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controlling in hearings in disciplinary proceedings. However, the administrative law judge shall exclude evidence which is irrelevant, immaterial, or unduly repetitious.

(b) Depositions. Depositions of witnesses taken pursuant to § 10.151 may be admitted as evidence.

(c) Government documents. Official documents, records, and papers of the Office are admissible without extrinsic evidence of authenticity. These documents, records, and papers may be evidenced by a copy certified as correct by an employee of the Office.

(d) Exhibits. If any document, record, or other paper is introduced in evidence as an exhibit, the administrative law judge may authorize the withdrawal of the exhibit subject to any conditions the administrative law judge deems appropriate.

(e) Objections. Objections to evidence will be in short form, stating the grounds of objection. Objections and rulings on objections will be a part of the record. No exception to the ruling is necessary to preserve the rights of the parties.

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

37 CFR 10.151 Depositions.

(a) Depositions for use at the hearing in lieu of personal appearance of a witness before the administrative law judge may be taken by respondent or the Director upon a showing of good cause and with the approval of, and under such conditions as may be deemed appropriate by, the administrative law judge. Depositions may be taken upon oral or written questions, upon not less than ten days' written notice to the other party, before any officer authorized to administer an oath or affirmation in the place where the deposition is to be taken. The requirement of ten days' notice may be waived by the parties and depositions may then be taken of a witness at a time and place mutually agreed to by the parties. When a deposition is taken upon written questions, copies of the written questions will be served upon the other party with the notice and copies of any written cross-questions will be served by hand or "Express Mail" not less than five days before the date of the taking of the deposition unless the parties mutually agree otherwise. A party on whose behalf a deposition is taken shall file a copy of a transcript of the deposition signed by a court reporter with the administrative law judge and shall serve one copy upon the opposing party. Expenses for a court reporter and preparing, serving, and filing depositions shall be borne by the party at whose instance the deposition is taken.

(b) When the Director and the respondent agree in writing, a deposition of any witness who will appear voluntarily may be taken under such terms and conditions as may be mutually agreeable to the Director and the respondent. The deposition shall not be filed with the administrative law judge and may not be admitted in evidence before the administrative law judge unless he or she orders the deposition admitted in evidence. The admissibility of the deposition shall lie within the discretion of the administrative law judge who may reject the deposition on any reasonable basis including the fact that demeanor is involved and that the witness should have been called to appear personally before the administrative law judge.

[Added 50 FR 5185, Feb. 6, 1985, effective Mar. 8, 1985]

37 CFR 10.152 Discovery.

Discovery shall not be authorized except as follows:

(a) After an answer is filed under § 10.136 and when a party establishes in a clear and convincing manner that discovery is necessary and relevant, the administrative law judge, under such conditions as he or she deems appropriate, may order an opposing party to:

- (1) Answer a reasonable number of written requests for admission or interrogatories;
- (2) Produce for inspection and copying a reasonable number of documents; and
- (3) Produce for inspection a reasonable number of things other than documents.

(b) Discovery shall not be authorized under paragraph (a) of this section of any matter which:

- (1) Will be used by another party solely for impeachment or cross-examination;

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- (2) Is not available to the party under 35 U.S.C. § 122;
 - (3) Relates to any disciplinary proceeding commenced in the Patent and Trademark Office prior to March 8, 1985;
 - (4) Relates to experts except as the administrative law judge may require under paragraph (e) of this section.
 - (5) Is privileged; or
 - (6) Relates to mental impressions, conclusions, opinions, or legal theories of any attorney or other representative of a party.
- (c) The administrative law judge may deny discovery requested under paragraph (a) of this section if the discovery sought:
- (1) Will unduly delay the disciplinary proceeding;
 - (2) Will place an undue burden on the party required to produce the discovery sought; or
 - (3) Is available
 - (i) generally to the public,
 - (ii) equally to the parties; or
 - (iii) to the party seeking the discovery through another source.
- (d) Prior to authorizing discovery under paragraph (a) of this section, the administrative law judge shall require the party seeking discovery to file a motion (w 10.143) and explain in detail for each request made how the discovery sought is necessary and relevant to an issue actually raised in the complaint or the answer.
- (e) The administrative law judge may require parties to file and serve, prior to any hearing, a pre-hearing statement which contains:
- (1) A list (together with a copy) of all proposed exhibits to be used in connection with a party's case-in-chief,
 - (2) A list of proposed witnesses,
 - (3) As to each proposed expert witness:
 - (i) An identification of the field in which the individual will be qualified as an expert;
 - (ii) A statement as to the subject matter on which the expert is expected to testify; and
 - (iii) A statement of the substance of the facts and opinions to which the expert is expected to testify,
 - (4) The identity of government employees who have investigated the case, and
 - (5) Copies of memoranda reflecting respondent's own statements to administrative representatives.
- (f) After a witness testifies for a party, if the opposing party requests, the party may be required to produce, prior to cross-examination, any written statement made by the witness.

