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- (1) Confidences or secrets with the consent of the client affected but only after a full disclosure to the client.
- (2) Confidences or secrets when permitted under Disciplinary Rules or required by law or court order.
- (3) The intention of a client to commit a crime and the information necessary to prevent the crime.
- (4) Confidences or secrets necessary to establish or collect the practitioner's fee or to defend the practitioner or the practitioner's employees or associates against an accusation of wrongful conduct.

(d) A practitioner shall exercise reasonable care to prevent the practitioner's employees, associates, and others whose services are utilized by the practitioner from disclosing or using confidences or secrets of a client, except that a practitioner may reveal the information allowed by paragraph (c) of this section through an employee.

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

**37 CFR 10.58** [Reserved]

**37 CFR 10.59** [Reserved]

**37 CFR 10.60** [Reserved]

**37 CFR 10.61** Canon 5.

A practitioner should exercise independent professional judgment on behalf of a client.

*[Added 50 FR 5179, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.62** Refusing employment when the interest of the practitioner may impair the practitioner's independent professional judgment.

(a) Except with the consent of a client after full disclosure, a practitioner shall not accept employment if the exercise of the practitioner's professional judgment on behalf of the client will be or reasonably may be affected by the practitioner's own financial, business, property, or personal interests.

(b) A practitioner shall not accept employment in a proceeding before the Office if the practitioner knows or it is obvious that the practitioner or another practitioner in the practitioner's firm ought to sign an affidavit to be filed in the Office or be called as a witness, except that the practitioner may undertake the employment and the practitioner or another practitioner in the practitioner's firm may testify:

- (1) If the testimony will relate solely to an uncontested matter.
- (2) If the testimony will relate solely to a matter of formality and there is no reason to believe that substantial evidence will be offered in opposition to the testimony.
- (3) If the testimony will relate solely to the nature and value of legal services rendered in the case by the practitioner or the practitioner's firm to the client.
- (4) As to any matter, if refusal would work a substantial hardship on the client because of the distinctive value of the practitioner or the practitioner's firm as counsel in the particular case.

*[Added 50 FR 5179, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.63** Withdrawal when the practitioner becomes a witness.

(a) If, after undertaking employment in a proceeding in the Office, a practitioner learns or it is obvious that the practitioner or another practitioner in the practitioner's firm ought to sign an affidavit to be filed in the Office or be called as a witness on behalf of a practitioner's client, the practitioner shall withdraw from the conduct of the proceeding and the practitioner's firm, if any, shall not continue representation in the proceeding, except that the practitioner may continue the

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representation and the practitioner or another practitioner in the practitioner's firm may testify in the circumstances enumerated in paragraphs (1) through (4) of § 10.62(b).

(b) If, after undertaking employment in a proceeding before the Office, a practitioner learns or it is obvious that the practitioner or another practitioner in the practitioner's firm may be asked to sign an affidavit to be filed in the Office or be called as a witness other than on behalf of the practitioner's client, the practitioner may continue the representation until it is apparent that the practitioner's affidavit or testimony is or may be prejudicial to the practitioner's client.

*[Added 50 FR 5179, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.64      Avoiding acquisition of interest in litigation or proceeding before the Office.**

(a) A practitioner shall not acquire a proprietary interest in the subject matter of a proceeding before the Office which the practitioner is conducting for a client, except that the practitioner may:

- (1) Acquire a lien granted by law to secure the practitioner's fee or expenses; or
- (2) Contract with a client for a reasonable contingent fee; or
- (3) In a patent case, take an interest in the patent as part or all of his or her fee.

(b) While representing a client in connection with a contemplated or pending proceeding before the Office, a practitioner shall not advance or guarantee financial assistance to a client, except that a practitioner may advance or guarantee the expenses of going forward in a proceeding before the Office including fees required by law to be paid to the Office, expenses of investigation, expenses of medical examination, and costs of obtaining and presenting evidence, provided the client remains ultimately liable for such expenses. A practitioner may, however, advance any fee required to prevent or remedy an abandonment of a client's application by reason of an act or omission attributable to the practitioner and not to the client, whether or not the client is ultimately liable for such fee.

*[Added 50 FR 5179, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.65      Limiting business relations with a client.**

A practitioner shall not enter into a business transaction with a client if they have differing interests therein and if the client expects the practitioner to exercise professional judgment therein for the protection of the client, unless the client has consented after full disclosure.

*[Added 50 FR 5179, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.66      Refusing to accept or continue employment if the interests of another client may impair the independent professional judgment of the practitioner.**

(a) A practitioner shall decline proffered employment if the exercise of the practitioner's independent professional judgment in behalf of a client will be or is likely to be adversely affected by the acceptance of the proffered employment, or if it would be likely to involve the practitioner in representing differing interests, except to the extent permitted under paragraph (c) of this section.

