



January 7, 2021

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

Via email: CLEguidelines@uspto.gov

RE: CLE Guidelines Request for Comments

Dear Mr. Covey:

Intellectual Property Owners Association (IPO) submits the following comments in response to the USPTO's notice entitled "Proposed Continuing Legal Education Guidelines," published in 85 Fed. Reg. 64128 (October 9, 2020).

IPO is an international trade association representing a "big tent" of diverse companies, law firms, service providers, and individuals in all industries and fields of technology that own, or are interested in, intellectual property (IP) rights. IPO advocates for effective, affordable, and balanced IP rights and offers a wide array of services, including supporting member interests relating to legislative and international issues; analyzing current IP issues; providing information and educational services; and disseminating information to the public on the importance of IP. IPO's mission is to promote high quality and enforceable IP rights and predictable legal systems for all industries and technologies. Our vision is the global acceleration of innovation, creativity, and investment necessary to improve lives.

Improving patent quality is an essential aspect of the USPTO's mission. But the connection between practitioners certifying continuing legal education credits earned and improving patent quality seems attenuated. Moreover, the creation, implementation, and promulgation of CLE guidelines will increase the budget of the Office of Enrollment and Discipline while providing minimal benefit to the public and practitioners.

Note that the answers to the questions posed in the request, below, are made in the context of the proposed voluntary program and would likely change if a CLE requirement were proposed.

Topic 1: Subject Matter of Courses Qualified for USPTO Patent CLE Credit

Overall, properly educating practitioners on legal issues at the intersection of patent law and other areas of law would benefit the public as well as practitioners, by enabling attorneys to answer clients' basic legal questions and refer matters as appropriate to attorneys specializing in other areas of law. Qualifying subject matter could encompass any legal topics that could intersect with patent law. Practitioners frequently field patent questions that relate to other legal areas including family law, bankruptcy law, licensing law, probate law, and due diligence activities, and there might be relevant educational opportunities in those or other areas of the law

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that tangentially involve patents. Additionally, there are relationships between patent law and other areas of IP law, and it is important for practitioners to understand the basics of each to best assist their clients in determining whether a patent is the best vehicle to achieve the desired protection.

We recommend that the Office carefully consider the ethical and malpractice issues that could arise in connection with approving CLE for agent practitioners on topics not currently within the scope of practice before the USPTO. Patent agents are not licensed by any state bar and are not authorized to engage in the practice of law. Educating agents on a range of legal topics unrelated to patent law might lead some to provide unauthorized advice beyond the scope of practice before the Office, which likely would not be covered by malpractice insurance. To avoid these issues, the USPTO could consider approving certain courses for patent attorneys only or labeling CLE courses on topics outside those enumerated in 37 C.F.R. § 11.5(b)(1) as such.

Topic 2: Other Activities That May Qualify for USPTO CLE Credit

The USPTO proposes that up to two of five credits of CLE may be obtained by participating in the Patent Pro Bono program. IPO fully supports pro bono efforts to help qualifying inventors obtain patents on their inventions and encourages our members to participate in pro bono activities. However, crediting pro bono hours as CLE does not further the objective of improving patent quality through improved practitioner education—pro bono work is no different than any other work practitioners undertake before the Office. Although it might incentivize practitioners to volunteer their time pro bono, it provides no educational benefit to practitioners beyond additional practice experience and should be removed from the final rule.

A mandatory pro bono requirement, should the USPTO desire to implement one in the future, could be difficult for patent practitioners to fulfill. Pro bono opportunities in patent law can be difficult to find because inventors comprise a much smaller portion of the population than those who seek legal assistance through community legal services initiatives or other legal aid services. If a pro bono requirement were implemented, there might not be enough individuals seeking assistance to allow every registered practitioner to meet that requirement. Also, establishing a process for cataloging the pro bono efforts of practitioners could become complex and would require the investment of additional resources by the Office. Finally, there are malpractice issues related to counseling pro bono, particularly for in-house attorneys who do not carry malpractice insurance.