[Added 50 FR 5185, Feb. 6, 1985, effective Mar. 8, 1985]

37 CFR 10.153 Proposed findings and conclusions; post-hearing memorandum.

Except in cases when the respondent has failed to answer the complaint, the administrative law judge, prior to making an initial decision, shall afford the parties a reasonable opportunity to submit proposed findings and conclusions and a post-hearing memorandum in support of the proposed findings and conclusions.

*Patent Laws and Regulations**[Added 50 FR 5185, Feb. 6, 1985, effective Mar. 8, 1985]***37 CFR 10.154 Initial decision of administrative law judge.**

(a) The administrative law judge shall make an initial decision in the case. The decision will include (1) a statement of findings and conclusions, as well as the reasons or basis therefor with appropriate references to the record, upon all the material issues of fact, law, or discretion presented on the record, and (2) an order of suspension or exclusion from practice, an order of reprimand, or an order dismissing the complaint. The administrative law judge shall file the decision with the Director and shall transmit a copy to the representative of the Director and to the respondent. In the absence of an appeal to the Commissioner, the decision of the administrative law judge will, without further proceedings, become the decision of the Commissioner of Patents and Trademarks thirty (30) days from the date of the decision of the administrative law judge.

(b) The initial decision of the administrative law judge shall explain the reason for any penalty or reprimand, suspension or exclusion. In determining any penalty, the following should normally be considered:

- (1) The public interest;
- (2) The seriousness of the violation of the Disciplinary Rule;
- (3) The deterrent effects deemed necessary;
- (4) The integrity of the legal profession; and
- (5) Any extenuating circumstances.

*[Added 50 FR 5185, Feb. 6, 1985, effective Mar. 8, 1985; amended 50 FR 25073, June 17, 1985]***37 CFR 10.155 Appeal to the Commissioner.**

(a) Within thirty (30) days from the date of the initial decision of the administrative law judge under § 10.154, either party may appeal to the Commissioner. An appeal by the respondent will be filed with the Director in duplicate and will include exceptions to the decisions of the administrative law judge and supporting reasons for those exceptions. If the Director files the appeal, the Director shall serve a copy of the appeal. Within thirty (30) days after receipt of an appeal or copy thereof, the other party may file a reply brief, in duplicate with the Director. If the Director files the reply brief, the Director shall serve a copy of the reply brief. Upon the filing of an appeal and a reply brief, if any, the Director shall transmit the entire record to the Commissioner.

(b) The appeal will be decided by the Commissioner on the record made before the administrative law judge.

(c) The Commissioner may order reopening of a disciplinary proceeding in accordance with the principles which govern the granting of new trials. Any request to reopen a disciplinary proceeding on the basis of newly discovered evidence must demonstrate that the newly discovered evidence could not have been discovered by due diligence.

(d) In the absence of an appeal by the Director, failure by the respondent to appeal under the provisions of this section shall be deemed to be both acceptance by the respondent of the initial decision and waiver by the respondent of the right to further administrative or judicial review.

*[Added 50 FR 5185, Feb. 6, 1985, effective Mar. 8, 1985; para. (d) added, 54 FR 26026, June 21, 1989, effective Aug. 1, 1989]***37 CFR 10.156 Decision of the Commissioner.**

(a) An appeal from an initial decision of the administrative law judge shall be decided by the Commissioner. The Commissioner may affirm, reverse, or modify the initial decision or remand the matter to the administrative law judge for such further proceedings as the Commissioner may deem appropriate. Subject to paragraph (c) of this section, a decision by the Commissioner does not become a final agency action in a disciplinary proceeding until 20 days after it is entered. In making a final decision, the Commissioner shall review the record or these portions of the record as may be cited by the parties in order to limit the issues. The Commissioner shall transmit a copy of the final decision to the Director and to the respondent.

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(b) A final decision of the Commissioner may dismiss a disciplinary proceeding, reprimand a practitioner, or may suspend or exclude the practitioner from practice before the Office.

