

From j_pokotylo@mandw.com Wed Nov 6 11:00:09 1996
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From: john pokotylo <j_pokotylo@mandw.com>
To: regreform@uspto.gov
Subject: comments re. proposed PTO rule changes

>Regarding Rule 4:

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> The PTO is adding a reasonable inquiry requirement that is not (explicitly) included in the present version of the rule. It is unclear what types of inquiries a practitioner would have to make. This also may expose practitioners who have not made a "reasonable inquiry" to malpractice liability. Accordingly, I oppose the rule in its present form.

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>Regarding Rule 121:

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> The PTO is adding the requirement of submitting a clean copy of all claims. This takes a burden from the PTO and add it to practitioners. (The PTO is apparently moving towards PCT type amendment procedures.) Moreover, the automatic cancelation of claims not included in such a pending claim list may impose significant costs in instances where claims are inadvertently omitted from the list, particularly in view of the proposed changes to rule 116. For example, if a claim(s) is inadvertently omitted from the pending claim list, once a final office action is sent, such claims cannot be reinserted into the application unless a so-called "continued prosecution application" is filed. Instead of its present form, the rule should presume that claims not explicitly cancelled are pending notwithstanding an omission from a list of pending claims. Correction to the list may be required by the PTO. Accordingly, I oppose the rule in its present form.

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>Regarding Registration Requirement:

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> A claim drafting test should remain a part of the registration examination. Merely requiring a course, "comprehensive" or not, will not serve to ensure the admission of qualified practitioners. Merely sitting through a course does not guarantee that the attendee will actually learn anything. Although Kayton and PLI would love this change, it will not prevent unqualified candidates from gaining admission to the PTO bar. As a practical matter, since most candidates can pass the multiple choice section (particularly if the questions are chosen from a fixed pool of questions), if they can pay for the course, they're in. If the OED wants annual fees for its operations, the fees are only going to increase when admissions standards drop and the OED's burdens are increased.

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>Regarding CLE Requirement:

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> While attractive in theory, this requirement would waste the resources of members of the PTO bar. Most active practitioners take it upon themselves to follow rule changes, changes in relevant case law, etc. A CLE requirement would require such practitioners to take courses presenting

information of which they are already aware. I, like many patent prosecution practitioners, attend courses and conferences presenting topics somewhat ancillary to our practice -- e.g., licensing, antitrust, trademark, copyright, ADR, etc. However, such courses have nothing to do with PTO practice and therefore would not satisfy CLE requirements for the patent bar. Accordingly, I oppose this proposal.

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