(b) A practitioner shall not continue multiple employment if the exercise of the practitioner's independent professional judgment in behalf of a client will be or is likely to be adversely affected by the practitioner's representation of another client, or if it would be likely to involve the practitioner in representing differing interests, except to the extent permitted under paragraph (c) of this section.

(c) In the situations covered by paragraphs (a) and (b) of this section, a practitioner may represent multiple clients if it is obvious that the practitioner can adequately represent the interest of each and if each consents to the representation after full disclosure of the possible effect of such representation on the exercise of the practitioner's independent professional judgment on behalf of each.

(d) If a practitioner is required to decline employment or to withdraw from employment under a Disciplinary Rule, no partner, or associate, or any other practitioner affiliated with the practitioner

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or the practitioner's firm, may accept or continue such employment unless otherwise ordered by the Director or Commissioner.

*[Added 50 FR 5179, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.67      Settling similar claims of clients.**

A practitioner who represents two or more clients shall not make or participate in the making of an aggregate settlement of the claims of or against the practitioner's clients, unless each client has consented to the settlement after being advised of the existence and nature of all the claims involved in the proposed settlement, of the total amount of the settlement, and of the participation of each person in the settlement.

*[Added 50 FR 5179, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.68      Avoiding influence by others than the client.**

(a) Except with the consent of the practitioner's client after full disclosure, a practitioner shall not:

- (1) Accept compensation from one other than the practitioner's client for the practitioner's legal services to or for the client.
- (2) Accept from one other than the practitioner's client any thing of value related to the practitioner's representation of or the practitioner's employment by the client.

(b) A practitioner shall not permit a person who recommends, employs, or pays the practitioner to render legal services for another, to direct or regulate the practitioner's professional judgment in rendering such legal services.

(c) A practitioner shall not practice with or in the form of a professional corporation or association authorized to practice law for a profit, if a non-practitioner has the right to direct or control the professional judgment of a practitioner.

*[Added 50 FR 5180, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.69      [Reserved]**

**37 CFR 10.70      [Reserved]**

**37 CFR 10.71      [Reserved]**

**37 CFR 10.72      [Reserved]**

**37 CFR 10.73      [Reserved]**

**37 CFR 10.74      [Reserved]**

**37 CFR 10.75      [Reserved]**

**37 CFR 10.76      Canon 6.**

A practitioner should represent a client competently.

*[Added 50 FR 5180, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.77      Failing to act competently.**

A practitioner shall not:

(a) Handle a legal matter which the practitioner knows or should know that the practitioner is not competent to handle, without associating with the practitioner another practitioner who is competent to handle it.

(b) Handle a legal matter without preparation adequate in the circumstances.

(c) Neglect a legal matter entrusted to the practitioner.

*[Added 50 FR 5180, Feb. 6, 1985, effective Mar. 8, 1985]*

*Patent Laws and Regulations***37 CFR 10.78 Limiting liability to client.**

A practitioner shall not attempt to exonerate himself or herself from, or limit his or her liability to, a client for his or her personal malpractice.

*[Added 50 FR 5180, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.79 [Reserved]**

**37 CFR 10.80 [Reserved]**

**37 CFR 10.81 [Reserved]**

**37 CFR 10.82 [Reserved]**

**37 CFR 10.83 Canon 7.**

A practitioner should represent a client zealously within the bounds of the law.

*[Added 50 FR 5180, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.84 Representing a client zealously.**

(a) A practitioner shall not intentionally:

- (1) Fail to seek the lawful objectives of a client through reasonable available means permitted by law and the Disciplinary Rules, except as provided by paragraph (b) of this section. A practitioner does not violate the provisions of this section, however, by acceding to reasonable requests of opposing counsel which do not prejudice the rights of the client, by being punctual in fulfilling all professional commitments, by avoiding offensive tactics, or by treating with courtesy and consideration all persons involved in the legal process.
- (2) Fail to carry out a contract of employment entered into with a client for professional services, but a practitioner may withdraw as permitted under §§ 10.40, 10.63, and 10.66.
- (3) Prejudice or damage a client during the course of a professional relationship, except as required under this part.

(b) In representation of a client, a practitioner may:

- (1) Where permissible, exercise professional judgment to waive or fail to assert a right or position of the client.
- (2) Refuse to aid or participate in conduct that the practitioner believes to be unlawful, even though there is some support for an argument that the conduct is legal.

