,

(iii) In which said employee participated personally and substantially as an employee of the Office; and

(2) To not knowingly act within two years after terminating employment by the Office as agent or attorney for, or otherwise represent any other person:

(i) Before the Office,

(ii) In connection with any particular patent or patent application,

(iii) If such patent or patent application was pending under the employee's official responsibility as an officer or employee within a period of one year prior to the termination of such responsibility.

[86 FR 28454, May 26, 2021]

§ 11.11 Administrative suspension, inactivation, resignation, reinstatement, and revocation.

(a) *Contact information.* (1) A registered practitioner, or person granted limited recognition under § 11.9(b), must notify the OED Director of the postal address for their office, at least one and up to three email addresses where they receive email, and a business telephone number, as well as every change to each of said addresses and telephone number within thirty days of the date of the change. A registered practitioner, or person granted limited recognition under § 11.9(b), shall, in addition to any notice of change of address and telephone number filed in individual patent applications, separately file written notice of the change of address or telephone number with the OED Director. A registered practitioner, or person granted limited recognition under § 11.9(b), who is an attorney in good standing with the bar of the highest court of one or more states shall provide the OED Director with the identification number associated with each bar membership. The OED Director shall publish a list containing the name, postal business addresses, business telephone number, registration number or limited recognition number, and registration status as an attorney or agent of each registered practitioner, or person granted limited recognition under § 11.9(b), recognized to practice before the Office in patent matters.

(2) Biennially, registered practitioners and persons granted limited recognition may be required to file a registration statement with the OED Director for the purpose of ascertaining whether such practitioner desires to remain in an active status. Any registered practitioner, or person granted limited recognition under

§ 11.9(b), failing to file the registration statement or give any information requested by the OED Director within a time limit specified shall be subject to administrative suspension under paragraph (b) of this section.

(b) *Administrative suspension.* (1) Whenever it appears that a registered practitioner, or person granted limited recognition under § 11.9(b), has failed to comply with paragraph (a)(2) of this section, the OED Director shall publish and send a notice to the registered practitioner, or person granted limited recognition, advising of the noncompliance, the consequence of being administratively suspended set forth in paragraph (b)(6) of this section if noncompliance is not timely remedied, and the requirements for reinstatement under paragraph (f) of this section. The notice shall be published and sent to the registered practitioner, or person granted limited recognition, by mail to the last postal address furnished under paragraph (a) of this section or by email addressed to the last email address furnished under paragraph (a) of this section. The notice shall demand compliance and payment of a delinquency fee set forth in § 1.21(a)(9)(i) of this chapter within 60 days after the date of such notice.

(2) In the event a practitioner fails to comply with the requirements specified in a notice provided pursuant to paragraph (b)(1) of this section within the time allowed, the OED Director shall publish and send to the practitioner a notice to show cause why the practitioner should not be administratively suspended. Such notice shall be sent in the same manner as set forth in paragraph (b)(1) of this section. The OED Director shall file a copy of the notice to show cause with the USPTO Director.

(3) A practitioner to whom a notice to show cause under this section has been issued shall be allowed 30 days from the date of the notice to show cause to file a response with the USPTO Director. The response should address any factual and legal bases why the practitioner should not be administratively suspended. The practitioner shall serve the OED Director with a copy of the response at the time it is filed with the USPTO Director.

Within 10 days of receiving a copy of the response, the OED Director may file a reply with the USPTO Director. A copy of the reply by the OED Director shall be sent to the practitioner at the practitioner's address of record. If the USPTO Director determines that there are no genuine issues of material fact regarding the Office's compliance with the notice requirements under this section or the failure of the practitioner to pay the requisite fees, the USPTO Director shall enter an order administratively suspending the practitioner. Otherwise, the USPTO Director shall enter an appropriate order dismissing the notice to show cause. Any request for reconsideration of the USPTO Director's decision must be filed within 20 days after the date such decision is rendered by the USPTO Director. Nothing herein shall permit an administratively suspended practitioner to seek a stay of the suspension during the pendency of any review of the USPTO Director's final decision. If, prior to the USPTO Director entering an order under this section, the OED Director determines that a practitioner has complied with requirements specified in the notice to show cause, the OED Director may withdraw the notice to show cause, and the practitioner will not be administratively suspended.

(4) [Reserved]

(5) A practitioner is subject to investigation and discipline for his or her conduct prior to, during, or after the period he or she was administratively suspended.

(6) A practitioner is prohibited from practicing before the Office in patent matters while administratively suspended. A practitioner who knows he or she has been administratively suspended is subject to discipline for failing to comply with the provisions of this paragraph and shall comply with the provisions of § 11.116.

(7) An administratively suspended practitioner may request reinstatement by complying with paragraph (f)(1) of this section.

(c) *Administrative inactivation.* (1) Any registered practitioner who shall become employed by the Office shall comply with § 11.116 for withdrawal from all patent, trademark, and other non-patent matters wherein he or she

represents an applicant or other person, and notify the OED Director in writing of said employment on the first day of said employment. The name of any registered practitioner employed by the Office shall be endorsed on the register as administratively inactive. Upon separation from the Office, an administratively inactive practitioner may request reactivation by complying with paragraph (f)(2) of this section.

(2) Any registered practitioner who is a judge of a court of record, full-time court commissioner, U.S. bankruptcy judge, U.S. magistrate judge, or a retired judge who is eligible for temporary judicial assignment and is not engaged in the practice of law may request, in writing, that his or her name be endorsed on the register as administratively inactive. Upon acceptance of the request, the OED Director shall endorse the name of the practitioner as administratively inactive. Following separation from the bench, the practitioner may request reactivation by complying with paragraph (f)(2) of this section.

(3) An administratively inactive practitioner remains subject to the provisions of the USPTO Rules of Professional Conduct and to proceedings and sanctions under §§11.19 through 11.58 for conduct that violates a provision of the USPTO Rules of Professional Conduct prior to or during such administrative inactivity.

(d) *Voluntary inactivation.* (1) Any registered practitioner may voluntarily enter inactive status by filing a request, in writing, that his or her name be endorsed on the roster as voluntarily inactive. Upon acceptance of the request, the OED Director shall endorse the name as voluntarily inactive.

(2) [Reserved]

(3) A registered practitioner who seeks or enters into voluntary inactive status is subject to investigation and discipline for his or her conduct prior to, during, or after the period of his or her inactivation.

(4) [Reserved]

(5) A registered practitioner in voluntary inactive status is prohibited from practicing before the Office in patent cases while in voluntary inactive status. A registered practitioner in voluntary inactive status will be sub-

ject to discipline for failing to comply with the provisions of this paragraph. Upon acceptance of the request for voluntary inactive status, the practitioner must comply with the provisions of §11.116.

(6) Any registered practitioner whose name has been endorsed as voluntarily inactive pursuant to paragraph (d)(1) of this section and is not under investigation and not subject to a disciplinary proceeding may be restored to active status on the register as may be appropriate, provided that the practitioner files a written request for restoration, a completed application for registration on a form supplied by the OED Director furnishing all requested information and material, including information and material pertaining to the practitioner's moral character and reputation under §11.7(a)(2)(i) during the period of inactivation, a declaration or affidavit attesting to the fact that the practitioner has read the most recent revisions of the patent laws and the rules of practice before the Office, and pays the fees set forth in §1.21(a)(7)(iii) and (iv) of this subchapter.

(e) *Resignation.* A registered practitioner or a practitioner recognized under §11.14(c) may request to resign by notifying the OED Director in writing of such intent, unless such practitioner is under investigation under §11.22 for a possible violation of the USPTO Rules of Professional Conduct, is a practitioner against whom probable cause has been found by a panel of the Committee on Discipline under §11.23(b), or is a respondent in a pending proceeding instituted under §11.24, §11.25, or §11.29. Upon acceptance in writing by the OED Director of such request, that practitioner shall no longer be eligible to practice before the Office in patent matters but shall continue to file a change of address for five years thereafter in order that he or she may be located in the event information regarding the practitioner's conduct comes to the attention of the OED Director or any grievance is made about his or her conduct while he or she engaged in practice before the Office. The name of any practitioner whose resignation is accepted shall be endorsed

as resigned, and notice thereof published in the Official Gazette. Upon acceptance of the resignation by the OED Director, the practitioner must comply with the provisions of § 11.116. A practitioner is subject to investigation and discipline for his or her conduct that occurred prior to, during, or after the period of his or her resignation.

(f) *Administrative reinstatement.* (1)(i) Any administratively suspended registered practitioner, or person granted limited recognition under § 11.9(b), may be reinstated provided the practitioner:

(A) Is not the subject of a disciplinary investigation or a party to a disciplinary proceeding;

(B) Has applied for reinstatement on an application form supplied by the OED Director;

(C) Has demonstrated good moral character and reputation and competence in advising and assisting patent applicants in the presentation and prosecution of their applications before the Office;

(D) Has submitted a declaration or affidavit attesting to the fact that the practitioner has read the most recent revisions of the patent laws and the rules of practice before the Office;

(E) Has paid the fees set forth in § 1.21(a)(9)(ii) of this chapter; and

(F) Has paid all applicable delinquency fees as set forth in § 1.21(a)(9)(i) of this chapter.

(ii) Any administratively suspended registered practitioner, or person granted limited recognition, who applies for reinstatement more than five years after the effective date of the administrative suspension, additionally shall be required to file a petition to the OED Director requesting reinstatement and providing objective evidence that they continue to possess the necessary legal qualifications to render valuable service to patent applicants.

(2)(i) A practitioner who has been administratively inactivated pursuant to paragraph (c) of this section may be reactivated after his or her employment with the Office ceases or his or her employment in a judicial capacity ceases, provided the following is filed with the OED Director:

(A) A completed application for reactivation on a form supplied by the OED Director;

(B) A data sheet;

(C) A signed written undertaking required by § 11.10(b); and

(D) The fee set forth in § 1.21(a)(9)(ii) of this chapter.

(ii) Administratively inactive practitioners who have been separated from the Office or have ceased to be employed in a judicial capacity for five or more years prior to filing a complete application for reactivation shall be required to provide objective evidence that they continue to possess the necessary legal qualifications to render valuable service to patent applicants.

(3)(i) Any registered practitioner who has been endorsed as resigned pursuant to paragraph (e) of this section may be reinstated on the register provided the practitioner:

(A) Is not the subject of a disciplinary investigation or a party to a disciplinary proceeding;

(B) Has applied for reinstatement on an application form supplied by the OED Director;

(C) Has demonstrated good moral character and reputation and competence in advising and assisting patent applicants in the presentation and prosecution of their applications before the Office;

(D) Has submitted a declaration or affidavit attesting to the fact that the practitioner has read the most recent revisions of the patent laws and the rules of practice before the Office;

(E) Has paid the fees set forth in § 1.21(a)(9)(ii) of this chapter; and

(F) Has paid all applicable delinquency fees as set forth in § 1.21(a)(9)(i) of this chapter.

(ii) Any resigned registered practitioner who applies for reinstatement more than five years after the effective date of the resignation additionally shall be required to file a petition to the OED Director requesting reinstatement and providing objective evidence that they continue to possess the necessary legal qualifications to render valuable service to patent applicants.

(g) *Administrative revocation.* (1) The USPTO Director may revoke an individual's registration or limited recognition if:

(i) The registration or limited recognition was issued through mistake or inadvertence, or

(ii) The individual's application for registration or limited recognition contains materially false information or omits material information.

(2) Whenever it appears that grounds for administrative revocation exist, the OED Director shall issue to the individual a notice to show cause why the individual's registration or limited recognition should not be revoked.

(i) The notice to show cause shall be served on the individual in the same manner as described in § 11.35.

(ii) The notice to show cause shall state the grounds for the proposed revocation.

(iii) The OED Director shall file a copy of the notice to show cause with the USPTO Director.

(3) Within 30 days after service of the notice to show cause, the individual may file a response to the notice to show cause with the USPTO Director. The response should address any factual or legal bases why the individual's registration or limited recognition should not be revoked. The individual shall serve the OED Director with a copy of the response at the time it is filed with the USPTO Director. Within 10 days of receiving a copy of the response, the OED Director may file a reply with the USPTO Director. A copy of the reply by the OED Director shall be sent to the individual at the individual's address of record.

(4) If the USPTO Director determines that there are no genuine issues of material fact regarding the Office's compliance with the notice requirements under this section or the grounds for the notice to show cause, the USPTO Director shall enter an order revoking the individual's registration or limited recognition. Otherwise, the USPTO Director shall enter an appropriate order dismissing the notice to show cause. An oral hearing will not be granted unless so ordered by the USPTO Director, upon a finding that such hearing is necessary. Any request for reconsideration of the USPTO Director's decision must be filed within 20 days after the date such decision is rendered by the USPTO Director. Nothing herein shall permit an individual to seek a stay of the revocation during the pendency of

any review of the USPTO Director's final decision.

[86 FR 28455, May 26, 2021, as amended at 87 FR 68057, Nov. 14, 2022]

§§ 11.12–11.13 [Reserved]

§ 11.14 Individuals who may practice before the Office in trademark and other non-patent matters.

(a) *Attorneys.* Any individual who is an attorney as defined in § 11.1 may represent others before the Office in trademark and other non-patent matters. An attorney is not required to apply for registration or recognition to practice before the Office in trademark and other non-patent matters. Registration as a patent practitioner does not itself entitle an individual to practice before the Office in trademark matters.

(b) *Non-lawyers.* Individuals who are not attorneys are not recognized to practice before the Office in trademark and other non-patent matters, except that individuals not attorneys who were recognized to practice before the Office in trademark matters under this chapter prior to January 1, 1957, will be recognized as agents to continue practice before the Office in trademark matters. Except as provided in the preceding sentence, registration as a patent agent does not itself entitle an individual to practice before the Office in trademark matters.

(c) *Foreigners.* (1) Any foreign attorney or agent not a resident of the United States who shall file a written application for reciprocal recognition under paragraph (f) of this section and prove to the satisfaction of the OED Director that he or she is a registered and active member in good standing before the trademark office of the country in which he or she resides and practices and possesses good moral character and reputation, may be recognized for the limited purpose of representing parties located in such country before the Office in the presentation and prosecution of trademark matters, provided: The trademark office of such country and the USPTO have reached an official understanding to allow substantially reciprocal privileges to those permitted to practice in trademark matters before the Office.

Recognition under this paragraph (c) shall continue only during the period that the conditions specified in this paragraph (c) obtain.

(2) In any trademark matter where a foreign attorney or agent authorized under paragraph (c)(1) of this section is representing an applicant, registrant, or party to a proceeding, an attorney, as defined in § 11.1 and qualified to practice under paragraph (a) of this section, must also be appointed pursuant to § 2.17(b) and (c) of this chapter as the representative who will file documents with the Office and with whom the Office will correspond.

(d) Recognition of any individual under this section shall not be construed as sanctioning or authorizing the performance of any act regarded in the jurisdiction where performed as the unauthorized practice of law.

(e) *Appearance.* No individual other than those specified in paragraphs (a), (b), and (c) of this section will be permitted to practice before the Office in trademark matters on behalf of a client. Except as specified in § 2.11(a) of this chapter, an individual may appear in a trademark or other non-patent matter in his or her own behalf or on behalf of:

(1) A firm of which he or she is a member;

(2) A partnership of which he or she is a partner; or

(3) A corporation or association of which he or she is an officer and which he or she is authorized to represent.

(f) *Application for reciprocal recognition.* An individual seeking reciprocal recognition under paragraph (c) of this section, in addition to providing evidence satisfying the provisions of paragraph (c) of this section, shall apply in writing to the OED Director for reciprocal recognition, and shall pay the application fee required by § 1.21(a)(1)(i) of this subchapter.

[73 FR 47688, Aug. 14, 2008, as amended at 84 FR 31511, July 2, 2019]

§ 11.15 Refusal to recognize a practitioner.

Any practitioner authorized to appear before the Office may be suspended, excluded, or reprimanded in accordance with the provisions of this Part. Any practitioner who is sus-

pended or excluded under this Part shall not be entitled to practice before the Office in patent, trademark, or other non-patent matters while suspended or excluded.

[73 FR 47688, Aug. 14, 2008]

§ 11.16 Requirements for admission to the USPTO Law School Clinic Certification Program.

(a) The USPTO Law School Clinic Certification Program allows students enrolled in a participating law school's clinic to practice before the Office in patent or trademark matters by drafting, filing, and prosecuting patent or trademark applications on a *pro bono* basis for clients that qualify for assistance from the law school's clinic. All law schools accredited by the American Bar Association are eligible for participation in the program, and shall be examined for acceptance using identical criteria.

(b) *Application for admission and renewal*—(1) *Application for admission.* Non-participating law schools seeking admission to the USPTO Law School Clinic Certification Program, and participating law schools seeking to add a practice area, shall submit an application for admission for such practice area to OED in accordance with criteria and time periods set forth by the OED Director.

(2) *Renewal application.* Each participating law school desiring to continue in the USPTO Law School Clinic Certification Program shall, biennially from a date assigned to the law school by the OED Director, submit a renewal application to OED in accordance with criteria set forth by the OED Director.

(3) The OED Director may refuse admission or renewal of a law school to the USPTO Law School Clinic Certification Program if the OED Director determines that admission, or renewal, of the law school would fail to provide significant benefit to the public or the law students participating in the law school's clinic.

(c) *Faculty Clinic Supervisor.* Any law school seeking admission to or participating in the USPTO Law School Clinic Certification Program must have at least one Faculty Clinic Supervisor for the patent practice area, if the clinic includes patent practice; and at least

one Faculty Clinic Supervisor for the trademark practice area, if the clinic includes trademark practice.

(1) *Patent Faculty Clinic Supervisor.* A Faculty Clinic Supervisor for a law school clinic's patent practice must:

(i) Be a registered patent practitioner in active status and good standing with OED;

(ii) Demonstrate at least 3 years experience in prosecuting patent applications before the Office within the 5 years immediately prior to the request for approval as a Faculty Clinic Supervisor;

(iii) Assume full responsibility for the instruction and guidance of law students participating in the law school clinic's patent practice;

(iv) Assume full responsibility for all patent applications and legal services, including filings with the Office, produced by the clinic; and

(v) Comply with all additional criteria established by the OED Director.

(2) *Trademark Faculty Clinic Supervisor.* A Faculty Clinic Supervisor for a law school clinic's trademark practice must:

(i) Be an attorney as defined in § 11.1;

(ii) Demonstrate at least 3 years experience in prosecuting trademark applications before the Office within the 5 years immediately prior to the date of the request for approval as a Faculty Clinic Supervisor;

(iii) Assume full responsibility for the instruction, guidance, and supervision of law students participating in the law school clinic's trademark practice;

(iv) Assume full responsibility for all trademark applications and legal services, including filings with the Office, produced by the clinic; and

(v) Comply with all additional criteria established by the OED Director.

(3) A Faculty Clinic Supervisor under paragraph (c) of this section must submit a statement:

(i) Assuming responsibility for performing conflicts checks for each law student and client in the relevant clinic practice area;

(ii) Assuming responsibility for student instruction and work, including instructing, mentoring, overseeing, and supervising all participating law school

students in the clinic's relevant practice area;

(iii) Assuming responsibility for content and timeliness of all applications and documents submitted to the Office through the relevant practice area of the clinic;

(iv) Assuming responsibility for all communications by clinic students to clinic clients in the relevant clinic practice area;

(v) Assuming responsibility for ensuring that there is no gap in representation of clinic clients in the relevant practice area during student turnover, school schedule variations, inter-semester transitions, or other disruptions;

(vi) Attesting to meeting the criteria of paragraph (c)(1) or (2) of this section based on relevant practice area of the clinic; and

(vii) Attesting to all other criteria as established by the OED Director.

