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**37 CFR 10.1 Definitions.**

This part governs solely the practice of patent, trademark, and other law before the 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 Patent and Trademark Office to accomplish its federal objectives. Unless otherwise clear from the context, the following definitions apply to this part:

- (a) “Affidavit” means affidavit, declaration under 35 U.S.C. 25 (see § 1.68 and § 2.20 of this subchapter), or statutory declaration under 28 U.S.C. 1746.
- (b) “Application” includes an application for a design, plant, or utility patent, an application to reissue any patent, and an application to register a trademark.
- (c) “Attorney” or “lawyer” means an individual who is a member in good standing of the bar of any United States court or the highest court of any State. A “non-lawyer” is a person who is not an attorney or lawyer.
- (d) “Canon” is defined in § 10.20(a).

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- (e) "Confidence" is defined in § 10.57(a).
  - (f) "Differing interests" include every interest that may adversely affect either the judgment or the loyalty of a practitioner to a client, whether it be a conflicting, inconsistent, diverse, or other interest.
  - (g) "Director" means the Director of Enrollment and Discipline.
  - (h) "Disciplinary Rule" is defined in § 10.20(b).
  - (i) "Employee of a tribunal" includes all employees of courts, the Office, and other adjudicatory bodies.
  - (j) "Giving information" within the meaning of § 10.23(c) (2) includes making
    - (1) a written statement or representation or
    - (2) an oral statement or representation.
  - (k) "Law firm" includes a professional legal corporation or a partnership.
  - (l) "Legal counsel" means practitioner.
  - (m) "Legal profession" includes the individuals who are lawfully engaged in practice of patent, trademark, and other law before the Office.
  - (n) "Legal service" means any legal service which may lawfully be performed by a practitioner before the Office.
  - (o) "Legal System" includes the Office and courts and adjudicatory bodies which review matters on which the Office has acted.
  - (p) "Office" means Patent and Trademark Office.
  - (q) "Person" includes a corporation, an association, a trust, a partnership, and any other organization or legal entity.
  - (r) "Practitioner" means
    - (1) an attorney or agent registered to practice before the Office in patent cases or
    - (2) an individual authorized under 5 U.S.C. 500(b) or otherwise as provided by this subchapter, to practice before the Office in trademark cases or other non-patent cases.
- A "suspended or excluded practitioner" is a practitioner who is suspended or excluded under § 10.156. A "non-practitioner" is an individual who is not a practitioner.
- (s) A "proceeding before the Office" includes an application, a reexamination, a protest, a public use proceeding, a patent interference, an inter partes trademark proceeding, or any other proceeding which is pending before the Office.
  - (t) "Professional legal corporation" means a corporation authorized by law to practice law for profit.
  - (u) "Registration" means registration to practice before the Office in patent cases.
  - (v) "Respondent" is defined in § 10.134(a)(1).
  - (w) "Secret" is defined in § 10.57(a).
  - (x) "Solicit" is defined in § 10.33.
  - (y) "State" includes the District of Columbia, Puerto Rico, and other federal territories and possessions.
  - (z) "Tribunal" includes courts, the Office, and other adjudicatory bodies.
  - (aa) "United States" means the United States of America, its territories and possessions.

*[Added 50 FR 5172, Feb. 6, 1985, effective Mar. 8, 1985]*

*Patent Laws and Regulations***37 CFR 10.2 Director of Enrollment and Discipline.**

(a) **Appointment.** The Commissioner shall appoint a Director of Enrollment and Discipline. In the event of the absence of the Director or a vacancy in the Office of the Director, the Commissioner may designate an employee of the Office to serve as acting Director of Enrollment and Discipline. The Director and any acting Director shall be an active member in good standing of the bar of a State.

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

- (1) Receive and act upon applications for registration, prepare and grade the examination provided for in § 10.7(b), maintain the register provided for in § 10.5, and perform such other duties in connection with enrollment and recognition of attorneys and agents as may be necessary.
- (2) 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), and perform such other duties in connection with investigations and disciplinary proceedings as may be necessary.

(c) **Review of Director's decision.** Any final decision of the Director refusing to register an individual under § 10.6, recognize an individual under § 10.9 or § 10.14(c), or reinstate a suspended or excluded petitioner under § 10.160, may be reviewed by petition to the Commissioner upon payment of the fee set forth in § 1.21(a)(5). A petition filed more than 30 days after the date of the decision of the Director may be dismissed as untimely. Any petition shall contain

- (1) a statement of the facts involved and the points to be reviewed and
- (2) the action requested. Briefs or memoranda, if any, in support of the petition shall accompany or be embodied therein.