*[Added 50 FR 5180, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.85 Representing a client within the bounds of the law.**

(a) In representation of a client, a practitioner shall not:

- (1) Initiate or defend any proceeding before the Office, assert a position, conduct a defense, delay a trial or proceeding before the Office, or take other action on behalf of the practitioner's client when the practitioner knows or when it is obvious that such action would serve merely to harass or maliciously injure another.
- (2) Knowingly advance a claim or defense that is unwarranted under existing law, except that a practitioner may advance such claim or defense if it can be supported by good faith argument for an extension, modification, or reversal of existing law.
- (3) Conceal or knowingly fail to disclose that which the practitioner is required by law to reveal.
- (4) Knowingly use perjured testimony or false evidence.
- (5) Knowingly make a false statement of law or fact.

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- (6) Participate in the creation or preservation of evidence when the practitioner knows or it is obvious that the evidence is false.
- (7) Counsel or assist a client in conduct that the practitioner knows to be illegal or fraudulent.
- (8) Knowingly engage in other illegal conduct or conduct contrary to a Disciplinary Rule.
- (b) A practitioner who receives information clearly establishing that:
  - (1) A client has, in the course of the representation, perpetrated a fraud upon a person or tribunal shall promptly call upon the client to rectify the same, and if the client refuses or is unable to do so the practitioner shall reveal the fraud to the affected person or tribunal.
  - (2) A person other than a client has perpetrated a fraud upon a tribunal shall promptly reveal the fraud to the tribunal.

*[Added 50 FR 5180, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.86 [Reserved]**

**37 CFR 10.87 Communicating with one of adverse interest.**

During the course of representation of a client, a practitioner shall not:

(a) Communicate or cause another to communicate on the subject of the representation with a party the practitioner knows to be represented by another practitioner in that matter unless the practitioner has the prior consent of the other practitioner representing such other party or is authorized by law to do so. It is not improper, however, for a practitioner to encourage a client to meet with an opposing party for settlement discussions.

(b) Give advice to a person who is not represented by a practitioner other than the advice to secure counsel, if the interests of such person are to have a reasonable possibility of being in conflict with the interests of the practitioner's client.

*[Added 50 FR 5180, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.88 Threatening criminal prosecution.**

A practitioner shall not present, participate in presenting, or threaten to present criminal charges solely to obtain an advantage in any prospective or pending proceeding before the Office.

*[Added 50 FR 5180, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.89 Conduct in proceedings.**

(a) A practitioner shall not disregard or advise a client to disregard any provision of this Subchapter or a decision of the Office made in the course of a proceeding before the Office, but the practitioner may take appropriate steps in good faith to test the validity of such provision or decision.

(b) In presenting a matter to the Office, a practitioner shall disclose:

- (1) Controlling legal authority known to the practitioner to be directly adverse to the position of the client and which is not disclosed by opposing counsel or an employee of the Office.
- (2) Unless privileged or irrelevant, the identities of the client the practitioner represents and of the persons who employed the practitioner.

(c) In appearing in a professional capacity before a tribunal, a practitioner shall not:

- (1) State or allude to any matter that the practitioner has no reasonable basis to believe is relevant to the case or that will not be supported by admissible evidence.
- (2) Ask any question that the practitioner has no reasonable basis to believe is

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relevant to the case and that is intended to degrade a witness or other person.

- (3) Assert the practitioner's personal knowledge of the facts in issue, except when testifying as a witness.
- (4) Assert the practitioner's personal opinion as to the justness of a cause, as to the credibility of a witness, as to the culpability of a civil litigant, or as to the guilt or innocence of an accused; but the practitioner may argue, on the practitioner's analysis of the evidence, for any position or conclusion with respect to the matters stated herein.
- (5) Engage in undignified or discourteous conduct before the Office (see § 1.3 of the subchapter).
- (6) Intentionally or habitually violate any provision of this subchapter or established rule of evidence.

*[Added 50 FR 5180, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.90** [Reserved]

**37 CFR 10.91** [Reserved]

**37 CFR 10.92** Contact with witnesses.

(a) A practitioner shall not suppress any evidence that the practitioner or the practitioner's client has a legal obligation to reveal or produce.

(b) A practitioner shall not advise or cause a person to be sequestered or to leave the jurisdiction of a tribunal for the purpose of making the person unavailable as a witness therein.

(c) A practitioner shall not pay, offer to pay, or acquiesce in payment of compensation to a witness contingent upon the content of the witness' affidavit, testimony or the outcome of the case. But a practitioner may advance, guarantee, or acquiesce in the payment of:

- (1) Expenses reasonably incurred by a witness in attending, testifying, or making an affidavit.
- (2) Reasonable compensation to a witness for the witness' loss of time in attending, testifying, or making an affidavit.
- (3) A reasonable fee for the professional services of an expert witness.

*[Added 50 FR 5181, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.93** Contact with officials.

(a) A practitioner shall not give or lend anything of value to a judge, official, or employee of a tribunal under circumstances which might give the appearance that the gift or loan is made to influence official action.