(d) *Limited recognition for law students participating in the USPTO Law School Clinic Certification Program.* (1) The OED Director may grant limited recognition to practice before the Office in patent or trademark matters, or both, to law school students enrolled in a clinic of a law school that is participating in the USPTO Law School Clinic Certification Program upon submission and approval of an application by a law student to OED in accordance with criteria established by the OED Director.

(2) In order to be granted limited recognition to practice before the Office in patent matters under the USPTO Law School Clinic Certification Program, a law student must:

(i) Be enrolled in a law school that is an active participant in the USPTO Law School Clinic Certification Program;

(ii) Be enrolled in the patent practice area of a clinic of the participating law school;

(iii) Have successfully completed at least one year of law school or the equivalent;

(iv) Have read the USPTO Rules of Professional Conduct and the relevant rules of practice and procedure for patent matters;

(v) Be supervised by an approved Faculty Clinic Supervisor pursuant to paragraph (c)(1) of this section;

(vi) Be certified by the dean of the participating law school, or one authorized to act for the dean, as: Having completed the first year of law school or the equivalent, being in compliance with the law school's ethics code, and being of good moral character and reputation;

(vii) Neither ask for nor receive any fee or compensation of any kind for legal services from a clinic client on whose behalf service is rendered;

(viii) Have proved to the satisfaction of the OED Director that he or she possesses the scientific and technical qualifications necessary for him or her to render patent applicants valuable service; and

(ix) Comply with all additional criteria established by the OED Director.

(3) In order to be granted limited recognition to practice before the Office in trademark matters under the USPTO Law School Clinic Certification Program, a law student must:

(i) Be enrolled in a law school that is an active participant in the USPTO Law School Clinic Certification Program;

(ii) Be enrolled in the trademark practice area of a clinic of the participating law school;

(iii) Have successfully completed at least one year of law school or the equivalent;

(iv) Have read the USPTO Rules of Professional Conduct and the relevant USPTO rules of practice and procedure for trademark matters;

(v) Be supervised by an approved Faculty Clinic Supervisor pursuant to paragraph (c)(2) of this section;

(vi) Be certified by the dean of the participating law school, or one authorized to act for the dean, as: Having completed the first year of law school or the equivalent, being in compliance with the law school's ethics code, and being of good moral character and reputation;

(vii) Neither ask for nor receive any fee or compensation of any kind for legal services from a clinic client on whose behalf service is rendered; and

(viii) Comply with all additional criteria established by the OED Director.

(4) Students registered to practice before the Office in patent matters as a patent agent, or authorized to practice

before the Office in trademark matters under § 11.14, must complete and submit a student application pursuant to paragraph (d)(1) of this section and meet the criteria of paragraph (d)(2) or (3) of this section, as applicable, in order to participate in the program.

[81 FR 33596, May 27, 2016]

§ 11.17 Requirements for participation in the USPTO Law School Clinic Certification Program.

(a) Each law school participating in the USPTO Law School Clinic Certification Program must provide its patent and/or trademark services on a *pro bono* basis.

(b) Each law school participating in the USPTO Law School Clinic Certification Program shall, on a semi-annual basis, provide OED with a report regarding its clinic activity during the reporting period, which shall include:

(1) The number of law students participating in each of the patent and trademark practice areas of the school's clinic;

(2) The number of faculty participating in each of the patent and trademark practice areas of the school's clinic;

(3) The number of persons to whom the school's clinic provided assistance in any given patent or trademark matter but with whom no practitioner-client relationship had formed;

(4) The number of client representations undertaken for each of the patent and trademark practice areas of the school's clinic;

(5) The identity and number of applications and responses filed in each of the patent and/or trademark practice areas of the school's clinic;

(6) The number of patents issued, or trademarks registered, to clients of the clinic; and

(7) All other information specified by the OED Director.

(c) *Inactivation of law schools participating in the USPTO Law School Certification Program.* (1) The OED Director may inactivate a patent and/or trademark practice area of a participating law school:

(i) If the participating law school does not have an approved Faculty Clinic Supervisor for the relevant practice area, as described in § 11.16(c);

(ii) If the participating law school does not meet each of the requirements and criteria for participation in the USPTO Law School Clinic Certification Program as set forth in §11.16, this section, or as otherwise established by the OED Director; or

(iii) For other good cause as determined by the OED Director.

(2) In the event that a practice area of a participating school is inactivated, the participating law school students must:

(i) Immediately cease all student practice before the Office in the relevant practice area and notify each client of such; and

(ii) Disassociate themselves from all client matters relating to practice before the Office in the relevant practice area, including complying with Office and State rules for withdrawal from representation.

(3) A patent or trademark practice area of a law school clinic that has been inactivated may be restored to active status, upon application to and approval by the OED Director.

(d) *Removal of law schools participating in the USPTO Law School Clinic Certification Program.* (1) The OED Director may remove a patent and/or trademark practice area of the clinic of a law school participating in the USPTO Law School Clinic Certification Program:

(i) Upon request from the law school;

(ii) If the participating law school does not meet each of the requirements and criteria for participation in the USPTO Law School Clinic Certification Program as set forth in §11.16, this section, or as otherwise established by the OED Director; or

(iii) For other good cause as determined by the OED Director.

(2) In the event that a practice area of a participating school is removed by the OED Director, the participating law school students must:

(i) Immediately cease all student practice before the Office in the relevant practice area and notify each client of such; and

(ii) Disassociate themselves from all client matters relating to practice before the Office in the relevant practice area, including complying with Office and State rules for withdrawal from representation.

(3) A school that has been removed from participation in the USPTO Law School Clinic Certification Program under this section may reapply to the program in compliance with §11.16.

[81 FR 33597, May 27, 2016]

§ 11.18 Signature and certificate for correspondence filed in the Office.

(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, and all documents filed with a hearing officer in a disciplinary proceeding, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Office must bear a signature, personally signed or inserted by such practitioner, in compliance with §1.4(d) or §2.193(a) of this chapter.

(b) By presenting to the Office or hearing officer in a disciplinary proceeding (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that—

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or knowingly and willfully makes any false, fictitious, or fraudulent statements or representations, or knowingly and willfully makes or uses any false writing or document knowing the same to contain any false, fictitious, or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001 and any other applicable criminal statute, and violations of the provisions of this section may jeopardize the probative value of the paper; and

(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances,

(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the

cost of any proceeding before the Office;

(ii) The other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

(c) Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions or actions as deemed appropriate by the USPTO Director, which may include, but are not limited to, any combination of—

(1) Striking the offending paper;

(2) Referring a practitioner's conduct to the Director of the Office of Enrollment and Discipline for appropriate action;

(3) Precluding a party or practitioner from submitting a paper, or presenting or contesting an issue;

(4) Affecting the weight given to the offending paper; or

(5) Terminating the proceedings in the Office.

(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action.

[73 FR 47689, Aug. 14, 2008, as amended at 74 FR 54912, Oct. 26, 2009; 78 FR 62409, Oct. 21, 2013; 86 FR 28457, May 26, 2021]

Subpart C—Investigations and Disciplinary Proceedings; Jurisdiction, Sanctions, Investigations, and Proceedings

SOURCE: 73 FR 47689, Aug. 14, 2008, unless otherwise noted.

§ 11.19 Disciplinary jurisdiction; grounds for discipline and for transfer to disability inactive status.

(a) *Disciplinary jurisdiction.* All practitioners engaged in practice before the Office; all practitioners administratively suspended under § 11.11; all practitioners registered or recognized to practice before the Office in patent matters; all practitioners resigned, inactivated, or in emeritus status under § 11.11; all practitioners authorized under § 41.5(a) or 42.10(c) of this chapter; and all practitioners transferred to disability inactive status or publicly disciplined by a duly constituted authority are subject to the disciplinary jurisdiction of the Office and subject to being transferred to disability inactive status. A non-practitioner is also subject to the disciplinary authority of the Office if the person engages in or offers to engage in practice before the Office without proper authority.

(b) *Grounds for discipline; Grounds for transfer to disability inactive status.* The following, whether done individually by a practitioner or in concert with any other person or persons and whether or not done in the course of providing legal services to a client, or in a matter pending before the Office, constitute grounds for discipline or grounds for transfer to disability inactive status.

(1) Grounds for discipline include:

(i) Conviction of a serious crime;

(ii) Discipline on ethical or professional misconduct grounds imposed in another jurisdiction or disciplinary disqualification from participating in or appearing before any Federal program or agency;

(iii) Failure to comply with any order of a Court disciplining a practitioner, or any final decision of the USPTO Director in a disciplinary matter;

(iv) Violation of any USPTO Rule of Professional Conduct; or

(v) Violation of the oath or declaration taken by the practitioner. See § 11.8.

(2) Grounds for transfer to disability inactive status include:

(i) Being transferred to disability inactive status in another jurisdiction;

(ii) Being judicially declared incompetent, being judicially ordered to be

§ 11.20

involuntarily committed after a hearing on the grounds of insanity, incompetency or disability, or being placed by court order under guardianship or conservatorship; or

(iii) Filing a motion requesting a disciplinary proceeding be held in abeyance because the practitioner is suffering from a disability or addiction that makes it impossible for the practitioner to adequately defend the charges in the disciplinary proceeding.

(c) Petitions to disqualify a practitioner in *ex parte* or *inter partes* matters in the Office are not governed by this subpart and will be handled on a case-by-case basis under such conditions as the USPTO Director deems appropriate.

(d) The OED Director may refer the existence of circumstances suggesting unauthorized practice of law to the authorities in the appropriate jurisdiction(s).

(e) The OED Director has the discretion to choose any of the independent grounds of discipline under paragraph (b) of this section and to pursue any of the procedures set forth in this subpart in every disciplinary proceeding.

[73 FR 47689, Aug. 14, 2008, as amended at 78 FR 20200, Apr. 3, 2013; 86 FR 28457, May 26, 2021]

§ 11.20 Disciplinary sanctions; Transfer to disability inactive status.

(a) *Types of discipline.* The USPTO Director, after notice and opportunity for a hearing, and where grounds for discipline exist, may impose on a practitioner the following types of discipline:

(1) Exclusion from practice before the Office;

(2) Suspension from practice before the Office for an appropriate period of time;

(3) Reprimand or censure; or

(4) *Probation.* Probation may be imposed in lieu of or in addition to any other disciplinary sanction. The conditions of probation shall be stated in the order imposing probation. Violation of any condition of probation shall be cause for imposition of the disciplinary sanction. Imposition of the disciplinary sanction predicated upon violation of probation shall occur only after a notice to show cause why the disciplinary

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sanction should not be imposed is resolved adversely to the practitioner.

(b) *Conditions imposed with discipline.* When imposing discipline, the USPTO Director may condition reinstatement upon the practitioner making restitution, successfully completing a professional responsibility course or examination, or any other condition deemed appropriate under the circumstances.

(c) *Transfer to disability inactive status.* As set forth in § 11.29, the USPTO Director, after notice and opportunity for a hearing, may transfer a practitioner to disability inactive status where grounds exist to believe the practitioner has been transferred to disability inactive status in another jurisdiction, has been judicially declared incompetent, has been judicially ordered to be involuntarily committed after a hearing on the grounds of incompetency or disability, or has been placed by court order under guardianship or conservatorship.

[73 FR 47689, Aug. 14, 2008, as amended at 78 FR 20200, Apr. 3, 2013; 86 FR 28457, May 26, 2021]

§ 11.21 Warnings.

A warning is neither public nor a disciplinary sanction. The OED Director may conclude an investigation with the issuance of a warning. The warning shall contain a statement of facts and identify the USPTO Rules of Professional Conduct relevant to the facts.

[86 FR 28458, May 26, 2021]

§ 11.22 Disciplinary investigations.

(a) The OED Director is authorized to investigate possible grounds for discipline. An investigation may be initiated when the OED Director receives a grievance, information or evidence from any source suggesting possible grounds for discipline. Neither unwillingness nor neglect by a grievant to prosecute a charge, nor settlement, compromise, or restitution with the grievant, shall in itself justify abatement of an investigation.

(b) Any person possessing information or evidence concerning possible grounds for discipline of a practitioner may report the information or evidence to the OED Director. The OED Director

may request that the report be presented in the form of an affidavit or declaration.

(c) *Notice to the OED Director.* Upon receiving the notification required by § 11.24(a), 11.25(a), or 11.29(a), the OED Director shall obtain a certified copy of the record or order regarding such discipline, disqualification, conviction, or transfer. A certified copy of the record or order regarding the discipline, disqualification, conviction, or transfer shall be clear and convincing evidence that the practitioner has been disciplined, disqualified, convicted of a crime, or transferred to disability status by another jurisdiction.

(d) *Preliminary screening of information or evidence.* The OED Director shall examine all information or evidence concerning possible grounds for discipline of a practitioner.

(e) *Notification of investigation.* The OED Director shall notify the practitioner in writing of the initiation of an investigation into whether a practitioner has engaged in conduct constituting possible grounds for discipline.

(f) *Request for information and evidence by OED Director.*

(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.

(2) The OED Director may request information and evidence regarding possible grounds for discipline of a practitioner from a non-grieving client either after obtaining the consent of the practitioner or upon a finding by a Contact Member of the Committee on Discipline, appointed in accordance with § 11.23(d), that good cause exists to believe that the possible ground for discipline alleged has occurred with respect to non-grieving clients. Neither a request for, nor disclosure of, such information shall constitute a violation of any USPTO Rules of Professional Conduct.

(g) Where the OED Director makes a request under paragraph (f)(2) of this

section to a Contact Member of the Committee on Discipline, such Contact Member shall not, with respect to the practitioner connected to the OED Director's request, participate in the Committee on Discipline panel that renders a probable cause determination under § 11.23(b) concerning such practitioner.

(h) *Disposition of investigation.* Upon the conclusion of an investigation, the OED Director may take appropriate action, including but not limited to:

(1) Closing the investigation without issuing a warning or taking disciplinary action;

(2) Issuing a warning to the practitioner;

(3) Instituting formal charges upon the approval of the Committee on Discipline; or

(4) Entering into a settlement agreement with the practitioner and submitting the same for approval of the USPTO Director.

(i) *Closing investigation.* The OED Director shall terminate an investigation and decline to refer a matter to the Committee on Discipline if the OED Director determines that:

(1) The information or evidence is unfounded;

(2) The information or evidence relates to matters not within the jurisdiction of the Office;

(3) As a matter of law, the conduct about which information or evidence has been obtained does not constitute grounds for discipline, even if the conduct may involve a legal dispute; or

(4) The available evidence is insufficient to conclude that there is probable cause to believe that grounds exist for discipline.

[73 FR 47689, Aug. 14, 2008, as amended at 77 FR 45251, July 31, 2012; 78 FR 20200, Apr. 3, 2013; 86 FR 28458, May 26, 2021]

§ 11.23 Committee on Discipline.

(a) The USPTO Director shall appoint a Committee on Discipline. The Committee on Discipline shall consist of at least three employees of the Office. None of the Committee members shall report directly or indirectly to the OED Director or any employee designated by the USPTO Director to decide disciplinary matters. Each Committee member shall be a member in

good standing of the bar of the highest court of a State. The Committee members shall select a Chairperson from among themselves. Three Committee members will constitute a panel of the Committee.

(b) *Powers and duties of the Committee on Discipline.* The Committee shall have the power and duty to:

(1) Meet in panels at the request of the OED Director and, after reviewing evidence presented by the OED Director, by majority vote of the panel, determine whether there is probable cause to bring charges under § 11.32 against a practitioner; and

(2) Prepare and forward its own probable cause findings and recommendations to the OED Director.

(c) No discovery shall be authorized of, and no member of the Committee on Discipline shall be required to testify about deliberations of, the Committee on Discipline or of any panel.

(d) The Chairperson shall appoint the members of the panels and a Contact Member of the Committee on Discipline.

§ 11.24 Reciprocal discipline.

(a) *Notice to the OED Director.* Within 30 days of being publicly censured, publicly reprimanded, subjected to probation, disbarred or suspended by another jurisdiction, or disciplinarily disqualified from participating in or appearing before any Federal program or agency, a practitioner subject to the disciplinary jurisdiction of the Office shall notify the OED Director in writing of the same. A practitioner is deemed to be disbarred if he or she is disbarred, is excluded on consent, or has resigned in lieu of discipline or a disciplinary proceeding. Upon receiving notification from any source or otherwise learning that a practitioner subject to the disciplinary jurisdiction of the Office has been publicly censured, publicly reprimanded, subjected to probation, disbarred, suspended, or disciplinarily disqualified, the OED Director shall obtain a certified copy of the record or order regarding the public censure, public reprimand, probation, disbarment, suspension, or disciplinary disqualification. A certified copy of the record or order regarding the discipline shall establish a prima facie case by

clear and convincing evidence that the practitioner has been publicly censured, publicly reprimanded, subjected to probation, disbarred, suspended, or disciplinarily disqualified by another jurisdiction. In addition to the actions identified in § 11.22(h) and (i), the OED Director may, without Committee on Discipline authorization, file with the USPTO Director a complaint complying with § 11.34 against the practitioner predicated upon the public censure, public reprimand, probation, disbarment, suspension, or disciplinary disqualification. The OED Director may request the USPTO Director to issue a notice and order as set forth in paragraph (b) of this section.

(b) *Notification served on practitioner.* Upon receipt of the complaint and request for notice and order, the USPTO Director shall issue a notice directed to the practitioner in accordance with § 11.35 and to the OED Director containing:

(1) A copy of the record or order regarding the public censure, public reprimand, probation, disbarment, suspension or disciplinary disqualification;

(2) A copy of the complaint; and

(3) An order directing the practitioner to file a response with the USPTO Director and the OED Director, within forty days of the date of the notice establishing a genuine issue of material fact predicated upon the grounds set forth in paragraphs (d)(1)(i) through (d)(1)(iv) of this section that the imposition of the identical public censure, public reprimand, probation, disbarment, suspension or disciplinary disqualification would be unwarranted and the reasons for that claim.

(c) *Effect of stay in another jurisdiction.* In the event the public censure, public reprimand, probation, disbarment, suspension imposed by another jurisdiction or disciplinary disqualification imposed in the Federal program or agency has been stayed, any reciprocal discipline imposed by the USPTO may be deferred until the stay expires.

(d) *Hearing and discipline to be imposed.* (1) The USPTO Director shall hear the matter on the documentary record unless the USPTO Director determines that an oral hearing is necessary. The USPTO Director may order

the OED Director or the practitioner to supplement the record with further information or argument. After expiration of the period specified in paragraph (b)(3) of this section, the USPTO Director shall consider the record and shall impose the identical public censure, public reprimand, probation, disbarment, suspension, or disciplinary disqualification unless the practitioner demonstrates by clear and convincing evidence, and the USPTO Director finds there is a genuine issue of material fact that:

(i) The procedure elsewhere was so lacking in notice or opportunity to be heard as to constitute a deprivation of due process;

(ii) There was such infirmity of proof establishing the conduct as to give rise to the clear conviction that the Office could not, consistently with its duty, accept as final the conclusion on that subject;

(iii) The imposition of the same public censure, public reprimand, probation, disbarment, suspension or disciplinary disqualification by the Office would result in grave injustice; or

(iv) Any argument that the practitioner was not publicly censured, publicly reprimanded, placed on probation, disbarred, suspended or disciplinarily disqualified.