The petition will be decided on the basis of the record made before the Director and no new evidence will be considered by the Commissioner in deciding the petition. Copies of documents already of record before the Director shall not be submitted with the petition. An oral hearing on the petition will not be granted except when considered necessary by the Commissioner.

*[Added 50 FR 5173, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.3 Committee on Enrollment.**

(a) The Commissioner may establish a Committee on Enrollment composed of one or more employees of the Office.

(b) The Committee on Enrollment shall, as necessary, advise the Director in connection with the Director's duties under § 10.2(b)(1).

*[Added 50 FR 5173, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.4 Committee on Discipline.**

(a) The Commissioner shall appoint a Committee on Discipline. The Committee on Discipline shall consist of at least three employees of the Office, none of whom reports directly or indirectly to the Director or the Solicitor. Each member of the Committee on Discipline shall be a member in good standing of the bar of a State.

(b) The Committee on Discipline shall meet at the request of the Director and after reviewing evidence presented by the Director shall, by majority vote, determine whether there is probable cause to bring charges under § 10.132 against a practitioner. When charges are brought against a practitioner, no member of the Committee on Discipline, employee under the direction of the Director, or associate solicitor or assistant solicitor in the Office of Solicitor shall participate in rendering a decision on the charges.

(c) No discovery shall be authorized of, and no member of the Committee on Discipline shall be required to testify about, deliberations of the Committee on Discipline.

*[Added 50 FR 5173, Feb. 6, 1985, effective Mar. 8, 1985]*

**INDIVIDUALS ENTITLED TO PRACTICE BEFORE THE  
PATENT AND TRADEMARK OFFICE**

**37 CFR 10.5      Register of attorneys and agents in patent cases.**

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 before the Office in the preparation and prosecution of applications for patent. Registration in the Office under the provisions of this part shall only entitle the individuals registered to practice before the Office in patent cases.

*[Added 50 FR 5173, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.6      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: Registration is not inconsistent with the terms upon which the alien was admitted to, and resides in, the United States and further provided: 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 § 10.9(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: Registration is not inconsistent with the terms upon which the alien was admitted to, and resides in, the United States, and further provided: 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 § 10.9(b).

NOTE: All individuals registered prior to November 15, 1938, were registered as attorneys, whether they were attorneys or not, and such registrations have not been changed.

(c) Foreigners. Any foreigner not a resident of the United States who shall file proof to the satisfaction of the 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 § 10.7, 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: The patent office of such country allows substantially reciprocal privileges to those admitted to practice before the United States Patent and Trademark Office. Registration as a patent agent under this paragraph shall continue only during the period that the conditions specified in this paragraph obtain.

*[Added 50 FR 5173, Feb. 6, 1985, effective Mar. 8, 1985; paras. (d) & (e) removed 53 FR 33948, Oct. 14, 1988, effective Nov. 4, 1988]*

**37 CFR 10.7      Requirements for registration.**

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

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- (1) Apply to the Commissioner in writing on a form supplied by the Director and furnish all requested information and material and
- (2) Establish to the satisfaction of the Director that he or she is:
  - (i) Of good moral character and repute;
  - (ii) Possessed of the legal, scientific, and technical qualifications necessary to enable him or her to render applicants valuable service; and
  - (iii) Is otherwise competent to advise and assist applicants for patents in the presentation and prosecution of their applications before the Office.

(b) In order that the Director may determine whether an individual seeking to have his or her name placed upon the register has the qualifications specified in paragraph (a) of this section, satisfactory proof of good moral character and repute and of sufficient basic training in scientific and technical matters must be submitted to the Director. Except as provided in this paragraph, each applicant for registration must take and pass an examination which is held from time to time. Each application for admission to take the examination for registration must be accompanied by the fee set forth in § 1.21(a)(1) of this subchapter. The taking of an examination may be waived in the case of any individual who has actively served for at least four years in the patent examining corps of the Office. The examination will not be administered as a mere academic exercise.

(c) Within two months from the date an applicant is notified that he or she failed an examination, the applicant may request regrading of the examination upon payment of the fee set forth in § 1.21(a)(6). Any applicant requesting regrading shall particularly point out the errors which the applicant believed occurred in the grading of his or her examination.

