

be used both in a case-in-chief and to impeach, it would have to be produced.

Paragraph (4) of § 11.52(e) would provide for identifying any Government witness who investigated the matter. Respondent could then call the Government witness. Paragraph (5) of § 11.52 would provide for producing copies of any statement made by the respondent.

Section 11.53, like current § 10.153, would afford the parties a reasonable opportunity to submit proposed findings and conclusions, and a post-hearing memorandum. See 5 U.S.C. 557(c).

Section 11.54, like current § 10.154, would provide for the hearing officer to file an "initial decision." It would be expected that the hearing officer would make appropriate reference to the administrative record in explaining an initial decision. See, e.g., *Food Marketing Institute v. Interstate Commerce Commission*, 587 F.2d 1285, 1292, n.20 (D.C. Cir. 1978). In the absence of an appeal to the USPTO Director under § 11.55, the decision of the hearing officer would become the final decision in the disciplinary proceeding. See 5 U.S.C. 557(b).

Paragraph (b) of 11.54 would require the hearing officer to explain the reason(s) for any penalty. Four factors would guide the hearing officer and the USPTO Director in setting and approving penalties. The factors are the public interest, the seriousness of the violation of the imperative USPTO Rules of Professional Conduct, the deterrent effects deemed necessary, and the integrity of the bar. These factors are derived from numerous cases, including *Silverman v. Commodities Futures Trading Commission*, 562 F.2d 432, 439 (7th Cir. 1977); and *In re Merritt*, 363 N.E.2d 961, 971 (Ind. 1977). See also *Florida Bar v. Murrell*, 74 So.2d 221 (Fla. 1954). Under the proposed rules, a sanction would be a matter within the discretion of the hearing officer, with ultimate discretion in the USPTO Director. The discipline in each disciplinary case would be tailored for the individual case. See *In re Wines*, 660 P.2d 454 (Ariz. 1983). Manifestly, absolute uniformity or perfection would not be expected. *Id.* Likewise, relitigation of penalties imposed in prior cases would not be permitted. *Id.*

Section 11.55, like current § 10.155, would provide for an appeal from an initial decision of the hearing officer to the USPTO Director. Under paragraph (a) of § 11.55, any appeal would have to be taken within thirty days after the initial decision of the hearing officer. A cross-appeal would have to be filed fourteen days after the date of service of

the appeal or thirty days after the initial decision, whichever is later. Under paragraph (c) of § 11.55, the USPTO Director may order reopening of a disciplinary proceeding in accordance with the principles that govern the granting of new trials based on newly discovered evidence that could not have been discovered by due diligence.

Under paragraph (d) of § 11.55, if an appeal is not taken, the initial decision of the hearing officer would become the decision of the USPTO Director. See § 11.54(a).

Section 11.56, like current § 10.156, would provide for a decision by the USPTO Director. The USPTO Director could affirm, reverse, or modify an initial decision of a hearing officer, or remand the proceeding to the hearing officer for such further proceedings as the USPTO Director may deem appropriate. Under paragraph (c) of § 11.56, a respondent could make a single request for reconsideration or modification.

Section 11.57, like current § 10.157, would set out how judicial review could be obtained from a final decision of the USPTO Director. Judicial review must occur in the United States District Court for the District of Columbia in accordance with 35 U.S.C. 32, and Local Rule LCvR 83.7 of the United States District Court for the District of Columbia.

Section 11.58, like current § 11.158, would set out conditions imposed on a practitioner suspended or excluded from the practice of law before the Office. Paragraph (a) of § 11.58 would make clear that a practitioner suspended or excluded under § 11.56 will not be automatically reinstated. For example, a suspended or excluded practitioner would be required, *inter alia*, to comply with the provisions of §§ 11.12 and 11.60 to be reinstated.

Paragraph (b) of § 11.58 sets out what a suspended or excluded practitioner would be required to do. Paragraph (1) of § 11.58(b) would require the practitioner take a number of actions within twenty days after the date of entry of the order of suspension or exclusion. The actions include filing notices of withdrawal in pending patent and trademark applications, reexamination and interference proceedings, and every other matter pending before the Office within twenty days after the entry of the order. The practitioner would be required to notify affiliated bars, and all clients having business before the Office, of the discipline imposed and inability to act; notify practitioners for all opposing parties having business before the Office; deliver to all clients having

business before the Office any papers or other property to which the clients are entitled; and refund any part of any fees paid in advance and unearned. A practitioner also would be required to remove from any telephone, legal, or other directory any advertisement, statement, or representation which would reasonably suggest that the practitioner is authorized to or does practice before the Office.

Paragraph (2) of § 11.58(b) would require the practitioner within 30 days after entry of the order of exclusion or suspension to file with the OED Director an affidavit certifying that the practitioner has fully complied with the provisions of the order, and with the Rules of Professional Conduct.

Appended to the affidavit would be documents showing compliance with the suspension or exclusion order. The documents would include a copy of each form of notice, the names and addressees of the clients, practitioners, courts, and agencies to which notices were sent, and all return receipts or returned mail received up to the date of the affidavit. Also appended would be a schedule of all accounts where the practitioner holds or held as of the entry date of the order any client, trust, or fiduciary funds regarding practice before the Office, proof of the proper distribution of the client, trust and fiduciary funds; a list of all jurisdictions to which the practitioner is admitted to practice, and the steps taken to remove any advertisement or representation suggesting that the practitioner is authorized to or does practice before the Office.

Paragraph (c) of § 11.58 would require that an order of exclusion or suspension be effective immediately after entry except as provided in §§ 11.24, 11.25, and 11.28, where the order would be effective immediately. The excluded or suspended practitioner, after entry of the order, would not accept any new retainer regarding immediate, pending, or prospective business before the Office, or engage as a practitioner for another in any new case or legal matter regarding practice before the Office. However, the practitioner would be granted limited recognition for thirty days to conclude other work on behalf of a client on any matters that were pending before the Office on the date of entry. If such work cannot be concluded, the practitioner would have to so advise the client so that the client could make other arrangements.

Paragraph (d) of § 11.58 would provide for an excluded or suspended practitioner to keep and maintain records of the various steps taken under this section, so that in any subsequent