

The definition of practice before the Office in trademark matters is derived in part from disciplinary cases concerning attorneys engaged to prepare and prosecute trademark matters. See *Attorney Grievance Commission of Maryland v. Harper*, 477 A.2d 756 (Md. 1984) (holding attorney neglected legal matter by failing to prosecute filed trademark application); *State of Nebraska v. Gregory*, 554 N.W.2d 422 (Neb. 1996) (holding attorney did not competently act or zealously represent a client by failing to file a trademark application); *Office of Disciplinary Counsel v. Frease*, 660 N.E.2d 1156 (Ohio 1996) (holding attorney neglected legal matter entrusted to him when he did not file applications for trademark registration). The definition is also derived from case law involving unauthorized practice of law wherein a layperson offered trademark registration services. See *Statewide Grievance Committee v. Goldstein*, 1996 Conn. Super. LEXIS 3430 (Conn. Super. 1996) (enjoining layperson from advertising, offering to complete, and completing blank legal documents for "areas commonly understood to be the practice of law including * * * trademark and/or patent," soliciting information from customers and using the information "to select, prepare or complete legal documents," and "providing written and/or oral instructions to customers advising them what to do with their legal documents.").

The definition of practice before the Office also includes private conduct relating to good character and integrity essential for a practitioner in patent, trademark, or other non-patent law matters. The definition is derived from case law disciplining attorneys for misconduct not related to the practice of law. Any misbehavior, private or professional, that reveals a lack of good character and integrity essential for a person to practice as an attorney constitutes a basis for discipline. *Matter of Hasbrouck*, 657 A.2d 878 (N.J. 1995); *In re LaDuca*, 140, 299 A.2d 405 (N.J. 1973). That a person's activity does not arise from a lawyer-client relationship, that the behavior is not related to the practice of law or that the offense is not committed in the attorney's professional capacity is immaterial. *In re Suchanoff*, 460 A.2d 642 (N.J. 1983); *In re Franklin*, 365 A.2d 1361 (N.J. 1976).

Section 11.6, like current § 10.6, would provide for registration of individuals to practice before the Office in patent matters.

Paragraphs (a) and (b) of § 11.6 would provide for registration of attorneys and agents, respectively. Citizens of the United States could be registered

regardless of their residence. The OED Director could register resident aliens, under appropriate circumstances. Registration of permanent resident aliens would be consistent with *In re Griffiths*, 413 U.S. 717 (1973) (permanent resident alien entitled to be admitted to Connecticut Bar notwithstanding status as alien). See also *Raffaelli v. Committee of Bar Examiners*, 496 P.2d 1264 (Cal. 1972) and *Application of Park*, 484 P.2d 1264 (Alas. 1971). The Office currently registers permanent resident aliens. See *In re Bhogaraju*, 178 USPQ 628 (Comm'r Pat. 1973); *In re Bramham*, 181 USPQ 723 (Comm'r Pat. 1974); and *In re Keen*, 187 USPQ 477 (Comm'r Pat. 1975).

The proposed rules would restrict circumstances under which an alien could be registered. Registration would be precluded if the practice of patent law before the Office is inconsistent with the terms of any visa under which the alien is admitted to and continues to reside in the United States. Registration would be precluded, for example, when the visa petition does not describe that the alien as being authorized to be employed in the capacity of representing patent applicants before the Office. See *In re Richardson*, 203 USPQ 959 (Comm'r Pat. 1979) (alien admitted to U.S. with H-3 visa for training could not practice patent law under terms of the visa), and *In re Mikhail*, 202 USPQ 71 (Comm'r Pat. 1976) (alien admitted to U.S. on B-1/B-2 visa and visiting the U.S. temporarily for business or pleasure could not practice under the terms of the visa). It is nevertheless appropriate for some aliens to be granted limited recognition under § 11.9. See *In re Messulam*, 185 USPQ 438 (Comm'r Pat. 1975) (granting limited recognition to alien admitted to U.S. on L-1 visa for purpose of rendering service to a single company for whom the alien had previously worked abroad and who would remain in the U.S. temporarily). See also *In re Gresset*, 189 USPQ 350 (Comm'r Pat. 1976).

Paragraph (c) of § 11.6, like current § 10.6(c), would continue to provide for registration of foreign patent agents on the basis of substantial reciprocity. Paragraph (c) would add procedures for removing a patent agent's name from the register if the patent agent is no longer registered in good standing before the patent office of the country in which he or she resides, or no longer resides in the foreign country. The procedures would avoid any necessity of going through an administrative proceeding.

Section 11.7, like current § 10.7, would set forth the requirements for registration.

Paragraphs (a)(1) and (a)(2) of § 11.7, like current § 10.7(a), would continue to require an individual to apply for registration, and establish possession of good moral character, as well as legal, scientific and technical qualifications, and competence to advise and assist patent applicants.

Paragraph (a)(3) of § 11.7 would explicitly place the burden of proof of good moral character and reputation on the applicant, and provide "clear and convincing" as the standard of proof.

Paragraph (b)(1) of § 11.7, like current § 10.7(b), would continue to require an individual to take and pass a registration examination in order to practice in patent matters before the Office.

Paragraph (b)(2) of § 11.7 would identify components of a complete registration application, give an individual submitting an incomplete application 60 days from the notice to file a complete application, and require individuals to update their applications wherever there is an addition to or change to information previously furnished with the application.

Paragraph (c) of § 11.7 would allow for a petition to the OED Director from any action refusing to register an individual, refusing to admit an individual to the registration examination, refusing to reinstate an individual, or refusing to refund or defer any fee. The petition would be accompanied by the fee set forth in § 1.21(a)(5).

Paragraph (d) of § 11.7, like current § 10.7(b), would continue to provide for waiver of the examination for former patent examiners. Unlike § 10.7(b), waiver no longer would be available (except for a grandfathering provision) merely upon successfully serving in the patent examining corps for four years. Paragraph (d) would introduce new conditions for waiver of the registration examination for former patent examiners and expand the occasions for waiving the examination for other Office employees.

Currently, the requirement to take the examination may be waived in the case of any individual who has actively served for at least four years in the patent examining corps of the Office. The Office provides newly hired examiners with initial training. Thereafter, training provided by the Office is received on the job, or in more advanced formal training courses. Primary patent examiners are examiners who the Office has certified as having legal competence to act with a minimum of oversight. The Office also gives primary examiners a certificate granting authority to negotiate with