



NYIPLA

The New York Intellectual Property Law Association®

BOARD OF DIRECTORS

OFFICERS

PRESIDENT

Colman B. Ragan
1.973.658.1800
colman.ragan@tevapharm.com

PRESIDENT-ELECT

Robert M. Isackson
1.914.821.1686
isackson@leasonellis.com

1st VICE-PRESIDENT

Heather M. Schneider
1.212.728.8685
hschneider@willkie.com

2nd VICE-PRESIDENT

Robert J. Rando
1.646.993.1898
rrando@taylorenglish.com

TREASURER

Abigail Struthers
1.917.797.5456
abby.struthers@sandoz.com

SECRETARY

Cheryl Wang
1.646.264.7289
cherylwang.esq@gmail.com

MEMBERS

John T. Moehringer
Alicia A. Russo
Diana G. Santos
Patrice P. Jean
Gene W. Lee
Marc J. Pensabene
Jonathan Berschadsky
Paul A. Bondor
John P. Mancini

IMMEDIATE PAST PRESIDENT

Kathleen E. McCarthy
1.212.556.2345
kmcCarthy@kslaw.com

NYIPLA EXECUTIVE OFFICE

2125 Center Avenue, Suite 616
Fort Lee, NJ 07024-5874
Tel: 1.201.461.6603
Fax: 1.201.461.6635
E-Mail: admin@nyipla.org
Website: www.nyipla.org

January 6, 2021

Via email: CLEguidelines@uspto.gov

Mr. William Covey, Director for the Office of Enrollment and Discipline
Mail Stop OED,
Director of the United States Patent and Trademark Office,
P.O. Box 1450, Alexandria, VA 22313-1450

CLE Guidelines Request for Comments 2020.

Thank you on behalf of the New York Intellectual Property Law Association (“NYIPLA”) for the opportunity to respond to your request for comments on the proposed guidelines regarding continuing legal education (“CLE”) for registered patent practitioners and individuals granted limited recognition to practice before the United States Patent and Trademark Office (“USPTO”).

NYIPLA Background

The NYIPLA is a professional association of attorneys whose interests and practices lie in the area of patent, trademark, copyright, trade secret, and other intellectual property law. The NYIPLA’s members include a diverse array of attorneys specializing in patent law, including in-house counsel for businesses that own, procure, enforce, and challenge patents, as well as attorneys in private practice, who prosecute patents and represent entities in various proceedings before the USPTO, as well as provide counseling and opinions in respect of patents.

Many of the NYIPLA’s member attorneys actively participate in patent prosecution before the USPTO, as well as patent litigation, representing both patent owners and accused infringers, including in *inter partes* review (“IPR”) and other post-issuance proceedings before the Patent Trial and Appeal Board (“PTAB”), and their appeals to the Federal Circuit Court of Appeals. The NYIPLA thus brings an informed perspective of stakeholders to the issues presented.

Responses to Topics and Questions

Topic 1: Subject Matter of Courses Qualified for USPTO Patent CLE Credit; Question 1: What course topics should qualify for USPTO patent CLE credit?

The NYIPLA submits that the scope of subject matters already proposed for USPTO Patent CLE credit is appropriate. Although the current boundaries for “litigation” are not clearly defined, to the extent that the litigation involves the U.S. Patent Act, any substantive patent law issue litigated depends in some respect on how the patent-in-suit was prosecuted, and therefore would be appropriate subject matter for USPTO Patent CLE credit. For example, whereas a presentation on procedural issue such as patent law venue might not fall within the USPTO’s subject matter categories because the patent itself is not relevant, a presentation regarding appeal of PTAB decisions on ex parte appeals should.

To the extent that the scope may be enlarged or diminished, the NYIPLA believes that in any event the scope will still be a narrow subset of the diverse subject matter course topics traditionally offered by various non-profit organizations such as the

NYIPLA on an annual basis. For more than 15 years, for example, the NYIPLA has obtained New York State CLE Board approval to provide CLE credit for those attorney members and non-members taking our subject matter course offerings. The extension of CLE requirements to registered patent agents and others who are qualified to practice before the USPTO that currently do not have a state bar CLE requirement is viewed favorably by the NYIPLA.

Question 2: What parameters should be used to determine what subject matters beyond those listed in 37 CFR 11.5(b)(1) would qualify for patent CLE credit, if any?

The NYIPLA offers no comment relevant to this topic beyond our comments elsewhere in this response.

Topic 2: Other Activities That May Qualify for USPTO CLE Credit; Question 3: What activities should qualify for USPTO CLE credit, either in patent law and practice or ethics?

