Commissioner of Patents and Trademarks
Patent and Trademark Office (P.T.O.)

IN RE MATTER OF: DAVID A. TEICHER
September 7, 1989

Michael K. Kirt

Assistant Commissioner for External Affairs

Decision on Petition Under 37 CFR § 10.2(c)

***1** David A. Teicher (Teicher) has petitioned the Commissioner under 37 CFR § 10.2(c), seeking review of a final decision of the Director of the Office of Enrollment and Discipline (OED) holding that petitioner is required to again meet the legal and good moral character and repute requirements of 37 CFR § 10.7(b). The decision of the Director of the Office of Enrollment and Discipline is hereby reversed.

Background

In June 1979, petitioner qualified for registration as a patent agent on the Patent and Trademark Office (PTO) register of attorneys and agents. Teicher advised OED that he was employed by the United States Government, and in August of 1979, his name was endorsed as 'inactive' in accordance with PTO rules in effect at that time (37 CFR 1.341(f), later redesignated as 37 CFR § 10.6(d)).

Teicher's federal employment terminated in March of 1987 and he requested reinstatement on the PTO roster of attorneys and agents. He also requested that OED change his designation from 'patent agent' to 'patent attorney' since he had graduated from law school and was admitted to practice in the State of Minnesota. A certificate of good standing from the Clerk of the Minnesota Supreme Court was filed with OED.

In April 1987, OED advised Teicher that in view of the length of time that had elapsed since he was designated 'inactive' and the lack of information indicating that he continued to be qualified for registration, he was required to again show that he satisfied the registration requirements of 37 CFR 10.7. This decision was based on the PTO's policy concerning reinstatement on the register in effect at that time. See 974 Official Gazette 14 (September 19, 1978) and 1064 Official Gazette 12 (March 11, 1986). [FN1]

Teicher took no further action until March 1989, when he again requested that OED change his designation to 'active.' A certificate of good standing from the Clerk of the Minnesota Supreme Court dated February 27, 1989, was filed with the request. Teicher noted that the PTO rules concerning registration of government employees had been changed effective November 4, 1988. 53 Federal Register 38949 (October 4, 1988).

In a decision dated March 15, 1989, OED denied Teicher's request, again referring to the policy for reinstatement of individuals who have been endorsed as 'inactive' for five years or longer. 1064 Official Gazette 12 (March 11, 1986). Teicher was advised that he had not provided information showing that he satisfied the legal requirements of 37 CFR § 10.7. He was further advised that the good character and repute requirement would be considered once the legal requirement was satisfied.

***2** On April 13, 1989, Teicher filed a petition pursuant to 37 CFR § 10.2(c), seeking review of OED's decision denying him reinstatement on the PTO register of attorneys and agents.

Opinion

On November 4, 1988, an amendment to the rules governing practice before the Patent and Trademark Office took effect. The rule change included removal of § § 10.6(d) and (e) from Part 10, 37 CFR. Thus, under the new rules, government employees who meet the requirements for registration are registered on the PTO roster; registered practitioners who enter federal service and whose official duties as a U.S. Government employee do not include the preparation and prosecution of patent applications are no longer endorsed as 'inactive.' [FN2]

Accordingly, in view of the recent rule-change that removed § § 10.6(d) and (e) from the PTO rules governing admission of Government employees to practice before the PTO in patent cases, the petition requesting reinstatement on the PTO register of agents and attorneys is granted. Petitioner's name will be placed on the register of attorneys and agents entitled to practice before the PTO in patent cases. Petitioner's designation will be changed from 'patent agent' to 'patent Attorney.'

The decision of the Director of OED is hereby reversed and this matter is remanded to OED for further action in accordance with this decision.

FN1. Reinstatement of Patent Attorneys and Agents to Practice before the U.S. Patent and Trademark Office (P.T.O.)

Any person whose name has been removed from the register of attorneys and agents pursuant to 37 CFR 10.11(b) . . . or whose name has been endorsed as inactive on the register pursuant to 37 CFR 10.6(d) . . . may request reinstatement on the register. However, where the person seeks reinstatement to the register five (5) or more years after his or her name was either removed . . . or endorsed as inactive . . . that person will be required to again meet the requirements of 37 CFR 10.7 [formerly 37 CFR 1.341(c)], including taking and passing the examination under § 10.7(b) before reinstatement is granted.

Those persons who show that they continue to possess the legal qualifications necessary to render applicants for patent valuable service despite the lapse of five or more years will not be required to take the examination. * * *

FN2. The Commissioner notes that petitioner's assertion that the rule-change removes the 'prohibition of outside patent prosecution by current government employees' is incorrect (petition p. 2). The amended rules merely permit federal employees to be registered. Amended § 10.10 specifically provides in paragraph (d) that: 'Practice before the Office by Government employees is subject to any applicable conflict of interest laws, regulations or codes of professional responsibility.' 37 C.F.R. § 10.10(d) (1988). As stated in the Supplementary Information section in the notice of final rule-making, the PTO maintains that the import of the opinion rendered by the Acting United States Attorney General, 41 Op. Att. Gen 21, 1949 Dec. Comm'r Pat. 1 (1949), is unchanged with respect to practice before the PTO by Government employees. In that decision, it was determined that all patent practice before the PTO involves a direct substantial Government interest within the meaning of 18 U.S.C. § § 203 and 205.

14 U.S.P.Q.2d 1573

END OF DOCUMENT