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Double Standards: An Empirical Study of Patent and Trademark Discipline

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DOUBLE STANDARDS: AN EMPIRICAL STUDY OF PATENT AND TRADEMARK DISCIPLINE

JON J. LEE

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JON J. LEE*

Abstract: Our legal system is built on the foundation that lawyers have a number of coexisting and sometimes conflicting duties—to their clients, to others who might be affected by their practice, and to the effective and equitable administration of justice. Although most lawyers fulfill these duties ethically, invariably some fail to live up to these expectations. For this reason, all states have created disciplinary authorities to regulate and sanction lawyer misconduct. Interestingly, the United States Patent and Trademark Office (USPTO) is one of the few agencies to have developed its own disciplinary system for policing the conduct of those who practice before it. The USPTO’s need to regulate the conduct of trademark attorneys and patent practitioners is largely due to the critical role that these professionals play in the provision of intellectual property rights. Yet the existence of this analogous disciplinary system is little more than window dressing if the USPTO does not leverage its authority to ensure that those it regulates conform their conduct to the ethical standards of the profession. Through innovative empirical methods marshalling data over sixteen years from disciplinary authorities throughout the country, this Article shows that the USPTO is not only failing to discipline bad actors with regularity, but also overlooking the types of misconduct that threaten to undercut the provision of intellectual property rights that are in the public interest.

INTRODUCTION

Intellectual property is often one of the most valuable—and hotly contested—assets of a corporation.¹ A utility patent provides its holder with twenty

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¹ See, e.g., Jack Nicas, *Apple and Samsung End Smartphone Patent Wars*, N.Y. TIMES (June 27, 2018), <https://www.nytimes.com/2018/06/27/technology/apple-samsung-smartphone-patent.html> [<https://>

years of exclusive use over the patented invention, during which time the holder can choose to sell the invention itself or license the right to make use of the invention to others for a sizeable fee.² For example, Lipitor, the cholesterol-lowering drug, generated approximately \$130 billion for Pfizer just during the fourteen years it was sold under patent protection.³ Following expiration, its sales dipped from more than \$10 billion annually to just over \$2 billion⁴—a dramatic hit to be sure, but still likely allowing Pfizer to benefit from the consumer recognition of its established brand.⁵

Though “patent wars” may grab headlines in the popular media,⁶ trademarks arguably have even greater influence because they may exist in perpetuity and are ubiquitous in their reach across industries and sectors.⁷ At the 141st Annual Meeting of the International Trademark Association in 2019, Andrei Iancu, the U.S. Patent and Trademark Office (USPTO) Director, touted the power of trademark protection in building a brand, noting that “trademark applicants have, on average, 34% higher employment and 24% greater revenue in the period following first filing, compared to a control group of non-filers.”⁸ Indeed, a 2011 study found that Google’s trademark was worth an estimated

perma.cc/SN9N-ZPJW] (discussing the end of a seven-year legal fight between Apple and Samsung over smartphone technology, involving several lawsuits).

² See 35 U.S.C. § 154 (2018) (explaining content and terms of patent rights).

³ Editorial, *Lessons from Lipitor and the Broken Blockbuster Drug Model*, 378 THE LANCET 1976, 1976 (2011).

⁴ U.S. SEC. & EXCH. COMM’N, PFIZER, INC., ANNUAL REPORT (FORM 10-K) 26 (2018) (reporting annual sales of Lipitor); see Duff Wilson, *Facing Generic Lipitor Rivals, Pfizer Battles to Protect Its Cash Cow*, N.Y. TIMES (Nov. 29, 2011), <https://www.nytimes.com/2011/11/30/health/generic-lipitor-sets-off-an-aggressive-push-by-pfizer.html> [<https://perma.cc/AW9A-QCK6>] (describing Pfizer’s strategy to avoid losses upon the expiration of the Lipitor patent).

⁵ See Jing Luo et al., *Effect of Generic Competition on Atorvastatin Prescribing and Patients’ Out-of-Pocket Spending*, 176 JAMA INTERNAL MED. 1317, 1318 (2016) (presenting the results of a study of consumer spending on Lipitor after patent expiration, suggesting that many continued to spend more for the brand name).

⁶ “Patent wars” refer to the contentious litigation between entities over patent rights. See, e.g., Nicas, *supra* note 1 (reporting on the legal battle over patent rights between Apple and Samsung). See generally THOMAS F. COTTER, PATENT WARS: HOW PATENTS IMPACT OUR DAILY LIVES (2018) (providing a comprehensive examination of patent laws and litigation).

⁷ ECON. & STATISTICS ADMIN. & U.S. PATENT & TRADEMARK OFFICE, INTELLECTUAL PROPERTY AND THE U.S. ECONOMY: 2016 UPDATE, at ii (2016), <https://www.uspto.gov/sites/default/files/documents/IPandtheUSEconomySept2016.pdf> [<https://perma.cc/K5CB-SUXD>] (“Trademark-intensive industries are the largest in number and contribute the most employment with 23.7 million jobs in 2014 . . .”).

⁸ Andrei Iancu, Dir., U.S. Patent & Trademark Office, Remarks by Director Iancu at International Trademark Association 141st Annual Meeting (May 21, 2019) [hereinafter Iancu, Remarks at International Trademark Association], <https://www.uspto.gov/about-us/news-updates/remarks-director-iancu-international-trademark-association-141st-annual> [<https://perma.cc/K2R6-5CDD>].

\$44.3 billion, just inching out Microsoft's trademark that was estimated to be worth \$42.8 billion.⁹

But there exists an even broader perspective on the reach of intellectual property, one that extends beyond the immediate profit potential for those who hold its rights.¹⁰ Scholars long have advanced the argument that intellectual property rights may themselves serve as conduits to advancing public interests.¹¹ Under this theory, patents are awarded to inventors so that inventors will share their inventions with others—thereby benefitting the public interest.¹² Trademarks are valuable because they provide consumers a “shortcut to finding the products they desire,” while the federal registration system simultaneously provides protection for businesses that wish to carve out a space for themselves in the marketplace.¹³ Although this theory is not without criticisms,¹⁴ the USPTO itself has repeatedly posited that all of its decisions affect the public interest.¹⁵

At the same time, the implications for under-regulation of intellectual property rights may be far-reaching. On the heels of the catastrophic implosion of Theranos, the infamous health company that falsely claimed to have developed revolutionary blood tests, the media called out the USPTO for its role in granting Elizabeth Holmes the credibility she needed to attract investors and business partners through the issuance of several patents.¹⁶ Even after the details of the Theranos scam came to light, the USPTO issued the already-defunct company five additional patents.¹⁷ On the trademark side, recently

⁹ See Sean Stonefield, *The 10 Most Valuable Trademarks*, FORBES (June 15, 2011), <https://www.forbes.com/sites/seanstonefield/2011/06/15/the-10-most-valuable-trademarks/#6785979236b8> [<https://perma.cc/M73Z-5GTT>] (presenting the results of a brand consulting firm's estimate of the ten most valuable trademarks).

¹⁰ Because copyright law falls under a different regulatory mechanism than the USPTO and does not have a disciplinary arm, it is omitted from this Article.

¹¹ See Rebecca Tushnet, *Intellectual Property as a Public Interest Mechanism*, in THE OXFORD HANDBOOK OF INTELLECTUAL PROPERTY LAW 95, 96 (Rochelle C. Dreyfuss & Justine Pila eds., 2018); see also J.H. Reichman & Jonathan A. Franklin, *Privately Legislated Intellectual Property Rights: Reconciling Freedom of Contract with Public Good Uses of Information*, 147 U. PA. L. REV. 875, 911 (1999) (describing the conflict between private and public interest in intellectual property).

¹² Tushnet, *supra* note 11, at 96.

¹³ *Id.* at 103.

¹⁴ See *id.* at 103–04 (identifying arguments to the contrary).

¹⁵ See, e.g., Changes to Representation of Others Before the United States Patent and Trademark Office, 78 Fed. Reg. 20,179, 20,184 (Apr. 3, 2013) (to be codified in scattered parts of 37 C.F.R.) (“All decisions made by the [USPTO] in patent and trademark matters affect the public interest.”).

¹⁶ Daniel Nazer, Opinion, *Theranos: How a Broken Patent System Sustained Its Decade-Long Deception*, ARS TECHNICA (Mar. 4, 2019), <https://arstechnica.com/tech-policy/2019/03/theranos-how-a-broken-patent-system-sustained-its-decade-long-deception/> [<https://perma.cc/W95Q-R2Y8>].

¹⁷ See *Elizabeth Holmes' Failed Theranos Was Just Granted 5 New Patents in 2019*, CB INSIGHTS (Apr. 11, 2019), <https://www.cbinsights.com/research/theranos-patents-2019/> [<https://perma.cc/QA9Z-5NLK>] (describing five patents issued after the company shut down).

there has been a dramatic increase in the number of reported fraudulent trademark applications from China, a country from which one-ninth of U.S. trademark applications originate.¹⁸ Addressing this phenomenon, Director Iancu noted that without an accurate register, businesses cannot reliably use the register to determine whether marks would be available for protection. This uncertainty could in turn lead businesses to alter their strategies and increase costs.¹⁹

The USPTO is the federal agency charged with ensuring the accurate issuance of U.S. patents and the federal registration of trademarks. In many ways, the patent and trademark functions at the USPTO are entirely separate—each has its own office that is responsible for examining applications, and each has a separate board that hears appeals and other challenges.²⁰ That distinction is not surprising, however, given the significant differences between the two species of intellectual property in terms of the relevant legal doctrines, procedural requirements, and subject matter expertise involved.²¹ But when it comes to the regulation of practitioners who are authorized to practice before the USPTO, both fall under the purview of the USPTO’s Office of Enrollment and Discipline (OED), which is part of the Office of General Counsel.²²

It is this latter commonality that presents an opportunity to examine the current state of professional discipline across patent and trademark practice, along with a potential mechanism for comprehensive reform. On account of the technical and legal expertise required in order to successively navigate the respective application processes, patent and trademark applicants alike routinely rely on specialized practitioners to prosecute their applications.²³ All practitioners—whether patent agents, patent attorneys, or trademark attorneys—are subject to identical USPTO Rules of Professional Conduct (USPTO Rules) that require them to conform their practices to the ethical standards contained therein.²⁴ Even though there are some differences between the OED and other

¹⁸ See Jacob Gershman, *Flood of Trademark Applications from China Alarms U.S. Officials*, WALL ST. J. (May 5, 2018), <https://www.wsj.com/articles/flood-of-trademark-applications-from-china-alarms-u-s-officials-1525521600> [<https://perma.cc/3PSP-5XSY>] (exemplifying the recent media attention on fraudulent trademark applications).

¹⁹ Iancu, Remarks at International Trademark Association, *supra* note 8.

²⁰ See *Organizational Offices*, U.S. PATENT & TRADEMARK OFFICE, <https://www.uspto.gov/about-us/organizational-offices> [<https://perma.cc/TZB3-84YR>] (describing the organizational structure of the USPTO).

²¹ See discussion *infra* Part I.

²² See *Office of the General Counsel*, U.S. PATENT & TRADEMARK OFFICE, <https://www.uspto.gov/about-us/organizational-offices/office-general-counsel> [<https://perma.cc/A6MX-VSSF>] (stating OED’s role as overseeing the “registration and regulation of patent attorneys and agents to practice before the USPTO”).

²³ See discussion *infra* Parts II.A and II.B.

²⁴ 37 C.F.R. § 11.19 (2019).

disciplinary authorities,²⁵ the USPTO's disciplinary process is styled after the ABA Model Rules for Disciplinary Enforcement²⁶ and its rules are largely modeled after the ABA Model Rules for Professional Conduct (ABA Rules).²⁷

So, the question arises: how does the OED compare to other state disciplinary authorities in its imposition of discipline on patent and trademark practitioners, given the unique functions of the USPTO and its corresponding concerns for those who practice before it? Surprisingly, there have been no in-depth longitudinal empirical studies of professional discipline in the scholarly literature—much less any that have touched on USPTO discipline. This Article begins to fill that gap. It provides a comprehensive analysis of USPTO discipline spanning sixteen years (2003–2018) and crossing two sets of ethics codes, examines the disparities between patent and trademark discipline, and identifies the types of misconduct that are being regulated—or missed—by USPTO authorities. It then explicitly links these findings to the purposes of professional discipline and concludes with recommendations so that the USPTO can realign its disciplinary work in accordance with its private and public constituencies.

Part I describes the patent and trademark application processes, focusing on the duty of candor and the roles of the practitioner in maximizing the likelihood of success.²⁸ Although theoretically litigants can navigate both systems *pro se*, the systems are designed for those who have the requisite subject matter and legal expertise.²⁹ Indeed, the duty of candor requires the person filing the application to understand what information must be disclosed to the USPTO and how to respond to the inevitable USPTO inquiries and objections.

Part II outlines the regulation of USPTO practitioners, both with respect to the requirements for admission and disciplinary investigations.³⁰ Although patent practitioners need not be licensed attorneys, all must satisfy a similar set of criteria to ensure they have the requisite competence and moral character associated with a person who is entrusted to be both a legal representative and a fiduciary. With the exception of reciprocal discipline, which merits special attention for USPTO practitioners, the USPTO's disciplinary process bears

²⁵ See discussion *infra* Part II.C.

²⁶ Compare 37 C.F.R. § 11.24 (outlining the OED's process for imposing reciprocal discipline), with MODEL RULES FOR LAWYER DISCIPLINARY ENF'T R. 22 (AM. BAR ASS'N 2002) (providing for reciprocal discipline).

²⁷ See discussion *infra* Part III.B (comparing and contrasting the USPTO Rules and ABA Rules).

²⁸ See discussion *infra* Part I.

²⁹ See *Pro Se Assistance Program*, U.S. PATENT & TRADEMARK OFFICE, <http://www.uspto.gov/patents-getting-started/using-legal-services/pro-se-assistance-program> [<https://perma.cc/Y5SC-JEGG>] (explaining that individuals can file *pro se* but recommending the use of a registered attorney or agent).

³⁰ See discussion *infra* Part II.

resemblance to that of a state disciplinary authority in terms of the course of the proceedings and the possible sanctions that may be imposed.

Part III introduces the two sets of USPTO ethics codes in force at various points during the time period under examination.³¹ Although the USPTO Code of Professional Responsibility (1985–2013) was loosely modeled after the ABA Code of Professional Conduct, it also contained a number of specific provisions that were exclusive to USPTO practice. On the other hand, the USPTO Rules, adopted in 2013, largely mirror the ABA Rules. The differences between USPTO Rules and ABA Rules highlight the ways in which the USPTO purports to take candor seriously. The USPTO's stance is arguably accounted for by its view that its decisions have an impact that extends beyond the immediate applicant, to competitors and ultimately to the public at large. This Part concludes with the first mapping between the various sets of ethics codes in order to facilitate a comprehensive analysis.

Part IV provides a theoretical framework for understanding practitioner discipline in the intellectual property context.³² Drawing on the work of several prominent ethics scholars,³³ this Part explores the primary purposes of practitioner discipline and the role of sanctions in carrying out those purposes. It then focuses on the role of the USPTO as the regulator of the provision of valuable intellectual property rights, in order to further understand and prioritize among the various purposes that have been identified.

Part V presents the findings of a groundbreaking empirical study of all public discipline imposed by the USPTO between January 1, 2003, and December 31, 2018.³⁴ After describing the methodology used to compile the data, this Part focuses on the frequency and types of USPTO-imposed discipline, in comparison to its state disciplinary authority counterparts. It finds that the USPTO disciplinary rates, though increasing slightly over the sixteen-year period under study, lag far behind state disciplinary authorities. This Part then delves more deeply into patent and trademark practitioner discipline, finding that there are vast discrepancies between the two. Although it appears that the imposition of both patent and trademark discipline is primarily limited to the types of misconduct that are easily identified and ultimately have less impact on the public interest, patent practitioners are disciplined more frequently, more severely, and more publicly than their trademark counterparts. This Part also identifies and describes four commonly observed patterns of misconduct

³¹ See discussion *infra* Part III.

³² See discussion *infra* Part IV.

³³ See generally Fred C. Zacharias, *The Purposes of Lawyer Discipline*, 45 WM. & MARY L. REV. 675 (2003) (presenting various theories on the purposes of lawyer discipline and the impact of adopting such theories on various constituents).

³⁴ See discussion *infra* Part V.

that trigger discipline across commonly cited and highly correlated ethics rules.

Finally, Part VI sets forth three recommendations for future legal and procedural reforms to improve the effectiveness of USPTO discipline in fulfilling its role.³⁵ These recommendations include developing a trademark practitioner registration process to facilitate the monitoring of their work and communications; instituting a strategic practitioner audit program that includes extensive examiner input; and broadening the dissemination of information on USPTO discipline and expectations of its practitioners. Part VI concludes and offers thoughts on additional ways in which this empirical work can be leveraged and implemented.

I. PATENT AND TRADEMARK PROSECUTION

It is not easy to navigate the required steps to obtain a patent or register a trademark (collectively referred to as “prosecution”). Even if an application contains the required components, there are still many legal and procedural hurdles awaiting the unsuspecting inventor or brand manager.³⁶ It is for that reason and others that the majority of applicants choose to leverage the expertise of a patent or trademark practitioner—which increases the likelihood that they will successfully receive federal protection of their intellectual property. This Part identifies the primary hurdles and describes the duty of candor that runs throughout all interactions with the USPTO during the application process and beyond.

A. Patent Application Process

To be granted a patent, which gives the patent holder the right to exclude others from practicing a patented invention, the patent claims must adequately notify the public of the invention’s scope.³⁷ The patent statute requires that the invention consist of eligible subject matter³⁸ that is sufficiently disclosed in the patent application.³⁹ Additionally, the invention must be novel (i.e. not previously known or used by others),⁴⁰ useful, and non-obvious to one who is

³⁵ See discussion *infra* Part VI.

³⁶ See discussion *infra* Part I.A.

³⁷ *Cf.* *Honeywell Int’l, Inc. v. Int’l Trade Comm’n*, 341 F.3d 1332, 1332, 1338 (Fed. Cir. 2003) (holding patent disclosing a process to make polyethylene terephthalate (PET) yarn, used as reinforcement for automobile tires, was indefinite and thus invalid).

³⁸ See 35 U.S.C. § 101 (“Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.”).

³⁹ See *id.* § 112(a)–(b) (describing the requirements for the specification of a patentable invention).

⁴⁰ See *id.* § 102(a)(1) (“A person shall be entitled to a patent unless . . . the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the

skilled in the relevant field.⁴¹ If these criteria are met, a patent may be awarded to the applicant as long as other administrative requirements are satisfied.

Patent applications may be filed by mail or, more commonly, online.⁴² The application must include a written description and the claim(s) that describe the scope of the protection that will be afforded by the patent.⁴³ In addition, the application must include the inventor's name along with an oath or declaration that the inventor believes that he or she is the original inventor or joint inventor of a claimed invention contained in the application.⁴⁴ Although not required at the time the application is filed, an Information Disclosure Statement (IDS) must be submitted by the applicant in a timely fashion.⁴⁵ The IDS must contain information about all known prior art, i.e. information that suggests that the invention may not be original, and other information that is material in determining patentability.⁴⁶ Further discussion of this obligation, known as the duty of disclosure, will follow in the next Section.

The filing of the application is only the beginning of a lengthy and involved patent prosecution process. Once submitted to the USPTO, the application will be assigned to a patent examiner based on the technical field of the patent.⁴⁷ The examiner will evaluate the application and issue one or more office actions containing grounds of objection or rejection.⁴⁸ An applicant must

public before the effective filing date of the claimed invention . . ."). This section contains several exceptions that are not relevant to this Article. *See id.* § 102(b).

⁴¹ *Id.* § 103. The statute notes:

A patent for a claimed invention may not be obtained . . . if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains.

Id.

⁴² *See File Online*, U.S. PATENT & TRADEMARK OFFICE, <https://www.uspto.gov/patents-application-process/file-online> [<https://perma.cc/G3PE-XCS3>] (explaining the types of online filing through EFS-Web, an electronic filing system, and postal mail).

⁴³ 35 U.S.C. § 111.

⁴⁴ *Id.* § 115.

⁴⁵ 37 C.F.R. § 1.97 (2019). The filing of the IDS has been a bottleneck for patent pendency, which has spurred the USPTO to develop programs to expedite the process. *See Quick Path Information Disclosure Statement*, U.S. PATENT & TRADEMARK OFFICE, <https://www.uspto.gov/patent/initiatives/quick-path-information-disclosure-statement-qpids> [<https://perma.cc/B5UP-FDFF>] (describing the Quick Path Information Disclosure Statement).

⁴⁶ *See* 37 C.F.R. § 1.97–98.

⁴⁷ *See* Stephen Key, *A Former Patent Examiner Pulls Back the Curtain at the USPTO*, INC. (Dec. 11, 2015), <https://www.inc.com/stephen-key/a-former-patent-examiner-pulls-back-the-curtain-at-the-uspto.html> [<https://perma.cc/5CRX-DPRD>] (providing an interview with a former USPTO examiner about his work).

⁴⁸ Michael Best & Friedrich LLP, *Abandonment and Revival of U.S. Patent Application*, NAT'L L. REV. (Oct. 27, 2012), <http://www.natlawreview.com/article/abandonment-and-revival-us-patent-application> [<https://perma.cc/RS9K-65PR>].

submit an acceptable, timely response or else the application will be deemed abandoned.⁴⁹ An abandoned patent application can only be reinstated in limited circumstances; otherwise, the applicant may lose all claims to the now-disclosed invention.⁵⁰

Once a patent is granted, the holder receives exclusive rights to the disclosed invention for twenty years from the date of filing provided that maintenance fees are paid during the active patent life.⁵¹ If maintenance fees are not paid by the stated deadline, the granted patent will be deemed abandoned.⁵² Again, just as in the prosecution process, this determination is typically fatal to the patent, and the patent holder's rights to the disclosed invention will most likely be lost.⁵³

A patent practitioner is key to successfully navigating the patent prosecution process and thereby protecting the value of an applicant's invention. Patent applications not only must conform to the formal requirements and adequately disclose the invention with properly constructed claims, but there must also be persuasive responses to an examiner's findings of obviousness or lack of novelty to avoid the final rejection of the application.⁵⁴ Although there are a number of online resources that explain the process, these resources may provide a false sense of ability to navigate the process, proving to be a trap for one who is inexperienced in patent prosecution because the process in fact requires significant expertise.⁵⁵

The USPTO puts it best in its strong recommendation of securing patent representation: "Inventors may prepare their own applications and file them in the USPTO and conduct the proceedings themselves, but unless they are famil-

⁴⁹ 37 C.F.R. § 1.134–135.

⁵⁰ *Id.* § 1.137; see *Abandoned Applications*, U.S. PATENT & TRADEMARK OFFICE, <https://www.uspto.gov/trademarks-application-process/abandoned-applications> [<https://perma.cc/95ZM-Y67T>] (describing abandonment and the revival process). Note that if the abandonment occurs before the USPTO publishes the pending application (generally eighteen months after filing), the invention may remain a trade secret. See 35 U.S.C. § 122.

⁵¹ See *Maintain Your Patent*, U.S. PATENT & TRADEMARK OFFICE, <http://www.uspto.gov/patents-maintaining-patent/maintain-your-patent> [<https://perma.cc/8543-AGVM>] (providing details on maintenance fees).

⁵² See *id.* ("Maintenance fees are required to keep in force all utility and reissue utility patents . . .").

⁵³ See *id.*

⁵⁴ See Katrina Brundage & Sarah Garber, *Are Patent Attorneys Worth Their Billables?*, ABOVE THE LAW (Apr. 27, 2016), <http://abovethelaw.com/2016/04/are-patent-attorneys-worth-their-billables/> [<https://perma.cc/JSA8-6FM5>] (arguing that patent attorneys are, indeed, worth their fees).