(b) In an adversary proceeding, including any inter partes proceeding before the Office, a practitioner shall not communicate, or cause another to communicate, as to the merits of the cause with a judge, official, or Office employee before whom the proceeding is pending, except:

- (1) In the course of official proceedings in the cause.
- (2) In writing if the practitioner promptly delivers a copy of the writing to opposing counsel or to the adverse party if the adverse party is not represented by a practitioner.
- (3) Orally upon adequate notice to opposing counsel or to the adverse party if the adverse party is not represented by a practitioner.
- (4) As otherwise authorized by law.

*[Added 50 FR 5181, Feb. 6, 1985, effective Mar. 8, 1985]*

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**37 CFR 10.94** [Reserved]

**37 CFR 10.95** [Reserved]

**37 CFR 10.96** [Reserved]

**37 CFR 10.97** [Reserved]

**37 CFR 10.98** [Reserved]

**37 CFR 10.99** [Reserved]

**37 CFR 10.100** **Canon 8.**

A practitioner should assist in improving the legal system.

*[Added 50 FR 5181, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.101** **Action as a public official.**

(a) A practitioner who holds public office shall not:

- (1) Use the practitioner's public position to obtain, or attempt to obtain, a special advantage in legislative matters for the practitioner or for a client under circumstances where the practitioner knows or it is obvious that such action is not in the public interest.
- (2) Use the practitioner's public position to influence, or attempt to influence, a tribunal to act in favor of the practitioner or of a client.
- (3) Accept any thing of value from any person when the practitioner knows or it is obvious that the offer is for the purpose of influencing the practitioner's action as a public official.

(b) A practitioner who is an officer or employee of the United States shall not practice before the Office in patent cases except as provided in §§ 10.10(c) and 10.10(d).

*[Added 50 FR 5181, Feb. 6, 1985, effective Mar. 8, 1985; para. (b) amended, 54 FR 6520, Feb. 13, 1989]*

**37 CFR 10.102** **Statements concerning officials.**

(a) A practitioner shall not knowingly make false statements of fact concerning the qualifications of a candidate for election or appointment to a judicial office or to a position in the Office.

(b) A practitioner shall not knowingly make false accusations against a judge, other adjudicatory officer, or employee of the Office.

*[Added 50 FR 5181, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.103** **Practitioner candidate for judicial office.**

A practitioner who is a candidate for judicial office shall comply with applicable provisions of law.

*[Added 50 FR 5181, Feb. 6, 1985, effective Mar. 8, 1985]*

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37 CFR 10.104 [Reserved]

37 CFR 10.105 [Reserved]

37 CFR 10.106 [Reserved]

37 CFR 10.107 [Reserved]

37 CFR 10.108 [Reserved]

37 CFR 10.109 [Reserved]

37 CFR 10.110 Canon 9.

A practitioner should avoid even the appearance of professional impropriety.

*[Added 50 FR 5181, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.111 Avoiding even the appearance of impropriety.**

(a) A practitioner shall not accept private employment in a matter upon the merits of which he or she has acted in a judicial capacity.

(b) A practitioner shall not accept private employment in a matter in which he or she had personal responsibility while a public employee.

(c) A practitioner shall not state or imply that the practitioner is able to influence improperly or upon irrelevant grounds any tribunal, legislative body, or public official.

*[Added 50 FR 5181, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.112 Preserving identity of funds and property of client.**

(a) All funds of clients paid to a practitioner or a practitioner's firm, other than advances for costs and expenses, shall be deposited in one or more identifiable bank accounts maintained in the United States or, in the case of a practitioner having an office in a foreign country or registered under § 10.6(c), in the United States or the foreign country.

(b) No funds belonging to the practitioner or the practitioner's firm shall be deposited in the bank accounts required by paragraph (a) of this section except as follows:

- (1) Funds reasonably sufficient to pay bank charges may be deposited therein.
- (2) Funds belonging in part to a client and in part presently or potentially to the practitioner or the practitioner's firm must be deposited therein, but the portion belonging to the practitioner or the practitioner's firm may be withdrawn when due unless the right of the practitioner or the practitioner's firm to receive it is disputed by the client, in which event the disputed portion shall not be withdrawn until the dispute is finally resolved.

(c) A practitioner shall:

- (1) Promptly notify a client of the receipt of the client's funds, securities, or other properties.
- (2) Identify and label securities and properties of a client promptly upon receipt and place them in a safe deposit box or other place of safekeeping as soon as practicable.
- (3) Maintain complete records of all funds, securities, and other properties of a client coming into the possession of the practitioner and render appropriate accounts to the client regarding the funds, securities, or other properties.
- (4) Promptly pay or deliver to the client as requested by a client the funds, securities, or other properties in the possession of the practitioner which the client is entitled to receive.