*[Added 50 FR 5174, Feb. 6, 1985, effective Mar. 8, 1985]*

### **37 CFR 10.8 Oath and registration fee.**

Before an individual may have his or her name entered on the register of attorneys and agents, the individual must, after his or her application is approved, subscribe and swear to an oath or make a declaration prescribed by the Commissioner and pay the registration fee set forth in § 1.21(a)(2) of this subchapter.

*[Added 50 FR 5174, Feb. 6, 1985, effective Mar. 8, 1985]*

### **37 CFR 10.9 Limited recognition in patent cases.**

(a) Any individual not registered under § 10.6 may, upon a showing of circumstances which render it necessary or justifiable, be given limited recognition by the Director to prosecute as attorney or agent a specified application or specified applications, but limited recognition under this paragraph shall not extend further than the application or applications specified.

(b) When registration of a resident alien under paragraphs (a) or (b) of § 10.6 is not appropriate, the resident alien may be given limited recognition as may be appropriate under paragraph (a) of this section.

(c) An individual not registered under § 10.6 may, if appointed by applicant to do so, prosecute an international application only before the U.S. International Searching Authority and the U.S. International Preliminary Examining Authority, provided: the individual has the right to practice before the national office with which the international application is filed (PCT Art. 49, Rule 90 and § 1.455 or before the International Bureau when acting as Receiving Office pursuant to PCT Rules 83.1bis and 90.1).

*[Added 50 FR 5174, Feb. 6, 1985, effective Mar. 8, 1985; para. (c) added, 58 FR 4335, Jan. 14, 1993, effective May 1, 1993; para. (c) amended, 60 FR 21438, May 2, 1995, effective June 1, 1995]*

### **37 CFR 10.10 Restrictions on practice in patent cases.**

(a) Only practitioners who are registered under § 10.6 or individuals given limited recognition under § 10.9 will be permitted to prosecute patent applications of others before the Office.

(b) No individual who has served in the patent examining corps of the Office may practice

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before the Office after termination of his or her service, unless he or she signs a written undertaking.

- (1) Not to prosecute or aid in any manner in the prosecution of any patent application pending in any patent examining group during his or her period of service therein and
- (2) Not to prepare or prosecute or to assist in any manner in the preparation or prosecution of any patent application of another
  - (i) assigned to such group for examination and
  - (ii) filed within two years after the date he or she left such group,
 without written authorization of the Director. Associated and related classes in other patent examining groups may be required to be included in the undertaking or designated classes may be excluded from the undertaking.

When an application for registration is made after resignation from the Office, the applicant will not be registered if he or she has prepared or prosecuted or assisted in the preparation or prosecution of any patent application as indicated in the paragraph. Knowingly preparing or prosecuting or providing assistance in the preparation or prosecution of any patent application contrary to the provisions of this paragraph shall constitute misconduct under § 10.23(c)(13) of this part.

(c) A practitioner who is an employee of the Office cannot prosecute or aid in any manner in the prosecution of any patent application before the Office.

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

*[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985; revised 53 FR 33950, Oct. 4, 1988, effective Nov. 4, 1988; corrected 53 FR 41278, Oct. 20, 1988]*

### **37 CFR 10.11 Removing names from the register.**

(a) Registered attorneys and agents shall notify the Director of any change of address. Any notification to the Director of any change of address shall be separate from any notice of change of address filed in individual applications.

(b) 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.

*[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.12 [Reserved]**

**37 CFR 10.13 [Reserved]**

### **37 CFR 10.14 Individuals who may practice before the Office in trademark and other non-patent cases.**

(a) Attorneys. Any individual who is an attorney may represent others before the Office in trademark and other non-patent cases. An attorney is not required to apply for registration or recognition to practice before the Office in trademark and other non-patent cases.

(b) Non-lawyers. Individuals who are not attorneys are not recognized to practice before the Office in trademark and other non-patent cases, except that individuals not attorneys who were recognized to practice before the Office in trademark cases under this chapter prior to January 1, 1957, will be recognized as agents to continue practice before the Office in trademark cases.

(c) Foreigners. Any foreign attorney or agent not a resident of the United States who shall

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prove to the satisfaction of the Director that he or she is registered or in good standing before the patent or trademark office of the country in which he or she resides and practices, may be recognized for the limited purpose of representing parties located in such country before the Office in the presentation and prosecution of trademark cases, provided: The patent or trademark office of such country allows substantially reciprocal privileges to those permitted to practice in trademark cases before the United States Patent and Trademark Office. Recognition under this paragraph shall continue only during the period that the conditions specified in this paragraph obtain.