(c) A single request for reconsideration or modification of the Commissioner's decision may be made by the respondent or the Director if filed within 20 days from the date of entry of the decision. Such a request shall have the effect of staying the effective date of the decision. The decision by the Commissioner on the request is a final agency action in a disciplinary proceeding and is effective on its date of entry.

[Added 50 FR 5186, Feb. 6, 1985, effective Mar. 8, 1985; para. (a) amended and para. (c) added, 54 FR 6660, Feb. 14, 1989]

37 CFR 10.157 Review of Commissioner's final decision.

(a) Review of the Commissioner's final decision in a disciplinary case may be had, subject to § 10.155(d), by a petition filed in the United States District Court for the District of Columbia. See 35 U.S.C. 32 and Local Rule 213 of the United States District Court for the District of Columbia.

(b) The Commissioner may stay a final decision pending review of the Commissioner's final decision.

[Added 50 FR 5186, Feb. 6, 1985, effective Mar. 8, 1985; amended 53 FR 13120, Apr. 21, 1988; para. (a) amended, 54 FR 26026, June 21, 1989, effective Aug. 1, 1989]

37 CFR 10.158 Suspended or excluded practitioner.

(a) A practitioner who is suspended or excluded from practice before the Office under § 10.156(b) shall not engage in unauthorized practice of patent, trademark and other non-patent law before the Office.

(b) Unless otherwise ordered by the Commissioner, any practitioner who is suspended or excluded from practice before the Office under § 10.156(b) shall:

- (1) Within 30 days of entry of the order of suspension or exclusion, notify all bars of which he or she is a member and all clients of the practitioner for whom he or she is handling matters before the Office in separate written communications of the suspension or exclusion and shall file a copy of each written communication with the Director.
- (2) Within 30 days of entry of the order of suspension or exclusion, surrender a client's active Office case files to
 - (i) the client or
 - (ii) another practitioner designated by the client.
- (3) Not hold himself or herself out as authorized to practice law before the Office.
- (4) Promptly take any necessary and appropriate steps to remove from any telephone, legal, or other directory any advertisement, statement, or representation which would reasonably suggest that the practitioner is authorized to practice patent, trademark, or other non-patent law before the Office, and within 30 days of taking those steps, file with the Director an affidavit describing the precise nature of the steps taken.
- (5) Not advertise the practitioner's availability or ability to perform or render legal services for any person having immediate, prospective, or pending business before the Office.
- (6) Not render legal advice or services to any person having immediate, prospective, or pending business before the Office as to that business.
- (7) Promptly take steps to change any sign identifying a practitioner's or the practitioner's firm's office and practitioner's or the practitioner's firm's stationery to delete therefrom any advertisement, statement, or representation which would reasonably suggest that the practitioner is authorized to practice law before the

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Office.

- (8) Within 30 days, return to any client any unearned funds, including any unearned retainer fee, and any securities and property of the client.

(c) A practitioner who is suspended or excluded from practice before the Office and who aids another practitioner in any way in the other practitioner's practice of law before the Office, may, under the direct supervision of the other practitioner, act as a paralegal for the other practitioner or perform other services for the other practitioner which are normally performed by lay-persons, provided:

- (1) The practitioner who is suspended or excluded is:
- (i) A salaried employee of:
 - (A) The other practitioner;
 - (B) The other practitioner's law firm; or
 - TO(C) A client-employer who employs the other practitioner as a salaried employee;
 - (2) The other practitioner assumes full professional responsibility to any client and the Office for any work performed by the suspended or excluded practitioner for the other practitioner;
 - (3) The suspended or excluded practitioner, in connection with any immediate, prospective, or pending business before the Office, does not:
 - (i) Communicate directly in writing, orally, or otherwise with a client of the other practitioner;
 - (ii) Render any legal advice or any legal services to a client of the other practitioner; or
 - (iii) Meet in person or in the presence of the other practitioner with:
 - (A) Any Office official in connection with the prosecution of any patent, trademark, or other case;
 - (B) Any client of the other practitioner, the other practitioner's law firm, or the client-employer of the other practitioner;
 - (C) Any witness or potential witness which the other practitioner, the other practitioner's law firm, or the other practitioner's client-employer may or intends to call as a witness in any proceeding before the Office. The term "witness" includes individuals who will testify orally in a proceeding before, or sign an affidavit or any other document to be filed in, the Office.