On a different topic, we suggest that a practitioner who is paid for a speaking engagement on a CLE-eligible topic should be eligible to receive USPTO CLE credit. Educating practitioners advances the USPTO's goal of improving patent quality through practitioner education, and receiving remuneration for speaking should not exempt practitioners from receiving CLE credit.

Topic 3: Providers of USPTO Patent CLE

We suggest that any CLE provider should be permitted to apply for USPTO CLE credit for their educational programs, and that the USPTO should not be the sole approved provider. Approving courses offered by non-USPTO providers would be inexpensive and efficient to implement and would minimize the burden on practitioners by allowing them to earn USPTO CLE credit for

participating in IP educational programs in which they already participate. It would also facilitate the availability of CLE opportunities on a wider range of subject matter and prevent a focus on examiner-related issues that might be less relevant to practitioners.

Topic 4: Form of Recognition for Practitioners Who Certify Completion Of CLE

We suggest identifying certifying practitioners by placing a simple asterisk or star next to a practitioner's name on the OED register, with a legend indicating the symbol means a practitioner has completed the voluntary CLE certification.

Question 6: Are There Any Other Issues or Concerns That the USPTO Should Consider Regarding CLE Guidelines?

For USPTO-sponsored CLE programs, we recommend including speakers from outside the USPTO to ensure that content is relevant to practitioners.

We are interested in whether the USPTO will grant CLE credit for live and interactive programs, self-study, or both. We suggest the USPTO grant credit for both to provide flexibility for practitioners and to increase the number of opportunities to obtain CLE credit. We are also interested in whether the USPTO will require practitioners to pay a fee to participate in CLE programs provided by the USPTO, and if so, how the fees will be used.

We have concerns that a voluntary CLE program is a first step toward establishing a CLE requirement. Mandatory CLE is a feature of nearly every mandatory bar association in the U.S., and it is unclear that implementing a redundant requirement for registered attorneys will further the USPTO's goals of producing higher quality patent applications, increasing efficiency of prosecution, and strengthening ultimate patent grants (84 Fed. Reg. 37415). A CLE requirement would add to attorney practitioners' existing reporting requirements and create a new requirement for agents. Creating a mandatory CLE program would also be burdensome on the USPTO.

Establishing voluntary CLE certification could create a mechanism for automatically removing practitioners from the roster for failing to meet a CLE requirement in the future. We suggest that the public is unlikely to benefit from a culling process that would result in fewer practitioners available to assist inventors and that culling the register in this manner is unlikely to improve patent quality.

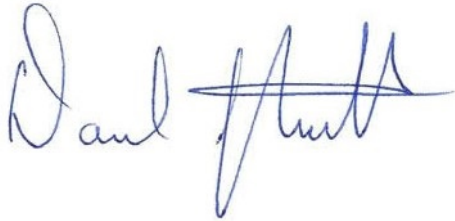
Were the USPTO to propose a CLE requirement in the future, we would have several questions about the impact on a practitioner for failing to make the CLE certification, the impact on an applicant whose practitioner fails to comply, whether the USPTO will provide a grace period, and similar issues. We will hold those questions in abeyance but request that the USPTO provide a detailed overview of any mandatory CLE program, and particularly the consequences for non-compliance, if one is proposed in the future. In the meantime, we suggest that the USPTO seek to identify solutions more directly related to improving the quality of practitioner work product.

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Even a voluntary CLE program will increase USPTO expenses. The costs associated with running a CLE approval program and creating a website where practitioners can report credits, and the possible future cost of disciplining noncompliant practitioners should the CLE program become mandatory, do not seem justified by a benefit to the Office measurable in dollars and cents. We are concerned the cost of administering the program eventually will be borne by practitioner registration fees that the Office has delayed but intends to implement in the future. If the Office moves forward with the voluntary CLE program, we recommend pursuing the least expensive and time-consuming approach and minimizing the added burden for practitioners, as discussed in our suggestions above.

Thank you for considering our comments. We welcome further dialogue or opportunity to provide additional information to assist your efforts.

Sincerely,

A handwritten signature in blue ink, appearing to read "Daniel Staudt". The signature is fluid and cursive, with a long horizontal stroke extending from the end.

Daniel Staudt
President