(d) Recognition of any individual under this section shall not be construed as sanctioning or authorizing the performance of any act regarded in the jurisdiction where performed as the unauthorized practice of law.

(e) No individual other than those specified in paragraphs (a), (b), and (c) of this section will be permitted to practice before the Office in trademark cases. Any individual may appear in a trademark or other non-patent case in his or her own behalf. Any individual may appear in a trademark case for

- (1) a firm of which he or she is a member or
- (2) a corporation or association of which he or she is an officer and which he or she is authorized to represent, if such firm, corporation, or association is a party to a trademark proceeding pending before the Office.

*[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.15 Refusal to recognize a practitioner.**

Any practitioner authorized to appear before the Office may be suspended or excluded in accordance with the provisions of this part. Any practitioner who is suspended or excluded under this subpart or removed under § 10.11(b) shall not be entitled to practice before the Office.

*[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.16 [Reserved]****37 CFR 10.17 [Reserved]****37 CFR 10.18 Signature and certificate of practitioner.**

(a) Except where a copy, including a photocopy or facsimile transmission, of a personally signed piece of correspondence is permitted to be filed pursuant to § 1.4 of this chapter, every piece of correspondence filed by a practitioner on behalf of himself or herself on representing an applicant or a party to a proceeding in the Patent and Trademark Office must bear an original signature personally signed in permanent ink by such practitioner except for correspondence which is required to be signed by the applicant or party. The signature of a practitioner on correspondence filed by the practitioner, regardless of whether the correspondence has an original signature or is a copy, including a photocopy or facsimile transmission, of correspondence bearing an original signature, constitutes a certificate that:

- (1) The correspondence has been read by the practitioner;
- (2) The filing of the correspondence is authorized;
- (3) To the best of practitioner's knowledge, information, and belief, there is good ground to support the correspondence, including any allegations of improper conduct contained or alleged therein; and
- (4) The correspondence is not interposed for delay.

(b) Any practitioner knowingly violating the provisions of this section is subject to disciplinary action. See § 10.23(c)(15).

*[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985; para. (a) amended, 58 FR 54494, Oct. 22, 1993, effective Nov. 22, 1993]*

**37 CFR 10.19 [Reserved]****PATENT AND TRADEMARK OFFICE CODE OF  
PROFESSIONAL RESPONSIBILITY****37 CFR 10.20 Canons and Disciplinary Rules.**

(a) Canons are set out in §§ 10.21, 10.30, 10.46, 10.56, 10.61, 10.76, 10.83, 10.100, and 10.110. Canons are statements of axiomatic norms, expressing in general terms the standards of professional conduct expected of practitioners in their relationships with the public, with the legal system, and with the legal profession.

(b) Disciplinary Rules are set out in §§ 10.22-10.24, 10.31-10.40, 10.47-10.57, 10.62-10.68, 10.77, 10.78, 10.84, 10.85, 10.87-10.89, 10.92, 10.93, 10.101-10.103, 10.111, and 10.112. Disciplinary Rules are mandatory in character and state the minimum level of conduct below which no practitioner can fall without being subjected to disciplinary action.

*[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.21 Canon 1.**

A practitioner should assist in maintaining the integrity and competence of the legal profession.

*[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.22 Maintaining integrity and competence of the legal profession.**

(a) A practitioner is subject to discipline if the practitioner has made a materially false statement in, or if the practitioner has deliberately failed to disclose a material fact requested in connection with, the practitioner's application for registration or membership in the bar of any United States court or any State court or his or her authority to otherwise practice before the Office in trademark and other non-patent cases.

(b) A practitioner shall not further the application for registration or membership in the bar of any United States court, State court, or administrative agency of another person known by the practitioner to be unqualified in respect to character, education, or other relative attribute.

*[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.23 Misconduct.**

(a) A practitioner shall not engage in disreputable or gross misconduct.

(b) A practitioner shall not:

- (1) Violate a Disciplinary Rule.
- (2) Circumvent a Disciplinary Rule through actions of another.
- (3) Engage in illegal conduct involving moral turpitude.
- (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.

