

Ethical Behavior under the
USPTO Rules of Professional
Conduct, Effective
May 3, 2013

The Rules appear in
37 C.F.R. §§ 11.101-901

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The new USPTO Rules of Professional Conduct became effective May 3, 2013. The Rules are based on the American Bar Association Model Rules of Professional Conduct. Compliance with the Rules is determined and controlled by the Office of Enrollment and Discipline of the USPTO.



Maintenance of Confidentiality

A practitioner is prohibited from revealing client's confidential information except that the practitioner shall comply with the duty of disclosure under 37 C.F.R. § 1.56 before the USPTO of disclosing and not withholding information material to the examination of an application. Also, information may be revealed upon client consent, to prevent client's inequitable conduct, to secure legal advice, et al.



Conflicts

A practitioner is prohibited from having a conflict of interest with a present client or a former client.

37 C.F.R. § 11.108 (b) prohibits using information relating to representation of a client to the disadvantage of that client.

37 C.F.R. § 11.109 (a) prohibits representing another client in a matter adverse to a former client.

(b) prohibits representing a person who is adverse to a client of a former firm of the practitioner where the practitioner acquired confidential information while practicing at the former firm.

(c) prohibits using information relating to the representation of a former client to that former client's disadvantage. 37 C.F.R. § 11.110 prohibits representing a client if a practitioner in the same firm would be prohibited from representing that client under § 11.107 or § 11.109.

In appropriate circumstances, the above noted representations may be performed if appropriate screening of the practitioner from information or dealing with the other party can be arranged.



Candor toward a Tribunal

37 C.F.R. § 303 (a) imposes an obligation of candor toward any tribunal, including the USPTO or a Court or other agency. This prohibits supplying false statements or false evidence;

(b) This also requires disclosure of either criminal or fraudulent conduct even if it requires revealing client confidential information;

(d) It requires disclosure of all material facts, adverse or not, to a tribunal especially in an ex parte proceeding; or

(e) It requires disclosing information necessary to comply with the duty of disclosure to the USPTO.

Duty applies to examination of an application and to a post grant proceeding.



Misconduct

37 C.F.R. § 11.804 prohibits acts including

- (b) criminal acts that reflect adversely on honesty, trustworthiness or fitness to practice;
- (c) conduct involving dishonesty, fraud, deceit or misrepresentation;
- (d) conduct prejudicial to the administration of justice;
or
- (i) conduct that reflects adversely on the practitioner's fitness to practice.



Grievances, which may lead to disciplinary action

Actions by a practitioner, which can lead to grievances or disciplinary action, include the following failures:

- a) Failure or delay to file a patent application;
- b) Failure to reply to an Office Action;
- c) Failure to revive or assist in reviving an abandoned application;
- d) Failure to communicate with the client by failing to report Office Actions or failure to reply to a client inquiry;
- e) Failure to notify a client of relevant correspondence;
- f) Failure to handle a matter for which the attorney has been retained;
- g) Failure to handle a matter with adequate legal preparation;
- h) Concealing information, including concealing a date of an Office Action, an abandonment, or the reason for abandonment, or misrepresenting the status of an abandoned application as still pending;



Grievances, which may lead to disciplinary action

(continued)

- i) Making false statements to the USPTO in connection with Petitions or Requests;
- j) Filing Oaths or Declarations signed by the Applicant prior to preparation of the application or prior to the Applicant's review of the application that had been prepared;
- k) Allowing a person not registered to practice before the USPTO to practice before the USPTO;
- l) Failure to return fees advanced by a client which were not used;
- m) Improper commingling of client's advanced legal fees;
- n) Having checks, or electronic or credit card payments repeatedly dishonored for insufficient funds.

