

# PUBLIC SUBMISSION

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Proposed Continuing Legal Education Guideline

**Comment On:** PTO-P-2020-0042-0001  
Proposed Continuing Legal Education Guidelines

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## General Comment

See attached file(s)

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## Attachments

Comments on Proposed Continuing Legal Education Guidelines

## Comments on Proposed Continuing Legal Education Guidelines

There are many problems with the PTO's proposed CLE guidelines, among them the following. But foremost is that it is unclear what the PTO's goal is. Is it to have practitioners who are up-to-date on the latest caselaw that may affect their clients' cases? Is it to help ensure that practitioners are aware of other things that may work to their clients' benefits?

Turning to more specific issues, first, the scope of what is proposed to receive credit – “practice in patent matters before the USPTO” – is too narrow. This is because a patent has to be written for several audiences, but the patent examiners and PTAB are only two of those audiences. Conscientious practitioners concern themselves not only with how to gain an allowance of a patent application, but matters such as how that patent will be viewed by a judge at a Markman hearing, by a potential licensee, or a potential investor; whether or not claim construction may be narrowed, and/or if file wrapper estoppel will apply, as a result of statements in the specification, claim amendments, and/or statements made during prosecution; and in view of the foregoing, whether or not certain arguments or amendments should be presented during prosecution. Thus keeping abreast of case law from Article III courts, particularly from the Federal Circuit and the Supreme Court, is as relevant to a practitioner's job as is focusing solely on practice “before the USPTO”, and should be credited.

Similarly, practical considerations also figure into the calculus when deciding how to proceed before the PTO. It is easy to describe how an applicant with infinite resources should proceed in patent drafting and prosecution, but even the biggest applicants have limited resources of financial and human capital. Again, teaching practitioners how to identify such considerations, and how to work through them, i.e. how to make help clients reach a decision when there is no “correct” choice among several possible courses of action, is something that is relevant to practitioners' jobs, and should be credited.

A further aspect of this is that there is an interplay between patent law and other types of intellectual property protections. A good practitioner should be able to advise a client about approaches in addition to, or instead of, patent protection, and should be able to receive CLE credit for this.

Second, the idea the PTO itself would be a CLE provider is both short-sighted and self-defeating. It is short-sighted in that the PTO focuses only on its (mis)interpretation (or willful ignoring of) statutes, regulations, guidance and caselaw, rather than the big picture described above. In other words, a VILT session (and I have listened to several) gives the PTO's view of the patenting process, and is certainly helpful to me as a practitioner in that it tells me how examiners are being instructed to do their jobs. But as noted above, there are several audiences that ideally should be kept in mind in the patenting process, and the PTO not only doesn't take those audiences into account, but in most cases is incapable of doing so. Moreover, the PTO routinely makes up “rules” out of thin air (e.g. the “requirement” that the benefit chain in an application sheet be listed in reverse chronological order), and allowing the PTO to be a CLE provider would enable the PTO propagate these errors through the community of practitioners and applicants.

A broader perspective could and likely would be provided by independent CLE providers, but this is where the PTO as a CLE provider is self-defeating. Independent CLE providers need to make a living, and thus generally charge money for their offerings, if only to cover the administrative costs of offering their programs and obtaining CLE certification (which is generally done for many state bar associations for a single program and can be a time-consuming process). If the PTO offers CLE for free (e.g. VILT), that will

significantly hamper the efforts of third parties to develop their own, more comprehensive CLE programs, since they won't be able to compete.

Third, the accreditation process is problematic. CLE is traditionally accredited on the basis of there being a session lasting X amount of time, with some state bar associations requiring speakers to provide papers of certain length (that in the end are more often ignored than read). I have served for several years on the Professional Programs committee of the AIPLA, and in that capacity I have helped organized a dozen or more CLE sessions, and have attended several dozen such sessions. Hence I know that the same information available via a(n often pricey) CLE session is often available from numerous individual writers and law firms that provide the same information in daily or periodic write-ups of recent developments in patent law – without the price tag of an accredited CLE session. Indeed, the best fora I have encountered for practical advice on patent practice are several email listservs maintained by fellow practitioner Carl Oppedahl. Participation in those listservs *should* be accredited, but is difficult to quantify. If the PTO is going to allow practitioners to self-certify CLE participation, it should allow them to fulfill the requirements by self-certifying as to blog reading or listserv participation.

Fourth, the proposal to give CLE credit for pro bono work is absurd. If the point of CLE is to ensure that practitioners are keeping up with developments, then there should be no distinction between pro bono and paid work, because one learns from pro bono work as from paid work. Taking that line of reasoning to its logical conclusion, there should be no need for CLE, because a practitioner could be assumed to keep up-to-date via his normal workday activities, paid or pro bono. Yet elsewhere the proposed guidelines explicitly foreswear CLE credit for routine daily practitioner work. If daily practitioner work is not deemed to be sufficient for CLE purposes, then offering CLE credit for pro bono work (or participation in a law school clinic) in effect encourages practitioners to make guinea pigs out of indigent clients, in lieu of actually keeping up with the practice of patent law. If the PTO wants to encourage practitioners to take on pro bono work, then it should offer practitioners a different incentive, commensurate with the time (and thus money) given up by taking on pro bono work.

Fifth, most practitioners already do CLEs to satisfy state bar requirements. If the PTO is going to allow CLE self-certification, then any IP-related course done in fulfillment of such a state bar requirement should count for PTO purposes.

Unfortunately, those are all the thoughts I have time for right now.

Ultimately, I think the PTO should stay out of the business of having practitioners certify CLEs. This is yet another example “mission creep”, in this case the OED seeking more oversight of something (but why should the PTO be different from any other part of the federal government?). Inasmuch as most practitioners are also lawyers and thus subject to both state bar sanctions and state CLE requirements, and all practitioners are subject to malpractice suits, that should be sufficient.

Daniel Feigelson, reg. no. 42527, January 7, 2021