(c) Conduct which constitutes a violation of paragraphs (a) and (b) of this section includes, but is not limited to:

- (1) Conviction of a criminal offense involving moral turpitude, dishonesty, or breach of trust.
- (2) Knowingly giving false or misleading information or knowingly participating in a material way in giving false or misleading information, to:
  - (i) A client in connection with any immediate, prospective, or pending

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- business before the Office.
- (ii) The Office or any employee of the Office.
- (3) Misappropriation of, or failure to properly or timely remit, funds received by a practitioner or the practitioner's firm from a client to pay a fee which the client is required by law to pay to the Office.
  - (4) Directly or indirectly improperly influencing, attempting to improperly influence, offering or agreeing to improperly influence, or attempting to offer or agree to improperly influence an official action of any employee of the Office by:
    - (i) Use of threats, false accusations, duress, or coercion,
    - (ii) An offer of any special inducement or promise of advantage, or
    - (iii) Improperly bestowing of any gift, favor, or thing of value.
  - (5) Suspension or disbarment from practice as an attorney or agent on ethical grounds by any duly constituted authority of a State or the United States or, in the case of a practitioner who resides in a foreign country or is registered under § 10.6(c), by any duly constituted authority of:
    - (i) A State,
    - (ii) The United States, or
    - (iii) The country in which the practitioner resides.
  - (6) Knowingly aiding or abetting a practitioner suspended or excluded from practice before the Office in engaging in unauthorized practice before the Office under § 10.158.
  - (7) Knowingly withholding from the Office information identifying a patent or patent application of another from which one or more claims have been copied. See §§ 1.604(b) and 1.607(c) of this subchapter.
  - (8) Failing to inform a client or former client or failing to timely notify the Office of an inability to notify a client or former client of correspondence received from the Office or the client's or former client's opponent in an inter partes proceeding before the Office when the correspondence
    - (i) could have a significant effect on a matter pending before the Office,
    - (ii) is received by the practitioner on behalf of a client or former client and
    - (iii) is correspondence of which a reasonable practitioner would believe under the circumstances the client or former client should be notified.
  - (9) Knowingly misusing a "Certificate of Mailing or Transmission" under § 1.8 of this chapter or a certificate of "Express Mail" under § 1.10 of this chapter.
  - (10) Knowingly violating or causing to be violated the requirements of § 1.56 or § 1.555 of this subchapter.
  - (11) Knowingly filing or causing to be filed an application containing any material alteration made in the application papers after the signing of the accompanying oath or declaration without identifying the alteration at the time of filing the application papers.
  - (12) Knowingly filing, or causing to be filed, a frivolous complaint alleging a violation by a practitioner of the Patent and Trademark Office Code of Professional Responsibility.
  - (13) Knowingly preparing or prosecuting or providing assistance in the preparation or prosecution of a patent application in violation of an undertaking signed under § 10.10(b).

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- (14) Knowingly failing to advise the Director in writing of any change which would preclude continued registration under § 10.6.
- (15) Knowingly signing a paper filed in the Office in violation of the provisions of § 10.18 or making a scandalous or indecent statement in a paper filed in the Office.
- (16) Willfully refusing to reveal or report knowledge or evidence to the Director contrary to § 10.24 or paragraph (b) of § 10.131.
- (17) Representing before the Office in a patent case either a joint venture comprising an inventor and an invention developer or an inventor referred to the registered practitioner by an invention developer when
  - (i) the registered practitioner knows, or has been advised by the Office, that a formal complaint filed by a federal or state agency, based on any violation of any law relating to securities, unfair methods of competition, unfair or deceptive acts or practices, mail fraud, or other civil or criminal conduct, is pending before a federal or state court or federal or state agency, or has been resolved unfavorably by such court or agency, against the invention developer in connection with invention development services and
  - (ii) the registered practitioner fails to fully advise the inventor of the existence of the pending complaint or unfavorable resolution thereof prior to undertaking or continuing representation of the joint venture or inventor.

“Invention developer” means any person, and any agent, employee, officer, partner, or independent contractor thereof, who is not a registered practitioner and who advertises invention development services in media of general circulation or who enters into contracts for invention development services with customers as a result of such advertisement. “Invention development services” means acts of invention development required or promised to be performed, or actually performed, or both, by an invention developer for a customer. “Invention development” means the evaluation, perfection, marketing, brokering, or promotion of an invention on behalf of a customer by an invention developer, including a patent search, preparation of a patent application, or any other act done by an invention developer for consideration toward the end of procuring or attempting to procure a license, buyer, or patent for an invention. “Customer” means any individual who has made an invention and who enters into a contract for invention development services with an invention developer with respect to the invention by which the inventor becomes obligated to pay the invention developer less than \$5,000 (not to include any additional sums which the invention developer is to receive as a result of successful development of the invention). “Contract for invention development services” means a contract for invention development services with an invention developer with respect to an invention made by a customer by which the inventor becomes obligated to pay the invention developer less than \$5,000 (not to include any additional sums which the invention developer is to receive as a result of successful development of the invention).