(2) If the USPTO Director determines that there is no genuine issue of material fact, the USPTO Director shall enter an appropriate final order. If the USPTO Director is unable to make such determination because there is a genuine issue of material fact, the USPTO Director shall enter an appropriate order:

(i) Referring the complaint to a hearing officer for a formal hearing and entry of an initial decision in accordance with the other rules in this part, and

(ii) Directing the practitioner to file an answer to the complaint in accordance with § 11.36.

(e) *Adjudication in another jurisdiction or Federal agency or program.* In all other respects, a final adjudication, regardless of the evidentiary standard, in another jurisdiction or Federal agency or program that a practitioner, whether or not admitted in that jurisdiction, has committed misconduct shall estab-

lish a prima facie case by clear and convincing evidence that the practitioner has engaged in misconduct under § 11.804(h).

(f) *Reciprocal discipline—action where practice has ceased.* Upon request by the practitioner, reciprocal discipline may be imposed *nunc pro tunc* only if the practitioner promptly notified the OED Director of his or her censure, public reprimand, probation, disbarment, suspension or disciplinary disqualification in another jurisdiction, and establishes by clear and convincing evidence that the practitioner voluntarily ceased all activities related to practice before the Office and complied with all provisions of § 11.58. The effective date of any public censure, public reprimand, probation, suspension, disbarment or disciplinary disqualification imposed *nunc pro tunc* shall be the date the practitioner voluntarily ceased all activities related to practice before the Office and complied with all provisions of § 11.58.

(g) *Reinstatement following reciprocal discipline proceeding.* A practitioner may petition for reinstatement under conditions set forth in § 11.60 no sooner than completion of the period of reciprocal discipline imposed, and compliance with all provisions of § 11.58.

[73 FR 47689, Aug. 14, 2008, as amended at 78 FR 20200, Apr. 3, 2013; 86 FR 28458, May 26, 2021]

§ 11.25 Interim suspension and discipline based upon conviction of committing a serious crime.

(a) *Notice to the OED Director.* Upon being convicted of a crime in a court of the United States, any State, or a foreign country, a practitioner subject to the disciplinary jurisdiction of the Office shall notify the OED Director in writing of the same within 30 days from the date of such conviction. Notwithstanding the preceding sentence, a practitioner is not required to notify the OED Director of a traffic offense that did not involve the use of alcohol or a controlled substance, did not result in a fine in excess of \$300, and did not result in the imposition of any other punishment. Upon being advised or learning that a practitioner subject to the disciplinary jurisdiction of the Office has been convicted of a crime,

the OED Director shall make a preliminary determination whether the crime constitutes a serious crime warranting interim suspension. If the crime is a serious crime, the OED Director may file with the USPTO Director proof of the conviction and request the USPTO Director to issue a notice and order set forth in paragraph (b)(2) of this section. The OED Director may, in addition, without Committee on Discipline authorization, file with the USPTO Director a complaint complying with § 11.34 against the practitioner predicated upon the conviction of a serious crime. If the crime is not a serious crime, the OED Director may process the matter in the same manner as any other information or evidence of a possible violation of any USPTO Rule of Professional Conduct coming to the attention of the OED Director.

(b) *Interim suspension and referral for disciplinary proceeding.* All proceedings under this section shall be handled as expeditiously as possible.

(1) The USPTO Director has authority to place a practitioner on interim suspension after hearing the request for interim suspension on the documentary record.

(2) *Notification served on practitioner.* Upon receipt of a certified copy of the court record, docket entry, or judgment demonstrating that the practitioner has been so convicted, together with the complaint, the USPTO Director shall issue a notice directed to the practitioner in accordance with § 11.35, and to the OED Director, containing:

(i) A copy of the court record, docket entry, or judgment of conviction;

(ii) A copy of the complaint; and

(iii) An order directing the practitioner to file a response with the USPTO Director and the OED Director, within forty days of the date of the notice, establishing that there is a genuine issue of material fact that the crime did not constitute a serious crime, the practitioner is not the individual found guilty of the crime, or that the conviction was so lacking in notice or opportunity to be heard as to constitute a deprivation of due process.

(3) *Hearing and final order on request for interim suspension.* The request for interim suspension shall be heard by the USPTO Director on the documen-

tary record unless the USPTO Director determines that the practitioner's response establishes by clear and convincing evidence a genuine issue of material fact that: The crime did not constitute a serious crime, the practitioner is not the person who committed the crime, or the conviction was so lacking in notice or opportunity to be heard as to constitute a deprivation of due process. The USPTO Director may order the OED Director or the practitioner to supplement the record with further information or argument. If the USPTO Director determines that there is no genuine issue of material fact, the USPTO Director shall enter an appropriate final order regarding the OED Director's request for interim suspension regardless of the pendency of any criminal appeal. If the USPTO Director is unable to make such determination because there is a genuine issue of material fact, the USPTO Director shall enter a final order dismissing the request and enter a further order referring the complaint to a hearing officer for a hearing and entry of an initial decision in accordance with the other rules in this part and directing the practitioner to file an answer to the complaint in accordance with § 11.36.

(4) *Termination.* The USPTO Director has authority to terminate an interim suspension. In the interest of justice, the USPTO Director may terminate an interim suspension at any time upon a showing of extraordinary circumstances, after affording the OED Director an opportunity to respond to the request to terminate interim suspension.

(5) *Referral for disciplinary proceeding.* Upon entering a final order imposing interim suspension, the USPTO Director shall refer the complaint to a hearing officer to conduct a formal disciplinary proceeding. The formal disciplinary proceeding, however, shall be stayed by the hearing officer until all direct appeals from the conviction are concluded. Review of the initial decision of the hearing officer shall be pursuant to § 11.55.

(c) *Proof of conviction and guilt—(1) Conviction in the United States.* For purposes of a hearing for interim suspension and a hearing on the formal

charges in a complaint filed as a consequence of the conviction, a certified copy of the court record, docket entry, or judgment of conviction in a court of the United States or any State shall establish a *prima facie* case by clear and convincing evidence that the practitioner was convicted of a serious crime and that the conviction was not lacking in notice or opportunity to be heard as to constitute a deprivation of due process.

(2) *Conviction in a foreign country.* For purposes of a hearing for interim suspension and on the formal charges filed as a result of a finding of guilt, a certified copy of the court record, docket entry, or judgment of conviction in a court of a foreign country shall establish a *prima facie* case by clear and convincing evidence that the practitioner was convicted of a serious crime and that the conviction was not lacking in notice or opportunity to be heard as to constitute a deprivation of due process. However, nothing in this paragraph shall preclude the practitioner from demonstrating by clear and convincing evidence in any hearing on a request for interim suspension there is a genuine issue of material fact to be considered when determining if the elements of a serious crime were committed in violating the criminal law of the foreign country and whether a disciplinary sanction should be entered.

(d) *Crime determined not to be serious crime.* If the USPTO Director determines that the crime is not a serious crime, the complaint shall be referred to the OED Director for investigation under § 11.22 and processing as is appropriate.

(e) *Reinstatement—(1) Upon reversal or setting aside a finding of guilt or a conviction.* If a practitioner suspended solely under the provisions of paragraph (b) of this section demonstrates that the underlying finding of guilt or conviction of serious crimes has been reversed or vacated, the order for interim suspension shall be vacated and the practitioner shall be placed on active status unless the finding of guilt was reversed or the conviction was set aside with respect to less than all serious crimes for which the practitioner was found guilty or convicted. The vacating of the interim suspension will

not terminate any other disciplinary proceeding then pending against the practitioner, the disposition of which shall be determined by the hearing officer before whom the matter is pending, on the basis of all available evidence other than the finding of guilt or conviction.

(2) *Following conviction of a serious crime.* Any practitioner convicted of a serious crime and disciplined in whole or in part in regard to that conviction, may petition for reinstatement under the conditions set forth in § 11.60 no earlier than after completion of service of his or her sentence, or after completion of service under probation or parole, whichever is later.

(f) *Notice to clients and others of interim suspension.* An interim suspension under this section shall constitute a suspension of the practitioner for the purpose of § 11.58.

[73 FR 47689, Aug. 14, 2008, as amended at 78 FR 20200, Apr. 3, 2013; 86 FR 28458, May 26, 2021]

§ 11.26 Settlement.

Before or after a complaint under § 11.34 is filed, a settlement conference may occur between the OED Director and the practitioner. Any offers of compromise and any statements made during the course of settlement discussions shall not be admissible in subsequent proceedings. The OED Director may recommend to the USPTO Director any settlement terms deemed appropriate, including steps taken to correct or mitigate the matter forming the basis of the action, or to prevent recurrence of the same or similar conduct. A settlement agreement shall be effective only upon entry of a final decision by the USPTO Director.

§ 11.27 Exclusion on consent.

(a) *Required affidavit.* The OED Director may confer with a practitioner concerning possible violations by the practitioner of the Rules of Professional Conduct whether or not a disciplinary proceeding has been instituted. A practitioner who is the subject of an investigation or a pending disciplinary proceeding based on allegations of grounds for discipline, and who desires to resign, may only do so by consenting to exclusion and delivering to the OED

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Director an affidavit declaring the consent of the practitioner to exclusion and stating:

(1) That the practitioner's consent is freely and voluntarily rendered, that the practitioner is not being subjected to coercion or duress, and that the practitioner is fully aware of the implications of consenting to exclusion;

(2) That the practitioner is aware that there is currently pending an investigation into, or a proceeding involving allegations of misconduct, the nature of which shall be specifically set forth in the affidavit to the satisfaction of the OED Director;

(3) That the practitioner acknowledges that, if and when he or she applies for reinstatement under §11.60, the OED Director will conclusively presume, for the limited purpose of determining the application for reinstatement, that:

(i) The facts upon which the investigation or complaint is based are true, and

(ii) The practitioner could not have successfully defended himself or herself against the allegations in the investigation or charges in the complaint.

(b) *Action by the USPTO Director.* Upon receipt of the required affidavit, the OED Director shall file the affidavit and any related papers with the USPTO Director for review and approval. The USPTO Director may order the OED Director or the practitioner to supplement the record with further information or argument. The OED Director may also file comments in response to the affidavit. If the affidavit is approved, the USPTO Director will enter an order excluding the practitioner on consent and providing other appropriate actions. Upon entry of the order, the excluded practitioner shall comply with the requirements set forth in §11.58.

(c) [Reserved]

(d) *Reinstatement.* Any practitioner excluded on consent under this section may not petition for reinstatement for five years. A practitioner excluded on consent who intends to reapply for admission to practice before the Office must comply with the provisions of §11.58, and apply for reinstatement in accordance with §11.60. Failure to comply with the provisions of §11.58 con-

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stitutes grounds for denying an application for reinstatement.

[73 FR 47689, Aug. 14, 2008, as amended at 86 FR 28459, May 26, 2021]

§ 11.28 Incapacitated practitioners in a disciplinary proceeding.

(a) *Holding in abeyance a disciplinary proceeding because of incapacitation due to a current disability or addiction—* (1) *Practitioner's motion.* In the course of a disciplinary proceeding under §11.32, the practitioner may file a motion requesting the hearing officer to enter an order holding such proceeding in abeyance based on the contention that the practitioner is suffering from a disability or addiction that makes it impossible for the practitioner to adequately defend the charges in the disciplinary proceeding.

(i) *Content of practitioner's motion.* The practitioner's motion shall, in addition to any other requirement of §11.43, include or have attached thereto:

(A) A brief statement of all material facts;

(B) Affidavits, medical reports, official records, or other documents and the opinion of at least one medical expert setting forth and establishing any of the material facts on which the practitioner is relying;

(C) A statement that the practitioner acknowledges the alleged incapacity by reason of disability or addiction;

(D) Written consent by the practitioner to be transferred to disability inactive status if the motion is granted; and

(E) Written agreement by the practitioner not to practice before the Office in patent, trademark, or other non-patent matters while in disability inactive status.

(ii) *Response.* The OED Director's response to any motion hereunder shall be served and filed within thirty days after service of the practitioner's motion unless such time is shortened or enlarged by the hearing officer for good cause shown, and shall set forth the following:

(A) All objections, if any, to the actions requested in the motion;

(B) An admission, denial or allegation of lack of knowledge with respect to each of the material facts in the

practitioner's motion and accompanying documents; and

(C) Affidavits, medical reports, official records, or other documents setting forth facts on which the OED Director intends to rely for purposes of disputing or denying any material fact set forth in the practitioner's papers.

(2) *Disposition of practitioner's motion.* The hearing officer shall decide the motion and any response thereto. The motion shall be granted upon a showing of good cause to believe the practitioner to be incapacitated as alleged. If the required showing is made, the hearing officer shall enter an order holding the disciplinary proceeding in abeyance. In the case of addiction to drugs or intoxicants, the order may provide that the practitioner will not be returned to active status absent satisfaction of specified conditions. Upon receipt of the order, the OED Director shall transfer the practitioner to disability inactive status, give notice to the practitioner, cause notice to be published, and give notice to appropriate authorities in the Office that the practitioner has been placed in disability inactive status. The practitioner shall comply with the provisions of § 11.58 and shall not engage in practice before the Office in patent, trademark, and other non-patent law until a determination is made of the practitioner's capability to resume practice before the Office in a proceeding under paragraph (c) or (d) of this section. A practitioner in disability inactive status must obtain permission from the OED Director to engage in paralegal activity permitted under § 11.58(h). Permission will be granted only if the practitioner has complied with all the conditions of § 11.58 applicable to disability inactive status. In the event that permission is granted, the practitioner shall fully comply with the provisions of § 11.58(h).

(b) *Motion for reactivation.* Any practitioner transferred to disability inactive status in a disciplinary proceeding may file with the hearing officer a motion for reactivation once a year beginning at any time not less than one year after the initial effective date of inactivation, or once during any shorter interval provided by the order issued pursuant to paragraph (a)(2) of this section

or any modification thereof. If the motion is granted, the disciplinary proceeding shall resume under such schedule as may be established by the hearing officer.

(c) *Contents of motion for reactivation.* A motion by the practitioner for reactivation alleging that a practitioner has recovered from a prior disability or addiction shall be accompanied by all available medical reports or similar documents relating thereto. The hearing officer may require the practitioner to present such other information as is necessary.

(d) *OED Director's motion to resume disciplinary proceeding held in abeyance.*

(1) The OED Director, having good cause to believe a practitioner is no longer incapacitated, may file a motion requesting the hearing officer to terminate a prior order holding in abeyance any pending proceeding because of the practitioner's disability or addiction. The hearing officer shall decide the matter presented by the OED Director's motion hereunder based on the affidavits and other admissible evidence attached to the OED Director's motion and the practitioner's response. The OED Director bears the burden of showing by clear and convincing evidence that the practitioner is able to defend himself or herself. If there is any genuine issue as to one or more material facts, the hearing officer will hold an evidentiary hearing.

(2) The hearing officer, upon receipt of the OED Director's motion under paragraph (d)(1) of this section, may direct the practitioner to file a response. If the hearing officer requires the practitioner to file a response, the practitioner must present clear and convincing evidence that the prior self-alleged disability or addiction continues to make it impossible for the practitioner to defend himself or herself in the underlying proceeding being held in abeyance.

(e) *Action by the hearing officer.* If, in deciding a motion under paragraph (b) or (d) of this section, the hearing officer determines that there is good cause to believe the practitioner is not incapacitated from defending himself or herself, or is not incapacitated from practicing before the Office, the hearing officer shall take such action as is

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deemed appropriate, including the entry of an order directing the reactivation of the practitioner and resumption of the disciplinary proceeding.

[73 FR 47689, Aug. 14, 2008, as amended at 86 FR 28459, May 26, 2021]

§ 11.29 Reciprocal transfer or initial transfer to disability inactive status.

(a) *Notice to the OED Director*—(1) *Transfer to disability inactive status in another jurisdiction as grounds for reciprocal transfer by the Office.* Within 30 days of being transferred to disability inactive status in another jurisdiction, a practitioner subject to the disciplinary jurisdiction of the Office shall notify the OED Director in writing of the transfer. Upon notification from any source that a practitioner subject to the disciplinary jurisdiction of the Office has been transferred to disability inactive status in another jurisdiction, the OED Director shall obtain a certified copy of the order. If the OED Director finds that transfer to disability inactive status is appropriate, the OED Director shall file with the USPTO Director:

- (i) The order;
- (ii) A request that the practitioner be transferred to disability inactive status, including the specific grounds therefor; and
- (iii) A request that the USPTO Director issue a notice and order as set forth in paragraph (b) of this section.

(2) *Involuntary commitment, adjudication of incompetency, or court ordered placement under guardianship or conservatorship as grounds for initial transfer to disability inactive status.* Within 30 days of being judicially declared incompetent, judicially ordered to be involuntarily committed after a hearing on the grounds of incompetency or disability, or placed by court order under guardianship or conservatorship in another jurisdiction, a practitioner subject to the disciplinary jurisdiction of the Office shall notify the OED Director in writing of such judicial action. Upon notification from any source that a practitioner subject to the disciplinary jurisdiction of the Office has been subject to such judicial action, the OED Director shall obtain a certified

copy of the order. If the OED Director finds that transfer to disability inactive status is appropriate, the OED Director shall file with the USPTO Director:

- (i) The order;
- (ii) A request that the practitioner be transferred to disability inactive status, including the specific grounds therefor; and
- (iii) A request that the USPTO Director issue a notice and order as set forth in paragraph (b) of this section.

(b) *Notice served on practitioner.* Upon receipt of a certified copy of an order or declaration issued by another jurisdiction demonstrating that a practitioner subject to the disciplinary jurisdiction of the Office has been transferred to disability inactive status, judicially declared incompetent, judicially ordered to be involuntarily committed after a judicial hearing on the grounds of incompetency or disability, or placed by court order under guardianship or conservatorship, together with the OED Director's request, the USPTO Director shall issue a notice, comporting with § 11.35, directed to the practitioner containing:

- (1) A copy of the order or declaration from the other jurisdiction;
- (2) A copy of the OED Director's request; and

(3) An order directing the practitioner to file a response with the USPTO Director and the OED Director, within 40 days from the date of the notice, establishing by clear and convincing evidence a genuine issue of material fact supported by an affidavit and predicated upon the grounds set forth in paragraphs (d)(1)(i) through (d)(1)(iv) of this section that a transfer to disability inactive status would be unwarranted and the reasons therefor.

(c) *Effect of stay of transfer, judicially declared incompetence, judicially ordered involuntary commitment on the grounds of incompetency or disability, or court-ordered placement under guardianship or conservatorship.* In the event the transfer, judicially declared incompetence, judicially ordered involuntary commitment on the grounds of incompetency or disability, or court-ordered placement under guardianship or conservatorship in the other jurisdiction has been stayed there, any reciprocal

transfer or transfer by the Office may be deferred until the stay expires.