⁵⁵ See *How to Conduct a U.S. Patent Search: A Step-by-Step Strategy*, U.S. PATENT & TRADEMARK OFFICE, <https://www.uspto.gov/video/cbt/ptrsearching> (providing a guide to conducting a patent search). The USPTO also has a Pro Se Assistance Program. See *Pro Se Assistance Program*, *supra* note 29 (providing some assistance to pro se applicants but recommending the use of registered patent practitioners).

iar with these matters or study them in detail, they may get into considerable difficulty.”⁵⁶ It further warns that, even if a pro se applicant were to be successful, there is no guarantee that the patent obtained would actually cover the invention the applicant intended it to.⁵⁷

The USPTO’s stance on practitioner representation is in line with the available data on the subject. One frequently cited⁵⁸ empirical study examining applications filed by pro se inventors versus their practitioner counterparts reported that 76% of pro se applications became abandoned, in comparison to only 35% of practitioner-represented applications.⁵⁹ Among those that were successful in obtaining patents, the pro se claims were narrower—and thereby less valuable—than those claims that had practitioner representation. The researcher hypothesized that the observed differences were due to the typical pro se applicant’s lack of understanding of the formal filing requirements or the need for timely responses, as well as the apparent lack of desire to engage in a lengthy exchange with examiners.⁶⁰

Perhaps surprisingly, there is no precise way, based on the publicly available data, to determine the percentage of all patent applications that are filed with practitioner assistance.⁶¹ The USPTO, for its part, simply states that “most” inventors do so.⁶² One scholar, who thoroughly examined a large sample of patent applications from 2011, found that approximately 92% were represented by a patent practitioner.⁶³ To check the accuracy of the 92% estimate, this study examined a complete patent application dataset from 2000 to 2018,⁶⁴

⁵⁶ *General Information Concerning Patents*, U.S. PATENT & TRADEMARK OFFICE, <https://www.uspto.gov/patents-getting-started/general-information-concerning-patents#heading-9> [<https://perma.cc/u4ct-33c3>].

⁵⁷ *Id.*

⁵⁸ See, e.g., Deborah R. Gerhardt & Jon P. McClanahan, *Do Trademark Lawyers Matter?*, 16 STAN. TECH. L. REV. 583, 591 & n.50 (2013); Peter Lee, *Toward a Distributive Agenda for U.S. Patent Law*, 55 HOUS. L. REV. 321, 365 (2017).

⁵⁹ Kate S. Gaudry, *The Lone Inventor: Low Success Rates and Common Errors Associated with Pro-Se Patent Applications*, 7 PLOS ONE e33141 (2012), <https://journals.plos.org/plosone/article/file?id=10.1371/journal.pone.0033141&type=printable> [<https://perma.cc/6X8M-XKB4>].

⁶⁰ See *id.*

⁶¹ The publicly available data on attorney docket number and customer number do not exactly track the frequency of practitioner filings. See *infra* notes 66–68 and accompanying text.

⁶² *General Information Concerning Patents*, *supra* note 56.

⁶³ See Dennis Crouch, *Estimate: Fewer Than 26,000 Active US Patent Attorneys & Agents*, PATENTLY-O (Jan. 13, 2012), <https://patentlyo.com/patent/2012/01/the-uspto-records-identify-more-than-41750-active-registered-practitioners-that-number-is-obviously-wrong-because-many-folk.html> [<https://perma.cc/6QBC-V8HP>].

⁶⁴ See *Patent Examination Research Dataset*, U.S. PATENT & TRADEMARK OFFICE, <https://bulk.data.uspto.gov/data/patent/pair/economics/2017/> [<https://perma.cc/3VKK-HZ2G>] (containing data on all application filings). The USPTO has made much of its data available for researchers through the Bulk Data Storage System and is a fruitful source for future research. See generally *Bulk Data Storage*

focusing on the attorney docket number and customer number fields.⁶⁵ The attorney docket number is a self-selected designation that patent prosecutors (most likely, practitioners) may use to track their applications.⁶⁶ The customer number is another tracking mechanism, but it is issued by the USPTO and requires the prosecutor to take the additional step of completing a form.⁶⁷ Over this time period, 96% of the applications contained an attorney docket number, whereas 87% included a customer number. These two values lend support to the 92% statistic, which will be used in Part V of this Article to estimate the percentage of applications that are filed by a patent practitioner.

B. Candor in Patent Prosecution

One of the most important roles of patent practitioners is to ensure that proper disclosures are made to the USPTO during the application process, or else they risk having the patent refused or later invalidated.⁶⁸ Under 37 C.F.R. § 1.56, “[e]ach individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability”⁶⁹ Patent practitioners are included among those individuals to which this duty applies.⁷⁰ The duty of disclosure rests on the principle that a patent “is affected [by the] public interest” and that “[t]he public interest is best served” when the USPTO knows all of the information material to patentability, including information that undercuts the applicant’s claim.⁷¹

System (BDSS) Version 1.1.0, U.S. PATENT & TRADEMARK OFFICE, <https://bulkdata.uspto.gov/> [<https://perma.cc/F64Z-RLTS>].

⁶⁵ See Crouch, *supra* note 63.

⁶⁶ See *Docket Number*, U.S. PATENT & TRADEMARK OFFICE, <https://www.uspto.gov/ebc/portal/info/docketnumber.htm> [<https://perma.cc/S955-76T2>] (defining and explaining the term “Docket Number”).

⁶⁷ See *Getting Started—New Users*, U.S. PATENT & TRADEMARK OFFICE, <https://www.uspto.gov/patents-application-process/applying-online/getting-started-new-users> [<https://perma.cc/EBD6-NPCV>] (explaining customer numbers and providing an application form to obtain a customer number from the USPTO).

⁶⁸ See, e.g., Lisa A. Dolak, *Patent Office Contested Proceedings and the Duty of Candor*, 22 J. INTELL. PROP. L. 1, 3 (2014) (noting the USPTO rule that “imposes an obligation of candor and good faith”); Dorian Ojemen, Comment, *The Ethics of Inter Partes Review Before the USPTO*, 47 ST. MARY’S L.J. 645, 669 (2016) (explaining the importance of the duty of candor and good faith and comparing Rule 11 of the Federal Rules of Civil Procedure and ABA Model Rule 3.1 and 3.3); Robert Kalinsky, *The Enhanced Duty of Candor Before the Patent Office*, LAW360 (Apr. 24, 2013), <https://www.law360.com/articles/432273/the-enhanced-duty-of-candor-before-the-patent-office> [<https://perma.cc/96FD-ZRSF>] (“All patent applicants know of the duty of candor that is required to practice before the U.S. Patent and Trademark Office.”).

⁶⁹ 37 C.F.R. § 1.56(a) (2019).

⁷⁰ *Id.* § 1.56(c)(2).

⁷¹ *Id.* § 1.56(a).

This duty of disclosure is enforced in two ways. First, as described in Part III, the USPTO Rules mandate compliance with the duty of disclosure and subject non-compliant practitioners to discipline.⁷² Second, and arguably even more dramatic, patents in which there has been a violation of the duty of disclosure may be rendered unenforceable through application of the inequitable conduct doctrine.⁷³ Although the U.S. Court of Appeals for the Federal Circuit in 2011, in *Therasense, Inc. v. Becton, Dickinson & Co.*, somewhat circumscribed the scope of the inequitable conduct doctrine,⁷⁴ it still retains vitality today.⁷⁵

In order to show inequitable conduct, a challenger must demonstrate both that the “applicant misrepresented or omitted material information with the specific intent to deceive the PTO,”⁷⁶ and that the USPTO would not have “allowed the claim if it had been aware of the undisclosed reference,” applying a “but-for” standard for materiality of the non-disclosure.⁷⁷ The materiality prong may also be satisfied, however, where there has been “egregious misconduct,” such as the filing of a clearly false affidavit.⁷⁸ Furthermore, the Federal Circuit has recently expanded its view of how intent may be shown, allowing an inference of intent based on “a pattern of lack of candor” such as repeated factual representations that turn out to be contrary to information in the declarant’s possession.⁷⁹

⁷² See discussion *infra* Part III.

⁷³ See, e.g., *Consol. Aluminum Corp. v. Foseco Int’l Ltd.*, 716 F. Supp. 316, 327–33 (N.D. Ill. 1989) (finding inequitable conduct in the prosecution of one claim that resulted in the rejection of related patent applications). See generally Thomas F. Cotter, *An Economic Analysis of Patent Law’s Inequitable Conduct Doctrine*, 53 ARIZ. L. REV. 735 (2011) (providing a comprehensive discussion of the inequitable conduct doctrine).

⁷⁴ 649 F.3d 1276, 1285 (Fed. Cir. 2011) (en banc). There have been several articles on the impact of *Therasense, Inc.* on findings of inequitable conduct. See generally Robert D. Swanson, Comment, *The Exergen and Therasense Effects*, 66 STAN. L. REV. 695 (2014) (adding data to the debate over *Therasense, Inc.*).

⁷⁵ See, e.g., *Regeneron Pharm., Inc. v. Merus N.V.*, 864 F.3d 1343, 1346 (Fed. Cir. 2017) (affirming the lower court finding of inequitable conduct on the part of Regeneron that rendered its patent unenforceable).

⁷⁶ *Therasense, Inc.*, 649 F.3d at 1287.

⁷⁷ *Id.* at 1291; see Amy Semet, *Specialized Trial Courts in Patent Litigation: A Review of the Patent Pilot Program’s Impact on Appellate Reversal Rates at the Five-Year Mark*, 60 B.C. L. REV. 519, 524 (2019) (noting that inequitable conduct arises and a patent is found unenforceable when the patent prosecutor commits fraud in the patent prosecution process).

⁷⁸ *Therasense, Inc.*, 649 F.3d at 1292.

⁷⁹ *Regeneron Pharm., Inc.*, 864 F.3d at 1351 (citing *Apotex Inc. v. UCB, Inc.*, 763 F.3d 1354, 1362 (Fed. Cir. 2014)); see Alison McCreary & Ryan Cagle, *Federal Circuit Says Inequitable Conduct Can Be Inferred from Activities in a Later Patent Litigation?*, IPWATCHDOG (Oct. 13, 2017), <https://www.ipwatchdog.com/2017/10/13/federal-circuit-inequitable-conduct-inferred-later-patent-litigation/id=88978/> [<https://perma.cc/9HJH-VSK5>] (discussing the *Regeneron Pharm., Inc.* decision and opining whether OED discipline might follow for the patent prosecutor).

In addition to the duty of candor in patent prosecution, there are also obligations of candor and good faith in post-grant proceedings, similar to those codified in Rule 11 of the Federal Rules of Civil Procedure.⁸⁰ In 2016, these provisions were amended to add that filings must comply with 37 C.F.R. § 11.18(b) that requires that the declarant certify the truth of all statements that are made within his or her own knowledge. The regulation further requires the declarant to certify, to the best of her knowledge, that there is evidentiary support, and that there is a bona fide legal basis for her arguments.⁸¹

At the time of these amendments, some were concerned that the additional certifications went beyond those in the patent prosecution process and would lead to additional disciplinary proceedings against practitioners.⁸² In its response, the USPTO noted that there had not been many investigations prior to the amendment and that it “d[id] not expect this situation to occur.”⁸³ Nevertheless, 37 C.F.R. § 11.18(d) explicitly provides that a practitioner who violates § 11.18 may face disciplinary action.⁸⁴

C. Trademark Application Process

A trademark may be registered either in a particular state or nationally through the USPTO. Although federal registration is not required to enforce a trademark through an infringement action—and indeed, trademarks may be enforced without being registered at all—federal registration has several strategic advantages. First, it constitutes prima facie evidence that the mark is valid and owned by the registrant.⁸⁵ Second, it allows a registrant to secure nationwide exclusive rights rather than just in those geographic locations where the mark is currently used.⁸⁶ Third, it puts all others on notice of the regis-

⁸⁰ 37 C.F.R. § 42.11 (2019); Dolak, *supra* note 68, at 3.

⁸¹ 37 C.F.R. § 11.18(b).

⁸² Amendments to the Rules of Practice for Trials Before the Patent Trial and Appeal Board, 81 Fed. Reg. 18,750, 18,760 (Apr. 1, 2016) (to be codified at 37 C.F.R. pt. 42) (providing comments on proposed changes prior to adoption); David Hricik, *Revision to IPR Duty of Candor: Broadening Duty?*, PATENTLY-O (Apr. 1, 2016), <https://patentlyo.com/hricik/2016/04/proposed-revision-broadening.html> [<https://perma.cc/U8WR-DSJG>].

⁸³ Amendments to the Rules of Practice for Trials Before the Patent Trial and Appeal Board, 81 Fed. Reg. at 18,760.

⁸⁴ 37 C.F.R. § 11.18(d).

⁸⁵ 15 U.S.C. § 1057(b) (2018).

⁸⁶ *Compare* Dawn Donut Co. v. Hart’s Food Stores, Inc., 267 F.2d 358, 365, 369 (2d Cir. 1959) (denying injunctive relief after finding no likelihood of confusion but clarifying that “the plaintiff may later, upon a proper showing of an intent to use the mark at the retail level in defendant’s market area, be entitled to enjoin defendant’s use of the mark”), *with* United Drug Co. v. Theodore Rectanus Co., 248 U.S. 90, 101, 104 (1918) (estopping the plaintiff from seeking an injunction to prevent the defendant from continuing to use a similar mark in a geographic location where the plaintiff had no business).

trant's claim of ownership of the mark.⁸⁷ Trademark applications and registrations may be searched online through the USPTO website,⁸⁸ and the existence of a registered mark can serve as an effective deterrent to organizations searching to create a distinctive brand.⁸⁹

In comparison to patent prosecution, obtaining a federal registration appears to be a simple process. The application forms are available online and are expected to take less than an hour to complete.⁹⁰ The application requests information on the owner of the proposed mark, identification of the goods or services the applicant uses or intends to use in connection with the mark, the date on which the mark was first used in interstate commerce, and whether an attorney is filing the application.⁹¹ A specimen illustrating the mark as used must also be submitted prior to registration, either with the application (if claiming that it is currently being used in commerce) or after publication (if claiming an intent to use the mark in commerce).⁹²

After a trademark application is submitted, there are two barriers to registration. First, the USPTO will assign an examining attorney to review the application and potentially refuse registration.⁹³ The most common grounds for refusal are likelihood of confusion (that consumers may confuse the proposed mark with another business)⁹⁴ and descriptiveness (that consumers do not view the symbol as a distinctive mark).⁹⁵ If the examining attorney finds a defect in

⁸⁷ See 15 U.S.C. § 1057(c) (“[T]he filing of the application to register such mark shall constitute constructive use of the mark, conferring a right of priority, nationwide in effect, on or in connection with the goods or services specified in the registration . . .”).

⁸⁸ *Search Trademark Database*, U.S. PATENT & TRADEMARK OFFICE, <https://www.uspto.gov/trade-marks-application-process/search-trademark-database> [<https://perma.cc/4WC4-RSD4>]; see *TESS TIPS*, U.S. PATENT & TRADEMARK OFFICE, http://www.uspto.gov/trademarks/process/search/Tess_tips.jsp [<https://perma.cc/BKD9-47X8>] (explaining how to use the Trademark Electronic Search System (TESS) to determine whether a proposed mark could be subject to refusal due to the existence of a prior application or registration).

⁸⁹ Gerhardt & McClanahan, *supra* note 58, at 587.

⁹⁰ See *Apply Online*, U.S. PATENT & TRADEMARK OFFICE, <http://www.uspto.gov/trademarks/teas/index.jsp> [<https://perma.cc/GQJ2-95KS>].

⁹¹ 15 U.S.C. § 1051.

⁹² *Id.*

⁹³ See Stuart J.H. Graham et al., *The USPTO Trademark Case Files Dataset: Descriptions, Lessons, and Insights*, 22 J. ECON. & MGMT. STRATEGY 669, 677 (2013) (describing and examining several aspects of the trademark application data).

⁹⁴ See 15 U.S.C. § 1052(d) (providing that a mark may not be registered if it “so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive”).

⁹⁵ See *id.* § 1052(e)–(f) (providing that a mark may not be registered if the mark “when used on or in connection with the goods of the applicant is merely descriptive” or “is primarily geographically deceptively misdescriptive of [the applicant’s goods]” unless the mark “has become distinctive of the applicant’s goods in commerce”).

the trademark application or otherwise believes that it may not be suitable for registration, the examiner may issue an office action identifying the problem.⁹⁶ In response, the applicant—or more often, the attorney on behalf of the applicant—may amend the application to fix the defect or submit additional materials to demonstrate that it should register. If the examining attorney approves the application, the mark is published in the *Official Gazette*, a USPTO weekly publication.⁹⁷

After publication, third-parties who believe they have legal grounds to oppose the registration have thirty days to prevent the impending registration by filing an opposition proceeding.⁹⁸ If no opposition is filed, or if there is an opposition and the Trademark Trial and Appeal Board (TTAB) sides with the applicant, the application will proceed to the next step in the process. Marks already being used in commerce will be placed on the Principal Register immediately, whereas those filed on an intent to use basis will register once the applicant provides evidence that he or she has begun using the mark in commerce.⁹⁹

Although the trademark registration process may be accomplished without legal counsel, over three-quarters of all applications are prosecuted by attorneys.¹⁰⁰ Moreover, having a trademark attorney is correlated with higher rates of publication and registration success. A comprehensive empirical study on trademark applications found that trademark applicants were 37% more likely to succeed in publication and 43% more likely to succeed in registration than their pro se counterparts.¹⁰¹ Among trademark attorneys, experience prosecuting trademark applications was correlated with even higher success rates—a significant finding given that those attorneys likely take on more challenging cases.¹⁰²

There are a number of reasons posited for the higher trademark attorney success rates. First, attorneys have a greater understanding of the underlying trademark doctrine and can draft responses to avoid legal landmines.¹⁰³ Second, they may be less conflict-averse than their pro se counterparts, choosing to respond to an examining attorney's objection rather than abandoning the application at the first sign of trouble.¹⁰⁴ Third, their higher success rates might reflect selectivity in which applications to prosecute, as they may be counsel-

⁹⁶ *Trademark Process*, U.S. PATENT & TRADEMARK OFFICE, <http://www.uspto.gov/trademarks/process/> [<https://perma.cc/M5PF-ME29>].

⁹⁷ *Id.*

⁹⁸ 15 U.S.C. § 1063(a).

⁹⁹ *Id.* § 1051.

¹⁰⁰ See Gerhardt & McClanahan, *supra* note 58, at 600.

¹⁰¹ *Id.* at 607–08.

¹⁰² *Id.* at 611, 617.

¹⁰³ *Id.* at 597, 617.

¹⁰⁴ See *id.* at 617–18.

ing their clients at the outset that they will be unable to register a descriptive mark and thus should avoid the time and expense related to filing.¹⁰⁵

The USPTO, for its part, has gone back and forth on the degree to which it encourages pro se applications. At the turn of the twenty-first century, the USPTO made several changes to make it easier to file applications and included more information online to assist non-attorneys who wished to file.¹⁰⁶ More recently the USPTO website is emphasizing the advantages of attorney assistance in filing trademark applications,¹⁰⁷ perhaps in recognition of the disparity in success rates and other anecdotal evidence of the benefits of legal representation.

D. Candor in Trademark Prosecution

As compared to patent prosecution, scholars and intellectual property attorneys pay significantly less attention to the duty of candor in trademark prosecution.¹⁰⁸ The phrases “duty of disclosure” and “inequitable conduct” are ubiquitous in the patent literature, and nearly every practitioner knows of *The-rasense, Inc.* and its progeny.¹⁰⁹ But as described below, similar concepts are carried into trademark practice and arguably should have similar force.¹¹⁰

At the end of the federal trademark application form, there are a number of statements that must be acknowledged and signed.¹¹¹ These statements include that “[t]he signatory believes that the applicant is the owner of the trademark/service mark sought to be registered,” that the mark is either being used in commerce or that the applicant has a bona fide intention to do so, and that the facts set forth in the application are true.¹¹² Furthermore, the signatory must acknowledge that “[t]o the best of the signatory’s knowledge, information, and belief, formed after an inquiry reasonable under the circumstances,

¹⁰⁵ *Id.* at 592.

¹⁰⁶ See, e.g., *Trademark FAQs*, U.S. PATENT & TRADEMARK OFFICE, <https://www.uspto.gov/learning-and-resources/trademark-faqs> [<https://perma.cc/B7ZH-G528>]; *Trademark Information Network*, U.S. PATENT & TRADEMARK OFFICE, <https://www.uspto.gov/trademarks-getting-started/process-overview/trademark-information-network> [<https://perma.cc/7EBG-HWYX>].

¹⁰⁷ See *Hiring a U.S.-Licensed Attorney*, U.S. PATENT & TRADEMARK OFFICE, <https://www.uspto.gov/trademarks-getting-started/why-hire-private-trademark-attorney> [<https://perma.cc/DCV8-726X>] (explaining the advantages of legal representation in trademark prosecution).

¹⁰⁸ *But see* Linda K. McLeod & Stephanie H. Bald, *Ethical Issues in U.S. Trademark Prosecution and TTAB Practice*, 10 J. MARSHALL REV. INTELL. PROP. L. 365, 374 (2011) (discussing ethical duties of trademark practitioners, including the duty of candor).

¹⁰⁹ See, e.g., Ojemen, *supra* note 68, at 669 (discussing the duty of candor and the doctrine of inequitable conduct).

¹¹⁰ See McLeod & Bald, *supra* note 108, at 374.

¹¹¹ For a PDF version of the application, including the statements that must be signed by the applicant, see *Trademark/Service Mark Application, Principle Register*, https://www.uspto.gov/sites/default/files/documents/TEAS_Plus.pdf [<https://perma.cc/SW7U-EWNT>].

¹¹² *Id.*

the allegations and other factual contentions made [in the submitted application] have evidentiary support.”¹¹³ The acknowledgements conclude with a warning that “willful false statements” could “jeopardize the validity of the application or submission or any registration resulting therefrom” or may lead to criminal prosecution.¹¹⁴

Although rare, the TTAB has invalidated federal trademark registration where there is clear and convincing evidence that the applicant committed fraud in the procurement of the registration.¹¹⁵ Such fraud may occur by, among other things, fabricating specimens in support of applications or by making false statements related to the use of the mark in commerce.¹¹⁶ Persons committing such fraud are also liable for damages to those who have been harmed.¹¹⁷ Although the leading trademark fraud case, *In re Bose Corp.*, seemed to heighten the standard for proving fraud from a showing of negligence to evidence of an intent to deceive,¹¹⁸ the Federal Circuit left open the question of whether fraud could also be found based on a high degree of recklessness.¹¹⁹ Indeed, *In re Bose Corp.* and *Therasense, Inc.* espouse very similar views as they relate to misrepresentations made to the USPTO, yet only the latter has endured in the practitioner lexicon.

¹¹³ *Id.*

¹¹⁴ *Id.*

¹¹⁵ See, e.g., *Nationstar Mortg. LLC v. Ahmad*, 112 U.S.P.Q.2d (BNA) 1361, 1376 (T.T.A.B. 2014) (invalidating use of “Nationstar” in connection with real estate business when it was clear that applicant had not been using the trademark in commerce).

¹¹⁶ See *id.*; see also Sarah Bro, *Trademark Trial and Appeal Board Sustains Opposition on the Basis of Fraud*, JD SUPRA (Nov. 21, 2014), <https://www.jdsupra.com/legalnews/trademark-trial-and-appeal-board-sustain-82527/> [<https://perma.cc/8HE3-SHC9>] (discussing *Nationstar Mortgage LLC* and its import).

¹¹⁷ 15 U.S.C. § 1120.

¹¹⁸ See 580 F.3d 1240, 1245 (Fed. Cir. 2009) (“[W]e hold that a trademark is obtained fraudulently under the Lanham Act only if the applicant or registrant knowingly makes a false, material representation with the intent to deceive the PTO.”). *In re Bose* overruled *Medinol Ltd. v. Neuro Vasx, Inc.*, which had applied an objective standard for determining whether an applicant acted knowingly. See generally *Medinol Ltd. v. Neuro Vasx, Inc.*, 67 U.S.P.Q.2d (BNA) 1205 (T.T.A.B. 2003); Brandon L. Harrell, Note, *Federal Circuit Tightens Standard for Proving Intent to Deceive in Trademark Fraud Cases*: *In re Bose Corp.*, 12 TUL. J. TECH. & INTELL. PROP. 313 (2009) (analyzing the *In re Bose Corp.* decision and its impact on fraud determinations).

¹¹⁹ See *In re Bose Corp.*, 580 F.3d at 1246 n.2 (“The PTO argues that under *Torres*, making a submission to the PTO with reckless disregard of its truth or falsity satisfies the intent to deceive requirement. We need not resolve this issue here.”); see also Theodore H. Davis Jr. & Lauren Brenner, *Allegations of Fraudulent Procurement and Maintenance of Federal Registrations Since In re Bose Corp.*, 104 TRADEMARK REP. 933, 936–43 (2014) (describing the various tests used for determining fraud following *In re Bose Corp.*).

