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VIA FACSIMILE AND EMAIL

Harry I. Moatz  
Director of Enrollment and Discipline  
Ethics Rules  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Re: Response to USPTO Request for Comments on Proposed Rule 37 CFR § 11.12**  
(Changes to Representation of Others Before The United States Patent and Trademark Office)

(Comments delayed due to Friday June 11, 2004 Federal day off.)

Summary of USPTO Proposal:

The USPTO has proposed implementing new rules under 37 CFR § 11.12 directed to requiring mandatory continuing education requirements (annual requirements) for practitioners licensed to practice in patent cases before the USPTO. The proposed rule offers two avenues for a practitioner to meet the mandatory continuing education requirements.

1. Self-administered testing of a question and answer set provided by the USPTO. The USPTO would provide educational materials to the practitioner for review and use in answering the questions. The practitioner would have to answer all of the questions correct within proscribed dates (by a particular due date). The USPTO would provide this testing via the Internet with links to USPTO publications that contain the answers.
2. Attend a mandatory continuing education program provided by a pre-approved sponsor by a particular due date (annually).

In either case, if the practitioner fails to meet these requirements they would be administratively suspended from practice before the USPTO.

Premise Behind Proposed Rule Change 37 CFR § 11.12:

In recent years there have been numerous changes to the Patent Act (35 USC), regulations (37 CFR) and court holdings (case law) that have resulted in various changes to the patent policies, practices and procedures for prosecuting patents before the USPTO. As a result, there has been an increase in the number of mistakes made by practitioners which may in part be due to the numerous changes in the patent policies, practices and procedures (as well as mistakes related to well-established practices). Correcting or reworking these mistakes contributes to inefficiencies in the USPTO prosecution of patents and gives the practitioner's clients and invariably the public reason to criticize the competency of the patent bar.

Implementing a mandatory continuing education program for practitioners licensed to perform patent practice before the USPTO will increase the competency of the patent practitioners, the efficiency of the USPTO and the public's opinion of the competency of the patent bar, without being onerous on the practitioners.

Comments To Proposed Rule Change:

Summary:

While I might agree that the efficiency of the USPTO may have decreased as a result of an increase in the number of mistakes made by practitioners precipitated by changes in the US patent law over the past few years, I do not believe that a permanent mandatory continuing education program is the best solution to improving the present competency of patent practitioners. I believe it would be better to consider other solutions as substitutes, alternatives or augmentations to the USPTO's proposed mandatory continuing education program for educating patent practitioners on the various recent and yet to come changes to the patent laws, rules and procedures.

Background:

First, a little bit of background on me and my reason for providing comments to this rule change. I am a private practitioner and a licensed patent attorney. I spend a reasonable portion of my practice prosecuting patent applications before the USPTO and counseling clients with respect to patent law. I am a proponent of the state implemented continuing legal education (CLE) requirements. I am presently a member of three state bars that require CLE. I am also a member of various professional organizations directed to patent law, the AIPLA, IPO, and ABA-IPL section. As a member of the AIPLA Law Practice Management committee, I was asked to consider and comment on this proposed rule change. Although, due to time constraints my comments have not been reviewed or approved by the AIPLA, they are my own.

I attend numerous CLE programs each year (upwards of 50 credit hour last year) and find that attending programs to obtain state imposed CLE requirements helps me keep current with many of the changes in patent law. I admit that given the myriad of changes to patent law over the last five or so years, I have not been able to keep up with

all the changes to the patent laws, rules and procedures even though I have attended numerous hours of CLE (average of 25 or more hours per year for the past 5 years), but I have been able to keep up with most of the changes. I value CLE and believe it is a good avenue to increasing the knowledge of professionals, particularly attorneys and patent practitioners. However, almost all three of my present state bar CLE requirements may be met by attending or taking the same courses, so that the burden is not cumulative. If they were cumulative, state CLE requirements would soon become too onerous for attorneys licensed and practicing in multiple states.

#### Detailed Suggestions:

##### Temporary Mandatory Continuing Education Requirements:

I recommend that if mandatory continuing educational requirements are implemented for patent practitioners, be only temporary (e.g., over the next two years) and require further comment if they are to be made permanent.

While it is true that laws are always changing, some areas of the law change less than others. On a historical basis, US patent law has been one of the areas of law that has had little change. Prior to about 1995, the US patent law had little change. However, the past 10-15 years the US patent law has seen numerous changes in the name of harmonization with other countries and improving the efficiency of the USPTO to utilize computer technology and handle the large increase in patent applications. The question this raises is whether the recent changes to US patent laws and procedures in the USPTO experienced over the past 10-15 years will continue.