*[Added 50 FR 5181, Feb. 6, 1985, effective Mar. 8, 1985]*



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37 CFR 10.113	[Reserved]
37 CFR 10.114	[Reserved]
37 CFR 10.115	[Reserved]
37 CFR 10.116	[Reserved]
37 CFR 10.117	[Reserved]
37 CFR 10.118	[Reserved]
37 CFR 10.119	[Reserved]
37 CFR 10.120	[Reserved]
37 CFR 10.121	[Reserved]
37 CFR 10.122	[Reserved]
37 CFR 10.123	[Reserved]
37 CFR 10.124	[Reserved]
37 CFR 10.125	[Reserved]
37 CFR 10.126	[Reserved]
37 CFR 10.127	[Reserved]
37 CFR 10.128	[Reserved]
37 CFR 10.129	[Reserved]

**INVESTIGATIONS AND DISCIPLINARY PROCEEDINGS****37 CFR 10.130 Reprimand, suspension or exclusion.**

(a) The Commissioner may, after notice and opportunity for a hearing, (1) reprimand or (2) suspend or exclude, either generally or in any particular case, any individual, attorney, or agent shown to be incompetent or disreputable, who is guilty of gross misconduct, or who violates a Disciplinary Rule.

(b) Petitions to disqualify a practitioner in ex parte or inter partes cases in the Office are not governed by §§ 10.130 through 10.170 and will be handled on a case-by-case basis under such conditions as the Commissioner deems appropriate.

*[Added 50 FR 5181, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.131 Investigations.**

(a) The Director is authorized to investigate possible violations of Disciplinary Rules by practitioners. See § 10.2(b)(2).

(b) Practitioners shall report and reveal to the Director any knowledge or evidence required by § 10.24. A practitioner shall cooperate with the Director in connection with any investigation under paragraph (a) of this section and with officials of the Office in connection with any disciplinary proceeding instituted under § 10.132(b).

(c) Any nonpractitioner possessing knowledge or information concerning a violation of a Disciplinary Rule by a practitioner may report the violation to the Director. The Director may require that the report be presented in the form of an affidavit.

*[Added 50 FR 5181, Feb. 6, 1985, effective Mar. 8, 1985]*

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**37 CFR 10.132     Initiating a disciplinary proceeding; reference to an administrative law judge.**

(a) If after conducting an investigation under § 10.131(a) the Director is of the opinion that a practitioner has violated a Disciplinary Rule, the Director shall, after complying where necessary with the provisions of 5 U.S.C. 558(c), call a meeting of the Committee on Discipline. The Committee on Discipline shall then determine as specified in § 10.4(b) whether a disciplinary proceeding shall be instituted under paragraph (b) of this section.

(b) If the Committee on Discipline determines that probable cause exists to believe that a practitioner has violated a Disciplinary Rule, the Director shall institute a disciplinary proceeding by filing a complaint under § 10.134. The complaint shall be filed in the Office of the Director. A disciplinary proceeding may result in:

- (1) A reprimand, or
- (2) Suspension or exclusion of a practitioner from practice before the Office.

(c) Upon the filing of a complaint under § 10.134, the Commissioner will refer the disciplinary proceeding to an administrative law judge.

*[Added 50 FR 5181, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.133     Conference between Director and practitioner; resignation.**

(a) General. The Director may confer with a practitioner concerning possible violations by the practitioner of a Disciplinary Rule whether or not a disciplinary proceeding has been instituted.

(b) Resignation. Any practitioner who is the subject of an investigation under § 10.131 or against whom a complaint has been filed under § 10.134 may resign from practice before the Office only by submitting with the Director an affidavit stating his or her desire to resign.

(c) If filed prior to the date set by the administrative law judge for a hearing, the affidavit shall state that:

- (1) The resignation is freely and voluntarily proffered;
- (2) The practitioner is not acting under duress or coercion from the Office;
- (3) The practitioner is fully aware of the implications of filing the resignation;
- (4) The practitioner is aware
  - (i) of a pending investigation or
  - (ii) of charges arising from the complaint alleging that he or she is guilty of a violation of the Patent and Trademark Office Code of Professional Responsibility, the nature of which shall be set forth by the practitioner to the satisfaction of the Director;
- (5) The practitioner acknowledges that, if and when he or she applies for reinstatement under § 10.160, the Director will conclusively presume, for the limited purpose of determining the application for reinstatement, that:
  - (i) The facts upon which the complaint is based are true and
  - (ii) The practitioner could not have successfully defended himself or herself against (A) charges predicated on the violation under investigation or (B) charges set out in the complaint filed against the practitioner.