II. REGULATION OF USPTO PRACTITIONERS

Although most attorneys are familiar with the general workings of state bar admissions and discipline, the USPTO's system operates somewhat differently. In fact, the USPTO is one of the few federal agencies to which Congress has given explicit authority to regulate the admissions and ethical conduct of those persons who practice before it.¹²⁰ The USPTO established the OED in 1985 and administers both functions through it.¹²¹ This Part will describe the regulation of practitioners before the USPTO. It will begin by identifying the requirements for admission to practice that differ significantly between patent and trademark practitioners.¹²² It will then turn to a brief discussion of the OED's disciplinary process, highlighting the key decision points and possible outcomes.¹²³

A. Admission to Practice in Patent Matters

Patent law is somewhat unique in that both lawyers (patent attorneys) and non-lawyer professionals (patent agents) are eligible to practice, provided that those individuals meet the requirements and successfully apply for admission.¹²⁴ Other than the fact that patent attorneys must be actively licensed attorneys in good standing with a state bar, there are no other differences between patent attorneys and patent agents, either in relation to admission requirements or in the scope of permissible patent practice before the USPTO.¹²⁵ The USPTO collectively refers to both groups as "patent practitioners,"¹²⁶ and it is for that reason that this Article uses the term "practitioner" rather than "attorney" when collectively referring to individuals who practice before the USPTO. All patent practitioners, including patent agents, are subject to the OED's disciplinary authority.¹²⁷

The requirements to become a registered patent practitioner are analogous to those for state bar admission. First, an individual must show that he or she

¹²⁰ See 35 U.S.C. § 32 (2018) (giving the USPTO director the authority to discipline practitioners); Michael P. Cox, *Regulation of Attorneys Practicing Before Federal Agencies*, 34 CASE W. RES. L. REV. 173, 184 (1983–1984) (discussing congressional granting of authority to USPTO).

¹²¹ U.S. PATENT & TRADEMARK OFFICE, PTD-10627-8-0001, OFFICE OF ENROLLMENT AND DISCIPLINE MUST CONDUCT MORE TIMELY INVESTIGATIONS OF COMPLAINTS AGAINST PRACTITIONERS, at i (1998), <https://www.oig.doc.gov/OIGPublications/USPTO-PTD-10627-06-1998.pdf> [<https://perma.cc/F8H5-698D>].

¹²² See discussion *infra* Parts II.A and II.B.

¹²³ See discussion *infra* Part II.C.

¹²⁴ 37 C.F.R. § 11.6(a)–(b) (2019).

¹²⁵ See *id.*; David Hricik, *Patent Agents: The Person You Are*, 20 GEO. J. LEGAL ETHICS 261, 262 (2007).

¹²⁶ *Patent and Trademark Practitioners*, U.S. PATENT & TRADEMARK OFFICE, <https://www.uspto.gov/learning-and-resources/patent-and-trademark-practitioners> [<https://perma.cc/AG7H-Q8NV>].

¹²⁷ See 37 C.F.R. § 11.19(a).

“[p]ossesses the legal, scientific, and technical qualifications necessary for him or her to render applicants valuable service.”¹²⁸ Ordinarily, an individual will demonstrate these qualifications through receipt of a bachelor’s degree in a recognized scientific or technical field or a bachelor’s degree in another field along with a specified number of credit hours in a scientific or technical field.¹²⁹ This requirement is analogous to that of most state bars, which require the successful completion of a Juris Doctorate degree, often from an ABA-accredited law school.¹³⁰ Second, an individual must show that he or she is “competent to advise and assist patent applicants in the presentation and prosecution of their applications before the Office.”¹³¹ This is generally accomplished by achieving a passing score on the patent registration examination, akin to passing a bar admission test.¹³² Third, an individual must show that he or she “possesses good moral character and reputation.”¹³³ Ultimately, the OED Director makes a determination of an individual’s moral character and reputation pursuant to a character and fitness inquiry, similar to that which would be conducted by a state bar.¹³⁴

Once a practitioner meets these requirements, he or she is assigned a unique registration number and added to the USPTO’s register of attorneys and agents. As of April 8, 2020, there were 48,000 active patent practitioners: 12,385 active patent agents and 35,615 active patent attorneys.¹³⁵

B. Admission to Practice in Trademark Matters

In contrast to patent practice, the requirements to practice before the USPTO in trademark matters are much more streamlined. With very limited exceptions, only active licensed attorneys in good standing with a state bar

¹²⁸ *Id.* § 11.7(a)(2)(ii).

¹²⁹ OFFICE OF ENROLLMENT & DISCIPLINE, U.S. PATENT & TRADEMARK OFFICE, GENERAL REQUIREMENTS BULLETIN FOR ADMISSION TO THE EXAMINATION FOR REGISTRATION TO PRACTICE IN PATENT CASES BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE, at 4–6 (2020), https://www.uspto.gov/sites/default/files/documents/OED_GRB.pdf [<https://perma.cc/2FKK-MUNK>].

¹³⁰ *See, e.g., Rules for Admission to the Bar*, MINN. ST. BD. L. EXAMINERS, <https://www.ble.mn.gov/rules/> [<https://perma.cc/9MPF-5H9A>] (requiring graduation from an ABA-accredited JD program).

¹³¹ 37 C.F.R. § 11.7(a)(2)(iii).

¹³² *See* OFFICE OF ENROLLMENT & DISCIPLINE, *supra* note 129, at 20.

¹³³ 37 C.F.R. § 11.7(a)(2)(i).

¹³⁴ *See, e.g., Character and Fitness Requirements*, MINN. ST. BD. L. EXAMINERS, <https://www.ble.mn.gov/character-and-fitness-requirements/> [<https://perma.cc/MD2Y-9CS5>] (identifying the character and fitness requirements for the Minnesota bar and providing resources for applicants).

¹³⁵ *Practitioner Roster*, U.S. PATENT & TRADEMARK OFFICE, <https://oedci.uspto.gov/OEDCI/practitionerRoster> [<https://perma.cc/3G3Q-XQQZ>]. The OED continually updates these numbers, which makes it difficult to have a comprehensive historical understanding of active practitioners. *Id.*

may represent others in trademark matters before the USPTO.¹³⁶ Notably, non-lawyer patent agents generally are not eligible to practice trademark law before the USPTO.¹³⁷

Perhaps because the USPTO does not impose additional substantive requirements on those individuals who wish to represent others in trademark matters, it does not require an attorney to apply for recognition to practice before the USPTO nor does it assign that person a registration number when prosecuting trademark applications on behalf of a client. For these reasons, it is difficult to ascertain the number of “active” trademark practitioners because an attorney might prosecute a single application on behalf of a client and thereafter not do so again. The USPTO first learns of the involvement of a trademark attorney when an application is filed because the application asks whether an attorney is filing it.¹³⁸ If the question is answered in the affirmative, the USPTO asks for basic contact information and will then communicate solely with the listed attorney regarding the application.¹³⁹

C. OED Disciplinary Process

The OED disciplinary process may be triggered whenever the OED Director receives information that warrants an investigation.¹⁴⁰ That information can come from a variety of sources, including “a client, an examiner, or another member of the USPTO, through published decisions and news articles, or opposing counsel during an *inter partes* proceeding.”¹⁴¹ At that time, the practitioner will be notified that an investigation has begun.¹⁴² The OED then conducts a preliminary screening of the alleged violation that will often involve sending a request for information (RFI) to the practitioner.¹⁴³ The practitioner is required, pursuant to the USPTO Rules, to respond accurately and completely to the RFI or face additional ethics charges.¹⁴⁴

There are four possible outcomes of an investigation. First, the OED Director may close the investigation without further action, presumably because

¹³⁶ 37 C.F.R. § 11.14(a).

¹³⁷ *Id.* § 11.14(b). There is a limited exception for non-attorneys who were permitted to prosecute trademarks prior to 1957, but that class of individuals is likely very small. *Id.*

¹³⁸ *Trademark Basics*, U.S. PATENT & TRADEMARK OFFICE, <https://www.uspto.gov/trademarks-getting-started/trademark-basics> [<https://perma.cc/N4VK-E2PY>].

¹³⁹ *Id.*

¹⁴⁰ 37 C.F.R. § 11.22(a).

¹⁴¹ DAVID HRICIK & MERCEDES MEYER, PATENT ETHICS: PROSECUTION § 1.03 (Matthew Bender ed., 2016).

¹⁴² 37 C.F.R. § 11.22(e).

¹⁴³ *Id.* § 11.22(f)(1)(ii).

¹⁴⁴ *Id.*; HRICIK & MEYER, *supra* note 141, § 1.03.

there are no grounds to proceed.¹⁴⁵ Second, a warning letter may be issued to the practitioner. A warning is not public and not considered a disciplinary sanction, but it reminds practitioners of their duties under the USPTO Rules.¹⁴⁶ Third, the OED Director and practitioner may enter into a settlement agreement. Settlement agreements are a common method of disposition,¹⁴⁷ particularly for practitioners who wish to maintain an uninterrupted practice before the USPTO.¹⁴⁸ Fourth, the OED Director may find that there has been a violation of the Rules and convene the Committee on Discipline (COD), a three-member panel appointed by the USPTO Director.¹⁴⁹ The COD will then independently determine whether there is probable cause to proceed in the disciplinary matter and make a recommendation to the OED Director.¹⁵⁰

Formal disciplinary hearings are conducted by an administrative law judge, who serves as the hearing officer for the proceeding.¹⁵¹ Assuming that the complaint is not dismissed, there are four possible sanctions that may be imposed: (1) exclusion from practice, (2) suspension, (3) public reprimand, or (4) probation.¹⁵² The first three sanctions, however, are mutually exclusive: “[p]robation may be imposed in lieu of or in addition to any other disciplinary sanction.”¹⁵³ In determining the appropriate sanction, a hearing officer is required to consider the following factors:

- (1) Whether the practitioner has violated a duty owed to a client, to the public, to the legal system, or to the profession;
- (2) [w]hether the practitioner acted intentionally, knowingly, or negligently;
- (3) [t]he amount of actual or potential injury caused by the practitioner’s misconduct; and
- (4) [t]he existence of any aggravating or mitigating factors.¹⁵⁴

¹⁴⁵ See 37 C.F.R. § 11.22(h)(1).

¹⁴⁶ See *id.* § 11.22(h)(2); Presentation at 12th Annual Advanced Patent Law Institute, U.S. Patent & Trademark Office, Select OED Procedure, Statistics, and Case Law, at 3–4 (Mar. 10, 2017) [hereinafter USPTO Presentation], https://www.uspto.gov/sites/default/files/documents/Advanced_Patent_Law_Institute_2017_Slides.pdf [<https://perma.cc/WS2Y-79W4>] (describing warning letters and presenting statistics on their issuance).

¹⁴⁷ Of the 410 public disciplinary actions between 2003 and 2018, 206 (50.2%) involved a settlement agreement.

¹⁴⁸ See 37 C.F.R. § 11.22(h)(4); see, e.g., *In re Guth*, No. D2010-37, at 6 (U.S. Patent and Trademark Office Feb. 11, 2011) (final order) (using cooperation with OED and related reconciliation as a mitigating factor).

¹⁴⁹ 37 C.F.R. §§ 11.22(h)(3), 11.23(a).

¹⁵⁰ *Id.* § 11.23(b).

¹⁵¹ See *id.* § 11.39 (referencing regulation authorizing appointment of administrative law judge to serve as hearing officer).

¹⁵² *Id.* § 11.20(a).

¹⁵³ *Id.* § 11.20(a)(4).

¹⁵⁴ *Id.* § 11.54(b).

A disciplined practitioner has the right to appeal the initial decision first to the OED Director, and subsequently to the U.S. District Court for the Eastern District of Virginia.¹⁵⁵

Special attention must be paid to the imposition of reciprocal discipline at the USPTO, given its prevalence and the differences in how discipline is imposed in such cases. Lawyers who practice before the USPTO have an affirmative obligation to notify the OED Director when they have been disciplined by another jurisdiction or federal agency.¹⁵⁶ But even if they fail to do so, the OED itself proactively searches state lawyer disciplinary records and identifies anyone within its purview who has been disciplined.¹⁵⁷ In either case, the OED director will file a complaint with the USPTO Director, without COD involvement, based on the other discipline.¹⁵⁸ Even though a practitioner is requested to respond to the complaint, there are extremely limited grounds on which the practitioner may challenge the imposition of an identical sanction by the USPTO.¹⁵⁹ Indeed, the USPTO Director has a reputation for successfully rebuffing challenges to reciprocal discipline¹⁶⁰ that rarely go beyond consideration of the documentary record.¹⁶¹

Once any type of public discipline has been imposed, the OED Director will issue a final decision.¹⁶² That final decision is publicly available on the OED Reading Room website, which can be accessed by conducting a search of the practitioner's name, or by using the free text search feature.¹⁶³ Information

¹⁵⁵ 35 U.S.C. § 32.

¹⁵⁶ 37 C.F.R. § 11.24.

¹⁵⁷ HRICK & MEYER, *supra* note 141.

¹⁵⁸ See 37 C.F.R. § 11.24(a).

¹⁵⁹ See *id.* § 11.24(d)(1)(i)–(iv). Acceptable challenges to reciprocal discipline include:

- (i) The procedure elsewhere was so lacking in notice or opportunity to be heard as to constitute a deprivation of due process; (ii) [t]here was such infirmity of proof establishing the conduct as to give rise to the clear conviction that the Office could not, consistently with its duty, accept as final the conclusion on that subject; (iii) [t]he imposition of the same public censure, public reprimand, probation, disbarment, suspension or disciplinary disqualification by the Office would result in grave injustice; or (iv) [a]ny argument that the practitioner was not publicly censured, publicly reprimanded, placed on probation, disbarred, suspended or disciplinarily disqualified.

Id.

¹⁶⁰ See Michael E. McCabe, Jr., *Enter the Sandman: USPTO Unhittable in Reciprocal Discipline Proceedings*, IPWATCHDOG (Sept. 22, 2014), <https://www.ipwatchdog.com/2014/09/22/uspto-unhittable-in-reciprocal-discipline/id=51327/> [<https://perma.cc/WB2K-LD9L>] (discussing the USPTO's perfect 77-0 record in reciprocal discipline cases).

¹⁶¹ USPTO Presentation, *supra* note 146, at 8 (acknowledging the straightforward nature of its reciprocal discipline cases).

¹⁶² 37 C.F.R. § 11.56.

¹⁶³ *FOIA Documents*, U.S. PATENT & TRADEMARK OFFICE, <https://e-foia.uspto.gov/Foia/OEDReadingRoom.jsp> [<https://perma.cc/9PTQ-Y8U5>].

about the practitioner's misconduct and sanction are also published in the *Official Gazette*.¹⁶⁴

III. USPTO ETHICS RULES: A PRIMER

This Article aims to empirically study the imposition of USPTO discipline between 2003 and 2018. As a preliminary matter, therefore, it is necessary to identify and understand the USPTO's ethics rules. This is not a straightforward task. The USPTO transitioned from the Patent and Trademark Office Code of Professional Responsibility (USPTO Code) to the USPTO Rules of Professional Conduct (USPTO Rules) on May 3, 2013.¹⁶⁵ Accordingly, this Part first describes the structure and features of the prior USPTO Code.¹⁶⁶ It then turns to a discussion of the USPTO Rules, focusing on the reasons for the transition and the key differences between the USPTO Rules and the ABA Rules.¹⁶⁷ The Part continues with a proposed mapping between the USPTO Code, USPTO Rules, and ABA Rules, which will become the basis for the analysis presented in Part V.¹⁶⁸

A. The USPTO Code (1985–2013)

The USPTO Code was based on the ABA Model Code of Professional Responsibility (ABA Code)¹⁶⁹ that was adopted in 1969¹⁷⁰ but replaced in 1983 by the ABA Model Rules.¹⁷¹ Indeed, the ABA's transition from the Model Code to the Model Rules likely precipitated the creation of the USPTO Code, because the USPTO had previously just incorporated the ABA Code by refer-

¹⁶⁴ See, e.g., *Notice of Suspension*, 1455 OFF. GAZ. PAT. & TRADEMARK OFFICE 67, 131 (2018), <https://www.uspto.gov/web/offices/com/sol/og/2018/week41/TOC.htm> [<https://perma.cc/3KKX-XJ85>] (publishing a notice of suspension); *Notice of Public Reprimand and Probation*, 1455 OFF. GAZ. PAT. & TRADEMARK OFFICE 67, 134 (2018), <https://www.uspto.gov/web/offices/com/sol/og/2018/week41/TOC.htm> [<https://perma.cc/A8FS-UETJ>] (publishing a notice of public reprimand and probation).

¹⁶⁵ Changes to Representation of Others Before the United States Patent and Trademark Office, 78 Fed. Reg. 20,179, 20,179 (Apr. 3, 2013) (to be codified in scattered parts of 37 C.F.R.); see also Press Release, U.S. Patent & Trademark Office, USPTO Updates Prof'l Conduct Rules and Registration Examination for Patent Att'ys (Apr. 3, 2013), <https://www.uspto.gov/about-us/news-updates/uspto-updates-professional-conduct-rules-and-registration-examination-patent> [<https://perma.cc/KF2U-EJVH>] (announcing the adoption of the USPTO Rules).

¹⁶⁶ See discussion *infra* Part III.A.

¹⁶⁷ See discussion *infra* Part III.B.

¹⁶⁸ See discussion *infra* Part III.C.

¹⁶⁹ See Practice Before the Patent and Trademark Office, 50 Fed. Reg. 5,158, 5,159 (Feb. 6, 1985) (to be codified at 37 C.F.R. pts. 1, 2, 10).

¹⁷⁰ MODEL CODE OF PROF'L RESPONSIBILITY (AM. BAR ASS'N 1980).

¹⁷¹ MODEL RULES OF PROF'L CONDUCT (AM. BAR ASS'N 1983).

ence and applied those provisions to practitioners.¹⁷² Like the ABA Code, the USPTO Code contained nine canons that were “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.”¹⁷³ These canons had no real disciplinary force—indeed, there were no USPTO disciplinary orders in the years under study that had been predicated on the violation of a canon—but they were used as guiding principles under which the disciplinary rules were organized.¹⁷⁴

Although the USPTO Code was based on the ABA Code, it also included a multitude of rules that were specific to practitioners’ work before the Office. Indeed, the section labeled “misconduct” contained six subsections and further listed an additional twenty categories of behavior that constituted misconduct before the USPTO.¹⁷⁵ Included among these categories was 37 C.F.R. § 10.23(c)(3) that proscribed “[m]isappropriation 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 [USPTO] Office.”¹⁷⁶ The specific conduct identified in these categories would have otherwise violated other enacted rules (for example, the prohibition on neglecting a legal matter),¹⁷⁷ but they provided clear examples of the types of misconduct that could occur in the course of USPTO practice.¹⁷⁸

In a few instances, the USPTO Code was more permissive than the ABA Code. For example, the USPTO Code carved out an exception to the general prohibition on practitioners acquiring a proprietary interest in the subject matter of the representation, under which they were permitted to “take an interest in the patent as part or all of his or her fee.”¹⁷⁹ This provision condoned a long-standing practice between patent applicants and practitioners, analogous to a contingency fee that lawyers had traditionally been permitted to collect.¹⁸⁰

¹⁷² See Practice Before the Patent and Trademark Office, 50 Fed. Reg. at 5,158 (describing the adoption of the USPTO Code).

¹⁷³ *Id.* at 5,175.

¹⁷⁴ See *id.*

¹⁷⁵ 37 C.F.R. § 10.23(b)–(c) (2012) (repealed 2013).

¹⁷⁶ *Id.* § 10.23(c).

¹⁷⁷ See *id.* § 10.77(c) (proscribing “[n]eglect[ing] a legal matter entrusted to the practitioner”).

¹⁷⁸ See, e.g., *id.* § 10.23(c)(15) (prohibiting the act of “making a scandalous or indecent statement in a paper filed in the [USPTO] Office”).

¹⁷⁹ *Id.* § 10.64(a)(3).

¹⁸⁰ See MODEL CODE OF PROF’L RESPONSIBILITY EC 2-20 (AM. BAR ASS’N 1980) (“Contingent fee arrangements in civil cases have long been commonly accepted in the United States in proceedings to enforce claims.”).

The USPTO Code was clear that it did not preempt the authority of states to regulate attorneys who practiced before them.¹⁸¹ What this meant for attorneys, at least, was that they were subject to at least two disciplinary authorities—the state disciplinary authority and the OED—each potentially having significantly different ethics rules. Although practitioners were required to conduct themselves according to the more restrictive standard, “sometimes the rules were so different, it was hard to know which standard was more restrictive.”¹⁸²

B. The USPTO Rules (2013–Present)

Given the confusion surrounding the differences between the USPTO Code and the ABA Rules, which had been adopted widely, the USPTO developed and eventually adopted a new set of ethics rules that drew heavily on the ABA Rules.¹⁸³ In fact, the USPTO published a document on its website at the time of the transition comparing the ABA Rules to the USPTO Rules that is a helpful resource for attorney-practitioners who are already familiar with the former.¹⁸⁴

In the Executive Summary that accompanied the new rules, the USPTO stated that it believed that practitioners would “benefit from modernization of the regulations governing professional conduct before the Office and harmonization of these regulations with corresponding rules adopted by bars in the States and the District of Columbia.”¹⁸⁵ Although licensed attorneys still must adhere to two sets of rules—and may be subject to reciprocal discipline if they are disciplined in another state¹⁸⁶—the new USPTO Rules were intended to

¹⁸¹ Practice Before the Patent and Trademark Office, 50 Fed. Reg. at 5,158. The Federal Register notes:

In issuing these rules, the PTO has made every effort to minimize preemption of State control over the practice of law. Thus, in § 10.1, second sentence, the new rules provide: Nothing in * * * [these rules] shall be construed to preempt the authority of each State to maintain control over the practice of law, except to the extent necessary for the Patent and Trademark Office to accomplish its federal objectives.

Id. (alterations in original).

¹⁸² Steven Seidenberg, *U.S. Patent and Trademark Office Adopts Ethics Guidelines That Closely Follow the ABA Model Rules*, ABA J. (July 1, 2013), http://www.abajournal.com/magazine/article/u.s._patent_and_trademark_office_adopts_ethics_guidelines_that_closely_follow [<https://perma.cc/KQ3H-YDGC>] (quoting Professor Lisa A. Dolak of Syracuse University College of Law).

¹⁸³ Press Release, U.S. Patent & Trademark Office, *supra* note 165.

¹⁸⁴ US. PATENT & TRADEMARK OFFICE, ABA AND USPTO RULE COMPARISON CHART [hereinafter RULE COMPARISON CHART], <https://www.uspto.gov/sites/default/files/documents/AbavsUSPTO.pdf> [<https://perma.cc/CDT6-EJE8>].

¹⁸⁵ Changes to Representation of Others Before the United States Patent and Trademark Office, 78 Fed. Reg. at 20,180.

¹⁸⁶ See 37 C.F.R. §§ 11.24, 11.804(h) (2019).

“clarify[] and streamline[] their professional responsibility obligations.”¹⁸⁷ The USPTO also anticipated that practitioners would benefit from disciplinary actions and judicial opinions from states that had adopted the ABA Model Rules, although it contemplated that eventually precedent specifically addressing practice before the USPTO would develop after the USPTO rules were implemented.¹⁸⁸

Given that the USPTO Rules were explicitly modeled after the ABA Rules, it raises the question of how—and why—the USPTO Rules diverge from the ABA Rules. One would expect there to be significant inertia around maintaining consistency between the two codes, meaning that changes would only be made on account of the unique features of USPTO practice or its priorities in regulating practitioners.

After a thorough review of both sets of codes, this Article identifies four primary categories of divergences. Each category is described below, together with relevant examples and commentary on the likely reasons for the divergence.

1. Practice Differences

The USPTO Rules contain a number of semantic changes that reflect the practice setting and the fact that those who practice before the USPTO are not necessarily attorneys. For example, USPTO Rules 11.102¹⁸⁹ and 11.105 (modeled after ABA Rules 1.2 and 1.5, respectively)¹⁹⁰ eliminated references to conduct in criminal or domestic relations matters, because those issues should not arise in patent or trademark litigation.¹⁹¹ Whereas ABA Rule 7.4 contains general guidance on the way in which attorneys may hold themselves out to the public, USPTO Rule 11.704 contains detailed information on who may hold themselves out as patent agents and patent attorneys, as well as additional limits on non-lawyers holding themselves out as authorized to practice trademark law.¹⁹²

¹⁸⁷ Changes to Representation of Others Before the United States Patent and Trademark Office, 78 Fed. Reg. at 20,180.

¹⁸⁸ *Id.*

¹⁸⁹ Although the official citation to the USPTO Rules would be 37 C.F.R. § 11.XXX, this Article will hereinafter refer to the USPTO Rules in the following manner in the main text: USPTO Rule 11.XXX.

