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## The USPTO's Catchall Disciplinary Rules

*Law360, New York (December 23, 2009)* -- Every patent agent and any attorney who practices before the United States Patent and Trademark Office, whether as a registered patent attorney or in a representative capacity in any nonpatent case, is subject to the USPTO disciplinary rules. 37 C.F.R. § 10.1(r). Misconduct before the USPTO is defined in USPTO disciplinary rule 37 C.F.R. § 10.23.

In all investigations and disciplinary proceedings against practitioners, the USPTO has cited ethics Rules 37 C.F.R. § 10.23(b)(4), (b)(5) and (b)(6) as having been or possibly having been violated.

The rules are very broad and sweeping. They apply to both personal conduct as well as professional conduct.

Thus, any argument that an accusation of misconduct is not related to practice before the USPTO and, therefore, not subject to USPTO disciplinary rules, is unavailing.

Rules 37 C.F.R. § 10.23(b)(4), (b)(5) and (b)(6) proscribe, inter alia, the following:

(b) A practitioner shall not:

(4) Engage in conduct involving dishonesty, fraud, deceit, or misrepresentation.

(5) Engage in conduct that is prejudicial to the administration of justice.

(6) Engage in any other conduct that adversely reflects on the practitioner's fitness to practice before the office.

The terms "dishonesty," "fraud," "deceit" and "misrepresentation" in 37 C.F.R. § 10.23(b)(4) are not defined in the USPTO disciplinary rules. The terms "fraud" and "deceit" inherently require an element of intent.

Be aware, however, that under 37 C.F.R. § 10.23(d) a “practitioner who acts with reckless indifference as to whether a representation is true or false is chargeable with knowledge of its falsity and that “[d]eceptive statements of half-truths or concealment of material facts shall be deemed actual fraud within the meaning [of the Disciplinary Rules].”

The terms “dishonesty” and “misrepresentation”, therefore, do not require an element of intent.

Thus, any conduct that could be reasonably shown as lacking truthfulness or honesty or a misrepresentation of fact, whether made in a personal matter or a matter before the USPTO, could subject a practitioner to disciplinary action.

It is imperative that when the practitioner becomes aware that a statement made to the USPTO may not be true or could be regarded as a misrepresentation, the practitioner take immediate, appropriate action to clarify the record and to explain to the USPTO how and why the error arose.

Remember, in any paper filed in the USPTO, the party presenting the paper is certifying that the “allegations and other factual contentions [made in the paper] have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation.” 37 C.F.R. § 11.18.

Disciplinary Rule 37 C.F.R. § 10.23(b)(5) is directed to conduct that is “prejudicial to the administration of justice.”

The expression “prejudicial to the administration of justice” is not defined in the USPTO rules. This rule is, however, associated with misconduct in court proceedings.

The USPTO does not use the term “court” in its rules, but the term “tribunal,” which the USPTO defines, includes the “courts, the office [USPTO], and other adjudicatory bodies.” 37 C.F.R. § 10.1(z).

Thus, conduct that could constitute violation of 37 C.F.R. § 10.23(b)(5) could be conduct that impairs the public confidence in the USPTO such as lying to a client or to the USPTO, or neglecting a matter before the USPTO or even failing to pay a parking ticket.

The ultimate catch-all rule is 37 C.F.R. § 10.23(b)(6), which is conduct that “adversely reflects on the practitioner's fitness to practice” before the USPTO.

What constitutes such conduct is not defined in the USPTO disciplinary rules. The rule is subject to whatever the USPTO regards as not being conduct that it will condone; whether the conduct is related to a personal matter or a matter before the USPTO.

This rule is cited by the USPTO against practitioners in all disciplinary investigations and/or disciplinary proceedings.

Be aware of the catchall rules. The USPTO has disciplined practitioners for violating any one of these rules alone without reference to any other disciplinary rule.

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