(d) *Transfer to disability inactive status.* (1) The request for transfer to disability inactive status shall be heard by the USPTO Director on the documentary record unless the USPTO Director determines that there is a genuine issue of material fact, in which case the USPTO Director may deny the request. The USPTO Director may order the OED Director or the practitioner to supplement the record with further information or argument. After expiration of the period specified in paragraph (b)(3) of this section, and after completion of any supplemental hearings, the USPTO Director shall consider any timely filed response and impose the identical transfer to disability inactive status based on the practitioner's transfer to disability status in another jurisdiction or shall transfer the practitioner to disability inactive status based on judicially declared incompetence, judicially ordered involuntary commitment on the grounds of incompetency or disability, or court-ordered placement under guardianship or conservatorship, unless the practitioner demonstrates by clear and convincing evidence, and the USPTO Director finds there is a genuine issue of material fact that:

(i) The procedure was so lacking in notice or opportunity to be heard as to constitute a deprivation of due process;

(ii) There was such infirmity of proof establishing the transfer to disability status, judicial declaration of incompetence, judicial order for involuntary commitment on the grounds of incompetency or disability, or placement by court order under guardianship or conservatorship that the USPTO Director could not, consistent with the Office's duty, accept as final the conclusion on that subject;

(iii) The imposition of the same disability status or transfer to disability status by the USPTO Director would result in grave injustice; or

(iv) The practitioner is not the individual transferred to disability status, judicially declared incompetent, judicially ordered for involuntary commitment on the grounds of incompetency or disability, or placed by court order under guardianship or conservatorship.

(2) If the USPTO Director determines that there is no genuine issue of material fact with regard to any of the elements of paragraphs (d)(1)(i) through (d)(1)(iv) of this section, the USPTO Director shall enter an appropriate final order. If the USPTO Director is unable to make that determination because there is a genuine issue of material fact, the USPTO Director shall enter an appropriate order dismissing the OED Director's request for such reason.

(e) *Adjudication in other jurisdiction.* In all other aspects, a final adjudication in another jurisdiction that a practitioner be transferred to disability inactive status, is judicially declared incompetent, is judicially ordered to be involuntarily committed on the grounds of incompetency or disability, or is placed by court order under guardianship or conservatorship shall establish the disability for purposes of a reciprocal transfer to or transfer to disability status before the Office.

(f) A practitioner who is transferred to disability inactive status under this section shall be deemed to have been refused recognition to practice before the Office for purposes of 35 U.S.C. 32.

(g) *Order imposing reciprocal transfer to disability inactive status or order imposing initial transfer to disability inactive status.* An order by the USPTO Director imposing reciprocal transfer to disability inactive status or transferring a practitioner to disability inactive status shall be effective immediately and shall be for an indefinite period until further order of the USPTO Director. A copy of the order transferring a practitioner to disability inactive status shall be served upon the practitioner, the practitioner's guardian, and/or the director of the institution to which the practitioner has been committed in the manner the USPTO Director may direct. A practitioner reciprocally transferred or transferred to disability inactive status shall comply with the provisions of this section and § 11.58 and shall not engage in practice before the Office in patent, trademark, and other non-patent law unless and until reinstated to active status.

(h) *Confidentiality of proceeding; Orders to be public.*—(1) *Confidentiality of proceeding.* All proceedings under this

section involving allegations of disability of a practitioner shall be kept confidential until and unless the USPTO Director enters an order reciprocally transferring or transferring the practitioner to disability inactive status.

(2) *Orders to be public.* The OED Director shall publicize any reciprocal transfer to disability inactive status or transfer to disability inactive status in the same manner as for the imposition of public discipline.

(i) *Employment of practitioners on disability inactive status.* A practitioner in disability inactive status must obtain permission from the OED Director to engage in paralegal activity permitted under §11.58(h). Permission will be granted only if the practitioner has complied with all the conditions of §11.58 applicable to disability inactive status. In the event that permission is granted, the practitioner shall fully comply with the provisions of §11.58(h).

(j) *Reinstatement from disability inactive status.* (1) *Generally.* No practitioner reciprocally transferred or transferred to disability inactive status under this section may resume active status except by order of the OED Director.

(2) *Petition.* A practitioner reciprocally transferred or transferred to disability inactive status shall be entitled to petition the OED Director for transfer to active status once a year, or at whatever shorter intervals the USPTO Director may direct in the order transferring or reciprocally transferring the practitioner to disability inactive status or any modification thereof.

(3) *Examination.* Upon the filing of a petition for transfer to active status, the OED Director may take or direct whatever action is deemed necessary or proper to determine whether the incapacity has been removed, including a direction for an examination of the practitioner by qualified medical or psychological experts designated by the OED Director. The expense of the examination shall be paid and borne by the practitioner.

(4) *Required disclosure, waiver of privilege.* With the filing of a petition for reinstatement to active status, the practitioner shall be required to disclose

the name of each psychiatrist, psychologist, physician and hospital or other institution by whom or in which the practitioner has been examined or treated for the disability since the transfer to disability inactive status. The practitioner shall furnish to the OED Director written consent to the release of information and records relating to the incapacity if requested by the OED Director.

(5) *Learning in the law, examination.* The OED Director may direct that the practitioner establish proof of competence and learning in law, which proof may include passing the registration examination.

(6) *Granting of petition for transfer to active status.* The OED Director shall grant the petition for transfer to active status upon a showing by clear and convincing evidence that the incapacity has been removed.

(7) *Reinstatement in other jurisdiction.* If a practitioner is reciprocally transferred to disability inactive status on the basis of a transfer to disability inactive status in another jurisdiction, the OED Director may dispense with further evidence that the disability has been removed and may immediately direct reinstatement to active status upon such terms as are deemed proper and advisable.

(8) *Judicial declaration of competency.* If a practitioner is transferred to disability inactive status on the basis of a judicially declared incompetence, judicially ordered involuntary commitment on the grounds of incompetency or disability, or court-ordered placement under guardianship or conservatorship has been declared to be competent, the OED Director may dispense with further evidence that the incapacity to practice law has been removed and may immediately direct reinstatement to active status.

[73 FR 47689, Aug. 14, 2008, as amended at 86 FR 28459, May 26, 2021]

§§ 11.30–11.31 [Reserved]

§ 11.32 Instituting a disciplinary proceeding.

If after conducting an investigation under §11.22(a), the OED Director is of

the opinion that grounds exist for discipline under § 11.19(b), the OED Director, after complying where necessary with the provisions of 5 U.S.C. 558(c), may convene a meeting of a panel of the Committee on Discipline. If convened, the panel of the Committee on Discipline shall then determine as specified in § 11.23(b) whether there is probable cause to bring disciplinary charges. If the panel of the Committee on Discipline determines that probable cause exists to bring charges, the OED Director may institute a disciplinary proceeding by filing a complaint under § 11.34.

[78 FR 20201, Apr. 3, 2013]

§ 11.33 [Reserved]

§ 11.34 Complaint.

(a) A complaint instituting a disciplinary proceeding shall:

(1) Name the person who is the subject of the complaint who may then be referred to as the “respondent”;

(2) Give a plain and concise description of the respondent’s alleged grounds for discipline;

(3) State the place and time, not less than thirty days from the date the complaint is filed, for filing an answer by the respondent;

(4) State that a decision by default may be entered if an answer is not timely filed by the respondent; and

(5) Be signed by the OED Director.

(b) A complaint will be deemed sufficient if it fairly informs the respondent of any grounds for discipline, and where applicable, the USPTO Rules of Professional Conduct that form the basis for the disciplinary proceeding so that the respondent is able to adequately prepare a defense.

(c) The complaint shall be filed in the manner prescribed by the USPTO Director. The term “filed” means the delivery, mailing, or electronic transmission of a document to a hearing officer or designee in connection with a disciplinary complaint or related matter.

(d) *Time for filing a complaint.* A complaint shall be filed within one year after the date on which the OED Director receives a grievance forming the basis of the complaint. No complaint shall be filed more than ten years after

the date on which the misconduct forming the basis for the proceeding occurred.

(e) *Tolling agreements.* The one-year period for filing a complaint under paragraph (d) of this section shall be tolled if the involved practitioner and the OED Director agree in writing to such tolling.

[73 FR 47689, Aug. 14, 2008, as amended at 77 FR 45251, July 31, 2012; 78 FR 20201, Apr. 3, 2013; 86 FR 28460, May 26, 2021]

§ 11.35 Service of complaint.

(a) A complaint may be served on a respondent by any of the following methods:

(1) By delivering a copy of the complaint personally to the respondent, in which case the individual who delivers the complaint to the respondent shall file an affidavit with the OED Director indicating the time and place the complaint was delivered to the respondent.

(2) By mailing a copy of the complaint by Priority Mail Express®, first-class mail, or any delivery service that provides confirmation of delivery or attempted delivery to:

(i) A respondent who is a registered practitioner at the address provided to OED pursuant to § 11.11, or

(ii) A respondent who is not registered at the last address for the respondent known to the OED Director.

(3) By any method mutually agreeable to the OED Director and the respondent.

(4) In the case of a respondent who resides outside the United States, by sending a copy of the complaint by any delivery service that provides the ability to confirm delivery or attempted delivery, to:

(i) A respondent who is a registered practitioner at the address provided to OED pursuant to § 11.11; or

(ii) A respondent who is not registered at the last address for the respondent known to the OED Director.

(b) If a copy of the complaint cannot be delivered to the respondent through any one of the procedures in paragraph (a) of this section, the OED Director shall serve the respondent by causing an appropriate notice to be published in the Official Gazette for two consecutive weeks, in which case the time for filing an answer shall be 30 days from

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the second publication of the notice. Failure to timely file an answer will constitute an admission of the allegations in the complaint in accordance with § 11.36(d), and the hearing officer may enter an initial decision on default.

(c) If the respondent is known to the OED Director to be represented by an attorney under § 11.40(a), a copy of the complaint may be served on the attorney in lieu of service on the respondent in the manner provided for in paragraph (a) or (b) of this section.

[86 FR 28460, May 26, 2021]

§ 11.36 Answer to complaint.

(a) *Time for answer.* An answer to a complaint shall be filed within the time set in the complaint but in no event shall that time be less than thirty days from the date the complaint is filed.

(b) *With whom filed.* The answer shall be filed in writing with the hearing officer at the address specified in the complaint. The hearing officer may extend the time for filing an answer once for a period of no more than thirty days upon a showing of good cause, provided a motion requesting an extension of time is filed within thirty days after the date the complaint is served on respondent. A copy of the answer, and any exhibits or attachments thereto, shall be served on the OED Director.

(c) *Content.* The respondent shall include in the answer a statement of the facts that constitute the grounds of defense and shall specifically admit or deny each allegation set forth in the complaint. The respondent shall not deny a material allegation in the complaint that the respondent knows to be true or state that respondent is without sufficient information to form a belief as to the truth of an allegation, when in fact the respondent possesses that information. The respondent shall also state affirmatively in the answer special matters of defense and any intent to raise a disability as a mitigating factor. If respondent intends to raise a special matter of defense or disability, the answer shall specify the defense or disability, its nexus to the misconduct, and the reason it provides a defense or mitigation. A respondent

who fails to do so cannot rely on a special matter of defense or disability. The hearing officer may, for good cause, allow the respondent to file the statement late, grant additional hearing preparation time, or make other appropriate orders.

(d) *Failure to deny allegations in complaint.* Every allegation in the complaint that is not denied by a respondent in the answer shall be deemed to be admitted and may be considered proven. The hearing officer at any hearing need receive no further evidence with respect to that allegation.

(e) *Default judgment.* Failure to timely file an answer will constitute an admission of the allegations in the complaint and may result in entry of default judgment.

§ 11.37 [Reserved]

§ 11.38 Contested case.

Upon the filing of an answer by the respondent, a disciplinary proceeding shall be regarded as a contested case within the meaning of 35 U.S.C. 24. Evidence obtained by a subpoena issued under 35 U.S.C. 24 shall not be admitted into the record or considered unless leave to proceed under 35 U.S.C. 24 was previously authorized by the hearing officer.

§ 11.39 Hearing officer; responsibilities; review of interlocutory orders; stays.

(a) *Designation.* A hearing officer designated by the USPTO Director shall conduct disciplinary proceedings as provided by this part.

(b) *Independence of the hearing officer.*
(1) A hearing officer designated in accordance with paragraph (a) of this section shall not be subject to first-level or second-level supervision by either the USPTO Director or OED Director or his or her designee.

(2) A hearing officer designated in accordance with paragraph (a) of this section shall not be subject to supervision of the person(s) investigating or prosecuting the case.

(3) A hearing officer designated in accordance with paragraph (a) of this section shall be impartial, shall not be an individual who has participated in any manner in the decision to initiate the

proceedings, and shall not have been employed under the immediate supervision of the practitioner.

(4) A hearing officer designated in accordance with paragraph (a) of this section shall be either an administrative law judge appointed under 5 U.S.C. 3105 or an attorney designated under 35 U.S.C. 32. The hearing officer shall possess suitable experience and training in conducting hearings, reaching a determination, and rendering an initial decision in an equitable manner.

(c) *Responsibilities.* The hearing officer shall have authority, consistent with specific provisions of these regulations, to:

(1) Administer oaths and affirmations;

(2) Make rulings upon motions and other requests;

(3) Rule upon offers of proof, receive relevant evidence, and examine witnesses;

(4) Authorize the taking of a deposition of a witness in lieu of personal appearance of the witness before the hearing officer;

(5) Determine the time and place of any hearing and regulate its course and conduct;

(6) Hold or provide for the holding of conferences to settle or simplify the issues;

(7) Receive and consider oral or written arguments on facts or law;

(8) Adopt procedures and modify procedures for the orderly disposition of proceedings;

(9) Make initial decisions under §§ 11.25 and 11.54; and

(10) Perform acts and take measures as necessary to promote the efficient, timely, and impartial conduct of any disciplinary proceeding.

(d) *Time for making initial decision.* The hearing officer shall set times and exercise control over a disciplinary proceeding such that an initial decision under § 11.54 is normally issued within nine months of the date a complaint is filed. The hearing officer may, however, issue an initial decision more than nine months after a complaint is filed if there exist circumstances, in his or her opinion, that preclude issuance of an initial decision within nine months of the filing of the complaint.

(e) *Review of interlocutory orders.* The USPTO Director will not review an interlocutory order of a hearing officer except:

(1) When the hearing officer shall be of the opinion:

(i) That the interlocutory order involves a controlling question of procedure or law as to which there is a substantial ground for a difference of opinion, and

(ii) That an immediate decision by the USPTO Director may materially advance the ultimate termination of the disciplinary proceeding, or

(2) In an extraordinary situation where the USPTO Director deems that justice requires review.

(f) *Stays pending review of interlocutory order.* If the OED Director or a respondent seeks review of an interlocutory order of a hearing officer under paragraph (e)(2) of this section, any time period set by the hearing officer for taking action shall not be stayed unless ordered by the USPTO Director or the hearing officer.

(g) The hearing officer shall engage in no *ex parte* discussions with any party on the merits of the complaint, beginning with appointment and ending when the final agency decision is issued.

[73 FR 47689, Aug. 14, 2008, as amended at 86 FR 28461, May 26, 2021]

§ 11.40 Representative for OED Director or respondent.

(a) A respondent may represent himself or herself, or be represented by an attorney before the Office in connection with an investigation or disciplinary proceeding. The attorney shall file a written declaration that he or she is an attorney within the meaning of § 11.1 and shall state:

(1) The address to which the attorney wants correspondence related to the investigation or disciplinary proceeding sent, and

(2) A telephone number where the attorney may be reached during normal business hours.

(b) The Deputy General Counsel for Intellectual Property and Solicitor and attorneys in the Office of the Solicitor shall represent the OED Director. The attorneys representing the OED Director in disciplinary proceedings shall

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not consult with the USPTO Director, the General Counsel, the Deputy General Counsel for General Law, or an individual designated by the USPTO Director to decide disciplinary matters regarding the proceeding.

(c) The General Counsel and the Deputy General Counsel for General Law shall remain screened from the investigation and prosecution of all disciplinary proceedings in order that they shall be available as counsel to the USPTO Director in deciding disciplinary proceedings unless access is appropriate to perform their duties. After a final decision is entered in a disciplinary proceeding, the OED Director and attorneys representing the OED Director shall be available to counsel the USPTO Director, the General Counsel, and the Deputy General Counsel for General Law in any further proceedings.

[73 FR 47689, Aug. 14, 2008, as amended at 86 FR 28461, May 26, 2021]

§ 11.41 Filing of papers.

(a) The provisions of §§ 1.8 and 2.197 of this chapter do not apply to disciplinary proceedings. All papers filed after the complaint and prior to entry of an initial decision by the hearing officer shall be filed with the hearing officer at an address or place designated by the hearing officer. The term “filed” means the delivery, mailing, or electronic transmission of a document to a hearing officer or designee in connection with a disciplinary complaint or related matter.

(b) All papers filed after entry of an initial decision by the hearing officer shall be filed with the USPTO Director. A copy of the paper shall be served on the OED Director. The hearing officer or the OED Director may provide for filing papers and other matters by hand, by Priority Mail Express®, or by other means.

[69 FR 35452, June 24, 2004, as amended at 79 FR 63042, Oct. 22, 2014; 86 FR 28461, May 26, 2021]

§ 11.42 Service of papers.

(a) All papers other than a complaint shall be served on a respondent who is represented by an attorney by:

(1) Delivering a copy of the paper to the office of the attorney; or

(2) Mailing a copy of the paper by first-class mail, Priority Mail Express®, or other delivery service to the attorney at the address provided by the attorney under § 11.40(a)(1); or

(3) Any other method mutually agreeable to the attorney and a representative for the OED Director.

(b) All papers other than a complaint shall be served on a respondent who is not represented by an attorney by:

(1) Delivering a copy of the paper to the respondent; or

(2) Mailing a copy of the paper by first-class mail, Priority Mail Express®, or other delivery service to the respondent at the address to which a complaint may be served or such other address as may be designated in writing by the respondent; or

(3) Any other method mutually agreeable to the respondent and a representative for the OED Director.

(c) A respondent shall serve on the representative for the OED Director one copy of each paper filed with the hearing officer or the OED Director. A paper may be served on the representative for the OED Director by:

(1) Delivering a copy of the paper to the representative; or

(2) Mailing a copy of the paper by first-class mail, Priority Mail Express®, or other delivery service to an address designated in writing by the representative; or

(3) Any other method mutually agreeable to the respondent and the representative.

(d) Each paper filed in a disciplinary proceeding shall contain therein a certificate of service indicating:

(1) The date on which service was made; and

(2) The method by which service was made.

(e) The hearing officer or the USPTO Director may require that a paper be served by hand or by Priority Mail Express®.

(f) Service by mail is completed when the paper mailed in the United States is placed into the custody of the U.S. Postal Service.

[79 FR 63042, Oct. 22, 2014]

§ 11.43 Motions before a hearing officer.

