

PATENT AND TRADEMARK OFFICE**37 CFR Parts 1, 10 and 11**

[Docket No.: 2002-C-005]

RIN 0651-AB55

Changes to Representation of Others Before the United States Patent and Trademark Office**AGENCY:** United States Patent and Trademark Office, Commerce.**ACTION:** Final rule.

SUMMARY: The United States Patent and Trademark Office (Office or USPTO) is updating the procedures regarding recognition to practice before the Office in patent cases. The update is done to take advantage of computerized delivery of examinations, and to enable registration applicants to benefit in several ways, including scheduling the examination a their convenience and having more opportunities to take the examination.

DATES: *Effective Date:* July 26, 2004.**FOR FURTHER INFORMATION CONTACT:**

Harry I. Moatz ((703) 305-9145), Director of Enrollment and Discipline (OED Director), directly by phone, or by facsimile to (703) 305-4136, marked to the attention of Mr. Moatz, or by mail addressed to: Mail Stop OED—Ethics Rules, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450.

SUPPLEMENTARY INFORMATION: The Office published proposed rules regarding “Changes to Representation of Others Before The United States Patent and Trademark Office” on December 12, 2003 (68 FR 69442) and provided a sixty-day comment period that ended on February 10, 2004. The proposed rules included Subpart A, General Provisions, Subpart B, Recognition To Practice Before The Office, Subpart C, Investigations and Disciplinary Proceedings, and Subpart D, United States Patent and Trademark Office Rules of Professional Conduct. The Office published in the **Federal Register** an initial extension on January 29, 2004 (69 FR 4269) of the period for public comment regarding the ethics rules in Subpart D of the proposed rules. Additional time for public comment was allowed for consideration of whether the Rules for Professional Conduct should include the revisions to the Model Rules as amended by the American Bar Association at the end of its February 2002 Midyear Meeting, also known as the Ethics 2000 revision. The Office thereafter published in the **Federal Register** notice on March 3,

2004 (69 FR 9986) of an extension for public comment on proposed rules 1.4(d)(2), 1.8(a)(2)(iii)(A), 1.21(a)(6) through (a)(9), 1.21(a)(11), 1.21(a)(12), 2.11, 2.17, 2.24, 2.33, 2.61, 11.2(b)(4) through 11.2(b)(7), 11.3(b) and (c), 11.5(b), 11.8(d), 11.9(c) (last two sentences), 11.9(d), 11.10(c) (second sentence), 11.10(d) (second sentence), 11.10(e) (second sentence), 11.11(b) through (f), 11.12 through 11.62, and 11.100 through 11.900 as well as the definitions in proposed rule 11.1 of terms that are used only in rules in Subparts B, C and D, USPTO Rules of Professional Conduct.

Time was not extended to comment upon the provisions in proposed rules 1.1, 1.21(a)(1) through (a)(5), 1.21(a)(10), 1.31, 1.33(c), 1.455(a), 11.2(a) through 11.2(b)(3), 11.2(c) through 11.2(e), 11.3(a) and (d), 11.4 through 11.5(a), 11.6 through 11.8(c), 11.9(a) through 11.9(c) (first sentence), 11.10(a) through 11.10(c) (first sentence), 11.10(d) (first sentence), 11.10(e) (first and third sentences), and 11.11(a), as well as the definitions in proposed rule 11.1 of terms used in the rules.

The rules adopted at this time apply only prospectively.

At this time, nearly 29,000 individuals are registered as patent attorneys and agents, of whom about 80% have indicated that they are attorneys. Most have been registered by taking and passing a paper registration examination that was usually offered twice a year. The existing rules, adopted in 1985, largely continued the practices and procedures adopted and followed since the 1930's. They were well suited to support delivery of a paper registration examination twice a year to several hundred applicants.

The number of persons seeking registration has grown from a few hundred to several thousand annually. Giving the examination twice a year requires biannual filing of thousands of applications. More than 6,000 persons filed applications seeking registration in 2003. The frequency of giving the examination has increased from once each nine months in the 1970's to twice annually in the last several years.

Under the new computerized examination procedure, there are no fixed application deadlines. Applications may be submitted throughout the year. The applications will be reviewed, and persons admitted to the examination will schedule the examination at their convenience with a commercial entity engaged to deliver the examination. The commercial entity is equipped to provide the exam at over 400 locations around the United States. A person approved to take the

examination will schedule with the contractor the date and location where he or she desires to take the examination. The person will have a ninety-day window, beginning five business days after the mailing date of the letter admitting the person to the examination, within which he or she must take the examination.

Providing the examination in this manner will benefit persons seeking registration by enabling them to apply at any time, schedule the examination at a location and date convenient to them, and receive their results more quickly. Those failing the examination will be able to re-take the examination within approximately thirty days rather than waiting six months, as has previously been the case.

Applicants for registration will benefit in several ways from a computerized examination. It is now possible to deliver the registration examination on a daily basis by computer. They will be able to take the examination more frequently, get their results sooner, and be registered sooner. There will be no registration application filing deadline. With more than 400 locations around the country where the examination will be offered each business day, the examination sites will be conveniently closer to applicants. Applicants will also be able to reschedule the examination.

The computerized examination will be offered beginning with the effective date of this rule package. The examination can be administered each business day throughout the year. The format of the examination will remain unchanged. The examination will have 100 multiple choice questions—50 in the morning session and 50 in the afternoon session. During an initial period while the Office observes the implementation of the computerized examination, applicants will receive exam results approximately six weeks after electronic testing. Thereafter, immediate exam results will be provided on-site.

Computer-based licensure testing will not be unique to the Office. A wide variety of professional organizations utilize computer-based testing for their licensure. For example, both the General Securities Representative Examination (Series 7), and the Uniform Certified Public Accountant (CPA) Examination are administered on computers.

Applicants will benefit from the program by the elimination of application filing deadlines and the new ability to schedule the exam at their convenience. In the past, the cyclical nature of giving the examination twice a year was inefficient to both the Office

and persons seeking registration. Invariably, applications were filed late and were necessarily disapproved. Many incomplete applications could not be completed by the deadline. In short, offering the exam twice a year meant that application deficiencies could not be cured until the next time the test was offered—approximately six months later.

Applicants benefit by being able to schedule when they want to take the examination. Applicants can schedule the examination date within a ninety-day period. They can also reschedule the examination on another date within the ninety-day period for any reason.

The old method of paper testing required a significant devotion of Office of Enrollment and Discipline (OED) resources during peak periods to process and evaluate applications, as well as process the results. A majority of applicants used to file their application just prior to or on the deadline. Obviously, applicants will be better served if their examination results are received more quickly. Those who pass the examination and have no good moral character and reputation issues will be registered sooner. The Office is better served by having a less cyclical exam process. The computerized examination will produce a more even flow of new applications for processing. The computerized examination can be administered daily, and its results released more quickly.

The new rules do not change the scientific and technical training requirements for registration.

The new rules change procedures for the examination. These changes will improve the Office's processes for handling applications for registration, petitions, and moral character investigations.

Discussion of Specific Rules

Section 1.1: Section 1.1(a)(5) is added to provide an address for correspondence directed to OED in enrollment, registration and investigation matters.

Section 1.21: Section 1.21(a) is added to designate the registration examination fee in paragraph (1)(ii)(A) for test administration by the commercial entity, and in paragraph (1)(ii)(B) for test administration by the USPTO.

Section 1.21(a)(5)(i) is added for a new fee for review by the OED Director of an initial decision by a staff member of OED.

Section 1.21(a)(5) has been redesignated (a)(5)(ii), and section citation of § 10.2(c) is amended to § 11.2(d).

Sections 1.21(a)(6) through 1.21(a)(9) are reserved.

Section 1.21(a)(10) is added for a fee for any of the following: On application by a person for recognition or registration after disbarment or suspension on ethical grounds, or resignation pending disciplinary proceedings in any other jurisdiction; on petition for reinstatement by a person excluded or suspended on ethical grounds, or excluded on consent from practice before the Office; on application by a person for recognition or registration who is asserting rehabilitation from prior conduct that resulted in an adverse decision in the Office regarding the person's moral character; and on application by a person for recognition or registration after being convicted of a felony or crime involving moral turpitude or breach of fiduciary duty. For persons suspended or disbarred, the fee applies to a person after suspension or disbarment on ethical grounds, as opposed to a person suspended on only non-ethical grounds, such as failure to pay State bar dues or failure to complete continuing legal education requirements. The amount of the fee, \$1,600, recovers a portion of the average cost of processing an application filed by a person described in this section.

Section 1.31: This section is amended to revise the references to §§ 11.6 and 11.9, respectively.

Section 1.33: Section 1.33(c) is amended to revise the references to §§ 11.5 and 11.11, respectively.

Section 1.455: This section is amended to revise the reference to § 11.9.

Title 37 of the Code of Federal Regulations, Part 10, is amended as follows:

Section 10.2: This section is removed and reserved.

Section 10.3: This section is removed and reserved.

Section 10.5: This section is removed and reserved.

Section 10.6: This section is removed and reserved.

Section 10.7: This section is removed and reserved.

Section 10.8: This section is removed and reserved.

Section 10.9: This section is removed and reserved.

Section 10.10: This section is removed and reserved.

Section 10.11: This section is revised by deleting paragraph (a) and deleting the designation (b) of paragraph (b).

Title 37 of the Code of Federal Regulations, Part 11, is added as follows:

Section 11.1: This section defines terms used in Part 11. The defined terms

include attorney, belief, conviction, crime, Data Sheet, fiscal year, fraud, good moral character and reputation, knowingly, matter, OED, OED Director, OED Director's representative, Office, practitioner, proceeding before the Office, reasonable, registration, roster, significant evidence of rehabilitation, state, substantial, suspend or suspension, United States, and USPTO Director. These terms are used in the rules that address the recognition of individuals to practice before the Office. An "application for reissue" has been added to the definition of "proceeding before the Office" to clarify its inclusion within the definition. "Other jurisdiction" has been added to the definition of "suspend" or "suspension" to clarify that the terms include temporary debarment from practice before the Office or another jurisdiction.

Section 11.2: Section 11.2(a) is added to provide for the appointment of the OED Director.

Section 11.2(b) sets forth the duties of the OED Director. The duties of the OED Director include managing the Office of Enrollment and Discipline, receiving and acting upon applications, and conducting investigations concerning the moral character and reputation of individuals seeking registration. The duties also include conducting investigations into possible violations by practitioners of Disciplinary Rules, initiating disciplinary proceedings under § 10.132(b) with the consent of the Committee on Discipline, and performing such other duties in connection with investigations and disciplinary proceedings as may be necessary. The investigation and disciplinary duties recited in § 10.2(b) have been moved to § 11.2(b)(4) to consolidate in one section all of the OED Director's duties. The provisions in proposed § 11.2(b)(4) remain subject to comment. The investigation and disciplinary duties in § 11.2(b)(4) will be subject to change following the comments on proposed § 11.2(b)(4).

Sections 11.2(b)(5) through (b)(7) are reserved.

Section 11.2(c) is added to provide a requirement that any petition from any action or requirement of the staff of OED reporting to the OED Director shall be taken to the OED Director. A provision added to the final rule requiring the petition to be filed within sixty days from the mailing date of the action or notice from which relief is requested clarifies the point in time, not otherwise provided for in the proposed rule, from which the petition must be filed. A fee, required by 37 CFR 1.21(a)(5), would be charged for the petition. A petition not

filed within the sixty-day period will be dismissed as untimely.

Section 11.2(d) is added to provide for a petition from a final decision of the OED Director to the USPTO Director. A provision added to the final rule requiring the petition to be filed within sixty days from the mailing date of the final decision of the OED Director clarifies the point in time, not otherwise provided for in the proposed rule, from which the petition must be filed. The petition must be accompanied by the fee in § 1.21(a)(5). The petition will be dismissed if not filed within sixty days from the mailing date of the final decision of the OED Director.

Section 11.3: Section 11.3 is added to provide for suspension of any requirement of the regulations of Part 11 which is not a requirement of the statutes in an extraordinary situation, when justice requires.

Recognition To Practice Before the USPTO

Section 11.4: Section 11.4 is reserved. Upon further consideration, the Office has concluded that it is unnecessary to provide for a Committee on Enrollment and has eliminated it in the rules. The Committee's principal function has been the vetting of registration examination questions. Office personnel have been developing a data bank of questions for the registration examination and examiner certification test. These personnel are not limited to members of the Committee. Further, the proposed rules, § 11.7(j), contemplated using the Committee to conduct hearings about an individual's good moral character and reputation. The final rules provide an individual an opportunity to create a record, to respond to the OED Director's show cause order, and to obtain review of the OED Director's decision by petition to the USPTO Director. An individual dissatisfied with the decision of the OED Director may petition the USPTO Director under § 11.2(d) for review of the decision. Accordingly, the rules will not provide for or utilize a Committee on Enrollment to conduct a hearing for good moral character and reputation determinations.

Section 11.5: Section 11.5 is added to provide for maintaining a single register of attorneys and agents registered to practice before the Office.

Section 11.6: Section 11.6(a) is added to provide qualifications for attorneys to register to practice before the Office in patent matters.

Section 11.6(b) is added to provide qualifications for non-attorneys to register as patent agents to practice before the Office in patent matters.

Section 11.6(c) is added to provide for qualifications for limited reciprocal registration of any foreign person who is registered in good standing before the patent office of the country in which he or she resides and practices.

Section 11.6(d) is added to provide that the Chief Administrative Patent Judge or Vice Chief Administrative Patent Judge of the Board of Patent Appeals and Interferences will determine whether and the circumstances under which an attorney who is not registered may take testimony for an interference under 35 U.S.C. 24, or under § 1.672 of this subchapter.

Section 11.7: Sections 11.7(a)(1) and 11.7(a)(2) require that an individual apply for registration, and establish possession of good moral character and reputation, legal, scientific and technical qualifications, and competence to advise and assist patent applicants.

Section 11.7(b)(1)(i) requires that an individual file a complete application for registration on a form supplied by the OED Director, pay the fees required by § 1.21(a)(1), and present satisfactory proof of sufficient basic training in scientific and technical matters. Aliens are also required to present affirmative proof that recognition to practice before the USPTO is not inconsistent with the terms of their visa or entry into the United States. The proposed rule provided for filing a complete application for each administration of the examination. Inasmuch as the computer delivered examination will be administered each business day, § 11.7(b)(1)(i) has been revised to provide that a complete application for registration must be filed each time admission to the examination is requested.

Section 11.7(b)(1)(ii), which appeared as § 11.7(b)(4) in the proposed rules, requires that individuals seeking registration pass the examination unless the examination is waived as provided for in § 11.7(d) to enable the OED Director to determine whether the individual possesses the required legal and competence qualifications. Section 11.7(b)(1)(ii) has been revised to provide that an individual failing the examination must wait thirty days after the date the individual last took the examination before retaking the examination. The revision reduces the interval in the proposed rule between opportunities to take and pass the examination. This section also sets forth the documents and fees that must be filed by an individual reapplying after failing the examination.

Section 11.7(b)(1)(iii), which appeared as § 11.7(b)(6) in the proposed rules, requires the individual to provide satisfactory proof of possession of good moral character and reputation.

Section 11.7(b)(2) is added to provide that an individual failing to file a complete application will be given notice and required to complete the application within sixty days of the mailing date of the notice. Inasmuch as the proposed rule did not specify when the sixty-day period began, the final rule clarifies that the sixty-day period begins with the mailing date of the notice. Individuals filing incomplete applications will not be admitted to the examination. Applications that are incomplete as originally submitted will be considered only when they have been completed and received by OED within the sixty-day period. Thereafter, a new and complete application must be filed to establish an individual's qualifications and demonstrated intent to take the examination. A proposed provision, appearing in proposed § 11.7(b)(4) as well as 37 CFR 10.7, and prohibiting administration of the examination as an academic exercise, has been revised inasmuch as it did not specify the qualifications for admission to the examination. As revised, the provision has been moved in the final rules to § 11.7(b)(2). The revision permits only an individual approved as satisfying the requirements of §§ 11.7(b)(1)(i)(A), 11.7(b)(1)(i)(B), 11.7(b)(1)(i)(C) and 11.7(b)(1)(i)(D) to be admitted to the examination.

Section 11.7(b)(3), which appeared as § 11.7(b)(5) in the proposed rules, requires an individual first reapplying more than one year after the mailing date of a notice of failure to again comply with § 11.7(b)(1) by filing a complete new application. The proposed rule did not specify the date from which the one year would begin. The final rule, by specifying the mailing date of the notice, eliminates uncertainty in the proposed rule of the starting date of the one-year period.

Section 11.7(c) provides that each individual seeking registration is responsible for updating all information and answers submitted in or with the application for registration. The application must be updated within thirty days after the date of the occasion that necessitates the update. In the notice of proposed rule making, § 11.7(c) provided for a petition to the OED Director. Proposed § 11.2(c) also provided for a petition to the OED Director. The redundancy is unnecessary and the provision for the petition in § 11.7(c) has been removed in the final rules. There were also

redundant provisions in §§ 11.7(b)(2) and 11.8(c) of the proposed rules requiring individuals to update their applications. The provisions have been removed from §§ 11.7(b)(2) and 11.8(c), and merged into § 11.7(c) in the final rules.

Section 11.7(d) is added to provide for waiver of the examination for former patent examiners and certain other employees. Section 11.7(d)(1) addresses registration of former patent examiners who by July 26, 2004, had not actively served four years in the patent examining corps, and were serving in the corps at the time of their separation. The examination may be waived if the individual demonstrates that he or she actively served in the patent examining corps, received a certificate of legal competency and negotiation authority, was thereafter rated at least fully successful in each quality performance element of his or her performance plan for the last two complete fiscal years as a patent examiner, and was not under an oral or written warning regarding the quality performance elements at the time of separation from the patent examining corps. For consistency, the effective date of § 11.7(d) has been reduced from sixty days indicated in the proposed rules, to thirty days following publication of the final rules.

Section 11.7(d)(2) is added to address registration of former patent examiners who on July 26, 2004, had actively served four years in the patent examining corps, and were serving in the corps at the time of their separation. The examination may be waived when the individual demonstrates that he or she actively served for at least four years in the patent examining corps of the Office by July 26, 2004, was rated at least fully successful in each quality performance element of his or her performance plan for the last two complete fiscal years as a patent examiner in the Office, and was not under an oral or written warning regarding the quality performance elements at the time of separation from the patent examining corps.

Section 11.7(d)(3) is added to address registration of certain former Office employees who were not serving in the patent examining corps upon their separation from the Office. The OED Director may waive the registration examination in the case of a former Office employee meeting the requirements of § 11.7(b)(1)(i)(c) who by petition demonstrates possession of the necessary legal qualifications. The former employee must show that as a result of having been in a position of responsibility in the Office, he or she has an equivalent comprehensive

knowledge of patent law. In the position, the individual must have provided substantial guidance on patent examination policy, including the development of rule or procedure changes, patent examination guidelines, changes to the Manual of Patent Examining Procedure, development of training or testing materials for the patent examining corps; development of materials for the registration examination or continuing legal education; or represented the Office in patent cases before Federal courts. The individual must establish that he or she was rated at least fully successful in each quality performance element of his or her performance plan for said position for the last two complete rating periods in the Office, and was not under an oral or written warning regarding performance elements relating to such activities at the time of separation from the Office.

Section 11.7(d)(4) limits the eligibility period for seeking waiver of the examination by an individual formerly employed by the Office within the scope of §§ 11.7(d)(1), 11.7(d)(2) and 11.7(d)(3). An individual filing an application for registration more than two years after separation from the Office is required to take and pass the registration examination. Employees and former employees not satisfying the requirements of §§ 11.7(d)(1) through 11.7(d)(3) must comply with §§ 11.7(a) and 11.7(b) and take and pass the registration examination to be registered. Therefore, it is redundant to include a provision in § 11.7(d)(4) requiring compliance with §§ 11.7(a) and 11.7(b). The provision in § 11.7(d)(4) has been removed from the final rule.

Section 11.7(e) is added to eliminate the regrading of examination answers. The language in the proposed rule has been simplified in the final rule. Within sixty days of the mailing date of a notice of failure, the individual is entitled to inspect, but not copy, the questions and answers he or she incorrectly answered. The inspection will occur under supervision. Applicants will not be permitted to take any notes relating to the questions or answers.

Section 11.7(f) is added to provide that applicants seeking reciprocal recognition under § 11.6(c) must file an application and pay the application fee set forth in § 1.21(a)(1)(i).

Section 11.7(g) is added to provide for soliciting information bearing on the good moral character and reputation of individuals seeking recognition, and for investigation of an individual's good moral character and reputation.

Sections 11.7(g)(2) and 11.8(a) in the proposed rules address publication of information to solicit information bearing on the good moral character and reputation of applicants passing the examination or seeking recognition. The redundancy has been removed by providing for the procedure in § 11.8(a). Sections 11.7(g)(3)(i) and 11.7(g)(3)(ii) have been renumbered 11.7(g)(2)(i) and 11.7(g)(2)(ii).

Section 11.7(g)(2)(i) requires that the OED Director conduct an investigation into the good moral character and reputation of an applicant if information is received "that reflects adversely" on the applicant's good moral character and reputation. The proposed rule authorized investigation upon receipt of information "tending to reflect" adversely the good moral character. The final rule narrows the circumstances when an investigation should occur.

Section 11.7(h) is added to provide guidance when lack of good moral character and reputation exists. The provisions relating to felonies and crimes have been clarified in the final rule to reference conviction of a felony, conviction of a crime involving moral turpitude, and a conviction of a crime involving breach of fiduciary duty. Unlike the proposed rule that did not provide for conviction of "a crime," the final rule clarifies that a conviction of the respective crimes is evidence of lack of good moral character and reputation.