¹⁹⁰ RULE COMPARISON CHART, *supra* note 184, at 4–5, 6–8.

¹⁹¹ Changes to Representation of Others Before the United States Patent and Trademark Office, 78 Fed. Reg. at 20,180.

¹⁹² RULE COMPARISON CHART, *supra* note 184, at 53–54. For another example, USPTO Rule 11.101, which governs competence representation, added “scientific” and “technical” knowledge to the legal knowledge required. *Id.*

2. Harmonizing Provisions

Several USPTO provisions were crafted to further align the USPTO Rules with obligations under state ethics rules or other ABA guidance. For example, USPTO Rule 11.115, which governs accounting and recordkeeping, provides that lawyers will be deemed in compliance with the Rule if they otherwise meet the corresponding requirements for the state in which they are actively licensed. The Rule further provides that non-lawyer practitioners will be deemed in compliance if they are part of a firm that maintains records that meet the requirements in a state in which one of their practitioners is a licensed attorney.¹⁹³ These rules have the effects of reducing confusion and streamlining compliance, which were two goals of adopting the USPTO Rules.¹⁹⁴

3. Non-Adoption of Ancillary Rules

The USPTO declined to adopt a number of rules that this Article is terming “ancillary,” meaning that they are not generally the subject of disciplinary proceedings because they are (1) explanatory, (2) aspirational, or (3) uncommon occurrences. An example of an explanatory provision is ABA Rule 1.2(b), which provides that legal representation “does not constitute an endorsement of the client’s political, economic, social or moral activities.”¹⁹⁵ ABA Rule 6.1 is an aspirational provision, encouraging lawyers to provide at least fifty hours of pro bono service annually.¹⁹⁶ Two examples of uncommon occurrences include ABA Rule 1.8(j), which regulates sexual relations with clients, and ABA Rule 7.6, which proscribes political contributions for obtaining legal engagements or appointments.¹⁹⁷ Even though these provisions were not formally adopted, the USPTO clarified that lawyer-practitioners would nevertheless be subject to these ancillary rules if they practiced in a jurisdiction that had adopted them, and that such conduct could very well violate one or more provisions of USPTO Rule 11.804, the general misconduct section.¹⁹⁸

¹⁹³ *Id.*

¹⁹⁴ See Press Release, U.S. Patent & Trademark Office, *supra* note 165.

¹⁹⁵ MODEL RULES OF PROF'L CONDUCT r. 1.2(b) (AM. BAR ASS'N 1983).

¹⁹⁶ *Id.* r. 6.1.

¹⁹⁷ *Id.* r. 1.8, r. 7.6.

¹⁹⁸ See, e.g., Changes to Representation of Others Before the United States Patent and Trademark Office, 78 Fed. Reg. at 20,183. The Federal Register notes:

Section 11.108(j) is reserved. The USPTO has declined to enact a rule that specifically addresses sexual relations between practitioners and clients. Because of the fiduciary duty to clients, combining a professional relationship with any intimate personal relationship may raise concerns about conflict of interest and impairment of the judgment of both practitioner and client. To the extent warranted, such conduct may be investigated under general provisions of the USPTO Rules. See § 11.804.

4. Substantive Deviations

The USPTO Rules contain several substantive deviations from the ABA Rules. Unlike the three preceding categories, each of these substantive deviations reflects a policy decision made by the USPTO to regulate practitioner conduct in a different manner than the ABA Rules would provide. These deviations could potentially have a significant impact on practitioner conduct, as well as on the OED's disciplinary function.

a. Duty of Disclosure and Inequitable Conduct

As discussed in Part II.B, patent practitioners have a duty to disclose information that is material to patentability. In addition to the threat of having a client's patent invalidated, a violation of the duty of disclosure may lead to USPTO disciplinary action. USPTO Code 11.303 mandates that practitioners "disclose to the Office information necessary to comply with applicable duty of disclosure provisions," which is further reiterated in subsection 11.106(c).¹⁹⁹ Furthermore, the USPTO Rules make it clear that a practitioner may not claim concerns of client confidentiality as a reason for non-disclosure. Subsections 11.106(a)(2) and (a)(3) both contain confidentiality exceptions for practitioners who reveal information to prevent or rectify injury caused by a client's inequitable conduct before the USPTO. The explanation accompanying the final rule states that "[t]he practitioner's responsibility to present the client's case with persuasive force is qualified by the practitioner's duty of candor to the tribunal," exhibiting a preference for the duty of candor.²⁰⁰

b. Fraud

The scienter required for fraud under the USPTO Rules is lower than that under the ABA Model Rules, as it may be satisfied by "intent to deceive or a state of mind *so reckless respecting consequences* as to be the equivalent of intent."²⁰¹ By contrast, the ABA definition of fraud looks to state substantive

Id.

¹⁹⁹ *Id.* at 20,184–85.

²⁰⁰ *Id.* at 20,185; see Kyle R. Kroll, Essay, *Prosecuting Inequitable Conduct*, 102 MINN. L. REV. HEADNOTES 49, 57 (2018) (discussing the prevalence of patent fraud before the USPTO and the applicability of the duty of disclosure); Brandee N. Woolard, Note, *The Resurrection of the Duty to Inquire After Therasense, Inc. v. Becton, Dickinson & Co.*, 12 DUKE L. & TECH. REV. 41, 51 (2013–2014) (discussing the USPTO Rules in light of the *Therasense, Inc.* decision).

²⁰¹ 37 C.F.R. § 11.1 (2019) (emphasis added). "Fraud" or "fraudulent" is defined as:

conduct that involves a misrepresentation of material fact made with intent to deceive or a state of mind so reckless respecting consequences as to be the equivalent of intent, where there is justifiable reliance on the misrepresentation by the party deceived, induc-

law, but also requires a showing that a lawyer has a “purpose to deceive.”²⁰² In support of its position, the USPTO cited a number of patent cases in which it had adopted the common-law definition of fraud.²⁰³ Interestingly, the USPTO did not identify any trademark cases that had adopted the standard (nor did it address the question left open in *In re Bose* about whether recklessness could suffice), but the fraud definition in the USPTO Rules applies with equal force in patent and trademark matters.²⁰⁴

c. Disclosure in Ex Parte Proceedings

The USPTO Rules carry a heightened duty of disclosure for ex parte proceedings, requiring practitioners under USPTO Rule 11.303 to disclose both known legal authority and material facts that are directly adverse to their client’s position. Notably, the USPTO justifies this deviation by stating that “[a]ll decisions made by the Office in patent and trademark matters affect the public interest” and that many of them are made ex parte.²⁰⁵

d. Misconduct

Although the USPTO’s misconduct section largely tracks the ABA version, it does contain two additional provisions of note.²⁰⁶ First, it includes a specific provision related to the imposition of reciprocal discipline. This provision provides that a practitioner (in this case, a lawyer) who is publicly disciplined by another authority will be deemed to have committed misconduct and

ing the party to act thereon, and where there is injury to the party deceived resulting from reliance on the misrepresentation. Fraud also may be established by a purposeful omission or failure to state a material fact, which omission or failure to state makes other statements misleading, and where the other elements of justifiable reliance and injury are established.

Id.

²⁰² See MODEL RULES OF PROF’L CONDUCT r. 1.0(d) (“‘Fraud’ or ‘fraudulent’ denotes conduct that is fraudulent under the substantive or procedural law of the applicable jurisdiction and has a purpose to deceive.”).

²⁰³ Changes to Representation of Others Before the United States Patent and Trademark Office, 78 Fed. Reg. at 20,181 (citing *Unitherm Food Sys., Inc. v. Swift-Ekrich, Inc.*, 375 F.3d 1341, 1358 (Fed. Cir. 2004) and *In re Spalding Sports Worldwide, Inc.*, 203 F.3d 800, 807 (Fed. Cir. 2000)).

²⁰⁴ See Stephanie H. Bald & Linda K. McLeod, *Ethical Issues for Trademark Lawyers Practicing Before the U.S. Patent and Trademark Office*, LANDSLIDE, May–June 2013, at 33, 36 (discussing the new fraud definition in the context of trademark practice).

²⁰⁵ Changes to Representation of Others Before the United States Patent and Trademark Office, 78 Fed. Reg. at 20,184; see Leonard Raykinsteen, *Ethical Considerations in Intellectual Property Law*, 99 J. PAT. & TRADEMARK OFF. SOC’Y 47, 61 (2017) (discussing the heightened obligations of patent practitioners because the work affects the public interest).

²⁰⁶ See RULE COMPARISON CHART, *supra* note 184, at 56–57.

thus subject to USPTO discipline as well.²⁰⁷ This provision, though not included in the ABA Rules, is not a deviation from its spirit because it is included within another ABA-approved code, the ABA Model Rules for Lawyer Disciplinary Enforcement.²⁰⁸ Its presence is worth noting, however, given the high percentage of USPTO disciplinary actions that impose reciprocal discipline.²⁰⁹

Second, the USPTO Rules contain an additional subsection that covers “other conduct that adversely reflects on the practitioner’s fitness to practice before the Office.”²¹⁰ This provision was carried over from the earlier USPTO Code and is analogous to a provision of the earlier ABA Code, which proscribed “conduct that adversely reflects on the lawyer’s fitness to practice law.”²¹¹ This provision somewhat fell out of favor, however, as challenges began to mount over the enforceability of the provision on grounds of vagueness and overbreadth.²¹² Nevertheless, several state disciplinary codes have retained the provision despite its absence in the ABA Rules, which counsels against putting too much weight into the USPTO’s decision to retain it.²¹³

e. Conflict of Interest Fee Provisions

The USPTO Rules continue to allow practitioners to acquire interests in patents or patent applications as their fee in matters before the Office, as was permitted under the USPTO Code.²¹⁴ Although this provision is more lenient than under the ABA Rules, it is still subject to the other conflict of interest limitations including 11.108(a), which requires that the transaction be fair and reasonable to the client and that the client give written informed consent to its

²⁰⁷ 37 C.F.R. § 11.804(h) (2019).

²⁰⁸ MODEL RULES FOR LAWYER DISCIPLINARY ENF’T r. 22 (AM. BAR ASS’N 2002) (providing for reciprocal discipline). *See generally* Arthur F. Greenbaum, *The Automatic Reporting of Lawyer Misconduct to Disciplinary Authorities: Filling the Reporting Gap*, 73 OHIO ST. L.J. 437 (2012).

²⁰⁹ *See* discussion *infra* Part V.B.

²¹⁰ 37 C.F.R. § 11.804(i).

²¹¹ MODEL CODE OF PROF’L RESPONSIBILITY DR 1-102(6) (AM. BAR ASS’N 1980).

²¹² *See, e.g.*, Att’y Grievance Comm’n v. Martin, 518 A.2d 1050, 1054 (Md. 1987); *see also* Donald T. Weckstein, *Maintaining the Integrity and Competence of the Legal Profession*, 48 TEX. L. REV. 267, 276 (1970) (expressing “uncertain[ty] of] what conduct will be held to reflect adversely on fitness to practice law”). *But see generally* Samuel J. Levine, *Taking Ethics Codes Seriously: Broad Ethics Provisions and Unenumerated Ethical Obligations in a Comparative Hermeneutic Framework*, 77 TUL. L. REV. 527 (2003) (calling on scholars to reconsider their criticism of broad ethics rules, including the fitness to practice rule).

²¹³ *See, e.g.*, ALABAMA RULES OF PROF’L CONDUCT r. 8.4(g) (2019); MASSACHUSETTS RULES OF PROF’L CONDUCT r. 8.4(h) (2019) (proscribing “any other conduct that adversely reflects on his or her fitness to practice law”).

²¹⁴ *See* 37 C.F.R. § 11.108(i)(3).

terms.²¹⁵ The USPTO Rules also allow practitioners to advance costs and expenses in connection with proceedings before the Office,²¹⁶ as well as fees that are “required to prevent or remedy an abandonment of a client’s application” due to practitioner misconduct.²¹⁷

These lenient and flexible fee provisions appear to recognize that the types of matters before the USPTO differ from those at the root of the concerns behind the conflict of interest fee provisions that appear in the ABA Rules.²¹⁸ Whereas patent and trademark matters are commercial enterprises (and the stereotypical client a sophisticated businessperson), the ABA Rules must be designed to cover a wider range of litigation and transactional matters and client bases.

Collectively, these substantive deviations from the ABA Rules largely reflect the heightened obligation of good faith expected of practitioners in their actions before the USPTO. For patent cases this obligation includes the so-called “duty of disclosure,” but all practitioners are expected to disclose adverse facts and law in *ex parte* proceedings and are subject to discipline for highly reckless misrepresentations, irrespective of the type of proceeding.²¹⁹

C. Mapping the Various Ethics Codes

There is no definitive mapping that exists between the USPTO Code and the USPTO Rules. This study first aimed to develop such a mapping so that disciplinary actions could be analyzed across years. The table below presents the first ever mapping between those two sets of ethics codes for the disciplinary rules that have been the subject of public discipline, together with the corresponding provisions of the ABA Rules and a category description.

²¹⁵ See Changes to Representation of Others Before the United States Patent and Trademark Office, 78 Fed. Reg. at 20,183.

²¹⁶ 37 C.F.R. § 11.108(e)(3).

²¹⁷ *Id.* § 11.108(e)(4).

²¹⁸ See MODEL RULES OF PROF’L CONDUCT r. 1.8 cmt. 10 (AM. BAR ASS’N 1983). The comment notes:

Lawyers may not subsidize lawsuits or administrative proceedings brought on behalf of their clients, including making or guaranteeing loans to their clients for living expenses, because to do so would encourage clients to pursue lawsuits that might not otherwise be brought and because such assistance gives lawyers too great a financial stake in the litigation.

Id.; see also *id.* at cmt. 16 (“Paragraph (i) states the traditional general rule that lawyers are prohibited from acquiring a proprietary interest in litigation. Like paragraph (e), the general rule has its basis in common law champerty and maintenance and is designed to avoid giving the lawyer too great an interest in the representation.”).

²¹⁹ See 37 C.F.R. § 11.303.

Nearly all of the USPTO Code provisions could be successfully mapped to a corresponding USPTO Rule section.²²⁰ The only exception was for USPTO Code 10.23(a), which provided that “[a] practitioner shall not engage in disreputable or gross misconduct.”²²¹ In reviewing each of the disciplinary actions for which 10.23(a) was violated, however, it became clear that it was nearly always identified along with more specific rules that described the precise type of misconduct involved.²²² There were two disciplinary actions that identified only 10.23(a) as the rule that had been violated, but in both instances there was clearly another specific provision that applied.²²³ Those two rules were re-coded accordingly and 10.23(a) was omitted from the analysis in Part V.

In total, the study identified only thirty-three categories over the sixteen-year period. This finding suggests that the USPTO relies on relatively few rules as the basis for discipline, a topic explored later in the Article.²²⁴

²²⁰ The initial plan was to map all the individual subsections of the USPTO Code and USPTO Rules, but that task proved intractable given the differences between the USPTO Code and USPTO Rules, as well as unnecessary given the low number of disciplinary actions. Thus, the provisions were generally mapped at the ABA Rules section level, with subsections mapped for general rules that included many disparate subsections (for example, misconduct and specific conflict of interest provisions). The only other exception was for the conflict of interest category, for which there were many differences between the USPTO Rules and USPTO Code.

²²¹ 37 C.F.R. § 10.23 (2012) (repealed 2013).

²²² See, e.g., *In re Maiorino*, No. D2004-11, at 1 (U.S. Patent and Trademark Office Aug. 9, 2004) (final order) (finding violations of 37 C.F.R. §§ 10.23(a), 10.23(b)(3), 10.23(b)(6), and 10.23(c)(1) for a sexual assault conviction).

²²³ *In re Fuller*, No. D2013-23, at 1 (U.S. Patent and Trademark Office Mar. 12, 2014) (final order) (finding that respondent illegally photographed other persons); *In re York*, No. D2013-19, at 8–9 (U.S. Patent and Trademark Office Nov. 18, 2013) (final order) (finding a violation of terms of fee sharing agreement with associated law firm).

²²⁴ See discussion *infra* Part IV.

Description	ABA Rule	USPTO Rule	USPTO Code
Competence	1.1	11.101	10.77(a), 10.77(b)
Scope of Representation	1.2	11.102	No equivalent rule
Diligence / Neglect	1.3	11.103	10.77(c), 10.84, 10.23(c)(3)
Communication	1.4	11.104	10.23(c)(8)
Fees	1.5	11.105	10.36
Confidentiality	1.6	11.106	10.57
Conflict of Interest	1.7, 1.9(a), 1.10	11.107, 11.109(a), 11.110	10.62(a), 10.66
Business Transaction with Client	1.8(a)	11.108(a)	10.65
Influence from Third-Party Payer	1.8(f)	11.108(f)	10.68
Limitation on Liability	1.8(h)	11.108(h)	10.78
USPTO / Gov't Employee	1.11	11.111	10.23(c)(19)–(20)
Safekeeping Property	1.15	11.115	10.112
Withdrawal / Termination	1.16	11.116	10.40
Candid Advice	2.1	11.201	No equivalent
Non-Meritorious Claims	3.1	11.301	10.39
False Statements / Fraud Before Office	3.3	11.303	10.85, 10.23(c)(2)(ii), 10.23(c)(14)–(15)
Fairness to Opposing Party and Counsel	3.4	11.304	10.89(c)
Ex Parte Communications	3.5(b)	11.305(b)	10.93
False Statements to Third Parties	4.1	11.401	No equivalent rule
Violation in Non-Lawyer Assistance	5.3	11.503	No equivalent rule
Improper Non-Practitioner Relationship	5.4	11.504	10.37, 10.48, 10.49
Assisting in Unauthorized Practice	5.5	11.505	10.23(c)(6), 10.47

False Advertising	7.1	11.701	10.31
Improper Advertising	7.2	11.702	10.32
Improper Solicitation	7.3	11.703	10.33
Office Admission Candor	8.1	11.801	10.22(a)
Reporting Misconduct	8.3	11.803	10.24, 10.23(c)(16)
Violation Through Others	8.4(a)	11.804(a)	10.23(b)(2)
Criminal Acts	8.4(b)	11.804(b)	10.23(b)(3) & (c)(1)
General Misrepresenta- tion	8.4(c)	11.804(c)	10.23(b)(4), 10.23(c)(2)(i)
Administration of Justice	8.4(d)	11.804(d)	10.23(b)(5), 10.23(c)(9)
Reciprocal Discipline	No equivalent	11.804(h)	10.23(c)(5)
General Unfitness to Practice	No equivalent	11.804(i)	10.23(b)(6)
Disreputable or Gross Misconduct	No equivalent	No equivalent	10.23(a)

IV. PRACTITIONER DISCIPLINE: A THEORETICAL FRAMEWORK

To evaluate the extent to which the OED is successful in carrying out its responsibilities, this Part identifies and describes the purposes of practitioner discipline and sanctions to provide the standards by which its work may be judged.²²⁵ Although a complete treatment of this topic is beyond the scope of this Article,²²⁶ several prevailing theories will be discussed. They will then be framed within the somewhat distinct setting of USPTO practice to determine the extent to which one or more theories should carry special weight.

A. Purposes of Practitioner Discipline

At the outset, it is important to note that disciplinary bodies and courts reviewing such cases rarely discuss the purposes behind imposing discipline outside of the context of a specific adjudication.²²⁷ This phenomenon has not been lost on those scholars, who argue forcefully that professional regulators should

²²⁵ See discussion *infra* Part IV.

²²⁶ See generally Leslie C. Levin, *The Emperor's Clothes and Other Tales About the Standards for Imposing Lawyer Discipline Sanctions*, 48 AM. U. L. REV. 1 (1998); Zacharias, *supra* note 33.

²²⁷ See Laurel S. Terry et al., *Adopting Regulatory Objectives for the Legal Profession*, 80 FORD-HAM L. REV. 2685, 2721–22 (2012) (noting that no U.S. jurisdiction has adopted regulatory objectives for the profession, and contrasting it with other nations).

more explicitly identify and prioritize the purposes behind discipline in order to promote effectiveness and consistency.²²⁸ Indeed, the lack of such guidance would make it difficult for those who impose discipline to know how to do so when there are competing considerations at stake. Nevertheless, several themes predominate.

The first purpose, and the one most often cited, is the “protection of the public.”²²⁹ What is precisely meant by the phrase is up for debate, as it is sometimes described in terms of the practitioner’s clients who have been directly affected by the misconduct.²³⁰ Such a narrow conception is not fully explanatory, however, because discipline is imposed on conduct that has already occurred and often does not include restitution to the client who has been harmed. A second conception of “public” implicates protecting the practitioner’s other clients or future clients.²³¹ This purpose can be accomplished in one of three ways: (1) by incapacitating the practitioner (through a term suspension or exclusion), (2) by giving notice to others of the practitioner’s misconduct and thereby affecting whether and how they engage with the practitioner, and (3) by decreasing the likelihood that the practitioner engages in such misconduct again. But there is still a third conception of the “public,” one that extends beyond the immediate practitioner-client relationship to others who might be harmed.²³² This could include persons other than clients who would be adversely impacted were this practitioner to commit this type of misconduct in the future. It could even be extended to include others who would be adversely impacted if another practitioner were to commit this type of misconduct, under the theory that the imposition of discipline against one practitioner might deter others from committing misconduct themselves.²³³

The second purpose behind lawyer discipline is the protection of the administration of justice.²³⁴ This purpose is evident in many rules adopted by

²²⁸ See Zacharias, *supra* note 33, at 733–34.

²²⁹ Mary M. Devlin, *The Development of Lawyer Disciplinary Procedures in the United States*, 7 GEO. J. LEGAL ETHICS 911, 939 (1994); Levin, *supra* note 226, at 20.

²³⁰ See Zacharias, *supra* note 33, at 695.

²³¹ See *id.*; Janine C. Ogando, Note, *Sanctioning Unfit Lawyers: The Need for Public Protection*, 5 GEO. J. LEGAL ETHICS 459, 462 (1991) (noting that “[c]lients and future clients potentially suffer the most harmful consequences” when courts do not appropriately sanction attorneys).

²³² See Ogando, *supra* note 231, at 462 (directly linking lawyer discipline to the need for broadly conceived public protection).

²³³ See Stephen Gillers, *Lowering the Bar: How Lawyer Discipline in New York Fails to Protect the Public*, 17 N.Y.U. J. LEGIS. & PUB. POL’Y 485, 494 (2014); Julie Rose O’Sullivan, *Professional Discipline for Law Firms? A Response to Professor Schneyer’s Proposal*, 16 GEO. J. LEGAL ETHICS 1, 14 (2002).

²³⁴ Levin, *supra* note 226, at 17; see, e.g., *In re Gortmaker*, 782 P.2d 421, 424 (Or. 1989) (“The purpose of professional discipline is to protect the public and the administration of justice from lawyers who have not discharged, will not discharge, or are unlikely to properly discharge their professional duties to their clients, the public, the legal system, and the legal profession.”).

disciplinary authorities, including ABA Rule 8.4(d), which explicitly prohibits lawyers from “engag[ing] in conduct that is prejudicial to the administration of justice.”²³⁵ But its presence can also be seen through ABA Rules 3.1–3.9, which impose discipline for a variety of activities that may have an adverse impact on an adjudication, and in the Preamble to the ABA Rules that reminds lawyers that they are “officer[s] of the legal system and . . . public citizen[s] having special responsibility for the quality of justice.”²³⁶ Thus, this purpose pervades the ABA Rules and provides a lens through which they should be understood.

The third purpose behind practitioner discipline is to instill and preserve confidence in the legal profession.²³⁷ This purpose comes under fire by scholars on account of the legal profession’s insistence on self-regulation that leads some to question the degree to which discipline may be legitimately and accurately imposed.²³⁸ Nevertheless, proponents of self-regulation tout the disciplinary process, and in particular the public imposition of discipline,²³⁹ as essential for preserving public confidence.²⁴⁰ This purpose has led scholars such as Leslie Levin to argue in favor of increased transparency in disciplinary proceedings and broad publication of disciplinary proceedings.²⁴¹ It has also fueled pushes for increased consistency, both across and within disciplinary bodies, in the imposition of discipline and sanctions imposed.²⁴² Indeed, the ABA Rules have been adopted in whole or large part by forty-nine states (California being the only exception) and four U.S. Territories, which should, in

²³⁵ MODEL RULES OF PROF’L CONDUCT r. 8.4(d) (AM. BAR ASS’N 1983).

²³⁶ *Id.* r. 3.1–9.

²³⁷ Devlin, *supra* note 229, at 939; Levin, *supra* note 226, at 17–18.