Motions, including all prehearing motions commonly filed under the Federal Rules of Civil Procedure, shall be served on the opposing party and filed with the hearing officer. Each motion shall be accompanied by a written memorandum setting forth a concise statement of the facts and supporting reasons, along with a citation of the authorities upon which the movant relies. Unless extended by the tribunal for good cause, an opposing party shall serve and file a memorandum in response to the motion within 21 days of the date of service of the motion, and the moving party may file a reply memorandum within 14 days after service of the opposing party's responsive memorandum. All memoranda shall be double-spaced and written in 12-point font unless otherwise ordered by the hearing officer. Every motion must include a statement that the moving party or attorney for the moving party has conferred with the opposing party or attorney for the opposing party in a good-faith effort to resolve the issues raised by the motion and whether the motion is opposed. If, prior to a decision on the motion, the parties resolve issues raised by a motion presented to the hearing officer, the parties shall promptly notify the hearing officer.

[86 FR 28461, May 26, 2021]

§ 11.44 Hearings.

(a) The hearing officer shall preside over hearings in disciplinary proceedings. After the time for filing an answer has elapsed, the hearing officer shall set the time and place for the hearing. In cases involving an incarcerated respondent, any necessary oral hearing may be held at the location of incarceration. Oral hearings will be stenographically recorded and transcribed, and the testimony of witnesses will be received under oath or affirmation. The hearing officer shall conduct the hearing as if the proceeding were subject to 5 U.S.C. 556. A copy of the transcript of the hearing shall become part of the record. A copy of the transcript shall be provided to the OED Director and the respondent at the expense of the Office.

(b) If the respondent to a disciplinary proceeding fails to appear at the hearing after a notice of hearing has been issued by the hearing officer, the hearing officer may deem the respondent to have waived the opportunity for a hearing and may proceed with the hearing in the absence of the respondent. Where the respondent does not appear, the hearing officer may strike the answer or any other pleading, deem the respondent to have admitted the facts as alleged in the complaint, receive evidence in aggravation or mitigation, enter a default judgment, and/or enter an initial decision imposing discipline on the respondent.

(c) A hearing under this section will not be open to the public except that the hearing officer may grant a request by a respondent to open his or her hearing to the public and make the record of the disciplinary proceeding available for public inspection, *provided*, a protective order is entered to exclude from public disclosure information which is privileged or confidential under applicable laws or regulations.

[73 FR 47689, Aug. 14, 2008, as amended at 86 FR 28461, May 26, 2021]

§ 11.45 Amendment of pleadings.

The OED Director may, without Committee on Discipline authorization, but with the authorization of the hearing officer, amend the complaint to include additional charges based upon conduct committed before or after the complaint was filed. If amendment of the complaint is authorized, the hearing officer shall authorize amendment of the answer. Any party who would otherwise be prejudiced by the amendment will be given reasonable opportunity to meet the allegations in the complaint or answer as amended, and the hearing officer shall make findings on any issue presented by the complaint or answer as amended.

§§ 11.46–11.48 [Reserved]**§ 11.49 Burden of proof.**

In a disciplinary proceeding, the OED Director shall have the burden of proving the violation by clear and convincing evidence and a respondent shall

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have the burden of proving any affirmative defense by clear and convincing evidence.

§ 11.50 Evidence.

(a) *Rules of evidence.* The rules of evidence prevailing in courts of law and equity are not controlling in hearings in disciplinary proceedings. However, the hearing officer shall exclude evidence that is irrelevant, immaterial, speculative, or unduly repetitious.

(b) *Depositions.* Depositions of witnesses taken pursuant to § 11.51 may be admitted as evidence.

(c) *Government documents.* Official documents, records, and papers of the Office, including, but not limited to, all papers in the file of a disciplinary investigation, are admissible without extrinsic evidence of authenticity. These documents, records, and papers may be evidenced by a copy certified as correct by an employee of the Office.

(d) *Exhibits.* If any document, record, or other paper is introduced in evidence as an exhibit, the hearing officer may authorize the withdrawal of the exhibit subject to any conditions the hearing officer deems appropriate.

(e) *Objections.* Objections to evidence will be in short form, stating the grounds of objection. Objections and rulings on objections will be a part of the record. No exception to the ruling is necessary to preserve the rights of the parties.

[73 FR 47689, Aug. 14, 2008, as amended at 86 FR 28462, May 26, 2021]

§ 11.51 Depositions.

(a) Depositions for use at the hearing in lieu of the personal appearance of a witness before the hearing officer may be taken by the respondent or the OED Director by agreement; or upon a showing of good cause and with the approval of, and under such conditions as may be deemed appropriate by, the hearing officer. If a motion to take a deposition is granted, the hearing officer shall authorize a subpoena to be issued pursuant to 35 U.S.C. 24. If the deponent is a USPTO employee, the respondent shall comply with the requirements of part 104 of this chapter.

(b) A party seeking a deposition shall give reasonable notice of not less than 14 days unless a shorter period is

agreed upon by the parties or authorized by the hearing officer. The notice shall state the date, time, and place of the deposition.

(c) Depositions may be taken upon oral or written questions before any officer authorized to administer an oath or affirmation in the place where the deposition is to be taken. Deposition expenses shall be borne by the party at whose instance the deposition is taken.

(d) When a deposition is taken upon written questions, copies of the written questions will be served upon the other party with the notice, and copies of any written cross-questions will be served by hand or Priority Mail Express® not less than five days before the date of the taking of the deposition unless the parties mutually agree otherwise.

(e) Testimony by deposition may be recorded by audiovisual means provided that:

(1) The notice of deposition states that the method of recording is audiovisual, and

(2) A written transcript of the deposition is prepared by a court reporter who was present at the deposition and recorded the testimony.

(f) A party on whose behalf a deposition is taken shall file with the hearing officer a copy of a transcript of the deposition signed by a court reporter and a copy of any audiovisual recording and shall serve one copy of the transcript and any audiovisual recording upon the opposing party.

(g) Depositions may not be taken to obtain discovery, except as provided for in paragraph (h) of this section.

(h) When the OED Director and the respondent agree in writing, a discovery deposition of any witness who will appear voluntarily may be taken under such terms and conditions as may be mutually agreeable to the OED Director and the respondent. The deposition shall not be filed with the hearing officer and may not be admitted into evidence before the hearing officer unless he or she orders the deposition admitted into evidence. The admissibility of the deposition shall lie within the discretion of the hearing officer, who may reject the deposition on any reasonable basis, including the fact that demeanor is involved and that the

witness should have been called to appear personally before the hearing officer.

[86 FR 28462, May 26, 2021]

§ 11.52 Written discovery.

(a) After an answer is filed under § 11.36, a party may seek written discovery of only relevant evidence. The party seeking written discovery shall file a motion under § 11.43 explaining in detail, for each request made, how the discovery sought is reasonable and relevant to an issue actually raised in the complaint or the answer. The motion shall include a copy of the proposed written discovery requests. Any response shall include specific objections to each request, if any. Any objection not raised in the response will be deemed to have been waived.

(b) If the hearing officer concludes that the proposed written discovery is reasonable and relevant, the hearing officer, under such conditions as he or she deems appropriate, may order an opposing party, within 30 days, or longer if so ordered by the hearing officer, to:

- (1) Answer a reasonable number of requests for admission, including requests for admission as to the genuineness of documents;
- (2) Answer a reasonable number of interrogatories;
- (3) Produce for inspection and copying a reasonable number of documents; and
- (4) Produce for inspection a reasonable number of things other than documents.

(c) Discovery shall not be authorized under paragraph (a) of this section of any matter that:

- (1) Will be used by another party solely for impeachment;
- (2) Is not available to the party under 35 U.S.C. 122;
- (3) Relates to any other disciplinary proceeding before the Office;
- (4) Relates to experts;
- (5) Is privileged; or
- (6) Relates to mental impressions, conclusions, opinions, or legal theories of any attorney or other representative of a party.

(d) The hearing officer may deny discovery requested under paragraph (a) of this section if the discovery sought:

(1) Will unduly delay the disciplinary proceeding;

(2) Will place an undue burden on the party required to produce the discovery sought; or

(3) Consists of information that is available:

- (i) Generally to the public,
- (ii) Equally to the parties, or
- (iii) To the party seeking the discovery through another source.

(e) A request for admission will be deemed admitted if the party to whom the request is directed fails to respond or object to the request within the time allowed.

(f) The hearing officer may require parties to file and serve, prior to any hearing, a pre-hearing statement that contains:

(1) A list (together with a copy) of all proposed exhibits to be used in connection with a party's case-in-chief;

(2) A list of proposed witnesses;

(3) As to each proposed expert witness:

(i) An identification of the field in which the individual will be qualified as an expert,

(ii) A statement as to the subject matter on which the expert is expected to testify,

(iii) A complete statement of all opinions to which the expert is expected to testify and the basis and reasons for them, and

(iv) A description of all facts or data considered by the expert in forming the opinions; and

(4) Copies of memoranda reflecting the respondent's own statements to administrative representatives.

[86 FR 28462, May 26, 2021]

§ 11.53 Proposed findings and conclusions; post-hearing memorandum.

(a) Except in cases in which the respondent has failed to answer the complaint or the amended complaint, or appear at a hearing, the hearing officer, prior to making an initial decision, shall afford the parties a reasonable opportunity to submit proposed findings and conclusions and a post-hearing memorandum in support of the proposed findings and conclusions.

(b) The OED Director shall serve and file a post-hearing memorandum within 30 days after the hearing transcript

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has been filed with the hearing officer. The respondent shall have 30 days after service of the OED Director's post-hearing memorandum to file a responsive post-hearing memorandum. The OED Director may file a reply memorandum within 21 days after service of any responsive post-hearing memorandum.

(c) The respondent shall serve and file a post-hearing memorandum with respect to any asserted affirmative defenses, or other matters for which the respondent bears the burden of proof, within 30 days after the hearing transcript has been filed with the hearing officer. The OED Director shall have 30 days after service of the respondent's post-hearing memorandum to file a responsive post-hearing memorandum. The respondent may file a reply memorandum within 21 days after service of any responsive post-hearing memorandum.

(d) The OED Director's and the respondent's responsive post-hearing memoranda shall be limited to 50 pages, 12-point font, double-spacing, and one-inch margins, and the reply memoranda shall be limited to 25 pages, 12-point font, double-spacing, and one-inch margins, unless otherwise ordered by the hearing officer.

(e) The hearing officer may extend the time for filing a post-hearing memorandum and may also increase the page limits, for good cause shown.

[86 FR 28463, May 26, 2021]

§ 11.54 Initial decision of hearing officer.

(a) The hearing officer shall make an initial decision in the case. The decision will include:

(1) A statement of findings of fact and conclusions of law, as well as the reasons or bases for those findings and conclusions with specific references to the record, upon all the material issues of fact, law, or discretion presented on the record; and

(2) An order of default judgment, of suspension or exclusion from practice, of reprimand, of probation, or an order dismissing the complaint. The order also may impose any conditions deemed appropriate under the circumstances.

(b) The initial decision of the hearing officer shall explain the reason for any default judgment, reprimand, suspension, exclusion, or probation and shall explain any conditions imposed with discipline. In determining any sanction, the following four factors shall be considered if they are applicable:

(1) Whether the practitioner has violated a duty owed to a client, the public, the legal system, or the profession;

(2) Whether the practitioner acted intentionally, knowingly, or negligently;

(3) The amount of the actual or potential injury caused by the practitioner's misconduct; and

(4) The existence of any aggravating or mitigating factors.

(c) The hearing officer shall transmit a copy of the initial decision to the OED Director and to the respondent and shall transmit the record of the proceeding to the OED Director within 14 days, or as soon as practicable if thereafter, of the date of the initial decision.

(d) In the absence of an appeal to the USPTO Director, the decision of the hearing officer will, without further proceedings, become the final decision of the USPTO Director 30 days from the date of the decision of the hearing officer.

[86 FR 28463, May 26, 2021]

§ 11.55 Appeal to the USPTO Director.

(a) Within 14 days after the date of the initial decision of the hearing officer under §§ 11.25 or 11.54, either party may appeal to the USPTO Director by filing a notice of appeal. The notice shall be filed with the General Counsel for the USPTO Director at the address set forth in § 1.1(a)(3)(iv) of this chapter and served on the opposing party. If both parties file notices of appeal, the first to file is deemed the appellant for purposes of this rule. If both file on the same day, the respondent is deemed the appellant.

(b) Any notice of cross-appeal shall be filed within 14 days after the date of service of the notice of appeal.

(c) After a notice of appeal is filed, the OED Director shall transmit the entire record to the USPTO Director and provide a copy to the respondent.

(d) The appellant's brief shall be filed within 30 days after the date of service of the record.

(e) Any appellee's brief shall be filed within 30 days after the date of service of the appellant's brief.

(f) The appellant's and appellee's briefs shall comply with the Federal Rules of Appellate Procedure 28(a)(2), (3), (5), (10), and 32(a)(4)–(7) unless otherwise ordered by the USPTO Director.

(g) Any reply brief shall be filed within 14 days after the date of service of the appellee's brief and, unless otherwise ordered by the USPTO Director, shall comply with Rules 28(c) and 32(a)(4)–(7) of the Federal Rules of Appellate Procedure.

(h) If a cross-appeal has been filed, the parties shall comply with Rules 28.1(c), (e), and (f) of the Federal Rules of Appellate Procedure unless otherwise ordered by the USPTO Director.

(i) References to the record in the briefs must be to the pages of the certified record.

(j) An appeal or cross-appeal must include exceptions to the decisions of the hearing officer and supporting reasons for those exceptions. Any exception not raised will be deemed to have been waived and will be disregarded by the USPTO Director in reviewing the initial decision.

(k) The USPTO Director may refuse entry of a nonconforming brief.

(l) The USPTO Director will decide the appeal on the record made before the hearing officer.

(m) Unless the USPTO Director permits, no further briefs or motions shall be filed. The USPTO Director may extend the time for filing a brief upon the granting of a motion accompanied by a supporting affidavit setting forth good cause warranting the extension.

(n) The USPTO Director may order reopening of a disciplinary proceeding in accordance with the principles that govern the granting of new trials. Any request to reopen a disciplinary proceeding on the basis of newly discovered evidence must demonstrate that the newly discovered evidence could not have been discovered any earlier by due diligence.

(o) Motions shall be served on the opposing party and filed with the USPTO Director. Each motion shall be accom-

panied by a written memorandum setting forth a concise statement of the facts and supporting reasons, along with a citation of the authorities upon which the movant relies. Unless extended by the USPTO Director for good cause, within 21 days of the date of service of the motion, an opposing party shall serve and file a response to the motion, and the moving party may file a reply within 14 days after service of the opposing party's responsive memorandum. All memoranda shall comply with Rules 32(a)(4)–(6) of the Federal Rules of Appellate Procedure unless otherwise ordered by the USPTO Director. Every motion must include a statement that the moving party or attorney for the moving party has conferred with the opposing party or attorney for the opposing party in a good faith effort to resolve the issues raised by the motion and whether the motion is opposed. If, prior to a decision on the motion, the parties resolve issues raised by a motion presented to the USPTO Director, the parties shall promptly notify the USPTO Director.

[86 FR 28463, May 26, 2021]

§ 11.56 Decision of the USPTO Director.

(a) The USPTO Director shall decide an appeal from an initial decision of the hearing officer. On appeal from the initial decision, the USPTO Director has authority to conduct a de novo review of the factual record. The USPTO Director may affirm, reverse, or modify the initial decision or remand the matter to the hearing officer for such further proceedings as the USPTO Director may deem appropriate. In making a final decision, the USPTO Director shall review the record or the portions of the record designated by the parties. The USPTO Director shall transmit a copy of the final decision to the OED Director and to the respondent.

(b) A final decision of the USPTO Director may dismiss a disciplinary proceeding, reverse or modify the initial decision, reprimand a practitioner, or may suspend or exclude the practitioner from practice before the Office. A final decision suspending or excluding a practitioner shall require compliance with the provisions of § 11.58. The

final decision may also condition the reinstatement of the practitioner upon a showing that the practitioner has taken steps to correct or mitigate the matter forming the basis of the action, or to prevent recurrence of the same or similar conduct.

(c) The respondent or the OED Director may make a single request for reconsideration or modification of the decision by the USPTO Director if filed within 20 days from the date of entry of the decision. The other party may file a response to the request for reconsideration within 14 days of the filing of the request. No request for reconsideration or modification shall be granted unless the request is based on newly discovered evidence or clear error of law or fact, and the requestor must demonstrate that any newly discovered evidence could not have been discovered any earlier by due diligence. Such a request shall have the effect of staying the effective date of the order of discipline in the final decision. The decision by the USPTO Director is effective on its date of entry.

[73 FR 47689, Aug. 14, 2008, as amended at 86 FR 28464, May 26, 2021]

§ 11.57 Review of final decision of the USPTO Director.

(a) Review of the final decision by the USPTO Director in a disciplinary case may be had by a petition filed in accordance with 35 U.S.C. 32. Any such petition shall be filed within 30 days after the date of the final decision.

(b) The respondent must serve the USPTO Director with the petition. The respondent must serve the petition in accordance with Rule 4 of the Federal Rules of Civil Procedure and § 104.2 of this chapter.

(c) Except as provided for in § 11.56(c), an order for discipline in a final decision will not be stayed except on proof of exceptional circumstances.

[86 FR 28464, May 26, 2021]

§ 11.58 Duties of disciplined practitioner or practitioner in disability inactive status.

(a) *Compliance requirements.* An excluded or suspended practitioner will not be automatically reinstated at the end of his or her period of exclusion or suspension. Unless otherwise ordered

by the USPTO Director, an excluded or suspended practitioner must comply with the provisions of this section and § 11.60 to be reinstated. A practitioner transferred to disability inactive status must comply with the provisions of this section and § 11.29 to be reinstated unless otherwise ordered by the USPTO Director. Failure to comply with the provisions of this section may constitute grounds for denying reinstatement and cause for further action.

(b) *Practice prohibitions.* Any excluded or suspended practitioner, or practitioner transferred to disability inactive status, shall:

(1) Not engage in practice before the Office in patent, trademark, or other non-patent matters;

(2) Not advertise or otherwise hold himself or herself out as authorized or able to practice before the Office; and

(3) Take all necessary steps to remove any advertisements or other representations that would reasonably suggest that the practitioner is authorized or able to practice before the Office.

(c) *Thirty-day requirements.* Within 30 days after the date of the order of exclusion, suspension, or transfer to disability inactive status, an excluded or suspended practitioner, or practitioner transferred to disability inactive status, shall:

(1) Withdraw from representation in all matters pending before the Office;

(2) Provide written notice of the order of exclusion, suspension, or transfer to disability inactive status to all State and Federal jurisdictions and administrative agencies to which the practitioner is admitted to practice;

(3) Provide to all clients having immediate or prospective business before the Office in patent, trademark, or other non-patent matters:

(i) Written notice of the order of exclusion, suspension, or transfer to disability inactive status, that calls attention to the practitioner's lack of authority to act as a practitioner after the effective date of the order; specifies any urgent dates for the client's matters; and advises the client to act promptly to seek legal advice elsewhere if the client is not already represented by another practitioner;

(ii) Any papers or other property to which the clients are entitled, or schedule a suitable time and place where the papers and other property may be obtained, and call attention to any urgency for obtaining the papers or other property; and

(iii) Any unearned fees for practice before the Office and any advanced costs not expended;

(4) Provide written notice of the order of exclusion, suspension, or transfer to disability inactive status to all opposing parties in matters pending before the Office and provide in the notice a mailing address for each client of the practitioner who is a party in the pending matter; and

(5) Serve all notices required by paragraphs (c)(2), (c)(3), and (c)(4) of this section by certified mail, return receipt requested, unless the intended recipient is located outside the United States. Where the intended recipient is located outside the United States, all notices shall be sent by a delivery service that provides the ability to confirm delivery or attempted delivery.

