

(B) *Assist in any manner* means aid or help another person on a particular matter involving representation. This provision is directed to the person who, as an employee, participates in a particular matter, *e.g.*, patent application, while employed by the Office and after separation from the Office, behind the scenes, either enters a “revolving door” by assisting the applicant on the same matter, or “switches sides” by assisting another person on the same matter.

*Example 1:* A primary patent examiner allows a patent application owned by Company X. After leaving the Office, he is registered as a patent agent, and is asked by Company X to assist its attorneys in filing and prosecuting a reissue patent application. He may neither participate in the drafting of claims to be included in the reissue application, nor advise Company X on tactics and procedure, including the form and content of the oath needed for the reissue application, nor participate in drafting amendments to be filed in the application, even if another registered practitioner signs the documents filed in the Office.

*Example 2:* A patent examiner, shortly before resigning from the Office, signs an Office action rejecting claims in an inventor's patent application. The inventor replies, and a new examiner sends the inventor another Office action containing a final rejection of claims in the application. After resigning, the former examiner becomes registered as a patent agent. The inventor asks the former examiner—now registered patent agent for advice in replying to the Office action and to ghostwrite a reply for the inventor to sign and file as the inventor's own reply to the Office action. The former examiner may not do so.

(C) A former Office employee is not prohibited from providing in-house assistance that does not involve representation, but is prohibited from providing in-house assistance involving representation of another person.

*Example 1:* An Office employee examined a patent application of Company X, and allowed the application, which matured into a patent. Upon separation from the Office, he is hired by Company X, and becomes registered as a patent attorney. He works on licensing the technology covered by the claims in the patent, but has no direct contact with the Office. At the request of a company vice president, he prepares a paper describing the persons at the Office who should be contacted regarding reexamination of the patent, and what they consider persuasive for a favorable reexamination ruling. He may do so.

*Example 2:* A patent examiner examined a patent application of Company Z, and allowed an original application, which matured into a patent. Upon separation from the Office, he is hired by Company Z, and becomes registered as a patent attorney. Company Z filed a continuation-in-part application based on the original application. Another registered practitioner is prosecuting

the CIP application. A company vice president requests the former patent examiner to assist the other practitioner by preparing an amendment for the CIP application to overcome outstanding rejections or objections. The amendment is to be signed by the other registered practitioner, and the former examiner is to have no direct contact with the Office. This would be a communication with intent to influence. The former patent examiner may not do so.

(D) *Appearance* means that an individual is physically present before the Office in either a formal or informal setting, or the individual conveys material to the Office in connection with a formal proceeding or application; the appearance must occur in regard to a communication that is intended to influence. A communication is broader than an appearance and includes, for example, correspondence, or telephone calls.

*Example 1:* An appearance occurs when a former patent examiner, now a registered patent agent, meets with a current patent examiner or group director in either the Office or a restaurant to discuss a patent application; or when the former examiner submits a communication, *e.g.*, an amendment, appeal brief, or petition, bearing his or her name.

*Example 2:* A former patent examiner, now a registered patent agent, makes a telephone call to a present patent examiner to discuss an Office action in an application to reissue a patent which the former patent examiner examined; or ghostwrites an amendment to be signed and filed by an inventor. The former examiner has made a communication.

(E) Elements of “influence” and potential controversy are required. Communications that do not include an “intent to influence” are not prohibited. Moreover, a routine request not involving a potential controversy is not prohibited. For example, the following are not prohibited: inquiring into the status of a pending application being prosecuted by the practitioner's law firm; a request for publicly available documents; or a communication by a former examiner, not in regard to an adversarial proceeding, imparting purely factual information.

*Example 1:* A member of the Board of Patent Appeals and Interferences personally works on an interference between a patent application of Company X and a patent application of Company Y. After leaving the Office, he is registered as a patent attorney, and asked by Company X and Company Y to act as arbitrator between the parties regarding the same interfering applications. The arbitration award is filed with the Office, and necessarily has the intent to influence that it meets all requirements to be dispositive and acceptable to the Office. The former member of the Board, through the award, in effect, represents both parties. He may not do so.

(F) Project responses not included. In a context not involving a potential

controversy involving the United States, no finding of “intent to influence” shall be based on whatever influential effect inheres in an attempt to formulate a meritorious proposal or program.

*Example 1:* The employee of Company X in the previous example is asked some ten years after being hired by the company to improve upon the claimed subject matter in the patent, which he does, and a patent application for the improvement is filed. This is not prohibited despite the fact that his improvement may be inherently influential on a question of patentability. However, he may not argue for its patentability.

(ii) “Particular patent or patent application involving a specific party or parties.” (A) Particular patent or patent application. Like the prohibitions of sections (a) and (b) of 18 U.S.C. 207, the prohibitions of this section would be based on the former employee's, *e.g.*, patent examiner's or assistant solicitor's, prior participation in or responsibility for a “judicial or other proceeding, application, request for a ruling or other determination, contract, claim, controversy, investigation, charge, accusation, arrest, or other particular matter involving a specific party or parties” in which the United States is a party or has a direct and substantial interest. Such matters typically involve a specific proceeding affecting the legal rights of the parties or an isolatable transaction or related set of transactions between identifiable parties.

All patent issues, including the filing and prosecution of a patent application, are applications, claims, or other matters in which the United States is a directly or indirectly interested. For a patent examiner, a particular matter includes any patent application of a specific party, including a provisional, substitute, international, continuation, divisional, continuation-in-part, or reissue patent application, as well as any protest, reexamination, petition, appeal, or interference based on the patent application of a specific party. A “specific party” includes the applicant, owner, or assignee of the application.

*Example 1:* A patent examiner reviews and allows a particular patent application for an invention. After leaving the Office, and becoming registered as a patent agent, the former patent examiner may not represent the owner of the patent before the Office in an application for reissue of the patent, in a reexamination of the patent, in an interference involving the patent, in a divisional or continuation-in-part application, and the like.

*Example 2:* A patent examiner participates by recommending an interference between an application she examined and an application that she did not examine. After leaving the Office and becoming a registered patent attorney, she may not represent the owner of