(d) If filed on or after the date set by the administrative law judge for a hearing, the affidavit shall make the statements required by paragraphs (b) (1) through (4) of this section and shall state that:

- (1) The practitioner acknowledges the facts upon which the complaint is based are true; and
- (2) The resignation is being submitted because the practitioner could not successfully

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defend himself or herself against

- (i) charges predicated on the violation under investigation or
- (ii) charges set out in the complaint.

(e) When an affidavit under paragraphs (b) or (c) of this section is received while an investigation is pending, the Commissioner shall enter an order excluding the practitioner "on consent." When an affidavit under paragraphs (b) or (c) of this section is received after a complaint under § 10.134 has been filed, the Director shall notify the administrative law judge. The administrative law judge shall enter an order transferring the disciplinary proceeding to the Commissioner and the Commissioner shall enter an order excluding the practitioner "on consent."

(f) Any practitioner who resigns from practice before the Office under this section and who intends to reapply for admission to practice before the Office must comply with the provisions of § 10.158.

(g) Settlement. Before or after a complaint is filed under § 10.134, a settlement conference may occur between the Director and a practitioner for the purpose of settling any disciplinary matter. If an offer of settlement is made by the Director or the practitioner and is not accepted by the other, no reference to the offer of settlement or its refusal shall be admissible in evidence in the disciplinary proceeding unless both the Director and the practitioner agree in writing.

*[Added 50 FR 5181, Feb. 6, 1985, effective Mar. 8, 1985]*

### **37 CFR 10.134 Complaint.**

(a) A complaint instituting a disciplinary proceeding shall:

- (1) Name the practitioner, who may then be referred to as the "respondent."
- (2) Give a plain and concise description of the alleged violations of the Disciplinary Rules by the practitioner.
- (3) State the place and time for filing an answer by the respondent.
- (4) State that a decision by default may be entered against the respondent if an answer is not timely filed.
- (5) Be signed by the Director.

(b) A complaint will be deemed sufficient if it fairly informs the respondent of any violation of the Disciplinary Rules which form the basis for the disciplinary proceeding so that the respondent is able to adequately prepare a defense.

*[Added 50 FR 5182, Feb. 6, 1985, effective Mar. 8, 1985]*

### **37 CFR 10.135 Service of complaint.**

(a) A complaint may be served on a respondent in any of the following methods:

- (1) By handing a copy of the complaint personally to the respondent, in which case the individual handing the complaint to the respondent shall file an affidavit with the Director indicating the time and place the complaint was handed to the respondent.
- (2) By mailing a copy of the complaint by "Express Mail" or first-class mail to:
  - (i) A registered practitioner at the address for which separate notice was last received by the Director or
  - (ii) A nonregistered practitioner at the last address for the respondent known to the Director.
- (3) By any method mutually agreeable to the Director and the respondent.

(b) If a complaint served by mail under paragraph (a)(2) of this section is returned by the U.S. Postal Service, the Director shall mail a second copy of the complaint to the respondent. If the second copy of the complaint is also returned by the U.S. Postal Service, the Director shall serve the respondent by publishing an appropriate notice in the Official Gazette for four consecutive weeks, in

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which case the time for answer shall be at least thirty days from the fourth publication of the notice.

(c) If a respondent is a registered practitioner, the Director may serve simultaneously with the complaint a letter under § 10.11(b). The Director may require the respondent to answer the § 10.11(b) letter within a period of not less than 15 days. An answer to the § 10.11(b) letter shall constitute proof of service. If the respondent fails to answer the § 10.11(b) letter, his or her name will be removed from the register as provided by § 10.11(b).

(d) If the respondent is represented by an attorney under § 10.140(a), a copy of the complaint shall also be served on the attorney.

*[Added 50 FR 5183, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.136 Answer to complaint.**

(a) Time for answer. An answer to a complaint shall be filed within a time set in the complaint which shall be not less than thirty days.

(b) With whom filed. The answer shall be filed in writing with the administrative law judge. The time for filing an answer may be extended once for a period of no more than thirty days by the administrative law judge upon a showing of good cause provided a motion requesting an extension of time is filed within thirty days after the date the complaint is filed by the Director. A copy of the answer shall be served on the Director.

(c) Content. The respondent shall include in the answer a statement of the facts which constitute the grounds of defense and shall specifically admit or deny each allegation set forth in the complaint. The respondent shall not deny a material allegation in the complaint which the respondent knows to be true or state that respondent is without sufficient information to form a belief as to the truth of an allegation when in fact the respondent possesses that information. The respondent shall also state affirmatively special matters of defense.

(d) Failure to deny allegations in complaint. Every allegation in the complaint which is not denied by a respondent in the answer is deemed to be admitted and may be considered proven. No further evidence in respect of that allegation need be received by the administrative law judge at any hearing. Failure to timely file an answer will constitute an admission of the allegations in the complaint.