(d) When a suspended or excluded practitioner acts as a paralegal or performs services under paragraph (c) of this section, the suspended or excluded practitioner shall not thereafter be reinstated to practice before the Office unless:

- (1) The suspended or excluded practitioner shall have filed with the Director an affidavit which
- (i) explains in detail the precise nature of all paralegal or other services performed by the suspended or excluded practitioner and
 - (ii) shows by clear and convincing evidence that the suspended or excluded practitioner has complied with the provisions of this section and all Disciplinary Rules, and
- (2) The other practitioner shall have filed with the Director a written statement which
- (i) shows that the other practitioner has read the affidavit required by subparagraph (d)(1) of this section and that the other practitioner believes every statement in the affidavit to be true and

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- (ii) states why the other practitioner believes that the suspended or excluded practitioner has complied with paragraph (c) of this section.

[Added 50 FR 5186, Feb. 6, 1985, effective Mar. 8, 1985]

37 CFR 10.159 Notice of suspension or exclusion.

(a) Upon issuance of a final decision reprimanding a practitioner or suspending or excluding a practitioner from practice before the Office, the Director shall give notice of the final decision to appropriate employees of the Office and to interested departments, agencies, and courts of the United States. The Director shall also give notice to appropriate authorities of any State in which a practitioner is known to be a member of the bar and any appropriate bar association.

(b) The Director shall cause to be published in the Official Gazette the name of any practitioner suspended or excluded from practice. Unless otherwise ordered by the Commissioner, the Director shall publish in the Official Gazette the name of any practitioner reprimanded by the Commissioner.

(c) The Director shall maintain records, which shall be available for public inspection, of every disciplinary proceeding where practitioner is reprimanded, suspended, or excluded unless the Commissioner orders that the proceeding be kept confidential.

[Added 50 FR 5186, Feb. 6, 1985, effective Mar. 8, 1985]

37 CFR 10.160 Petitioner for reinstatement.

(a) A petition for reinstatement of a practitioner suspended for a period of less than five years will not be considered until the period of suspension has been passed.

(b) A petition for reinstatement of a practitioner excluded from practice will not be considered until five years after the effective date of the exclusion.

(c) An individual who has resigned under § 10.133 or who has been suspended or excluded may file a petition for reinstatement. The Director may grant a petition for reinstatement when the individual makes a clear and convincing showing that the individual will conduct himself or herself in accordance with the regulations of this part and that granting a petition for reinstatement is not contrary to the public interest. As a condition to reinstatement, the Director may require the individual to:

- (1) Meet the requirements of § 10.7, including taking and passing an examination under § 10.7(b) and
- (2) Pay all or a portion of the costs and expenses, not to exceed \$1,500, of the disciplinary proceeding which led to suspension or exclusion.

(d) Any suspended or excluded practitioner who has violated the provisions of § 10.158 during his or her period of suspension or exclusion shall not be entitled to reinstatement until such time as the Director is satisfied that a period of suspension equal in time to that ordered by the Commissioner or exclusion for five years has passed during which the suspended or excluded practitioner has complied with the provisions of § 10.158.

(e) Proceedings on any petition for reinstatement shall be open to the public. Before reinstating any suspended or excluded practitioner, the Director shall publish in the Official Gazette a notice of the suspended or excluded practitioner's petition for reinstatement and shall permit the public a reasonable opportunity to comment or submit evidence with respect to the petition for reinstatement.

[Added 50 FR 5186, Feb. 6, 1985, effective Mar. 8, 1985]

37 CFR 10.161 Savings clause.

(a) A disciplinary proceeding based on conduct engaged in prior to the effective date of these regulations may be instituted subsequent to such effective date, if such conduct would continue to justify suspension or exclusion under the provisions of this part.

(b) No practitioner shall be subject to a disciplinary proceeding under this part based on

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conduct engaged in before the effective date hereof if such conduct would not have been subject to disciplinary action before such effective date.

[Added 50 FR 5186, Feb. 6, 1985, effective Mar. 8, 1985]

37 CFR 10.162 [Reserved]

37 CFR 10.163 [Reserved]

37 CFR 10.164 [Reserved]

37 CFR 10.165 [Reserved]

37 CFR 10.166 [Reserved]

37 CFR 10.167 [Reserved]

37 CFR 10.168 [Reserved]

37 CFR 10.169 [Reserved]

37 CFR 10.170 Suspension of rules.

(a) In an extraordinary situation, when justice requires, any requirement of the regulations of this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, sua sponte, or on petition of any party, including the Director or the Director's representative, subject to such other requirements as may be imposed.

(b) Any petition under this section will not stay a disciplinary proceeding unless ordered by the Commissioner or an administrative law judge.

