

ETHICAL OBLIGATIONS OF PATENT PRACTITIONERS: DO YOU KNOW THE RULES?

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1. Which of the following ethical rules apply to patent attorneys practicing before the Patent Office:
 - a. The disciplinary rules of the state in which the practitioner is licensed?
 - b. USPTO Code re Representation of Others (37 CFR § 10.1)
 - c. Both a and b
 - d. Neither a nor b

2. You can represent a party adverse to a current client, without the client's consent, under
 - a. The Model Rules of Professional Conduct
 - b. PTO Code
 - c. Both a and b
 - d. Neither a nor b

3. What should you do with "material" information required to be submitted under Rule 56 if your client considers it confidential information and instructs the practitioner not to disclose it?
 - a. Disclose it and do not withdraw under the PTO Rules
 - b. Not disclose it under the rules of the state in which the practitioner is licensed
 - c. Withdraw and not disclose it
 - d. Disclose it and then withdraw

4. Same as 3, except the client fires you and hires another attorney and does not disclose the material information to the new attorney
 - a. Nothing and count your blessings
 - b. Disclose the situation to the new attorney
 - c. Disclose the situation to the Patent Office under Rule 10.85(b)

5. Can an e-mail from a prospective client visiting your law firm's web site, disclosing confidential information, cause disqualification of your entire firm?
 - a. Yes
 - b. No

6. Who is the client(s) when preparing a patent that is assigned by the inventor to his employer where the inventor executes a power of attorney?
 - a. Employer
 - b. Inventor
 - c. Both employer and inventor
 - d. Depends whether it is for disqualification or a malpractice claim

7. A lawyer commits malpractice for “claim shaving” where claims were narrowed in view of another client’s pending application
 - a. Yes
 - b. Yes, only if it affects the ultimate result
 - c. No

8. Which of the following can give rise to an ethical problem?
 - a. Using one client’s trade secrets to obtain a patent for another client
 - b. Arguing against a rejection on the basis of lack of enablement or written description in a patent obtained by the firm
 - c. Submitting proof of conception and reduction to practice to antedate a patent obtained by the firm
 - d. All of the above

9. With regard to a patent prosecuted by you, your firm can:
 - a. Opine as to whether another client’s product infringes
 - b. Opine as to whether the patent is invalid
 - c. Neither a nor b
 - d. Both a and b

10. When filing a patent application after the declaration has been executed by the inventor, it is permissible for you to
 - a. Correct obvious typographical and spelling errors
 - b. Add words that are obviously missing
 - c. Fix improper claim numbering
 - d. All of the above
 - e. None of the above

11. Your assistant may fill in your electronic signature
 - a. With oral authorization
 - b. With written authorization
 - c. Both a and b
 - d. Neither a nor b

12. You may fill in an inventor’s electronic signature
 - a. With oral authorization
 - b. With written authorization
 - c. Both a and b
 - d. Neither a nor b

13. The PTO Rules of Representation specifically prohibit (more than one is correct)?
- a. Misappropriation of client fees provided to pay PTO fees
 - b. Failure to identify a patent or application from which claims were copied
 - c. Knowingly misuse a "Certificate of Mailing or Transmission"
 - d. Bribing an examiner
 - e. Having a suspended practitioner prepare a response to an office action
 - f. Violate Rule 56
 - g. Making a scandalous statement in a paper file in the PTO
 - h. Making an indecent statement in a paper file in the PTO
 - i. Working for an invention developer
 - j. Accusing a practitioner of inequitable conduct in a court proceeding without a reasonable belief of the accusation
 - k. Failing to let the PTO know about another practitioner's violation of a Disciplinary Rule
 - l. Using the name of a U.S. Senator in advertising the practitioner's practice
 - m. Sending a solicitation letter to company sued for patent infringement in the local District Court, when the company has no prior relationship to the practitioner, threatening the company with dire circumstances if they do not retain someone as qualified as you
 - n. Charging a clearly excessive fee
 - o. Splitting fees received with a retired partner
 - p. Requiring a retired partner to stop practicing before the PTO as a condition to obtain retirement benefits
 - q. Answering a complaint for patent infringement that the patent is anticipated without a reasonable basis
 - r. Forming a partnership with a non-practitioner
 - s. Accept employment in litigation when an attorney in the firm will need to testify as to diligence in constructive reduction to practice
 - t. A provision in a retainer agreement where the client waives any claim for malpractice
14. The applicable test for "materiality" under Rule 56 is:
- a. The broad pre-1992 standard
 - b. The current 1992 version of Rule 1.56
 - c. "But for" for the inequitable conduct, a particular claim would not have issued
 - d. Both a and b

15. Which of the following was held to be material in 2005 - 2008 (more than one is correct)?
- Declarants distinguishing prior art references in PTO prosecution received research funds from the applicant
 - Failure to disclose the best mode
 - Implying the existence of clinical data to support unexpected results
 - An advertisement for the product less than one year before the filing date that did not disclose the invention
 - Submitting a video purportedly taken with the claimed invention, but was not, but could have been
 - Relying on a prophetic example during prosecution on the basis that it was actually performed
 - In application A, a rejection in a related copending application B by the same examiner who is examining application A where application B was cited to the examiner B
 - In application A, the fact that related application B was allowed a few months earlier by the same examiner who is examining application A, where application B was cited to the examiner
 - Payment of small entity fees after licensing the patent to a large entity
 - Misclaiming an effective priority day
 - Failing to disclose litigation involving parent patents
16. Which of the following is it prudent to cite to the PTO under Rule 56? (more than one is correct)
- File history of great-uncle patent
 - PCT published version of cited US parent application
 - PCT search report "A" references
 - For a cip application, commercial activity occurring more than 1 year before filing date, but after filing of parent application
 - Non-prior art article by inventor discussing success/failure rate of claimed compounds
 - "Me-too device" submissions to FDA
17. With regard to Rule 105 (37 C.F.R. § 1.105)
- It sucks
 - Failure to comply can result in abandonment of your application
 - An examiner can require disclosure of information that would not be discoverable in litigation
 - An examiner can require disclosure of information that is not material under Rule 56
 - All of the above
18. For there to be inequitable conduct for withholding information by an applicant, it is necessary that the applicant knows that the information withheld was material.
- True
 - False

19. 37 C.F.R.10.18(b)(2) requires a person filing a paper in the PTO to have made the judgment that the paper is not interposed for improper purpose “after an inquiry reasonable under the circumstances.” Harry Moatz (Director of Enrollment and Discipline) can be a basis for finding a lack of reasonable inquiry:
 - a. Not reading each paper submitted to the PTO in its entirety before it is submitted.
 - b. Burying a material reference among a large number of cumulative references
 - c. Filing an application with claims anticipated by a publication authored by one of the inventors
 - d. a and b
 - e. b and c
 - f. a, b, and c

20. 37 C.F.R.10.18(b) requires that submitted papers not be presented for an improper purpose. Harry Moatz believes that the following potentially involve improper purpose or delay
 - a. Too many claims with multiple dependent claims
 - b. Paying insufficient fees
 - c. Bouncing checks

21. All of the above If you get sued for using “consisting” instead of ”comprising” by an unhappy client, you get to defend yourself in:
 - a. Federal court
 - b. State court
 - c. Either state court of Federal court