

DEPARTMENT OF COMMERCE**Patent and Trademark Office****37 CFR Parts 1, 2, 10 and 11**

[Docket No.: 2002-C-005]

RIN 0651-AB55

Changes to Representation of Others Before the United States Patent and Trademark Office**AGENCY:** United States Patent and Trademark Office, Commerce.**ACTION:** Notice of proposed rulemaking.

SUMMARY: The United States Patent and Trademark Office (Office or USPTO) proposes to update the procedures regarding enrollment and discipline. The Office also proposes to replace the current USPTO Code of Professional Responsibility, which is based on the Model Code of Professional Responsibility of the American Bar Association, with new USPTO Rules of Professional Conduct, largely based on the Model Rules of Professional Conduct of the American Bar Association.

DATES: To be ensured of consideration, written comments must be received on or before February 10, 2004.

ADDRESSES: Comments should be sent by electronic mail over the Internet addressed to: ethicsrules.comments@uspto.gov. Comments may also be submitted by mail addressed to: Mail Stop OED-Ethics Rules, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450 or by facsimile to (703) 306-4134, marked to the attention of Harry I. Moatz. Although comments may be submitted by mail or facsimile, the Office prefers to receive comments via the Internet. If comments are submitted by mail, the Office would prefer that the comments be submitted on a DOS formatted 3½-inch disk accompanied by a paper copy. The comments will be available for public inspection at the Office of Enrollment and Discipline, located in Room 1103, Crystal Plaza 6, 2221 South Clark Street, Arlington, Virginia, and will be available through anonymous file transfer protocol (ftp) via the Internet (address: <http://www.uspto.gov>). Since comments will be made available for public inspection, information that is not desired to be made public, such as an address or telephone number, should not be included in the comments.

FOR FURTHER INFORMATION CONTACT: Harry I. Moatz ((703) 305-9145),

Director of Enrollment and Discipline (OED Director), directly by phone, or by facsimile to (703) 305-4136, marked to the attention of Mr. Moatz, or by mail addressed to: Mail Stop OED-Ethics Rules, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450.

SUPPLEMENTARY INFORMATION: At this time, nearly 28,000 individuals are registered as patent attorneys and agents, of whom about 80% have indicated that they are attorneys. The registered patent attorneys have offices located in all fifty States and the District of Columbia. More than 2,500 individuals applied for admission to the registration examination given on October 18, 2000. At the same time, the Martindale-Hubbell reports that there are more than 900,000 lawyers and law firms listed in its legal directory. More than 17,000 attorneys are members of the Intellectual Property Law Committee of the American Bar Association. Any attorney who is a member in good standing of the bar of the highest court of a State or the District of Columbia is eligible to practice before the Office in trademark and other non-patent matters. 5 U.S.C. 500(a). Forty-two of the bars have adopted the Model Rules of Professional Conduct of the American Bar Association or a modification thereof, and two have disciplinary rules which are a combination of the Model Code and the Model Rules of Professional Conduct of the American Bar Association. Adopting ethics rules that are largely based on the Model Rules of Professional Conduct of the American Bar Association would provide attorneys, as well as registered patent agents, with consistent ethical standards, and large bodies of both case law and ethics opinions.

This notice of proposed rule making sets out rules in three areas:

(1) Rules of general applicability, and rules governing the recognition of individuals to practice as attorneys and agents before the Office in patent, trademark, and other non-patent matters (§§ 11.1-11.18);

(2) Rules governing investigation and disciplinary proceedings for possible violations of the Office Rules of Professional Conduct (§§ 11.19-11.62). Disciplinary proceedings can result in reprimand, suspension or exclusion (disbarment) of individuals from practicing before the Office who, after notice and opportunity for a hearing, are found to have violated an imperative USPTO Rule of Professional Conduct; and

(3) Rules setting out the proposed Office Rules of Professional Conduct (§§ 11.100-11.806).

These changes are intended to improve the Office's processes for handling applications for registration, petitions, investigations, and disciplinary proceedings. The changes also are intended to bring standards of ethical practice before the Office into closer conformity with the Rules of Professional Conduct adopted by the majority of States, while addressing circumstances particular to practice before the Office. As these environments change (e.g., by adoption of amendments to the Model Rules of Professional Conduct of the American Bar Association) the Office will consider whether to make further changes to the rules.

This proposed rule making is being conducted under the auspices of the General Counsel of the United States Patent and Trademark Office, James Toupin (703) 308-2000, and the supervision of the OED Director, Harry I. Moatz (703) 305-9145. They would appreciate feedback on the overall rule making process in addition to any comments on the merits of the proposed rules.

Table 1 shows the principal sources of the proposed rules relating to (1) admission to practice of attorneys and agents in patent matters, and (2) practice in trademark and non-patent matters.

Table 2 shows the principal sources of the rules proposed for disciplinary proceedings.

Table 3 shows the principal sources of the rules proposed for the Office Rules of Professional Conduct.

Discussion of Specific Rules:

Section 1.1 would be amended to add paragraph (4) to provide an address for correspondence for the Office of Enrollment and Discipline in enrollment, registration and investigation matters.

Section 1.4 would be amended to revise the references from §§ 10.18(b)(2), 10.18(c), and 10.23(c)(15) to §§ 11.18(b)(2), 11.18(c), and 11.804(c)(i)(15), respectively.

Section 1.21 would be amended to revise one paragraph into two distinct fees, add ten paragraphs to provide for ten new fees, as well as to reserve paragraph (3), redesignate another paragraph and change a section citation therein. These fees are intended to fund the costs of the registration examination process, disciplinary system, and maintain the roster of registered practitioners up-to-date. Bar disciplinary activities are generally regarded as being in the interest of maintaining the Bar's reputation for integrity and supporting the willingness of potential clients to engage the services of practitioners. The continual