²³⁸ See, e.g., David B. Wilkins, *Who Should Regulate Lawyers?*, 105 HARV. L. REV. 799, 853 (1992); Fred C. Zacharias, *The Myth of Self-Regulation*, 93 MINN. L. REV. 1147, 1151 (2009); see also Allen Blumenthal, *Attorney Self-Regulation, Consumer Protection, and the Future of the Legal Profession*, 3 KAN. J.L. & PUB. POL’Y 6, 11 (1993–1994).

²³⁹ Leslie C. Levin, *The Case for Less Secrecy in Lawyer Discipline*, 20 GEO. J. LEGAL ETHICS 1, 29 (2007); Jacquelyn M. Desch, Note, *Attorney Discipline Online*, 29 GEO. J. LEGAL ETHICS 921, 938 (2016).

²⁴⁰ See COMM’N ON EVALUATION OF DISCIPLINARY ENF’T, AM. BAR ASS’N, LAWYER REGULATION FOR A NEW CENTURY (2018), https://www.americanbar.org/groups/professional_responsibility/resources/report_archive/mckay_report/ [<https://perma.cc/XQ59-4LX7>] (recommending greater access to disciplinary action); see also Vincent R. Johnson, *Justice Tom C. Clark’s Legacy in the Field of Legal Ethics*, 29 J. LEGAL PROF. 33, 66 (2005).

²⁴¹ See Levin, *supra* note 226, at 71; see also Jennifer Carpenter & Thomas Cluderay, Note, *Implications of Online Disciplinary Records: Balancing the Public’s Interest in Openness with Attorneys’ Concerns for Maintaining Flexible Self-Regulation*, 22 GEO. J. LEGAL ETHICS 733, 740 (2009).

²⁴² See Ogando, *supra* note 231, at 464.

theory at least, serve to limit the variability across jurisdictions in terms of the types of misconduct that are subject to discipline.²⁴³

B. The Role of Sanctions

With these three purposes in mind—protection of the public, promotion of the administration of justice, and the instilling of confidence in the legal profession—further attention to the role of sanctions is warranted. In many ways, disciplinary sanctions can be viewed as analogous to criminal sanctions, and professional responsibility scholars have looked to the vast criminal law literature in the area for guidance.²⁴⁴

Yet there are important differences. Unlike criminal sanctions, disciplinary sanctions should not be grounded in retribution because the misconduct at issue is not necessarily morally blameworthy but rather professionally incompetent.²⁴⁵ To the extent that such conduct is simultaneously morally blameworthy, it can be vindicated instead through the criminal justice system. By contrast, disciplinary sanctions should be forward-looking and directed toward the goal of ensuring that such misconduct not recur.²⁴⁶ Furthermore, disciplinary bodies rarely impose restitutionary sanctions and, in theory, aggrieved clients or third parties would be able to pursue restitution through civil proceedings.²⁴⁷

This Article will focus instead on five goals to be served by sanctions: (1) specific deterrence, (2) general deterrence, (3) incapacitation, (4) rehabilitation, and (5) expressions of disapproval. Sanctions that operate as specific deterrence will reduce the likelihood that the same practitioner will commit future misconduct.²⁴⁸ Although in theory any type of sanction could operate as specific deterrence, sanctions that include the imposition of probation should lessen the likelihood that a practitioner will commit misconduct during the probationary period. To the extent that prior misconduct will be considered an

²⁴³ See *Alphabetical List of Jurisdictions Adopting Model Rules*, AM. BAR ASS'N, https://www.americanbar.org/groups/professional_responsibility/publications/model_rules_of_professional_conduct/alpha_list_state_adopting_model_rules/ [<https://perma.cc/EVK9-KJ8C>]; see also John S. Dzienkowski, *Ethical Decisionmaking and the Design of Rules of Ethics*, 42 HOFSTRA L. REV. 55, 57 (2013) (noting the success of the ABA in creating rules that are uniformly adopted, but arguing that such rules have not kept up with changes in the profession).

²⁴⁴ See, e.g., Zacharias, *supra* note 226, at 683. See generally Nancy J. Moore, *Mens Rea Standards in Lawyer Disciplinary Codes*, 23 GEO. J. LEGAL ETHICS 1 (2010) (applying criminal law concepts to analyze and interpret lawyer disciplinary codes).

²⁴⁵ Zacharias, *supra* note 33, at 684.

²⁴⁶ *Id.* at 685–86.

²⁴⁷ See David B. Wilkins, *Making Context Count: Regulating Lawyers After Kaye*, Scholer, 66 S. CAL. L. REV. 1145, 1177 (1993).

²⁴⁸ Stephen G. Bené, Note, *Why Not Fine Attorneys?: An Economic Approach to Lawyer Disciplinary Sanctions*, 43 STAN. L. REV. 907, 935 (1991).

aggravating factor in a subsequent disciplinary proceeding, that fact could also serve to increase the deterrent effect on the practitioner.²⁴⁹

Sanctions that operate as general deterrence do so by virtue of their effect on other practitioners, who are aware of the sanctions and conduct themselves in a manner to ensure that they do not end up suffering the same fate as the sanctioned practitioner.²⁵⁰ But the effectiveness of sanctions as general deterrence is subject to a number of considerations. First, such sanctions must be publicized in a way that other practitioners are made aware of them; otherwise, they cannot operate as a deterrence to others.²⁵¹ Second, the deterrent effect of sanctions should not be viewed in isolation. The public is likely only aware of the infrequent, highly publicized cases, whereas lawyers themselves probably change their actions in reaction to more frequent and commonplace prosecutions.²⁵² Thus, it is the practitioner's perception that he or she might likely face discipline that might deter him or her from committing misconduct, but such a perception will only be formed if the person is aware that a number of other practitioners have been disciplined for similar actions.²⁵³

Incapacitating sanctions prevent practitioners from committing future misconduct because the sanction prohibits them from representing clients or otherwise engaging in the profession.²⁵⁴ The two types of incapacitating sanctions are suspension and disbarment.²⁵⁵ Disbarment is termed "exclusion" when imposed by the USPTO.²⁵⁶ Although suspension generally lasts for a definite period of time,²⁵⁷ exclusion is theoretically permanent—subject to the practitioner successfully petitioning for reinstatement after a minimum period

²⁴⁹ Compare Benjamin B. Sendor, *The Relevance of Conduct and Character to Guilt and Punishment*, 10 NOTRE DAME J.L. ETHICS & PUB. POL'Y 99, 127 (1996) (noting that consideration of past acts is consistent with a specific deterrence theory), with Carissa Byrne Hessick, *Why Are Only Bad Acts Good Sentencing Factors?*, 88 B.U. L. REV. 1109, 1150 (2008) (calling into question the utility of aggravating factors as an effective deterrent).

²⁵⁰ See Bené, *supra* note 248, at 935.

²⁵¹ See Levin, *supra* note 226, at 72.

²⁵² Zacharias, *supra* note 33, at 729; see also Fred C. Zacharias, *What Lawyers Do When Nobody's Watching: Legal Advertising as a Case Study of the Impact of Underenforced Professional Rules*, 87 IOWA L. REV. 971, 1005–06 (2002) (discussing effects of underenforcement on attorneys' propensity to violate ethical rules).

²⁵³ Cf. Raymond Paternoster, *How Much Do We Really Know About Criminal Deterrence?*, 100 J. CRIM. L. & CRIMINOLOGY 765, 819 (2010) (applying the concept in the criminal context).

²⁵⁴ Bené, *supra* note 248, at 933–34; see DEBORAH L. RHODE & DAVID LUBAN, *LEGAL ETHICS* 956 (4th ed. 2004) (noting incapacitation as one of the predominant justifications for lawyer discipline).

²⁵⁵ Kevin Hopkins, *The Politics of Misconduct: Rethinking How We Regulate Lawyer-Politicians*, 57 RUTGERS L. REV. 839, 860 (2005).

²⁵⁶ 35 U.S.C. § 32 (2018).

²⁵⁷ *But see* 37 C.F.R. § 11.25 (2019) (providing for interim suspensions that will last until there is an opportunity for a formal disciplinary proceeding).

of time, usually five years.²⁵⁸ Given the economic and professional impacts of incapacitating sanctions, they are to be limited to more egregious instances of practitioner misconduct.²⁵⁹

As with incapacitating sanctions, rehabilitative sanctions are aimed toward eliminating future misconduct, but they do so by imposing measures on the practitioner that promote ongoing conformity with the rules.²⁶⁰ Three common rehabilitative sanctions include probation (often with ongoing monitoring of client matters or funds), mandatory education in professional responsibility, and mandatory mental health or chemical dependency treatment.²⁶¹ Often, these conditions are imposed in addition to more traditional sanctions and have become increasingly common even as rehabilitation has somewhat gone out of favor among criminal law theorists.²⁶²

Unlike the aforementioned types of sanctions, an expressive sanction is one that primarily expresses disapproval of practitioner conduct rather than imposing significant limitations or conditions on a practitioner's future professional activities.²⁶³ There are two primary types of expressive sanctions: the private warning (sometimes called an admonition or a warning letter) and the public reprimand.²⁶⁴ Whereas the former sends an expressive signal only to the disciplined practitioner, the latter may send a signal to other practitioners or to the public that such conduct is disapproved and, if repeated, could be subject to more severe sanction.²⁶⁵

Of course, a particular sanction or set of sanctions could simultaneously serve multiple purposes. For example, a public reprimand could operate as specific deterrence (lessening the likelihood that the practitioner herself would commit future misconduct), as general deterrence (lessening the likelihood that other practitioners would commit similar types of misconduct in the future), and as an expressive signal that such conduct will not be condoned. That said, a sanction such as a public reprimand may have a stronger expressive effect than a deterrent effect. Part V will examine the imposition of USPTO sanctions in light of the degree to which they serve particular purposes.²⁶⁶

²⁵⁸ *Id.* § 11.60(b) (“An excluded practitioner shall be eligible to apply for reinstatement no earlier than at least five years from the effective date of the exclusion.”).

²⁵⁹ Hopkins, *supra* note 255, at 860; Levin, *supra* note 226, at 21.

²⁶⁰ See Jennifer Gerarda Brown & Liana G.T. Wolf, *The Paradox and Promise of Restorative Attorney Discipline*, 12 NEV. L.J. 253, 299 (2012).

²⁶¹ See Levin, *supra* note 226, at 24.

²⁶² *Id.* at 23.

²⁶³ See *id.* at 22; cf. Dan M. Kahan, *What Do Alternative Sanctions Mean?*, 63 U. CHI. L. REV. 591, 602–03 (1996) (discussing the expressive character of sanctions in the context of criminal law).

²⁶⁴ The USPTO issues private warning letters. See 37 C.F.R. § 11.21 (2019).

²⁶⁵ See Levin, *supra* note 226, at 22–23.

²⁶⁶ See discussion *infra* Part V.

C. The USPTO Practice Setting

In comparison to the practice of law in a particular state, which varies widely among its licensed attorneys, practice before the USPTO is considerably more focused. This focus arguably should influence how the OED approaches practitioner discipline, in order to ensure that its work further promotes the USPTO's ultimate mission.

As the federal gatekeeper for patent issuance and trademark registration, one of the USPTO's primary responsibilities is ensuring accuracy while promoting innovation and enterprise.²⁶⁷ With many determinations being made on an *ex parte* basis, the application process,²⁶⁸ substantive requirements,²⁶⁹ and USPTO Rules²⁷⁰ all highlight the overriding importance of the duty of candor and good faith in dealings with the Office. Even in the years during which the empirical study was conducted, the USPTO promulgated additional rules and revamped its application forms to impress upon practitioners the seriousness of these obligations.²⁷¹

Ultimately, the USPTO justifies its focus on candor as being linked to the fact that its decisions affect the public interest—not just the immediate applicant's rights, but those third parties that may rely on that recognition of intellectual property rights in conducting their own affairs.²⁷² Those third parties may include future competitors, who decline to use a particular mark for fear of infringing on a pre-existing registered trademark. It may include investors, who use the issuance of a patent as an official stamp of approval on the viability of an invention. Viewed in this manner, protection of the public—broadly defined—is arguably paramount. Equally important, these third parties gener-

²⁶⁷ See U.S. PATENT & TRADEMARK OFFICE, 2018–2022 STRATEGIC PLAN, at 2 (2018), https://www.uspto.gov/sites/default/files/documents/USPTO_2018-2022_Strategic_Plan.pdf [<https://perma.cc/Y3RX-DSTW>]. The USPTO defines its mission as:

fostering innovation, competitiveness and job growth in the United States by conducting high quality and timely patent and trademark examination and review proceedings in order to produce reliable and predictable intellectual property rights; guiding intellectual property policy, and improving intellectual property rights protection; and delivering intellectual property information and education worldwide.

Id.

²⁶⁸ See discussion *supra* Parts I.A and I.C.

²⁶⁹ See discussion *supra* Parts I.B and I.D.

²⁷⁰ See discussion *supra* Part III.B.

²⁷¹ See, e.g., 37 C.F.R. § 42.51 (2019) (providing disclosure requirements); Amendments to the Rules of Practice for Trials Before the Patent Trial and Appeal Board, 81 Fed. Reg. 18,750, 18,761 (June 16, 2016) (to be codified at 37 C.F.R. pt. 42) (heightening disclosure requirements).

²⁷² Iancu, Remarks at International Trademark Association, *supra* note 8; see Changes to Representation of Others Before the United States Patent and Trademark Office, 78 Fed. Reg. 20,178, 20,184 (Apr. 3, 2013) (to be codified in scattered parts of 37 C.F.R.) (“All decisions made by the [USPTO] in patent and trademark matters affect the public interest.”).

ally are not participants in the prosecution process, for they have neither the relevant information nor the inclination to be involved at the early stages of an applicant's commercial enterprise.

With regard to the administration of justice, the USPTO has suggested that it is especially interested in ensuring that practitioners are responsive to inquiries from its employees, including the OED itself.²⁷³ Again, without the benefit of a true adversarial process, the USPTO simultaneously serves as decisionmaker and healthy skeptic. Thus, it would be expected that its emphasis on the administration of justice be related to those activities that could thwart the ability of the USPTO to reach timely, impartial, and accurate decisions.²⁷⁴

But what about instilling confidence in the profession? In contrast to the legal profession that is largely self-governing, USPTO practitioners do not regulate themselves. The disciplinary rules are initially enforced by USPTO employees, and the hearing officers are administrative law judges from a variety of fields. That separation should make it less likely that outsiders would view the system as a captured one—at least in comparison to the legal profession. Furthermore, although the popular media and general public sometimes have a low opinion of attorneys, that view is not especially prevalent when it comes to practitioners.²⁷⁵ That is not to say that the OED should ignore or overlook this purpose, but rather that this purpose may be secondary to the others discussed above.

A final point to raise is the relationship between OED discipline and that which may be imposed by state disciplinary authorities. At least when it comes to practitioners who are also attorneys, there are certain types of misconduct that arguably seem as or better suited to be investigated by a state disciplinary authority rather than by the OED. Such examples could include criminal acts that may reflect poorly on the practitioner-attorney's character and fitness but that do not have any direct connection to the subject matter of their practice

²⁷³ See Changes to Representation of Others Before the United States Patent and Trademark Office, 78 Fed. Reg. at 20,193 ("A practitioner's duty to cooperate fully with OED is vital to maintaining the integrity of the legal profession, which is an important duty owed by a practitioner to the public, the bar, the profession, and the Office.").

²⁷⁴ See *id.* ("A practitioner's compliance with the duty to cooperate has recently become even more essential to maintaining the integrity of the profession in light of the shorter statutory time allowed for the OED Director to complete a full and fair investigation of a practitioner's alleged misconduct.").

²⁷⁵ See, e.g., LISA G. LERMAN & PHILIP G. SCHRAG, ETHICAL PROBLEMS IN THE PRACTICE OF LAW 6–8 (4th ed. 2016) (presenting public opinion data indicating that public perception of attorneys is low); *Honesty/Ethics in Professions*, GALLUP, <https://news.gallup.com/poll/1654/honesty-ethics-professions.aspx> [<https://perma.cc/X5N7-FZ6Q>] (finding that 22% of the American public rate the honesty and ethical standards of lawyers as "Very High" or "High," and 28% rate lawyers' standards as "Low or Very Low"). These ratings are lower than those for nurses, medical doctors, police officers, and bankers. *Honesty/Ethics in Professions*, *supra*.

before the USPTO. Even client trust account violations, although indirectly related to attorneys' USPTO practice, are quite likely more pervasive than among their trademark or patent clients (assuming that their practice is not so limited). By contrast, the OED would be the optimal disciplinary authority to investigate practitioners who have improper relationships with non-practitioners in prosecuting patents, prosecute fraudulent applications, or violate USPTO-specific rules such as the duty of disclosure.

V. EMPIRICAL ANALYSIS OF USPTO PRACTITIONER DISCIPLINE

With this theoretical foundation in place, this Article now turns to the critical practical question of how the OED is carrying out its responsibility to mete out discipline. To address this question, a comprehensive study was conducted of all public discipline imposed on practitioners between January 1, 2003, and December 31, 2018. This Part begins with a discussion of the methodology employed, including the rationale behind the strategic coding and analytical decisions made.²⁷⁶ It then presents the results of the study and the implications that may be drawn, first for USPTO practitioners as a whole and then specifically comparing and contrasting the discipline imposed on patent and trademark practitioners.²⁷⁷ It concludes with a discussion of the ethics rules that form the basis of discipline, identifying four common patterns of misconduct and the inferences that might be made about the OED's work and current focus.²⁷⁸

A. Methodology

To evaluate the imposition of USPTO discipline, it was necessary first to compile all disciplinary actions for the time period of interest. The USPTO provides access to all decisions from disciplinary hearings through the OED Reading Room, a searchable database that compiles information online pursuant to the Freedom of Information Act.²⁷⁹ In addition to disciplinary orders, the OED Reading Room contains a number of decisions related to practitioner admission that could be a fruitful topic for additional research.²⁸⁰

Initially, this project isolated only those disciplinary orders that were categorized as "Final Decision" or "Final Order," because the USPTO website

²⁷⁶ See discussion *infra* Part V.A.

²⁷⁷ See discussion *infra* Parts V.B and V.C.

²⁷⁸ See discussion *infra* Part V.D.

²⁷⁹ *FOIA Documents*, *supra* note 163.

²⁸⁰ *Id.*; see, e.g., *In re Graham*, No. D2013-09, at 3–4 (U.S. Patent and Trademark Office July 17, 2013) (final order) (ordering respondent's suspension and describing steps he must take prior to reinstatement to practice before the USPTO).

suggested that those designations would capture all disciplinary actions.²⁸¹ But this was under-inclusive, as there were a large number of documents labeled “Initial Decision” that did not include a corresponding “Final Decision.”²⁸² In inspecting those later documents, the reason became clear: each included language that the disciplined practitioner had thirty days to appeal the initial decision or else it would become a final decision. Accordingly, those decisions—the vast majority of which were default judgments—were included. There were also some decisions that were labeled in unconventional ways, such as “Memorandum and Order” or “Judgment.”²⁸³ Each of those was reviewed further to determine whether it should be considered a final judgment on discipline and categorized accordingly.

Once the complete set of disciplinary orders was retrieved, all were manually reviewed to determine whether they should be included in the dataset. Each document is titled in the following manner: “D[YEAR]-XX.”²⁸⁴ The year appears to generally correspond to the year in which the investigation was opened. Seven decisions corresponded to a year earlier than 2003 but these decisions were still included in the analysis because state disciplinary authorities likewise report their activities according to the year of decision and include any cases originating in an earlier year.²⁸⁵

There were two types of discipline that were excluded from the analysis. First, there were twelve disciplinary orders that imposed an interim suspension, which is imposed when a practitioner has been convicted of a serious crime.²⁸⁶ In those instances, the practitioner is then referred to a formal disciplinary proceeding based on the same misconduct, and thus there should be

²⁸¹ See *Finding a Patent Practitioner*, U.S. PATENT & TRADEMARK OFFICE, <https://www.uspto.gov/learning-and-resources/patent-and-trademark-practitioners/finding-patent-practitioner> [<https://perma.cc/5PYB-33HX>] (“For information about practitioners who have been disciplined, search OED Final Decisions in the FOIA Reading Room.”).

²⁸² See, e.g., *In re Robinson*, No. D2009-48 (U.S. Patent and Trademark Office July 1, 2010) (providing an example of an “Initial Decision” without a corresponding “Final Decision”).

²⁸³ See, e.g., *In re Myers*, No. D2015-33 (U.S. Patent and Trademark Office Dec. 31, 2015) (providing an example of a decision labeled as a “Judgment”); *In re Halvonik*, No. D2006-15 (U.S. Patent and Trademark Office Jan. 21, 2009) (providing an example of a decision labeled as a “Memorandum and Order”).

²⁸⁴ See *FOIA Documents*, *supra* note 163.

²⁸⁵ See, e.g., STANDING COMM. ON PROF’L DISCIPLINE, AM. BAR ASS’N, 2015 SURVEY ON LAWYER DISCIPLINE SYSTEMS 5–7 (2017), https://www.americanbar.org/content/dam/aba/administrative/professional_responsibility/2015_sold_results.pdf [<https://perma.cc/B7VP-N45V>] (listing the number of ethics complaints pending from prior years). There were two decisions from investigations that began in 1999, one from 2000, two from 2001, and two from 2002.

²⁸⁶ See 37 C.F.R. § 11.25 (2019) (providing for interim suspension and discipline based on conviction of a serious crime).

later disciplinary actions that cover the misconduct at issue in these orders.²⁸⁷ Second, there were four disciplinary orders in which practitioners were transferred to inactive status on account of a disability that rendered them incapable to practice law.²⁸⁸ Though styled as a “disciplinary action,” these orders do not fall within the aim of this study and were excluded.

After this scrubbing was completed, each order was read and coded according to the type of practitioner who had been disciplined, i.e. patent agent, patent attorney, or trademark attorney. But of course, some lawyers prosecute both patents and trademarks, and the misconduct at issue might involve one or both of their practices. Accordingly, each order was coded by the practice area(s) in which the misconduct had occurred and whether the practitioner was an attorney at the time of the proceeding.²⁸⁹ In cases of reciprocal discipline, practitioners were coded according to their practice area(s) rather than the areas in which the underlying misconduct occurred, unless it was clear that the underlying misconduct was in fact related to one or both practice areas.

In addition to other variables related to the disciplinary process itself (for example, whether the practitioner had responded or entered into a settlement agreement), each order was coded according to the disciplinary rule(s) violated, sanction type, sanction length, and whether additional conditions had been imposed.²⁹⁰ Finally, a summary of the relevant misconduct was prepared in order to better elucidate some of the frequently occurring fact patterns in disciplinary cases.

Of the 410 “public” disciplinary orders in the final set, five practitioners received a “private” reprimand.²⁹¹ These orders removed any identifying practitioner information but still provided insight into the misconduct at issue. In the analysis that follows, these orders are combined with the public reprimands when considered collectively but specifically identified when relevant to understanding the “public” nature of discipline imposed on a specific practitioner.

To contextualize the frequency and severity of USPTO discipline, a separate dataset was compiled of lawyer discipline by state authorities using information published by the ABA Standing Committee on Professional Discipline.

²⁸⁷ See *id.* § 11.25(b)(5) (“Upon entering a final order imposing interim suspension, the USPTO Director shall refer the complaint to a hearing officer to conduct a formal disciplinary proceeding.”).

²⁸⁸ See *id.* § 11.20(c) (providing for transfer to disability inactive status).

²⁸⁹ For patent disciplinary actions, individuals were denoted as an attorney if they were designated “patent attorney” or if the order stated that the individual was licensed to practice law.

²⁹⁰ Orders imposing suspensions required additional attention, as a significant number of them immediately stayed the suspension and instead put the practitioner on probation. For these orders, both the suspension and alternative disposition were captured.

²⁹¹ See, e.g., *In re* [Anonymous], No. D2006-17, at 3 (U.S. Patent and Trademark Office Apr. 30, 2007) (final order) (stating that a patent attorney had reached a settlement agreement whereby they would be privately reprimanded).

Each year, this committee releases results from the Survey of Lawyer Discipline (ABA SOLD), which is completed by nearly all state lawyer disciplinary authorities.²⁹² When necessary, the study was supplemented with additional data sources noted in the following analysis.