[Added 50 FR 5186, Feb. 6, 1985, effective Mar. 8, 1985]

*Patent Laws and Regulations***PART 15—SERVICE OF PROCESS**

Sec.

- 15.1 Scope and purpose.
- 15.2 Definitions.
- 15.3 Acceptance of service of process.

Authority: 5 U.S.C. 301; 15 U.S.C. 1501, 1512, 1513, 1515, and 1518; Reorganization Plan No. 5 of 1950; 44 U.S.C. 3101; 15 CFR 15.2(a).

37 CFR 15.1 Scope and purpose.

(a) This part supplements 15 CFR Part 15 and sets forth the procedures to be followed when a summons or complaint is served on the Office or the Commissioner or an employee of the Office in his or her official capacity. This part is to be construed consistent with 15 CFR Part 15.

(b) This part is intended to ensure the orderly execution of the affairs of the Office and not to impede any legal proceeding.

(c) This part does not apply to subpoenas. The procedures to be followed with respect to subpoenas are set out in Part 15a of this Title.

(d) This part does not apply to service of process made on an Office employee personally on matters not related to official business of the Office or to the official responsibilities of the Office employee.

37 CFR 15.2 Definitions.

For the purpose of this part:

- (a) "Commissioner" means Assistant Secretary and Commissioner of Patents and Trademarks.
- (b) "Legal proceeding" means a proceeding before a tribunal constituted by law, including a court, an administrative body or commission, or an administrative law judge or hearing officer.
- (c) "Office" means Patent and Trademark Office.
- (d) "Office employee" means any officer or employee of the Office.
- (e) "Official business" means the authorized business of the Office.
- (f) "Solicitor" means the chief legal officer of the Office or other Office employee to whom the Solicitor has delegated authority to act under this part.

37 CFR 15.3 Acceptance of service of process.

(a) Any summons or complaint to be served in person or by registered or certified mail or as otherwise authorized by law on the Office or the Commissioner or an Office employee in his or her official capacity, shall be served on the Solicitor or an Office employee designated by the Solicitor.

(b) Any summons or complaint to be served by mail may be addressed to Solicitor, P.O. Box 15667, Arlington, Virginia 22215. Any summons or complaint to be served by hand may be delivered to the Office of the Solicitor.

(c) Any Office employee served with a summons or complaint shall immediately notify and deliver the summons or complaint to the Office of the Solicitor.

(d) Any Office employee receiving a summons or complaint shall note on the summons or complaint the date, hour, and place of service and whether service was by personal delivery or by mail.

(e) When a legal proceeding is brought to hold an Office employee personally liable in connection with an action taken in the conduct of official business, rather than liable in an official capacity, the Office employee by law is to be served personally with process. Service of process in this case is inadequate when made upon the Solicitor or the Solicitor's designee. Any Office employee sued personally for an action taken in the conduct of official business shall immediately notify and

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deliver a copy of the summons or complaint to the Office of the Solicitor.

(f) An Office employee sued personally in connection with official business may be represented by the Department of Justice at its discretion. See 28 CFR 50.15 and 50.16 (1987).

(g) The Solicitor or Office employee designated by the Solicitor, when accepting service of process for an Office employee in an official capacity, shall endorse on the Marshal's or server's return of service form or receipt for registered or certified mail the following statement: "Service accepted in official capacity only." The statement may be placed on the form or receipt with a rubber stamp.

(h) Upon acceptance of service or receiving notification of service, as provided in this section, the Solicitor shall take appropriate steps to protect the rights of the Commissioner or Office employee involved.

**PART 15a—TESTIMONY BY EMPLOYEES AND THE
PRODUCTION OF DOCUMENTS IN LEGAL PROCEEDINGS**

Sec.

- 15a.1 Scope.
- 15a.2 Definitions.
- 15a.3 Office policy.
- 15a.4 Testimony or production of documents; general rule.
- 15a.5 Testimony of Office employees in proceedings involving the United States.
- 15a.6 Legal proceedings between private litigants.
- 15a.7 Procedures when an Office employee receives a subpoena.

Authority: 5 U.S.C. 301; 15 U.S.C. 1501, 1512, 1513, 1515, and 1518; Reorganization Plan No. 5 of 1950; 44 U.S.C. 3101; 15 CFR 15a.1(e) and 15a.2(f).