(e) Reply by the Director. No reply to an answer is required by the Director and any affirmative defense in the answer shall be deemed to be denied. The Director may, however, file a reply if he or she chooses or if ordered by the administrative law judge.

*[Added 50 FR 5183, Feb. 6, 1985, effective Mar. 8, 1985; amended 50 FR 25073, June 17, 1985, ]*

**37 CFR 10.137 Supplemental complaint.**

False statements in an answer may be made the basis of a supplemental complaint.

*[Added 50 FR 5183, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.138 Contested case.**

Upon the filing of an answer by the respondent, a disciplinary proceeding shall be regarded as a contested case within the meaning of 35 U.S.C. 24. Evidence obtained by a subpoena issued under 35 U.S.C. 24 shall not be admitted into the record or considered unless leave to proceed under 35 U.S.C. 24 was previously authorized by the administrative law judge.

*[Added 50 FR 5183, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.139 Administrative law judge; appointment; responsibilities; review of interlocutory orders; stays.**

(a) Appointment. An administrative law judge, appointed under 5 U.S.C. 3105, shall conduct disciplinary proceedings as provided by this part.

(b) Responsibilities. The administrative law judge shall have authority to:

(1) Administer oaths and affirmations;

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- (2) Make rulings upon motions and other requests;
- (3) Rule upon offers of proof, receive relevant evidence, and examine witnesses;
- (4) Authorize the taking of a deposition of a witness in lieu of personal appearance of the witness before the administrative law judge;
- (5) Determine the time and place of any hearing and regulate its course and conduct;
- (6) Hold or provide for the holding of conferences to settle or simplify the issues.
- (7) Receive and consider oral or written arguments on facts and law;
- (8) Adopt procedures and modify procedures from time to time as occasion requires for the orderly disposition of proceedings;
- (9) Make initial decisions under § 10.154; and
- (10) Perform acts and take measures as necessary to promote the efficient and timely conduct of any disciplinary proceeding.

(c) Time for making initial decision. The administrative law judge shall set times and exercise control over a disciplinary proceeding such that an initial decision under § 10.154 is normally issued within six months of the date a complaint is filed. The administrative law judge may, however, issue an initial decision more than six months after a complaint is filed if in his or her opinion there exist unusual circumstances which preclude issuance of an initial decision within six months of the filing of the complaint.

(d) Review of interlocutory orders. An interlocutory order of an administrative law judge will not be reviewed by the Commissioner except:

- (1) when the administrative law judge shall be of the opinion
  - (i) that the interlocutory order involves a controlling question of procedure or law as to which there is a substantial ground for a difference of opinion and
  - (ii) that an immediate decision by the Commissioner may materially advance the ultimate termination of the disciplinary proceeding; or
- (2) in an extraordinary situation where justice requires review.

(e) Stays pending review of interlocutory order. If the Director or a respondent seeks review of an interlocutory order of an administrative law judge under paragraph (b)(2) of this section, any time period set for taking action by the administrative law judge shall not be stayed unless ordered by the Commissioner or the administrative law judge.

*[Added 50 FR 5183, Feb. 6, 1985, effective Mar. 8, 1985; amended 50 FR 25073, June 17, 1985]*

### **37 CFR 10.140 Representative for Director or respondent.**

(a) A respondent may be represented before the Office in connection with an investigation or disciplinary proceeding by an attorney. The attorney shall file a written declaration that he or she is an attorney within the meaning of § 10.1(c) and shall state:

- (1) The address to which the attorney wants correspondence related to the investigation or disciplinary proceeding sent; and
- (2) A telephone number where the attorney may be reached during normal business hours.

(b) The Commissioner shall designate at least two associate solicitors in the Office of the Solicitor to act as representatives for the Director in disciplinary proceedings. In prosecuting disciplinary proceedings, the designated associate solicitors shall not involve the Solicitor or the Deputy Solicitor. The Solicitor and the Deputy Solicitor shall remain insulated from the investigation and prosecution of all disciplinary proceedings in order that they shall be available as counsel to the Commissioner in deciding disciplinary proceedings.

*Patent Laws and Regulations**[Added 50 FR 5183, Feb. 6, 1985, effective Mar. 8, 1985]***37 CFR 10.141 Filing of papers.**

- (a) The provisions of § 1.8 of this subchapter do not apply to disciplinary proceedings.
- (b) All papers filed after the complaint and prior to entry of an initial decision by the administrative law judge shall be filed with the administrative law judge at an address or place designated by the administrative law judge. All papers filed after entry of an initial decision by the administrative law judge shall be filed with the Director. The Director shall promptly forward to the Commissioner any paper which requires action under this part by the Commissioner.
- (c) The administrative law judge or the Director may provide for filing papers and other matters by hand or "Express Mail."

