

Manual on the Administrative Procedure Act, pp.65–66 (1947). *See also Harary v. Blumenthal*, 555 F.2d 1113 (2nd Cir. 1977) (certified public accountant disbarred from practice before IRS), and *Koden v. U.S. Department of Justice*, 564 F.2d 228 (7th Cir 1977) (suspending attorney from practice before INS).

Section 11.18, with one exception, would continue the provisions under current § 10.18 regarding who must sign documents filed in the Office, and responsibility for the content of documents filed in the Office. The exception is that the phrase “claims and other” found in § 10.18(b)(2)(ii) would not be carried forward into paragraph (b)(2)(ii) of § 11.18. The deletion is necessary inasmuch as § 11.18 is derived from Rule 11 of the Federal Rules of Civil Procedure, wherein a “claim” is not a patent claim. However, in the predecessor rule, § 10.18, it is possible to construe “claim” to be a patent claim. Clearly, a patent claim is not the same claim under the Rule 11 of the Federal Rules of Civil Procedure. The practice under § 11.18 is otherwise similar to that under Rule 11 of the Federal Rules of Civil Procedure.

Investigations and Disciplinary Proceedings

Section 11.19 would introduce a definition of the disciplinary jurisdiction of the Office.

Paragraph (a) of § 11.19 would provide that practitioners registered or recognized to practice before the Office, practitioners administratively suspended under § 11.11(b), practitioners disciplined by suspension or exclusion, as well as *pro se* patent applicants and any individual appearing in trademark or other non-patent case in his or her own behalf, are subject to the disciplinary jurisdiction of the Office. The inclusion of administratively suspended practitioners, and practitioners disciplined by suspension or exclusion would permit the Office to take further action where appropriate or necessary. Thus, for example, a suspended practitioner continuing to practice before the Office despite suspension may be further disciplined for unauthorized practice before the Office. Similarly, a practitioner continuing to practice before the Office despite removal of his or her name from the register should not be able to use administrative suspension as a shield to avoid discipline for misconduct occurring before or after removal of the practitioner's name from the register.

Paragraph (b) of § 11.19 would recognize the authority of state bars to discipline practitioners for misconduct

involving or related to practice before the Office in any matter.

Paragraph (c)(1) of § 11.19 would set out grounds for disciplining a practitioner, or a suspended or excluded practitioner. Grounds would include conviction of a crime; discipline imposed in another jurisdiction; failure to comply with any order of a Court, the USPTO Director, or OED Director; or failure to respond to a written inquiry from a Court, the USPTO Director, or OED Director in the course of a disciplinary investigation or proceeding without asserting, in writing, the grounds for refusing to do so.

Paragraph (c)(2) of § 11.19 would set out grounds for disciplining a *pro se* applicant. Grounds include violation of §§ 11.303(a)(1), 11.304, 11.305(a), and 11.804. *Pro se* litigants in United States District Courts are subject to Rule 11 of the Federal Rules of Civil Procedure, which imposes sanctions for filing baseless or frivolous lawsuits wherein the pleadings are not well grounded in fact or in law, or in a good faith argument for extension, modification, or reversal of existing law, and had an improper purpose. By extension, comparable conduct before the Office would be subject to disciplinary action by the Office.

Paragraph (d) of § 11.19 would continue essentially the same procedure as current § 10.130(b) for handling petitions to disqualify a practitioner in *ex parte* or *inter partes* matters in the Office on a case-by-case basis. *See SEC v. Chenery Corp.*, 332 U.S. 194, 203 (1974).

Paragraph (e) of § 11.19 would make clear that the Office can refer unauthorized practice allegations and convictions to the jurisdiction(s) where the act(s) occur. This can apply to unregistered individuals, including unregistered attorneys practicing before the Office in patent matters by ghostwriting applications and/or replies to Office actions to be signed and filed by inventors.

Section 11.20 would continue the present procedure in current § 10.130(a) under which the USPTO Director imposes discipline. The statutory framework for practice before the Office in patent, trademark, and other non-patent law vests responsibility for discipline in the USPTO Director. 35 U.S.C. 2(b)(2)(c). The discipline imposed on practitioners includes reprimand, suspension or exclusion. Paragraph (a)(1) is based on 35 U.S.C. 32 and 5 U.S.C. 500(d). The term “exclude,” rather than “disbar,” is used throughout the proposed rules because “exclude” is used in 35 U.S.C. 32. Probation has been employed by OED

pursuant to 35 U.S.C. 32 and 5 U.S.C. 500(d). *See Weiffenbach v. Lett*, 1101 Official Gazette 59 (April 25, 1989).

Paragraph (a)(2) of § 11.20 would permit sanctions to be imposed on patent applicants representing themselves or other applicants under § 1.31, a person or party representing themselves or others in a patent case pursuant to § 1.33(b)(4), or by a representative appearing in a trademark application pursuant to § 11.14(e). A variety of sanctions can be imposed on *pro se* litigants subject to Rule 11 of the Federal Rules of Civil Procedure. The sanctions usually imposed serve two main purposes: deterrence and compensation. Subsidiary goals include punishing prosecution/litigation abuse, and facilitating case management. *See Navarro-Ayala v. Nunez*, 968 F.2d 1421 (C.A. Puerto Rico 1992). Sanctions that may be imposed on *pro se* litigants may also be imposed on *pro se* applicants, including prohibition from commencing additional or continuing other proceedings before the Office without being represented by a licensed attorney or by leave of the Commissioner for Patents or the Commissioner for Trademarks to proceed *pro se*. *Accord, Schramek v. Jones*, 161 F.R.D. 119 (D.C. Fla. 1995); and *Ketchum v. Cruz*, 775 F. Supp. 1399 (D. Colo. 1991), *aff'd*, 961 F.2d 916 (1991).

Paragraph (b) of § 11.20 would provide for imposition of conditions with discipline as a condition of probation, to protect the public.

Section 11.21 would provide for issuing warnings alerting the practitioner that he or she could be subject to disciplinary action if corrective action is not taken to bring his or her conduct into conformity with the Office's Rules of Professional Conduct. 5 U.S.C. 558(c) authorizes warnings.

Section 11.22 would continue the OED Director's authority under current § 10.131(a) to investigate possible violations of Rules of Professional Conduct by practitioners. *See* § 11.2(b)(2).

Paragraph (b) of § 11.22 would continue the provisions of current § 10.131(a), under which a nonpractitioner can report to the OED Director a possible violation of Rules of Professional Conduct. The OED Director would be enabled to require that the report be presented in the form of an affidavit.

Paragraph (c) of § 11.22 would provide for initiating investigations upon complaint or information received from any source. The investigation would not be abated because of neglect by the complainant to prosecute a