

questions will be served upon the other party with the notice and copies of any written cross-questions will be served by hand or "Express Mail" not less than five days before the date of the taking of the deposition unless the parties mutually agree otherwise. A party on whose behalf a deposition is taken shall file a copy of a transcript of the deposition signed by a court reporter with the hearing officer and shall serve one copy upon the opposing party. Expenses for a court reporter and preparing, serving, and filing depositions shall be borne by the party at whose instance the deposition is taken. Depositions may not be taken to obtain discovery.

(b) When the OED Director and the respondent agree in writing, a deposition of any witness who will appear voluntarily may be taken under such terms and conditions as may be mutually agreeable to the OED Director and the respondent. The deposition shall not be filed with the hearing officer and may not be admitted in evidence before the hearing officer unless he or she orders the deposition admitted in evidence. The admissibility of the deposition shall lie within the discretion of the hearing officer who may reject the deposition on any reasonable basis including the fact that demeanor is involved and that the witness should have been called to appear personally before the hearing officer.

#### **§ 11.52 Discovery.**

Discovery shall not be authorized except as follows.

(a) After an answer is filed under § 11.36 and when a party establishes in a clear and convincing manner that discovery is necessary and relevant, the hearing officer, under such conditions as he or she deems appropriate, may order an opposing party to:

(1) Answer a reasonable number of written requests for admission or interrogatories;

(2) Produce for inspection and copying a reasonable number of documents; and

(3) Produce for inspection a reasonable number of things other than documents.

(b) Discovery shall not be authorized under paragraph (a) of this section of any matter which:

(1) Will be used by another party solely for impeachment or cross-examination;

(2) Is not available to the party under 35 U.S.C. 122;

(3) Relates to any disciplinary proceeding commenced in the Office prior to March 8, 1985;

(4) Relates to experts except as the hearing officer may require under paragraph (e) of this section.

(5) Is privileged; or

(6) Relates to mental impressions, conclusions, opinions, or legal theories of any attorney or other representative of a party.

(c) The hearing officer may deny discovery requested under paragraph (a) of this section if the discovery sought:

(1) Will unduly delay the disciplinary proceeding;

(2) Will place an undue burden on the party required to produce the discovery sought; or

(3) Is available:

(i) Generally to the public;

(ii) Equally to the parties; or

(iii) To the party seeking the discovery through another source.

(d) Prior to authorizing discovery under paragraph (a) of this section, the hearing officer shall require the party seeking discovery to file a motion (§ 11.43) and explain in detail for each request made how the discovery sought is necessary and relevant to an issue actually raised in the complaint or the answer.

(e) The hearing officer may require parties to file and serve, prior to any hearing, a pre-hearing statement that contains:

(1) A list (together with a copy) of all proposed exhibits to be used in connection with a party's case-in-chief;

(2) A list of proposed witnesses;

(3) As to each proposed expert witness:

(i) An identification of the field in which the individual will be qualified as an expert;

(ii) A statement as to the subject matter on which the expert is expected to testify; and

(iii) A statement of the substance of the facts and opinions to which the expert is expected to testify;

(4) The identity of Government employees who have investigated the case; and

(5) Copies of memoranda reflecting respondent's own statements to administrative representatives.

(f) After a witness testifies for a party, if the opposing party requests, the party may be required to produce, prior to cross-examination, any written statement made by the witness.

#### **§ 11.53 Proposed findings and conclusions; post-hearing memorandum.**

Except in cases in which the respondent has failed to answer the complaint or amended complaint, the hearing officer, prior to making an initial decision, shall afford the parties a reasonable opportunity to submit

proposed findings and conclusions and a post-hearing memorandum in support of the proposed findings and conclusions.

#### **§ 11.54 Initial decision of hearing officer.**

(a) The hearing officer shall make an initial decision in the case. The decision will include:

(1) A statement of findings and conclusions, as well as the reasons or basis therefor with appropriate references to the record, upon all the material issues of fact, law, or discretion presented on the record, and

(2) An order of suspension or exclusion from practice, an order of reprimand, or an order dismissing the complaint. The hearing officer shall transmit a copy of the decision to the OED Director and to the respondent. After issuing the decision, the hearing officer shall transmit the entire record to the OED Director. In the absence of an appeal to the USPTO Director, the decision of the hearing officer will, without further proceedings, become the decision of the USPTO Director thirty (30) days from the date of the decision of the hearing officer.

(b) The initial decision of the hearing officer shall explain the reason for any reprimand, suspension or exclusion. In determining any sanction, the following should normally be considered:

(1) The public interest;

(2) The seriousness of the violation of the imperative USPTO Rules of Professional Conduct;

(3) The deterrent effects deemed necessary;

(4) The integrity of the legal and patent professions; and

(5) Any extenuating circumstances.

#### **§ 11.55 Appeal to the USPTO Director.**

(a) Within thirty (30) days from the date of the initial decision of the hearing officer under §§ 11.28, or 11.54, either party may appeal to the USPTO Director. The appeal shall include the appellant's brief. If an appeal is taken, the time for filing a cross-appeal shall expire 14 days after the date of service of the appeal pursuant to § 11.42, or 30 days after the date of the initial decision of the hearing officer, whichever is later. The cross-appeal shall include the cross appellant's brief. An appeal or cross-appeal by the respondent will be filed with the USPTO Director and served on the OED Director, and will include exceptions to the decisions of the hearing officer and supporting reasons for those exceptions. All briefs must include a separate section containing a concise statement of the disputed facts and disputed points of law. Any issue not raised in the concise statement of