(d) *Forty-five-day requirements.* Within 45 days after the date of the order of exclusion, suspension, or transfer to disability inactive status, an excluded or suspended practitioner, or practitioner transferred to disability inactive status, shall file with the OED Director an affidavit of compliance certifying that the practitioner has fully complied with the provisions of the order, with this section, and with § 11.116 for withdrawal from representation. Appended to the affidavit of compliance shall be:

(1) A copy of each form of notice; the names and addresses of the clients, practitioners, courts, and agencies to which notices were sent; and all return receipts or returned mail received up to the date of the affidavit. Supplemental affidavits shall be filed covering subsequent return receipts and returned mail. Such names and addresses of clients shall remain confidential unless otherwise ordered by the USPTO Director;

(2) A schedule showing the location, title, and account number of every account in which the practitioner holds, or held as of the entry date of the

order, any client, trust, or fiduciary funds for practice before the Office;

(3) A schedule describing, and evidence showing, the practitioner's disposition of all client and fiduciary funds for practice before the Office in the practitioner's possession, custody, or control as of the date of the order or thereafter;

(4) A list of all State, Federal, and administrative jurisdictions to which the practitioner is admitted to practice; and

(5) A description of the steps taken to remove any advertisements or other representations that would reasonably suggest that the practitioner is authorized to practice patent, trademark, or other non-patent law before the Office.

(e) *Requirement to update correspondence address.* An excluded or suspended practitioner, or a practitioner transferred to disability inactive status, shall continue to file a statement in accordance with § 11.11 regarding any change of residence or other address to which communications may thereafter be directed.

(f) *Limited recognition for winding up practice.* Unless otherwise provided by an order of the USPTO Director, an excluded or suspended practitioner, or practitioner transferred to disability inactive status, shall not engage in any practice before the Office. The USPTO Director may grant such a practitioner limited recognition for a period of no more than 30 days to conclude work on behalf of a client on any matters pending before the Office. If such work cannot be concluded, the practitioner shall so advise the client so that the client may make other arrangements.

(g) *Required records.* An excluded or suspended practitioner, or practitioner transferred to disability inactive status, shall retain copies of all notices sent and maintain records of the various steps taken under this section. The practitioner shall provide proof of compliance as a condition precedent to the granting of any petition for reinstatement.

(h) *Aiding another practitioner while suspended or excluded; acting as a paralegal.* An excluded or suspended practitioner, or practitioner in disability inactive status, may act as a paralegal

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for a supervising practitioner or perform other services for the supervising practitioner that are normally performed by laypersons, provided:

(1) The practitioner is under the direct supervision of the supervising practitioner;

(2) The practitioner is a salaried employee of:

(i) The supervising practitioner,

(ii) The supervising practitioner's law firm, or

(iii) A client-employer who employs the supervising practitioner as a salaried employee;

(3) The supervising practitioner assumes full professional responsibility to any client and the Office for any work performed by the practitioner for the supervising practitioner; and

(4) The practitioner does not:

(i) Communicate directly in writing, orally, or otherwise with a client, or prospective client, of the supervising practitioner in regard to any immediate or prospective business before the Office;

(ii) Render any legal advice or any legal services in regard to any immediate or prospective business before the Office; or

(iii) Meet in person with, regardless of the presence of the supervising practitioner:

(A) Any Office employee in connection with the prosecution of any patent, trademark, or other matter before the Office;

(B) Any client, or prospective client, of the supervising practitioner, the supervising practitioner's law firm, or the client-employer of the supervising practitioner regarding immediate or prospective business before the Office; or

(C) Any witness or potential witness whom the supervising practitioner, the supervising practitioner's law firm, or the supervising practitioner's client-employer may, or intends to, call as a witness in any proceeding before the Office. The term "witness" includes individuals who will testify orally in a proceeding before, or sign an affidavit or any other document to be filed in, the Office.

(i) *Reinstatement after aiding another practitioner while suspended or excluded.* When an excluded or suspended practi-

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tioner, or practitioner transferred to disability inactive status, acts as a paralegal or performs services under paragraph (h) of this section, the practitioner shall not thereafter be reinstated to practice before the Office unless:

(1) The practitioner has filed with the OED Director an affidavit that:

(i) Explains in detail the precise nature of all paralegal or other services performed by the practitioner, and

(ii) Shows by clear and convincing evidence that the practitioner has complied with the provisions of this section and all USPTO Rules of Professional Conduct; and

(2) The supervising practitioner has filed with the OED Director a written statement that:

(i) States that the supervising practitioner has read the affidavit required by paragraph (i)(1) of this section and that the supervising practitioner believes every statement in the affidavit to be true, and

(ii) States that the supervising practitioner believes that the excluded or suspended practitioner, or practitioner transferred to disability inactive status, has complied with paragraph (h) of this section.

[86 FR 28464, May 26, 2021]

§ 11.59 Dissemination of disciplinary and other information.

(a) The OED Director shall inform the public of the disposition of each matter in which public discipline has been imposed, and of any other changes in a practitioner's registration status. Public discipline includes exclusion, as well as exclusion on consent; suspension; and public reprimand. Unless otherwise ordered by the USPTO Director, the OED Director shall give notice of public discipline and the reasons for the discipline to disciplinary enforcement agencies in the State where the practitioner is admitted to practice, to courts where the practitioner is known to be admitted, and the public. If public discipline is imposed, the OED Director shall cause a final decision of the USPTO Director to be published. Final decisions of the USPTO Director include default judgments. See § 11.54(a)(2). If a private reprimand is imposed, the OED Director shall cause

a redacted version of the final decision to be published.

(b) *Records available to the public.* Unless the USPTO Director orders that the proceeding or a portion of the record be kept confidential, the OED Director's records of every disciplinary proceeding where a practitioner is reprimanded, suspended, or excluded, including when said sanction is imposed by default judgment, shall be made available to the public upon written request, except that information may be withheld as necessary to protect the privacy of third parties or as directed in a protective order issued pursuant to § 11.44(c). The record of a proceeding that results in a practitioner's transfer to disability inactive status shall not be available to the public.

(c) *Access to records of exclusion by consent.* Unless the USPTO Director orders that the proceeding or a portion of the record be kept confidential, an order excluding a practitioner on consent under § 11.27 and the affidavit required under paragraph (a) of § 11.27 shall be available to the public, except that information in the order or affidavit may be withheld as necessary to protect the privacy of third parties or as directed in a protective order under § 11.44(c). The affidavit required under paragraph (a) of § 11.27 shall not be used in any other proceeding except by order of the USPTO Director or upon written consent of the practitioner.

§ 11.60 Petition for reinstatement of disciplined practitioner.

(a) *Restrictions on practice.* An excluded or suspended practitioner shall not resume the practice of patent, trademark, or other non-patent matters before the Office until reinstated.

(b) *Petition for reinstatement for excluded or suspended practitioners.* An excluded or suspended practitioner shall be eligible to petition for reinstatement only upon expiration of the period of suspension or exclusion and the practitioner's full compliance with § 11.58. An excluded practitioner shall be eligible to petition for reinstatement no earlier than five years from the effective date of the exclusion.

(c) *Review of reinstatement petition.* An excluded or suspended practitioner shall file a petition for reinstatement

accompanied by the fee required by § 1.21(a)(10) of this chapter. The petition for reinstatement shall be filed with the OED Director. A practitioner who has violated any provision of § 11.58 shall not be eligible for reinstatement until a continuous period of the time in compliance with § 11.58 that is equal to the period of suspension or exclusion has elapsed. If the excluded or suspended practitioner is not eligible for reinstatement, or if the OED Director determines that the petition is insufficient or defective on its face, the OED Director may dismiss the petition. Otherwise, the OED Director shall consider the petition for reinstatement. The excluded or suspended practitioner seeking reinstatement shall have the burden of proving, by clear and convincing evidence, that:

(1) The excluded or suspended practitioner has the good moral character and reputation, competency, and learning in law required under § 11.7 for admission;

(2) The resumption of practice before the Office will not be detrimental to the administration of justice or subversive to the public interest; and

(3) The practitioner, if suspended, has complied with the provisions of § 11.58 for the full period of suspension or, if excluded, has complied with the provisions of § 11.58 for at least five continuous years.

(d) *Petitions for reinstatement—Action by the OED Director granting reinstatement.* (1) If the excluded or suspended practitioner is found to have complied with paragraphs (c)(1) through (c)(3) of this section, the OED Director shall enter an order of reinstatement that shall be conditioned on payment of the costs of the disciplinary proceeding to the extent set forth in paragraphs (d)(2) and (d)(3) of this section.

(2) *Payment of costs of disciplinary proceedings.* Prior to reinstatement to practice under this section, the excluded or suspended practitioner shall pay the costs of the disciplinary proceeding. The costs imposed pursuant to this section include all of the following:

(i) The actual expense incurred by the OED Director or the Office for the original and copies of any reporter's

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transcripts of the disciplinary proceeding and any fee paid for the services of the reporter;

(ii) All expenses paid by the OED Director or the Office that would qualify as taxable costs recoverable in civil proceedings; and

(iii) The charges determined by the OED Director to be “reasonable costs” of investigation, hearing, and review. These amounts shall serve to defray the costs, other than fees for services of attorneys and experts, of the Office of Enrollment and Discipline in the preparation or hearing of the disciplinary proceeding and costs incurred in the administrative processing of the disciplinary proceeding.

(3) A practitioner may only be granted relief from an order assessing costs under this section, whether in whole or in part or by grant of an extension of time to pay these costs, upon grounds of hardship, special circumstances, or other good cause at the discretion of the OED Director.

(e) *Petitions for reinstatement—Action by the OED Director denying reinstatement.* If the excluded or suspended practitioner is found unfit to resume practice before the Office, the OED Director shall first provide the excluded or suspended practitioner with an opportunity to show cause in writing why the petition should not be denied. If unpersuaded by the showing, the OED Director shall deny the petition. In addition to the reinstatement provisions set forth in this section, the OED Director may require the excluded or suspended practitioner, in meeting the requirements of paragraph (c)(1) of this section, to take and pass the registration examination; attend ethics, substance abuse, or law practice management courses; and/or take and pass the Multistate Professional Responsibility Examination.

(f) *Right to review.* An excluded or suspended practitioner dissatisfied with a final decision of the OED Director regarding his or her reinstatement may seek review by the USPTO Director pursuant to §11.2(d).

(g) *Resubmission of petitions for reinstatement.* If a petition for reinstatement is denied, no further petition for reinstatement may be filed until the expiration of at least one year fol-

lowing the denial unless the order of denial provides otherwise.

(h) *Reinstatement proceedings open to public.* (1) Proceedings on any petition for reinstatement shall be open to the public. Before reinstating any excluded or suspended practitioner, the OED Director shall publish a notice that such practitioner seeks reinstatement and shall permit the public a reasonable opportunity to comment or submit evidence regarding such matter.

(2) Up to 90 days prior to the expiration of the period of suspension or exclusion, a practitioner may file a written notice of his or her intent to seek reinstatement with the OED Director and may request that such notice be published. In the absence of such a request, notice of a petition for reinstatement will be published upon receipt of such petition.

[86 FR 28465, May 26, 2021]

§§ 11.61–11.99 [Reserved]

Subpart D—USPTO Rules of Professional Conduct

SOURCE: 78 FR 20201, Apr. 3, 2013, unless otherwise noted.

§ 11.100 [Reserved]

CLIENT-PRACTITIONER RELATIONSHIP

§ 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.

§ 11.102 Scope of representation and allocation of authority between client and practitioner.

(a) Subject to paragraphs (c) and (d) of this section, a practitioner shall abide by a client’s decisions concerning the objectives of representation and, as required by §11.104, shall consult with the client as to the means by which they are to be pursued. A practitioner may take such action on behalf of the client as is impliedly authorized to

carry out the representation. A practitioner shall abide by a client's decision whether to settle a matter.

(b) [Reserved]

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

(d) A practitioner shall not counsel a client to engage, or assist a client, in conduct that the practitioner knows is criminal or fraudulent, but a practitioner may discuss the legal consequences of any proposed course of conduct with a client and may counsel or assist a client to make a good-faith effort to determine the validity, scope, meaning or application of the law.

§ 11.103 Diligence.

A practitioner shall act with reasonable diligence and promptness in representing a client.

§ 11.104 Communication.

(a) A practitioner shall:

(1) Promptly inform the client of any decision or circumstance with respect to which the client's informed consent is required by the USPTO Rules of Professional Conduct;

(2) Reasonably consult with the client about the means by which the client's objectives are to be accomplished;

(3) Keep the client reasonably informed about the status of the matter;

(4) Promptly comply with reasonable requests for information from the client; and

(5) Consult with the client about any relevant limitation on the practitioner's conduct when the practitioner knows that the client expects assistance not permitted by the USPTO Rules of Professional Conduct or other law.

(b) A practitioner shall explain a matter to the extent reasonably necessary to permit the client to make informed decisions regarding the representation.

§ 11.105 Fees.

(a) A practitioner shall not make an agreement for, charge, or collect an unreasonable fee or an unreasonable amount for expenses. The factors to be

considered in determining the reasonableness of a fee include the following:

(1) The time and labor required, the novelty and difficulty of the questions involved, and the skill requisite to perform the legal service properly;

(2) The likelihood, if apparent to the client, that the acceptance of the particular employment will preclude other employment by the practitioner;

(3) The fee customarily charged in the locality for similar legal services;

(4) The amount involved and the results obtained;

(5) The time limitations imposed by the client or by the circumstances;

(6) The nature and length of the professional relationship with the client;

(7) The experience, reputation, and ability of the practitioner or practitioners performing the services; and

(8) Whether the fee is fixed or contingent.

(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.

(c) A fee may be contingent on the outcome of the matter for which the service is rendered, except in a matter in which a contingent fee is prohibited by law. A contingent fee agreement shall be in a writing signed by the client and shall state the method by which the fee is to be determined, including the percentage or percentages that shall accrue to the practitioner in the event of settlement, trial or appeal; litigation and other expenses to be deducted from the recovery; and whether such expenses are to be deducted before or after the contingent fee is calculated. The agreement must clearly notify the client of any expenses for which the client will be liable whether or not the client is the prevailing party. Upon conclusion of a contingent

fee matter, the practitioner shall provide the client with a written statement stating the outcome of the matter and, if there is a recovery, showing the remittance to the client and the method of its determination.

(d) [Reserved]

(e) A division of a fee between practitioners who are not in the same firm may be made only if:

(1) The division is in proportion to the services performed by each practitioner or each practitioner assumes joint responsibility for the representation;

(2) The client agrees to the arrangement, including the share each practitioner will receive, and the agreement is confirmed in writing; and

(3) The total fee is reasonable.

§ 11.106 Confidentiality of information.

(a) A practitioner shall not reveal information relating to the representation of a client unless the client gives informed consent, the disclosure is impliedly authorized in order to carry out the representation, the disclosure is permitted by paragraph (b) of this section, or the disclosure is required by paragraph (c) of this section.

(b) A practitioner may reveal information relating to the representation of a client to the extent the practitioner reasonably believes necessary:

(1) To prevent reasonably certain death or substantial bodily harm;

(2) To prevent the client from engaging in inequitable conduct before the Office or from committing a crime or fraud that is reasonably certain to result in substantial injury to the financial interests or property of another and in furtherance of which the client has used or is using the practitioner's services;

(3) To prevent, mitigate, or rectify substantial injury to the financial interests or property of another that is reasonably certain to result or has resulted from the client's commission of a crime, fraud, or inequitable conduct before the Office in furtherance of which the client has used the practitioner's services;

(4) To secure legal advice about the practitioner's compliance with the USPTO Rules of Professional Conduct;

(5) To establish a claim or defense on behalf of the practitioner in a controversy between the practitioner and the client, to establish a defense to a criminal charge or civil claim against the practitioner based upon conduct in which the client was involved, or to respond to allegations in any proceeding concerning the practitioner's representation of the client;

(6) To comply with other law or a court order; or

(7) To detect and resolve conflicts of interest arising from the practitioner's change of employment or from changes in the composition or ownership of a firm, but only if the revealed information would not compromise the practitioner-client privilege or otherwise prejudice the client.

(c) A practitioner shall disclose to the Office information necessary to comply with applicable duty of disclosure provisions.

(d) A practitioner shall make reasonable efforts to prevent the inadvertent or unauthorized disclosure of, or unauthorized access to, information relating to the representation of a client.

[86 FR 28466, May 26, 2021]

§ 11.107 Conflict of interest; Current clients.

(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.

§ 11.108 Conflict of interest; Current clients; Specific rules.

(a) A practitioner shall not enter into a business transaction with a client or knowingly acquire an ownership, possessory, security or other pecuniary interest adverse to a client unless:

(1) The transaction and terms on which the practitioner acquires the interest are fair and reasonable to the client and are fully disclosed and transmitted in writing in a manner that can be reasonably understood by the client;

(2) The client is advised in writing of the desirability of seeking and is given a reasonable opportunity to seek the advice of independent legal counsel in the transaction; and

(3) The client gives informed consent, in a writing signed by the client, to the essential terms of the transaction and the practitioner's role in the transaction, including whether the practitioner is representing the client in the transaction.

(b) A practitioner shall not use information relating to representation of a client to the disadvantage of the client unless the client gives informed consent, except as permitted or required by the USPTO Rules of Professional Conduct.

(c) A practitioner shall not solicit any substantial gift from a client, including a testamentary gift, or prepare on behalf of a client an instrument giving the practitioner or a person related to the practitioner any substantial gift unless the practitioner or other recipient of the gift is related to the client. For purposes of this paragraph, related persons include a spouse, child, grandchild, parent, grandparent or other relative or individual with whom the practitioner or the client maintains a close, familial relationship.

(d) Prior to the conclusion of representation of a client, a practitioner shall not make or negotiate an agreement giving the practitioner literary

or media rights to a portrayal or account based in substantial part on information relating to the representation.

(e) A practitioner shall not provide financial assistance to a client in connection with pending or contemplated litigation or a proceeding before the Office, except that:

(1) A practitioner may advance court costs and expenses of litigation, the repayment of which may be contingent on the outcome of the matter;

(2) A practitioner representing an indigent client may pay court costs and expenses of litigation or a proceeding before the Office on behalf of the client;

(3) A practitioner may advance costs and expenses in connection with a proceeding before the Office provided the client remains ultimately liable for such costs and expenses; and

(4) A practitioner may also advance any fee required to prevent or remedy an abandonment of a client's application by reason of an act or omission attributable to the practitioner and not to the client, whether or not the client is ultimately liable for such fee.

(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.

(g) A practitioner who represents two or more clients shall not participate in making an aggregate settlement of the claims of or against the clients, unless each client gives informed consent, in a writing signed by the client. The practitioner's disclosure shall include the existence and nature of all the claims involved and of the participation of each person in the settlement.

(h) A practitioner shall not:

(1) Make an agreement prospectively limiting the practitioner's liability to a client for malpractice unless the client is independently represented in making the agreement; or

(2) Settle a claim or potential claim for such liability with an unrepresented client or former client unless that person is advised in writing of the desirability of seeking and is given a reasonable opportunity to seek the advice of independent legal counsel in connection therewith.

