

September 9, 2019

Honorable Andrei Iancu
Under Secretary of Commerce for Intellectual
Property and Director of the United States
Patent and Trademark Office.600 Dulany Street Alexandria, VA 22314
Via email: fee.setting@uspto.gov

Attention: Brendan Hourigan

RE: Comments on USPTO Setting and Adjusting Patent Fees During Fiscal Year 2020

Dear Director Iancu:

I am a member of AIPLA and a registered patent agent. I work for a corporation. My comments pertain to the proposed annual practitioner fee and CLE discount for this fee.

I am strongly opposed to the proposed annual practitioner fee, and further to the CLE discount for this fee.

Patent budgets will be affected and this will drive short-sightedness (or further short-sightedness) in patent assignee's handling of IP.

I have seen these questions from an AIPLA draft of comments, and I agree that all these questions are important for the USPTO to address:

- a. What are the implications of an administratively suspended or voluntarily suspended practitioner giving advice on a patent matter versus signing documents? Will this be considered practice before the Office?
- b. Will an administratively suspended or voluntarily suspended patent agent lose attorney-client privilege?
- c. The numerous statuses laid out in the proposed regulations might be unduly confusing. This is a complex scheme that is best implemented in an NPRM outside of the Section 10 fee setting authority. Such complexity invites confusion by the public who employ patent professionals' services as to what each status means. The statuses include Administratively Suspended, Disciplinarily Suspended, Voluntarily Inactive, Emeritus, and Resigned. Each status has different fee requirements and different

requirements for reactivation. In this regard, however, we welcome the statement in the NPRM that only practitioners who have been resigned for more than two years would need to retake the registration examination.

- d. Why would anyone opt for voluntary suspension over emeritus as there are no fees for emeritus status and reactivation is easier?
- e. Did the Office consider that an inadvertently administratively suspended attorney may need to report the suspension to their state bar?
- f. Did the Office consider that imposing the APF may result in an increase in practitioner malpractice premiums, especially if the PTO does not actively notify practitioners of their due dates by both USPS mail and email?

Regarding the CLE discount for the APF fee, the amount of the discount, \$100, is not much of an incentive and it is likely that practitioners will choose not to make the certification and instead, pay the undiscounted APF. Thus, the discount seems to be a tax. **Furthermore, the CLE discount disproportionately affects patent agents who do not have a CLE requirement and, thus, will not be able to make the certification without incurring extra expense.**

I am also concerned about the publication of the CLE status of practitioners pursuant to their claiming the APF discount. The proposed amendment to Section 11.11(a) states that “(t)he OED Director may also publish from the register the continuing legal education certification status of each registered practitioner.” I believe this will **unfairly prejudice practitioners, especially patent agents**, who do not have a state CLE requirement or who simply opt to pay the full APF. Providing a public record that reports a lack of certification may be equivalent to a public shaming that makes the CLE mandatory.

Thank you for your attention.

Sincerely,

/Karen R. DiDomenicis/

Karen R. DiDomenicis

Reg. No. 38,600