Section 11.7(h)(1)(i) provides that an individual convicted of a felony or any misdemeanor identified in §§ 11.7(h) and 11.7(h)(1) is not eligible to apply for registration during the time of any sentence, deferred adjudication, period of probation or parole as a result of the conviction, and for a period of two years thereafter. The proposed rule also provided for ineligibility for registration. The latter provision has been removed from the final rule because ineligibility to apply for registration precludes registration. Pursuant to § 11.3, an individual may request waiver of the two-year period upon showing an extraordinary situation where justice requires waiver, such as when a conviction is overturned.

Section 11.7(h)(4)(iii) specifies the defenses available to an individual seeking registration who has been disbarred, suspended on ethical grounds, or resigned in lieu of a disciplinary proceeding. The proposed rule did not indicate the purpose of the defenses. The final rule limits the defenses to an underlying disciplinary matter where the individual contests the relevance of the disciplinary matter to his or her good moral character and

reputation. The defenses are the same as those that are available to a practitioner in a reciprocal disciplinary proceeding.

Section 11.7(i) identifies factors that may be taken into consideration when evaluating rehabilitation of an applicant seeking a good moral character determination for registration. Section 11.7(i)(8), which addresses misconduct attributable in part to a medically recognized mental disease, disorder or illness, is revised to remove a minimum period of time for which recovery must be shown, and to provide that letters from the treating psychiatrist/psychologist must verify that the medically recognized mental disease, disorder or illness will not impede the individual's ability to competently practice before the Office. The change reflects the Office's standard for recognizing an individual's recovery efforts and a professional's assessment. Proposed § 11.7(i)(11) has been removed as providing a presumption that education equates to ethical conduct. Section 11.7(i)(12) has been revised to remove references to particular programs designed to provide social benefits or ameliorate social problems. The revision enlarges the scope of acceptable programs providing the same benefits. Proposed §§ 11.7(i)(12) and 11.7(i)(13) have been renumbered as §§ 11.7(i)(11) and 11.7(i)(12).

Section 11.7(j) is added to provide for the OED Director to inquire into the good moral character and reputation of an individual seeking registration, to provide the individual with an opportunity to respond and create a record on which a decision is made. The OED Director will consider the response and record, and issue a notice to show cause if the OED Director is of the opinion that an individual has not satisfactorily established that he or she possesses good moral character and reputation. After a notice to show cause is issued, the OED Director will consider the record and response filed by the individual, and issue a decision on whether the individual has sustained his or her burden. An individual may seek review of the OED Director's decision pursuant to § 11.2(d).

Section 11.7(k) is added to set forth conditions for reapplication when an application for registration has been rejected because of lack of good moral character and reputation. An applicant may reapply for registration two years after the date of the decision denying the individual registration. The application must include the fee required by § 1.21(a)(10). Pursuant to § 11.3, an individual may request waiver of the two-year period upon showing an extraordinary situation where justice

requires waiver, such as when a conviction is overturned.

Section 11.8: Section 11.8(a) provides for the OED Director to promptly publish a solicitation for information concerning the individual's moral character and reputation, including the individual's name, and business or communication postal address.

Section 11.8(b) provides procedures for registration as a patent attorney or agent, or being granted limited recognition. This section also provides that within two years of issuance of notice of a passing grade on the registration examination, the requirements for completion of registration must be met. An individual seeking registration as a patent attorney must demonstrate that he or she is a member in good standing with the bar of the highest court of a state.

Section 11.8(c) provides that an individual who does not comply with the requirements of § 11.8(b) within the two-year period will be required to retake the registration examination. This provision appeared in § 11.8(a) in the proposed rules.

Section 11.9: Section 11.9(a) provides for limited recognition of individuals to practice before the Office in a particular patent application or patent applications.

Section 11.9(b) provides for granting limited recognition to a nonimmigrant alien who resides in the United States and fulfills the provisions of §§ 11.7(a) and (b) if the nonimmigrant is authorized to be employed or trained in the United States in the capacity of representing a patent applicant by preparing or prosecuting the applicant's patent application. A provision in the proposed rules, making nonimmigrant aliens authorized to receive training ineligible for limited recognition, is withdrawn. Another proposal, limiting recognition to being granted in increments of one year, has also been withdrawn. Limited recognition will be granted for a period consistent with the terms of authorized employment or training. These changes are consistent with the law, will reduce burdens on applicants, and facilitate administrative procedures.

Section 11.9(c) provides for limited recognition of an individual not registered under § 11.6 to prosecute an international patent application only before the U.S. International Searching Authority and the U.S. International Preliminary Examining Authority.

Section 11.10: Section 11.10 is added to address restrictions on practice in patent matters for former employees of the Office. Section 11.10(a) is added to permit only practitioners who are

registered under § 11.6 or individuals given limited recognition under § 11.9(a) or (b) to prosecute patent applications of others before the Office. Individuals granted limited recognition under § 11.9(c) may prosecute an international patent application only before the United States International Searching Authority and the United States International Preliminary Examining Authority, but may not otherwise practice before the Office, such as in an application filed under 35 U.S.C. 111 or 371. Accordingly, § 11.10(a) addresses only individuals granted limited recognition under §§ 11.9(a) or 11.9(b), but not § 11.9(c).

Section 11.10(b) is added to set forth post employment provisions for any registered former Office employee. The provisions parallel basic restrictions of 18 U.S.C. 207(a) and (b) on a registered former Office employee acting as representative or communicating with intent to influence a particular matter in which the employee personally participated or for which the employee had official responsibility within specified time periods. In addition, the provision proscribes the similar conduct occurring behind the scenes by prohibiting conduct that "aids in any manner" the representation or communication with intent to influence.

Section 11.10(c) is added to clarify that the restrictions of § 11.10(c) are in addition to those imposed on all Government employees by other statutes and regulations.

Section 11.10(d) is added to continue to prohibit employees of the Office from prosecuting or aiding in any manner in the prosecution of a patent application.

Section 11.10(e) is added to make clear that practice before the Office by Government employees is subject to any applicable conflict of interest laws, regulations or codes of professional responsibility. A statement in the proposed rule making, "noncompliance with said conflict of interest laws, regulations or codes of professional responsibility shall constitute misconduct under §§ 11.804(b) or 11.804(h)(8)," will be separately addressed when adoption of proposed §§ 11.804(b) or 11.804(h)(8) is considered.

Section 11.11: Section 11.11 is added to require a registered practitioner to notify OED, separately from any notice given in any patent application, of the business postal address, business e-mail address, business telephone number, and of every change to any of those addresses or telephone numbers, within thirty days of the date of the change. Practitioners who are attorneys in good standing with the bar of the highest

court of one or more states must provide the OED Director with the State bar identification number associated with each membership. Further, this section identifies the information that the OED Director will routinely publish on the roster about each registered practitioner recognized to practice before the Office in patent cases.

Response to comments: The Office published a notice on December 12, 2003, proposing changes to rules by updating the procedures regarding enrollment and discipline, and introducing new USPTO Rules of Professional Conduct, largely based on the Model Rules of Professional Conduct of the American Bar Association. See Changes to Representation of Others Before the United States Patent and Trademark Office, 68 FR 69442 (December 12, 2003), 1278 Off. Gaz. Pat. Office 22 (January 6, 2004) (proposed rule). The Office received 112 written comments (27 from intellectual property or other organizations and 85 by patent practitioners) in response to this notice. The comments regarding the rules adopted at this time and the Office's responses to the comments follow.

Comment 1: One comment suggested that privatized administration of the registration examination will result in problems stemming from the introduced profit motive, including increased costs associated with sitting for the examination, and a decreased quality of practitioners allowed to pass the examination. The comment opined that the profit motive will result in a degradation of the examination process itself and of the examination results if the private tester reduces manpower and materials required to effectively administer the exam.

Response: To the extent the comment is suggesting that the Office maintain the status quo for the examination procedure, the suggestion has not been adopted. The commercial entity will be responsible only for computer-based administration of the examination. Candidates will continue to apply to OED, which will continue to review applications and grant approval to sit for the examination only to persons possessing the necessary scientific and technical training qualifications. The Office retains complete control over (1) the qualifications of the candidates, (2) determining each candidate's moral character, (3) the content of the examination, and (4) the qualifications to pass the examination. The USPTO will continue to set the passing score. The USPTO will maintain control over the development and content of the examination. The questions seek to

ascertain that a candidate knows the practices, policies, and procedures applicable to patent prosecution as related in the Manual. Only Office personnel generate, develop, vet and clear the questions for use on the examination. The questions and answers are carefully checked against the Manual to confirm that there is one correct answer. The Manual will be available to candidates on a computer, and where they may confirm the correctness of the answer they have selected. The Office is the only entity that determines whether a question will be withdrawn for any reason, or reused. Thus the Office will continue to maintain the same high standards for registration.

In the past, the examination was administered twice a year in about 37 cities, whereas the commercial entity can administer the examination each business day in over 400 sites. Accordingly, the examination will be more widely available. The total fees for the computerized examination are \$350 (the sum of \$200 examination development fee charged by the Office, and the \$150 fee charged by the commercial entity administering the examination). This is an increase of only \$40 over the \$310 examination fee previously charged by the Office.

The computerized examination enables candidates to realize a substantial savings for other costs associated with the examination. For example, expenses that candidates may have incurred traveling to 37 cities to take the examination should be significantly reduced or eliminated with more test facilities available on a daily basis. Scheduling will also be more convenient for candidates. They can schedule the examination anytime within a set ninety-day period at the commercial entity's testing site closest to their home or office. They can also arrange with the commercial entity to reschedule the examination within the same ninety-day period.

The Office will also offer applicants the option of taking a paper examination administered by the Office once a year. The fee for the Office-administered paper examination will be \$450. Inasmuch as one paper examination was already administered in fiscal year 2004, the OED Director will announce when the Office will offer a paper examination.

Comment 2: One comment suggested that the \$130 petition fee for review of any decision of the OED Director not be adopted because it is an inequitable monetary penalty imposed upon a practitioner for the privilege of seeking review of what may very well be an

erroneous action on the part of the OED Director.

Response: The suggestion has not been adopted. It is not a penalty to charge a fee for a petition to review an official's decision. Since 1985 the Office has charged applicants for registration and practitioners a petition fee for review of a variety of decisions by the OED Director. See 37 CFR 1.21(a)(5) (imposing a fee for review under § 10.2(c)). The Office also charges for petitions to review other decisions by agency officials. See 37 CFR 1.17(h) (imposing a fee for filing a petition under § 1.295 for review of refusals to publish a statutory invention registration, § 1.377 for review of decisions refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent, and § 1.378(e) for reconsideration of a decision on petition refusing to accept delayed payment of maintenance fee in an expired patent). The \$130 fee is consistent with the fee charged for the foregoing petitions in § 1.17(h).

The fee is for review of the official's decision and the benefits delivered by the opportunity for review and decision. The fee is not punitive, nor is it a sanction against petitioners.

Comment 3: Two comments observed that the proposal to amend § 1.1(a) by adding new paragraph (a)(4), the address for correspondence intended for the United States Patent and Trademark Office, is based upon an outdated version of § 1.1(a).

Response: The suggestion has been adopted. The provisions of § 1.1 have been revised to remove the reference to paragraph (a)(2), and to change the numbering of proposed paragraph (a)(4) to (a)(5).

Comment 4: One comment suggested that § 1.31 be amended to recognize the situation in which joint applicants choose to file and prosecute their own case before the USPTO.

Response: The suggestion is not adopted with this rule. The matter is addressed in another rule titled "Clarification of Power of Attorney Practice, and Revisions to Assignment Rules," RIN 0651-AB63. This final rule has been submitted to the **Federal Register** for publication at this time.

Comment 5: One comment suggested for clarity, each definition in § 11.1 should be separately numbered, e.g. by (1), (2) * * *, etc., to facilitate citation of each definition.

Response: The suggestion has not been adopted. The omission of paragraph numbers facilitates the ease of addition or deletion of definitions in § 11.1 without having to renumber the definitions if their position in the list of

definitions changes. The definitions will be maintained in alphabetical order to facilitate citation and location of each definition.

Comment 6: One comment suggested that the definition of “good moral character” appearing in the first sentence of § 11.7(h) be moved to § 11.1 because the term is used in a number of other proposed rules without reference to the definition in § 11.7(h). Therefore a person reading a rule other than § 11.7(h) may not know that the term had been defined in § 11.7(h) and would naturally seek the definition in § 11.1.

Response: The suggestion has been adopted. The first sentence of § 11.7(h) defining “good moral character and reputation” has been moved to § 11.1.

Comment 7: One comment pointed out that, although proposed Sec 11.1 defined “application” as a patent or trademark application, the term “application” is also used in proposed §§ 11.2, 11.7, 11.8, 11.10 and 11.11 to refer to an application for registration. It was suggested that the phrase “application for registration” be defined in § 11.1 and be the term that is used in §§ 11.2(b)(2), 11.7(b)(1)(i), 11.7(f), 11.7(j)(1), 11.7(j)(3), 11.8(c), 11.10 and 11.11. The latter section uses the term “application,” and the definition of “application” includes only patent and trademark applications. Introduction and use of the term “application for registration” would avoid confusion with “application.”

Response: The suggestion has been adopted in part. The term “application for registration” need not be defined in § 11.1, but the term has replaced “application” in §§ 11.2(b)(2), 11.7(b)(1)(i), 11.7(f), and 11.7(j). Inasmuch as there is no reference to an “application for registration” in § 11.8(c) as amended, and § 11.10, it was not necessary to modify “application” in this manner. The suggestion as to proposed §§ 11.7(j)(1) and 11.7(j)(3) is now moot inasmuch as they are not adopted. Section 11.11 addresses the necessity for registered practitioners to separately provide written notice to the OED Director in addition to any notice of change of address and telephone number filed in individual applications. Therefore, where an introductory reference to an “application” occurs in §§ 11.10 and 11.11, the term “application” has been modified with “patent.”

Comment 8: One comment suggested that the definition of “belief” or “believes” in § 11.1 is indefinite because the meaning of phrases “actually supposed” and “inferred from circumstances” are not clear, and urged that the terms be defined as meaning

that “an individual assents to the truth of something offered for acceptance and that the individual’s belief may be inferred from factual circumstances.”

Response: The suggestion has not been adopted. The definition comes from the Model Rules of Professional Conduct of the American Bar Association. One of the purposes of generally conforming the USPTO rules to the Model Rules is that those rules have been widely adopted by states. As a result, decisional law through state auspices should facilitate the development of a body of case law that will help provide practitioners guidance on the meaning of terms that are necessarily broad because they need to cover a variety of circumstances. At this time, no change will be made while comments continue to be received regarding the proposed professional conduct rules.

Comment 9: One comment opined that the definitions of “fraud” or “fraudulent” and the terms “knowingly,” “known,” or “knows” in § 11.1 can be clarified. The definition of “fraud” or “fraudulent,” as “failure to apprise another of relevant information” could encompass a deceit which under the definition would not constitute fraud or a fraudulent act, and suggested that the terms be tailored to practice before the Office in light of 37 CFR 1.56, and that they be defined as “conduct having a purpose to deceive, and not merely negligent misrepresentation or negligent failure to apprise another of relevant information.” It was suggested that the definition of “knowingly,” “known,” or “knows” as “inferred from circumstances” is not understood, and that the definition be replaced with the phrase “inferred from circumstantial evidence.”

Response: The suggestions have not been adopted. The definitions come from the Model Rules of Professional Conduct of the American Bar Association. At this time, no change will be made while comments continue to be received regarding the proposed professional conduct rules.

Comment 10: One comment suggested that the definitions of “suspended or excluded practitioner,” and “non-practitioner” be separated out of the definition of “practitioner” to facilitate ease of finding the definitions.

Response: The suggestion has been adopted in part. The definitions of “suspended or excluded practitioner,” and “nonpractitioner” have been separated from “practitioner,” and are not included in this rule.

Comment 11: One comment suggested that § 11.2(a) provide for appointment of an acting Director where the OED

Director must recuse himself or herself from a case.

Response: The suggestion has been adopted. The second sentence has been amended to read “In the event of the absence of the OED Director or a vacancy in the Office of the OED Director, or in the event that the OED Director recuses himself or herself from a case, the USPTO Director may * * *.” The appointment would contain any necessary directions limiting the Acting OED Director’s authority to act only in the matter from which the OED Director is recused.

Comment 12: Two comments suggested that § 11.2(c) be modified to change the proposed one-month period in § 11.2(c) to two months, and one comment suggested that no fee be required to be consistent with 37 CFR 1.181. A third comment suggested that the proposed one-month period be increased to ninety days.

Response: The suggestion has been adopted in part. The thirty-day period for filing a petition has been enlarged to sixty days. Charging a fee is consistent with the provisions of 37 CFR 1.181(d). As the staff of OED with respect to individual cases generally exercises independent judgment, charging a fee for review of that judgment by the OED Director is in keeping with circumstances under which the USPTO generally charges fees for consideration of petitions. The decisions address the merits of a variety of situations, including, but not limited to, incompleteness of applications for registration, scientific and technical qualifications, and refunds. The Office charges fees for review of decisions by other officials in a variety of situations. See, for example, the fees charged in 37 CFR 1.17(h) for petitions under § 1.295 (for review of refusal to publish a statutory invention registration), petitions under § 1.377 (for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent), petitions under § 1.378(e) (for reconsideration of a decision on petition refusing to accept delayed payment of maintenance fee in an expired patent), and petitions under §§ 1.644(e) and 1.166(f) (in an interference and for requesting reconsideration of a decision on petition).

Comment 13: Two comments suggested that if a fee is charged under § 11.2 for filing a petition, it should be refunded if it is determined that the OED Director acted improperly.

Response: The suggestion has not been adopted. A petition seeks a determination that a decision should be reversed or modified. Such a

determination is obtained by the decision on petition. Under 35 U.S.C. 42(d), the Director is authorized to refund any fee paid in excess of the amount required, or that is paid by mistake. Upon receiving a decision, the petitioner who has paid the amount required is not entitled to a refund of the petition fee inasmuch as the fee was not paid by mistake or in excess. The fee, like other petition fees charged by the Office, is designed to support the agency's cost of the procedure. The petitioner obtained that which he or she sought, the determination.

Comment 14: One comment suggested that the third sentence of § 11.2(c) be deleted because it would discourage individuals who seek registration from filing legitimate appeals of an improper decision of an OED staff member, while not providing any assurance that a decision by the OED Director would be promptly decided to avoid interfering with rights of the petitioner or applicant for registration; and if kept, the phrase "other proceedings" be defined.

Response: The suggestion has been adopted in part. The third sentence has been amended to delete "including the timely filing of an application for registration," as being unnecessary. The third sentence now states "[t]he filing of a petition will not stay the period for taking other action which may be running, or stay other proceedings." The language in the third sentence of § 11.2(c), including "other proceedings," corresponds substantially to the language of the first sentence of 37 CFR 1.181(f). Inasmuch as the third sentence now corresponds substantially to the first section of § 1.181(f), it is believed that the third sentence will not discourage the filing of legitimate appeals. On the contrary, the third sentence encourages all applicants for registration to pursue legitimate actions that are not stayed by the filing of a petition.

Comment 15: One comment suggested that the fourth sentence of § 11.2(c) be revised to state that "[a]ny request for reconsideration of the OED Director's decision waives a right to appeal * * *."

Response: The suggestion is now moot since all reference to a request for reconsideration has been removed from § 11.2(c) as further discussed in response to Comment 16.

Comment 16: Two comments suggested that the fourth sentence of § 11.2(c) be deleted because it is punitive, unnecessary, denies due process, and encourages numerous unnecessary appeals to the USPTO Director because a practitioner dissatisfied with a decision of the OED

Director cannot reasonably risk loss of the right of appeal.

Response: The suggestion has been adopted in part. All reference to a request for reconsideration has been removed from § 11.2(c). The fourth sentence of § 11.2(c) has been amended to clarify that "[a] final decision by the OED Director may be reviewed in accordance with the provisions of" § 11.2(d).

Comment 17: Two comments suggested that the thirty-day time periods set in § 11.2 should be increased. One comment suggested that the Office, absent a compelling reason, consider setting a uniform period in §§ 11.2(d) and 11.2(e), for example, the two-month period found in 37 CFR 1.181, for filing a petition to any USPTO official seeking review of an action taken by the USPTO and seeking reconsideration. Another comment suggested that the time in § 11.2(d) be increased to ninety days and be extendable to one hundred twenty days to provide due process.

Response: The suggestion to adopt a uniform period has been adopted in part, but the suggestion that the period be extendable has not been adopted. Section 11.2(d) has been revised to refer to a sixty-day period for filing a petition from a final decision of the OED Director. Section 11.2(d) provides that "[a]ny petition not filed within sixty days from the mailing date of the final decision of the OED Director will be dismissed as untimely." A thirty-day period is provided for filing a request for reconsideration. The penultimate sentence of § 11.2(d) provides that a "request for reconsideration of the decision of the USPTO Director will be dismissed as untimely if not filed within thirty days from the mailing date of said decision." Section 11.2(e) has been deleted.

The sixty-day period is independent of the different lengths of the months, and provides consistency. The sixty-day period has been adopted wherever possible. Sixty days is substantially the same time period provided for in § 1.181, and thereby provides sufficient time to permit individuals and practitioners to determine whether they will seek review by petition and to prepare a petition.

A thirty-day period is adopted for requesting reconsideration of the USPTO Director's decision. Under 35 U.S.C. 32, the United States District Court for the District of Columbia reviews a decision refusing to recognize or suspending or excluding an individual upon petition filed within thirty days of the decision. Providing an individual the same thirty-day period to

seek reconsideration is consistent with the time available to seek review.

Comment 18: One comment suggested that the term "one OED Director" in § 11.2(e) be revised to read "former OED Director or an acting OED Director" to provide clarity.

Response: The suggestion is moot since proposed § 11.2(e) has not been adopted.

