

United States Patent and Trademark Office Revises Rules

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The US Patent and Trademark Office (“PTO”) is adopting new rules governing the conduct of disciplinary investigations, issuing warnings when closing disciplinary investigations, disciplinary proceedings, non-disciplinary transfer to disability inactive statutes and reinstatement to practice before the PTO. The new rules include a rule regarding recognition to practice before the PTO in trademark cases, as well as a rule that addresses a practitioner’s signature and certificate for correspondence filed in the PTO.

One of the most significant portions of the rules is the precise definition of what the PTO authorizes. Section 11.5(b)(1) states in part, “preparing and prosecuting any patent application, consulting with or giving advice to a client in contemplation of filing a patent application or other document with the Office, drafting the specification or claims of a patent application’ drafting an amendment or reply to a communication from the Office that may require written argument to establish the patentability of a claimed invention; and drafting a communication for a public use, interference, reexamination proceeding, petition, appeal to the Board of Patent Appeals and Interferences, or other proceeding.”

In a comment to the revised rules, the PTO clarifies that PTO registration does not authorize offering an “opinion of validity of another party’s patent when the client is contemplating litigation and not seeking reexamination.” This activity “could not be reasonably necessary and incident to the preparation and prosecution” of a client’s patent. These limits are directed at patent agents because patent attorneys, when practicing within their state, have overlapping authority from state bar registration.

The changes to the rules will enable the PTO to protect the public more efficiently from practitioners who do not comply with the PTO’s ethics rules. These new rules of discipline and professionalism that govern patent agents, patent attorneys, and trademark attorneys are effective on September 15, 2008.

Sources:

PTO Revises Rules of Ethics and Professionalism, <http://www.patentlyo.com/patent/2008/08/pto-revises-rul.html> (Aug. 15, 2008).

Changes to Representation of Others Before the US Patent and Trademark Office, 73 Fed. Reg. 158 (Aug. 14, 2008) (to be codified at 37 C.F.R. pts. 1, 2, 7, 10, 11, and 41), *available at* <http://www.uspto.gov/web/offices/com/sol/notices/73fr47650.pdf>.