- (18) In the absence of information sufficient to establish a reasonable belief that fraud or inequitable conduct has occurred, alleging before a tribunal that anyone has committed a fraud on the Office or engaged in inequitable conduct in a proceeding before the Office.
- (19) Action by an employee of the Office contrary to the provisions set forth in § 10.10(c).
- (20) Knowing practice by a Government employee contrary to applicable Federal conflict of interest laws, or regulations of the Department, agency, or commission employing said individual.

(d) A practitioner who acts with reckless indifference to whether a representation is true or false is chargeable with knowledge of its falsity. Deceitful statements of half-truths or concealment

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of material facts shall be deemed actual fraud within the meaning of this part.

*[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985; amended 50 FR 25073, June 17, 1985; 50 FR 25980, June 24, 1985; paras. (c)(13), (19) & (20), 53 FR 33950, Oct. 4, 1988, effective Nov. 4, 1988; corrected 53 FR 41278, Oct. 20, 1988; paras. (c)(10) & (c)(11), 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; para. (c)(a) amended, 58 FR 54494, Oct. 2, 1993, effective Nov. 22, 1993]*

**37 CFR 10.24 Disclosure of information to authorities.**

(a) A practitioner possessing unprivileged knowledge of a violation of a Disciplinary Rule shall report such knowledge to the Director.

(b) A practitioner possessing unprivileged knowledge or evidence concerning another practitioner, employee of the Office, or a judge shall reveal fully such knowledge or evidence upon proper request of a tribunal or other authority empowered to investigate or act upon the conduct of practitioners, employees of the Office, or judges.

*[Added 50 FR 5176, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.25 [Reserved]****37 CFR 10.29 [Reserved]****37 CFR 10.30 Canon 2.**

A practitioner should assist the legal profession in fulfilling its duty to make legal counsel available.

*[Added 50 FR 5177, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.31 Communications concerning a practitioner's services.**

(a) No practitioner shall with respect to any prospective business before the Office, by word, circular, letter, or advertising, with intent to defraud in any manner, deceive, mislead, or threaten any prospective applicant or other person having immediate or prospective business before the Office.

(b) A practitioner may not use the name of a Member of either House of Congress or of an individual in the service of the United States in advertising the practitioner's practice before the Office.

(c) Unless authorized under § 10.14(b), a non-lawyer practitioner shall not hold himself or herself out as authorized to practice before the Office in trademark cases.

(d) Unless a practitioner is an attorney, the practitioner shall not hold himself or herself out:

(1) To be an attorney or lawyer or

(2) As authorized to practice before the Office in non-patent and trademark cases.

*[Added 50 FR 5177, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.32 Advertising.**

(a) Subject to § 10.31, a practitioner may advertise services through public media, including a telephone directory, legal directory, newspaper, or other periodical, radio, or television, or through written communications not involving solicitation as defined by § 10.33.

(b) A practitioner shall not give anything of value to a person for recommending the practitioner's services, except that a practitioner may pay the reasonable cost of advertising or written communication permitted by this section and may pay the usual charges of a not-for-profit lawyer referral service or other legal service organization.

(c) Any communication made pursuant to this section shall include the name of at least one practitioner responsible for its content.

*[Added 50 FR 5177, Feb. 6, 1985, effective Mar. 8, 1985]*

*Patent Laws and Regulations***37 CFR 10.33 Direct contact with prospective clients.**

A practitioner may not solicit professional employment from a prospective client with whom the practitioner has no family or prior professional relationship, by mail, in-person, or otherwise, when a significant motive for the practitioner's doing so is the practitioner's pecuniary gain under circumstances evidencing undue influence, intimidation, or overreaching. The term "solicit" includes contact in person, by telephone or telegraph, by letter or other writing, or by other communication directed to a specific recipient, but does not include letters addressed or advertising circulars distributed generally to persons not specifically known to need legal services of the kind provided by the practitioner in a particular manner, but who are so situated that they might in general find such services useful.

*[Added 50 FR 5177, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.34 Communications of fields of practice.**

A registered practitioner may state or imply that the practitioner is a specialist as follows:

(a) A registered practitioner who is an attorney may use the designation "Patents," "Patent Attorney," "Patent Lawyer," "Registered Patent Attorney," or a substantially similar designation.