Comment 19: One comment suggested that inasmuch as § 11.3(a) does not define the phrase "OED Director's representative," reference be made to proposed § 11.40(b) and the phrase be defined in § 11.1.

Response: The suggestion has been adopted in part. Section 11.1 has been revised to include a definition of the OED Director's representative. It is unnecessary to reference § 11.40(b).

Comment 20: Five comments suggested that the provisions in proposed § 11.3(d) regarding qualified immunity not be adopted because the present rules provide sufficient safeguards, and the proposal may encourage Office employees to file frivolous complaints.

Response: The suggestion has been adopted. Some states provide by regulation the proposed safeguards. However, upon further reflection, it is believed that adequate safeguards are already available. Accordingly, the proposed § 11.3(d) has not been adopted.

Comment 21: One comment suggested several reasons why the USPTO Director should draw on persons who are not employees of the USPTO to serve on the Committee of Enrollment.

Response: The suggestion is now moot since § 11.4(a), which proposed the use of the Committee on Enrollment in "good moral character and reputation" determinations has been deleted from § 11.7. Determining the content of the examination is an inherently governmental function that cannot be assigned to non-governmental employees.

Comment 22: One comment suggested that in view of provisions in the North American Free Trade Agreement (NAFTA), Canadian citizens should be entitled to registration under the proposed §§ 11.6(a) or 11.6(b) in the same manner as United States citizens.

Response: The suggestion has not been adopted. The provisions of NAFTA provide for each Party to accord no less favorable treatment to another party than that it accords, in like circumstances, to its own service providers, including representation in patent applications. The NAFTA Services Chapter did envisage phaseout of nationality requirements for patent

attorneys and agents. However, neither Party has phased out the nationality requirement. Under the treaty, the only recourse for failure to do so is for other Parties to maintain their requirements. At this time, the USPTO, in accordance with the treaty, continues to maintain its requirements, and need not act unilaterally. See NAFTA Art. 1210.3 (no penalty for phaseout).

Comment 23: One comment suggested that any non-immigrant alien who is resident in the United States and who has passed the USPTO registration exam should be eligible to be registered and remain registered under 37 CFR 11.6(a) or (b) for as long as he or she remains resident in the United States.

Response: The suggestion has not been adopted. Pursuant to 35 U.S.C. 2(b)(2)(D), persons seeking registration must demonstrate that they are of good moral character and reputation. Empowering nonimmigrant aliens to engage in employment or training contrary to their status under the immigration laws would be inconsistent with the requirement that they possess good moral character. USPTO's registration should not create the occasion for violation of the immigration laws.

Comment 24: One comment suggested that § 11.6 be modified to strip away all citizenship requirements against a prospective patent attorney or agent to be registered—or for an existing patent attorney or agent to maintain his or her registration.

Response: The suggestion has not been adopted. Foreign patent attorneys and agents may be registered to practice before the Office in patent cases upon compliance with the provisions of § 11.6(c). Under § 11.6(c), registration is available if the patent office, where the foreign attorney or agent is registered and resides, grants substantially reciprocal privileges to practitioners registered to practice before the Office. At this time, only the Canadian Patent Office is recognized as providing substantially reciprocal privileges, and practitioners registered by both offices benefit from the reciprocal recognition. Practitioners in other countries may similarly benefit if the provisions of § 11.6(c) are satisfied.

Comment 25: One comment suggested that any individual registered under proposed § 11.6(c) should be required to pass the USPTO's registration examination since this section does not require familiarity with the USPTO's rules and procedures. The examination assures that all registered individuals are fully competent to act in patent matters before the USPTO. The commenter observed that in many

material respects, practice before the USPTO is considerably different from practice before the Canadian Patent Office (and other patent offices).

Response: The suggestion has not been adopted. Since about 1934, the USPTO and Canadian Patent Office have provided for reciprocal recognition of each other's registered attorneys and agents. Neither Office has required the attorneys and agents of the other Office to take and pass their registration examination. Moreover, the Canadian Patent Office does not require that persons registered to practice before the USPTO complete a period of service in the Canadian Patent Office or work in Canada in the area of Canadian patent law, or take the Canadian qualifying examination prior to registration.

Comment 26: One comment suggested that § 11.6(d) should also include public use proceedings under 37 CFR 1.292 since these proceedings, like interference proceedings, allow the taking of testimony which could be done by unregistered attorneys.

Response: The suggestion has not been adopted. The provisions of § 11.6(d) empower the Chief Administrative Patent Judge or Vice Chief Administrative Patent Judge of the Board of Patent Appeals and Interferences to determine whether and the circumstances under which an attorney who is not registered may take testimony for an interference under 35 U.S.C. 24, or under § 1.672. Unlike interference proceedings, the taking of testimony for a public use proceeding does not occur under the authority of the Board of Patent Appeals and Interferences. The USPTO Director may designate an appropriate official to conduct the public use proceeding, and the official may set the time for taking testimony. See 37 CFR 1.292. The OED Director, in consultation with the designated official, may authorize an unregistered attorney to take testimony for a public use proceeding. Accordingly, the authority cannot be placed on the Chief Administrative Patent Judge or Vice Chief Administrative Patent Judge of the Board of Patent Appeals and Interferences to administer the taking of depositions in public use proceedings.

Comment 27: One comment said that the Office admits to practice whole categories of lawyers who are not possessed of the required technical background. Although no category of lawyers was specified, the comment refers to practitioners registered under the current provisions of 37 CFR 10.6(c).

Response: All individuals admitted to practice must demonstrate that they possess the required scientific and

technical background. Persons seeking registration under § 11.6(c) must demonstrate that they possess the "qualifications stated in § 11.7," which includes the scientific and technical training requirements of § 11.7(a)(2)(ii). The same is required under current 37 CFR 10.6(c) and 10.7(a)(2)(ii).

Comment 28: One comment pointed out that although the commentary at 68 Fed. Reg. at 69446 stated that "[p]aragraph (a)(3) of § 11.7 would explicitly place the burden of proof of good moral character and reputation on the applicant, and provide 'clear and convincing' as the standard of proof," there is no paragraph (a)(3) in § 11.7 corresponding to this statement, and suggested that commentary conform with the rules.

Response: The comment is correct that § 11.7 does not include paragraph (a)(3). Section 11.7(b)(1)(iii) establishes the burden of proof and requires an individual to "provide satisfactory proof of possession of good moral character and reputation." Individuals seeking registration have been required by current 37 CFR 10.7(a)(2)(i), and its predecessor rules, to establish to the "satisfaction" of the Director that they are of good moral character and reputation. This is unchanged by the new rules and may be met in most instances by candid answers to all questions in the application for registration, and production of complete explanations and required documents in accordance with instructions included in the application. The Office plans to adopt an application form containing substantially the same questions that attorneys commonly answer in State bar applications. Thus, attorneys will submit substantially the same questionnaire for the State bar, and agents will fill out this questionnaire for the first time.

Comment 29: One comment suggested that the terms or phrases "a form supplied by the OED Director," "application for admission," "registration application," "complete application," "applications," "application," "application form," and "application form supplied by the OED Director" in § 11.7 be replaced by "application for registration" to provide clarity and consistency. It also suggested that the phrase "complete application" wherever it is used in the proposed rules be changed to be "complete application for registration" for consistency in terms.

Response: The suggestions have been adopted. Inasmuch as the terms or phrases "a form supplied by the OED Director," "application for admission," "registration application," "complete

application,” “application,” “applications,” “application form,” and “application form supplied by the OED Director” all reference the application for registration, and the components of a complete application for registration are set forth in the provisions of § 11.7(b), the terms and phrases have been replaced as suggested. The change also distinguishes the application for registration from patent and trademark applications when the term “application” is used in other rules.

Comment 30: One comment suggested that if registration is to continue and to fulfill the statutorily required qualifications of drafting patent applications and claims the OED must reinstate the essay question format that required demonstration of claim drafting skills as an integral part of the examination.

Response: The suggestion has not been adopted. Regardless of the efforts taken to establish standards for grading essay examinations, the process of grading essays remains subjective and subject to heightened dispute. Grading an essay examination is an expensive, time-consuming, resource-intensive program requiring diversion of the Office’s employees to provide a subjective evaluation. Grading essay examinations inevitably creates uncertainties and the potential for subjectivity in test answer evaluation. Processing and evaluating 6000 essays would require a massive commitment of USPTO resources without a concomitant benefit to the patent system. In contrast, both candidates for registration and the Office benefit from a multiple choice examination. A multiple choice examination is objectively graded. Moreover, multiple choice examinations, unlike essay examinations, cover a broader multitude of topics and elicit the candidate’s ability to distinguish correct from incorrect practices, policies, and procedures as well as addressing application and claim drafting. Multiple choice examinations may be administered more frequently than essay examinations, thereby increasing the opportunity for registration. The passing rate over the past five years has ranged between 37% and 72%, and the overall average passing rate was 53.6%. Despite the fact that in the same period prior examinations were made public and some questions were reused, the multiple choice examination has not become a means to become registered by memorization. On the contrary, the examination provides a reasonable means for safeguarding the public from incompetent representation.

Comment 31: One comment suggested that the questions on the proposed examination not be publicly available because if questions are reused, it would be possible to simply memorize the publicly available questions and answers, and the examination would not measure a person’s legal and technical competence. Another comment was to assure that the examination include questions covering 35 U.S.C. 101, 102, 103 and 112.

Response: The suggestions are noted. The comments in the proposed rules regarding § 1.21 stated that the data bank of questions and answers would be publicly available. However, the comments for § 11.7(e) said that it would be necessary to cease publication of the questions and the corresponding answers to reuse questions, and reduce pressure on the Office staff, as well as preserve the fairness of the test for later applicants. Any confusion resulting from these statements is regretted. The data bank of questions and answers will not be published or otherwise made available to the public. The registration examination will utilize a data bank of multiple choice questions that can be reused in subsequent examinations. Further, everyone practicing in patent cases before the Office must be familiar with the provisions of 35 U.S.C. 101, 102, 103 and 112. Accordingly, the examination will include questions covering these sections.

Comment 32: One comment suggested that there should be two or more questions that contain drawings in every examination to demonstrate that persons who pass the examination are competent to assist patent applicants by the ability to read and understand simple drawings, patents and technical publications. The comment suggested that an examination without drawings does not fulfill § 11.7(a)(4).

Response: The suggestion has not been adopted at this time. Presumably, the comment is referencing § 11.7(a)(2)(iii) as there is no § 11.7(a)(4) in the proposed rules. A drawing is not necessary to understand the claimed subject matter of every application as drawings are only required for applications “where necessary for the understanding of the subject matter sought to be patented.” 35 U.S.C. 113. Thus, inclusion of one or two drawings is not required for the examination to test whether the persons passing the examination are capable of rendering competent assistance to patent applicants. Nevertheless, consideration is being given to the development of questions having drawings for inclusion in future computer-delivered registration examinations.

Comment 33: One comment suggested that before admitting an individual to the registration examination, the individual should be required to complete a minimum period of apprenticeship or work involving the preparation and prosecution of patent applications before the USPTO under the supervision of one or more registered practitioners, that only practitioners registered for at least a certain number of years should be deemed competent to provide such supervision, and that compliance be verified by requiring a written declaration from the candidate and a registered practitioner supervisor.

Response: The suggestion has not been adopted. Between 1922 and 1934, registration applicants demonstrated their qualifications by submitting evidence of experience in patent work, such as patent prosecution. Non-attorneys were required to show three years of experience preparing and prosecuting patent applications under the guidance of a registered patent attorney. Attorneys were required to show actual work experience in patent prosecution, but the experience was not required to extend over any particular period. The showing of experience was ordinarily made by affidavit of the registered practitioner under whom the applicant had worked.

The procedure was administratively difficult due, in part, to the lack of any objective standards. It is understood that Congressional correspondence on behalf of individual applicants was voluminous. Commissioner Robertson, in a 1933 report termed the registration system based upon submission of affidavits as neither reliable nor satisfactory. Commissioner Robertson regarded the applicant’s showing of “several examples of his ability to prosecute a patent application” as “perfunctory” and “certainly not sufficient.” Additionally, the Commissioner cited the required affidavit as being “subject to the great weakness of friendship between attorneys and the applicant,” and that an “established attorney hesitates to refuse to make an affidavit as to competency of one of his employees who is ambitious and is striving to climb the ladder of success.” The practice was ended in 1934 with the introduction of the registration examination. It would be difficult to avoid the weaknesses in the apprenticeship system employed prior to 1934 if the Office were to adopt the proposed apprenticeship or work system, even when coupled with the registration examination.

Comment 34: Two comments suggested that the location of § 11.7(c) seems to be out of place in the sequence of other provisions. One suggested that it should be located just before the hearing provision in § 11.7(j).

Response: The suggestion has been adopted in part. The petition provision in proposed § 11.7(c) is redundant with the petition provision in § 11.2(c). Accordingly, the provision for petitions in proposed § 11.7(c) is unnecessary, and has been removed from this section, and retained in § 11.2(c). Sections 11.7(b)(2) and 11.8(c) each addressed the necessity for an individual seeking recognition to update his or her application for registration. These provisions have been merged and moved into § 11.7(c).

Comment 35: One comment suggested that § 11.7(d) be subtitled "Waiver of the registration examination for former Office employees" followed by subsections (1), (2), *etc.*, to immediately apprise the reader that the rule is directed to waiver of the registration examination for former PTO employees.

Response: The suggestion has been adopted. The revision would apprise individuals who never served in the Office that the provisions of § 11.7(d) do not pertain to them.

Comment 36: One comment suggested that the phrase "actively served" in §§ 11.7(d)(1), (d)(2), and (d)(3) be defined to resolve whether a person is a "patent examiner" who has or has not "actively served" in the examining corps. The metes and bounds of "actively served" are not immediately apparent. The commenter suggested that the definition would resolve whether the examination would be waived for a former examining technical center director who never served as a patent examiner, but served more than four years as group director at the time of separation from the examining corps, or for a special program examiner who was not a patent examiner, but who served more than four years in the examining corps at the time of separation from the Office.

Response: The suggestion has not been adopted. The practice of waiving the examination for persons who actively served in the patent examining corps is well established. "Actively served" is not a new term of art. It has been used in predecessor rules since at least 1959. See 37 CFR 10.7(b) (1985), and 37 CFR 1.341(c) (1959). "Actively served" is found only in §§ 11.7(d)(1) and (d)(2), and is used in its ordinary sense. §§ 11.7(d)(1) and (d)(2) apply to only former examiners who were serving in the patent examining corps at the time of their separation from service.

Obviously, a technical center group director who never was a patent examiner is not within the scope of §§ 11.7(d)(1) or (d)(2). Similarly, a special program examiner is not in the patent examining corps, and is not subject to the provisions of §§ 11.7(d)(1) or (d)(2). However, they would be among the "certain former Office employees" addressed in § 11.7(d)(3) for whom waiver of the examination and registration is available upon a satisfactory showing of the qualifying conditions set forth in § 11.7(d)(3).

Comment 37: One comment suggested that examining technical center directors, special program examiners, individuals who served as Assistant Commissioners for Patents, and administrative patent law judges at the Board of Patent Appeals and Interferences who have not "actively served" in the examining corps should be exempt from making a showing under § 11.7(d)(3) of possessing legal qualifications to render to patent applicants and others valuable service in the preparation and prosecution of patent applications. In contrast, three comments suggested that the proposal in § 11.7(d)(3) to exempt certain USPTO employees from the registration examination not be adopted. The latter comments opined that Office employees are only skilled in the application of rules concerning patentability, have not practiced patent law, and have no training how to properly describe and claim an invention. One of the latter comments suggested that the period of service in the Office be extended to five years to ensure broad experience.

Response: The suggestions have not been adopted. Many individuals in the foregoing positions supervise patent examiners and/or have authority to review and reverse decisions of patent examiners. These individuals have an opportunity to demonstrate possession of legal qualifications to render patent applicants and others valuable service in the preparation and prosecution of patent applications. Their positions in the Office have exposed them to proper description and claim practices, and given them the opportunity to evaluate the practices. Further, their positions and responsibilities enable them to readily find answers in the Manual of Patent Examining Procedure, rules and laws.

Mere qualification based on years of service in a position has not and should not be the standard for waiver of the examination. Accordingly, § 11.7(d)(3) requires that certain former Office employees show that they have exhibited a comprehensive knowledge of patent law equivalent to that shown

by passing the registration examination as a result of having been in a position of responsibility in the Office, that they are rated at least fully successful in each quality performance element of their performance plans, and are not under an oral warning regarding performance elements relating to such activities at the time of separation from the Office. Moreover, waiver of the examination is not automatic; it is in the discretion of the OED Director. For that purpose the second sentence in each of §§ 11.7(d)(1), 11.7(d)(2) and 11.7(d)(3) have been revised by replacing the term "would" with the term "may." Further, §§ 11.7(d)(1) and 11.7(d)(2) are revised to delete §§ 11.7(d)(1)(v) and 11.7(d)(2)(iv), which provided for waiver of the criteria of these sections upon a showing of good cause. Any individuals believing the requirements of §§ 11.7(d)(1) or 11.7(d)(2) should be waived may avail themselves of the provisions of § 11.3, which provides the standard for suspension of any requirement of the regulations in Part 11 that is not a requirement of statute.

Waiver of the examination is not automatic for former patent examiners. Former patent examiners have been required to take the examination where there is evidence that they did not possess the legal qualifications to render patent applicants and others valuable service in the preparation and prosecution of patent applications. See Legal01 decision in the FOIA Reading Room of the Office Web site at www.uspto.gov/web/offices/com/sol/foia/oed/legal/legal.htm. The same will apply to former Office employees in all positions. The public and Office must be assured that the examination is waived only in appropriate circumstances. Accordingly, § 11.7(d) requires comprehensive knowledge of patent law equivalent to that shown by passing the registration examination, that the individual be rated at least fully successful in each quality performance element of his or her performance plan for their position for the last two complete rating periods in the Office, and that the individual not be under an oral warning regarding performance elements relating to such activities at the time of separation from the Office.

Comment 38: One comment inquired whether administrative patent judges at the Board of Patent Appeals and Interferences would qualify for registration under § 11.7(d)(3)(i)(A) when they leave the Office and wish to be registered to practice, and suggested a section be added to § 11.7 that would cover Administrative Patent Judges.

Response: This suggestion has not been adopted. Upon leaving the Office

administrative patent judges may be registered under the provisions of § 11.7(d)(3)(i)(A).

Comment 39: Four comments suggested that § 11.7(e) not be adopted. Three of the comments suggested that the Office continue to permit substantive review and regrading of registration examinations. One comment suggested that perhaps applicants would be willing to entertain a slightly higher examination cost to maintain the current system. Another comment said that the proposed process could be punitive. Two comments said denial of regrades would prevent applicants from receiving due process if a question is incorrectly graded. In contrast, another comment said that while the elimination of regrades perhaps meets the minimal requirements to pass muster under law, the provisions of § 11.7(e) seem to miss the element of fundamental fairness embodied in the present system, that is usually the cornerstone of PTO rules and practice. One comment opined that § 11.7(e) is an effort to minimize the burden of USPTO personnel in reviewing examination results, and its effect may be to ignore and/or cover up errors in the examination or in the manner that the examination was graded, and inequitably transfer the burden of Office errors to registration applicants. One comment said the possibility of regrades being arbitrary and capricious could arise only if the examination was in a format other than multiple choice.

Response: The suggestions have not been adopted. Thirty states and the Northern Mariana Islands do not have any provision for regrading a bar examination, either prior or subsequent to the publication of the grades. Many of the states that do provide regrades provide so only in limited circumstances that will not arise in connection with a computerized system of delivering a multiple choice examination.

Regrades are not required where the examination is offered again, particularly as frequently as the USPTO plans. Applicants are afforded due process by the ability to sit for the examination again. *See, e.g., Lucero v. Ogden*, 718 F.2d 355 (10th Cir. 1983), *cert. denied*, 465 U.S. 1035, 79 L. Ed. 2d 706, 104 S.Ct. 1308 (1984) (“Courts have consistently refrained from entering the arena of regrading bar examinations when an unqualified right of reexamination exists.”).

Applicants failing the computerized registration examination will be able to retake the examination more frequently than those failing a State bar exam. Those who fail the examination can take

it again in thirty days. The benefit to applicants of providing frequent examinations outweighs the costs of eliminating regrades. It typically requires several months for regrade results to be released. An applicant who retakes and passes the examination may be registered in less time than it would have taken to obtain the regrade result.

Limiting access to the questions will not deny the unsuccessful applicant equal protection of the laws. The Multistate Bar Examination (MBE), like the registration examination, is a multiple choice examination. Questions on the MBE are reused in later years. Inasmuch as some of the questions appear in following years, the questions must be kept secret in order to preserve the fairness of the test for later applicants. *See Fields v. Kelly*, 986 F.2d 225, 227 (8th Cir. 1993). An unsuccessful candidate also is not deprived of a property right without due process by limiting access to the questions. The provision of § 11.7(e) of providing an opportunity to review the examination under supervision without taking notes affords the applicant a hearing at the administrative level. *Id.* at 228.

The USPTO will take precautions to ensure the accuracy of questions and answers. Office employees with expertise in various Office organizations, including the Office of the Solicitor, Patent Cooperation Treaty Legal Affairs, Office of Patent Legal Administration, and the Board of Patent Appeals and Interferences, draft the examination questions. All the questions are multiple choice, and each addresses the patent laws, rules and procedures as related in the Manual of Patent Examining Procedure. Different employees then vet the questions to ensure that each question has a correct answer. The employees vetting the questions are drawn from the editorial staff of the MPEP, the Office of the Solicitor, the Board of Patent Appeals and Interferences, and Quality Assurance Supervisory Primary Examiners.

