

Professional responsibility and practice before the USPTO

*Office of Enrollment and Discipline (OED), United
States Patent Office*



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(OED)



UNITED STATES
PATENT AND TRADEMARK OFFICE ®

Practice before the USPTO and Artificial Intelligence (AI)

- On April 11, 2024, the USPTO issued a Federal Register notice, Guidance on Use of Artificial Intelligence-Based Tools in Practice Before the United States Patent and Trademark Office. See <https://www.federalregister.gov/documents/2024/04/11/2024-07629/guidance-on-use-of-artificial-intelligence-based-tools-in-practice-before-the-united-states-patent>.
- When practicing before the USPTO, practitioners' use of AI may implicate ethical considerations.
- 37 C.F.R. § 11.18 imposes duties on parties and practitioners in connection with submissions before the USPTO, including the practitioner's signature pursuant to 37 C.F.R. §§ 1.4(d)(1), 2.193.
- 37 C.F.R. § 11.18(b), in part, stipulates that parties presenting papers to the Office make a certification, formed after a reasonable inquiry, as to evidentiary support for factual contentions and allegations.
- See <https://www.uspto.gov/initiatives/artificial-intelligence/artificial-intelligence-resources>



USPTO Guidance on use of AI-based tools

- Director guidance on party and practitioner misconduct related to the use of AI – memorandum issued February 6, 2024
- USPTO issued “Guidance on Use of Artificial Intelligence-Based Tools in Practice Before the United States Patent and Trademark Office” on April 11, 2024 (89 FR 25609)
- Takeaways
 - Use of AI-based tools by practitioners and parties is *not* prohibited
 - Practitioners reminded of existing rules that may be relevant to use of AI-based tools
 - Notice educates practitioners on possible risks associated with AI-based tools to promote healthy adoption of AI in practice before the USPTO
 - USPTO’s existing rules and policies help mitigate risks of AI-assistance
 - Guidance does not introduce any new rules or duties

Document drafting

- 37 CFR 11.18(b) applies to parties signing and/or presenting papers to the Office
- No obligation to disclose use of specific tools to the USPTO unless specifically requested by the USPTO
- All individuals associated with a proceeding before the Office have a duty of candor and good faith

Filings with the USPTO

- Papers submitted to the USPTO must be signed by the person submitting the paper
 - AI tool cannot sign for a natural person
- USPTO.gov accounts are limited to natural persons and cannot be obtained by non-natural persons
 - Practitioners may not sponsor AI tools as support staff individual to obtain an account



Interacting with USPTO Information Technology (IT) systems and websites

- An AI system is not considered a “user” for filing or accessing documents via the USPTO electronic filing systems
- Use of computer tools including AI systems for data mining information from USPTO databases subject to Terms of Use for USPTO websites
 - USPTO’s bulk data products available for permitted and appropriate data mining
- Use of AI tools on USPTO websites for unauthorized access, use, etc. may constitute a violation of the Computer Fraud and Abuse Act



Confidentiality and national security

- Risks associated with searching or drafting aspects of an invention using AI systems:
 - Inadvertent disclosure of client-sensitive information to third parties resulting in breach of practitioners' confidentiality obligations to clients
 - National security, export control, and foreign filing license issues
 - Data breaches that subject user data to disclosure risks
- Practitioners may mitigate risks by:
 - Complying with USPTO Rules of Professional Conduct when relying on AI tools and/or related third party services
 - Understanding AI tools' terms of use, privacy policies, and cybersecurity practices



What do the courts, bar, and USPTO say?

- Katherine K. Vidal – USPTO
 - Focuses on AI, not only GenAI
 - **Certification** requirement (USPTO R. 11.18 is based on FRCP R. 11)
 - Sanctions
 - Striking an offending paper
 - Precluding submission of a paper
 - Terminating proceedings
 - Disciplinary action

reasonable opportunity for discovery.¹² The USPTO's Rule 11.18 is based on Federal Rule of Civil Procedure 11, and the federal courts have applied that rule to submissions made with AI assistance that were not adequately investigated by the submitter prior to filing.¹³

Accordingly, under existing rules and current practice, any paper submitted to the USPTO under signature must be reviewed by the person presenting the paper. The reasonable inquiry required by USPTO Rule 11.18 is necessarily context-specific and can include ascertaining how the paper was prepared, determining whether errors or omissions may have been introduced as a result of how the submission was prepared, and verifying the accuracy of all factual and legal representations. This is true regardless of how the submission was prepared:

Signature and certificate

37 C.F.R. § 11.18(b)(2)

“(b) By presenting to the Office . . . (whether by **signing, filing, submitting, or later advocating**) any paper, the party presenting such paper, whether a practitioner or non-practitioner, **is certifying** that -.”