(b) A registered practitioner who is not an attorney may use the designation "Patents," "Patent Agent," "Registered Patent Agent," or a substantially similar designation, except that any practitioner who was registered prior to November 15, 1938, may refer to himself or herself as a "patent attorney."

*[Added 50 FR 5177, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.35 Firm names and letterheads.**

(a) A practitioner shall not use a firm name, letterhead, or other professional designation that violates § 10.31. A trade name may be used by a practitioner in private practice if it does not imply a current connection with a government agency or with a public or charitable legal services organization and is not otherwise in violation of § 10.31.

(b) Practitioners may state or imply that they practice in a partnership or other organization only when that is the fact.

*[Added 50 FR 5177, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.36 Fees for legal services.**

(a) A practitioner shall not enter into an agreement for, charge, or collect an illegal or clearly excessive fee.

(b) A fee is clearly excessive when, after a review of the facts, a practitioner of ordinary prudence would be left with a definite and firm conviction that the fee is in excess of a reasonable fee. Factors to be considered as guides in determining the reasonableness of a fee include the following:

- (1) The time and labor required, the novelty and difficulty of the questions involved, and the skill requisite to perform the legal service properly.
- (2) The likelihood, if apparent to the client, that the acceptance of the particular employment will preclude other employment by the practitioner.
- (3) The fee customarily charged for similar legal services.
- (4) The amount involved and the results obtained.
- (5) The time limitations imposed by the client or by the circumstances.
- (6) The nature and length of the professional relationship with the client.
- (7) The experience, reputation, and ability of the practitioner or practitioners performing the services.
- (8) Whether the fee is fixed or contingent.

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*[Added 50 FR 5177, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.37 Division of fees among practitioners.**

(a) A practitioner shall not divide a fee for legal services with another practitioner who is not a partner in or associate of the practitioner's law firm or law office, unless:

- (1) The client consents to employment of the other practitioner after a full disclosure that a division of fees will be made.
- (2) The division is made in proportion to the services performed and responsibility assumed by each.
- (3) The total fee of the practitioners does not clearly exceed reasonable compensation for all legal services rendered to the client.

(b) This section does not prohibit payment to a former partner or associate pursuant to a separation or retirement agreement.

*[Added 50 FR 5177, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.38 Agreements restricting the practice of a practitioner.**

(a) A practitioner shall not be a party to or participate in a partnership or employment agreement with another practitioner that restricts the right of a practitioner to practice before the Office after the termination of a relationship created by the agreement, except as a condition to payment of retirement benefits.

(b) In connection with the settlement of a controversy or suit, a practitioner shall not enter into an agreement that restricts the practitioner's right to practice before the Office.

*[Added 50 FR 5177, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.39 Acceptance of employment.**

A practitioner shall not accept employment on behalf of a person if the practitioner knows or it is obvious that such person wishes to:

- (a) Bring a legal action, commence a proceeding before the Office, conduct a defense, assert a position in any proceeding pending before the Office, or otherwise have steps taken for the person, merely for the purpose of harassing or maliciously injuring any other person.
- (b) Present a claim or defense in litigation or any proceeding before the Office that it is not warranted under existing law, unless it can be supported by good faith argument for an extension, modification, or reversal of existing law.

*[Added 50 FR 5177, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.40 Withdrawal from employment.**

(a) A practitioner shall not withdraw from employment in a proceeding before the Office without permission from the Office (see §§ 1.36 and 2.19 of this subchapter). In any event, a practitioner shall not withdraw from employment until the practitioner has taken reasonable steps to avoid foreseeable prejudice to the rights of the client, including giving due notice to his or her client, allowing time for employment of another practitioner, delivering to the client all papers and property to which the client is entitled, and complying with applicable laws and rules. A practitioner who withdraws from employment shall refund promptly any part of a fee paid in advance that has not been earned.

(b) Mandatory withdrawal. A practitioner representing a client before the Office shall withdraw from employment if:

- (1) The practitioner knows or it is obvious that the client is bringing a legal action, commencing a proceeding before the Office, conducting a defense, or asserting a position in litigation or any proceeding pending before the Office, or is otherwise having steps taken for the client, merely for the purpose of harassing or maliciously injuring any person;

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- (2) The practitioner knows or it is obvious that the practitioner's continued employment will result in violation of a Disciplinary Rule;
- (3) The practitioner's mental or physical condition renders it unreasonably difficult for the practitioner to carry out the employment effectively; or
- (4) The practitioner is discharged by the client.