The examination will be administered by a commercial entity with extensive experience in administering computerized examinations. An examination will include 100 questions. After an examination is administered, the statistical performance of each question in the group of 100 questions is reviewed and evaluated by testing experts before the question is included in the computation of each applicant's score. The questions will be reviewed psychometrically to identify questions that appear too difficult. Psychometric analysis involves comparison of the

results of each question in the top fifty percentile with the bottom fifty percentile of applicants, and shows the relative difficulty of each question. For example, as in the past, where a psychometrically significant number of applicants passing the examination select an incorrect answer to a question, the question is subject to content review by the Office. This corresponds to the internal review conducted by eleven states before publication of their bar exam results. This final statistical review is conducted to ensure that each question is accurate and psychometrically sound. Based upon the review, corrective action may be warranted, including withdrawal of the question. The questions are all objective-based, selected-response items. Some questions have been used in previous versions of the exam. Over time, each collection of 100 questions will include a number of previously used and reviewed questions, as well as new questions. The new questions will undergo the same psychometric analysis and review necessary to assure that the examination is fair.

Comment 40: One comment opined that adoption of § 11.7(e) would delay feedback from registration candidates, and eliminate both the income generated by the regrade process as well as the teaching tool provided by the regrades posted on the Office's Web site.

Response: The comment is not persuasive. The feedback received by the psychometric analysis provided by the commercial entity will be at least as fast as the feedback now received from the candidates. Psychometric analysis involves comparison of the results on each question of the top fifty percentile with the bottom fifty percentile of applicants, and shows the relative difficulty of each question. The Office will be able to review psychometric feedback received from the commercial entity as frequently as each week. Questions appearing to be too difficult are again reviewed after the examination to ascertain if there is a problem that needs to be addressed, as opposed to being a difficult question. For example, the question would be reviewed to ascertain if anything is misleading or incorrect in the body of the question or in the answer options, if it is readable, or if there is a change or inconsistency in the materials in the MPEP.

The regrade program is not a source of income to the Office. It is an expensive, time-consuming, resource-intensive program requiring diversion of the Office's employees who could be otherwise occupied deciding petitions, representing the Office in court, and examining patent applications.

Diversion of these resources to process and decide regrades does not optimize the USPTO's accomplishment of its statutory mission.

The value of posted regrade decisions as a teaching tool decreases with the passage of time since the patent laws, rules, and procedures change. A collection of regrade decisions can be found on the Office Web site in the Freedom of Information Reading Room. However, the continued posting of the questions has no relation to their value. Nothing on the Web site distinguishes between decisions addressing laws, rules and procedures that are currently followed and those no longer followed.

Comment 41: One comment opined that if the outsourced examination contract is limited to a sole source provider, the Office would be subject to further allegations of supporting arbitrary and capricious decisions regarding best answers, or other administrative interpretations within the USPTO.

Response: The comment is unpersuasive. The commercial entity, selected through full and open competition, does not create the questions or select the correct answers to the questions. As discussed above, the questions are developed within the Office. The examination will be delivered on computers at sites operated by the commercial entity. The commercial entity has extensive experience in administering examinations by computer. Every reasonable precaution has been taken to assure that the questions are not incorrectly graded. All questions and answers are carefully reviewed by the Office to assure that the answer selected by those in the Office vetting the question is the answer identified by the computer to accept as correct.

Comment 42: One comment opined that a "no error" grading of certification examination is unwarranted within the USPTO, and suggested that the Office, like others licensing professionals, including certified public accountants and professional engineers, utilize passing grade levels of approximately 70%.

Response: In referring to the "certification examination", it is presumed that the commentator is referring to the registration examination. It is also presumed that "no error" grading" refers to requiring candidates to correctly answer all questions. However, there is no proposal to require candidates to correctly answer all questions on the registration examination to pass the examination. The Office plans to continue to use a passing grade of 70%. The Office's

proposal to use a form of on-line self-correcting examination as one means of delivering continuing legal education remains subject to comment.

Comment 43: Four comments opposed the elimination of provisions for regrading examinations in § 11.7, at least to the extent that questions in the examination should continue to be subject to review for correctness, readability and fairness; the comment urged that the use of Office Model Answers assured only uniformity, that it is only reasonable and fair to require the Office to regrade/review questions that it has developed, and an applicant should have the right to appeal the result of their exam because, given the nature of patent practice, there will be occasions where there may be more than one correct answer.

Response: The suggestion to retain regrade is not adopted. The suggestion to allow limited access to the questions to review the questions is permitted to the extent provided in § 11.7(e). As discussed above, continuing the regrade program is not a reasonable expenditure of agency resources. Resources used to process regrades must be devoted to the processing of a backlog of over 500,000 patent applications, as well as petitions and appeals. Diversion of these resources to process and decide regrades is not the best use of Office resources. As also discussed above, questions will be psychometrically reviewed to identify those requiring additional, closer review. The psychometric analysis of answers will enable the Office to objectively identify questions that may have issues of correctness, readability and fairness, and to resolve the issues. Also, as in the past, corrective action is taken when warranted, such as by withdrawing a question. Moreover, elimination of regrades conforms to the practice in a majority of State bars.

Comment 44: One comment questioned keeping the questions and answers confidential and another suggested that it would constitute undue hardship to require that applicants travel to a location to review test results.

Response: The suggestion has not been adopted. The questions and answers will be maintained in confidence. This is consistent with confidentiality with which the Multistate Bar Examination is maintained. Maintaining the registration examination in confidence supports the integrity of the examination inasmuch as the questions can appear in following months or years. By maintaining confidentiality, no candidate has the advantage of memorizing questions and

answers. The multiple choice, computer-based examination will use questions selected from a large database of questions and answers that will not be publicly available. This will assure that passing the examination depends upon the ability to spot issues and determine a substantively sound result, rather than upon the ability to memorize questions and answers.

Comment 45: One comment, apparently based on the experience with regrades of two other persons, said that their failure was unjustified; that in one case the model answers to one of the essay questions was simply wrong; and in the other case the examination grader did not recognize the candidate's way of writing of the letter "t" (European candidate) and interpreted each instance of this letter as a misspelling.

Response: The comments pertain to results of examinations that were based on essay questions and answers, which have not been used for several years. As the examination is now multiple choice, the possibility of subjectivity in the grading of essay answers has been eliminated.

Comment 46: The summary of § 11.7(g) at 68 FR 69449 sought comments regarding two options for determining good moral character. Four comments favored the second option, which gives deference to State bar determinations for those applicants who are attorneys and reserves authority by the Office for further investigation in the event of a substantial discrepancy between information given to the State bar and information given to the Office.

Response: The suggestion has been adopted. To effectuate the procedure and policy, § 11.7(g)(1) is amended to provide that "[a]n individual who is an attorney shall submit a certified copy of each of his or her State bar applications and moral character determinations, if available." A new paragraph is added, designated § 11.7(g)(2)(ii), which provides "[t]he OED Director, in considering an application for registration by an attorney, may accept a State bar's character determination as meeting the requirements set forth in paragraph (g) of this section if, after review, the Office finds no substantial discrepancy between the information provided with his or her application for registration and the State bar application and moral character determination, provided that acceptance is not inconsistent with other rules and the requirements of 35 U.S.C. 2(b)(2)(D)."

Comment 47: One comment suggested that for agent practitioners, the Office should require a showing of good moral character consistent with that required

by a majority of State bars, that the Office should gather the same information as gathered by the majority of State bar applications, that the information should be included as part of the application for non-attorneys to practice before the Office, and that the Office use this information to conduct an investigation of moral character that is consistent with that made by the majority of State bars.

Response: No regulatory provision is necessary to implement the suggestion. Plans are under way to change the application for registration to gather the same essential information from non-attorney applicants as is gathered by a majority of State bar applications. Any necessary investigation will be conducted.

Comment 48: One comment suggested that attorneys and non-attorneys be subject to same procedures for determining good moral character and reputation by requiring an attorney denied admission to a bar for lack of good moral character and reputation to inform the Office in the application for registration, that the Office should request a certificate of good standing from every bar where the applicant is a member to confirm whether an attorney is a member in good standing, and that at least five character affidavits should be requested from each non-attorney applicant so the treatment of both types of applicants would be on somewhat an equal footing.

Response: As discussed above, plans are under way to change the application to gather from non-attorneys the same essential information as is obtained by a majority of State bar applications. Non-attorneys will have to disclose the same information. The application for registration already requests a certificate of good standing from the highest court of a state, and inquires whether the applicant has been suspended or disbarred from the practice of law on ethical grounds.

Comment 49: Two comments suggested that the first option, namely that the Office give deference to the State bars by permitting patent attorneys to submit a copy of their State bar application and moral character determination, would be preferable. One comment opined that the first option would relieve the Office of an apparently unnecessary burden unless experience has indicated that such an approach could cause problems of some undefined character. The other comment opined that there seems to be no need for the Office to establish new procedures and require new personnel to administer those procedures when the individual State bars already

perform the same task and it has not been shown that simply giving deference to a determination by the State bars would in any way permit Office registration of unqualified candidates.

Response: The suggestion has not been adopted. While accepting a State bar's determination on moral character without further review appears to be administratively attractive, experience indicates that the existence of substantial discrepancies can be problematic. A registration application might disclose information that would warrant a disciplinary proceeding. If the Office did not make provision to disallow registration of such an applicant, then following registration, it would be necessary to admit a practitioner and initiate a disciplinary action. Such a step would create a situation in which an attorney or agent whom the Office should have denied registration is representing clients until disciplinary proceedings are concluded. The disciplinary action requires devotion of additional personnel and expenditure of time and funds that would not otherwise be necessary in an enrollment proceeding to protect the public by suspending or excluding the individual. Moreover, the burden of proof shifts in a disciplinary action. An enrollment applicant has the burden of showing that he or she is of good moral character and reputation, whereas in a disciplinary action the OED Director must demonstrate a violation of the disciplinary rules. By following the first option, as opposed to the second, the Office fulfills the responsibility Congress placed on the Director to protect the public while not duplicating efforts already undertaken by the State bars.

Comment 50: One comment suggested that the good moral character determination for both attorneys and agents be administered by the Office in a manner similar to that utilized by the National Council of Examiners for Engineering and Surveying (NCEES), a non-profit organization, whose membership consists of engineering and land surveying licensing boards for all states and territories of the United States. These member boards represent all states and U.S. territorial jurisdictions. The suggestion is that the Office utilize the organizational model of NCEES by having member boards representing all State bar associations serve as a central body for maintaining registered practitioners' representation records comprising pertinent state and Office information. A practitioner's representation record would contain some combination of NCEES-type

records and State bar records including professional references, employment verifications, licensure information, and State bar applications, which are all determinants of moral character. The comment also suggested that the Office would share information with State bar associations regarding the conduct of "registered" trademark practitioners for enforcement of ethical standards at the state level.

Response: The suggestion has not been adopted. Congress placed on the Director of the USPTO the primary responsibility of determining who would be recognized to practice before the Office in patent cases and protecting the public. See 35 U.S.C. 2(b)(2)(D). The maintenance of the register of registered patent attorneys and agents is an inherently governmental function that cannot be performed by non-employees.

The Office already shares with State bars information regarding conduct of registered practitioners for enforcement of ethical standards at the state level. See 37 CFR 10.159. Although the Office does not register trademark practitioners, the Office does share with state bar associations information about the attorneys for enforcement of ethical standards at the State level. See 37 CFR 10.159.

It is understood that NCEES has a Records Program that serves as a verifying agency for the engineer or land surveyor who is seeking multiple-jurisdiction licensure. Through this program, an NCEES Council verifies and houses a record holder's file, which contains the college transcripts, licensure information, professional engineer or surveyor references, and employment verifications. The Office will consider whether and how it may communicate with NCEES to obtain records regarding applicants for registration.

Comment 51: One comment suggested that § 11.7(g), which permits the OED Director to list the names of proposed registrants on the Internet and make inquiry regarding the moral character of the individuals listed, not be adopted because it is a tremendous invasion of privacy; and further suggested that the Office should not be involved with regulating moral conduct when it does not concern matters before the Office, citing misdemeanor cases, such as shoplifting or drug dependency, as examples of matters with which the Office should not be concerned.

Response: The suggestion has not been adopted. The statute requires the Office to consider "reputation" of prospective attorneys and agents. In furtherance of that mandate, the Office has long published in the Official

Gazette the names of applicants for registration seeking comments regarding their qualifications. The Official Gazette is published on the Office's Web site on the Internet. The provision has been moved to § 11.8(a), and codifies that which has long occurred with the publication of the Official Gazette in paper and on the Internet.

The Office agrees that the Office should not be involved with regulating moral conduct when it does not concern matters before the Office. Nevertheless, there are instances where conduct not directly occurring in the representation of others before the Office has a nexus with the person's moral character for purposes of representing others; for example, drug dealing, and wire or insurance fraud. There are a number of cases where State bars have denied admission to persons whose conduct involves the conduct of the kind addressed by the commenter. See Moral 03 and Moral 04 decisions in the FOIA Reading Room of the Office Web site at www.uspto.gov/web/offices/com/sol/foia/oed/moral/moral.htm.

Comment 52: One comment suggested that § 11.7(g)(1), which requires an individual seeking recognition to "answer all questions," clarify the source of the questions.

Response: The suggestion has been adopted. The first sentence of § 11.7(g)(1) has been revised to state "answer[ing] all questions in the application for registration and request(s) for comments issued by OED."

Comment 53: One comment suggested deletion of the third sentence in proposed § 11.7(g)(3), which states, "If the individual seeking registration or recognition is an attorney, the individual is not entitled to a disciplinary proceeding under §§ 11.32–11.57 in lieu of good moral character proceedings under paragraphs (j) through (m) of this section." The commenter noted that only the OED Director can initiate a disciplinary proceeding if the Committee on Discipline finds probable cause, and it is not clear how an attorney who is not yet a registered practitioner would be subject to the disciplinary proceedings.

Response: The suggestion has been adopted. Section 11.7(g)(3) in the proposed rules has been renumbered § 11.7(g)(2)(i) in the final rules. The third sentence of proposed § 11.7(g)(3) has been omitted from the final rule.

Comment 54: One comment suggested that in the fourth sentence of § 11.7(g)(3), the phrase "OED Director" be changed to "Office of Enrollment and Discipline" since in all likelihood

questions will be sent through a staff attorney in OED.

Response: The suggestion has been adopted in part. The fourth sentence of proposed § 11.7(g)(3) is the third sentence of § 11.7(g)(2)(i) in the final rule. The reference to "OED Director" has been changed to "OED."

Comment 55: One comment suggested that a typographical error be corrected in the last sentence in § 11.7(h) before the beginning of subsection (1).

Response: The suggestion is now moot inasmuch as the last sentence of proposed § 11.7(h) has been deleted.

Comment 56: One comment inquired whether "good moral character" has the same meaning as "good moral character and reputation." Another comment suggested that the entire phrase "good moral character and reputation," which appears in 35 U.S.C. 2(b)(2)(D), be defined.

Response: The latter suggestion has been adopted. Under 35 U.S.C. 2(b)(2)(D), an individual is required to possess "good moral character and reputation." "Good moral character and reputation" is defined in § 11.1. Webster's Third New International Dictionary defines "reputation" as "the condition of being regarded as worthy or meritorious" (second version under the first definition), and is the source for the definition applied to reputation in the phrase "good moral character and reputation."

Comment 57: One comment opined that §§ 11.7(h)(3) and 11.7(h)(4) contain definitions of good moral character that do not appear to be within the scope of the definition in proposed § 11.7(h).

Response: Good moral character is now defined in § 11.1, and continues to mean the "possession of honesty and truthfulness, trustworthiness and reliability, and a professional commitment to the legal process and the administration of justice."

The definition of good moral character is inclusive of the conduct referenced in §§ 11.7(h)(3) and 11.7(h)(4). Section 11.7(h)(3) refers to "[a]n individual's lack of candor in disclosing facts bearing on or relevant to issues concerning good moral character and reputation when completing the application or any time thereafter." Lack of candor is within the ambit of "honesty and truthfulness, trustworthiness and reliability." Similarly, § 11.7(h)(4) refers to an "individual who has been disbarred or suspended from practice of law or other profession, or has resigned in lieu of a disciplinary proceeding * * *." Disbarment reflects a lack of the same traits required for good moral character and reputation.

Comment 58: One comment suggested that the Office define what it considers to be a violation of "moral turpitude" based on decisions in disciplinary proceedings before the Office and add the definition to § 11.1 inasmuch as "moral turpitude" has been open to interpretation by State bars and the disciplinary courts.

Response: The suggestion has not been adopted. The fact that State bars and courts of each State interpret their own State laws and identify those acts that constitute moral turpitude reflects a wide variety of differences among laws under which prosecution may be brought. Federal laws raise similar issues. A wide variety of fact patterns and underlying laws come before OED for consideration. Courts in the state where an applicant's conduct occurred may have issued a decision that an act does or does not constitute moral turpitude. There may be no decision regarding the act in that state. Courts in another state may have issued a decision based on the same or similar law regarding the same or similar conduct. It is unlikely that a rule could be derived from the decisions issued by the state courts that would be clear and unequivocal for all cases.

It seems preferable to allow applicants to make their presentations with respect to concrete circumstances and the particular laws under which the conviction occurred. An applicant may present such analyses of case law and past circumstances for consideration as the applicant deems best to characterize his or her situation. The Office will consider the applicant's presentation as well as relevant case law from the same and other jurisdictions. Such flexibility is most likely to lead to fair results.

Comment 59: One comment pointed out that although § 11.7(h)(1) includes a misdemeanor in the definition of "a crime," the definition of "crime" in § 11.1 does not include a misdemeanor. It is suggested that the rules be consistent in defining repeated terms.

Response: The suggestion has been adopted. The definition of "crime" in § 11.1 has been revised to include "any offense declared to be a felony or misdemeanor by Federal or State law in the jurisdiction where the act occurs."

Comment 60: One comment suggested that the phrase "convicted for said felony" in the third sentence of § 11.7(h)(1) should read "convicted of said felony."

Response: The suggestion has been adopted, and the sentences are restructured.

Comment 61: One comment suggested that the term "compelling proof" and the phrase "at a minimum a lengthy

period of exemplary conduct" in § 11.7(h)(1) be defined.

Response: The suggestion has been adopted in part. Section 11.7 has been revised to delete provisions calling for "compelling proof" and "clear and convincing" evidence of good moral character. Section 11.7 will require individuals to establish to the satisfaction of the OED Director that they are of good moral character. This standard is set forth in the current rules at 37 CFR 10.7(a)(2)(i). Thus, new § 11.7 will continue to apply the same standard whether the individual is a first time applicant, a disbarred attorney, or convicted felon. Applicants in the latter two instances must make a more substantial showing than a first time applicant with no such record because of the need to overcome evidence weighing against a finding of good moral character. Case law recognizes that following disbarment, the burden of proving good moral character is substantially more rigorous for an attorney seeking reinstatement, even in a different jurisdiction, than for a first time applicant. See *In re Menna*, 905 P.2d 944 (Cal. 1995). As in the case of reinstatement after disbarment, even a first time applicant has a heavy burden of showing good moral character after conviction of a felony. See *In re Gossage*, 5 P.3d 186 (Cal. 2000); *In re Dortch*, 486 S.E.2d 311 (W.Va. 1997).

Section 11.7(h)(1) has been revised to delete the provision for a lengthy period of exemplary conduct. Section 11.7(h)(1)(ii)(B) provides a two-year period following completion of the sentence, deferred adjudication, and period of probation or parole, whichever is later, for demonstrating good moral character and reputation.

Comment 62: One comment suggested that the term "provisions" in the first sentence of § 11.7(h)(1)(ii) be changed to "presumptions" since it appears that sections (A) and (B) thereunder are presumptions that will be made by the Office for an individual who has been convicted of a felony or misdemeanor and is seeking registration. The comment further suggested that in § 11.7(h)(1)(ii)(B), the expression "apply for or be registered" be amended to read "apply for registration or be registered" for grammatical correctness. It was still further suggested that since proposed paragraph (C) in § 11.7(h)(1)(ii) is not a presumption, it should be renumbered § (h)(iii) and that proposed § 11.7(h)(iii) be changed to § 11.7(h)(iv). Further, it was suggested that the expression "an application" in proposed § 11.7(h)(1)(iii) be changed to "a complete application for registration and the fee required by § 1.21(a)(1)(ii)."

Response: The suggestions have been adopted in part. In § 11.7(h)(1)(ii), the term "provisions" is changed to read "presumptions." In § 11.7(h)(1)(ii)(B), the expression "apply for or be registered" is revised to read "apply for registration." The numbering of paragraph (h)(1)(ii)(C) in § 11.7 is changed to paragraph (h)(1)(iii), the expression "an application" in proposed § 11.7(h)(1)(iii) is changed to "a complete application for registration and the fee required by § 1.21(a)(1)(ii) of this subchapter," and the numbering of § 11.7(h)(1)(iii) is changed to § 11.7(h)(1)(iv).

Comment 63: One comment suggested that the phrase "from drug or alcohol abuse or dependency" be added after "recovery" in § 11.7(h)(2) to clarify that recovery is from past, as opposed to present, drug or alcohol abuse or dependency.

Response: The suggestion has not been adopted. Section 11.7(h)(2) requires that an individual's record be reviewed as a whole to see if there is a drug or alcohol abuse or dependency issue. Section 11.7(h)(2) covers both past and present abuse and dependency issues. Accordingly, recovery should encompass past or present abuse and dependency issues.

Comment 64: One comment suggested that the procedure in § 11.7(h)(2) for holding an application for registration in abeyance for an applicant who has not established a record of recovery from drug or alcohol dependency, and manner by which an agreement for recovery from the dependency is "initiated" and confirmed can be clarified by ending the last sentence at "time," and adding the following sentence: "If the individual accepts the offer, the individual and the OED Director shall execute an agreement specifying (i) the period of time the application for registration will be held in abeyance, (ii) the conditions regarding the initiation and confirmation of treatment; and (iii) conditions that constitute evidence that recovery is confirmed."