The NYIPLA agrees that subject matter courses of the type currently provided by non-USPTO CLE providers are appropriate activities for receiving CLE credit, including live and virtual presentations by lecture, panel discussions and question and answer sessions on defined relevant topics, consistent with how most state bars accredit CLE presentations under state requirements. The NYIPLA also agrees it is appropriate to provide additional CLE credit to those individuals who prepare and present CLE presentations, in the same manner that state bars currently provide such extra CLE credit for speakers.

The NYIPLA submits it would be appropriate to include professional development activities as worthy of CLE credit, such as professional practice management (e.g., how to operate a patent prosecution practice) and client relationship development (e.g., how to interact with clients so as to be able to better represent and serve clients).

The NYIPLA disagrees, however, that pro bono activities should qualify for CLE credit because there is no principled basis to distinguish on the job training for pro bono clients as contrasted to for paying clients. CLE credit should be earned for professional educational activities, not client work. Pro bono is a separate commitment all attorneys are expected to provide as a member of the legal profession. If the USPTO wishes to incentivize pro bono participation for both qualified attorneys and agents authorized to practice before the USPTO, the NYIPLA suggests an alternate form of motivation should be provided

Topic 3: Providers of USPTO Patent CLE; Question 4: Should organizations or providers outside the USPTO be authorized to deliver USPTO CLE courses? If so, how should such courses be approved?

The NYIPLA submits that non-USPTO providers of CLE should be permitted, and the USPTO should adopt approval procedures like those currently used by state CLE authorities for approving programs for CLE credit. Specifically, we recommend following the guidelines established by the New York State CLE Board CLE Program Rules. The New York State CLE Board CLE Program Rules can be accessed at the following link: <http://ww2.nycourts.gov/sites/default/files/document/files/2018-03/programrules.pdf>.

For almost 100 years, the NYIPLA has offered educational programming to our members (and non-member) as part of our core mission. Since the advent of CLE, the NYIPLA has regularly sought and obtained approval to provide CLE credit for those attending our education presentations. Over the last several years, on an annual basis, the NYIPLA typically provides about twenty-four hours of CLE credit on a wide range of topics related to intellectual property law and ethics, including now

diversity, to our members and non-members. Many of the offered CLE credit hours relate to subject matter that we believe would easily fall within the scope of the subject matter and ethics categories already identified as qualified for USPTO Patent CLE credit. The NYIPLA views providing CLE credit as a core service to our membership, which fosters collegiality and professionalism, one which maintains high standards that advances the profession.

The NYIPLA urges the USPTO to establish guidelines for non-USPTO providers of CLE courses to qualify their subject matter courses for USPTO Patent CLE credit. The NYIPLA cautions, however, that different state bars have different criteria for approving courses for CLE credit in the respective states, and some are more onerous than others. In as much as the USPTO standard will be national, the NYIPLA urges the USPTO to adopt a process that is widely acceptable to the state bars, so as to keep the process as simple and therefore as accessible to USPTO bar registrants, as possible.

However, our view also is that many of our members would very likely be able to satisfy the USPTO's proposed biennial CLE requirements by their attendance at various NYIPLA-presented CLE events including subject matter courses that qualify for USPTO Patent CLE credit, and such attendees should not be burdened by also having to satisfy their USPTO Patent CLE requirements by attending duplicative subject matter courses simply because they are provided by the USPTO. In this regard, the USPTO should coordinate with state bar CLE authorities to ensure that any course that is accredited for USPTO Patent CLE credit also meets the state bar standards for CLE credit for attorneys registered in that state.

Topic 4: Form of Recognition for Practitioners Who Certify Completion of CLE;
Question 5: In what manner should the USPTO recognize practitioners who make the CLE certification on their mandatory registration statement?

The NYIPLA submits that if CLE is mandatory, then individuals who fail to satisfy their CLE requirements should be removed from the register until such time as they have cured the failure in accordance with the USPTO's guidelines. We see any form of recognition on the register as (i) unnecessary, because appearance on the register should be a sufficient recognition that the named individual has qualified to practice before the USPTO and (ii) problematic because those attorneys who have passed the patent bar but have not yet practiced for two years and thus not had an opportunity to submit a CLE certification will be at a comparative disadvantage.

6. Are there any other issues or concerns that the USPTO should consider regarding the CLE guidelines? If so, what are they and how and why would they apply?

The NYIPLA offers no comment relevant to this topic beyond our comments elsewhere in this response.

* * *

We would like to thank the USPTO for seeking the input from the public with respect to this CLE initiative.

Sincerely,



Colman B. Ragan., NYIPLA President