(i) A practitioner shall not acquire a proprietary interest in the cause of action, subject matter of litigation, or a proceeding before the Office which the practitioner is conducting for a client, except that the practitioner may, subject to the other provisions in this section:

(1) Acquire a lien authorized by law to secure the practitioner's fee or expenses;

(2) Contract with a client for a reasonable contingent fee in a civil case; and

(3) In a patent case or a proceeding before the Office, take an interest in the patent or patent application as part or all of his or her fee.

(j) [Reserved]

(k) While practitioners are associated in a firm, a prohibition in paragraphs (a) through (i) of this section that applies to any one of them shall apply to all of them.

§ 11.109 Duties to former clients.

(a) A practitioner who has formerly represented a client in a matter shall not thereafter represent another person in the same or a substantially related matter in which that person's interests are materially adverse to the interests of the former client unless the former client gives informed consent, confirmed in writing.

(b) A practitioner shall not knowingly represent a person in the same or a substantially related matter in which a firm with which the practitioner formerly was associated had previously represented a client:

(1) Whose interests are materially adverse to that person; and

(2) About whom the practitioner had acquired information protected by §§ 11.106 and 11.109(c) that is material to the matter; unless the former client gives informed consent, confirmed in writing.

(c) A practitioner who has formerly represented a client in a matter or

whose present or former firm has formerly represented a client in a matter shall not thereafter:

(1) Use information relating to the representation to the disadvantage of the former client except as the USPTO Rules of Professional Conduct would permit or require with respect to a client, or when the information has become generally known; or

(2) Reveal information relating to the representation except as the USPTO Rules of Professional Conduct would permit or require with respect to a client.

§ 11.110 Imputation of conflicts of interest; General rule.

(a) While practitioners are associated in a firm, none of them shall knowingly represent a client when any one of them practicing alone would be prohibited from doing so by §§ 11.107 or 11.109, unless:

(1) The prohibition is based on a personal interest of the disqualified practitioner and does not present a significant risk of materially limiting the representation of the client by the remaining practitioners in the firm; or

(2) The prohibition is based upon § 11.109(a) or (b), and arises out of the disqualified practitioner's association with a prior firm, and

(i) The disqualified practitioner is timely screened from any participation in the matter and is apportioned no part of the fee therefrom; and

(ii) Written notice is promptly given to any affected former client to enable the former client to ascertain compliance with the provisions of this section, which shall include a description of the screening procedures employed; a statement of the firm's and of the screened practitioner's compliance with the USPTO Rules of Professional Conduct; a statement that review may be available before a tribunal; and an agreement by the firm to respond promptly to any written inquiries or objections by the former client about the screening procedures.

(b) When a practitioner has terminated an association with a firm, the firm is not prohibited from thereafter representing a person with interests materially adverse to those of a client represented by the formerly associated

practitioner and not currently represented by the firm, unless:

(1) The matter is the same or substantially related to that in which the formerly associated practitioner represented the client; and

(2) Any practitioner remaining in the firm has information protected by §§ 11.106 and 11.109(c) that is material to the matter.

(c) A disqualification prescribed by this section may be waived by the affected client under the conditions stated in § 11.107.

(d) The disqualification of practitioners associated in a firm with former or current Federal Government lawyers is governed by § 11.111.

§ 11.111 Former or current Federal Government employees.

A practitioner who is a former or current Federal Government employee shall not engage in any conduct which is contrary to applicable Federal ethics law, including conflict of interest statutes and regulations of the department, agency or commission formerly or currently employing said practitioner.

§ 11.112 Former judge, arbitrator, mediator or other third-party neutral.

(a) Except as stated in paragraph (d) of this section, a practitioner shall not represent anyone in connection with a matter in which the practitioner participated personally and substantially as a judge or other adjudicative officer or law clerk to such a person or as an arbitrator, mediator or other third-party neutral, unless all parties to the proceeding give informed consent, confirmed in writing.

(b) A practitioner shall not negotiate for employment with any person who is involved as a party or as practitioner for a party in a matter in which the practitioner is participating personally and substantially as a judge or other adjudicative officer or as an arbitrator, mediator or other third-party neutral. A practitioner serving as a law clerk to a judge or other adjudicative officer may negotiate for employment with a party or practitioner involved in a matter in which the clerk is participating personally and substantially, but only after the practitioner has no-

tified the judge, or other adjudicative officer.

(c) If a practitioner is disqualified by paragraph (a) of this section, no practitioner in a firm with which that practitioner is associated may knowingly undertake or continue representation in the matter unless:

(1) The disqualified practitioner is timely screened from any participation in the matter and is apportioned no part of the fee therefrom; and

(2) Written notice is promptly given to the parties and any appropriate tribunal to enable them to ascertain compliance with the provisions of this section.

(d) An arbitrator selected as a partisan of a party in a multimember arbitration panel is not prohibited from subsequently representing that party.

§ 11.113 Organization as client.

(a) A practitioner employed or retained by an organization represents the organization acting through its duly authorized constituents.

(b) If a practitioner for an organization knows that an officer, employee or other person associated with the organization is engaged in action, intends to act or refuses to act in a matter related to the representation that is a violation of a legal obligation to the organization, or a violation of law that reasonably might be imputed to the organization, and that is likely to result in substantial injury to the organization, then the practitioner shall proceed as is reasonably necessary in the best interest of the organization. Unless the practitioner reasonably believes that it is not necessary in the best interest of the organization to do so, the practitioner shall refer the matter to higher authority in the organization, including, if warranted by the circumstances, to the highest authority that can act on behalf of the organization as determined by applicable law.

(c) Except as provided in paragraph (d) of this section, if

(1) Despite the practitioner's efforts in accordance with paragraph (b) of this section the highest authority that can act on behalf of the organization insists upon or fails to address in a

timely and appropriate manner an action, or a refusal to act, that is clearly a violation of law, and

(2) The practitioner reasonably believes that the violation is reasonably certain to result in substantial injury to the organization, then the practitioner may reveal information relating to the representation whether or not § 11.106 permits such disclosure, but only if and to the extent the practitioner reasonably believes necessary to prevent substantial injury to the organization.

(d) Paragraph (c) of this section shall not apply with respect to information relating to a practitioner's representation of an organization to investigate an alleged violation of law, or to defend the organization or an officer, employee or other constituent associated with the organization against a claim arising out of an alleged violation of law.

(e) A practitioner who reasonably believes that he or she has been discharged because of the practitioner's actions taken pursuant to paragraphs (b) or (c) of this section, or who withdraws under circumstances that require or permit the practitioner to take action under either of those paragraphs, shall proceed as the practitioner reasonably believes necessary to assure that the organization's highest authority is informed of the practitioner's discharge or withdrawal.

(f) In dealing with an organization's directors, officers, employees, members, shareholders, or other constituents, a practitioner shall explain the identity of the client when the practitioner knows or reasonably should know that the organization's interests are adverse to those of the constituents with whom the practitioner is dealing.

(g) A practitioner representing an organization may also represent any of its directors, officers, employees, members, shareholders or other constituents, subject to the provisions of § 11.107. If the organization's consent to the dual representation is required by § 11.107, the consent shall be given by an appropriate official of the organization other than the individual who is to be represented, or by the shareholders.

§ 11.114 Client with diminished capacity.

(a) When a client's capacity to make adequately considered decisions in connection with a representation is diminished, whether because of minority, mental impairment or for some other reason, the practitioner shall, as far as reasonably possible, maintain a normal client-practitioner relationship with the client.

(b) When the practitioner reasonably believes that the client has diminished capacity, is at risk of substantial physical, financial or other harm unless action is taken and cannot adequately act in the client's own interest, the practitioner may take reasonably necessary protective action, including consulting with individuals or entities that have the ability to take action to protect the client and, in appropriate cases, seeking the appointment of a guardian ad litem, conservator or guardian.

(c) Information relating to the representation of a client with diminished capacity is protected under § 11.106. When taking protective action pursuant to paragraph (b) of this section, the practitioner is impliedly authorized under § 11.106(a) to reveal information about the client, but only to the extent reasonably necessary to protect the client's interests.

§ 11.115 Safekeeping property.

(a) A practitioner shall hold property of clients or third persons that is in a practitioner's possession in connection with a representation separate from the practitioner's own property. Funds shall be kept in a separate account maintained in the state where the practitioner's office is situated, or elsewhere with the consent of the client or third person. Where the practitioner's office is situated in a foreign country, funds shall be kept in a separate account maintained in that foreign country or elsewhere with the consent of the client or third person. Other property shall be identified as such and appropriately safeguarded. Complete records of such account funds and other property shall be kept by the practitioner and shall be preserved for a period of five years after termination of the representation.

(b) A practitioner may deposit the practitioner's own funds in a client trust account for the sole purpose of paying bank service charges on that account, but only in an amount necessary for that purpose.

(c) A practitioner shall deposit into a client trust account legal fees and expenses that have been paid in advance, to be withdrawn by the practitioner only as fees are earned or expenses incurred.

(d) Upon receiving funds or other property in which a client or third person has an interest, a practitioner shall promptly notify the client or third person. Except as stated in this section or otherwise permitted by law or by agreement with the client, a practitioner shall promptly deliver to the client or third person any funds or other property that the client or third person is entitled to receive and, upon request by the client or third person, shall promptly render a full accounting regarding such property.

(e) When in the course of representation a practitioner is in possession of property in which two or more persons (one of whom may be the practitioner) claim interests, the property shall be kept separate by the practitioner until the dispute is resolved. The practitioner shall promptly distribute all portions of the property as to which the interests are not in dispute.

(f) All separate accounts for clients or third persons kept by a practitioner must also comply with the following provisions:

(1) *Required records.* The records to be kept include:

(i) Receipt and disbursement journals containing a record of deposits to and withdrawals from client trust accounts, specifically identifying the date, source, and description of each item deposited, as well as the date, payee and purpose of each disbursement;

(ii) Ledger records for all client trust accounts showing, for each separate trust client or beneficiary, the source of all funds deposited, the names of all persons for whom the funds are or were held, the amount of such funds, the descriptions and amounts of charges or withdrawals, and the names of all per-

sons or entities to whom such funds were disbursed;

(iii) Copies of retainer and compensation agreements with clients;

(iv) Copies of accountings to clients or third persons showing the disbursement of funds to them or on their behalf;

(v) Copies of bills for legal fees and expenses rendered to clients;

(vi) Copies of records showing disbursements on behalf of clients;

(vii) The physical or electronic equivalents of all checkbook registers, bank statements, records of deposit, pre-numbered canceled checks, and substitute checks provided by a financial institution;

(viii) Records of all electronic transfers from client trust accounts, including the name of the person authorizing transfer, the date of transfer, the name of the recipient and confirmation from the financial institution of the trust account number from which money was withdrawn and the date and the time the transfer was completed;

(ix) Copies of monthly trial balances and quarterly reconciliations of the client trust accounts maintained by the practitioner; and

(x) Copies of those portions of client files that are reasonably related to client trust account transactions.

(2) *Client trust account safeguards.* With respect to client trust accounts required by paragraphs (a) through (e) of this section:

(i) Only a practitioner or a person under the direct supervision of the practitioner shall be an authorized signatory or authorize transfers from a client trust account;

(ii) Receipts shall be deposited intact and records of deposit should be sufficiently detailed to identify each item; and

(iii) Withdrawals shall be made only by check payable to a named payee and not to cash, or by authorized electronic transfer.

(3) *Availability of records.* Records required by paragraph (f)(1) of this section may be maintained by electronic, photographic, or other media provided that they otherwise comply with paragraphs (f)(1) and (f)(2) of this section

and that printed copies can be produced. These records shall be readily accessible to the practitioner.

(4) *Lawyers.* The records kept by a lawyer are deemed to be in compliance with this section if the types of records that are maintained meet the recordkeeping requirements of a state in which the lawyer is licensed and in good standing, the recordkeeping requirements of the state where the lawyer's principal place of business is located, or the recordkeeping requirements of this section.

(5) *Patent agents and persons granted limited recognition who are employed in the United States by a law firm.* The records kept by a law firm employing one or more registered patent agents or persons granted limited recognition under § 11.9 are deemed to be in compliance with this section if the types of records that are maintained meet the recordkeeping requirements of the state where at least one practitioner of the law firm is licensed and in good standing, the recordkeeping requirements of the state where the law firm's principal place of business is located, or the recordkeeping requirements of this section.

§ 11.116 Declining or terminating representation.

(a) Except as stated in paragraph (c) of this section, a practitioner shall not represent a client, or where representation has commenced, shall withdraw from the representation of a client if:

(1) The representation will result in violation of the USPTO Rules of Professional Conduct or other law;

(2) The practitioner's physical or mental condition materially impairs the practitioner's ability to represent the client; or

(3) The practitioner is discharged.

(b) Except as stated in paragraph (c) of this section, a practitioner may withdraw from representing a client if:

(1) Withdrawal can be accomplished without material adverse effect on the interests of the client;

(2) The client persists in a course of action involving the practitioner's services that the practitioner reasonably believes is criminal or fraudulent;

(3) The client has used the practitioner's services to perpetrate a crime or fraud;

(4) A client insists upon taking action that the practitioner considers repugnant or with which the practitioner has a fundamental disagreement;

(5) The client fails substantially to fulfill an obligation to the practitioner regarding the practitioner's services and has been given reasonable warning that the practitioner will withdraw unless the obligation is fulfilled;

(6) The representation will result in an unreasonable financial burden on the practitioner or has been rendered unreasonably difficult by the client; or

(7) Other good cause for withdrawal exists.

(c) A practitioner must comply with applicable law requiring notice to or permission of a tribunal when terminating a representation. When ordered to do so by a tribunal, a practitioner shall continue representation notwithstanding good cause for terminating the representation.

(d) Upon termination of representation, a practitioner shall take steps to the extent reasonably practicable to protect a client's interests, such as giving reasonable notice to the client, allowing time for employment of other counsel, surrendering papers and property to which the client is entitled and refunding any advance payment of fee or expense that has not been earned or incurred. The practitioner may retain papers relating to the client to the extent permitted by other law.

§ 11.117 Sale of law practice.

A practitioner or a law firm may sell or purchase a law practice, or an area of law practice, including good will, if the following conditions are satisfied:

(a) The seller ceases to engage in the private practice of law, or in the area of practice that has been sold, in a geographic area in which the practice has been conducted;

(b)(1) Except as provided in paragraph (b)(2) of this section, the entire practice, or the entire area of practice, is sold to one or more lawyers or law firms;

(2) To the extent the practice or the area of practice involves patent proceedings before the Office, that practice or area of practice may be sold only to one or more registered practitioners or law firms that include at least one registered practitioner;

(c)(1) The seller gives written notice to each of the seller's clients regarding:

(i) The proposed sale;

(ii) The client's right to retain other counsel or to take possession of the file; and

(iii) The fact that the client's consent to the transfer of the client's files will be presumed if the client does not take any action or does not otherwise object within ninety (90) days after receipt of the notice.

(2) If a client cannot be given notice, the representation of that client may be transferred to the purchaser only upon entry of an order so authorizing by a court having jurisdiction. The seller may disclose to the court in camera information relating to the representation only to the extent necessary to obtain an order authorizing the transfer of a file; and

(d) The fees charged clients shall not be increased by reason of the sale.

§ 11.118 Duties to prospective client.

(a) A person who consults with a practitioner about the possibility of forming a client-practitioner relationship with respect to a matter is a prospective client.

(b) Even when no client-practitioner relationship ensues, a practitioner who has learned information from a prospective client shall not use or reveal that information, except as § 11.109 would permit with respect to information of a former client.

(c) A practitioner subject to paragraph (b) of this section shall not represent a client with interests materially adverse to those of a prospective client in the same or a substantially related matter if the practitioner received information from the prospective client that could be significantly harmful to that person in the matter, except as provided in paragraph (d) of this section. If a practitioner is disqualified from representation under this paragraph, no practitioner in a firm with which that practitioner is as-

sociated may knowingly undertake or continue representation in such a matter, except as provided in paragraph (d) of this section.

(d) When the practitioner has received disqualifying information as defined in paragraph (c) of this section, representation is permissible if:

(1) Both the affected client and the prospective client have given informed consent, confirmed in writing; or

(2) The practitioner who received the information took reasonable measures to avoid exposure to more disqualifying information than was reasonably necessary to determine whether to represent the prospective client; and

(i) The disqualified practitioner is timely screened from any participation in the matter and is apportioned no part of the fee therefrom; and

(ii) Written notice is promptly given to the prospective client.

[78 FR 20201, Apr. 3, 2013, as amended at 86 FR 28466, May 26, 2021]

§§ 11.119–11.200 [Reserved]

COUNSELOR

§ 11.201 Advisor.

In representing a client, a practitioner shall exercise independent professional judgment and render candid advice. In rendering advice, a practitioner may refer not only to law but to other considerations such as moral, economic, social and political factors that may be relevant to the client's situation.

§ 11.202 [Reserved]

§ 11.203 Evaluation for use by third persons.

(a) A practitioner may provide an evaluation of a matter affecting a client for the use of someone other than the client if the practitioner reasonably believes that making the evaluation is compatible with other aspects of the practitioner's relationship with the client.

(b) When the practitioner knows or reasonably should know that the evaluation is likely to affect the client's interests materially and adversely, the

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practitioner shall not provide the evaluation unless the client gives informed consent.

(c) Except as disclosure is authorized in connection with a report of an evaluation, information relating to the evaluation is otherwise protected by § 11.106.

§ 11.204 Practitioner serving as third-party neutral.

(a) A practitioner serves as a third-party neutral when the practitioner assists two or more persons who are not clients of the practitioner to reach a resolution of a dispute or other matter that has arisen between them. Service as a third-party neutral may include service as an arbitrator, a mediator or in such other capacity as will enable the practitioner to assist the parties to resolve the matter.

(b) A practitioner serving as a third-party neutral shall inform unrepresented parties that the practitioner is not representing them. When the practitioner knows or reasonably should know that a party does not understand the practitioner's role in the matter, the practitioner shall explain the difference between the practitioner's role as a third-party neutral and a practitioner's role as one who represents a client.

§§ 11.205–11.300 [Reserved]

ADVOCATE

§ 11.301 Meritorious claims and contentions.

A practitioner shall not bring or defend a proceeding, or assert or controvert an issue therein, unless there is a basis in law and fact for doing so that is not frivolous, which includes a good-faith argument for an extension, modification or reversal of existing law.

§ 11.302 Expediting proceedings.

A practitioner shall make reasonable efforts to expedite proceedings before a tribunal consistent with the interests of the client.

§ 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;

(2) Fail to disclose to the tribunal legal authority in the controlling jurisdiction known to the practitioner to be directly adverse to the position of the client and not disclosed by opposing counsel in an *inter partes* proceeding, or fail to disclose such authority in an *ex parte* proceeding before the Office if such authority is not otherwise disclosed; or

(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. A practitioner may refuse to offer evidence that the practitioner reasonably believes is false.

(b) A practitioner who represents a client in a proceeding before a tribunal and who knows that a person intends to engage, is engaging or has engaged in criminal or fraudulent conduct related to the proceeding shall take reasonable remedial measures, including, if necessary, disclosure to the tribunal.