Response: The suggestion is now moot inasmuch as the proposal for holding an application in abeyance while an individual complies with a recovery agreement is not adopted. The OED Director will provide the individual with an opportunity to withdraw his or her application in order to avoid its denial with attendant consequences under § 11.7(k). The individual will be notified that he or she may resume the application for registration or reapply when the individual is no longer abusing alcohol or drugs and can satisfactorily

demonstrate that he or she is complying with treatment and undergoing recovery. Under § 11.8(b), the individual may resume completion of the application for registration without taking the examination again if, within two years of mailing date of a notice of passing the examination, the individual files a satisfactory showing and complies with the provisions of § 11.8. An individual would reapply if a satisfactory showing is made outside the two-year period.

Comment 65: One comment suggested that § 11.7(h)(4) be expanded to include, in addition to a suspended or disbarred attorney, a non-attorney who, for instance, was disciplined by an institution or government authority for acts of misconduct involving moral character, e.g., students, stock brokers, CPA's, doctors. It was also suggested that § 11.7(h)(4) be revised to organize its provisions to separately and clearly identify individuals ineligible for registration and their respective ineligibility periods, the documents and fees to be filed for registration, as well as the presumptions that arise from the discipline or resignation and the available defenses.

Response: The suggestion has been adopted in part. The provisions of § 11.7(h)(4) have been expanded to include individuals who are disbarred, suspended or have resigned in lieu of disciplinary action in the legal profession as well as other professions. Further, the provisions have been extensively reorganized to more clearly identify the ineligible individuals, their respective ineligibility periods, and the fees and documents they must file. The burden of establishing reform and rehabilitation has been clarified to require a satisfactory showing, which is consistent with § 11.7(h)(1).

Comment 66: One comment suggested that to avoid confusion § 11.7(i) should not introduce the term "applicant" for the first time, and that "applicant" be changed to "individual."

Response: The suggestion has been adopted.

Comment 67: One comment suggested that in § 11.7(i)(2)(xii), the word "religious" replace the word "church" as a sponsor of "programs designed to provide social benefits or to ameliorate social problems," because "church" is limited to a body of Christians.

Response: The suggestion is now moot. Proposed § 11.7(i)(1) and the second and third sentences of proposed § 11.7(i)(2) have been deleted. The first sentence of proposed § 11.7(i)(2) has been renumbered § 11.7(i) in the final rules. Proposed § 11.7(i)(2)(viii) has been deleted, and the remaining

proposed §§ 11.7(i)(2)(i) through 11.7(i)(2)(xiii) have been renumbered §§ 11.7(i)(1) through 11.7(i)(12) in the final rules. Section 11.7(i)(11) in the final rules, which is based on proposed § 11.7(i)(2)(xii), is revised to eliminate any characterization, such as “church,” limiting the identity of sponsors.

Comment 68: One comment suggested that the language of the first two sentences of § 11.7(j) be revised as follows: If, after an investigation of moral character and reputation, the OED Director is of the opinion that the evidence of record does not establish that the individual seeking registration possesses good moral character and reputation, the OED Director shall issue to the individual a notice to show cause with reasons why the individual should not be registered. The notice shall give the individual the opportunity for a hearing before the Committee on Enrollment or withdrawing his or her application for registration.

Response: The suggestion has been adopted in part. As discussed with regard to § 11.4, the Office will no longer provide for a Committee on Enrollment, and the proposal to provide for oral enrollment hearings will not be adopted. The first two sentences have been replaced by the following provisions: “[i]f, following inquiry and consideration of the record, the OED Director is of the opinion that the individual seeking registration has not satisfactorily established that he or she presently possesses good moral character and reputation, the OED Director shall issue to the individual a notice to show cause why the individual’s application for registration should not be denied.” The “individual shall be given no less than ten days from the date of the notice to reply. The notice shall be given by certified mail at the address appearing on the application if the address is in the United States, and by any other reasonable means if the address is outside the United States.” Following “receipt of the individual’s response, or in the event of the absence of a response, if any, the OED Director shall consider the individual’s response and the record, and determine whether, in the OED Director’s opinion, the individual has sustained his or her burden of satisfactorily demonstrating that he or she presently possesses good moral character and reputation.”

Comment 69: One comment objected to the term “interrogated” in § 11.7(j)(1) as sounding like an inquisition, and suggested that the phrase “to be sworn and interrogated” be changed to read “to provide sworn testimony”; and suggested that “an adverse decision” is

indefinite and should be changed to “a decision denying recognition based on lack of good moral character and reputation.”

Response: The suggestion is moot since proposed § 11.7(j)(1) has not been adopted.

Comment 70: One comment pointed out that § 11.7(j)(2) needs to clarify that the “individual” is not the “particular person,” and suggested that the term “individual” be changed to read “individual seeking registration.”

Response: The suggestion is moot since proposed § 11.7(j)(2) has not been adopted.

Comment 71: One comment suggested that § 11.7(j)(2)(ii) refers to “rights” listed in “paragraph (j)(2)(A),” whereas § 11.7(j)(2)(i) should reference § 11.7(j)(2)(i), which is directed to “rules of procedure.”

Response: The suggestion is moot since proposed § 11.7(j)(2) has not been adopted.

Comment 72: One comment noted the use of the terms “recommendation” and “decision” in § 11.7(j)(3) is confusing and the need for consistency.

Response: The suggestion is moot since proposed § 11.7(j)(3) as well as proposed §§ 11.7(j)(4) and 11.7(j)(5) have not been adopted.

Comment 73: One comment suggested that the first sentence of § 11.8(a) be clarified to inform an individual who passed the examination that he or she has two years within which to complete registration by revising the sentence to read “an individual passing the registration examination who does not comply with the requirements of paragraph (b) of this section within two years after the date on a notice of passing the examination will be required to retake the registration examination.”

Response: The subject of the comment has been moved to § 11.8(c), which has been revised to reflect this comment.

Comment 74: One comment noted that § 11.8(b) requires that an attorney or agent must submit a certificate of good standing from the bar of the highest court of a state, whereas this would not be possible for agents.

Response: The suggestion has been adopted. Section 11.8(b) has been amended to require only attorneys to submit a certificate of good standing from the bar of the highest court of a state.

Comment 75: One comment suggested the requirement in § 11.8(b) that attorneys and agents must file a completed form to obtain the Office’s authorization to use a digital signature as a prerequisite for registration before the Office is premature and

unnecessary. The purpose for the digital signature is to facilitate electronic filing; however, electronic filing is, currently, not required. Moreover, it is not clear why a registration applicant must complete a form for a digital signature in order to be registered to practice before the Office, yet currently registered attorneys and agents have no such requirement, and a form for a digital signature can be completed when it is appropriate for that attorney or agent to do so.

Response: The suggestion has been adopted. Section 11.8(b) has been revised to remove the provision requiring “a completed form to obtain the Office’s authorization to use a digital signature.”

Comment 76: One comment suggested that § 11.6(c) appears to conflict with State bar rules, which do not have residency requirements, that the proposed rules do not appear to prohibit aliens who no longer reside in the United States to remain registered, and suggested that aliens no longer residing in the United States may continue to be registered and practice before the Office, that such continued work would not be in contravention of the immigration laws as they would not be working in the United States, and that a former permanent resident would be eligible for re-admission to the United States as a special immigrant.

Response: The suggestion has not been adopted. State law is not applicable. Under 5 U.S.C. 500(e), the Office is empowered to determine who may practice before it with respect to patent matters. New § 11.6(c) continues the practice followed under current 37 CFR 10.6(c). Under § 11.6(c), only aliens residing outside the United States satisfying the requirements of that rule may be registered. Such aliens must show that the patent office of the country where they reside and are registered practitioners grants substantial reciprocity to attorneys and agents admitted to practice before the USPTO in patent cases. At this time, only the Canadian Patent Office is considered to meet the requirements. Aliens in the United States, such as permanent residents, meeting the requirements of §§ 11.6(a) or 11.6(b) can be registered while they remain in the United States. The provisions of § 11.9(b) continue the practice of granting limited recognition to aliens in the United States not meeting the requirements of §§ 11.6(a) or 11.6(b), but who nevertheless show they are authorized to prepare and prosecute patent applications; they may be granted limited recognition under § 11.9(b) to practice while they remain in the

United States. Upon departing the United States, their authorization to practice ceases, and they can be registered only if the provisions of § 11.6(c) are satisfied.

Comment 77: One comment objected to the fifth sentence in § 11.9(b)(2), which states “[a]ny person admitted to the United States to be trained in patent law shall not be admitted to the registration examination or granted recognition until completion of that training.” The comment suggested that non-immigrant persons be registered.

Response: The suggestion has been adopted in part. Section 11.9(b) has been revised to provide limited recognition to a nonimmigrant alien who resides in the United States and fulfills the provisions of §§ 11.7(a) and (b) if the nonimmigrant alien is authorized to be employed or trained in the United States in the capacity of representing a patent applicant by preparing or prosecuting a patent application. The fifth sentence in proposed § 11.9(b) has not been adopted.

Comment 78: Three comments suggested it is unclear whether a nonpractitioner assistant would be violating proposed § 11.10(a) if he or she assisted a registered practitioner, for example, in the preparation of a patent application, even under the direction and guidance of a registered practitioner. The question is raised in part, because proposed § 11.5(b) does not define “prosecution.”

Response: This suggestion has not been adopted. Section 11.10(a) adds nothing that was not already present in the current 37 CFR 10.10(a). No action has been taken regarding proposed § 11.5(b). It is the registered practitioner, as opposed to the non-practitioner, who is responsible for compliance with § 11.10(a). It is common practice for nonpractitioner assistants to work under the direct supervision of a registered practitioner in conducting many of the activities associated with practice before the Office, and nothing in § 11.10(a) prohibits this activity so long as the registered practitioner supervises and remains responsible for the assistant’s work.

Comment 79: One comment suggested that the subtitle of § 11.10(b), “Undertaking for registration by former Office employees” is not clear since the phrase “undertaking for registration” would have no meaning to a person unfamiliar with OED practice.

Response: The suggestion has been adopted. The subtitle of § 11.10(b) has been revised to read “Post employment agreement of former Office employees.”

Comment 80: One comment suggested that the first sentence of § 11.10(b), addressing restrictions on registration for current employees, be divided from the second and subsequent sentences, which address restrictions on practice by former employees.

Response: The suggestion has been adopted in part. The first sentence has been deleted. The first sentence prohibited registration of current employees who had not been previously registered. However, current employees who pass the registration examination are permitted to be registered, but their names are endorsed on the register as inactive. They are not permitted to practice in patent cases while they remain employed by the Office.

Comment 81: One comment objected to §§ 11.10(b)(1) and 11.10(b)(2) as intertwining rules of conduct with commentary.

Response: This suggestion has been adopted. The use of examples was proposed to clarify the rules. However, the examples have been removed. It is planned to expand the discussion of restrictions on former examiners in the Manual of Patent Examining Procedure (MPEP). Appropriate examples will be included in the MPEP.

Comment 82: Three comments suggested that §§ 11.10(b)(1) and (b)(2) be revised to change “United States” to “Office” to remove ambiguity. One comment pointed out that all communications to the Office are in some sense to the United States. One comment pointed out that the “or’s” in § 11.10(b)(1) result in the rule proscribing preparing someone’s tax return or helping to write a letter to their congressman. A fourth comment suggested that it is unnecessary to reference United States or the Office inasmuch as the United States would be a party with respect to the prosecution of a patent application since the Office would be regarded as one party and that the United States has a direct and substantial interest since it is granting the monopoly for a patent or trademark.

Response: These comments have been accepted. Only representation before the Office is within the scope of this part, and the relevant provisions have been revised to more clearly reflect this.

Comment 83: One comment suggested that it is unnecessary to include limitations in § 11.10(b)(1) beyond that it can be construed merely to require that former patent examiners cannot act as a representative or intend to bring influence, including “conduct occurring behind the scenes,” for a period of two years in a “particular matter in which he or she personally and substantially

participated as an employee of the Office.”

Response: This suggestion has not been adopted. The substantive restrictions are set forth in §§ 11.10(b)(1) and 11.10(b)(2). Section 11.10(b)(3) provides definitions for use in interpreting the substantive provisions, but does not impose additional restrictions.

Comment 84: One comment suggested that §§ 11.10(b)(1) and 11.10(b)(2), like 18 U.S.C. 207, not separate appearance and influence portions of the statute into two separate and distinct prohibitions.

Response: These sections have been rewritten to remove the references to communications with the intent to influence, which are already included within the term “representation” as defined by § 11.10(3)(i).

Comment 85: Three comments suggested that the items listed in §§ 11.10(b)(1)(i)–(iii) and 11.10(b)(2)(i)–(iii), should not be in the alternative as proposed, but should be linked with “and” so as to include all three conditions. Another comment suggested §§ 11.10(b)(1) and 11.10(b)(2) appear to present grammar and syntax problems that jam too many thoughts into a single sentence, and do not work.

Response: The suggestion has been adopted. These provisions have been rewritten for clarity.

Comment 86: One comment observed that unlike §§ 11.10(b)(1) and 11.10(b)(2), 18 U.S.C. 207 does not specify that appearance is “formal and informal” or that communications are “oral or written,” and that the sections be revised to conform with the statute.

Response: The suggestion has been adopted in part. Section 11.10(b) does not implement or interpret 18 U.S.C. 207. The references to appearances and communications have been removed from §§ 11.10(b)(1) and 11.10(b)(2) as discussed in response to Comment 84.

Comment 87: One comment said the interchanging use in § 11.10(b) of “individual,” “any person” and “employee” is somewhat confusing.

Response: The suggestion has not been adopted. The Office does not believe that the use of these terms renders § 11.10(b) ambiguous, or that using different or fewer terms would increase its clarity.

Comment 88: One comment said 18 U.S.C. 207 provides for a one-year restriction while § 11.10(b)(2) provides for a two-year restriction, and suggested that the period in the proposed rule be commensurate with the statutory period.

Response: The suggestion has not been adopted. While § 11.10(b)(2) does

not implement 18 U.S.C. 207, its two-year restriction parallels that of the statute.

Comment 89: One comment suggested that § 11.11(a) be revised to change “state bar” to “State bar” in the rules to conform to the definition of “State” in §§ 11.1 and 11.7(h)(4).

Response: The suggestion has been adopted. The lower case “s” in “state” or “states” has been changed to an upper case “S” wherever found in § 11.11(a). Also, the designation of the first paragraph of § 11.11 as paragraph (a) has been deleted inasmuch as proposed §§ 11.11(b) through 11.11(f) remain under consideration, and no paragraph following the first paragraph has been adopted.

Comment 90: One comment suggested that the second sentence of § 11.11(a) does not parse.

Response: The suggestion has been adopted. Although the language of the sentence is the same as found in 37 CFR 10.11(a), the language has been updated and revised.

Comment 91: One comment suggested that the Office should be able to maintain at least three e-mail addresses for practitioners (e.g., home, work, and “permanent” e-mail addresses), and send electronic communication to all of these addresses to maximize the chance that a message is actually received by the intended practitioner. The cost of doing this is virtually nothing.

Response: The suggestion has been adopted in part. OED will maintain a list of up to three e-mail addresses for a registered practitioner and § 11.11 has been revised to provide for up to three e-mail addresses where the practitioner receives e-mail. Practitioners will be responsible for updating OED with each and every change of e-mail address. OED plans to use all the addresses furnished by a practitioner to communicate with him or her.

Comment 92: One comment suggested that the following groups of alien attorneys and agents should be exempt from the provisions of proposed §§ 11.6(a) and 11.6(b), respectively: (1) aliens who have visas acceptable for practice before the Office under current Rule 10.6, whether or not they have yet entered the United States; and (2) aliens in the midst of the visa application process for practice before the Office acceptable under current Rule 10.6. Requiring aliens in these groups to obtain new visas is unduly burdensome and impractical if the visas are sufficient under the current rule.

Response: The suggestion has not been adopted. As discussed in response to Comment 23, empowering nonimmigrant aliens to engage in

employment or training contrary to the immigration laws and their reliance on registration to conduct themselves in that manner would be inconsistent with the requirement that they possess good moral character. Regulations prohibit some nonimmigrant aliens from engaging in employment. *See, e.g.,* 8 CFR 214.1(e). A nonimmigrant alien in the United States may not engage in any employment unless the person has been accorded a nonimmigrant classification which authorizes employment or the person has been granted permission to engage in employment in accordance with regulations found in Title 8 of the Code of Federal Regulations. A nonimmigrant alien who is permitted to engage in employment may engage only in such employment as has been authorized. Any unauthorized employment by a nonimmigrant alien constitutes a failure to maintain status. *See, e.g.,* 8 CFR 214.1(e). The Bureau of Citizenship and Immigration Services (BCIS) determines which nonimmigrant alien is authorized to be employed while in the United States, the capacity in which they are employed, and who may employ them. The Office has no authority to license nonimmigrant aliens to engage in employment, or to be employed by an employer beyond that which the BCIS has sanctioned.

Comment 93: One comment suggested the phrase “such registration is not inconsistent with the terms upon which the alien was admitted to, and resides in, the United States,” in §§ 11.6(a) and 11.6(b), be defined to enable practitioners and the general public to understand what constitutes registration not inconsistent with the terms upon which the alien was admitted to and is residing in the United States.

Response: The suggestion has not been adopted. The admission of aliens to the United States and their authority to be employed is dependent upon regulations promulgated by BCIS and its predecessor, the Immigration and Naturalization Service. Those regulations change with some frequency. It would not be prudent for the Office to adopt definitions that would be rendered inconsistent with the regulations adopted by the BCIS. Case law provides guidance in defining the meaning of the phrase, which has been in use since 1985.

Comment 94: One comment suggested that the circumstances under which an unregistered attorney may take testimony in an interference should be elaborated upon either in § 11.6(d) or in the commentary.

Response: The suggestion has not been adopted. Section 11.6(d) permits the Chief Administrative Patent Judge or

Vice Chief Administrative Patent Judge of the Board of Patent Appeals and Interferences to determine whether and the circumstances under which an attorney who is not registered may take testimony for an interference under 35 U.S.C. 24, or under 37 CFR 1.672. The circumstances and necessity for setting forth circumstances can differ between interferences. Accordingly, it is inappropriate to attempt to provide in the rule or commentary an exhaustive listing of circumstances. The Judges will exercise their discretion in determining the circumstances under which the testimony will be taken.

Comment 95: One comment suggested that the registration procedure sequence in § 11.7 contains redundancy regarding scientific and technical training in §§ 11.7(b)(1) and 11.7(b)(3); that the procedure contained in § 11.7(b)(4) for retaking the examination upon failure should be a separate provision; that the qualifications considered are found in § 11.7(b)(i) as well as §§ 11.7(b)(2) to (b)(4) and (b)(6); that the requirement to keep an application updated be separated from § 11.7(b)(2); and it is necessary to clarify why an individual reapplying more than one-year after failing the registration examination must again submit satisfactory proof of his or her scientific training.

Response: The suggestion for reorganizing the regulation is adopted in part. The provisions in proposed § 11.7(b)(3) have been merged into § 11.7(b)(1)(i)(C), and proposed § 11.7(b)(5) has been revised and renumbered § 11.7(b)(3). Proposed §§ 11.7(b)(4) and 11.7(b)(6) has been moved into § 11.7(b)(1) and renumbered §§ 11.7(b)(1)(ii) and 11.7(b)(1)(iii), respectively. The reference to § 11.7(b)(3) in §§ 11.7(d)(1), 11.7(d)(2) and 11.7(d)(3) is revised to read as § 11.7(b)(1)(i)(C). The procedure for retaking the examination upon notice of failure has been moved to § 11.7(b)(1)(ii). It is believed to be preferable to consolidate in one paragraph the provisions for passing the examination and for retaking the examination upon failure. The qualification provisions in § 11.7(b)(1) are not repeated in renumbered §§ 11.7(b)(2) and 11.7(b)(3). The latter sections address two matters not covered in § 11.7(b)(1); the consequence of failing to file a complete application, and the necessity for an individual, who does not reapply until more than one year after the mailing date of the notice of failure, to again comply with § 11.7(b)(1).

Individuals reapplying more than one year after failing the registration examination must again submit

satisfactory proof of their scientific training because their files will have been archived. The Office does not have facilities for on-site long-term storage of files of individuals who fail the examination. Ordering files from archived records could subject applicants to unanticipated delays and does not promote efficiency. While there are plans for scanning the files, resources are limited at this time, and until scanning of all files is available, files older than one year must be archived.

Comment 96: One comment suggested that all practitioners be treated the same with respect to fitness, moral character, and legal competence by: requiring all practitioners to have minimum technical and legal experience if they are to practice before the USPTO; resolve the allegedly inherent “unauthorized practice of law” by agents by eliminating the agent status altogether, allowing agent status for those only who complete the patent academy with four or more years’ experience; change the name “agent” to “non-legal agent” or other name in order to protect the public and to put the public on notice that they are not working with an attorney; notify agents that they cannot practice law and further limit their scope of practice to preparing and filing applications, not prosecution of patent applications; and require a registered attorney to sign work done by an agent, and/or require each agent to practice under the supervision of registered attorney.

Response: The suggestion has not been adopted. A requirement for minimum legal experience is subject to the same weakness discussed in response to Comment 33. The Office is neither eliminating registration of patent agents, nor requiring that they practice under the supervision of registered attorneys. This rule making has not addressed any change of status for patent agents. Patent agents serve a variety of purposes, including helping make access to the patent system widely available. The Office will continue to register individuals as patent agents. Issues affecting unauthorized practice of law will be addressed in the rules and commentary pertaining to § 11.5(b). The period for comment on the proposed rules for § 11.5(b) has been extended until June 11, 2004.

Comment 97: One comment suggested that to benefit from patent harmonization, the registration examination given under § 11.7 should place less emphasis on formalities and test each candidate’s ability to identify inventions, draft applications to global standards, respond to substantive

official actions from all major patent offices, advise on the interpretation of patents and their validity, and advise clients on the global patent positions arising in the commonly encountered business situations.

