

BRIAN G. BODINE
DIRECT (206) 628-7623
brianbodine@dwt.com

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Mail Stop OED-Ethics Rules
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Re: Proposed Changes to 37 CFR Parts 1, 2, 10 and 11

To Whom It May Concern:

I write this letter on behalf of the Washington State Patent Law Association, of which I am currently president. This letter is intended to place the organization's opposition on the record concerning the proposed changes to 37 CFR Parts 1, 2, 10 and 11 (as published in the Federal Register, Volume 68, No.239 on Friday, December 12, 2003).

The Washington State Patent Law Association is an organization serving the needs of more than 200 patent practitioners in and around the Seattle area. We hold periodic continuing education seminars focusing on the changing needs and interests of the patent bar members in the Pacific Northwest. Our members are employed in both private and corporate practice and are actively engaged in the preparation, filing, prosecution and maintenance of patent applications and trademark registrations both domestically and internationally. For these reasons, the proposed rule changes have a direct and immediate impact on our members.

The Washington State Patent Law Association is strongly opposed to the enactment of the proposed rule changes for the following reasons:

1. ***There has been an insufficient showing of the need for the rule changes.*** The Office has failed to provide a sufficient showing that there is a problem that needs to be addressed by the proposed rule changes or that the proposed rule changes are adequately narrow in scope to only address any problem that might be identified. First, there is no data on the extent of the problem being addressed by the rule changes concerning the mandatory continuing legal education (CLE) or the need for

revisions to the code of conduct. It would be appropriate to provide some data on how many members of the public have actually criticized the competence of practitioners and what the breakdown of those practitioners were (attorney versus agent, patent versus trademark). If a problem truly exists it should be focused only on that section of the population of registered practitioners from which it arose. The Supplemental Information notes that of the nearly 28,000 attorneys and agents registered, nearly 80% are attorneys registered to practice in a state or the District of Columbia. The Supplemental Information goes on to note that of these, forty-two of the fifty states represented have adopted the Model Rules of Professional Conduct of the American Bar Association or a modification thereof. Thus, the overwhelming majority of attorneys registered to practice before the USPTO already are subject to one or more codes of ethics and professional conduct. Most of these also have in place rules regarding CLE requirements. It is unclear whether the problem, if any, resides with patent attorneys, patent agents, trademark attorneys or some combination of these. Thus, the proposed rules are believed to be excessively broad and sweeping given the knowledge of the existing problem.

2. ***The rule changes create an unnecessary bureaucracy within the USPTO.*** The establishment of an organization to administer the teaching and certification of CLE is a significant additional cost to an agency that already is having great difficulty meeting its financial needs. Putting into place an organization that is largely redundant with the many fine organizations that currently provide CLE to the patent profession seems at odds with building a stream-lined USPTO. It also assumes, without any data that can be evaluated, that the education currently being offered is somehow insufficient. Many state bar associations already have in place organizations to review and evaluate these educational offerings and decide on whether to grant CLE credit based on these reviews and evaluations. The Office has failed to provide a convincing argument that there would be a benefit to having a redundant organization in place at the USPTO.
3. ***The rule changes add a significant burden to attorneys.*** The Office has made light of the burden the rule changes place on the attorneys. The financial burden of annual fees, the time to take additional CLEs over and above those already required by existing bar associations, and the time and cost for the possible travel to and payment for CLEs are not insignificant when viewed as (more often than not) additive to the existing burden already in place to practice before a state bar and meet that state's CLE requirements. This additional burden would be especially pronounced for sole practitioners and for attorneys practicing in small firms. Numerous attorneys fitting this description are members in the Washington State Patent Law Association. In addition, the proposed rule changes turn a blind eye to the fact that over time many attorneys have specialized in niche areas and many of the facets of the rules lie well outside of the areas within which they practice. Thus, it is possible much of that

which they will need to learn to pass the certification may be useless to them. Finally, there has been a significant investment in having paralegals and administrative assistants become conversant with the intricacies of some of the procedural rules, fees and timelines so as to free the attorneys for more substantive work. To what end is it that testing an attorney on these matters will improve the competencies of the profession? It should not be lost on the Office that state bar associations may require CLEs but they do not require re-examination. The rationale for this onerous requirement, which could result in many senior practitioners leaving the profession rather than having to face the possibility of losing certification, is conspicuously absent from the document and needs to be addressed. At the very least some consideration of grandfathering practitioners of longstanding status without complaint needs to be considered.

4. ***The rule changes are discriminatory against patent practitioners over trademark attorneys.*** It is worth noting that the trademark attorneys are conspicuously not being held to the same standard as patent attorneys under the proposed rule changes. This discrimination is hard to reconcile with the many significant changes taking place in the trademark arena today. The movement to electronic filings, the adoption of the Madrid Protocol and many recent court decisions in this area are but a few of the significant changes facing that profession. Moreover, the logic of requiring one group of attorneys to be held to a lower standard seems to undercut the very principles upon which the imposition of CLE's and recertification was predicated.
5. ***The rule changes undermine the efforts of local associations.*** The application of 11.13(g)(4) seems to undercut the longstanding efforts of law firms and local attorney associations such as the Washington State Patent Law Association to provide CLEs to their constituencies. Many of these firms and associations have a long tradition of providing low cost education of the highest caliber to corporate client law departments and to local peers. For example, within the last year the Washington State Patent Law Association has arranged presentations from speakers from the USPTO, the University of Maryland School of Law, Mercer University School of Law, and Franklin Pierce Law Center concerning a variety of subjects including patent practice before the USPTO, developments in patent law in the Courts, and ethics in patent prosecution and litigation. These presentations have each been approved for CLE credit through the Washington Bar Association. Other local associations have a tradition of providing similar CLEs to their constituencies. The proposed rules would discourage local organizations from providing such services because the reporting and pre-approval process would be onerous to such local organizations, most of which rely on volunteers to conduct their business. The rule changes could undermine the very rationale for having many local patent associations and in the end may result in less informed practitioners by discouraging organizations

Mail Stop OED-Ethics Rules
United States Patent and Trademark Office
February 3, 2004
Page 4

such as the Washington State Patent Law Association from continuing to provide local, cost-effective continuing legal education directed at patent practitioners.

For the reasons stated above, the Washington State Patent Law Association strongly opposes the proposed changes to 37 C.F.R. Parts 1, 2, 10, and 11 announced on December 12, 2003.

Sincerely yours,

Washington State Patent Law Association

Brian G. Bodine
President