37 CFR 15a.1 Scope.

(a) This part supplements 15 CFR Part 15a and prescribes the policies and procedures of the Office with respect to the testimony of Office employees as witnesses in legal proceedings and the production of documents of the Office for use in legal proceedings pursuant to a request, order, or subpoena. This part is issued pursuant to 15 CFR 15a.1(e) and is to be construed consistent with 15 CFR 15a.

(b) This part does not apply to any legal proceeding in which an Office employee is to testify, while on leave status, as to facts or events that are in no way related to the official business of the Office.

(c) This part is intended to ensure the orderly execution of the affairs of the Office and not to impede any legal proceeding and in no way affects the rights and procedures governing public access to records pursuant to the Freedom of Information Act or the Privacy Act. See 15 CFR 15a.4 and 37 CFR 1.15.

37 CFR 15a.2 Definitions.

For the purpose of this part:

- (a) “Commissioner” means Assistant Secretary and Commissioner of Patents and Trademarks.
- (b) “Demand” means a request, order, or subpoena for testimony or documents for use in a legal proceeding.
- (c) “Document” means any record, paper, and other property held by the Office, including without limitation official patent and trademark files, official letters, telegrams, memoranda, reports, studies, calendar and diary entries, maps, graphs, pamphlets, notes, charts, tabulations, analyses, statistical or informational accumulations, any kind of summaries of meetings and conversations, film impressions, magnetic tapes, and sound or mechanical reproductions.
- (d) “Legal proceeding” means a proceeding before a tribunal constituted by law, including a court, an administrative body or commission, an administrative law judge or hearing officer or any discovery proceeding in support thereof.
- (e) “Office” means Patent and Trademark Office.
- (f) “Office employee” means any officer or employee of the Office.
- (g) “Official business” means the authorized business of the Office.
- (h) “Solicitor” means the chief legal officer of the Office or other Office employee to whom the Solicitor has delegated authority to act under this part.
- (i) “Testimony” means a statement given in person before a tribunal or by deposition for use before the tribunal or any other statement given for use before a tribunal in a legal proceeding, including an affidavit, declaration under 35 U.S.C. 25, or declaration under 28 U.S.C. 1746.

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(j) “United States” means the Federal Government, its departments and agencies, and individuals acting on behalf of the Federal Government.

37 CFR 15a.3 Office policy.

The Office policy is that its documents will not be voluntarily produced and Office employees will not voluntarily appear as witnesses or give testimony in a legal proceeding. The reasons for this policy include:

- (a) To conserve the time of Office employees for conducting official business.
- (b) To minimize the possibility of involving the Office in controversial or other issues which are not related to the mission of the Office.
- (c) To prevent the possibility that the public will misconstrue variances between personal opinions of Office employees and Office policy.
- (d) To avoid spending the time and money of the United States for private purposes.
- (e) To preserve the integrity of the administrative process, minimize disruption of the decision-making process, and prevent interference with the Office's administrative functions.

37 CFR 15a.4 Testimony or production of documents; general rule.

(a) No Office employee shall give testimony concerning the official business of the Office or produce any document in any legal proceeding without the prior authorization of the Solicitor. Where appropriate, an Office employee may be instructed in writing by the Commissioner, Solicitor, or other appropriate Office employee not to give testimony or produce a document.

Without prior approval, no Office employee shall answer inquiries from a person not employed by the Department of Commerce regarding testimony or documents subject to a demand or a potential demand under the provisions of this Part. All inquiries involving a demand or potential demand on an Office employee shall be referred to the Solicitor.

(b) A certified copy of a document, not otherwise available under Chapter I of this Title, will be provided for use in a legal proceeding upon written request and payment of applicable fees required by law.

(c)(1) Request for testimony or document. A request for testimony of an Office employee or document shall be mailed or hand-delivered to the Office of the Solicitor. The mailing address of the Office of the Solicitor is Box 8, Patent and Trademark Office, Washington, D.C. 20231.

- (2) Subpoenas. A subpoena for testimony by an Office employee or a document shall be served in accordance with the Federal Rules of Civil or Criminal Procedure as appropriate, or applicable state procedure, and a copy of the subpoena shall be sent to the Solicitor.
- (3) Affidavit. Every request and subpoena shall be accompanied by an affidavit or declaration under 28 U.S.C. 1746 or, if an affidavit or declaration is not feasible, a written statement setting forth the title of the legal proceeding, the forum, the requesting party's interest in the legal proceeding, the reasons for the request or subpoena, a showing that the desired testimony or document is not reasonably available from any other source, and if testimony is requested, the intended use of the testimony, a general summary of the testimony desired, and a showing that no document could be provided and used in lieu of testimony. The purpose of this requirement is to permit the Solicitor to make an informed decision as to whether testimony or production of a document should be authorized.