Response: The suggestion has not been adopted. Under 35 U.S.C. 2(b)(2)(D), registration is for the recognition of agents and attorneys representing applicants or other parties before the Office. Accordingly, the examination is properly confined to aspects of drafting applications to be filed in the Office as well as applications filed under the Patent Cooperation Treaty, and responding to substantive official actions from the Office. A practitioner advising clients on their global patent positions arising in the commonly encountered business situations should have the legal knowledge, skill, thoroughness and preparation *reasonably* necessary to provide the advice. Practitioners without the background should either prepare adequately to provide competent advice or refer the client to other practitioners prepared to provide the advice.

Comment 98: One comment referred to the comments on page 69448 of the Notice which indicated that the registration examination will be “open book” in the sense that the MPEP would be accessible on-line in the computerized examination. The comment suggested that individuals be permitted to utilize a paper copy of the MPEP because prohibiting paper resource material will, to some extent, adversely impact some individuals.

Response: The suggestion has not been adopted. Prior to taking an examination, a tutorial will be provided by the commercial entity to all individuals to show them how to operate the computer, download and search the MPEP, and navigate among the questions. Further, we are in the process of developing a tutorial that will be available either on or through a link from the Office Web site to show how the MPEP will be accessed and navigated during the examination. Use of a computer on this examination, as on tests for driver’s licenses, is readily learned.

Comment 99: One comment inquired why candidates are no longer allowed to bring in their notes and/or reference books to the exam, and suggested that they be able to bring notes used in preparing for the exam, an indexed notebook on patent law material, and a hard copy of the MPEP that has been tabbed to the candidate’s liking.

Response: The suggestion has not been adopted inasmuch as the rules do

not contain a provision addressing the issue. The answer to each examination question is located in the MPEP. The MPEP will be available on the computer and will download quickly. Thus, the source of all correct answers will be made available to all candidates. Additional materials are unnecessary.

Rule Making Considerations

Regulatory Flexibility Act

The Regulatory Flexibility Act, 5 U.S.C. 601 *et seq*, requires agencies to consider the economic impact of regulatory actions on small entities when finalizing a rule making. If the rule is expected to have a significant economic impact on a substantial number of small entities, the agency must prepare a final regulatory flexibility analysis (FRFA). However, section 605(b) of the Regulatory Flexibility Act allows the head of an agency to prepare a certification statement in lieu of a FRFA if the rule making is not expected to have a significant economic impact on a substantial number of small entities. The Deputy General Counsel for General Law¹ of the USPTO hereby certifies to the Chief Counsel for Advocacy, Small Business Administration, that this final rule will not have a significant economic impact on a substantial number of small entities. The factual basis for the certification is as follows:

Factual Basis for Certification

The primary purpose of the rule package is to codify enrollment procedures implementing computerized delivery of the registration examination and to provide procedures for processing registration applications that are more efficient and flexible for the Office and applicants. At the outset, it should be noted that the only persons affected by the fee increases set forth in this rule package are those individuals seeking enrollment to become registered patent practitioners or those individuals seeking registration or reinstatement after certain events led to their disbarment or suspension on ethical

¹ By statute, the USPTO may establish regulations, not inconsistent with law, which “govern the recognition and conduct of agents, attorneys or other persons representing applicants or other parties before the Office, and may require them, before being recognized as representatives of applicants or other persons, to show that they are of good moral character and reputation and are possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office[.]” 35 U.S.C. 2(b)(2)(D). The Under Secretary of Commerce for Intellectual Property and Director of the USPTO has delegated his authority to the USPTO’s Deputy General Counsel For General Law. See AAO217–2 (2001).

grounds, denial of registration on grounds of lack of good moral character and reputation, or conviction of a felony or crime involving moral turpitude or breach of fiduciary duty.

Both attorneys and non-attorneys can take the registration examination. Inasmuch as the income of attorneys and non-attorneys differs, the discussion contained in this Regulatory Flexibility Act certification considers the respective average incomes of both types of potential applicants. USPTO statistics indicate that over the course of the last four examinations (during 2002 and 2003), on average approximately 19% of applicants are licensed attorneys at the time they seek registration to take the enrollment examination. For April 2002, October 2002, April 2003, and October 2003, the number of applicants indicating they were attorneys was 26%, 16%, 17% and 16%, respectively. Conversely, the USPTO estimates that approximately 81% of applicants are not licensed attorneys at the time they seek registration to take the enrollment examination.

The Office does not require applicants to identify their affiliation with a particular type of employer (law firm, business, solo practitioner, *etc.*) at the time of application. Furthermore, the Office does not require applicants to categorize their employer as a large or small entity. In a customer satisfaction survey answered by 1,651 patent attorneys in 2002, the Office collected data indicating that approximately 63.5% of patent attorneys are affiliated with a law firm. The Office believes that the affiliation of attorney-applicants does not dramatically differ from the affiliation of patent attorneys who responded to the survey. Thus, estimates for attorney income are based on the compensation attorneys receive in law firms.

Only individuals, not legal entities, may take the registration examination. This is true even if the individual is a lawyer having a solo practice. The fees associated with the application and examination may be paid by the individual applicant or by his or her employer. Employers, some of which may qualify as small entities, are not required to pay the fees. Whether the individual or the business (small or large) bears the cost of the fees is at the option of the individual and the employer. Inasmuch as the rules do not require the business (large or small) to bear the cost of the fees, the Small Business Administration's size standards for offices of lawyers are not applicable. Thus, the Office has considered, but rejected, measuring the

impact of this rule package on law firms that may qualify as small entities.

Computerized Examination Fee

Section 1.21(a)(1)(ii)(A) establishes a \$200 registration examination fee for test administration by a commercial entity. Individuals wishing to take the computerized examination administered by a commercial entity will pay the entity an additional fee of \$150. The combined cost of \$350 (\$200 + \$150) is only \$40 more than the \$310 fee previously charged by the Office. The \$40 increase provides applicants with additional conveniences, such as the ability to take the examination in one of over 400 locations throughout the country, thereby reducing travel and associated expenses. The examination is expected to be offered by the commercial entity five days a week, excluding holidays. Consequently, applicants will have more opportunities to take the examination, rather than waiting for the Office to administer the examination only twice per year.

Substantial Number of Persons Affected

Of approximately 5,897 applications filed in Fiscal Year 2003 for recognition to practice before the USPTO in patent cases, approximately 5,338 individuals were admitted to take the examination. Based upon the admission rate (approximately 90%), the USPTO estimates that approximately the same number of individuals will be affected by the change to Sec. 1.21.

Not a Significant Economic Impact

The \$40 increase in fees to take the registration examination is insignificant. The previously charged \$310 fee has not been increased since 1997. In comparison to examination fees charged by various state bars, the \$350 total fee is quite low. *See, e.g.,* Comprehensive Guide to Bar Admissions 2004, Chart XI, Bar Admissions Fees (National Conference of Bar Examiners and American Bar Association Section of Legal Education and Admissions to the Bar), also available on the Internet at www.ncbex.org/pub.htm. All state bars charge bar examination fees. For non-attorneys, the state bar examination fee ranges from \$100 to \$1,450, and for attorneys, the fee ranges from \$100 to \$2,500. The USPTO examination fee is less than or equal to the fee charged by 34 states for non-attorneys, and less than or equal to the fee charged by 33 states for attorneys.

As previously noted, the Office estimates that approximately 19% of applicants seeking enrollment are attorneys licensed to practice in a U.S. jurisdiction. Of this 19% of applicants,

approximately 63.5% of these attorneys work in law firms. The average total compensation of attorneys in a law firm ranges from \$102,841 to \$299,391, depending on whether the attorney is of-counsel, a staff attorney, an associate attorney, a non-equity partner or an equity partner/shareholder. *See, e.g.,* The 2003 Survey of Law Firm Economics, "National Individual Status Codes Total Compensation," p. 169. The relevant "Total Compensation" chart is also available at www.altmanweil.com/pdf/2003SLFESample.pdf. Thus, the \$40 increase in total fees to take the registration examination is insignificant to attorneys, in comparison with their average annual income.

For those applicants who are not licensed attorneys at the time they register to take the examination, it is noted that the average income for males in the United States is about \$58,000. For females in the United States, the average income is \$41,000. *See* "Income In The United States: 2002 Current Population Reports Consumer Income" issued by the U.S. Census Bureau, page 9, www.census.gov/prod/2003pubs/p60-221.pdf. It is equally likely that an applicant for registration is a male or female. Accordingly, it is assumed that the average income of an applicant is \$49,500, the average of the incomes of males and females in the United States. In comparison to the average income of a citizen of the United States, the \$40 increase in total fees to take the computerized examination is not significant.

In addition, the Office is giving applicants the option of taking the examination by computer or by paper (discussed below). Applicants may choose the lower priced option of taking the computerized examination, rather than choosing to take the higher priced paper examination. There is no substantive difference between the computerized and paper versions of the examination. Applicants who take the computerized examination will not be required to purchase computers, software or computer programs.

Paper Examination Fee

Section 1.21(a)(1)(ii)(B) establishes a \$450 registration examination fee for test administration by the Office. For the past several decades, the Office of Personnel Management administered a paper examination for the Office, which cost applicants \$310. The Office must charge the \$450 fee in order to recoup the higher costs of administering the paper examination. The examination provided for under Section 1.21(a)(1)(ii)(B) will be given on paper only once per year at or relatively near

the USPTO headquarters office in Alexandria, Virginia.

Not a Substantial Number of Small Entities

The Office does not believe that a substantial number of applicants will request the Office to deliver the paper examination to them because the administration and grading of such a paper examination will cost more and will take more time to process. Release of results will take much longer than in the case of the electronic examination. As a result, applicants who choose the paper examination will not be eligible for registration as quickly as those passing the computerized examination.

Based on the 5,897 applications received in Fiscal Year 2003, the Office estimates that the change to Sec. 1.21 would impact few (about 2%) registration applicants. It is estimated that approximately 130 individuals will request that the Office administer a paper examination to them and grade it annually. The Office estimates that approximately one half of DC metro area applicants may wish to take the paper examination.

In Fiscal Year 2003, the number of local applicants taking the examination in each of two administrations was 235 and 238, respectively. In Fiscal Year 2002, the number of local applicants taking the examination in each of two administrations was 285 and 252, respectively. In Fiscal Year 2001, the number of local applicants taking the examination in each of two administrations was 270 and 285, respectively. Assuming that one half of the applicants would want to take the paper examination, the Office estimates approximately 130 applicants will desire to take the paper examination provided for under this final rule section. As such, the rule does not affect a substantial number of individuals.

Not a Significant Economic Impact

The \$450 fee is an increase of only \$140 over the fee previously charged to take the examination.

As previously stated, approximately 19% of applicants are attorneys, and approximately 63.5% of those attorneys earn an average annual income ranging from \$102,841 to \$299,391. Approximately 81% of applicants are non-attorneys, with an average annual income of \$49,500. This fee increase will not have a significant economic impact on attorneys or non-attorneys.

In addition, the paper examination is provided as an alternative to the computerized examination. In this way, the USPTO affords applicants a voluntary, additional option for those

who desire to take the examination on paper. Applicants are not required, under this rule making or any other statute or regulation, to take the paper examination. Taking the more expensive paper examination is solely at the discretion of the applicant.

In fact, the commercial entity providing the computerized examination will be able to accommodate those applicants who require a reasonable accommodation. Thus, there is no reason that an applicant would be required to take the paper examination administered by the Office, which costs more than the computerized examination given by a commercial entity.

Petition Fee

Section 1.21(a)(5)(i) establishes a fee of \$130 for petitions to the Director of the Office of Enrollment and Discipline.

Not a Substantial Number of Small Entities

The Office initially estimated that there would be approximately 69 petitions impacted by this fee. In Fiscal Years 2002 and 2003, there were, respectively, 67 and 57 petitions to the Director of Enrollment and Discipline filed by registration applicants. The Office is revising its estimate to be 62 petitions, the average of the number of the petitions filed in Fiscal Years 2002 and 2003. Based on 5,897 applications received in Fiscal Year 2003, the Office estimates that the change to Sec. 1.21 would impact few (about 0.1%) of registration applicants. As such, the rule does not affect a substantial number of individuals.

Not a Significant Economic Impact

Adoption of the \$130 fee will not have a significant economic impact on a substantial number of small entities. The average total compensation of lawyers in a law firm ranges from \$102,841 to \$299,391. The average annual income of an individual applicant (non-attorney) is \$49,500.

Application/Reinstatement Fee

Section 1.21(a)(10) imposes a \$1600 fee on application by applicants for recognition or registration after disbarment or suspension on ethical grounds, or resignation pending disciplinary proceedings in any other jurisdiction; on application by a person for recognition or registration who is asserting rehabilitation from prior conduct that resulted in an adverse decision in the Office regarding the person's moral character; on application by a person for recognition or registration after being convicted of a

felony or crime involving moral turpitude or breach of fiduciary duty; and on petition for reinstatement by a person excluded or suspended on ethical grounds, or excluded on consent from practice before the Office.

Not a Substantial Number of Small Entities

The Office initially estimated that there would be approximately two such applications filed annually. In Fiscal Year 2003, one application for registration and three petitions for reinstatement were filed with the Director of Enrollment and Discipline for applicants that would fall within the scope of this rule. In view of the figures for Fiscal Year 2003, the Office is revising its estimate to four applications filed annually that would be affected by the provision in Sec. 1.21(a)(10). Based on the 5,897 applications received in Fiscal Year 2003, the Office estimates that the change to Sec. 1.21 would impact very few (0.06%) applicants. As such, the rule does not affect a substantial number of individuals.

Not a Significant Economic Impact

The \$1,600 fee is an increase of \$1,560 over the \$40 application fee the affected individuals paid under the previous rule, 37 CFR 1.21(a)(1)(i). This fee increase is necessary in order for the Office to cover a portion of the expenses associated with investigating and resolving these types of petitions, based on average hours spent by the OED Director, staff attorneys, paralegals, and clericals.

The adoption of the \$1,600 fee will not have a significant economic impact on a substantial number of small entities. For any given fiscal year, the persons who will be required to pay this fee will be attorneys an estimated 75% of the time. Thus, in a majority of the situations where a practitioner must pay this fee, the average total compensation of attorneys in a law firm ranges from \$102,841 to \$299,391. In the remaining situations, the average income of the person who will be required to pay this fee is approximately \$49,500. The \$1540 increase does not have a significant economic impact on either attorneys or non-attorneys.

Regulatory Flexibility Act Comments and Responses

The Office received five comments, three from individuals and two from an intellectual property law organization, regarding the impact of these rules upon small entities. With regard to comments about rules promulgated in this final rule making, the comments are summarized and addressed below.

Comment: One comment suggested that the Office is proposing “to registration institute [sic] fees based on assumptions of how much people make.” The comment further states, “I am always disturbed that these fee schedules consider only full time and inactive attorneys. There is no consideration given for part time attorneys.”

Response: Inasmuch as the comment references “institut[ing]” fees, the comment is construed as referring to the annual fees (not previously charged) that were included in the notice of proposed rule making. The instant rules change only the fees associated with becoming registered to practice. Accordingly, changing the fees to become registered would not involve “institut[ing]” fees for full time, part time, or inactive attorneys who are already registered to practice. The fees considered in the instant final rules do not address the annual fees. Thus, the Office will address the impact of annual fees upon part time attorneys when the final rule adopting annual fees is promulgated.

Comment: One comment suggested improvements in licensing (including preceptorship) in order to assist small businesses and inventors who are not able to judge the qualifications of registered practitioners. The comment opines that the proposed rules allow incompetent practitioners to prey on small businesses and individuals and will increase the cost of obtaining meaningful patent protection for small businesses because of the loss of rights due to drafting inadequate specifications and claims.

Response: The registration requirements set forth in this rule package operate to protect small entities, independent inventors and large entities alike. These rules allow for a practitioner to provide legal services after certain registration requirements are met. Small entities may confidently rely upon the Office’s registration of practitioners to the same extent that larger entities do. Thus, the rules do not increase the cost of obtaining meaningful patent protection for either small or large businesses.

The registration rules ensure that all recognized practitioners meet the same scientific and technical competency requirements to practice before the USPTO. Of the 5,897 applicants for registration in Fiscal Year 2003, approximately 5,338 were admitted to the registration examination. About another 120 applicants are registered to practice pursuant to the last sentence of 37 CFR 10.7(b) or reciprocally registered as foreign patent agents pursuant to 37

CFR 10.6(c). All registration requirements are substantially uniform. All applicants have met the scientific and training qualifications found in the regulations. Accordingly, all individuals registered to practice before the Office are believed to possess the requisite level of competence.

The Office does not require preceptorships (a period of training). As discussed in response to Comment 33, *supra*, Commissioner Robertson, in a 1933 report, termed the registration system upon submission of affidavits of attorneys as neither reliable nor satisfactory. Commissioner Robertson regarded the applicant’s showing of “several examples of his ability to prosecute a patent application” as “perfunctory” and “certainly not sufficient.” Additionally, the Commissioner cited the required affidavit as being “subject to the great weakness of friendship between attorneys and the applicant,” and that an “established attorney hesitates to refuse to make an affidavit as to competency of one of his employees who is ambitious and is striving to climb the ladder of success.” The practice was ended in 1934. The suggested preceptorship, being subject to the same weaknesses as the affidavit practice rejected by Commissioner Robertson, is not satisfactory for the same reasons.

Comment: One comment said the proposed rules governing recognition of individuals to practice should be carefully considered with regard to adverse consequences on smaller businesses. The comment also suggested that the proposed rules were not well thought-out concerning whether they make access to the USPTO more difficult and costly for small businesses. The comment also alleges that the proposed rules unnecessarily disrupt the prosecution of a significant number of patent applications currently before the USPTO.

Response: The rules adopted in this rule making package do not make access to the Office more difficult or costly for small entities. The rules do not affect the Office fees for patent or trademark applications. In fact, qualifying small entities pay reduced fees to obtain patents under the current fee structure.

The fees in this final rule package affect only individuals seeking registration as attorneys or agents. Only individuals, not businesses or other legal entities, may be registered to practice before the Office in patent cases. To the extent that an individual may qualify as a small entity, the economic impact of the fee increases in this rule package is not significant. For

example, as discussed in detail above, for the vast majority of individuals seeking registration, the increase in the fee associated with admission to the examination is only \$40. The increase in fees simply does not have a significant economic impact on individuals who may qualify as small entities.

Comment: Two letters from an intellectual property law organization complained, in general, about whether the USPTO has complied with the requirements of the Regulatory Flexibility Act in certifying that the notice of proposed rule making will not have a significant economic impact on a substantial number of small entities.

Response: As noted above, the USPTO has complied with all requirements of the Regulatory Flexibility Act by certifying that this rule making will not have a significant economic impact on a substantial number of small entities. The Office certified, in the Notice of Proposed Rule Making, that an initial Regulatory Flexibility Act analysis was not required because the notice of proposed rule making did not have a significant economic impact on a substantial number of small entities. *See* 68 F.R. 69442, 69510–69511 (Dec. 12, 2003). With respect to this final rule making, for a more detailed explanation of the certification, please see the Factual Basis set forth in this section, above.

None of these comments change the USPTO’s assessment that the preparation of a Regulatory Flexibility Act analysis is not required. This rule making will not have a significant economic impact on a substantial number of small entities.

Executive Order 13132: This notice of rule making does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (August 4, 1999).

Executive Order 12866: This notice of rule making has been determined to be not significant for purposes of Executive Order 12866 (September 30, 1993).

Paperwork Reduction Act: This notice of rule making involves information collection requirements which are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 *et seq.*). This rule introduces new information requirements and fees into collection 0651–0012. Additional information collection activities involved in this notice of rule making are covered under OMB control number 0651–0017.

The title, description, and respondent description of the currently approved information collection 0651–0012 are

shown below with an estimate of the annual reporting burdens.

Included in this estimate is the time for reviewing instructions, gathering and maintaining the data needed, and completing and reviewing the collection of information. The principal impact of the changes in this notice of rule making is to applicants seeking registration as patent attorneys and agents.

OMB Number: 0651-0012.

Title: Admittance to Practice and Roster of Registered Patent Attorneys and Agents Admitted to Practice Before the United States Patent and Trademark Office (USPTO).

Form Numbers: PTO-158, PTO158A, PTO-275, PTO-107A, PTO-1209.

Affected Public: Individuals or households, business or other for-profit, Federal Government, and State, local or tribal governments.

Estimated Number of Respondents: 24,024.

Estimated Time Per Response: The USPTO estimates that it takes the public 30 minutes to complete either an application for registration to practice before the USPTO, or an application for a foreign resident to practice before the USPTO and, depending upon the complexity of the situation, to gather, prepare and submit the application. It is estimated to take 20 minutes to complete undertakings under 37 CFR 10.10(b); 10 minutes to complete data sheets; 5 minutes to complete the oath or affirmation; 45 minutes to complete the petition for waiver of regulations; and 90 minutes to complete the written request for reconsideration of disapproval notice of application and the petition for reinstatement to practice. These times include time to gather the necessary information, prepare and submit the forms and requirements in this collection.

Estimated Total Annual Burden Hours: 6,078.

Needs and Uses: The public uses the forms in this collection to apply for the examination for registration, to ensure that all of the necessary information is provided to the USPTO and to request inclusion on the Register of Patent Attorneys and Agents.

Comments have been invited on: (1) Whether the collection of information is necessary for proper performance of the functions of the agency; (2) the accuracy of the agency's estimate of the burden; (3) ways to enhance the quality, utility, and clarity of the information to be collected; and (4) ways to minimize the burden of the collection of information to respondents.