*[Added 50 FR 5184, Feb. 6, 1985, effective Mar. 8, 1985]***37 CFR 10.142 Service of papers.**

- (a) All papers other than a complaint shall be served on a respondent represented by an attorney by:
  - (1) Delivering a copy of the paper to the office of the attorney; or
  - (2) Mailing a copy of the paper by first-class mail or "Express Mail" to the attorney at the address provided by the attorney under § 10.140(a)(1); or
  - (3) Any other method mutually agreeable to the attorney and a representative for the Director.
- (b) All papers other than a complaint shall be served on a respondent who is not represented by an attorney by:
  - (1) Delivering a copy of the paper to the respondent; or
  - (2) Mailing a copy of the paper by first-class mail or "Express Mail" to the respondent at the address to which a complaint may be served or such other address as may be designated in writing by the respondent; or
  - (3) Any other method mutually agreeable to the respondent and a representative of the Director.
- (c) A respondent shall serve on the representative for the Director one copy of each paper filed with the administrative law judge or the Director. A paper may be served on the representative of the Director by:
  - (1) Delivering a copy of the paper to the representative; or
  - (2) Mailing a copy of the paper by first-class mail or "Express Mail" to an address designated in writing by the representative; or
  - (3) Any other method mutually agreeable to the respondent and the representative.
- (d) Each paper filed in a disciplinary proceeding shall contain therein a certificate of service indicating:
  - (1) The date of which service was made; and
  - (2) The method by which service was made.
- (e) The administrative law judge or the Commissioner may require that a paper be served by hand or by "Express Mail."
- (f) Service by mail is completed when the paper mailed in the United States is placed into the custody of the U.S. Postal Service.

*[Added 50 FR 5184, Feb. 6, 1985, effective Mar. 8, 1985]*

*Patent Laws and Regulations***37 CFR 10.143 Motions.**

Motions may be filed with the administrative law judge. The administrative law judge will determine on a case-by-case basis the time period for response to a motion and whether replies to responses will be authorized. No motion shall be filed with the administrative law judge unless such motion is supported by a written statement by the moving party that the moving party or attorney for the moving party has conferred with the opposing party or attorney for the opposing party in an effort in good faith to resolve by agreement the issues raised by the motion and has been unable to reach agreement. If issues raised by a motion are resolved by the parties prior to a decision on the motion by the administrative law judge, the parties shall promptly notify the administrative law judge.

*[Added 50 FR 5184, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.144 Hearings.**

(a) The administrative law judge shall preside at hearings in disciplinary proceedings. Hearings will be stenographically recorded and transcribed and the testimony of witnesses will be received under oath or affirmation. The administrative law judge shall conduct hearings in accordance with 5 U.S.C. 556. A copy of the transcript of the hearing shall become part of the record. A copy of the transcript shall be provided to the Director and the respondent at the expense of the Office.

(b) If the respondent to a disciplinary proceeding fails to appear at the hearing after a notice of hearing has been given by the administrative law judge, the administrative law judge may deem the respondent to have waived the right to a hearing and may proceed with the hearing in the absence of the respondent.

(c) A hearing under this section will not be open to the public except that the Director may grant a request by a respondent to open his or her hearing to the public and make the record of the disciplinary proceeding available for public inspection, provided, Agreement is reached in advance to exclude from public disclosure information which is privileged or confidential under applicable laws or regulations. If a disciplinary proceeding results in disciplinary action against a practitioner, and subject to § 10.159(c), the record of the entire disciplinary proceeding, including any settlement agreement, will be available for public inspection.

*[Added 50 FR 5184, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.145 Proof; variance; amendment of pleadings.**

In case of a variance between the evidence and the allegations in a complaint, answer, or reply, if any, the administrative law judge may order or authorize amendment of the complaint, answer, or reply to conform to the evidence. Any party who would otherwise be prejudiced by the amendment will be given reasonable opportunity to meet the allegations in the complaint, answer, or reply, as amended, and the administrative law judge shall make findings on any issue presented by the complaint, answer, or reply as amended.

*[Added 50 FR 5184, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.146 [Reserved]****37 CFR 10.147 [Reserved]****37 CFR 10.148 [Reserved]****37 CFR 10.149 Burden of proof.**

In a disciplinary proceeding, the Director shall have the burden of proving his or her case by clear and convincing evidence and a respondent shall have the burden of proving any affirmative defense by clear and convincing evidence.

*[Added 50 FR 5184, Feb. 6, 1985, effective Mar. 8, 1985]*

**37 CFR 10.150 Evidence.**

(a) Rules of evidence. The rules of evidence prevailing in courts of law and equity are not