

testimony and statements made in the course of solicitor disciplinary proceedings. See *Addis v. Crocker*, 1 Q.B. 11, 2 All E.R. 629 CA. See *Halsbury's Laws of England*, Libel and Slander 28:98–101. Several states provide absolute privilege for complaints and testimony in ethics proceedings through statutes, court rules, or rules of attorney discipline. See Alaska Attorney Rules, Disciplinary Enforcement Rule 9 (Supp.1983); Ariz. Rules Regulating Conduct of Attorneys, Rule XII (Michie Supp. 1983); Cal. Art. 5.5 § 6094 (1984); Colo.R.C.P. Rule 259(C) (Michie Supp. 1983); *Stone v. Rosen*, 348 So. 2d 397 (Fla.Dist.Ct.App. 3 1977); Ga. Code App. to Title 9, Part IV, State Bar Rule 4–221(g); Hawaii S. Ct. Rule 16.7 (1992); La. Rev. Stat. Ann. § 37 ch. 4 App., Art. of Incorp. Of La. State Bar Ass'n., Art. 15 § 13 (West Supp. 1983); Minn. Rules of Law: Prof. Resp., Rule 21 (1977); Miss. Code Ann. § 73–3–345 (1992); N.J.S.Ct.Rule 1:20–11(b)(1984); *Sullivan v. Crisona*, 283 N.Y.S.2d 62 (Sup. Ct. 1967) (interpreting N.Y. Judiciary Law § 90); N.D. Cent. Code § 27–14–03 (1974); Okla. Ct. Rules Governing Disciplinary Proc., Chap. 1, App. 1–A, Rule 5, Sec.5.4 (1981); S.C. Rules on Disciplinary Procedure for Att'ys §§ 11, 26 (Lawyers Coop. Supp. 1983) (complaints may be subject to contempt sanctions and injunction against malicious filing, but privilege prevents lawsuits predicated on filing or testimony); S.D. Codified Laws Ann. § 16–19–30 (1994); W. Va. State Bar Bylaws Art. VI § 43 (1982); Wyo. Ct. Rules, Disciplinary Code for the Wyo. State Bar, Rule VI (1973).

Other jurisdictions provide qualified immunity or privilege. See Ind. S.Ct. Rules Part VI, Admission & Discipline Rule 23 § 20 (1983) (immunity in absence of malice); Kan.S.Ct.Rule 223 (same privilege as attaches in other judicial proceedings); Me. Bar Rule 7(f)(1) (1983) (immunity in absence of malice); Neb.S.Ct. Rule 106 (1983) (absolute privilege for good faith complainant); *In re Proposed Rules Relating to Grievance Pro.*, 341 A.2d 272 (N.H. 1975) (approving proposed rules effective July 25, 1975, Rule 10 providing immunity for statements made in good faith).

Communications made to licensing agencies in connection with an application for issuance, renewal, or revocation of a license have frequently been held to be entitled to absolute privilege. *Alagna v. New York & Cuba Mail S.S. Co.*, 155 Misc. 796 279 NYS 319 (1935) (complaint to Federal Communications Commission complaining of conduct of licensed radio operators held absolutely

privileged). Communications to Federal agencies responsible for protecting the public are privileged. See *Holmes v. Eddy*, 341 F.2d 477 (CA 4 1965) (holding communication to the Securities and Exchange Commission did not amount to defamation since Commission had statutory duty to protect public from frauds through stock issues, and communication was treated as confidential and not disclosed until beginning of court action); *Riccobene v. Scales*, 19 F.Supp 2d 577 (N.D. W. Va. 1998) (statements by attorney, representing Army officer's wife, to officer's superior made in course of representing the wife, are absolutely privileged as they were intended to obtain Army's help in ending domestic abuse, and Army had clear interest in receiving reports of domestic violence committed by soldiers).

A person filing a complaint with the Office is proscribed from providing materially false written statements. Under 18 U.S.C 1001(a) criminal penalties are provided for whoever, in any matter within the jurisdiction of the Office “knowingly and willfully * * * (2) makes any materially false, fictitious, or fraudulent statement or representation; or (3) makes or uses any false writing or document knowing the same to contain any materially false, fictitious, or fraudulent statement or entry.”

The Office is responsible for protecting the public from persons, agents and attorneys demonstrated to be “incompetent or disreputable, or guilty of gross misconduct, or who does not comply with the regulations established under section 2(b)(2)(D) of” the Patent Statute. 35 U.S.C. 2(b)(2)(D). The proposed rule provides potential complainants with appropriate notice of the qualified immunity while enabling the Office to fulfill its responsibility.

Recognition To Practice Before the USPTO

Section 11.4, like current § 10.3, would provide for a Committee on Enrollment, which will advise the OED Director in connection with the Director's duties under § 11.2(b)(2).

Section 11.5 would provide for keeping a register of attorneys and agents recognized to practice before the Office in patent matters, and a definition of practice before the Office.

Paragraph (a) of § 11.5, like current § 10.5, would continue to provide for maintaining a single register of attorneys and agents registered to practice before the Office. The proposed rule would conform to actual practice.

Paragraph (b) of § 11.5 would add a new concept for disciplinary and non-

disciplinary matters. The paragraph introduces definitions for practice before the Office broadly, as well as practice before the Office in patent matters, and practice before the Office in trademark matters. The proposed broad definition of practice before the Office is similar to the definition of “practice” adopted by the Internal Revenue Service. 31 CFR 10.2(e). Practice before the Office would not include the physical or electronic delivery of documents to the Office.

The definition of practice before the Office in patent matters is derived from *Sperry v. Florida*, 373 U.S. 379, 137 USPQ 578 (1963). In *Sperry*, the Supreme Court found that “preparation and prosecution of patent applications for others constitutes the practice of law.” The Court recognized that “[s]uch conduct inevitably requires the practitioner to consider and advise his clients as to the patentability of their inventions under the statutory criteria, 35 U.S.C. 101–103, 161, 171, as well as to consider the advisability of relying upon alternative forms of protection which may be available under state law. It also involves his participation in the drafting of the specification and claims of the patent application, 35 U.S.C. 112, which this Court long ago noted ‘constitute[s] one of the most difficult legal instruments to draw with accuracy.’ *Topliff v. Topliff*, 145 U.S. 156, 171. And upon rejection of the application, the practitioner may also assist in the preparation of amendments, 37 CFR 1.117–1.126,¹ which frequently requires written argument to establish the patentability of the claimed invention under the applicable rules of law and in light of the prior art. 37 CFR 1.119.” *Sperry*, 373 U.S. at 383, 137 USPQ at 579.

Consistent with the foregoing, courts in several jurisdictions have held the preparation of patent applications by unregistered individuals to be the unauthorized practice of law. See *In re Amalgamated Development Co., Inc.*, 375 A.2d 494, 195 USPQ 192 (D.D.C. 1977), cert. denied, 434 U.S. 924 (1977); *People v. O'Brien*, 142 USPQ 239 (N.Y. 1964); *Cowgill v. Albright*, 307 N.E. 2d 191, 191 USPQ 103 (Ct. App. Ohio 1973); and *Virginia v. Blasius*, 2 USPQ2d 1320 (Va. Cir. Ct. 1987).

In Ohio, the preparation, filing and prosecution of patent applications before the Office has been recognized as the practice of law. Formal Opinion 91–25 (1991) of the Board of Commissioners on Grievances and Discipline of the Ohio Supreme Court.

¹ 37 CFR 1.117–1.119, and 1.122–1.124 no longer exist.