To provide an accurate comparison of the frequency of discipline among different disciplinary authorities, it was necessary to identify the number of practitioners or lawyers who were subject to such discipline. Although the ABA SOLD contains that information for each reporting state, there is no readily available comparable data for USPTO practitioners. The OED shares current information on the number of “active” patent practitioners, but there is no historical repository containing those numbers.²⁹³ Nevertheless, an estimate for patent practitioners was constructed based on several known years of data and the corresponding trends in the patent practitioner population.²⁹⁴

An estimate was even harder to develop for trademark attorneys, because the OED has no registration process or other methods for identifying who is subject to its jurisdiction. The USPTO does compile historical data on each trademark application, which may include the name of the attorney who is prosecuting it.²⁹⁵ This field required considerable scrubbing, however, because many of the “names” are not in fact names of attorneys at all.²⁹⁶ After this data was scrubbed, attorneys were considered active for a particular year if they had prosecuted a trademark application sometime within the prior three calendar years. From there, the number of active attorneys was calculated for each year during the time period of interest.

²⁹² See STANDING COMM. ON PROF'L DISCIPLINE, AM. BAR ASS'N, 2016 SURVEY ON LAWYER DISCIPLINE SYSTEMS (2018), https://www.americanbar.org/content/dam/aba/administrative/professional_responsibility/2016sold_results.pdf [<https://perma.cc/NSH9-S96F>] (providing the results of the 2016 survey); see also *Historical ABA S.O.L.D. Surveys*, AM. BAR ASS'N, https://www.americanbar.org/groups/professional_responsibility/resources/historicalabasoldsurveys/ [<https://perma.cc/3EZ6-HX84>] (providing links to previous surveys from 1998 to 2016). Although survey data from 2003 to 2016 are available, estimates for 2017 and 2018 have been created by using a combination of the five year average and annual trend. For example, if the five year average was 100 but there had been a 20 point decrease during each year, the following year would be estimated at 80.

²⁹³ See discussion *supra* Part II.A.

²⁹⁴ The number of active patent practitioners was available for five of the sixteen years. These numbers were used as a starting point for constructing the estimate of active practitioners, with adjustments for the changes in the number of known patent application filings.

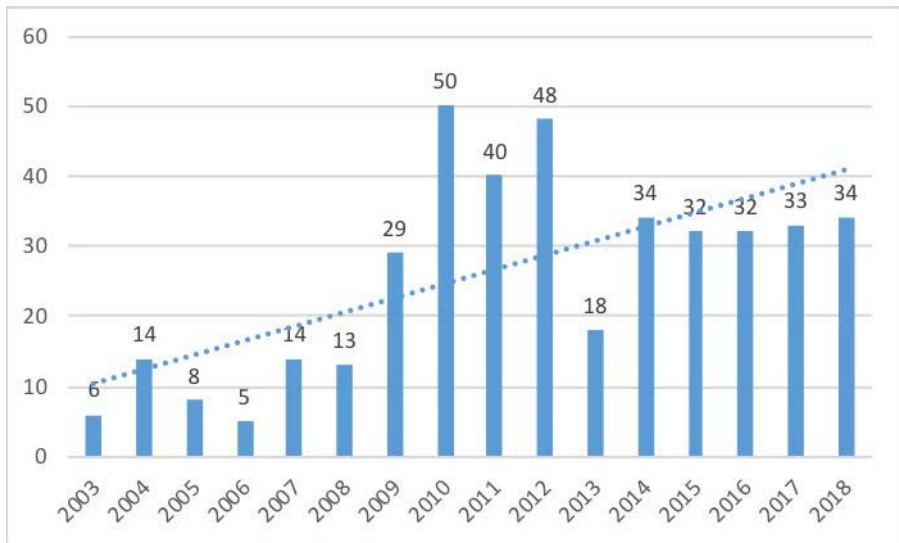
²⁹⁵ See *Trademark Case Files Dataset*, U.S. PATENT & TRADEMARK OFFICE, <https://www.uspto.gov/learning-and-resources/electronic-data-products/trademark-case-files-dataset-0> [<https://perma.cc/ND8D-K9K3>] (containing the research datasets along with documents describing the data). See generally Graham et al., *supra* note 93 (providing trademark application data).

²⁹⁶ Many of the entries in this field were not names, but rather numbers or parts of addresses (e.g., WI 53202-4910). These were removed from the analysis, as it was unclear whether the application had been filed by an attorney and, in these cases, the identity of the attorney was also unclear.

B. Overall Results

As an initial matter, the frequency of practitioner discipline was calculated over time. Although the OED publicly disciplined twenty-six practitioners on average each year between 2003 and 2018, there was an upward trend over that timeframe. But, as Figure I illustrates, that trend was irregular and inconsistent, particularly with the large spike in disciplinary actions (fifty) in 2010.

Figure I: OED-Imposed Public Discipline by Year



Additional analysis sheds some insight on one reason for the disparity: reciprocal discipline. As Part II.C explained, the OED is vigilant in its imposition of reciprocal discipline for attorneys disciplined by another state bar authority. Figures II and III below demonstrate how reciprocal discipline shapes and impacts the OED's work. It comprises nearly half of all public discipline imposed, and over two-thirds (23/34) of the discipline in 2018. Likewise, although there were fifty practitioners who received public discipline in 2010, only twenty of those were actually the result of an OED investigation and the rest were reciprocal discipline cases.

Figure II. Composition of OED Public Discipline

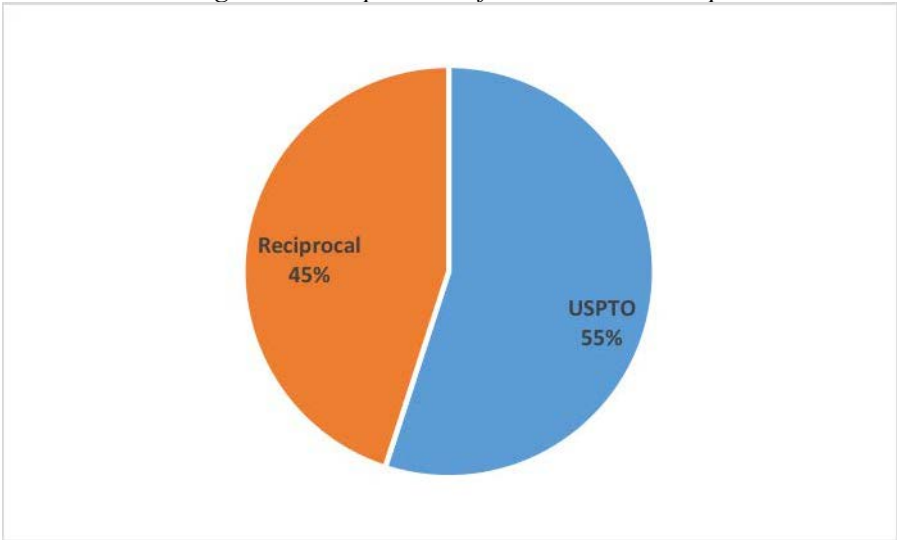
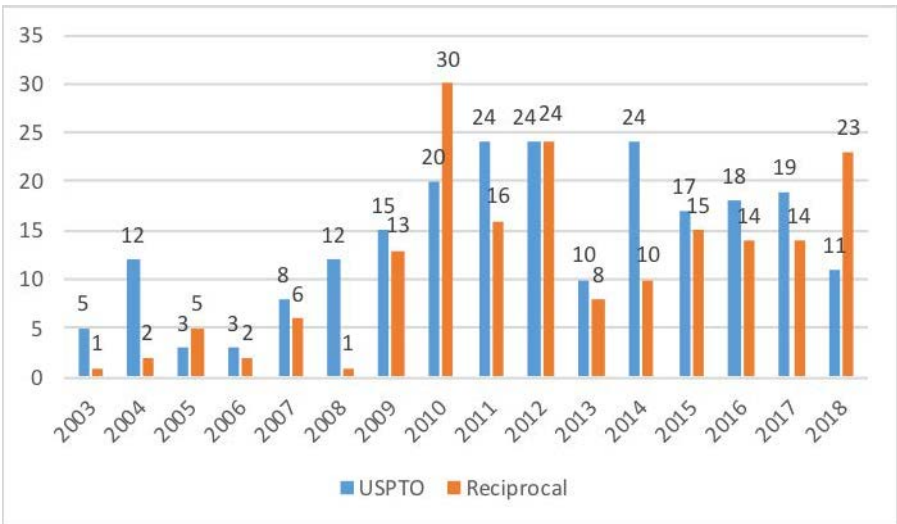
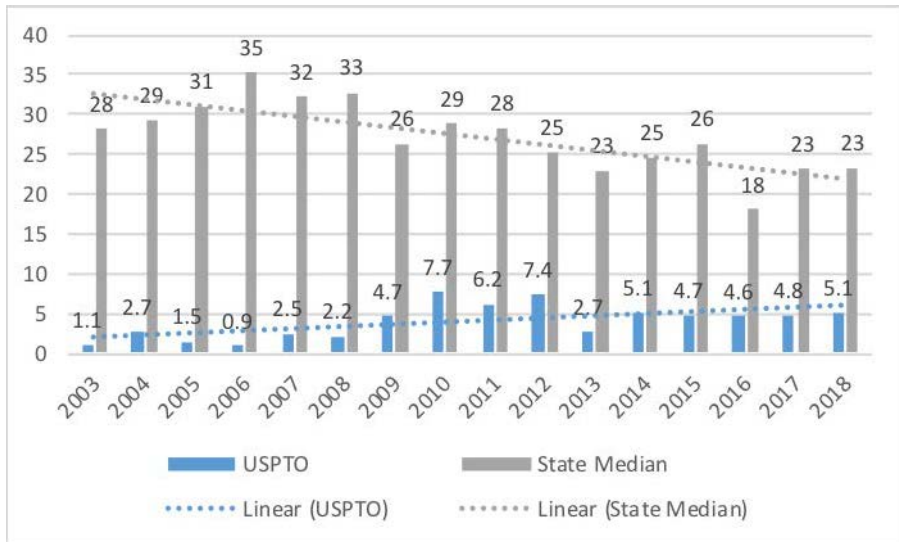


Figure III. USPTO and Reciprocal Discipline by Year



Although the small numbers of disciplinary actions suggest that the OED does not seem to frequently impose discipline, the question arises of how these numbers might compare to other disciplinary authorities—is the OED disciplining fewer practitioners than its state counterparts? Figure IV below demonstrates that it is indeed imposing less discipline, even though there has been a significant increase in practitioner discipline over the sixteen-year time period coupled with an overall decline in state attorney discipline during that same time frame.

Figure IV. Imposition of Public Discipline (per 10,000 Active Practitioners)



On average over the sixteen years studied, just 4.0 out of every 10,000 practitioners were subject to public discipline by the OED, in comparison to 26.9 attorneys from their respective state authorities. Even this statistic overinflates OED discipline, because 45% of those were in fact reciprocal discipline already included among the state disciplinary statistics. Although there has been a general upward trend in OED discipline relative to state discipline, it has remained between 4.6 and 5.1 practitioners per 10,000 since 2015—a rate that is less than one-fourth of the rate of state discipline during that time.

Figures V and VI provide further insight into the relative distribution of public sanctions imposed, as well as the frequency of alternative dispositions. At first glance, these two figures may seem somewhat contradictory. On the one hand, the OED imposes relatively more punitive sanctions than its state counterparts. On the other hand, the OED imposes considerably more private discipline and terms of probation.

Figure V: Type of Public Sanction Imposed

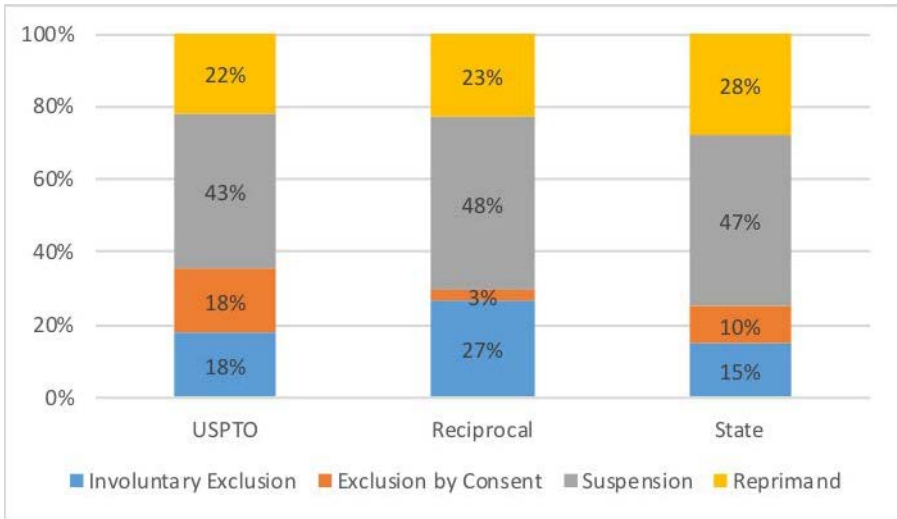
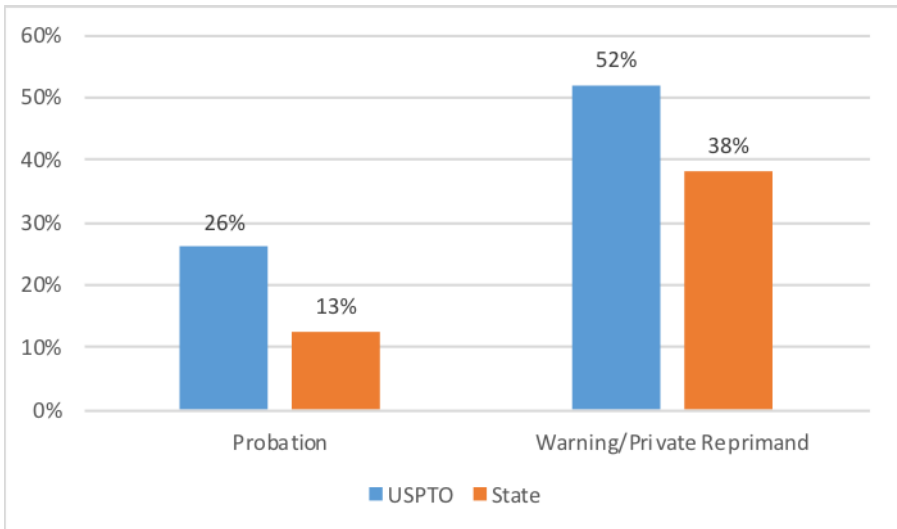


Figure VI: Other Sanctions



But taken together, a theme begins to emerge in terms of the purposes these sanctions serve. Each of the heavily imposed USPTO sanctions furthers the goal of specific deterrence, in that they are limited to the knowledge of the practitioner (private warnings), they ensure that the practitioner conforms his or her future conduct to the USPTO Rules (probation), or they incapacitate a

practitioner who cannot conform his or her conduct to the USPTO Rules (exclusion, and to a lesser extent, suspension).²⁹⁷

At the same time, USPTO sanctioning practice does not appear to prioritize the goals of general deterrence or expressiveness to the same extent.²⁹⁸ As a general matter, the practitioner population will not know of the prevalence of private sanctions—indeed, it is not even published on the USPTO website—and it certainly will not learn of the specific conduct which led to it. Likewise, the existence of relatively few public reprimands means that the practitioner population will not learn of many examples in the mid-level category of misconduct falling below that which would operate as a suspension. This circumstance, coupled with the low number of disciplinary actions overall, means that practitioners have little available guidance on the boundaries of permissible conduct in their USPTO practice.

C. Comparing the Discipline of Patent and Trademark Practitioners

Although the preceding Section sheds some light on the degree to which the OED is using its disciplinary function to regulate practitioner conduct, it is only the beginning of the story. As was described in Parts II and III, patent and trademark practitioners are not situated similarly in relation to the USPTO. Whereas patent practitioners must satisfy several requirements to become registered, attorneys who wish to practice before the USPTO need only find willing clientele and they can begin a trademark prosecution practice. Moreover, there is a marked difference between the two in the way that the USPTO communicates practitioners' obligations. The patent practitioners' duty of candor and possible sanctions upon violation are well-known, but the same is not true for the obligations imposed on trademark attorneys.²⁹⁹ This Section explores whether that distinction carries through to the OED's work, despite the fact that ostensibly it regulates both sets of practitioners in the same manner.

Figures VII and VIII below reveal the staggering differences in patent and trademark discipline, showing that 77% of all public disciplinary actions involve those who prosecute patents. Though there has been a slight increase in the discipline of trademark attorneys since 2014, that trend is nearly comparable for patent practitioners as well. In 2018, for instance, only 32% (11/34) of all disciplinary actions involved trademark practice alone.

²⁹⁷ See discussion *supra* Part IV.B.

²⁹⁸ See discussion *supra* Part IV.B.

²⁹⁹ See discussion *supra* Parts II.B and II.D.

Figure VII: OED Discipline Frequency by Practice Area

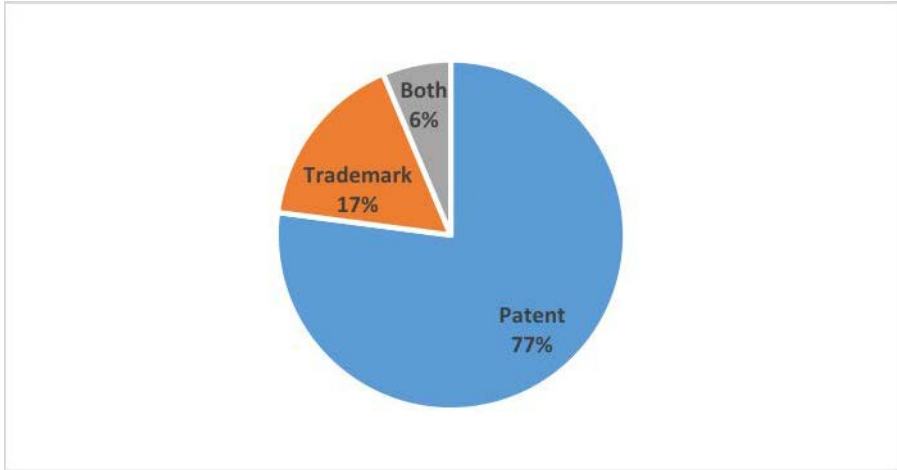
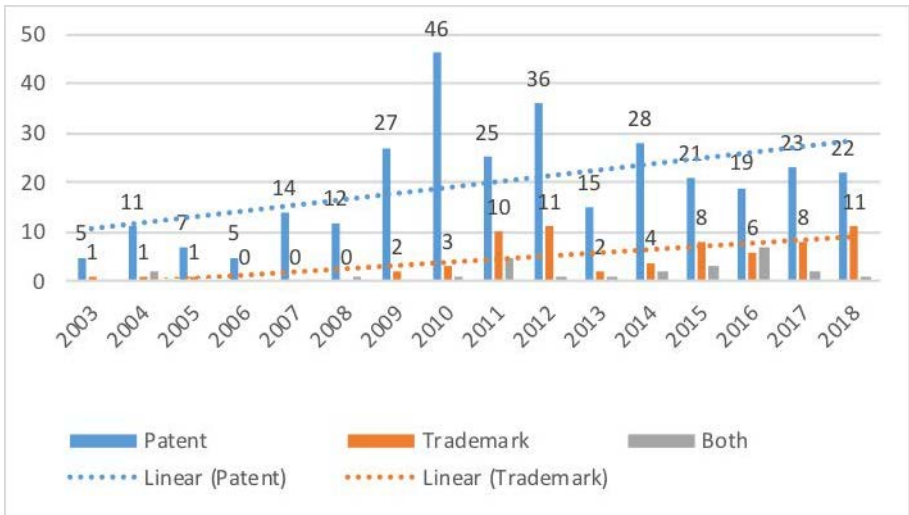


Figure VIII: OED Discipline by Practice Area Over Time



Figures IX and X below demonstrate that these differences cannot be fully explained by the disparities in the sizes of the practitioner populations or in the number of USPTO applications filed.

Figure IX: Imposition of Public Discipline (per 10,000 Active Practitioners)

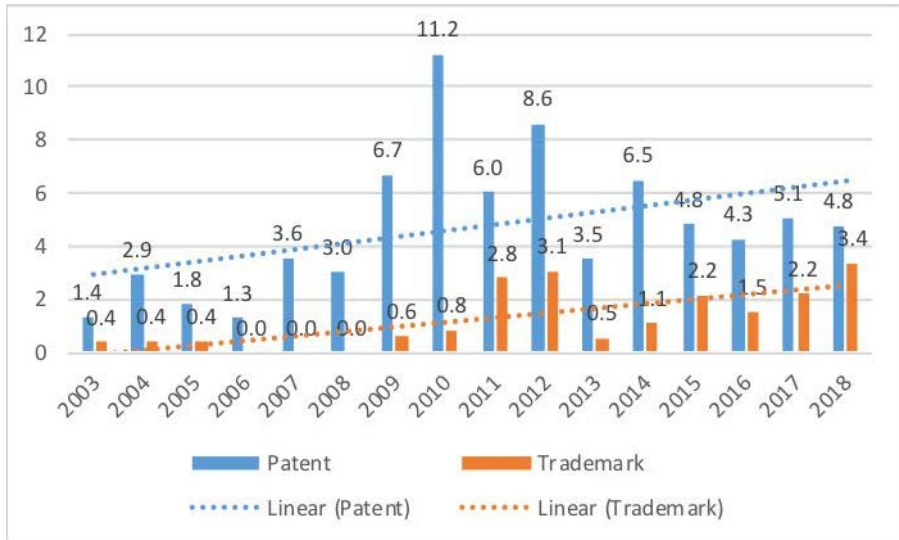
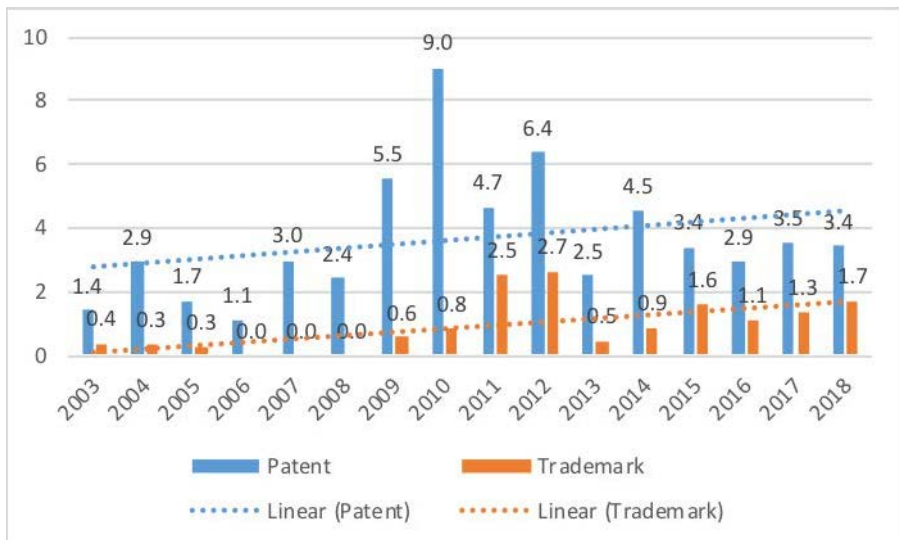


Figure X: Imposition of Public Discipline (per 100,000 Application Filings)



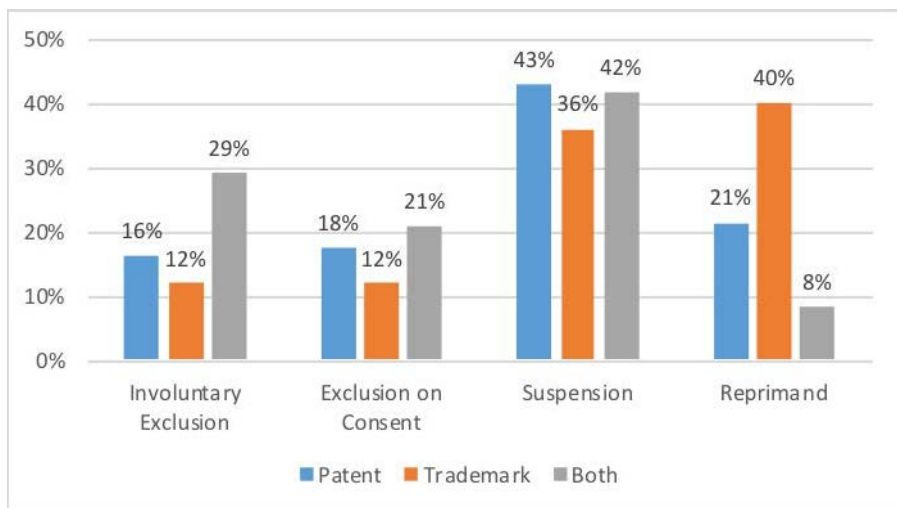
Even when accounting for the larger pool of patent practitioners or the larger number of patent applications filed, there is still a significant difference between trademark and patent practices in regard to discipline.³⁰⁰ In fact, dur-

³⁰⁰ During the relevant time period, there were averages of 497,004 patent filings and 407,152 trademark filings each year. That gap has been narrowing, however, with 643,349 patent filings and

ing the three-year period between 2006 and 2008, there were *no* disciplinary actions based on trademark practice alone—an astonishing statistic. These figures should not necessarily suggest that patent practitioners are unduly targeted or over-represented; a quick comparison between Figure VIII and Figure IV indicates that they are subject to less discipline by the OED than are attorneys by their respective state authorities. Rather, these figures seem to indicate that trademark attorneys are significantly under-represented among those receiving discipline. Although discipline for both types of practices is trending upward, the increase is neither steep nor consistent across the time period.