Signature and certificate

37 C.F.R. § 11.18(b)(2) cont.

“(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances,

- (i) **The paper is not being presented for any improper purpose**, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding before the Office;
- (ii) The other **legal contentions therein are warranted by existing law** or by a **nonfrivolous argument** for the extension, modification, or reversal of existing law or the establishment of new law; . . .”



Inequitable conduct:

In re Tendler, Proceeding No. D2013-17 (USPTO Jan. 8, 2014)

- Patent attorney filed Rule 131 declaration re: reduction to practice with USPTO.
- Soon after, attorney learned that the inventor did not review the declaration and that declaration contained inaccurate information.
- Respondent did not advise the office in writing of the inaccurate information and did not fully correct the record in writing.
- District court held resultant patent unenforceable due to inequitable conduct, in part, because of false declaration. *Intellect Wireless v. HTC Corp.*, 910 F. Supp. 1056 (N.D. Ill. 2012). Federal Circuit upheld.
 - First requirement is to expressly advise the USPTO of existence of misrepresentation, stating specifically where it resides.
 - Second requirement is that the USPTO be advised of misrepresented facts, making it clear that further examination may be required if USPTO action may be based on the misrepresentation.
 - It does not suffice to merely supply the office with accurate facts without calling attention to the misrepresentation.
- Settlement: Four-year suspension (eligible for reinstatement after two years).



Candor toward tribunal

In re Hicks, Proceeding No. D2013-11 (USPTO Sept. 10, 2013)

- Attorney sanctioned by EDNY for non-compliance with discovery orders.
- Federal Circuit affirmed sanction and found appellate brief to contain “misleading or improper” statements.
 - Brief reads, “Both the Magistrate and the District Court Found that RTI's and its Litigation Counsel Hicks' Pre-Filing Investigation Was Sufficient.” However, neither the magistrate judge nor the district court ultimately found that RTI's or Mr. Hicks's pre-filing investigation was “sufficient.”
 - Mr. Hicks also failed to inform the court that a case citation was non-precedential and therefore unavailable to support his legal contentions aside from “claim preclusion, issue preclusion, judicial estoppel, law of the case, and the like.”
 - *Rates Technology, Inc. v Mediatix Telecom, Inc.*, 688 F.3d 742 (Fed. Cir. 2012).
- Settlement: public reprimand and one-year probation.



**Practice before the PTAB
37 C.F.R. Parts 41 and 42**

Duty of candor

37 C.F.R. § 42.11(a)

“Parties and individuals involved in the proceeding have a duty of candor and good faith to the Office during the course of a proceeding.”

Representations to the Board

37 C.F.R. § 42.11(c)

“By presenting to the Board a petition, response, written motion, or other paper—**whether by signing, filing, submitting, or later advocating it**—an attorney, registered practitioner, or unrepresented party **attests to compliance** with the certification requirements **under § 11.18(b)(2)** of this chapter.”

PTAB: AI Areas of interest

- Disclosure rules
 - Duty of candor
 - Mandatory notices
 - Routine discovery: information inconsistent with a position advanced
 - Signature
 - Representations to the Board

Sanctions

37 C.F.R. § 42.12(a)

“(a) The Board may impose a sanction against a party for misconduct, including:

- (1) Failure to comply with an applicable rule or order in the proceeding;
- (2) Advancing a misleading or frivolous argument or request for relief;
- (3) Misrepresentation of a fact;
- (4) Engaging in dilatory tactics;
- (5) Abuse of discovery;
- (6) Abuse of process; or
- (7) Any other improper use of the proceeding, including actions that harass or cause unnecessary delay or an unnecessary increase in the cost of the proceeding.”



Thank you!

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