Interested persons were requested to send comments regarding these information collections, including

suggestions for reducing this burden, to Harry I. Moatz, Director of Enrollment and Discipline, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450, or to the Office of Information and Regulatory Affairs of OMB, New Executive Office Building, 725 17th Street, NW., Room 10235, Washington, DC 20503, Attention: Desk Officer for the United States Patent and Trademark Office.

Notwithstanding any other provision of law, no person is required to respond to nor shall a person be subject to a penalty for failure to comply with a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid OMB control number.

List of Subjects

37 CFR Part 1

Administrative practice and procedure, Courts, Freedom of information, Inventions and patents, Reporting and recordkeeping requirements, Small businesses.

37 CFR Part 10

Administrative practice and procedure, Inventions and patents, Lawyers, Reporting and recordkeeping requirements.

37 CFR Part 11

Administrative practice and procedure, Inventions and patents, Lawyers, Reporting and recordkeeping requirements.

■ For the reasons set forth in the preamble, the United States Patent and Trademark Office is amending 37 CFR parts 1, 10, and 11 as follows:

PART 1—RULES OF PRACTICE IN PATENT CASES

■ 1. The authority citation for 37 CFR part 1 continues to read as follows:

Authority: 35 U.S.C. 2(b)(2), unless otherwise noted.

■ 2. Section 1.1 is amended by revising paragraph (a) introductory text and by adding paragraph (a)(5) to read as follows:

§ 1.1 Addresses for non-trademark correspondence with the United States Patent and Trademark Office.

(a) *In general.* Except as provided in paragraphs (a)(3)(i), (a)(3)(ii), and (d)(1) of this section, all correspondence intended for the United States Patent and Trademark Office must be addressed to either "Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria,

Virginia 22313-1450" or to specific areas within the Office as set out in paragraphs (a)(1), and (a)(3)(iii) of this section. When appropriate, correspondence should also be marked for the attention of a particular office or individual.

* * * * *

(5) *Office of Enrollment and Discipline correspondence.* All correspondence directed to the Office of Enrollment and Discipline concerning enrollment, registration, and investigation matters should be addressed to Mail Stop OED, Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450.

* * * * *

■ 3. Section 1.21 is amended by revising paragraph (a) to read as follows:

§ 1.21 Miscellaneous fees and charges.

* * * * *

(a) Registration of attorneys and agents:

(1) For admission to examination for registration to practice:

(i) Application Fee (non-refundable)—\$40.00

(ii) Registration examination fee

(A) For test administration by commercial entity—\$200.00

(B) For test administration by the USPTO—\$450.00

(2) On registration to practice or grant of limited recognition under § 11.9(b) or (c)—\$100.00

(3) For reinstatement to practice—\$40.00

(4) For certificate of good standing as an attorney or agent—\$10.00

(i) Suitable for framing—\$20.00

(ii) [Reserved]

(5) For review of decision:

(i) By the Director of Enrollment and Discipline under § 11.2(c)—\$130.00

(ii) Of the Director of Enrollment and Discipline under § 11.2(d)—\$130.00

(6)–(9) [Reserved]

(10) On application by a person for recognition or registration after disbarment or suspension on ethical grounds, or resignation pending disciplinary proceedings in any other jurisdiction; on application by a person for recognition or registration who is asserting rehabilitation from prior conduct that resulted in an adverse decision in the Office regarding the person's moral character; and on application by a person for recognition or registration after being convicted of a felony or crime involving moral turpitude or breach of fiduciary duty; on petition for reinstatement by a person excluded or suspended on ethical

grounds, or excluded on consent from practice before the Office.—\$1,600.00

* * * * *

■ 4. Section 1.31 is revised to read as follows:

§ 1.31 Applicants may be represented by a registered attorney or agent.

An applicant for patent may file and prosecute his or her own case, or he or she may be represented by a registered attorney, registered agent, or other individual authorized to practice before the United States Patent and Trademark Office in patent matters. *See* §§ 11.6 and 11.9 of this subchapter. The United States Patent and Trademark Office cannot aid in the selection of a registered attorney or agent.

■ 5. Section 1.33, paragraph (c), is revised to read as follows:

§ 1.33 Correspondence respecting patent applications, reexamination proceedings, and other proceedings.

* * * * *

(c) All notices, official letters, and other communications for the patent owner or owners in a reexamination proceeding will be directed to the attorney or agent of record (*See* § 1.34(b)) in the patent file at the address listed on the register of patent attorneys and agents maintained pursuant to §§ 11.5 and 11.11 of this subchapter or, if no attorney or agent is of record, to the patent owner or owners at the address or addresses of record.

* * * * *

■ 6. Section 1.455 is amended by revising the first sentence of paragraph (a) to read as follows:

§ 1.455 Representation in international applications.

(a) Applicants of international applications may be represented by attorneys or agents registered to practice before the United States Patent and Trademark Office or by an applicant appointed as a common representative (PCT Art. 49, Rules 4.8 and 90 and § 11.9). * * *

* * * * *

PART 10—REPRESENTATION OF OTHERS BEFORE THE PATENT AND TRADEMARK OFFICE

■ 7. The authority citation for 37 CFR Part 10 continues to read as follows:

Authority: 5 U.S.C. 500; 15 U.S.C. 1123; 35 U.S.C. 2, 6, 32, 41.

§ 10.2 [Removed]

■ 8. Section 10.2 is removed and reserved.

§ 10.3 [Removed]

■ 9. Section 10.3 is removed and reserved.

§ 10.5 [Removed]

■ 10. Section 10.5 is removed and reserved.

§ 10.6 [Removed]

■ 11. Section 10.6 is removed and reserved.

§ 10.7 [Removed]

■ 12. Section 10.7 is removed and reserved.

§ 10.8 [Removed]

■ 13. Section 10.8 is removed and reserved.

§ 10.9 [Removed]

■ 14. Section 10.9 is removed and reserved.

§ 10.10 [Removed]

■ 15. Section 10.10 is removed and reserved.

■ 16. Section 10.11 is revised to read as follows:

§ 10.11 Removing names from the register.

A letter may be addressed to any individual on the register, at the address of which separate notice was last received by the Director, for the purpose of ascertaining whether such individual desires to remain on the register. The name of any individual failing to reply and give any information requested by the Director within a time limit specified will be removed from the register and the names of individuals so removed will be published in the Official Gazette. The name of any individual so removed may be reinstated on the register as may be appropriate and upon payment of the fee set forth in § 1.21(a)(3) of this subchapter.

■ 17. Part 11 is added as follows:

PART 11—REPRESENTATION OF OTHERS BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE

Subpart A—General Provisions

General Information

Sec.

11.1 Definitions.

11.2 Director of the Office of Enrollment and Discipline.

11.3 Suspension of rules.

Subpart B—Recognition To Practice Before the USPTO

Patents, Trademarks, and Other Non-Patent Law

11.4 [Reserved]

11.5 Register of attorneys and agents in patent matters.

11.6 Registration of attorneys and agents.

11.7 Requirements for registration.

11.8 Oath and registration fee.

11.9 Limited recognition in patent matters.

11.10 Restrictions on practice in patent matters.

11.11 Notification.

Authority: 5 U.S.C. 500, 15 U.S.C. 1123, 35 U.S.C. 2(b)(2)(D), 32.

Subpart A—General Provisions

General Information

§ 11.1 Definitions.

This part governs solely the practice of patent, trademark, and other law before the United States Patent and Trademark Office. Nothing in this part shall be construed to preempt the authority of each State to regulate the practice of law, except to the extent necessary for the United States Patent and Trademark Office to accomplish its Federal objectives. Unless otherwise clear from the context, the following definitions apply to this part:

Attorney or lawyer means an individual who is a member in good standing of the highest court of any State, including an individual who is in good standing of the highest court of one State and under an order of any court or Federal agency suspending, enjoining, restraining, disbaring or otherwise restricting the attorney from practice before the bar of another State or Federal agency. A *non-lawyer* means a person or entity who is not an attorney or lawyer.

Belief or believes means that the person involved actually supposed the fact in question to be true. A person's belief may be inferred from circumstances.

Conviction or convicted means any confession to a crime; a verdict or judgment finding a person guilty of a crime; any entered plea, including *nolo contendere* or Alford plea, to a crime; or receipt of deferred adjudication (whether judgment or sentence has been entered or not) for an accused or pled crime.

Crime means any offense declared to be a felony or misdemeanor by Federal or State law in the jurisdiction where the act occurs.

Data sheet means a form used to collect the name, address, and telephone information from individuals recognized to practice before the Office in patent matters.

Fiscal year means the time period from October 1st through the ensuing September 30th.

Fraud or fraudulent means conduct having a purpose to deceive and not merely negligent misrepresentation or

failure to apprise another of relevant information.

Good moral character and reputation means the possession of honesty and truthfulness, trustworthiness and reliability, and a professional commitment to the legal process and the administration of justice, as well as the condition of being regarded as possessing such qualities.

Knowingly, known, or knows means actual knowledge of the fact in question. A person's knowledge may be inferred from circumstances.

Matter means any litigation, administrative proceeding, lobbying activity, application, claim, investigation, controversy, arrest, charge, accusation, contract, negotiation, estate or family relations practice issue, request for a ruling or other determination, or any other matter covered by the conflict of interest rules of the appropriate Government entity.

OED means the Office of Enrollment and Discipline.

OED Director means the Director of the Office of Enrollment and Discipline.

OED Director's representatives means attorneys within the USPTO Office of General Counsel who act as representatives of the OED Director.

Office means the United States Patent and Trademark Office.

Practitioner means:

(1) An attorney or agent registered to practice before the Office in patent matters,

(2) An individual authorized under 5 U.S.C. 500(b) or otherwise as provided by § 10.14(b), (c), and (e) of this subchapter, to practice before the Office in trademark matters or other non-patent matters, or

(3) An individual authorized to practice before the Office in a patent case or matters under § 11.9(a) or (b).

Proceeding before the Office means an application for patent, an application for reissue, a reexamination, a protest, a public use matter, an *inter partes* patent matter, correction of a patent, correction of inventorship, an application to register a trademark, an *inter partes* trademark matter, an appeal, a petition, and any other matter that is pending before the Office.

Reasonable or reasonably when used in relation to conduct by a practitioner means the conduct of a reasonably prudent and competent practitioner.

Registration means registration to practice before the Office in patent proceedings.

Roster means a list of individuals who have been registered as either a patent attorney or patent agent.

Significant evidence of rehabilitation means satisfactory evidence that is

significantly more probable than not that there will be no recurrence in the foreseeable future of the practitioner's prior disability or addiction.

State means any of the 50 states of the United States of America, the District of Columbia, and other territories and possessions of the United States of America.

Substantial when used in reference to degree or extent means a material matter of clear and weighty importance.

Suspend or suspension means a temporary debarring from practice before the Office or other jurisdiction.

United States means the United States of America, and the territories and possessions the United States of America.

USPTO Director means the Director of the United States Patent and Trademark Office, or an employee of the Office delegated authority to act for the Director of the United States Patent and Trademark Office in matters arising under this part.

§ 11.2 Director of the Office of Enrollment and Discipline.

(a) *Appointment.* The USPTO Director shall appoint a Director of the Office of Enrollment and Discipline (OED Director). In the event of the absence of the OED Director or a vacancy in the office of the OED Director, or in the event that the OED Director recuses himself or herself from a case, the USPTO Director may designate an employee of the Office to serve as acting OED Director. The OED Director and any acting OED Director shall be an active member in good standing of the bar of a State.

(b) *Duties.* The OED Director shall:

(1) Supervise staff as may be necessary for the performance of the OED Director's duties.

(2) Receive and act upon applications for registration, prepare and grade the examination provided for in § 11.7(b), maintain the register provided for in § 11.5, and perform such other duties in connection with enrollment and recognition of attorneys and agents as may be necessary.

(3) Conduct investigations into the moral character and reputation of any individual seeking to be registered as an attorney or agent, or of any individual seeking limited recognition, deny registration or recognition of individuals failing to demonstrate possession of good moral character and reputation, and perform such other duties in connection with enrollment matters and investigations as may be necessary.

(4) The Director shall conduct investigations into possible violations by practitioners of Disciplinary Rules,

with the consent of the Committee on Discipline initiate disciplinary proceedings under § 10.132(b) of this subchapter, and perform such other duties in connection with investigations and disciplinary proceedings as may be necessary.

(5)–(7) [Reserved]

(c) *Petition to OED Director.* Any petition from any action or requirement of the staff of OED reporting to the OED Director shall be taken to the OED Director. Any such petition not filed within sixty days from the mailing date of the action or notice from which relief is requested will be dismissed as untimely. The filing of a petition will not stay the period for taking other action which may be running, or stay other proceedings. A final decision by the OED Director may be reviewed in accordance with the provisions of paragraph (d) of this section.

(d) *Review of OED Director's decision.* An individual dissatisfied with a final decision of the OED Director, except for a decision dismissing a complaint or closing an investigation, may seek review of the decision upon petition to the USPTO Director accompanied by payment of the fee set forth in § 1.21(a)(5)(ii) of this subchapter. A decision dismissing a complaint or closing an investigation is not subject to review by petition. Any petition not filed within sixty days from the mailing date of the final decision of the OED Director will be dismissed as untimely. Any petition shall be limited to the facts of record. Briefs or memoranda, if any, in support of the petition shall accompany or be embodied therein. The USPTO Director in deciding the petition will consider no new evidence. Copies of documents already of record before the OED Director need not be submitted with the petition. No oral hearing on the petition will be held except when considered necessary by the USPTO Director. Any request for reconsideration of the decision of the USPTO Director will be dismissed as untimely if not filed within thirty days after the mailing date of said decision. If any request for reconsideration is filed, the decision on reconsideration shall be the final agency action.

§ 11.3 Suspension of rules.

In an extraordinary situation, when justice requires, any requirement of the regulations of this part which is not a requirement of statute may be suspended or waived by the USPTO Director or the designee of the USPTO Director, *sua sponte* or on petition of any party, including the OED Director or the OED Director's representative,

subject to such other requirements as may be imposed.

Subpart B—Recognition To Practice Before the USPTO

Patents, Trademarks, and Other Non-Patent Law

§ 11.4 [Reserved]

§ 11.5 Register of attorneys and agents in patent matters.

A register of attorneys and agents is kept in the Office on which are entered the names of all individuals recognized as entitled to represent applicants having prospective or immediate business before the Office in the preparation and prosecution of patent applications. Registration in the Office under the provisions of this part shall entitle the individuals so registered to practice before the Office only in patent matters.

§ 11.6 Registration of attorneys and agents.

(a) *Attorneys.* Any citizen of the United States who is an attorney and who fulfills the requirements of this part may be registered as a patent attorney to practice before the Office. When appropriate, any alien who is an attorney, who lawfully resides in the United States, and who fulfills the requirements of this part may be registered as a patent attorney to practice before the Office, provided that such registration is not inconsistent with the terms upon which the alien was admitted to, and resides in, the United States and further provided that the alien may remain registered only:

(1) If the alien continues to lawfully reside in the United States and registration does not become inconsistent with the terms upon which the alien continues to lawfully reside in the United States, or

(2) If the alien ceases to reside in the United States, the alien is qualified to be registered under paragraph (c) of this section. *See also* § 11.9(b).

(b) *Agents.* Any citizen of the United States who is not an attorney, and who fulfills the requirements of this part may be registered as a patent agent to practice before the Office. When appropriate, any alien who is not an attorney, who lawfully resides in the United States, and who fulfills the requirements of this part may be registered as a patent agent to practice before the Office, provided that such registration is not inconsistent with the terms upon which the alien was admitted to, and resides in, the United States, and further provided that the alien may remain registered only:

(1) If the alien continues to lawfully reside in the United States and registration does not become inconsistent with the terms upon which the alien continues to lawfully reside in the United States or

(2) If the alien ceases to reside in the United States, the alien is qualified to be registered under paragraph (c) of this section. *See also* § 11.9(b).

(c) *Foreigners.* Any foreigner not a resident of the United States who shall file proof to the satisfaction of the OED Director that he or she is registered and in good standing before the patent office of the country in which he or she resides and practices, and who is possessed of the qualifications stated in § 11.7, may be registered as a patent agent to practice before the Office for the limited purpose of presenting and prosecuting patent applications of applicants located in such country, provided that the patent office of such country allows substantially reciprocal privileges to those admitted to practice before the Office. Registration as a patent agent under this paragraph shall continue only during the period that the conditions specified in this paragraph obtain. Upon notice by the patent office of such country that a patent agent registered under this section is no longer registered or no longer in good standing before the patent office of such country, and absent a showing of cause why his or her name should not be removed from the register, the OED Director shall promptly remove the name of the patent agent from the register and publish the fact of removal. Upon ceasing to reside in such country, the patent agent registered under this section is no longer qualified to be registered under this section, and the OED Director shall promptly remove the name of the patent agent from the register and publish the fact of removal.

(d) *Interference matters.* The Chief Administrative Patent Judge or Vice Chief Administrative Patent Judge of the Board of Patent Appeals and Interferences shall determine whether and the circumstances under which an attorney who is not registered may take testimony for an interference under 35 U.S.C. 24, or under § 1.672 of this subchapter.

§ 11.7 Requirements for registration.

(a) No individual will be registered to practice before the Office unless he or she has:

(1) Applied to the USPTO Director in writing by completing an application for registration form supplied by the OED Director and furnishing all requested information and material; and

(2) Established to the satisfaction of the OED Director that he or she:

(i) Possesses good moral character and reputation;

(ii) Possesses the legal, scientific, and technical qualifications necessary for him or her to render applicants valuable service; and

(iii) Is competent to advise and assist patent applicants in the presentation and prosecution of their applications before the Office.

(b)(1) To enable the OED Director to determine whether an individual has the qualifications specified in paragraph (a)(2) of this section, the individual shall:

(i) File a complete application for registration each time admission to the registration examination is requested. A complete application for registration includes:

(A) An application for registration form supplied by the OED Director wherein all requested information and supporting documents are furnished,

(B) Payment of the fees required by § 1.21(a)(1) of this subchapter,

(C) Satisfactory proof of scientific and technical qualifications, and

(D) For aliens, provide proof that recognition is not inconsistent with the terms of their visa or entry into the United States;

(ii) Pass the registration examination, unless the taking and passing of the examination is waived as provided in paragraph (d) of this section. Unless examination is waived pursuant to paragraph (d) of this section, each individual seeking registration must take and pass the registration examination to enable the OED Director to determine whether the individual possesses the legal and competence qualifications specified in paragraphs (a)(2)(ii) and (a)(2)(iii) of this section. An individual failing the examination may, upon receipt of notice of failure from OED, reapply for admission to the examination. An individual failing the examination must wait thirty days after the date the individual last took the examination before retaking the examination. An individual reapplying shall:

(A) File a completed application for registration form wherein all requested information and supporting documents are furnished,

(B) Pay the fees required by

§ 1.21(a)(1) of this subchapter, and

(C) For aliens, provide proof that recognition is not inconsistent with the terms of their visa or entry into the United States; and

(iii) Provide satisfactory proof of possession of good moral character and reputation.

(2) An individual failing to file a complete application for registration will not be admitted to the examination and will be notified of the incompleteness. Applications for registration that are incomplete as originally submitted will be considered only when they have been completed and received by OED, provided that this occurs within sixty days of the mailing date of the notice of incompleteness. Thereafter, a new and complete application for registration must be filed. Only an individual approved as satisfying the requirements of paragraphs (b)(1)(i)(A), (b)(1)(i)(B), (b)(1)(i)(C) and (b)(1)(i)(D) of this section may be admitted to the examination.

(3) If an individual does not reapply until more than one year after the mailing date of a notice of failure, that individual must again comply with paragraph (b)(1)(i) of this section.

(c) Each individual seeking registration is responsible for updating all information and answers submitted in or with the application for registration based upon anything occurring between the date the application for registration is signed by the individual, and the date he or she is registered or recognized to practice before the Office in patent matters. The update shall be filed within thirty days after the date of the occasion that necessitates the update.

(d) *Waiver of the Registration Examination for Former Office Employees.* (1) *Former patent examiners who by July 26, 2004, had not actively served four years in the patent examining corps, and were serving in the corps at the time of their separation.* The OED Director may waive the taking of a registration examination in the case of any individual meeting the requirements of paragraph (b)(1)(i)(C) of this section who is a former patent examiner but by July 26, 2004, had not served four years in the patent examining corps, if the individual demonstrates that he or she:

(i) Actively served in the patent examining corps of the Office and was serving in the corps at the time of separation from the Office;

(ii) Received a certificate of legal competency and negotiation authority;

(iii) After receiving the certificate of legal competency and negotiation authority, was rated at least fully successful in each quality performance element of his or her performance plan for the last two complete fiscal years as a patent examiner; and

(iv) Was not under an oral or written warning regarding the quality performance elements at the time of

separation from the patent examining corps.

(2) *Former patent examiners who on July 26, 2004, had actively served four years in the patent examining corps, and were serving in the corps at the time of their separation.* The OED Director may waive the taking of a registration examination in the case of any individual meeting the requirements of paragraph (b)(1)(i)(C) of this section who is a former patent examiner and by July 26, 2004, had served four years in the patent examining corps, if the individual demonstrates that he or she:

(i) Actively served for at least four years in the patent examining corps of the Office by July 26, 2004, and was serving in the corps at the time of separation from the Office;

(ii) Was rated at least fully successful in each quality performance element of his or her performance plan for the last two complete fiscal years as a patent examiner in the Office; and

(iii) Was not under an oral or written warning regarding the quality performance elements at the time of separation from the patent examining corps.

(3) *Certain former Office employees who were not serving in the patent examining corps upon their separation from the Office.* The OED Director may waive the taking of a registration examination in the case of a former Office employee meeting the requirements of paragraph (b)(1)(i)(C) of this section who by petition demonstrates possession of the necessary legal qualifications to render to patent applicants and others valuable service and assistance in the preparation and prosecution of their applications or other business before the Office by showing that he or she has:

(i) Exhibited comprehensive knowledge of patent law equivalent to that shown by passing the registration examination as a result of having been in a position of responsibility in the Office in which he or she:

(A) Provided substantial guidance on patent examination policy, including the development of rule or procedure changes, patent examination guidelines, changes to the Manual of Patent Examining Procedure, development of training or testing materials for the patent examining corps, or development of materials for the registration examination or continuing legal education; or

(B) Represented the Office in patent cases before Federal courts; and

(ii) Was rated at least fully successful in each quality performance element of his or her performance plan for said position for the last two complete rating

periods in the Office, and was not under an oral or written warning regarding such performance elements at the time of separation from the Office.

(4) To be eligible for consideration for waiver, an individual formerly employed by the Office within the scope of one of paragraphs (d)(1), (d)(2) or (d)(3) of this section must file a complete application for registration and pay the fee required by § 1.21(a)(1)(i) of this subchapter within two years of the individual's date of separation from the Office. All other individuals formerly employed by the Office, including former examiners, filing an application for registration or fee more than two years after separation from the Office, are required to take and pass the registration examination. The individual or former examiner must pay the examination fee required by § 1.21(a)(1)(ii) of this subchapter within thirty days after notice of non-waiver.

(e) *Examination results.* Notification of the examination results is final. Within sixty days of the mailing date of a notice of failure, the individual is entitled to inspect, but not copy, the questions and answers he or she incorrectly answered. Review will be under supervision. No notes may be taken during such review. Substantive review of the answers or questions may not be pursued by petition for regrade. An individual who failed the examination has the right to retake the examination an unlimited number of times upon payment of the fees required by § 1.21(a)(1)(i) and (ii) of this subchapter, and a fee charged by a commercial entity administering the examination.

(f) *Application for reciprocal recognition.* An individual seeking reciprocal recognition under § 11.6(c), in addition to satisfying the provisions of paragraphs (a) and (b) of this section, and the provisions of § 11.8(c), shall pay the application fee required by § 1.21(a)(1)(i) of this subchapter upon filing an application for registration.

(g) *Investigation of good moral character and reputation.* (1) Every individual seeking recognition shall answer all questions in the application for registration and request(s) for comments issued by OED; disclose all relevant facts, dates and information; and provide verified copies of documents relevant to his or her good moral character and reputation. An individual who is an attorney shall submit a certified copy of each of his or her State bar applications and moral character determinations, if available.

(2)(i) If the OED Director receives information from any source that reflects adversely on the good moral

character or reputation of an individual seeking registration or recognition, the OED Director shall conduct an investigation into the good moral character and reputation of that individual. The investigation will be conducted after the individual has passed the registration examination, or after the registration examination has been waived for the individual, as applicable. An individual failing to timely answer questions or respond to an inquiry by OED shall be deemed to have withdrawn his or her application, and shall be required to reapply, pass the examination, and otherwise satisfy all the requirements of this section. No individual shall be certified for registration or recognition by the OED Director until, to the satisfaction of the OED Director, the individual demonstrates his or her possession of good moral character and reputation.

(ii) The OED Director, in considering an application for registration by an attorney, may accept a State bar's character determination as meeting the requirements set forth in paragraph (g) of this section if, after review, the Office finds no substantial discrepancy between the information provided with his or her application for registration and the State bar application and moral character determination, provided that acceptance is not inconsistent with other rules and the requirements of 35 U.S.C. 2(b)(2)(D).

(h) *Good moral character and reputation.* Evidence showing lack of good moral character and reputation may include, but is not limited to, conviction of a felony or a misdemeanor identified in paragraph (h)(1) of this section, drug or alcohol abuse; lack of candor; suspension or disbarment on ethical grounds from a State bar; and resignation from a State bar while under investigation.

(1) *Conviction of felony or misdemeanor.* An individual who has been convicted of a felony or a misdemeanor involving moral turpitude, breach of trust, interference with the administration of justice, false swearing, misrepresentation, fraud, deceit, bribery, extortion, misappropriation, theft, or conspiracy to commit any felony or misdemeanor, is presumed not to be of good moral character and reputation in the absence of a pardon or a satisfactory showing of reform and rehabilitation, and shall file with his or her application for registration the fees required by § 1.21(a)(1)(ii) and (a)(10) of this subchapter. The OED Director shall determine whether individuals convicted of said felony or

misdemeanor provided satisfactory proof of reform and rehabilitation.

(i) An individual who has been convicted of a felony or a misdemeanor identified in paragraph (h)(1) of this section shall not be eligible to apply for registration during the time of any sentence (including confinement or commitment to imprisonment), deferred adjudication, and period of probation or parole as a result of the conviction, and for a period of two years after the date of completion of the sentence, deferred adjudication, and period of probation or parole, whichever is later.

(ii) The following presumptions apply to the determination of good moral character and reputation of an individual convicted of said felony or misdemeanor:

(A) The court record or docket entry of conviction is conclusive evidence of guilt in the absence of a pardon or a satisfactory showing of reform or rehabilitation; and

(B) An individual convicted of a felony or any misdemeanor identified in paragraph (h)(1) of this section is conclusively deemed not to have good moral character and reputation, and shall not be eligible to apply for registration for a period of two years after completion of the sentence, deferred adjudication, and period of probation or parole, whichever is later.

(iii) The individual, upon applying for registration, shall provide satisfactory evidence that he or she is of good moral character and reputation.

(iv) Upon proof that a conviction has been set aside or reversed, the individual shall be eligible to file a complete application for registration and the fee required by § 1.21(a)(1)(ii) of this subchapter and, upon passing the registration examination, have the OED Director determine, in accordance with paragraph (h)(1) of this section, whether, absent the conviction, the individual possesses good moral character and reputation.

(2) *Good moral character and reputation involving drug or alcohol abuse.* An individual's record is reviewed as a whole to see if there is a drug or alcohol abuse issue. An individual appearing to abuse drugs or alcohol may be asked to undergo an evaluation, at the individual's expense, by a qualified professional approved by the OED Director. In instances where, before an investigation commences, there is evidence of a present abuse or an individual has not established a record of recovery, the OED Director may request the individual to withdraw his or her application, and require the individual to satisfactorily demonstrate

that he or she is complying with treatment and undergoing recovery.

(3) *Moral character and reputation involving lack of candor.* An individual's lack of candor in disclosing facts bearing on or relevant to issues concerning good moral character and reputation when completing the application or any time thereafter may be found to be cause to deny registration on moral character and reputation grounds.

(4) *Moral character and reputation involving suspension, disbarment, or resignation from a profession.* (i) An individual who has been disbarred or suspended from practice of law or other profession, or has resigned in lieu of a disciplinary proceeding (excluded or disbarred on consent) shall be ineligible to apply for registration as follows:

(A) An individual who has been disbarred from practice of law or other profession, or has resigned in lieu of a disciplinary proceeding (excluded or disbarred on consent) shall be ineligible to apply for registration for a period of five years from the date of disbarment or resignation.

(B) An individual who has been suspended on ethical grounds from the practice of law or other profession shall be ineligible to apply for registration until expiration of the period of suspension.

(C) An individual who was not only disbarred, suspended or resigned in lieu of a disciplinary proceeding, but also convicted in a court of a felony, or of a crime involving moral turpitude or breach of trust, shall be ineligible to apply for registration until the conditions in paragraphs (h)(1) and (h)(4) of this section are fully satisfied.

(ii) An individual who has been disbarred or suspended, or who resigned in lieu of a disciplinary proceeding shall file an application for registration and the fees required by § 1.21(a)(1)(ii) and (a)(10) of this subchapter; provide a full and complete copy of the proceedings that led to the disbarment, suspension, or resignation; and provide satisfactory proof that he or she possesses good moral character and reputation. The following presumptions shall govern the determination of good moral character and reputation of an individual who has been licensed to practice law or other profession in any jurisdiction and has been disbarred, suspended on ethical grounds, or allowed to resign in lieu of discipline, in that jurisdiction:

(A) A copy of the record resulting in disbarment, suspension or resignation is *prima facie* evidence of the matters contained in the record, and the imposition of disbarment or suspension,

or the acceptance of the resignation of the individual shall be deemed conclusive that the individual has committed professional misconduct.

(B) The individual is ineligible for registration and is deemed not to have good moral character and reputation during the period of the imposed discipline.

(iii) The only defenses available with regard to an underlying disciplinary matter resulting in disbarment, suspension on ethical grounds, or resignation in lieu of a disciplinary proceeding are set out below, and must be shown to the satisfaction of the OED Director:

(A) The procedure in the disciplinary court was so lacking in notice or opportunity to be heard as to constitute a deprivation of due process;

(B) There was such infirmity of proof establishing the misconduct as to give rise to the clear conviction that the Office could not, consistently with its duty, accept as final the conclusion on that subject; or

(C) The finding of lack of good moral character and reputation by the Office would result in grave injustice.

(i) *Factors that may be taken into consideration when evaluating rehabilitation of an individual seeking a moral character and reputation determination.* The factors enumerated below are guidelines to assist the OED Director in determining whether an individual has demonstrated rehabilitation from an act of misconduct or moral turpitude. The factors include:

(1) The nature of the act of misconduct, including whether it involved moral turpitude, whether there were aggravating or mitigating circumstances, and whether the activity was an isolated event or part of a pattern;

(2) The age and education of the individual at the time of the misconduct and the age and education of the individual at the present time;

(3) The length of time that has passed between the misconduct and the present, absent any involvement in any further acts of moral turpitude, the amount of time and the extent of rehabilitation being dependent upon the nature and seriousness of the act of misconduct under consideration;

(4) Restitution by the individual to any person who suffered monetary losses through acts or omissions of the individual;

(5) Expungement of a conviction;

(6) Successful completion or early discharge from probation or parole;

(7) Abstinence from the use of controlled substances or alcohol for not less than two years if the specific

misconduct was attributable in part to the use of a controlled substance or alcohol, where abstinence may be demonstrated by, but is not necessarily limited to, enrolling in and complying with a self-help or professional treatment program;

(8) If the specific misconduct was attributable in part to a medically recognized mental disease, disorder or illness, proof that the individual sought professional assistance, and complied with the treatment program prescribed by the professional, and submitted letters from the treating psychiatrist/psychologist verifying that the medically recognized mental disease, disorder or illness will not impede the individual's ability to competently practice before the Office;

(9) Payment of the fine imposed in connection with any criminal conviction;

(10) Correction of behavior responsible in some degree for the misconduct;

(11) Significant and conscientious involvement in programs designed to provide social benefits or to ameliorate social problems; and

(12) Change in attitude from that which existed at the time of the act of misconduct in question as evidenced by any or all of the following:

(i) Statements of the individual;

(ii) Statements from persons familiar with the individual's previous misconduct and with subsequent attitudes and behavioral patterns;

(iii) Statements from probation or parole officers or law enforcement officials as to the individual's social adjustments; and

(iv) Statements from persons competent to testify with regard to neuropsychiatry or emotional disturbances.

(j) *Notice to Show Cause.* The OED Director shall inquire into the good moral character and reputation of an individual seeking registration, providing the individual with the opportunity to create a record on which a decision is made. If, following inquiry and consideration of the record, the OED Director is of the opinion that the individual seeking registration has not satisfactorily established that he or she possesses good moral character and reputation, the OED Director shall issue to the individual a notice to show cause why the individual's application for registration should not be denied.

(1) The individual shall be given no less than ten days from the date of the notice to reply. The notice shall be given by certified mail at the address appearing on the application if the address is in the United States, and by

any other reasonable means if the address is outside the United States.

(2) Following receipt of the individual's response, or in the absence of a response, the OED Director shall consider the individual's response, if any, and the record, and determine whether, in the OED Director's opinion, the individual has sustained his or her burden of satisfactorily demonstrating that he or she possesses good moral character and reputation.

(k) *Reapplication for registration.* An individual who has been refused registration for lack of good moral character or reputation may reapply for registration two years after the date of the decision, unless a shorter period is otherwise ordered by the USPTO Director. An individual, who has been notified that he or she is under investigation for good moral character and reputation may elect to withdraw his or her application for registration, and may reapply for registration two years after the date of withdrawal. Upon reapplication for registration, the individual shall pay the fees required by § 1.21(a)(1)(ii) and (a)(10) of this subchapter, and has the burden of showing to the satisfaction of the OED Director his or her possession of good moral character and reputation as prescribed in paragraph (b) of this section. Upon reapplication for registration, the individual also shall complete successfully the examination prescribed in paragraph (b) of this section, even though the individual has previously passed a registration examination.

§ 11.8 Oath and registration fee.

(a) After an individual passes the examination, or the examination is waived, the OED Director shall promptly publish a solicitation for information concerning the individual's good moral character and reputation. The solicitation shall include the individual's name, and business or communication postal address.

(b) An individual shall not be registered as an attorney under § 11.6(a), registered as an agent under § 11.6(b) or (c), or granted limited recognition under § 11.9(b) unless within two years of the mailing date of a notice of passing registration examination or of waiver of the examination the individual files with the OED Director a completed Data Sheet, an oath or declaration prescribed by the USPTO Director, and the registration fee set forth in § 1.21(a)(2) of this subchapter. An individual seeking registration as an attorney under § 11.6(a) must provide a certificate of good standing of the bar of the highest

court of a State that is no more than six months old.

(c) An individual who does not comply with the requirements of paragraph (b) of this section within the two-year period will be required to retake the registration examination.

§ 11.9 Limited recognition in patent matters.

(a) Any individual not registered under § 11.6 may, upon a showing of circumstances which render it necessary or justifiable, and that the individual is of good moral character and reputation, be given limited recognition by the OED Director to prosecute as attorney or agent a specified patent application or specified patent applications. Limited recognition under this paragraph shall not extend further than the application or applications specified. Limited recognition shall not be granted while individuals who have passed the examination or for whom the examination has been waived are awaiting registration to practice before the Office in patent matters.

(b) A nonimmigrant alien residing in the United States and fulfilling the provisions of § 11.7(a) and (b) may be granted limited recognition if the nonimmigrant alien is authorized by the Bureau of Citizenship and Immigration Services to be employed or trained in the United States in the capacity of representing a patent applicant by presenting or prosecuting a patent application. Limited recognition shall be granted for a period consistent with the terms of authorized employment or training. Limited recognition shall not be granted or extended to a non-United States citizen residing abroad. If granted, limited recognition shall automatically expire upon the nonimmigrant alien's departure from the United States.

(c) An individual not registered under § 11.6 may, if appointed by an applicant, prosecute an international patent application only before the United States International Searching Authority and the United States International Preliminary Examining Authority, provided that the individual has the right to practice before the national office with which the international application is filed as provided in PCT Art. 49, Rule 90 and § 1.455 of this subchapter, or before the International Bureau when the USPTO is acting as Receiving Office pursuant to PCT Rules 83.1 bis and 90.1.

§ 11.10 Restrictions on practice in patent matters.

(a) Only practitioners who are registered under § 11.6 or individuals

given limited recognition under § 11.9(a) or (b) are permitted to prosecute patent applications of others before the Office; or represent others in any proceedings before the Office.

(b) *Post employment agreement of former Office employee.* No individual who has served in the patent examining corps or elsewhere in the Office may practice before the Office after termination of his or her service, unless he or she signs a written undertaking agreeing:

(1) To not knowingly act as agent or attorney for, or otherwise represent, or assist in any manner the representation of, any other person:

- (i) Before the Office,
- (ii) In connection with any particular patent or patent application,
- (iii) In which said employee participated personally and substantially as an employee of the Office; and

(2) To not knowingly act within two years after terminating employment by the Office as agent or attorney for, or otherwise represent, or assist in any manner the representation of any other person:

- (i) Before the Office,
- (ii) In connection with any particular patent or patent application,
- (iii) If such patent or patent application was pending under the employee's official responsibility as an officer or employee within a period of one year prior to the termination of such responsibility.

(3) The words and phrases in paragraphs (b)(1) and (b)(2) of this section are construed as follows:

(i) *Represent and representation* mean acting as patent attorney or patent agent or other representative in any appearance before the Office, or communicating with an employee of the Office with intent to influence.

(ii) *Assist in any manner* means aid or help another person on a particular patent or patent application involving representation.

(iii) *Particular patent or patent application* means any patent or patent application, including, but not limited to, 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 or patent application.

(iv) *Participate personally and substantially.* (A) Basic requirements. The restrictions of § 11.10(a)(1) apply only to those patents and patent applications in which a former Office employee had "personal and substantial participation," exercised "through

decision, approval, disapproval, recommendation, the rendering of advice, investigation or otherwise." To *participate personally* means directly, and includes the participation of a subordinate when actually directed by the former Office employee in the patent or patent application. *Substantially* means that the employee's involvement must be of significance to the matter, or form a basis for a reasonable appearance of such significance. It requires more than official responsibility, knowledge, perfunctory involvement, or involvement on an administrative or peripheral issue. A finding of substantiality should be based not only on the effort devoted to a patent or patent application, but also on the importance of the effort. While a series of peripheral involvements may be insubstantial, the single act of approving or participation in a critical step may be substantial. It is essential that the participation be related to a "particular patent or patent application." (See paragraph (b)(3)(iii) of this section.)

(B) *Participation on ancillary matters.* An Office employee's participation on subjects not directly involving the substantive merits of a patent or patent application may not be "substantial," even if it is time-consuming. An employee whose official responsibility is the review of a patent or patent application solely for compliance with administrative control or budgetary considerations and who reviews a particular patent or patent application for such a purpose should not be regarded as having participated substantially in the patent or patent application, except when such considerations also are the subject of the employee's proposed representation.

(C) *Role of official responsibility in determining substantial participation.* *Official responsibility* is defined in paragraph (b)(3)(v) of this section. "Personal and substantial participation" is different from "official responsibility." One's responsibility may, however, play a role in determining the "substantiality" of an Office employee's participation.

(v) *Official responsibility* means the direct administrative or operating authority, whether intermediate or final, and either exercisable alone or with others, and either personally or through subordinates, to approve, disapprove, or otherwise direct Government actions.

(A) *Determining official responsibility.* Ordinarily, those areas assigned by statute, regulation, Executive Order, job description, or delegation of authority determine the scope of an employee's "official responsibility". All particular matters

under consideration in the Office are under the "official responsibility" of the Director of the Office, and each is under that of any intermediate supervisor having responsibility for an employee who actually participates in the patent or patent application within the scope of his or her duties. A patent examiner would have "official responsibility" for the patent applications assigned to him or her.

(B) Ancillary matters and official responsibility. *Administrative* authority as used in paragraph (v) of this section means authority for planning, organizing and controlling a patent or patent application rather than authority to review or make decisions on ancillary aspects of a patent or patent application such as the regularity of budgeting procedures, public or community relations aspects, or equal employment opportunity considerations. Responsibility for such an ancillary consideration does not constitute official responsibility for the particular patent or patent application, except when such a consideration is also the subject of the employee's proposed representation.

(C) Duty to inquire. In order for a former employee, *e.g.*, former patent examiner, to be barred from representing or assisting in representing another as to a particular patent or patent application, he or she need not have known, while employed by the Office, that the patent or patent application was pending under his or her official responsibility. The former employee has a reasonable duty of inquiry to learn whether the patent or patent application had been under his or her official responsibility. Ordinarily, a former employee who is asked to represent another on a patent or patent application will become aware of facts sufficient to suggest the relationship of the prior matter to his or her former office, *e.g.*, technology center, group or art unit. If so, he or she is under a duty to make further inquiry. It would be

prudent for an employee to maintain a record of only patent application numbers of the applications actually acted upon by decision or recommendation, as well as those applications under the employee's official responsibility which he or she has not acted upon.

(D) Self-disqualification. A former employee, *e.g.*, former patent examiner, cannot avoid the restrictions of this section through self-disqualification with respect to a patent or patent application for which he or she otherwise had official responsibility. However, an employee who through self-disqualification does not participate personally and substantially in a particular patent or patent application is not subject to the lifetime restriction of paragraph (b)(1) of this section.

(vi) *Pending* means that the matter was in fact referred to or under consideration by persons within the employee's area of official responsibility.

(4) Measurement of the two-year restriction period. The two-year period under paragraph (b)(2) of this section is measured from the date when the employee's official responsibility in a particular area ends, not from the termination of service in the Office, unless the two occur simultaneously. The prohibition applies to all particular patents or patent applications subject to such official responsibility in the one-year period before termination of such responsibility.

(c) *Former employees of the Office.* This section imposes restrictions generally parallel to those imposed in 18 U.S.C. 207(a) and (b)(1). This section, however, does not interpret these statutory provisions or any other post-employment restrictions that may apply to former Office employees, and such former employees should not assume that conduct not prohibited by this section is otherwise permissible. Former employees of the Office, whether or not they are practitioners, are encouraged to

contact the Department of Commerce for information concerning applicable post-employment restrictions.

(d) An employee of the Office may not prosecute or aid in any manner in the prosecution of any patent application before the Office.

(e) Practice before the Office by Government employees is subject to any applicable conflict of interest laws, regulations or codes of professional responsibility.

§ 11.11 Notification.

A registered attorney or agent must notify the OED Director of his or her postal address for his or her office, up to three e-mail addresses where he or she receives e-mail, and business telephone number, as well as every change to any of said addresses, or telephone numbers within thirty days of the date of the change. A registered attorney or agent shall, in addition to any notice of change of address and telephone number filed in individual patent applications, separately file written notice of the change of address or telephone number to the OED Director. A registered practitioner who is an attorney in good standing with the bar of the highest court of one or more States shall provide the OED Director with the State bar identification number associated with each membership. The OED Director shall publish from the roster a list containing the name, postal business addresses, business telephone number, registration number, and registration status as an attorney or agent of each registered practitioner recognized to practice before the Office in patent cases.

Dated: June 14, 2004.

Jon W. Dudas,

Acting Under Secretary of Commerce for Intellectual Property and Acting Director of the United States Patent and Trademark Office.

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