Figure XI presents the frequency with which different types of sanctions are imposed on practitioners in the two practice areas.³⁰¹ It demonstrates that trademark practitioners receive less punitive sanctions than their patent counterparts. Figure XII provides additional detail on the length of suspensions for each group.

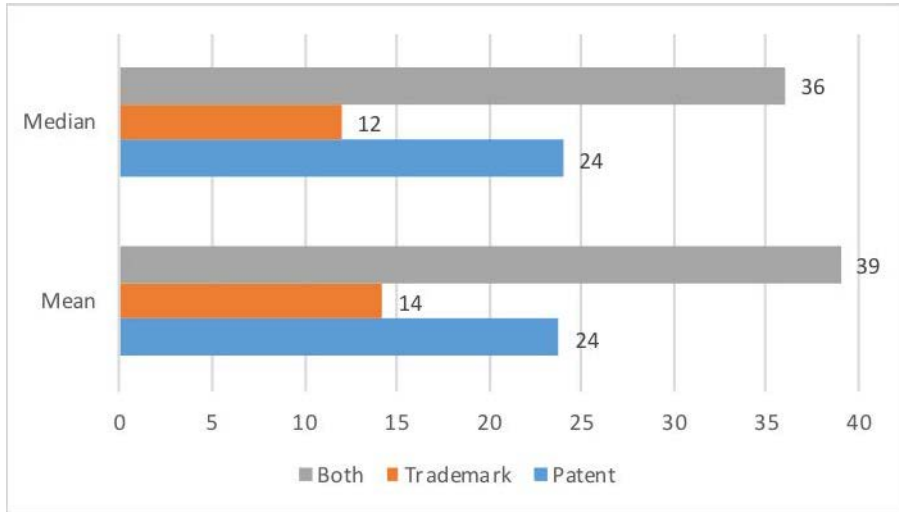
Figure XI: Type of Sanction by Practice Area



638,847 trademark filings in 2018. With regards to practitioners, there was an estimated average of 41,213 patent practitioners, as compared to 32,198 trademark practitioners. The gap between the two widened to 13,590 in 2018.

³⁰¹ Figure XI and the figures that follow exclude reciprocal discipline cases because the OED does not play a role in determining the type of sanction imposed by the initiating state.

Figure XII: Average Length of Suspension (in Months) by Practice Area



Several trends emerge. First, it is clear that the most severe sanctions are imposed among those practitioners in the “both” category. That result is not surprising, however, once one considers how that category is constructed; by definition, the proscribed misconduct included both patent and trademark prosecution. Given the inherently larger scope of misconduct, it would be expected that the corresponding sanctions would be more punitive on average. Comparing patent- and trademark-only practitioners, patent practitioners have a higher representation among each of the more severe incapacitating sanctions (involuntary exclusion, exclusion on consent, suspension), whereas trademark practitioners are much more likely to receive a reprimand.

Patent practitioners also serve longer suspensions on average than their trademark counterparts. Though there is not comprehensive statewide data available on this subject,³⁰² available evidence suggests that patent practitioners are likely serving even longer suspensions than they would have, had the sanction been imposed by a state authority.³⁰³ Once again, those practitioners

³⁰² Notably, the ABA Survey on Lawyer Discipline does not require states to provide information on the average length of suspensions; such data could be beneficial to an understanding of this issue. See, e.g., STANDING COMM. ON PROF'L DISCIPLINE, *supra* note 292, at 1.

³⁰³ See Patricia W. Hatamyar & Kevin M. Simmons, *Are Women More Ethical Lawyers? An Empirical Study*, 31 FLA. ST. U. L. REV. 785, 820 (2004) (finding an 11.26-month mean term of suspension and six month median term of suspension for attorneys, with statistically significant differences by gender).

committing misconduct across both practice areas are receiving the longest suspensions on average.

D. Ethics Rules Violated by USPTO Practitioners

Given the differences between patent and trademark practice, along with the disparity between the two in terms of the types of discipline imposed, one would expect there to be corresponding differences between the two in regard to the number and types of ethics rules that are cited as providing the basis for discipline. Figure XIII provides the number of ethics rules cited in all public disciplinary orders, and Figure XIV further calculates the average number of rules cited for each practice area.

Figure XIII: Number of Ethics Rules Cited in Disciplinary Orders

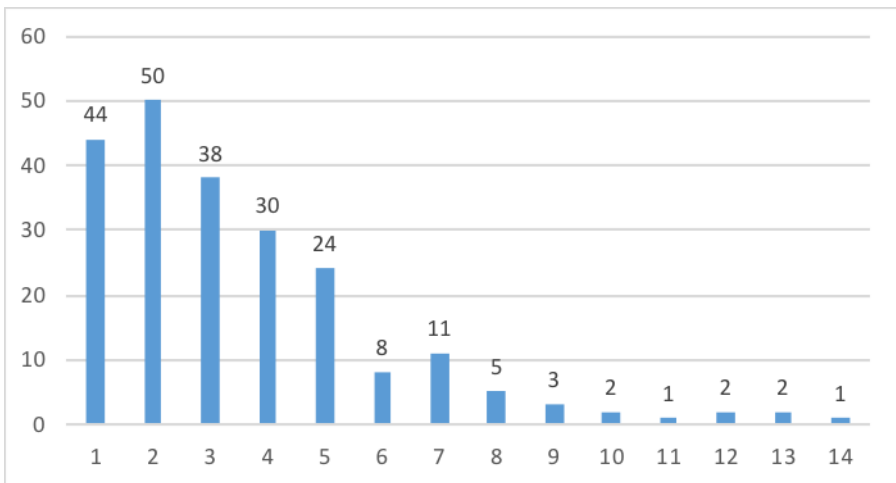


Figure XIV: Number of Ethics Rules Cited by Practice Area

	Mean Rules Cited	Median Rules Cited
Overall	3.5	3
Patent	3.2	3
Trademark	3.6	4
Both	5.6	5

As Figure XIII indicates, more than eighty percent of USPTO disciplinary actions cited two or more ethics rules that provided the basis for discipline. Unexpectedly, trademark disciplinary cases cite more ethics rules on average

than do patent cases (3.6 vs. 3.2), even though the former lead to less severe sanctions on average.³⁰⁴

This mismatch between the number of rule violations and severity of sanctions may contribute to the perception among patent practitioners that they must be wary of the threat of OED investigation. Even a cursory Internet search reveals a number of articles and blog posts about patent practitioner discipline and best practices to avoid getting in trouble.³⁰⁵ The same is not true for trademark discipline, about which there is little discussion.

Armed with the knowledge that most OED disciplinary actions implicate more than one ethics rule, this Section now turns to the more nuanced question of what types of misconduct give rise to disciplinary actions. Figure XV presents an initial picture using the categories identified in Part III.C, both for the overall practitioner population and by practice area. The number under the label in parentheses corresponds to the number of disciplinary actions in that category.

Figure XV: Ethics Rules Cited as Source of OED Discipline

Misconduct Category	Overall (221)	Patent (174)	Trademark (23)	Both (24)
Diligence	45.7%	44.3%	34.8%	66.7%
General Misrepresentation	44.3%	40.8%	43.5%	70.8%
Administration of Justice	40.3%	35.6%	47.8%	66.7%
General Unfitness to Practice	35.3%	36.2%	26.1%	37.5%
Communication	29.4%	26.4%	21.7%	58.3%
Client Property and Accounting	21.3%	21.3%	8.7%	33.3%
Competence	14.9%	11.5%	17.4%	37.5%
Criminal Acts	12.7%	14.9%	4.3%	4.2%
Cooperation with OED	12.2%	10.9%	8.7%	25.0%
Assisting Unauthorized Practice	11.8%	5.7%	26.1%	41.7%
Termination Issues	10.9%	9.2%	8.7%	25.0%
Truthfulness	10.0%	8.0%	13.0%	20.8%

³⁰⁴ See discussion *supra* Part V.C.

³⁰⁵ See, e.g., Michael E. McCabe, Jr., *This Post Could Save Your Patent Law License*, MCCABE LAW (June 1, 2017), <https://www.ipethicslaw.com/this-post-could-save-your-patent-law-license/> [<https://perma.cc/5X48-7ME8>] (discussing administrative suspensions of patent practitioners at the USPTO).

Misconduct Category	Overall (221)	Patent (174)	Trademark (23)	Both (24)
to USPTO				
Conflict of Interest	9.5%	8.6%	17.4%	8.3%
Improper Influence by Third Party	9.0%	9.2%	13.0%	4.2%
Relationship with Non-Practitioner	8.1%	7.5%	17.4%	4.2%
Fairness to Opposing Parties	6.3%	5.7%	4.3%	12.5%
Fees	5.4%	6.3%	0.0%	4.2%
Scope of Representation	4.5%	4.6%	4.3%	4.2%
False Advertising	4.5%	2.3%	13.0%	12.5%
Violation of Rules Through Others	3.2%	2.9%	4.3%	4.2%
Confidentiality	2.3%	2.9%	0.0%	0.0%
Reporting Misconduct	1.8%	1.1%	4.3%	4.2%
Improper Oversight of Non-Practitioner	1.8%	0.6%	4.3%	8.3%
Improper Business Transactions with Client	1.4%	1.1%	4.3%	0.0%
Limitation of Liability	0.9%	0.6%	0.0%	4.2%
Gov't Employee Conflict	0.9%	0.6%	4.3%	0.0%
Candid Advice	0.9%	1.1%	0.0%	0.0%
Truthfulness to Others	0.5%	0.6%	0.0%	0.0%
Ex Parte Communications	0.5%	0.0%	4.3%	0.0%
Improper Advertising	0.5%	0.6%	0.0%	0.0%
Improper Solicitation	0.5%	0.0%	4.3%	0.0%

After diligence, which is the most prevalent ethics rule that forms the basis of discipline (45.7%), the next three most frequently cited provisions are all part of the general misconduct rule—misrepresentation (44.3%), actions that are prejudicial to the administration of justice (40.3%), and actions that reflect adversely on one's fitness to practice before the USPTO (35.3%). This is notable, in part because there is criticism among some ethics scholars about the

over-reliance on these provisions by state disciplinary authorities together with the difficulty for practitioners to understand what types of misconduct are subject to these rules.³⁰⁶ Indeed, as mentioned in Part III.B, the ABA Rules eliminated the “fitness to practice” provision on account of these concerns.³⁰⁷

These concerns are especially salient when it comes to USPTO practice. The USPTO purports to give heightened attention to misconduct related to the duties of candor and good faith and yet there are relatively few disciplinary actions related to that type of misconduct. As Figure XV demonstrates, the ethics provisions that are most clearly linked to these duties—truthfulness toward the USPTO (the twelfth most frequently cited), fairness to opposing parties (the sixteenth most frequently cited), and confidentiality (the twenty-first most frequently cited)—all rank outside of the top ten most frequently cited rules.

Although there is some variation between trademark and patent practices, these statistics must be interpreted with caution given the small number of trademark cases in the dataset (twenty-three). So, despite the fact that there are relatively more trademark cases which cite truthfulness in actions toward the USPTO as the source of misconduct (13% versus 10% overall), that rule only appears in a total of three trademark cases over the entire sixteen-year time period.

Figure XVI provides further insight into the interrelationship between the top ten ethics rules cited, in order to begin to identify typical patterns of misconduct that give rise to disciplinary actions. Each cell contains the Pearson correlation coefficient between the two ethics rules, with statistically significant correlations denoted by one (significant at .05 level) or two (significant at .01 level) stars. All correlations above .200 have been highlighted as well. The strongest correlation is between diligence and communication, which is very high at .504.

³⁰⁶ See discussion *supra* Part III.B and note 227.

³⁰⁷ See discussion *supra* Part III.B.

Figure XVI: Correlations Between Top 10 Cited Ethics Rules

	Competence	Diligence	Communication	Client Property & Accounting	Assisting Unauth. Practice	Cooperation with OED	Criminal Acts	Misrepresentation	Admin. of Justice	General Unfitness
Competence		.15*	.09	.22**	.28**	.08	-.12	.16*	.12	.04
Diligence	.15*		.50**	.26**	.09	.16*	-.24**	.19**	-.03	-.09
Communication	.09	.50**		.25**	.13*	.21**	-.22**	.00	-.06	-.21**
Client Property & Accounting	.22**	.26**	.25**		.09	.25**	-.13	.18**	-.04	.15*
Assisting Unauth. Practice	.28**	.09	.13*	.09		.16*	-.14*	.16*	.22**	-.06
Cooperation with OED	.08	.16*	.21**	.25**	.16*		-.02	.25**	.34**	-.07
Criminal Acts	-.12	-.24**	-.22**	-.13	-.14*	-.02		.10	-.06	.20**
Misrepresentation	.16*	.19**	.00	.18**	.16*	.25**	.10		.25**	.31**
Admin. of Justice	.12	-.03	-.06	-.04	.22**	.34**	-.06	.25**		.13
General Unfitness	.04	-.09	-.21**	.15*	-.06	-.07	.20**	.31**	.13	

Using these correlations as a starting point, this Article identifies and describes four commonly observed patterns of misconduct that simultaneously implicate strongly correlated rules. This is the first such categorization in the scholarly literature, which could be replicated for other disciplinary authorities in the future. Each category is described in further detail below.

1. The Financial Fool

One of the most frequent patterns of misconduct leading to OED discipline involves practitioners who submit fee payments to the USPTO that are dishonored for insufficient funds, often triggering violations of the diligence and client property/accounting provisions. These disciplinary actions are nearly exclusively limited to patent practitioners due to various filing fees that must be submitted over the course of the life of a patent; the most common sanctions for violations include public reprimands and term suspensions.³⁰⁸

In re Guth in 2011 is paradigmatic of these disciplinary actions.³⁰⁹ The OED received information from the USPTO Office of Finance that Guth had issued ten checks that were dishonored due to insufficient funds. This infor-

³⁰⁸ See, e.g., *In re King*, No. D2015-29, at 6–11 (U.S. Patent and Trademark Office May 26, 2015) (final order) (ordering a public reprimand for eleven dishonored electronic and check payments to USPTO); *In re Perkowski*, No. D2011-11, at 3–4 (U.S. Patent and Trademark Office June 17, 2011) (final order) (ordering a two-year suspension, stayed pursuant to settlement agreement, for eighteen dishonored checks).

³⁰⁹ See No. D2010-37 (U.S. Patent and Trademark Office Feb. 11, 2011) (final order).

mation triggered an OED investigation that revealed a number of mishandled transactions and patent applications that were under threat of abandonment due to Guth's financial neglect. Guth's actions were the result of poor accounting practices, and he undertook remedial action and cooperated with the OED investigation to mitigate his misconduct. Pursuant to a settlement agreement, Guth received a two-year suspension that was stayed and replaced by a two-year probation.³¹⁰

2. The Overcommitted Practitioner

Another common scenario giving rise to discipline is where an experienced practitioner begins neglecting a series of applications, apparently because the practitioner is overcommitted. They start missing deadlines,³¹¹ cutting corners,³¹² and leaving the client out of the communications loop.³¹³ Eventually these actions come to light, often by a client who asks about the status of an abandoned application.³¹⁴ At this point, the more ethical practitioners will reveal the misconduct and attempt to ameliorate it.³¹⁵ But the less scrupulous will attempt to cover up their mistakes with lies—first to their client and sometimes even to the OED.³¹⁶ These cases regularly involve violations of the diligence and communication provisions and sometimes will include misrepresentations to their clients and the OED.

In re Fuess in 2017 exemplifies one of the more extreme scenarios.³¹⁷ Over thirty-six years of active patent practice, Fuess had prosecuted more than three hundred applications and had no disciplinary history prior to 2008. At that time, he neglected ten separate patent applications for four clients, which ultimately led to abandonment. Several of these applications were for one of his longstanding clients, who eventually confronted him about them and even-

³¹⁰ *See id.*

³¹¹ *See, e.g., In re Matlock*, No. D2011-52, at 2 (U.S. Patent and Trademark Office Feb. 7, 2012) (final order) (noting that the respondent missed several deadlines and claimed that "his firm had staffing problems" at the time of the neglect).

³¹² *See id.* (rejecting respondent's claim that he made a timely response and noting that the USPTO did not receive any such response).

³¹³ *See, e.g., In re Shaffer*, No. D2014-18, at 2 (U.S. Patent and Trademark Office July 31, 2014) (final order) (finding that respondent abandoned several trademark applications and failed to inform clients of the status of their applications).

³¹⁴ *See, e.g., In re Fuess*, No. D2015-08, at 7 (U.S. Patent and Trademark Office July 21, 2017) (initial decision and order) (describing how respondent faced discipline after a client inquired about the status of their abandoned application).

³¹⁵ *See, e.g., In re Lahser*, No. D2016-27, at 4, 6 (U.S. Patent and Trademark Office June 3, 2016) (final order) (suspending practitioner for twelve months, mitigated by the fact that the practitioner voluntarily made restitution to the client and cooperated with OED).

³¹⁶ *In re Fuess*, No. D2015-08, at 7.

³¹⁷ *Id.*

tually replaced him with another practitioner. Fuess repeatedly shaded the truth, first blaming it on the USPTO and eventually providing responses to the OED in which he misrepresented the nature of his relationships with clients and their wishes. Fuess received a three-year suspension from patent practice, justified in part by the breadth of his neglect and misrepresentations.³¹⁸ The initial hearing decision specifically noted that this misconduct was likely the result of Fuess's burgeoning patent docket.³¹⁹

Unlike the financial fool, the overwhelmed practitioner may be a patent or trademark practitioner—though the vast majority of disciplinary actions in this category involve patent practice.³²⁰ The sanctions also vary widely, with a larger percentage of public reprimands and shorter suspensions among those practitioners who neglect fewer applications and/or are fully responsive to the client and OED inquiries.³²¹

3. The Absent Advocate

Similar to the overwhelmed practitioner, the absent advocate neglects one or more client matters—but they do so by wholly failing to communicate, either with or on behalf of clients.³²² Invariably their non-responsiveness continues even after they become subject to an OED inquiry, which exacerbates their misconduct and leads to more punitive sanctions.³²³ This category includes those who practice patent or trademark law and they often receive sanctions in the form of suspensions and occasionally exclusions.³²⁴ Among the cited rule violations are failure to cooperate with the OED, failure to communicate, and failure to return unearned client funds.

³¹⁸ *Id.*

³¹⁹ *See id.* at 68 (“As the reasons Respondent offered for the neglect were not credible, the Director suggests that the reasons Respondent neglected the applications might be that he was overwhelmed with work . . .”).

³²⁰ *See, e.g., In re Shaffer*, No. 2014-18, at 2–6 (disciplining a trademark practitioner).

³²¹ *See, e.g., In re Hill*, No. D2001-06, at 11 (U.S. Patent and Trademark Office July 26, 2004) (final decision) (reprimanding an attorney who neglected patent applications due to a firm docketing system, in part because “Respondent owned up to the errors of his own volition, filed petitions to revive in time to prevent any appreciable harm to his client, and paid the full costs associated with these petitions, approximately \$20,000, out of his own pocket without prodding or debate”).

³²² *See, e.g., In re Schaefer*, No. D2007-01, at 1–2 (U.S. Patent and Trademark Office Apr. 30, 2007) (final order) (failing to prosecute a number of applications and communicate with clients or the USPTO).

³²³ *See, e.g., In re Hill*, No. D2014-41, at 11–16 (U.S. Patent and Trademark Office Feb. 19, 2015) (initial decision on default) (failing to respond, in part or in whole, to multiple RFIs from the OED).

³²⁴ *See id.*

In re Dao in 2015 illustrates this category of misconduct for a practitioner who prosecutes both patent and trademark applications.³²⁵ After filing three patent applications for three clients and two trademark applications for another client, Dao became completely unresponsive to office actions and failed to maintain client communications. He also continued to prosecute trademark applications—and failed to inform the USPTO—when he was administratively suspended from the practice of law by a state disciplinary authority.³²⁶ When the OED sent an RFI and multiple follow up notices, Dao did not respond for six months. Though he eventually provided a response, he did not provide a reason for his prolonged unresponsiveness. Eventually, Dao entered into a settlement agreement with the OED under which he would serve a six-month suspension from USPTO practice.³²⁷

4. Patent Mill Participants

Whereas the preceding categories are not unique to USPTO practice, the patent mill is necessarily limited to patent practice. Although there are some variations in their structure, most patent mills employ very few patent practitioners and have a larger number of non-practitioners who conduct nearly all work for the organization.³²⁸ The practitioners have little to no contact with the inventor clients, relying on the non-practitioners to assist clients in navigating the patent application process.³²⁹ The patent mills' services are widely advertised to prospective clients who are relatively unfamiliar with patent prosecution, and they leverage this fact—often along with unfounded claims of success—to acquire a large client base.³³⁰ These cases involve violations of competence, the relationship with non-practitioners, and the general misconduct provisions.

World Patent Marketing (WPM) was one of the more notorious patent mills.³³¹ Its fraudulent practices were uncovered by a disgruntled customer in

³²⁵ No. D2015-23, at 4 (U.S. Patent and Trademark Office May 15, 2015) (final order).

³²⁶ *Id.* at 3.

³²⁷ *Id.* at 5.

³²⁸ *See, e.g., In re Colitz, Jr.*, No. D1999-04, at 1–2 (U.S. Patent and Trademark Office Jan. 2, 2003) (final decision) (committing misconduct through the Invention Submission Corporation, National Idea Network, and American Inventors Corporation, three invention development companies).

³²⁹ *See id.* at 32.

³³⁰ *See, e.g., In re Montgomery*, No. D2018-02, at 13 (U.S. Patent and Trademark Office Jan. 10, 2018) (final order) (“Respondent understood the general lack of sophistication of his clients, but neither Respondent nor [Montgomery Patent & Design, L.P.] ever explained to inventors the likelihood that the inventor would receive a patent of ‘useful scope,’ as described on [the Montgomery family businesses’] websites, if they pursued provisional, design, or utility patent protection.”).

³³¹ *See Carol D. Leonnig et al., Whitaker Fielded Early Fraud Complaints from Customers at Patent Company Even as He Championed It, Records Show*, WASH. POST (Nov. 30, 2018), <https://>

conjunction with an undercover Federal Trade Commission investigation. The company's sole registered patent practitioner, Marina Mikhailova, filed more than 400 patent applications under her registration number.³³² Not surprisingly, Mikhailova did little work on the applications, relying without question on the assertions of non-practitioner employees without verifying the details of the filings or directly communicating with clients. As a WPM employee, she received all her compensation from the company and did not address the conflicts issues that inherently arose.³³³ Once the OED investigation began, however, she was extremely cooperative, acknowledging her misconduct and agreeing to serve a twenty-month suspension.³³⁴ Scott Cooper, the CEO of WPM, has been banned by the FTC from running an invention promotion business and forced to pay \$1 million.³³⁵ A criminal investigation is also underway.³³⁶

Taken together, these four categories of misconduct illustrate some of the most common types of misconduct that lead to OED investigations and public discipline. But it must be remembered that almost half of all disciplinary actions do not originate with the USPTO; rather, they are the result of the imposition of reciprocal discipline.³³⁷ Three of these categories—the financial fool, overwhelmed practitioner, and absent advocate—are not unique to USPTO practice and are easily detectable in that they leave a trail of dishonored checks, abandoned applications, and irate clients in their wake. Although patent mills do not inherently lead to substandard results, they are structured in such a way that some percentage of their clients will be dissatisfied with their work.³³⁸ Eventually, one or more of these clients may contact the USPTO and trigger an OED investigation.

Although it is important for the OED to continue to investigate and discipline practitioners who fall into one of the preceding categories, they only repre-

wapo.st/3chIZLl [<https://perma.cc/39QL-3TJ7>] (reporting on the WPM scam that was made even more famous by the implication that the acting U.S. Attorney General was involved).

³³² *In re Mikhailova*, No. D2017-18, at 2 (U.S. Patent and Trademark Office June 16, 2017) (final order).