(c) Permissive withdrawal. If paragraph (b) of this section is not applicable, a practitioner may not request permission to withdraw in matters pending before the Office unless such request or such withdrawal is because:

- (1) The petitioner's client:
  - (i) Insists upon presenting a claim or defense that is not warranted under existing law and cannot be supported by good faith argument for an extension, modification, or reversal of existing law;
  - (ii) Personally seeks to pursue an illegal course of conduct;
  - (iii) Insists that the practitioner pursue a course of conduct that is illegal or that is prohibited under a Disciplinary Rule;
  - (iv) By other conduct renders it unreasonably difficult for the practitioner to carry out the employment effectively;
  - (v) Insists, in a matter not pending before a tribunal, that the practitioner engage in conduct that is contrary to the judgment and advice of the practitioner but not prohibited under the Disciplinary Rule; or
  - (vi) Has failed to pay one or more bills rendered by the practitioner for an unreasonable period of time or has failed to honor an agreement to pay a retainer in advance of the performance of legal services.
- (2) The practitioner's continued employment is likely to result in a violation of a Disciplinary Rule;
- (3) The practitioner's inability to work with co-counsel indicates that the best interests of the client likely will be served by withdrawal;
- (4) The practitioner's mental or physical condition renders it difficult for the practitioner to carry out the employment effectively;
- (5) The practitioner's client knowingly and freely assents to termination of the employment; or
- (6) The practitioner believes in good faith, in a proceeding pending before the Office, that the Office will find the existence of other good cause for withdrawal.

*[Added 50 FR 5178, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.41 [Reserved]**

**37 CFR 10.42 [Reserved]**

**37 CFR 10.43 [Reserved]**

**37 CFR 10.45 [Reserved]**

**37 CFR 10.46 Canon 3.**

A practitioner should assist in preventing the unauthorized practice of law.

*[Added 50 FR 5178, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.47 Aiding unauthorized practice of law.**

(a) A practitioner shall not aid a non-practitioner in the unauthorized practice of law before the Office.

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(b) A practitioner shall not aid a suspended or excluded practitioner in the practice of law before the Office.

(c) A practitioner shall not aid a non-lawyer in the unauthorized practice of law.

*[Added 50 FR 5178, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.48      Sharing legal fees.**

A practitioner or a firm of practitioners shall not share legal fees with a non-practitioner except that:

(a) An agreement by a practitioner with the practitioner's firm, partner, or associate may provide for the payment of money, over a reasonable period of time after the practitioner's death, to the practitioner's estate or to one or more specified persons.

(b) A practitioner who undertakes to complete unfinished legal business of a deceased practitioner may pay to the estate of the deceased practitioner that proportion of the total compensation which fairly represents the services rendered by the deceased practitioner.

(c) A practitioner or firm of practitioners may include non-practitioner employees in a compensation or retirement plan, even though the plan is based in whole or in part on a profit-sharing arrangement, providing such plan does not circumvent another Disciplinary Rule.

*[Added 50 FR 5178, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.49      Forming a partnership with a non-practitioner.**

A practitioner shall not form a partnership with a non-practitioner if any of the activities of the partnership consist of the practice of patent, trademark, or other law before the Office.

*[Added 50 FR 5178, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.50      [Reserved]**

**37 CFR 10.51      [Reserved]**

**37 CFR 10.52      [Reserved]**

**37 CFR 10.53      [Reserved]**

**37 CFR 10.54      [Reserved]**

**37 CFR 10.55      [Reserved]**

**37 CFR 10.56      Canon 4.**

A practitioner should preserve the confidences and secrets of a client.

*[Added 50 FR 5178, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.57      Preservation of confidences and secrets of a client.**

(a) "Confidence" refers to information protected by the attorney-client or agent-client privilege under applicable law. "Secret" refers to the other information gained in the professional relationship that the client has requested be held inviolate or the disclosure of which would be embarrassing or would be likely to be detrimental to the client.

(b) Except when permitted under paragraph (c) of this section, a practitioner shall not knowingly:

- (1) Reveal a confidence or secret of a client.
- (2) Use a confidence or secret of a client to the disadvantage of the client.
- (3) Use a confidence or secret of a client for the advantage of the practitioner or of a third person, unless the client consents after full disclosure.

(c) A practitioner may reveal: