

LA IPLA

Los Angeles Intellectual Property Law Association

Officers

President

BRIAN M. BERLINER
400 S. Hope Street
Los Angeles, CA 90071
Tel: 213.430.6000
Fax: 213.430.6407
bberliner@omm.com

Vice President

PAUL D. TRIPODI, II
555 West 5th Street
Los Angeles, CA 90013
Tel: 213-896-6000
ptripodi@sidley.com

Secretary

GARY J. NELSON
350 W. Colorado, Suite 500
P.O. Box 7068
Pasadena, CA 91109-7068
Tel: 626.795.9900
Fax: 626.577.8800
gary.nelson@cph.com

Treasurer

SEAN M. KNEAFSEY
445 S. Figueroa Street
Suite 2580
Los Angeles, CA 90071
Tel: 213-688-0430 x 112

Board of Directors

Charles S. Barquist
Brian M. Berliner
Margaret Churchill
Jason S. Feldmar
Elizabeth J. Hoult
Sean M. Kneafsey
Keith Newbury
Gary Nelson
Sung Oh
Paul D. Tripodi, II
Edward Schewe

Administrator

Linda E. W. Cain
1430 South Grand Avenue
256
Glendora, CA 91740-5400
Ph: 626-974-5429
Fax: 626-974-5439
E-Mail: 01cain@gte.net

visit us at:
www.laipla.org

June 14, 2004

Honorable Jon W. Dudas
Mail Stop OED-Ethics Rules
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450
Attention: Harry I. Moatz (ethicsrules.comments@uspto.gov)

Re: Comments regarding proposed changes to Representation of Others Before the United States Patent and Trademark Office

Dear Sir:

The following are the comments of the Los Angeles Intellectual Property Law Association (LA IPLA) with respect to the proposed new rules for Representation of Others Before the United States Patent and Trademark Office published in a notice in the Federal Register on December 12, 2003 (68 Fed. Reg. 69442).

The LA IPLA is a regional bar association of attorneys with more than 500 members in private and corporate practice principally in Los Angeles County. The LA IPLA represents a wide and diverse spectrum of practitioners involved in the practice of patent, trademark, copyright and unfair competition law as well as other fields involving intellectual property law. The new proposed rules will have a significant impact on our members and the LA IPLA appreciates the opportunity to provide its comments on the rule changes proposed by the Office.

The comments herewith address the proposed rule changes in Part 11, Subparts A through D of title 37 of the Code of Federal Regulations for the proposed Rules which are still open for public comment.

Respectfully submitted,
/s/ Brian M. Berliner

COMMENTS OF THE LAIPLA

SUBPART A - GENERAL PROVISIONS

Proposed Rule 11.3

Proposed Rule 11.3(b) Suspension of Rules. Subpart (a) of this proposed rule allows the USPTO Director or his designee, in certain circumstances, to suspend or waive any requirement of the proposed rules which is not required by statute. Subpart (b) seeks to limit subpart (a) by making proposed rules 11.19 (disciplinary jurisdiction), 11.24 (interim suspension and discipline based on reciprocal discipline), and 11.100 - 11.901 (Rules of Professional Conduct) not waivable "for any reason". The proposed rules not governed by statute should be waivable at the discretion of the Director in the interest of fairness.

SUBPART B - RECOGNITION TO PRACTICE BEFORE THE USPTO

Patents, Trademarks, and Other Non-Patent Law

Proposed Rules 11.4 through 11.18

Proposed Rule 11.5(b) Registration of Attorneys and Agents in Patent Matters; Practice Before the Office. The proposed rule is confusing and overbroad. First, Rule 11.5(a) defines the register of attorneys and agents and specifies that registration in the Office under the provisions of this Part shall entitle the individuals so registered to practice before the Office only in patent matters. But subsection (b) attempts to define all types of "practice before the Office". Proposed Rule 11.5(b)(1) "Practice before the Office" includes an overly broad definition or identification of matters "connected with the presentation to the Office" such as "conduct of non-patent law." It would appear that there is no statutory authority for the PTO to have jurisdiction to regulate the conduct of non-patent law other than trademark law. "Conduct of non-patent law (aside from trademark law) should not be considered "Practice before the Office."

Similarly overly broad is Rule 11.5(b)(2) which identifies "Practice before the Office" in "patent matters" in an unbounded fashion and includes "considering advisability of relying upon alternative forms of protection that may be available under State law." Advice concerning such alternative forms of protection is a matter of state law over which the PTO does not appear to have any jurisdiction. Further, under state law patent agents are not licensed to provide such advice, and

they should not be permitted to practice such law merely because they are registered to practice before the PTO.

Rule 11.5(b)(3) defines practice before the Office “in private as well as other professional matters” to include conduct reflecting adversely on a person’s fitness to practice law, such as, but not limited to, the good character and integrity essential for a practitioner in patent, trademark, or other non-patent law matters. Thus, the proposed rules define “practice before the Office” to include at least some conduct in private matters. Moreover, because the definition is “not limited to” such conduct, practice before the Office may include almost any conduct. The definition is unnecessary and overreaching. Clarification is required.

Proposed Rule 11.8(d) Oath, registration fee, and annual fee. The proposed rule imposes an annual fee on registered patent agents and attorneys. A long history of diversion of PTO fees exists. The LAIPLA is concerned that these fees will also be diverted rather than paying for the administration of the fee payment program and discipline related costs. At this time, the LAIPLA opposes imposing an annual fee.

This proposed rule further provides that failure to pay the fee shall result in a delinquency fee and “further financial penalties and administrative suspension as set forth in existing Rule 11.11(b)(2).” These further financial penalties and administrative suspension appear unduly harsh and punitive. In the event of an inadvertent failure to pay the fee, or failure to receive a notice to pay the annual fee, the PTO could appear to take the position that papers signed by the practitioner during the period of suspension are invalid, leading to unfair prejudice to the practitioner’s clients. It could be a major undertaking to remedy the unfair prejudice to the practitioner’s clients if a practitioner signed numerous papers while he or she was unknowingly suspended. Before any such punitive measures are imposed, the PTO should ensure that the practitioner was actually served with a notice of a failure to pay the required fee. Such service should be by means more secure than merely mailing a letter, as stated in Rule 11.11(b). In the absence of any provision requiring actual service of a notice of failure to pay, the LAIPLA recommends that the Rule provide that the paper signed is still valid but the practitioner may be permanently suspended.

Proposed Rule 11.10 Restrictions on Practice in Patent Matters. The rule is excessively detailed and cumbersome. Subsection (b)(3) including all the

definitions and examples is better suited to be provided separately as guidelines for applying the rule defined in subsections (a)-(b)(2). Accordingly, the LAIPLA recommends the elimination of subsection (b)(3) from the proposed rule.

Proposed Rule 11.11(d) Voluntary Inactivation. The inactive status provision of this proposed rule requires that a practitioner continue to complete all continuing training programs. Thus, a practitioner on inactive status would have many of the obligations of a practitioner on active status with none of the benefits. Many state bars allow members to go on a voluntary inactive status, and while on inactive status, continuing education requirements are eliminated. This is a reasonable policy, because a practitioner on inactive status will not be practicing and compliance with the continuing education requirements could be unduly burdensome for a practitioner who is ill or out of the country. If the PTO provides for voluntary inactivation, it should eliminate any continuing education requirements for such members.

Proposed Rules 11.12 and 11.13 Mandatory continuing training for licensed practitioners; Eligible mandatory continuing education programs. The proposed rules require continuing education for practitioners and limits eligible continuing education programs to those provided by the PTO or other PTO pre-approved sponsors. Law firms, professional corporations, and corporate law departments are specifically excluded from eligibility to become approved sponsors. Many state bars allow law firms, professional corporations, and corporate law departments to provide state bar approved continuing legal education programs, and such programs have been highly successful. The LAIPLA opposes adoption of the rules excluding law firms, professional corporations, and corporate law firms from providing continuing education. The LAIPLA suggests that if the PTO does impose continuing education requirements, the PTO should credit practitioners with CLE programs that are related to PTO practice or the practitioner must represent that the course is reasonably related to the practice of patent law or to relevant legal issues.

Proposed Rule 11.16 Financial Books and Records. The proposed rule provides that in return for being registered, a practitioner agrees that the OED Director may inspect the financial records of a practitioner. This includes the nonpublic financial

records of a corporation or a law firm. There are several reasons to oppose this rule. First, the financial records may include attorney-client privileged information.

It seems that even the drafter of the proposed rule suspected that it was overreaching and attempted to cure any problems by crafting it as an artificial agreement by the practitioner in consideration for registration. If the financial records are to be open to inspection by the OED, there are no safeguards in the proposed rule that information will be secure, kept confidential and could not be obtained through FOIA requests or be improperly viewed by or reported to other Government agencies. Accordingly, the LAIPLA opposes the adoption of this rule.

SUBPART C - INVESTIGATIONS AND DISCIPLINARY PROCEEDINGS

Jurisdiction, Sanctions, Investigations and Proceedings

Proposed Rules 11.19 through 11.62

Proposed Rule 11.20(a)(2) Disciplinary Sanctions. This portion of the proposed rule sets forth the disciplinary sanctions the USPTO Director may impose on persons other than practitioners. It allows for "dismissing the filing of an application with prejudice". Applicants may be unfairly penalized by another's conduct and thus the LAIPLA opposes the adoption of this portion of the proposed rule.

Proposed Rule 11.22(k) Investigations. This proposed rule would allow the OED Director to request financial books and records during an investigation. The LAIPLA opposes this for the same reasons it opposes proposed Rule 11.16. The Examination of escrow accounts or trust accounts by the OED should be limited to determining whether they comply with Rule 11.115(a).

Proposed Rule 11.22(l) Investigations. This portion of the proposed rule concerns investigations by the OED Director into possible violations of the Rules. It would allow taking a matter to the Committee on Discipline if a practitioner "replies evasively" in the conduct of such an investigation. The phrase "replies evasively" is unnecessarily ambiguous and does not put the public on reasonable notice of what constitutes a violation. The LAIPLA opposes the adoption of this portion of the proposed rule and recommends clarification or striking it from the proposed rule.

Proposed Rules 11.25(a) and (f) Interim Suspension and Discipline. The proposed rules provide for interim suspension and discipline for crimes committed

by practitioners. The proposed rule uses the terms "moral turpitude and "moral turpitude per se". These terms have not been defined. These terms should be specifically defined in proposed Rule 11.1 to place the public on notice. The LAIPLA opposes the adoption of these portions of the proposed rule as presently written.

Proposed Rule 11.39(a) Hearing Officer. The proposed Rule permits the USPTO Director to appoint a hearing officer to conduct disability or disciplinary proceedings under either 5 USC 3105 (administrative law judge) or 35 USC 32 (Director's discretion to designate any attorney who is an officer or employee of the USPTO). This is in contrast to present rules 10.132(c) and 10.129 which provide that the Commissioner will refer the disciplinary proceeding to an administrative law judge. The LAIPLA objects to the proposed rule to the extent it conflicts with the present rules. It is believed that the proceedings should continue to be referred only to administrative law judges to insure public confidence in the proceedings. Federal administrative law judges hold a position with tenure very similar to that provided to federal judges under the Constitution and are better qualified to handle such matters. See Timony, *Performance Evaluation of Federal Administrative Law Judges*, 7 Admin. L.J. A.U. 629, 633-634 (1993).

Proposed Rule 11.49 Burden of Proof. The proposed rule is directed to the standard of proof to be used in disciplinary proceedings. The Office has asked for comments with respect to whether the clear and convincing standard should be changed to a preponderance of the evidence. The LAIPLA does not object to the present clear and convincing standard and finds no compelling reason to change the burden of proof requirement.

Proposed Rule 11.58(b) Suspended or Excluded Practitioner. The proposed rule reduces the time for a disciplined practitioner to wind up his or her affairs to twenty days from the present 30 days in rule 10.158(b)(1). The proposed time period is unreasonable. The LAIPLA proposes the present 30-day time period be maintained. In addition, the filing of the affidavit as required by proposed Rule 11.58(b)(2) should be set at 60 days after entry of the order of suspension, exclusion or exclusion by consent, or of acceptance of resignation because the practitioner or his attorney may require additional time to prepare the required affidavit.

Proposed Rules 11.58(e) and (f) Suspended or Excluded Practitioner. The

Office has asked for comments on whether it should delete the provisions of present rules 10.158(c) and (d) and not adopt proposed rules 11.58(e) and (f). Like the present rules, proposed Rule 11.58(e) provides conditions under which a suspended practitioner could aid another practitioner before the Office and proposed Rule 11.58(f) proscribes reinstatement of a practitioner who has assisted another practitioner unless an appropriate affidavit is filed with the Office. The LAIPLA recommends that a uniform federal rule would be good as provided by the present rules and the proposed rules and PTO practice should continue to be managed by the PTO.

SUBPART D - UNITED STATES PATENT AND TRADEMARK OFFICE RULES OF PROFESSIONAL CONDUCT Proposed Rules 11.100 through 11.806

1. JURISDICTION

The goals of the proposed rules for professional conduct are laudable. Unfortunately, the proposed rules appear overly broad in a number of ways that are inconsistent with the states' jurisdiction over attorney conduct in legal matters having nothing to do with the Office. Moreover, the proposed rules appear to apply to attorneys over whom the Office should have no jurisdiction.

In the proposed rules, the term "practitioners" is defined to mean both patent agents and all individuals who are a member in good standing of the bar of the highest court of a State. This group includes a large number of attorneys who never practice in front of the Office, but who could theoretically record a document or file a trademark. Without including those attorneys never practicing in front of the Office, Rule 11.504(c) would prevent such attorneys from becoming partners with attorneys practicing in front of the Office. Nevertheless, Congress clearly did not intend for the Office to have jurisdiction over the conduct of all attorneys who are members in good standing of a bar in any state.

Furthermore, the practice in front of the Office of many attorneys is limited to a small fraction of their practice. Attorneys practicing state law in state courts should not have their state-law practice regulated by Office rules of conduct. Wherever possible, the concerns of the Office should defer to the well established and already functioning state regulatory schemes concerning the authority and right to practice law. Instead, the proposed rules are so broadly written as to seemingly apply to attorneys over whom the Office has no jurisdiction whatsoever.

Examples of proposed rules that extend to controlling the conduct of all attorneys outside of practice within the jurisdiction of the Office include proposed rules 11.101, 11.102, 11.103, 11.104, 11.105, 11.113, 11.115, 11.116, 11.201,

11.202, 11.203, 11.309, 11.401, 11.402, 11.403, 11.404, 11.501, 11.502, 11.503, 11.504, 11.505, 11.506, 11.507, 11.602, 11.603, 11.604, 11.701, 11.702, 11.703, 11.705 and 11.803.

2. STATE LAW

Most states differ from the model rules in at least some ways, and that number of ways increases when considering that identical statutes can be interpreted differently when enacted in different jurisdictions. It is noteworthy that the states not adopting a substantial portion of the model rules include some of the most populous states, and thus a very large number of practitioners practice under rules that differ substantially from the present proposal.

Even though the proposed rules include a myriad of exceptions for state-law conflicts, they nevertheless have many potential conflicts. Furthermore, the proposed rules effectively enforce an inappropriate unification of professional conduct rules upon attorneys across the nation.

3. MALPRACTICE INSURANCE

Under proposed rule 11.804(a), conduct violating the rules in Subpart D constitutes professional misconduct. Under proposed rule 11.101, even minor and unintended variations from Office practice are a violation of the rules in Subpart D, and under proposed rule 11.803, even incidents that do not appear to reflect adversely on the practitioner's honesty, trustworthiness, or fitness as a practitioner would be a violation of the rules in Subpart D. Given the complexity of practice in front of the Office, and the frequency with which it changes, the likelihood of violating Subpart D is significantly increased under the proposed rules. For example, under proposed rule 11.101(c)(3), professional misconduct would appear to include activities such as using incorrect insertion and deletion of markings in a claim amendment.

Under proposed rule 11.803, conduct violating the rules of Subpart D must be reported. It is well understood that the violation of professional rules of conduct is a touchstone in state law professional liability claims. Therefore, professional liability insurance companies typically require the reporting of any conduct in violation of the applicable rules of professional conduct. The expansion in the scope of professional misconduct to include even minor variations from Office procedures could affect the ability of reasonable practitioners, and particularly small practitioners who are sensitive to insurance costs, to obtain insurance coverage. Such a result does not serve the goals of the Office, the applicants or the practitioners. The PTO needs to offer real justification before implementing rules that will upset the traditional way of conducting business.

4. COMMENTS ON SPECIFIC RULES

Proposed Rule 11.101 Competence. This rule overreaches the jurisdiction of the Office, as discussed above in Section 1. For example, rule 11.101(c)(1) appears to assert jurisdiction over a labor attorney's ability to counsel a client regarding admiralty law if the client has business before the Office on another unrelated matter with another firm. This rule should be restricted in application to a practitioner's competence to practice in front of the Office.

11.101(c)(1)-(4). Per se violations do not allow for factual considerations, and should not be used unless it is impossible for reasonable exceptions to exist. Instead, a list of possible violations could be noted as conduct that might constitute a violation of the competence rule. Such a change allows for the Office to determine competence on a per-case basis when it is necessary and appropriate.

Furthermore, under the proposed per se violations, minor practitioner mistakes, such as those correctable under established patent office procedures, fall within the ambit of incompetent practice. As such, these minor errors constitute professional misconduct under 11.804(a), and are subject to disciplinary action. Also, such minor errors could potentially constitute professional malpractice that must be reported to professional liability carriers any time they occur.

If it is really necessary for the rules to include potentially minor and correctable per se violations (rule 11.101(c)), we support other commentators suggesting that a scienter requirement should be added to these rules.

11.101(c)(1). This proposed rule should not be adopted. A practitioner should be able to consult with an expert that is not a practitioner.

11.101(c)(3). This per se rule gives no consideration to the seriousness of the procedural error or the amount of notice given to the practitioner that the procedures had changed.

Proposed Rule 11.102 Scope of representation. This rule overreaches the jurisdiction of the Office, as described above in Section 1, and should not be adopted.

11.102(a). It is unclear as to whether this is a conflict with 11.101(c)(4).

11.102(c). This rule states that a practitioner may limit the objectives of the representation if the client having immediate or prospective business before the Office consents in writing after full disclosure by the practitioner. This paragraph would appear to place an undue administrative burden on practitioners with little or no tangible benefit to applicants. The rule implies that client representation is unlimited unless the practitioner obtains a written waiver. For example, by requiring a written consent whenever the objective or goal of a client

representation is changed, would practitioners be required to obtain written consents to amend pending patent application claims, to forego novelty searches in certain appropriate circumstances, or to abandon a pending application? The LAIPLA opposes this rule.

11.102(g). This proposed rule should not be adopted.

Proposed Rule 11.103 Diligence and zeal. This rule appears to overreach the jurisdiction of the Office. This rule should be restricted in application to conduct on matters in front of the Office.

Proposed Rule 11.104 Communication. This rule overreaches the jurisdiction of the Office, as discussed above in Section 1. It should be restricted in application to advice and conduct on matters in front of the Office.

11.104(a)(2). The terms "pending" and "prospective" are vague and confusing. Also, this rule is vague and potentially overreaching on well established international business practices, as discussed above in section 3(b). If it calls on the practitioner to inquire into the business relationship between foreign attorneys and their foreign clients, and to interfere in such business relationships when they are not conducted in writing, then it is unnecessarily intrusive, and would be considered offensive in many cultures. Likewise, if it calls on the practitioner to demand direct written contact with the foreign applicants, then it calls upon practitioners to change long established business practices.

Unless the Office is aware of problems with foreign attorneys requesting that practitioners file US applications without the permission of the foreign clients, the breadth of this rule serves no purpose.

11.104(b). The proposed rule should be stricken as overreaching.

Proposed Rule 11.105 Fees. This rule could be interpreted to suggest that practitioners have to estimate a fee for future prosecution. An identification of the practitioner's hourly rate should be sufficient.

This rule will set standards that differ from state law standards in some jurisdictions. Furthermore, it is unclear if attorneys can offer flat rates for certain services, as that rate might be high in relation to the effort expended in one matter,

while low in relation to the effort expended in other. Flat rates are a common practice for some practitioners.

For attorneys practicing under state laws, it is unclear why the attorney should be required to do more than comport with state law on attorney fees.

Proposed Rule 11.106 Confidentiality of information.

11.106(a). We agree with commentators who point out that this proposed rule does not clarify the situation where a practitioner receives information from one client relating to another.

11.106(b)(2). This rule is unclear as to the level of controversy required. It may conflict with state laws.

Proposed Rule 11.108 Conflict of interest: Prohibited transactions. State rules should govern conflicts of interest. Under various state laws, the boundaries of familial relationships may be different. For example, some states recognize various types of domestic partnerships. These distinctions demonstrate that conflicts of interest might be better controlled under each state's rules, which will consider the legal recognition of relationships within that state. This is particularly pertinent to 11.108(c) and 11.108(i).

11.108(e)(2). It is unclear why a practitioner cannot choose to help a client whose cause is worthy. Furthermore, this rule could be interpreted to limit a practitioner's ability to write off time, such as because the time was not reasonable under 11.105. A practitioner should be able to assist a client in order to generate client goodwill, such as by covering a corrective expense when a delay or error was caused by an inventor or inside counsel.

11.108(e)(3). When does the Office envision that a medical examination will be required? The exception allowing the advance of any fee "required to prevent or remedy an abandonment of a client's application by reason of an act or omission attributable to the practitioner" should extend to a remedy for any problem attributable to the practitioner, and not just those required to prevent or remedy an abandonment. For example, if a practitioner delays the filing of an IDS, the practitioner should be able to pay the fee under 37 C.F.R. 1.17(p) for the late filing of the IDS, or if necessary, for a Request for Continued Examination.

11.108(f)(1). In some cases an inventor does not immediately assign an invention to a corporate client that pays for the attorney services. In other cases, a privately held company (owned by an inventor) hires an attorney to prepare and prosecute an application that is never assigned to the corporation. It is unclear if this rule would apply to these situations.

11.108(j). This shouldn't be limited to papers received from "a client". It should cover any situation where papers relate to client's interest.

11.108(j)(2). This rule is overreaching. Civil cases are covered by state laws.

11.108(j)(3). It is unclear if a "patent case" refers to a patent application, or to a suit in federal court.

Proposed Rule 11.109 Conflict of interest: Former client. This proposed rule create unforeseen problems. If one client's patent is cited by the PTO against another client's patent application, there could many issues that arise under this rule.

Proposed Rule 11.110 Imputed disqualification: General rule. It is unclear why state rules should not govern disqualification. Some states could allow ethical walls, which this rule overrules. A better rule would be to require attorneys to operate within the requirements of state rules.

Proposed Rule 11.113 Organization as client. This could apply to any attorney in any practice area, or one not even practicing law (see, Section 1 on Jurisdiction). This rule could conflict with an attorneys' duties under state law. A better rule would be to require attorneys to operate within the requirements of state rules.

Proposed Rule 11.114 Client under a disability. There is no reason state law should not control this issue. A better rule would be: The activities of a practitioner employed or retained by a client under a disability shall comport with state law for the responsibilities of attorneys practicing under the jurisdiction of the state in which the practitioner is practicing.

Proposed Rule 11.115 Safekeeping property. This could apply to any funds

received from any client, so long as that client has even unrelated business in front of the Office (see, Section 1). State rules provide for the protection of client funds and properties. For attorney practitioners, the proposed rules are best fairly redundant and at worst an unwarranted burden on the reasonable practice of attorneys under state law. With the exception of 11.115(b), the entirety of 11.115 would be better off if replaced with an incorporation of state law.

11.115(d)(3). This rule could be interpreted to require complete records of simple property such as extra trademark specimens, which would be an unwarranted record keeping requirement.

11.115(f)(4). The reference to the fiduciary relationship is unclear in this section. Is this meant to imply something more than a client-practitioner relationship?

Proposed Rule 11.116 Declining or terminating representation.

11.116(d). The final sentence could conflict with state law. It should be redrawn to automatically comport with the law of each state.

Proposed Rule 11.117 Sale of practice. Rules restricting the sale of a practice as a single unit is unduly restrictive and beyond the scope of the Office's authority. There is no apparent reason for the Office to regulate the sale of a law practice, and there is a significant possibility for this rule to conflict with state law or interfere with state law jurisdiction.

Proposed Rule 11.201 Advisor. This rule overreaches the jurisdiction of the Office (see, Section 1). It should be restricted in application to advice and conduct on matters in front of the Office.

Proposed Rule 11.202 Intermediary. This rule overreaches the jurisdiction of the Office (see, Section 1). Furthermore, there is no reason state law should not control this issue.

11.202(c). This rule could be interpreted to require a practitioner to withdraw from prosecuting an application simply because two inventors require the assistance of separate attorneys to draft an assignment from one inventor to the other. This section should allow a withdrawing practitioner to continue

representing one side with the informed consent of the other side, confirmed in writing.

11.202(d). "May" should be stricken.

Proposed Rule 11.203 Evaluation for use by third persons. This rule overreaches the jurisdiction of the Office (see, Section 1). It should be restricted in application to advice and conduct on matters in front of the Office, or simply changed to comport with state law.

Proposed Rule 11.303 Candor toward the tribunal.

11.303(a)(3). This rule could be interpreted as requiring practitioners to cite all potentially negative case law in ex parte actions. Also, practitioners could be required to prepare better briefs for an opposing side if the opposing side did not fully support their arguments with case law. Even if not taken to that extreme, this rule could require a practitioner to research the best case law supporting each opposing position, even in situations where little practitioner time is available for such research (e.g., in responding to an office action). In such cases, this is a substantial divergence from present day practice, and substantially burdens the practitioner from the duties of advocating for the client.

11.303(b). This section should include an exception where the disclosure would violate state rules.

11.303(e)(5). This section should be limited to material communications pertaining to practice in front of the Office.

Proposed Rule 11.304 Fairness to opposing party, the Office, and counsel.

11.304(f)(1). This rule should comport with any state law definitions of domestic partnership.

Proposed Rule 11.307 Practitioner as witness.

11.307(a). This rule should be limited to inter parte proceedings.

Proposed Rule 11.309 Advocate in nonadjudicative proceedings. This rule overreaches the jurisdiction of the Office (see, Section 1). Furthermore, there is no

reason state law should not control this issue.

Proposed Rule 11.402 Communication with person represented by counsel.

This rule overreaches the jurisdiction of the Office (see, Section 1). Furthermore, there is no reason state law should not control this issue. It should at least be restricted in application to communications made regarding matters in front of the Office.

11.402(a). As previously noted, the word "prospective" is vague, as any client can eventually have business in front of the Office.

Proposed Rule 11.501 Responsibilities of a partner or supervisory practitioner.

This rule overreaches the jurisdiction of the Office (see, Section 1). Furthermore, too many malpractice and liability issues are created by this rule.

Proposed Rule 11.502 Responsibilities of a subordinate practitioner. This rule overreaches the jurisdiction of the Office (see, Section 1). Furthermore, there is no reason state law should not control this issue. It should at least be restricted in application to matters in front of the Office.

Proposed Rule 11.503 Responsibilities regarding nonpractitioner assistants.

This rule overreaches the jurisdiction of the Office (see, Section 1). Furthermore, there is no reason state law should not control this issue. It should at least be restricted in application to matters in front of the Office.

Proposed Rule 11.504 Professional independence of a practitioner. This rule overreaches the jurisdiction of the Office (see, Section 1). Furthermore, there is no reason to limit law firms to either practitioners or non-practitioners and there is no reason state law should not control this issue.

Proposed Rule 11.505 Unauthorized practice of law. This rule overreaches the jurisdiction of the Office (see, Section 1). Furthermore, there is no reason state law should not control this issue.

Proposed Rule 11.506 Restrictions on right to practice. This rule overreaches the jurisdiction of the Office (see, Section 1). Furthermore, there is no reason state law should not control this issue.

Proposed Rule 11.507 Responsibilities regarding law related services. This rule

overreaches the jurisdiction of the Office (see, Section 1). Furthermore, there is no reason state law should not control this issue. It should at least be restricted in application to matters in front of the Office.

Proposed Rule 11.601 Pro Bono Public service. Per proposed rule 11.100, imperative rules are cast in terms of “shall,” while permissive rules are cast in terms of “may.” Other rules are partly obligatory and partly permissive. The first sentence of this rule is cast in terms of “should.” If the rule reads “shall”, the rule should be withdrawn. Practitioners should not be forced to do pro bono work.

Proposed Rule 11.602 Accepting appointments. Unless the Office is intending to appoint practitioners to tribunals, this rule appears to be entirely unrelated to practice in front of the Office. It also appears to be inapplicable to patent agents, and thus state law covers all relevant practitioners. Furthermore, this rule overreaches the jurisdiction of the Office (see, Section 1) and there is no reason state law should not control this issue. It should at least be restricted in application to matters in front of the Office.

Proposed Rule 11.603 Membership in legal services organizations. This rule is inapplicable to patent agents, and thus state law covers all relevant practitioners where it is not redundant. This rule overreaches the jurisdiction of the Office (see, Section 1). Furthermore, if the Board overrules a decision of a director and that decision is incompatible with a client obligation, the director should not be forced to withdraw from the Board. Such a withdrawal appears to be required by this rule.

Proposed Rule 11.604 Law reform activities. This rule overreaches into legal matters and clients that have nothing to do with practice in front of the Office. This rule overreaches the jurisdiction of the Office (see, Section 1). Furthermore, there is no reason state law should not control this issue.

Proposed Rule 11.701 Communications concerning a practitioner’s services. Because of differences with various states laws, this rule may needlessly complicate communication activities of firms having a wide variety of services to offer clients (see, Section 1). With the exception of 11.701(b)(5), the entirety of 11.701 would be better off if replaced with an incorporation of state law.

11.701(a). This rule should be limited to communications regarding practice before the Office.

Proposed Rule 11.702 Advertising. Because of differences with various states laws, this rule may needlessly complicate communication activities of firms having a wide variety of services to offer clients (see, Section 1). The entirety of 11.702 would be better off if replaced with an incorporation of state law.

Proposed Rule 11.703 Direct contact with prospective clients. This rule may needlessly complicate the direct communications of attorneys at firms having a wide variety of services to offer clients (see, Section 1). The entirety of 11.703 would be better off if replaced with an incorporation of state law.

Proposed Rule 11.704 Communication of fields of practice and certification. The Office would appear to be regulating the ability of federal and state organizations to recognize or certify a specialist in a particular field of law. It also appears to be regulating Admiralty law. Section (e) should be replaced with language to the effect that a practitioner that has been recognized or certified under state or federal law as a specialist in a particular field of law not pertaining to practice in front of the Office may use the recognized or certified designations.

Proposed Rule 11.705 Firm names and letterheads. This rule overreaches the jurisdiction of the Office (see, Section 1). Furthermore, there is no reason state law should not control this issue. This rule may needlessly complicate the naming and operations of firms having a wide variety of services to offer clients.

Proposed Rule 11.803 Reporting professional misconduct. The "appropriate professional authority" should be clearly defined, be it the OED or another body. Also, it should be clear whether this rule trumps a practitioner's duties regarding client confidences under state law and the proposed rules.

11.803(d)(1). This reporting requirement is overly broad, and should be limited to criminal acts that reflect adversely on the practitioner's honesty, trustworthiness, or fitness as a practitioner. Under the proposed rule, a practitioner (regardless of whether they have ever practiced in front of the Office – see, Section 1) must report convictions for misdemeanor civil disobedience, riding a bicycle while under the influence of strong antihistamines, smoking ordinance violations, and a huge variety of other petty incidents that do not appear to reflect adversely on the practitioner's honesty, trustworthiness, or fitness as a practitioner. For example, does one have an obligation to report every time one reviews a file history and discovers a failure to advise the examiner of prior

negative office actions? Does one have a duty to report the examiner? If one reports and is determined to be wrong, is that sanctionable?

11.803(d)(2). A court typically holds that an applicant, rather than a practitioner, engaged in inequitable conduct. A practitioner is not a party to a lawsuit, and has no control over its defense or outcome. Furthermore, it is possible a practitioner would not even be aware of a holding of inequitable conduct within the ten day window for obtaining and filing a certified copy of a court order with the OED Director.

11.803(e)(2). It is not entirely clear that the required certified copy would always be available within ten days. An accommodation should be available if the certified copy takes longer.

11.803(f)(4). This rule appears to recite that being suspended or disbarred as an attorney is a violation of a practitioner's duty to report professional misconduct. Perhaps it should recite that failing to report being suspended or disbarred as an attorney is a violation of a practitioner's duty to report professional misconduct.

Proposed Rule 11.804 Misconduct.

11.804(g). Without a definition of gross misconduct or disreputable misconduct in the rules, this rule is vague. Numerous state jurisdictions could provide different meanings for these terms, thus complicating the interpretation of this rule by practitioners.

11.804(h). Per se rules do not aid in obtaining just results. These should be guidelines that can be considered in light of the facts of a given case. For example, (h)(4) does not take into consideration whether the practitioner knew the former employee was in fact a former employee. Likewise, (h)(9) does not allow for an address change to be lost in the mail, or to be lost by the Office. Similarly, (h)(10) could have factual considerations that weigh against a practitioner having committed misconduct when a filed complaint is found frivolous. At a minimum, a scienter requirement should be added to the per se rules not already containing one.

11.804(h)(8). This should refer to PTO Rules of Professional Conduct, not "professional responsibility."

Proposed Rule 11.805 Disciplinary authority: Choice of law. This is a savings clause that is too little too late. There are concerns throughout this section about conflicts with state laws, for example, state choice of law rules may conflict with these rules on matters of confidentiality, conflicts, and the like. It is also unclear whether deference is up to the tribunal or to be raised by the practitioner. Non attorney practitioners should be subject to a separate section covering choice of law and attorneys would only be subject to PTO rules if there is no conflicting state law, rule or regulation.

Proposed Rule 11.806 Sexual relations with clients and third persons. This rule overreaches the jurisdiction of the Office (see, Section 1). Furthermore, there is no reason state law should not control this issue.

11.806(d). This rule is vague to the extent that most practitioners who are members of a firm could be considered as a participating in the representation of a client (from the standpoint of benefitting from the fees).