³³³ *Id.* at 3.

³³⁴ *Id.* at 5.

³³⁵ Press Release, Fed. Trade Comm'n, FTC Settlement Will Ban Fraudulent Marketers from Invention Promotion Bus. (May 10, 2018), <https://www.ftc.gov/news-events/press-releases/2018/05/ftc-settlement-will-ban-fraudulent-marketers-invention-promotion> [<https://perma.cc/HXT2-VZ7K>].

³³⁶ Christine Wang, *FBI Reportedly Investigating Company Where Trump's Acting Attorney General Was an Advisory Board Member*, CNBC (Nov. 9, 2018), <https://www.cnbc.com/2018/11/09/fbi-reportedly-probing-company-where-matthew-whitaker-was-board-member.html> [<https://perma.cc/39CN-RJNB>].

³³⁷ See discussion *supra* Part V.B.

³³⁸ See, e.g., *In re Montgomery*, No. D2018-02, at 2 (“Approximately, twenty percent (20%) of inventions that were submitted for suitability review were recommended by [the Montgomery family businesses] for a Research Report; the balance of approximately eighty percent (80%) were determined not to be suitable.”).

sent a subset of ways in which practitioners may commit misconduct in connection with their USPTO practice. In particular, there are very few disciplinary orders that involve practitioners who overreach in connection with their work, whether fraudulent (for example, filing a fraudulent specimen or falsely claiming that a trademark is being used in commerce) or misleading (for example, failing to disclose information material to patentability).³³⁹ Although these types of misconduct are somewhat harder to detect, they are arguably even more dangerous given that an incorrectly issued patent or registered trademark can have an impact that extends beyond the practitioner-client relationship to investors, competitors, and the public at large.³⁴⁰ Moreover, the USPTO has recognized the importance of regulating such misconduct by adopting regulations that require a stricter level of practitioner candor than the ABA Rules.³⁴¹

VI. THE PATH TOWARD USPTO DISCIPLINARY REFORM

As Part V illustrates, USPTO discipline is underutilized as a tool to regulate practitioner conduct and promote good faith in the prosecution of patent and trademark applications. Practitioner discipline rates are far below those found in state counterparts, particularly when accounting for the high percentage of USPTO reciprocal discipline cases. The OED's sanctioning practice, although in some respects more punitive than its state counterparts, is aimed at promoting specific deterrence rather than general deterrence, thereby limiting its broader impact on the USPTO practitioner population. The actions that become the subject of discipline are largely not unique to the USPTO and are easy to identify. The types of misconduct before the USPTO that are more likely to have an effect on the broader public interest, however, are less likely to be subject to discipline.

Even if the lower disciplinary rates for USPTO practitioners are somewhat related to the nature of their work, the significant disparities between patent and trademark practitioners suggest that even though they are considered equals by the OED in theory, they are in fact receiving disparate focus and treatment. Patent practitioners are more likely to receive public discipline and receive more punitive sanctions, despite the fact that fewer rule violations are being cited in their disciplinary orders.

³³⁹ *But see In re Swyers*, No. D2016-20, at 1 (U.S. Patent and Trademark Office Jan. 26, 2017) (final order) (finding exclusion by consent where trademark lawyer allowed the filing of multiple fraudulent specimens by non-lawyer employees). Swyers is the only trademark attorney who was disciplined on this basis, notable in its own right. *See id.*

³⁴⁰ *See* discussion *supra* Introduction; Iancu, Remarks at International Trademark Association, *supra* note 8.

³⁴¹ *See* discussion *supra* Part III.B.

This Part responds to these weighty empirical findings, providing three recommendations that aim to improve the USPTO disciplinary system. Although these recommendations may be implemented in tandem in a synergistic fashion, each should have a positive effect. In developing these recommendations, special attention has been paid to regulating misconduct that currently slips through the cracks because there is neither a mechanism to detect it nor an entity (such as an adversary) that would naturally report it.

A. Recommendation 1: Trademark Attorney Registration

As discussed in Part II.B, trademark attorneys are not subject to separate substantive admissions requirements to practice before the USPTO; they only need to be an active member in good standing of any state bar. Nor is there an admissions process or registration like that which exists for patent practitioners; the USPTO first learns that an attorney is prosecuting trademarks when she files her first application on behalf of a client and provides her name and contact information.

The lack of a trademark attorney registration system greatly impacts the OED's ability to regulate trademark attorneys. First, it makes it extremely difficult for the USPTO (and thereby the OED) to have an accurate picture of a trademark attorney's prosecution history. Currently the USPTO would have to construct this history using the information provided on trademark application forms.³⁴² But these forms require an attorney to provide little information and have no quality control checks in place. For example, an attorney might include a middle name on one application and not another, accidentally misspell part of their name, or legally change their name between filings. Unless a trademark attorney is extremely vigilant and detail-oriented, it is unlikely that the USPTO has a complete record of that attorney's trademark filings. If each trademark attorney had a uniquely assigned registration number, similar to patent practitioners, the OED could more easily track and monitor their work.

Second, such a registration system would allow the OED to easily identify and track those dual practitioners, i.e. those who are prosecuting both patents and trademarks. This would have at least two benefits. First, the additional detail could aid the OED's searches for practitioners who are neglecting multiple client matters, because those could involve both practice areas. Second, it would lessen the likelihood that a suspended or excluded patent practitioner could continue to prosecute trademark applications. This latter issue is

³⁴² The USPTO compiles this data in its research datasets. See *Trademark Case Files Dataset*, *supra* note 295.

one that seems to occur with some frequency, perhaps because there is less formal oversight of trademark attorneys.³⁴³

Third, trademark attorney registration would provide the USPTO a better understanding of those who are actively engaged in trademark practice. As discussed in Part V.A, currently there is no easy way to ascertain the number of active trademark practitioners because they may choose to begin or end practice at any time without notifying the USPTO (and the data itself has a large percentage of incorrect or suspect attorney names). Were there a trademark attorney register, the OED could send inquiries to registered trademark attorneys about their practice as it currently does for patent practitioners and remove those who no longer intend to practice.³⁴⁴ Having a register would also significantly streamline the imposition of reciprocal discipline that appears to be more regularly imposed for patent practitioners than their trademark counterparts.³⁴⁵

Fourth, maintaining a trademark practitioner registry would provide the USPTO with a way to communicate with those practitioners who are subject to its regulation. This communication channel could be used to provide information of interest about emerging issues that implicate the USPTO Rules.³⁴⁶ Further, it could reinforce the notion that the OED is paying attention to trademark attorneys and that they should conduct themselves accordingly.

Although any registration system is not without cost, a trademark attorney registration need not be as comprehensive or costly as the current patent practitioner registration system that has been maintained—seemingly without debate—for decades. In terms of the substantive admission requirements, the USPTO could continue its practice of permitting any actively licensed attorney to prosecute trademarks. At most, an attorney applicant would have to prove the fact of an active admission in good standing (thereby avoiding unauthorized practice issues from the outset), provide basic contact information, and then be assigned a unique registration number. Trademark attorneys could then

³⁴³ See, e.g., *In re Frayne*, No. D2016-09, at 4–5 (U.S. Patent and Trademark Office June 17, 2016) (initial decision on default) (excluding practitioner who continued to represent trademark applicants and registrants before the USPTO while suspended from practice).

³⁴⁴ See *Patent Practitioner Search*, U.S. PATENT & TRADEMARK OFFICE, <https://oedci.uspto.gov/OEDCI/practitionerSearchEntry> [<https://perma.cc/6WWR-EMTC>].

³⁴⁵ Of the 184 reciprocal discipline cases, 139 (75%) involve patent practitioners, 43 (23%) involve trademark practitioners, and 2 (1%) involve dual practitioners. The dual practitioners statistic is low in part because there is no easy way to determine whether some of the disciplined patent practitioners also prosecute trademarks.

³⁴⁶ Such notices could include the new USPTO Pilot Program for reporting improper trademark specimens. See Press Release, U.S. Patent & Trademark Office, *TM Specimen Protests Email Pilot Program* (Mar. 6, 2018), <https://www.uspto.gov/sites/default/files/documents/Specimen%20Protests%20Email%20Pilot%20Program.pdf> [<https://perma.cc/MER2-22WD>].

incur an ongoing duty to update their information and to notify the OED if there is a change in their state bar status.

*B. Recommendation 2: Strategic USPTO Practitioner
Audits with Examiner Input*

Along with the multitude of benefits that a trademark practitioner registration system could provide, the USPTO could also benefit from instituting a strategic practitioner audit program (PAP). This idea is not entirely novel. In 2017, the USPTO instituted the Post-Registration Proof of Audit Program (Use Audit Program) to tackle the issue of so-called “trademark dead wood,” that is, existing registrations that no longer reflect the classes of goods and services in which the trademark is being used in commerce.³⁴⁷ Its initial pilot program was quite successful, with over half of the randomly audited registrations containing registrations that could not be substantiated.³⁴⁸

The USPTO should experiment with a different type of audit—one that focuses on practitioners rather than their work. Even though both patent and trademark applications receive examiner review, they concentrate on whether the application under consideration meets the relevant formal and substantive requirements.³⁴⁹ By contrast, a practitioner audit would review all of the practitioner’s filings and other interactions with and representations to the USPTO to determine the propriety of their conduct. The validity of the underlying intellectual property would be a secondary factor of this type of PAP and it is quite likely that audits would be triggered by a practitioner’s unsuccessful applications.

Although the PAP could randomly select its targets, experience suggests that such audits would be more effective if they were conducted strategically—similar to a tax audit.³⁵⁰ Among the criteria that could be considered in deter-

³⁴⁷ *Post Registration Proof of Use Audit Program*, U.S. PATENT & TRADEMARK OFFICE, <https://www.uspto.gov/trademarks-maintaining-trademark-registration/post-registration-audit-program> [<https://perma.cc/96Q6-ZCSQ>]; see Emily Kappers & Howard Michael, *Cutting the Dead Wood: The USPTO’s Post-Registration Trademark Use Audit Program*, NAT’L L. REV. (Nov. 16, 2018), <https://www.natlawreview.com/article/cutting-dead-wood-uspto-s-post-registration-trademark-use-audit-program> [<https://perma.cc/6QRZ-X2CZ>] (touting the success of the pilot program and discussing the full rollout).

³⁴⁸ See Kappers & Michael, *supra* note 347.

³⁴⁹ See SUE A. PURVIS, U.S. PATENT & TRADEMARK OFFICE, THE ROLE OF THE PATENT EXAMINER 8–9 (2013), https://www.uspto.gov/sites/default/files/about/offices/ous/04082013_StonyBrookU.pdf [<https://perma.cc/22HV-3MKG>] (describing the role of the patent examiner as requiring the examiner to “[i]ssue [v]alid [p]atents” and to “[a]ct as an advocate for the [p]ublic” in ensuring that patents are only issued in accordance with the law).

³⁵⁰ See *IRS Audits*, INTERNAL REVENUE SERV., <https://www.irs.gov/businesses/small-businesses-self-employed/irs-audits> [<https://perma.cc/LR72-YJ25>] (“[S]ometimes returns are selected based solely on a statistical formula. We compare your tax return against ‘norms’ for similar returns. We develop these ‘norms’ from audits of a statistically valid random sample of returns, as part of the National

mining which practitioners to audit would be those having a relatively high percentage of denied applications. Though this fact is not dispositive of misconduct, this may be an indication that a practitioner is either intentionally or recklessly overreaching in their work. Over time, additional audit criteria could be identified and eventually an algorithm could be developed to pinpoint suspect activities with precision.³⁵¹

But the first line of defense against practitioner misconduct is already in place. In the course of their daily work, patent and trademark examiners are reviewing numerous applications and responses filed by practitioners. Not every examination denial (or even the vast majority) will indicate potential practitioner misconduct, but denials could help examiners identify practitioners who should be subject to the PAP or, in more egregious cases, make a direct referral to the OED. Although the frequency of these direct referrals is not publicly known, the overwhelming majority of disciplinary actions appears to have originated from identifiable financial misconduct or from neglect that later became apparent to a client.³⁵²

Instituting the PAP will come at a cost. An audit process must be identified and executed, requiring auditors to extensively review practitioner conduct and engage with audited practitioners. In addition, it will likely lead to additional OED investigations and formal processes. These expenses, however, are justified if it is assumed that the USPTO should be increasing the frequency of its discipline. Further, the PAP could be streamlined over to defray some of these costs. The USPTO could facilitate greater information sharing between the examiners and auditors, which should theoretically decrease the auditors' work. Audited practitioners would also be required to respond to a series of questions (similar to an RFI), which would then guide the rest of the audit.

As with the first recommendation, the PAP could provide a number of secondary benefits as well. First, the audits could reveal fraudulent or otherwise ineligible patents or trademarks. The revelation of fraud is in and of itself a concern worth addressing, but this could also tackle rising concerns about

Research Program the IRS conducts. The IRS uses this program to update return selection information.”) In spite of decreases in IRS personnel, the threat of a tax audit is heavily discussed and tied to particular categories of reported activities. See Thomas Heath, *Your Chances of an IRS Audit Are Way Down. But Keep It on the Up and Up.*, WASH. POST (Apr. 6, 2018), <https://wapo.st/3bhkkq2> [<https://perma.cc/8S8U-5RRG>].

³⁵¹ Cf. Ting Sun & Miklos A. Vasarhelyi, *Deep Learning and the Future of Auditing*, CPA J. (June 2017), <https://www.cpajournal.com/2017/06/19/deep-learning-future-auditing/> [<https://perma.cc/5VXN-RN3S>] (discussing the use of artificial intelligence to improve the effectiveness of auditing in the accounting context).

³⁵² See discussion *supra* Part V.C (discussing the common patterns of misconduct).

depletion and clutter.³⁵³ Second, the PAP could have a deterrent effect on those practitioners who are subject to an audit. Even if the audit does not reveal misconduct giving rise to formal discipline, the audit findings could dissuade those practitioners from continuing certain practices that could lead to future discipline. Third, and perhaps more importantly, the potential of being subject to an audit could have a general deterrent effect on high volume practitioners who might otherwise be susceptible to committing misconduct in the face of a growing docket and demanding clients.³⁵⁴

C. Recommendation 3: Broader Dissemination of OED Disciplinary Function

There is existing literature on the advantages of ensuring that the work of a state disciplinary authority is adequately publicized to practitioners and members of the general public.³⁵⁵ Information about disciplinary actions can increase practitioners' knowledge about the types of misconduct that they should guard against.³⁵⁶ The public dissemination of practitioner discipline also has an expressive component as well, signaling to practitioners that the

³⁵³ See Barton Beebe & Jeanne C. Fromer, *Are We Running Out of Trademarks? An Empirical Study of Trademark Depletion and Congestion*, 131 HARV. L. REV. 945, 1041 (2018) (concluding that trademark depletion and congestion is a real concern, despite popular belief to the contrary).

³⁵⁴ Cf. Joshua D. Blank & Daniel Z. Levin, *When Is Tax Enforcement Publicized?*, 30 VA. TAX REV. 1, 21–23 (2010) (discussing the deterrent effect of publicizing criminal tax convictions and the threat of tax audit). The deterrent effect of tax audits is discussed in the tax literature. See, e.g., Susan Cleary Morse et al., *Cash Businesses and Tax Evasion*, 20 STAN. L. & POL'Y REV. 37, 64 (2009). One article notes:

Most studies show that the [general deterrence] effect of audits overwhelms the direct revenue effect. One recent study estimates the general deterrence effect is over ten times the direct revenue effect, and that a doubling of audit funding at the federal level would increase taxes by as much as 60 times the cost of the additional audits.

Id.

³⁵⁵ See Levin, *supra* note 239, at 2 (identifying the benefits and drawbacks of greater transparency, and concluding that the benefits outweigh the drawbacks). One author writes:

Making disciplinary proceedings more available to the public, particularly by ensuring access to online records as the digital age requires, advances several goals the ABA has set for attorney discipline, including consistency in punishments, attorney awareness of wrongful conduct, integrity of the legal profession, protecting and educating the public, ensuring effective assistance, and creating competition for clients.

Desch, *supra* note 239, at 923 (citations omitted).

³⁵⁶ See Changes to Representation of Others Before the United States Patent and Trademark Office, 78 Fed. Reg. 20,178, 20,180 (Apr. 3, 2013) (to be codified in scattered parts of 37 C.F.R.) (contemplating that practitioners would use disciplinary actions, both from the USPTO and other jurisdictions, to inform their understanding of ethical conduct).

OED is committed to ensuring that practitioners act in accordance with the USPTO Rules.³⁵⁷

For the general public, broader dissemination of OED discipline can raise awareness about the disciplinary process and increase the likelihood that clients and other affected persons will report complaints to the OED for investigation. Furthermore, it can have a positive impact on the public's belief that the USPTO is operating as an effective gatekeeper for the issuance of patents and trademarks.³⁵⁸

Currently the USPTO does very little to publicize the OED's disciplinary function. The OED section of the website is difficult to navigate and requires users to actively look for information on discipline. There is no public information on the website about the imposition of warning letters (private discipline), including the number of letters issued or the types of misconduct that give rise to such letters.³⁵⁹ Although the OED Reading Room website allows users to search for public discipline, users need to understand how disciplinary actions are organized in order to perform an effective search. Even then, the search returns PDF versions of documents with descriptive labels such as "Final Order," which means that a user has to read the entire document to learn the specifics about the practitioner's misconduct and sanction imposed.³⁶⁰ Again, there is no compiled information on the public website about the frequency of public discipline or the types of misconduct that may lead to public discipline.

This Article suggests a variety of measures that could increase the visibility and understanding of USPTO discipline, which vary in terms of the administrative time required. First, the USPTO website could be redesigned so that discipline would be featured more prominently. A few simple changes to the site architecture and menu would enable website users to quickly find information about the OED's disciplinary function and ways that aggrieved persons can provide relevant material to the OED so that it can begin an investigation.³⁶¹

³⁵⁷ See generally Mark J. Fucile, *Public Discipline Is More "Public" Than Ever: The Impact of Web-Based Lawyer Rating Services on Discipline*, 24 PROF. LAW. 1 (2016) (discussing the impact of publicity of attorney discipline on lawyer conduct).

³⁵⁸ Cf. Carpenter & Cluderay, *supra* note 241, at 739–40 (discussing the public benefit to increased transparency of attorney disciplinary proceedings).

³⁵⁹ The USPTO presents selected statistics at its Patent Law Institute but the files and data are not posted consistently on the USPTO website. See generally USPTO Presentation, *supra* note 146.

³⁶⁰ See *FOIA Documents*, *supra* note 163.

³⁶¹ For an example of a well-designed and comprehensive site, see *Lawyer Discipline*, N.C. ST. BAR, <https://www.nbar.gov/lawyer-discipline/> [<https://perma.cc/4MLC-E3TA>]. From the main page, users can search past disciplinary orders, read a roadmap of the disciplinary process, view annual disciplinary reports, and learn how to file a grievance or engage in alternative dispute resolution. *Id.*

Second, the USPTO website could include pages related to the disciplinary process and data on the imposition of private and public discipline. Even though the specific contents of warning letters should remain private, there is an opportunity to share redacted information on these troubling actions that could, if repeated, lead to the imposition of public discipline.³⁶²

Third, the USPTO website could include clear and easily accessible information about the imposition of public discipline for specific practitioners. Instead of requiring interested persons to read through numerous (and often lengthy) documents to glean an understanding of USPTO public discipline, the USPTO could produce short summaries of these actions and publish them on the website.³⁶³ Although some of the *Official Gazette* notices include such information, they are not written at a consistent level of detail and are not compiled together in one location for reference or review.

Fourth, the USPTO could develop a series of formal ethics opinions. These types of opinions are frequently published by state disciplinary authorities and enable the authority to communicate definitive guidance on frequently encountered or emerging issues.³⁶⁴ At their best, these formal opinions can guide practitioner conduct so that they do not become the subject of an investigation. If not complied with, the formal ethics opinions can aptly demonstrate that a practitioner committed misconduct.³⁶⁵

With regard to the costs associated with the foregoing suggestions, the first three would take little administrative time and expense. The USPTO compiles much of this information for other purposes already, and thus the additional time would be for altering the website architecture, creating a modest amount of web-friendly content, and then making regular updates.³⁶⁶ Though formal ethics opinions would take significantly more time to craft and publish, they could have considerably greater deterrent value—particularly given the low number of formal disciplinary decisions that have been published since the 2013 adoption of the USPTO Rules. Indeed, the USPTO had contemplated that

³⁶² See, e.g., OFFICE OF COUNSEL, N.C. STATE BAR, 2018 ANNUAL REPORT 5–12 (2019), <https://www.ncbar.gov/media/730494/2018-counsel-annual-report.pdf> [<https://perma.cc/98KQ-EQGD>] (providing a comprehensive report of activities of the Office of Counsel, including summaries of major disciplinary actions).

³⁶³ See, e.g., *Archived Issues*, STATE BAR CAL., <http://www.calbar.ca.gov/About-Us/News-Events/California-Bar-Journal/Attorney-Discipline/attorney-who-flouted-court-orders-stripped-of-law-license> [<https://perma.cc/F89D-DH5U>] (providing updates on latest disciplinary actions).

³⁶⁴ For an example of a comprehensive website containing formal ethics opinions, see *Adopted Opinions*, N.C. STATE BAR, <https://www.ncbar.gov/for-lawyers/ethics/adopted-opinions/> [<https://perma.cc/DMS7-8S79>].

³⁶⁵ See Alice Neece Mine, *How the State Bar Rules on Questions of Legal Ethics*, N.C. ST. B. Q., Spring 1994, at 6, 6 (discussing the significance of formal ethics opinions and ethics advisories in North Carolina).

³⁶⁶ See generally USPTO Presentation, *supra* note 146.

practitioners would be able to increasingly use disciplinary decisions to guide their conduct, a circumstance that has not come to fruition.³⁶⁷

CONCLUSION

Over the last several decades, the USPTO has come to recognize the critical role that practitioners play in the provision and enforcement of intellectual property rights. They serve as trusted technical and legal intermediaries between applicants and the USPTO—simultaneously expected to advocate for their clients and act in good faith by fully disclosing information that could potentially damage their clients' chances of success. It is for these reasons that the USPTO has invested significant energy in professionalizing the practitioner ranks, both for admissions and discipline. The OED has considerable infrastructure and processes already in place. Without knowing more, one might assume that the OED is likewise acting in a manner similar to other state disciplinary authorities in regulating practitioners.

Yet as the results of this original empirical study have demonstrated, the OED has failed to fully leverage its disciplinary authority, particularly in its regulation of trademark attorneys. Overall, practitioner discipline rates are less than one-fourth of that which is imposed by state authorities, and nearly half of the OED's cases involve the imposition of reciprocal discipline imposed by another state. Furthermore, trademark discipline comprises less than one-quarter of all OED cases, and trademark attorneys generally receive less punitive sanctions than do patent practitioners despite violating more ethics rules on average. This disparity between patent- and trademark-related discipline may not be all that surprising, however, given the differences in how the USPTO regulates these two groups of professionals.

Over the sixteen-year period under study, USPTO discipline was used primarily as a tool to regulate individual practitioners who have committed easily detected types of misconduct. Three of the four common patterns of misconduct that were identified and described—the financial fool, overcommitted practitioner, and absent advocate—are not unique to patent practice and do not relate to the central place that the duties of candor and good faith occupy in the USPTO's regulatory purpose.

With fraudulent and suspicious activity before the USPTO on the rise, it is now time for the OED to use its disciplinary authority to more effectively serve the public interest. With the adoption of the newest version of the USPTO Rules, there is already a regulatory mechanism in place to sanction

³⁶⁷ See Changes to Representation of Others Before the United States Patent and Trademark Office, 78 Fed. Reg. at 20,180.

these types of misconduct. But this mechanism has largely gone unused and its workings are largely unknown, even to those who are subject to it.

The three recommendations provided in this Article present a first step towards strategically leveraging the threat of practitioner discipline to promote more ethical conduct before the USPTO. Rather than being conceived as draconian measures, however, these recommendations reinforce the notion that USPTO practitioners are entrusted to act responsibly and in good faith—not only in relation to their individual clients, but also in their entire practice before the USPTO.

This Article also has provided a blueprint for how to conduct empirical studies of practitioner/attorney discipline, which can be emulated for other disciplinary authorities so that they may better understand and improve their work. In conducting the background research in preparation for this study, the author was surprised that there is very little scholarly work on the subject. Additional studies would enable disciplinary authorities to identify best practices and to align their work in accordance with their mission and the purposes of discipline that they wish to prioritize and promote, as was done for the USPTO in this Article.