



March 5, 2012

Hon. David J. Kappos
Under Secretary of Commerce for Intellectual Property
and Director of the U.S. Patent and Trademark Office
600 Dulany Street
P.O. Box 1450
Alexandria, VA 22313-1450

Submitted via: OED_SOL@uspto.gov

Re: Comments on Proposed Rules: "Implementation of Statute of
Limitations Provisions for Office of Disciplinary Proceedings"
77 Fed. Reg. 457 (January 5, 2012)

Dear Under Secretary Kappos:

Intellectual Property Owners Association (IPO) appreciates the opportunity to
provide comments to the U.S. Patent and Trademark Office in response to the proposed
rules to Implement the Statute of Limitations Provisions for Office of Disciplinary
Proceedings Provisions (OED) of the Leahy-Smith America Invents Act (AIA)
published in the Federal Register on January 5, 2012 (Notice).

IPO is a trade association representing companies and individuals in all industries
and fields of technology who own or are interested in intellectual property rights. IPO's
membership includes more than 200 companies and more than 12,000 individuals who
are involved in the association either through their companies or as inventor, author, law
firm, or attorney members.

IPO appreciates the opportunity to comment on the proposed rulemaking. As an
organization representing owners of intellectual property, IPO's membership has the
utmost interest in assuring that all those involved in the patenting process are held to the
highest standards of ethical conduct and integrity. IPO agrees with the Office's
proposed changes to rule 11.22 and proposed new section (d) of rule 11.34.

Section 3(k) of the AIA amended 35 U.S.C. §32 to state that disciplinary
proceedings against any person practicing before the Office must commence either
within 10 years of the misconduct or within one year of the date when the misconduct is
"made known" to the Office, whichever is earlier. In the Notice, the Office has
proposed in new section (d) of rule 11.34 that the commencement date for the one year
statute of limitations date is:

- (1) The date on which the OED Director receives a certified copy of the
record or order regarding the practitioner being publicly censured,

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- publicly reprimanded, subjected to probation, disbarred, suspended, or disciplinarily disqualified;
- (2) 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; or
 - (3) The date on which the OED Director receives from the accused practitioner a complete, written response to a request for information and evidence from the OED Director.

IPO believes that the proposed rule is consistent with the statute and intent of Congress.

With respect to subsections (1) and (2), the misconduct that forms the basis for a proceeding is the violation of the relevant rule and not the precursor misconduct. For example, in the case of attorney disbarment in a sister jurisdiction, the misconduct under 37 CFR §10.23(5) forming the basis for a disciplinary proceeding is the disbarment and not the conduct that led to the disbarment. It is therefore reasonable that period for initiating a disciplinary proceeding commences on the date that the OED Director receives certification that there is probable cause for rule violation, e.g., the notification of the disbarment.

With respect to subsection (3), it is more difficult to identify the precise moment when the misconduct that forms the basis for a disciplinary proceeding is “made known” to the Office. To illustrate, the Notice provides that current investigation procedures pursuant to an allegation under subsection (3) include four steps prior to the filing of a disciplinary complaint against a practitioner:

Step 1: a preliminary screening of the allegation is made against the practitioner.

Step 2: information is requested from the practitioner about the alleged conduct.

Step 3: a thorough investigation is conducted after providing the practitioner an opportunity to respond to the allegation.

Step 4: after the investigation, the case is submitted to the Committee on Discipline for a determination of whether there is probable cause to bring charges against the practitioner.

Proposed rule 11.34(d)(3) commences the one year limitations period immediately prior to Step 3.

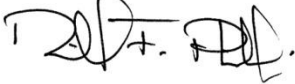
IPO agrees that among the various timing options, the proposed rule best recognizes the competing concerns of practitioners, the Office and the public. Starting the limitations period earlier in the process could disadvantage practitioners because initial allegations may be completely unfounded and time constraints may adversely impact the practitioner’s response. Starting the

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limitations at the end of the process could potentially exceed the statutory mandate by not triggering the one year statute of limitations until some potentially lengthy period after the misconduct is “made known” to the Office.

IPO thanks the USPTO for considering these comments and would welcome any further dialogue or opportunity to support the USPTO in implementing the OED Statute of Limitations Provisions of the AIA.

Sincerely,

A handwritten signature in black ink, appearing to read 'R. F. Phillips', written in a cursive style.

Richard F. Phillips
President