As for harmonization, there are only a few significant changes left, a first-to-file patent system and an opposition proceeding procedure, to substantially complete harmonization of US patent laws to that of most of the other countries in the world. With respect to increasing the USPTO efficiency to handle greater number of applications, much of the procedures are now or soon to be computerized. Therefore, it seems that the number of changes to the US patent laws and USPTO procedures will likely decrease significantly in the future. Therefore, there may not be a need for a permanent mandatory continuing educational requirement for patent practitioners because there will be far fewer changes to become familiar with.

##### Different Requirements for Different Classes of Practitioners:

I recommend that if mandatory continuing educational requirements be imposed, that each class of patent practitioner have their own requirements. As noted by the USPTO, there are a number of different groups of patent practitioners: patent attorneys, patent agents, and foreign patent agents. Further, patent attorneys may be broken down into prosecution attorneys (registered patent attorneys who spend most of their time prosecuting patent applications before the USPTO), transactional or litigation attorneys (registered patent attorneys who spend little or none of their time prosecuting patent application before the USPTO), or managing patent attorneys (typically senior registered patent attorneys who manage others but do not themselves file documents in the

USPTO). Each of these groups is likely to have different competency concerns and levels.

Registered patent attorneys should have the opportunity to opt out of the USPTO mandatory continuing educational requirements for at least two reasons.

1. They do not intend on practicing before the USPTO in the near future (pure transactional or litigation attorney; senior managing patent attorney). In this case they may become inactive and must take some sort of course or exam to become active again.
2. They have state CLE requirements and spend some of those credit hours (e.g., half) in courses related to patent prosecution and procedures. The patent prosecution and procedures course may or may not be by the USPTO or approved by the USPTO.

Registered patent attorneys that do not opt out of the mandatory continuing educational requirements would be required to complete whatever programs that the USPTO institutes.

On the other hand, patent agents and foreign patent agents should be required to complete whatever mandatory continuing educational requirements that are created by the USPTO because they presumably will not have required CLE and will be practicing before the USPTO. However, they too could decide to become inactive or show with substantial proof that they have attended CLE courses directed to patent policies and procedures for the USPTO.

#### Information Push System for the Internet:

I recommend that the USPTO consider as an alternative to the mandatory continuing educational requirements to begin an electronic and periodic newsletter listing change updates and sent to all registered patent practitioners via the Internet. I presently receive a daily patent newsletter by the Intellectual Property Owners (IPO) and a monthly patent newsletter from the IP Section of The North Carolina State Bar (summary of changes noted for the USPTO) among others. This information should be presented in Executive Summary format and contain hyperlinks to the various web sites and pages where the detailed changes may be found. There is no need to test practitioners on the materials because it is obviously in their best interest to read the information to remain current and avoid mistakes.

It would also be helpful if the "Push System" included recent changes to the MPEP, etc. Historically, the MPEP has been published annually. I think with electronic technology it could be updated on a rolling basis and new pages and sections or changes made available when the drafts have been approved. The pages should then be sent to patent practitioners immediately via the Internet. The changed sections might even be highlighted in, for example, a different color text.

#### Mandatory Attendance (or viewing) USPTO Course Presentations:

I recommend that the USPTO consider providing mandatory patent law "recent changes" courses and presentations. These courses should be provided at the various patent law professional organizations (e.g., AIPLA, IPO, ABA-IPL, etc.) meetings or

state bar patent related meetings (e.g., North Carolina Bar – Patent Law Section). I have attended the PCT Seminar which the USPTO supports and found it to be very helpful and convenient because it is coincident to something I attend anyway. These courses should be video taped and available from the USPTO web site free of charge.

Supplemental “Important Changes” Mailings:

I recommend that the USPTO send via a mailing (US mail and Internet) a detailed description of each significant change made in USPTO policies and procedures. One recent example is the detailed instructions recently sent to practitioners for making amendments to patent applications. Although those were sent primarily with Office Actions, they should be sent to all registered practitioners (who have not requested to go inactive).

Help Services:

The USPTO web site and the help call centers might include a “recent changes” section that can be available to answer people’s questions about any recent changes in the USPTO policies and procedures.

Conclusion:

Patent practitioners are generally conscientious, but busy, professionals. The USPTO should consider using the carrot rather than the stick approach to helping them stay up to date on the changes to various patent laws and USPTO policies and procedures. I do not believe that a permanent mandatory continuing educational requirements by the USPTO is the best solution to the problem. Perhaps some of the suggestions provided herein can provide the basis of a more helpful and less onerous method of maintaining patent attorney competence in the future.

If you have any questions or I can be of any assistance in this matter, please feel free to contact me at 703-535-6790 or [kevin.wolff@wolffking.com](mailto:kevin.wolff@wolffking.com).

Sincerely,

Kevin Alan Wolff  
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