(d) Any Office employee who is served with a demand shall immediately notify the Office of the Solicitor.

(e) The Solicitor may consult or negotiate with an attorney for a party or the party, if not represented by an attorney, to refine or limit a demand so that compliance is less burdensome or obtain information necessary to make the determination required by paragraph (c) of this section. Failure of the attorney or party to cooperate in good faith to enable an informed determination to be made under this part may serve as the basis for a determination not to comply with the demand.

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(f) A determination under this part to comply or not to comply with a demand is not an assertion or waiver of privilege, lack of relevance, technical deficiencies, or any other ground for noncompliance. The Commissioner reserves the right to oppose any demand on any legal ground independent of any determination under this part.

37 CFR 15a.5 Testimony of Office employees in proceedings involving the United States.

(a) An Office employee may not testify as an expert or opinion witness for any party other than the United States.

(b) When appropriate, the Solicitor may authorize an Office employee to give testimony as an expert or opinion witness on behalf of the United States. Expert or opinion testimony on behalf of the United States will not be authorized in any legal proceeding involving the validity or enforceability of a patent or registered trademark.

(c) Whenever, in any legal proceeding involving the United States, a request is made by an attorney representing or acting under the authority of the United States, the Solicitor will make all necessary arrangements for the Office employee to give testimony on behalf of the United States. Where appropriate, the Solicitor may require reimbursement to the Office of the expenses associated with an Office employee giving testimony on behalf of the United States.

37 CFR 15a.6 Legal proceedings between private litigants.

(a) Testimony by an Office employee and production of documents in a legal proceeding not involving the United States shall be governed by § 15a.4.

(b) If an Office employee is authorized to give testimony in a legal proceeding, the testimony, if otherwise proper, shall be limited to facts within the personal knowledge of the Office employee. An Office employee is prohibited from giving expert or opinion testimony, answering hypothetical or speculative questions, or giving testimony with respect to subject matter which is privileged. If an Office employee is authorized to testify in connection with the employee's involvement or assistance in a quasi-judicial proceeding which took place before the Office, that employee is further prohibited from giving testimony in response to questions which seek:

- (1) Information about that employee's:
 - (i) Background.
 - (ii) Expertise.
 - (iii) Qualifications to examine or otherwise consider a particular patent or trademark application.
 - (iv) Usual practice or whether the employee followed a procedure set out in any Office manual of practice in a particular case.
 - (v) Consultation with another Office employee.
 - (vi) Understanding of:
 - (A) A patented invention, an invention sought to be patented, or patent application, patent, reexamination or interference file.
 - (B) Prior art.
 - (C) Registered subject matter, subject matter sought to be registered, or a trademark application, registration, opposition, cancellation, interference, or concurrent use file.
 - (D) Any Office manual of practice.
 - (E) Office regulations.
 - (F) Patent, trademark, or other law.
 - (G) The responsibilities of another Office employee.
 - (vii) Reliance on particular facts or arguments.
- (2) To inquire into the manner in and extent to which the employee considered or

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studied material in performing the quasi-judicial function.

- (3) To inquire into the bases, reasons, mental processes, analyses, or conclusions of that Office employee in performing the quasi-judicial function.

37 CFR 15a.7 Procedures when an Office employee receives a subpoena.

(a) Any Office employee who receives a subpoena shall immediately forward the subpoena to the Office of the Solicitor. The Solicitor will determine the extent to which an Office employee will comply with the subpoena.

(b) If the Office employee is not authorized to comply with the subpoena, the Office employee shall appear at the time and place stated in the subpoena, produce a copy of Part 15a of Title 15 and a copy of this part, and respectfully refuse to provide any testimony or produce any document. *United States ex rel. Touhy v. Ragen*. 340 U.S. 462 (1951).

(c) When necessary or appropriate, the Solicitor will request assistance from the Department of Justice or a U.S. Attorney or otherwise assure the presence of an attorney to represent the interests of the Office or an Office employee.

SUBCHAPTER B-GOVERNMENT INVENTIONS JURISDICTION

PART 100-RESERVED

PART 101-ACQUISITION AND PROTECTION OF FOREIGN
RIGHTS IN INVENTIONS

Sec.

- 101.1 Purpose.
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- 101.11 Dissemination of this part.

AUTHORITY: E.O. 9865, 3 CFR 1943-1948 Comp., p. 651, E.O. 10096, 3 CFR 1948-1953 Comp., p. 292.

