Lawyer Discipline Before the USPTO: Too Little, Too Late

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This article will be the first to empirically study lawyer discipline before the USPTO and to begin to address the question of whether the current disciplinary system is adequately fulfilling its role in protecting clients, competitors, and the public against lawyer misconduct. Last year, the USPTO began a program to more aggressively police fraudulent trademark specimens—shining a light more broadly on the degree to which suspect and fraudulent trademark applications are filed (and sometimes succeed to registration).

After providing background information on the USPTO's Office of Enrollment and Discipline ("OED"), the USPTO Rules of Professional Conduct, and the disciplinary process for practitioners who are suspected of misconduct, this article will turn to an empirical analysis of lawyer discipline before the USPTO. The years from 2009-2018 will be selected for examination in order to identify trends in discipline since the USPTO updated its ethics rules in 2013. After providing overall data on the number and types of discipline, this article will hone in on the discipline of trademark attorneys—comparing them against their patent counterparts and against the backdrop of attorney discipline by other state grievance committees. This part will expose the underenforcement of lawyer discipline before the USPTO generally, with much of it coming from imposing reciprocal discipline from other states. Furthermore, to the extent that the USPTO does impose its own discipline, it relates to financial or other traditional, identifiable instances of lawyer misconduct. Trademark attorneys, in particular, are rarely the subject of formal discipline, and even rarer still does such discipline address the types of fraud and overreaching that may be most problematic to the proliferation of suspect marks.

The article will next examine the USPTO's discipline in light of the purposes to be fulfilled by an effective disciplinary system. Such a process will both protect the public against lawyer abuses and also operate as a deterrent effect on future misconduct. This article argues that USPTO's discipline against trademark attorneys in particular fails to meet those objectives. In this regard, the USPTO has done a more effective job in regulating the conduct of patent prosecutors, likely due to the high stakes associated with patents and the recognition of patent misuse. On the other hand, the incentives associated with filing trademark applications—even if suspect—in combination with the under-detection and imposition of discipline, create an environment in which clients are lulled into believing that their intellectual property is strongly protected while legitimate competitors are deterred from pursing commercial use of a mark for fear of infringement. And because of the largely non-adversarial nature of trademark prosecution, it is rare that such abuses come to light until long after a trademark has been prosecuted.

This article argues that these trademark issues will continue to become exacerbated with the influx in filing rates, unless the USPTO increases its internal investigation and enforcement of disciplinary rules. The article will conclude with recommendations for implementation of such a program.