(c) The duties stated in paragraphs (a) and (b) of this section continue to the conclusion of the proceeding, and apply even if compliance requires disclosure of information otherwise protected by § 11.106.

(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.

(e) In a proceeding before the Office, a practitioner shall disclose to the Office information necessary to comply with applicable duty of disclosure provisions.

§ 11.304 Fairness to opposing party and counsel.

A practitioner shall not:

(a) Unlawfully obstruct another party's access to evidence or unlawfully alter, destroy or conceal a document or

other material having potential evidentiary value. A practitioner shall not counsel or assist another person to do any such act;

(b) Falsify evidence, counsel or assist a witness to testify falsely, or offer an inducement to a witness that is prohibited by law;

(c) Knowingly disobey an obligation under the rules of a tribunal except for an open refusal based on an assertion that no valid obligation exists;

(d) Make a frivolous discovery request or fail to make a reasonably diligent effort to comply with a legally proper discovery request by an opposing party;

(e) In a proceeding before a tribunal, allude to any matter that the practitioner does not reasonably believe is relevant or that will not be supported by admissible evidence, assert personal knowledge of facts in issue except when testifying as a witness, or state a personal opinion as to the justness of a cause, the credibility of a witness, the culpability of a civil litigant or the guilt or innocence of an accused; or

(f) Request a person other than a client to refrain from voluntarily giving relevant information to another party unless:

(1) The person is a relative or an employee or other agent of a client; and

(2) The practitioner reasonably believes that the person's interests will not be adversely affected by refraining from giving such information.

§ 11.305 Impartiality and decorum of the tribunal.

A practitioner shall not:

(a) Seek to influence a judge, hearing officer, administrative law judge, administrative patent judge, administrative trademark judge, juror, prospective juror, employee or officer of the Office, or other official by means prohibited by law;

(b) Communicate *ex parte* with such a person during the proceeding unless authorized to do so by law, rule or court order; or

(c) [Reserved]

(d) Engage in conduct intended to disrupt any proceeding before a tribunal.

§ 11.306 Trial publicity.

(a) A practitioner who is participating or has participated in the investigation or litigation of a matter shall not make an extrajudicial statement that the practitioner knows or reasonably should know will be disseminated by means of public communication and will have a substantial likelihood of materially prejudicing an adjudicative proceeding in the matter.

(b) Notwithstanding paragraph (a) of this section, a practitioner may state:

(1) The claim, offense or defense involved and, except when prohibited by law, the identity of the persons involved;

(2) Information contained in a public record;

(3) That an investigation of a matter is in progress;

(4) The scheduling or result of any step in litigation;

(5) A request for assistance in obtaining evidence and information necessary thereto; and

(6) A warning of danger concerning the behavior of a person involved, when there is reason to believe that there exists the likelihood of substantial harm to an individual or to the public interest.

(c) Notwithstanding paragraph (a) of this section, a practitioner may make a statement that a reasonable practitioner would believe is required to protect a client from the substantial undue prejudicial effect of recent publicity not initiated by the practitioner or the practitioner's client. A statement made pursuant to this paragraph shall be limited to such information as is necessary to mitigate the recent adverse publicity.

(d) No practitioner associated in a firm or government agency with a practitioner subject to paragraph (a) of this section shall make a statement prohibited by paragraph (a).

§ 11.307 Practitioner as witness.

(a) A practitioner shall not act as advocate at a proceeding before a tribunal in which the practitioner is likely to be a necessary witness unless:

(1) The testimony relates to an uncontested issue;

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(2) The testimony relates to the nature and value of legal services rendered in the case; or

(3) Disqualification of the practitioner would work substantial hardship on the client.

(b) A practitioner may act as advocate in a proceeding before a tribunal in which another practitioner in the practitioner's firm is likely to be called as a witness unless precluded from doing so by §§ 11.107 or 11.109.

§ 11.308 [Reserved]

§ 11.309 Advocate in nonadjudicative proceedings.

A practitioner representing a client before a legislative body or administrative agency in a nonadjudicative proceeding shall disclose that the appearance is in a representative capacity and shall conform to the provisions of §§ 11.303(a) through (c), 11.304(a) through (c), and 11.305.

§§ 11.310–11.400 [Reserved]

TRANSACTIONS WITH PERSONS OTHER THAN CLIENTS

§ 11.401 Truthfulness in statements to others.

In the course of representing a client, a practitioner shall not knowingly:

(a) Make a false statement of material fact or law to a third person; or

(b) Fail to disclose a material fact to a third person when disclosure is necessary to avoid assisting a criminal or fraudulent act by a client, unless disclosure is prohibited by § 11.106.

§ 11.402 Communication with person represented by a practitioner.

(a) In representing a client, a practitioner shall not communicate about the subject of the representation with a person the practitioner knows to be represented by another practitioner in the matter, unless the practitioner has the consent of the other practitioner or is authorized to do so by law, rule, or a court order.

(b) This section does not prohibit communication by a practitioner with government officials who are otherwise represented by counsel and who have the authority to redress the grievances of the practitioner's client, provided

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that, if the communication relates to a matter for which the government official is represented, then prior to the communication the practitioner must disclose to such government official both the practitioner's identity and the fact that the practitioner represents a party with a claim against the government.

§ 11.403 Dealing with unrepresented person.

In dealing on behalf of a client with a person who is not represented by a practitioner, a practitioner shall not state or imply that the practitioner is disinterested. When the practitioner knows or reasonably should know that the unrepresented person misunderstands the practitioner's role in the matter, the practitioner shall make reasonable efforts to correct the misunderstanding. The practitioner shall not give legal advice to an unrepresented person, other than the advice to secure counsel, if the practitioner knows or reasonably should know that the interests of such a person are or have a reasonable possibility of being in conflict with the interests of the client.

§ 11.404 Respect for rights of third persons.

(a) In representing a client, a practitioner shall not use means that have no substantial purpose other than to embarrass, delay, or burden a third person, or use methods of obtaining evidence that violate the legal rights of such a person.

(b) A practitioner who receives a document or electronically stored information relating to the representation of the practitioner's client and knows or reasonably should know that the document or electronically stored information was inadvertently sent shall promptly notify the sender.

§§ 11.405–11.500 [Reserved]

LAW FIRMS AND ASSOCIATIONS

§ 11.501 Responsibilities of partners, managers, and supervisory practitioners.

(a) A practitioner who is a partner in a law firm, and a practitioner who individually or together with other practitioners possesses comparable managerial authority in a law firm, shall make reasonable efforts to ensure that the firm has in effect measures giving reasonable assurance that all practitioners in the firm conform to the USPTO Rules of Professional Conduct.

(b) A practitioner having direct supervisory authority over another practitioner shall make reasonable efforts to ensure that the other practitioner conforms to the USPTO Rules of Professional Conduct.

(c) A practitioner shall be responsible for another practitioner's violation of the USPTO Rules of Professional Conduct if:

(1) The practitioner orders or, with knowledge of the specific conduct, ratifies the conduct involved; or

(2) The practitioner is a partner or has comparable managerial authority in the law firm in which the other practitioner practices, or has direct supervisory authority over the other practitioner, and knows of the conduct at a time when its consequences can be avoided or mitigated but fails to take reasonable remedial action.

§ 11.502 Responsibilities of a subordinate practitioner.

(a) A practitioner is bound by the USPTO Rules of Professional Conduct notwithstanding that the practitioner acted at the direction of another person.

(b) A subordinate practitioner does not violate the USPTO Rules of Professional Conduct if that practitioner acts in accordance with a supervisory practitioner's reasonable resolution of an arguable question of professional duty.

§ 11.503 Responsibilities regarding non-practitioner assistance.

With respect to a non-practitioner assistant employed or retained by or associated with a practitioner:

(a) A practitioner who is a partner, and a practitioner who individually or together with other practitioners possesses comparable managerial authority in a law firm shall make reasonable efforts to ensure that the firm has in effect measures giving reasonable assurance that the person's conduct is compatible with the professional obligations of the practitioner;

(b) A practitioner having direct supervisory authority over the non-practitioner assistant shall make reasonable efforts to ensure that the person's conduct is compatible with the professional obligations of the practitioner; and

(c) A practitioner shall be responsible for conduct of such a person that would be a violation of the USPTO Rules of Professional Conduct if engaged in by a practitioner if:

(1) The practitioner orders or, with the knowledge of the specific conduct, ratifies the conduct involved; or

(2) The practitioner is a partner or has comparable managerial authority in the law firm in which the person is employed, or has direct supervisory authority over the person, and knows of the conduct at a time when its consequences can be avoided or mitigated but fails to take reasonable remedial action.

§ 11.504 Professional independence of a practitioner.

(a) A practitioner or law firm shall not share legal fees with a non-practitioner, except that:

(1) An agreement by a practitioner with the practitioner's firm, partner, or associate may provide for the payment of money, over a reasonable period of time after the practitioner's death, to the practitioner's estate or to one or more specified persons;

(2) A practitioner who purchases the practice of a deceased, disabled, or disappeared practitioner may, pursuant to the provisions of § 11.117, pay to the estate or other representative of that practitioner the agreed-upon purchase price;

(3) A practitioner or law firm may include non-practitioner employees in a compensation or retirement plan, even though the plan is based in whole or in

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part on a profit-sharing arrangement; and

(4) A practitioner may share legal fees, whether awarded by a tribunal or received in settlement of a matter, with a nonprofit organization that employed, retained or recommended employment of the practitioner in the matter and that qualifies under Section 501(c)(3) of the Internal Revenue Code.

(b) A practitioner shall not form a partnership with a non-practitioner if any of the activities of the partnership consist of the practice of law.

(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.

(d) A practitioner shall not practice with or in the form of a professional corporation or association authorized to practice law for a profit, if:

(1) A non-practitioner owns any interest therein, except that a fiduciary representative of the estate of a practitioner may hold the stock or interest of the practitioner for a reasonable time during administration;

(2) A non-practitioner is a corporate director or officer thereof or occupies the position of similar responsibility in any form of association other than a corporation; or

(3) A non-practitioner has the right to direct or control the professional judgment of a practitioner.

§ 11.505 Unauthorized practice of law.

A practitioner shall not practice law in a jurisdiction in violation of the regulation of the legal profession in that jurisdiction, or assist another in doing so.

§ 11.506 Restrictions on right to practice.

A practitioner shall not participate in offering or making:

(a) A partnership, shareholders, operating, employment, or other similar type of agreement that restricts the right of a practitioner to practice after termination of the relationship, except an agreement concerning benefits upon retirement; or

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(b) An agreement in which a restriction on the practitioner's right to practice is part of the settlement of a client controversy.

§ 11.507 Responsibilities regarding law-related services.

A practitioner shall be subject to the USPTO Rules of Professional Conduct with respect to the provision of law-related services if the law-related services are provided:

(a) By the practitioner in circumstances that are not distinct from the practitioner's provision of legal services to clients; or

(b) In other circumstances by an entity controlled by the practitioner individually or with others if the practitioner fails to take reasonable measures to assure that a person obtaining the law-related services knows that the services are not legal services and that the protections of the client-practitioner relationship do not exist.

§§ 11.508–11.700 [Reserved]

INFORMATION ABOUT LEGAL SERVICES

§ 11.701 Communications concerning a practitioner's services.

A practitioner shall not make a false or misleading communication about the practitioner or the practitioner's services. A communication is false or misleading if it contains a material misrepresentation of fact or law, or omits a fact necessary to make the statement considered as a whole not materially misleading.

§ 11.702 Communications concerning a practitioner's services: specific rules.

(a) A practitioner may communicate information regarding the practitioner's services through any medium.

(b) A practitioner shall not compensate, give, or promise anything of value to a person for recommending the practitioner's services, except that a practitioner may:

(1) Pay the reasonable costs of advertisements or communications permitted by this section;

(2) Pay the usual charges of a legal service plan or a not-for-profit or qualified practitioner referral service;

(3) Pay for a law practice in accordance with § 11.117;

(4) Refer clients to another practitioner or a non-practitioner professional pursuant to an agreement not otherwise prohibited under the USPTO Rules of Professional Conduct that provides for the other person to refer clients or customers to the practitioner, if:

(i) The reciprocal referral agreement is not exclusive, and

(ii) The client is informed of the existence and nature of the agreement; and

(5) Give nominal gifts as an expression of appreciation that are neither intended nor reasonably expected to be a form of compensation for recommending a practitioner's services.

(c) A practitioner shall not state or imply that he or she is certified as a specialist in a particular field of law, unless:

(1) The practitioner has been certified as a specialist by an organization that has been approved by an appropriate authority of a State or that has been accredited by the American Bar Association, and

(2) The name of the certifying organization is clearly identified in the communication.

(d) Any communication made under this section must include the name and contact information of at least one practitioner or law firm responsible for its content.

[86 FR 28466, May 26, 2021]

§ 11.703 Solicitation of clients.

(a) "Solicitation" or "solicit" denotes a communication initiated by or on behalf of a practitioner or law firm that is directed to a specific person the practitioner knows or reasonably should know needs legal services in a particular matter and that offers to provide, or reasonably can be understood as offering to provide, legal services for that matter.

(b) A practitioner shall not solicit professional employment by live person-to-person contact when a significant motive for the practitioner's doing so is the practitioner's or law firm's pecuniary gain, unless the contact is with a:

(1) Practitioner;

(2) Person who has a family, close personal, or prior business or professional relationship with the practitioner or law firm; or

(3) Person who routinely uses for business purposes the type of legal services offered by the practitioner.

(c) A practitioner shall not solicit professional employment even when not otherwise prohibited by paragraph (b) of this section, if:

(1) The target of solicitation has made known to the practitioner a desire not to be solicited by the practitioner, or

(2) The solicitation involves coercion, duress, or harassment.

(d) This section does not prohibit communications authorized by law or ordered by a court or other tribunal.

(e) Notwithstanding the prohibitions in this section, a practitioner may participate with a prepaid or group legal service plan operated by an organization not owned or directed by the practitioner that uses live person-to-person contact to enroll members or sell subscriptions for the plan from persons who are not known to need legal services in a particular matter covered by the plan.

[86 FR 28467, May 26, 2021]

§ 11.704 Communication of fields of practice and specialization.

(a) A practitioner may communicate the fact that the practitioner does or does not practice in particular fields of law.

(b) A registered practitioner who is an attorney may use the designation "Patents," "Patent Attorney," "Patent Lawyer," "Registered Patent Attorney," or a substantially similar designation. A registered practitioner who is not an attorney may use the designation "Patents," "Patent Agent," "Registered Patent Agent," or a substantially similar designation. Unless authorized by § 11.14(b), a registered patent agent shall not hold himself or herself out as being qualified or authorized to practice before the Office in trademark matters or before a court.

(c) [Reserved]

(d) A practitioner shall not state or imply that a practitioner is certified as a specialist in a particular field of law, unless:

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(1) The practitioner has been certified as a specialist by an organization that has been approved by an appropriate state authority or that has been accredited by the American Bar Association; and

(2) The name of the certifying organization is clearly identified in the communication.

(e) Individuals granted limited recognition may use the designation “Limited Recognition” but may not hold themselves out as being registered.

[78 FR 20201, Apr. 3, 2013, as amended at 86 FR 28467, May 26, 2021]

§ 11.705 Firm names and letterheads.

(a) A practitioner shall not use a firm name, letterhead or other professional designation that violates § 11.701. A trade name may be used by a practitioner in private practice if it does not imply a connection with a government agency or with a public or charitable legal services organization and is not otherwise in violation of § 11.701.

(b) [Reserved]

(c) The name of a practitioner holding a public office shall not be used in the name of a law firm, or in communications on its behalf, during any substantial period in which the practitioner is not actively and regularly practicing with the firm.

§§ 11.706–11.800 [Reserved]

MAINTAINING THE INTEGRITY OF THE PROFESSION

§ 11.801 Registration, recognition and disciplinary matters.

An applicant for registration or recognition to practice before the Office, or a practitioner in connection with an application for registration or recognition, or a practitioner in connection with a disciplinary or reinstatement matter, shall not:

(a) Knowingly make a false statement of material fact; or

(b) Fail to disclose a fact necessary to correct a misapprehension known by the person to have arisen in the matter, fail to cooperate with the Office of Enrollment and Discipline in an investigation of any matter before it, or knowingly fail to respond to a lawful

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demand or request for information from an admissions or disciplinary authority, except that the provisions of this section do not require disclosure of information otherwise protected by § 11.106.

§ 11.802 Judicial and legal officials.

(a) A practitioner shall not make a statement that the practitioner knows to be false or with reckless disregard as to its truth or falsity concerning the qualifications or integrity of a judge, adjudicatory officer or public legal officer, or of a candidate for election or appointment to judicial or legal office.

(b) A practitioner who is a candidate for judicial office shall comply with the applicable provisions of the Code of Judicial Conduct.

§ 11.803 Reporting professional misconduct.

(a) A practitioner who knows that another practitioner has committed a violation of the USPTO Rules of Professional Conduct that raises a substantial question as to that practitioner’s honesty, trustworthiness or fitness as a practitioner in other respects, shall inform the OED Director and any other appropriate professional authority.

(b) A practitioner who knows that a judge, hearing officer, administrative law judge, administrative patent judge, or administrative trademark judge has committed a violation of applicable rules of judicial conduct that raises a substantial question as to the individual’s fitness for office shall inform the appropriate authority.

(c) The provisions of this section do not require disclosure of information otherwise protected by § 11.106 or information gained while participating in an approved lawyers assistance program.

§ 11.804 Misconduct.

It is professional misconduct for a practitioner to:

(a) Violate or attempt to violate the USPTO Rules of Professional Conduct, knowingly assist or induce another to do so, or do so through the acts of another;

(b) Commit a criminal act that reflects adversely on the practitioner’s

honesty, trustworthiness, or fitness as a practitioner in other respects, or be convicted of a crime that reflects adversely on the practitioner's honesty, trustworthiness, or fitness as a practitioner in other respects;

(c) Engage in conduct involving dishonesty, fraud, deceit or misrepresentation;

(d) Engage in conduct that is prejudicial to the administration of justice;

(e) State or imply an ability to influence improperly a government agency or official or to achieve results by means that violate the USPTO Rules of Professional Conduct or other law;

(f) Knowingly assist a judge, hearing officer, administrative law judge, administrative patent judge, administrative trademark judge, or judicial officer in conduct that is a violation of applicable rules of judicial conduct or other law;

(g) Knowingly assist an officer or employee of the Office in conduct that is a violation of applicable rules of conduct or other law;

(h) Be publicly disciplined on ethical or professional misconduct grounds by any duly constituted authority of:

(1) A State,

(2) The United States, or

(3) A country having disciplinary jurisdiction over the practitioner; or

(i) Engage in other conduct that adversely reflects on the practitioner's fitness to practice before the Office.

[78 FR 20201, Apr. 3, 2013, as amended at 86 FR 28467, May 26, 2021]

§§ 11.805–11.900 [Reserved]

§ 11.901 Savings clause.

(a) A disciplinary proceeding based on conduct engaged in prior to the effective date of these regulations may be instituted subsequent to such effective date, if such conduct would continue to justify disciplinary sanctions under the provisions of this part.

(b) No practitioner shall be subject to a disciplinary proceeding under this part based on conduct engaged in before the effective date hereof if such conduct would not have been subject to disciplinary action before such effective date.

PARTS 15–15a [RESERVED]

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