SOURCE: Administrative Order 6, 19 FR 3937, June 29, 1954, unless otherwise noted. Redesignated at 34 FR 20383, Dec. 31, 1969.

37 CFR 101.1 Purpose.

The purpose of this part is to provide for the administration of a uniform policy for the Government with respect to the acquisition and protection of foreign rights in and to certain inventions.

37 CFR 101.2 Authority.

Authority for the issuance of this part is provided in E.O. 9865, dated June 14, 1947 (12 FR 3907), as amended by paragraph 5 of E.O. 10096, dated January 23, 1960 (15 PR 389).

37 CFR 101.3 Scope.

This Part is restricted to inventions to which the Government is entitled to acquire, or may acquire, title or the right to file foreign patent applications or otherwise to seek protection abroad thereon. Exempted from the provisions of this part are

- (a) Inventions within the jurisdiction of the Atomic Energy Commission, except in such cases as the said Commission specifically authorizes the inclusion of an invention, and
- (b) inventions officially classified for reasons of the national security, until such inventions become declassified.

37 CFR 101.4 Option to be obtained

(a) When the Government is entitled to acquire foreign rights in and to an invention made by a Government employee, including the right to file for foreign patent applications or otherwise to seek protection abroad on the invention, the Government agency concerned shall obtain an option to acquire such rights.

(b) When the Government is entitled to acquire foreign rights in and to an invention made pursuant to contract, including the right to file foreign patent applications or otherwise to seek protection abroad on the invention, the Government agency concerned shall, when the agency deems it desirable, obtain an option to acquire such rights.

*Patent Laws and Regulations***37 CFR 101.5 Action by agency concerned**

Subject to the approval of the Chairman of the Government Patents Board on all matters of policy, the Government agency concerned shall, with respect to each invention to which the option specified in § 101.4 is obtained or on which the foreign rights have been acquired, determine whether or not and in what foreign jurisdictions patent protection should be sought in the public interest. Upon determining that foreign patent protection is desirable, the agency shall:

(a) To the extent of available funds within its own appropriation, take or cause to be taken all action necessary to secure such foreign patent protection of the invention, consistent with existing law and the requirements of the Government; and

(b) If sufficient funds are not available within its own appropriation or the agency does not see fit to use funds when available, furnish the Secretary of Commerce as soon as practicable, preferably not later than two months after the filing of the application for United States patent on the invention, through the use of Foreign Patent Protection Reporting Form TS-12, sufficient information concerning the invention and the reasons for its determination with respect to the desirability of foreign patent protection, to enable the Secretary of Commerce to seek the financial support of other interested Government agencies and/or of industry in securing foreign patent protection of the invention.

37 CFR 101.6 Action by the Department of Commerce.

Subject to the approval of the Chairman of the Government Patents Board on all matters of policy, the Secretary of Commerce shall, immediately upon receipt of a Foreign Patent Protection Reporting Form TS-12 on an invention, pursuant to § 101.5(b):

(a) Consult with Government agencies and with United States industry and commerce, familiar with the technical, scientific, industrial, commercial or other economic or social factors affecting the invention involved, to ascertain possible interest in foreign patent protection of the invention and willingness to finance such protection; and

(b) After such consultation and consideration of such factors as the availability of valid patent protection in the countries selected and to the extent of funds made available by Government agencies and/or industry, take or cause to be taken all action necessary to secure such protection of the invention, consistent with existing law and the requirements of the Government.

37 CFR 101.7 Publication in lieu of patenting.

When the foreign rights of the Government with respect to an invention may be adequately protected through prompt disclosure of the invention in lieu of patenting, the Government agency concerned, or the Secretary of Commerce in cooperation with the Government agency concerned, may, with the approval of the Chairman of the Government Patents Board, cause the invention to be disclosed by publication thereof.

37 CFR 101.8 Foreign filing by inventor.

When the foreign rights in and to an invention are not assigned to the Government but the Government may, at its option or on request, acquire such rights and determines not to cause an application to be filed in any particular foreign country or otherwise to seek protection of the invention, or fails to take such action:

(a) Within six months of the filing of an application for United States patent on the invention, or

(b) Within six months of declassification of an invention previously under a security classification, or

(c) Within six months after disclosure of an invention to the Government pursuant to contract, whichever is later,

such determination or such failure to act shall constitute a decision by the Government to leave such rights to the inventor subject, to the extent practicable, to a nonexclusive, irrevocable, royalty-