

**AMERICAN BAR ASSOCIATION**

**Section of Intellectual Property Law**

321 North Clark Street  
Chicago, IL 60654-7598

(312) 988-6254

FAX: (312) 988-6800

E-mail: [iplaw@americanbar.org](mailto:iplaw@americanbar.org)

[www.americanbar.org/iplaw](http://www.americanbar.org/iplaw)

**CHAIR**  
Robert A. Armitage  
Indianapolis, IN

**CHAIR-ELECT**  
Joseph M. Potenza  
Washington, DC

**VICE-CHAIR**  
Robert O. Lindefield  
Pittsburgh, PA

**SECRETARY**  
Adriana S. Luedke  
Herndon, VA

**FINANCIAL OFFICER**  
Theodore H. Davis, Jr.  
Atlanta, GA

**CLE OFFICER**  
Kim R. Jessum  
Philadelphia, PA

**PUBLICATIONS OFFICER**  
Antoinette M. Tease  
Billings, MT

**MEMBERSHIP OFFICER**  
Susan E. McGahan  
Bedminster, NJ

**SECTION DELEGATES TO  
THE HOUSE OF DELEGATES**  
Donald R. Dunner (2012)  
Washington, DC

Susan Barbieri Montgomery (2013)  
Boston, MA

Jack C. Goldstein (2014)  
Houston, TX

**IMMEDIATE PAST CHAIR**  
Marylee Jenkins  
New York, NY

**COUNCIL MEMBERS**  
Donna H. Gies (2012)  
Gary L. Griswold (2012)  
Joan M. McGivern (2012)  
Philip C. Swain (2012)  
Mark K. Dickson (2013)  
Lisa A. Dunner (2013)  
Nancy J. Linck (2013)  
Ralph Oman (2013)  
Amy J. Benjamin (2014)  
George W. Jordan III (2014)  
Donna P. Suchy (2014)  
Marc K. Temin (2014)  
June M. Besek (2015)  
Christopher A. Bullard (2015)  
Denise W. DeFranco (2015)  
Scott F. Partridge (2015)

**SECTION STAFF**  
Michael G. Winkler  
Director

Amy Mandel  
Communications / Publications

Hayden W. Gregory  
Legislative Consultant  
Washington, DC  
[hayden.gregory@americanbar.org](mailto:hayden.gregory@americanbar.org)

March 5, 2012

**Via Electronic Mail**  
OED\_SOL@uspto.gov

The Honorable David J. Kappos  
Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office  
Mail Stop Comments - Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Attn: William R. Covey, Deputy General Counsel for Enrollment and  
Discipline and Director of the Office of Enrollment and Discipline

Re: Implementation of Statute of Limitations Provisions for Office  
Disciplinary Proceedings [Docket No. PTO-C-2011-0089]

Dear Under Secretary Kappos:

I am writing on behalf of the American Bar Association Section of Intellectual Property Law (the "Section") to respond to the request of the United States Patent and Trademark Office (the "Office") for pre-rulemaking comments on "Implementation of Statute of Limitations Provisions for Office Disciplinary Proceedings," published on January 6, 2012 in the Federal Register, 77 Fed. Reg. 457 (the "Notice"). These comments have not been approved by the American Bar Association's House of Delegates or Board of Governors and should not be considered to be views of the American Bar Association.

The Section has carefully considered the Office's rationale behind its proposed rulemaking. However, the Section is concerned that the proposed rule defining when "the date on which the misconduct forming the basis for the proceeding is made known to an officer or employee of the Office" does not accurately track the statute.

Under 35 U.S.C. §32, as amended by the AIA, a disciplinary action must be commenced

not later than the earlier of either the date that is 10 years after the date on which the misconduct forming the basis for the proceeding occurred, or *1 year after the date on which the misconduct forming the basis for the proceeding is made known to an officer or employee of the Office* as prescribed in the regulations established under section 2(b)(2)(D) [emphasis added].

The Honorable David J. Kappos

March 5, 2012

Page 2

The Section respectfully submits the italicized language clearly means “the date on which the misconduct” upon which a complaint is ultimately based “is made known” to the Office. Under the statute, once such conduct is brought to the attention of the Office, it has one year to investigate and file a complaint. However, proposed rule 11.34 (d) defines “the date on which the misconduct forming the basis for the proceeding is made known to an officer or employee of the Office” as follows:

- (1) with respect to complaints under Sec. 11.24, the date on which the OED Director receives a certified copy of the record or order regarding the practitioner being publicly censured, publicly reprimanded, subjected to probation, disbarred, suspended, or disciplinarily disqualified;
- (2) with respect to complaints under Sec. 1.25, the date on which the OED Director receives a certified copy of the record, docket entry, or judgment demonstrating that the practitioner has been convicted of a serious crime; and
- (3) with respect to complaints under Sec. 11.32, the date on which the OED Director receives from the practitioner, who is the subject of an investigation commenced under section Sec. 11.22(a), a complete, written response to a request for information and evidence issued pursuant to Sec. 11.22(f)(1)(ii).

The Section respectfully submits these proposed dates are not the dates the misconduct is “made known to” the Office.

While the Section is sympathetic with the procedures the Office must go through prior to filing a complaint, practitioners suspected of misconduct are in a difficult position and deserve the initial process to be completed within one year from the time an investigation is commenced, as the statute requires. The Section urges the Office to faithfully adhere to the language of the statute itself and insure that any investigation is completed within the one-year time period allotted it under the statute so that the complaint, if any, can be filed within that period.

The Section looks forward to working with the Office as it continues to implement provisions of the Leahy-Smith America Invents Act. If you should have any questions or we can be of further assistance, please do not hesitate to contact us.

Sincerely,



Robert A. Armitage  
Section Chairperson  
American Bar Association  
Section of Intellectual Property Law