

mail is not always available, because receipts are returned signed by individuals other than the respondent. Moreover, the Office may have to resort to proving who signed a particular receipt. Accordingly, § 11.35 provides that service may be accomplished by handing the complaint to the respondent. When service is by hand delivery, the party serving the respondent would file an affidavit with the OED Director. An alternative method for serving the complaint is to mail the complaint first-class mail or "Express Mail" to the last known address of the respondent. Although the proposed rule being considered does not so specify, under this rule the OED Director would probably attempt to contact the respondent shortly after mailing to determine whether the complaint had been received. A third method of service would be any method mutually agreeable to the OED Director and a respondent.

Paragraph (b) of § 11.35 would provide that if a complaint is returned by the Postal Service, a second complaint would be mailed. If the second complaint is returned, the respondent would be served by appropriate notice published in the Official Gazette for two consecutive weeks. Any time for answering would run from the second publication of the notice.

Section 11.36 would continue, in paragraphs (a) through (e), to provide the same procedure as in current § 10.136 for answering a complaint. For instance, under paragraph (a), an answer would be due within thirty days unless extended for up to no more than thirty additional days by the hearing officer. Paragraph (f) would provide procedures for giving notice of intent to raise an alleged disability in mitigation of the sanction that may be imposed. The regulation also would provide for appointment of monitor(s), and for suspension of respondent if the monitor reports violation of any terms or conditions under which the respondent continued to practice.

Section 11.37, like current § 10.137, would provide that false statements in an answer could be made the basis of supplemental charges.

Section 11.38, like current § 10.138, would provide that on filing of an answer, a disciplinary proceeding would become a contested case within the meaning of 35 U.S.C. 24. Evidence obtained by a subpoena issued under 35 U.S.C. 24 would not be admissible in evidence or considered unless leave to proceed under 35 U.S.C. 24 is first obtained from the hearing officer. Ordinarily, a subpoena under 35 U.S.C.

24 is needed when a witness will not voluntarily appear. Often, subpoenas are issued to be sure that a witness appears—particularly if both counsel and the hearing officer have to travel to hear the testimony of a witness. Approval by the hearing officer before a subpoena is issued is necessary. Initially, the hearing officer can determine whether the evidence is relevant and/or whether a third party should be subjected to the inconvenience of a subpoena. In this respect, if the hearing officer does not believe any proffered evidence is admissible, the hearing officer may refuse to permit any party to proceed under 35 U.S.C. 24. If a party nevertheless caused a subpoena to issue, a motion to quash the subpoena would lie in the District Court, which issued the subpoena. Moreover, evidence obtained by subpoena without leave of the hearing officer would not be admitted or considered in the disciplinary proceeding. The proposed rule would adopt the policy of *Sheehan v. Doyle*, 513 F.2d 895, 898, 185 USPQ 489, 492 (1st Cir.), cert. denied, 423 U.S. 874 (1975), and *Sheehan v. Doyle*, 529 F.2d 38, 40, 188 USPQ 545, 546 (1st Cir.), cert. denied, 429 U.S. 879 (1976), rehearing denied, 429 U.S. 987 (1976), while rejecting the policy announced in *Brown v. Braddick*, 595 F.2d 961, 967, 203 USPQ 95, 101–102 (5th Cir. 1979).

Section 11.39, like current § 10.139, would provide for an ALJ to conduct disciplinary proceedings. Additionally, a hearing officer appointed under 35 U.S.C. 32 also would be able to conduct the proceedings. Paragraph (b) of § 11.39 would set out the authority of the hearing officer.

Paragraph (2) of § 11.39(c) would provide for the hearing officer's ruling on motions. See also § 11.43. It should be noted that, under § 11.42(e), a hearing officer could require papers to be served by "Express Mail."

Paragraph (4) of § 11.39(c) would require the hearing officer to authorize the taking of depositions in lieu of personal appearance at a hearing. The hearing officer would have discretion to authorize the taking of depositions. If demeanor is an issue for a particular witness, the hearing officer could exercise discretion and deny a request to take a deposition in lieu of appearance. When the hearing officer would authorize a deposition, notice and taking of the deposition would be governed by § 11.51(a).

Paragraph (8) of § 11.39(c) would provide for the hearing officer adopting procedures for the orderly disposition of disciplinary proceedings. For example, the hearing officer could require the

parties to file not only a pre-hearing exchange setting out the names of witnesses to be called, a summary of their expected testimony, and copies of exhibits to be used in their respective cases-in-chief; but also a pre-hearing brief discussing any disputed legal and factual issues.

Paragraph (d) of § 11.39 would provide for the hearing officer exercising such control over the disciplinary proceeding as to normally issue an initial decision within nine months from the filing of the complaint. The hearing officer, however, could issue an initial decision after nine months if in his or her opinion there exists unusual circumstances that preclude issuance of the initial decision within the nine-month period. The purpose of this provision would be to put parties on notice that the hearing officer has authority to complete his or her work within nine months, and that parties should plan to meet any time schedules set by the hearing officer. This paragraph would be designed to minimize delays. It is expected that the hearing officer would, as in the past, consult with the parties in setting times, and the nine-month provision will not set an undue hardship on either party.

Paragraphs (e) and (f) of § 11.39 would preclude interlocutory appeal by the OED Director or respondent from an order of the hearing officer except under limited circumstances. Under paragraph (d), the hearing officer could permit interlocutory review of his or her order when the interlocutory order involves a controlling question of procedure or law as to which there is a substantial ground for a difference of opinion and an immediate decision by the USPTO Director may materially advance the ultimate termination of the disciplinary proceeding or in an extraordinary situation where justice requires review. The standard would be the same as that of 28 U.S.C. 1292(b). Proceedings before the hearing officer would not be stayed for an interlocutory appeal unless the hearing officer or USPTO Director grants a stay. Under this section, stays would be granted only in the most compelling circumstances. The parties filing appeals or requests for review of interlocutory orders would not render the hearing officer ineffective.

Section 11.40, like current § 10.140, would provide for representation of respondent and the OED Director.

Section 11.41, like current § 10.141, would provide for the filing of papers. Under paragraph (a), the certificate of mailing practice under 37 CFR 1.8 and 1.10 is not applicable in disciplinary proceedings. Paragraph (b) would provide that papers filed after the