

## § 11.8

in the OED Director's opinion, the individual has sustained his or her burden of satisfactorily demonstrating that he or she possesses good moral character and reputation.

(k) *Reapplication for registration.* An individual who has been refused registration for lack of good moral character or reputation may reapply for registration two years after the date of the decision, unless a shorter period is otherwise ordered by the USPTO Director. An individual, who has been notified that he or she is under investigation for good moral character and reputation may elect to withdraw his or her application for registration, and may reapply for registration two years after the date of withdrawal. Upon reapplication for registration, the individual shall pay the fees required by § 1.21(a)(1)(ii) and (a)(10) of this subchapter, and has the burden of showing to the satisfaction of the OED Director his or her possession of good moral character and reputation as prescribed in paragraph (b) of this section. Upon reapplication for registration, the individual also shall complete successfully the examination prescribed in paragraph (b) of this section, even though the individual has previously passed a registration examination.

### § 11.8 Oath and registration fee.

(a) After an individual passes the examination, or the examination is waived, the OED Director shall promptly publish a solicitation for information concerning the individual's good moral character and reputation. The solicitation shall include the individual's name, and business or communication postal address.

(b) An individual shall not be registered as an attorney under § 11.6(a), registered as an agent under § 11.6(b) or (c), or granted limited recognition under § 11.9(b) unless within two years of the mailing date of a notice of passing registration examination or of waiver of the examination the individual files with the OED Director a completed Data Sheet, an oath or declaration prescribed by the USPTO Director, and the registration fee set forth in § 1.21(a)(2) of this subchapter. An individual seeking registration as an attorney under § 11.6(a) must pro-

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vide a certificate of good standing of the bar of the highest court of a State that is no more than six months old.

(c) An individual who does not comply with the requirements of paragraph (b) of this section within the two-year period will be required to retake the registration examination.

(d) [Reserved]

[69 FR 35452, June 24, 2004, as amended at 73 FR 67757, Nov. 17, 2008; 78 FR 20198, Apr. 3, 2013]

### § 11.9 Limited recognition in patent matters.

(a) Any individual not registered under § 11.6 may, upon a showing of circumstances which render it necessary or justifiable, and that the individual is of good moral character and reputation, be given limited recognition by the OED Director to prosecute as attorney or agent a specified patent application or specified patent applications. Limited recognition under this paragraph shall not extend further than the application or applications specified. Limited recognition shall not be granted while individuals who have passed the examination or for whom the examination has been waived are awaiting registration to practice before the Office in patent matters.

(b) A nonimmigrant alien residing in the United States and fulfilling the provisions of § 11.7(a) and (b) may be granted limited recognition if the nonimmigrant alien is authorized by the United States Government to be employed or trained in the United States in the capacity of representing a patent applicant by presenting or prosecuting a patent application. Limited recognition shall be granted for a period consistent with the terms of authorized employment or training. Limited recognition shall not be granted or extended to a non-United States citizen residing abroad. If granted, limited recognition shall automatically expire upon the nonimmigrant alien's departure from the United States.

(c) An individual not registered under § 11.6 may, if appointed by an applicant, prosecute an international patent application only before the United States International Searching Authority and

the United States International Preliminary Examining Authority, provided that the individual has the right to practice before the national office with which the international application is filed as provided in PCT Art. 49, Rule 90 and § 1.455 of this subchapter, or before the International Bureau when the USPTO is acting as Receiving Office pursuant to PCT Rules 83.1 bis and 90.1.

[69 FR 35452, June 24, 2004, as amended at 78 FR 20198, Apr. 3, 2013]

**§ 11.10 Restrictions on practice in patent matters.**

(a) Only practitioners who are registered under § 11.6 or individuals given limited recognition under § 11.9(a) or (b) are permitted to prosecute patent applications of others before the Office; or represent others in any proceedings before the Office.

(b) *Post employment agreement of former Office employee.* No individual who has served in the patent examining corps or elsewhere in the Office may practice before the Office after termination of his or her service, unless he or she signs a written undertaking agreeing:

(1) To not knowingly act as agent or attorney for, or otherwise represent, or assist in any manner the representation of, any other person:

(i) Before the Office,

(ii) In connection with any particular patent or patent application,

(iii) In which said employee participated personally and substantially as an employee of the Office; and

(2) To not knowingly act within two years after terminating employment by the Office as agent or attorney for, or otherwise represent, or assist in any manner the representation of any other person:

(i) Before the Office,

(ii) In connection with any particular patent or patent application,

(iii) If such patent or patent application was pending under the employee's official responsibility as an officer or employee within a period of one year prior to the termination of such responsibility.

(3) The words and phrases in paragraphs (b)(1) and (b)(2) of this section are construed as follows:

(i) *Represent* and *representation* mean acting as patent attorney or patent agent or other representative in any appearance before the Office, or communicating with an employee of the Office with intent to influence.

(ii) *Assist in any manner* means aid or help another person on a particular patent or patent application involving representation.

(iii) Particular patent or patent application means any patent or patent application, including, but not limited to, a provisional, substitute, international, continuation, divisional, continuation-in-part, or reissue patent application, as well as any protest, reexamination, petition, appeal, interference, or trial proceeding based on the patent or patent application.

(iv) *Participate personally and substantially.* (A) Basic requirements. The restrictions of § 11.10(a)(1) apply only to those patents and patent applications in which a former Office employee had "personal and substantial participation," exercised "through decision, approval, disapproval, recommendation, the rendering of advice, investigation or otherwise." To *participate personally* means directly, and includes the participation of a subordinate when actually directed by the former Office employee in the patent or patent application. *Substantially* means that the employee's involvement must be of significance to the matter, or form a basis for a reasonable appearance of such significance. It requires more than official responsibility, knowledge, perfunctory involvement, or involvement on an administrative or peripheral issue. A finding of substantiality should be based not only on the effort devoted to a patent or patent application, but also on the importance of the effort. While a series of peripheral involvements may be insubstantial, the single act of approving or participation in a critical step may be substantial. It is essential that the participation be related to a "particular patent or patent application." (See paragraph (b)(3)(iii) of this section.)

(B) Participation on ancillary matters. An Office employee's participation on subjects not directly involving the substantive merits of a patent or