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Docket: PTO-P-2020-0042
Proposed Continuing Legal Education Guideline

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

Document: PTO-P-2020-0042-DRAFT-0008
Comment on FR Doc # 2020-22420

Submitter Information

Name: June Besek ABA-IPL

General Comment

Mail Stop-OED,
Director of the United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: William Covey, Director for the Office of Enrollment and Discipline, CLE
Guidelines Request for Comments 2020

Re: Comments in response to the Notice of Proposed Rulemaking
entitled: Proposed Continuing Legal Education Guidelines: (Federal
Register / Vol. 85, No. 197/ Friday, October 9, 2020)

Dear Sir:

As Chair of the American Bar Association Section of Intellectual Property Law (the "Section"), I am writing on behalf of the Section to provide comments in response to the Request for Comments related to the proposed CLE guidelines of the United States Patent and Trademark Office ("the Office") entitled: Proposed Continuing Legal Education: (Federal Register / Vol. 85, No. 197/ Friday, October 9, 2020) (hereinafter, "Proposed CLE Guidelines"). The views expressed herein are presented on behalf of the Section of Intellectual Property Law.

Since 1894, the ABA-IPL Section has advanced the development and improvement of intellectual property laws and their fair and just administration. As the forum for rich perspectives and balanced insight on the full spectrum of intellectual property law, the Section serves within the ABA as a highly respected voice within the intellectual property profession, before policy

makers, and with the public. The ABA-IPL Section membership includes attorneys who represent trademark owners, accused infringers, small corporations, universities, and research institutions across a wide range of industries.

The Section generally supports the Office in fostering and encouraging registered patent practitioners to complete a recommended number of CLE hours in patent law and practice, including ethics. Accordingly, the Section supports the stated goals of the Proposed CLE Guidelines to (1) clarify the types of CLE classes or activities that will qualify for USPTO CLE credit; (2) establish procedures for approving CLE courses; and (3) establish the type of recognition patent practitioners will receive if the patent practitioners certify completion of the CLE requirements.

The Section generally favors the approach suggested by the Office, subject to the concerns it expresses in its responses below to the six questions identified in the Proposed CLE Guidelines.

Please see the entirety of comments in the enclosed PDF.

The Section gratefully acknowledges the efforts by the Office to formulate reasonable USPTO CLE guidelines. The aforementioned comments have been provided in the spirit of making proposed changes in a way that is compatible with the needs of our members. We thank the Office for the opportunity to provide comments on the Notice. If the Office has any questions regarding the Section's comments, please feel free to contact me. Either I or another member of the leadership of the Section will respond to any inquiry.

Sincerely,

June M. Besek Chair
ABA Section of Intellectual Property Law

Attachments

ABA-IPL Comments to USPTO in response to NPRM re CLE guidelines



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January 6, 2021

Via Electronic Mail: CLEguidelines@uspto.gov

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Since 1894, the ABA-IPL Section has advanced the development and improvement of intellectual property laws and their fair and just administration. As the forum for rich perspectives and balanced insight on the full spectrum of intellectual property law, the Section serves within the ABA as a highly respected voice within the intellectual property profession, before policy makers, and with the public. The ABA-IPL Section membership includes attorneys who represent trademark owners, accused infringers, small corporations, universities, and research institutions across a wide range of industries.

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hours in patent law and practice, including ethics. Accordingly, the Section supports the stated goals of the Proposed CLE Guidelines to (1) clarify the types of CLE classes or activities that will qualify for USPTO CLE credit; (2) establish procedures for approving CLE courses; and (3) establish the type of recognition patent practitioners will receive if the patent practitioners certify completion of the CLE requirements.

The Section generally favors the approach suggested by the Office, subject to the concerns it expresses in its responses below to the six questions identified in the Proposed CLE Guidelines.

1. What course topics should qualify for USPTO patent CLE credit?

The goal of the USPTO CLE requirements should be to improve a patent practitioner's practice before the Office. Accordingly, any CLE course that furthers this goal should qualify for USPTO patent CLE credit. Thus, in addition to the course topics listed in section II(A)(1) of the Guidelines, the Section recommends that the following topics should also qualify for USPTO CLE credit:

- Persuasive writing (a persuasive writing course can provide a patent practitioner with a better grasp of grammar or techniques for succinct, direct, and descriptive writing)
- Oral advocacy (oral advocacy could be beneficial to patent practitioner, such as for Examiner interviews and advocacy before the PTAB)
- A CLE course addressing a court decision pertaining to a patent-related issue (e.g., patent cases decided by the Court of Appeals for the Federal Circuit can provide valuable guidance to patent practitioners)
- A CLE course on any matter relating to ethics and the practice of law or practice before the Office (e.g., ethics on substantive law, client-patent practitioner relationship, etc.)

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?

As mentioned above, the goal of the USPTO CLE requirements should be to improve a patent practitioner's practice. Accordingly, the Section recommends that any CLE course that furthers this goal should qualify for USPTO patent CLE credit.

The Section recognizes that many patent-related CLE courses include both patent and non-patent related content. Examples include CLEs discussing patentability and trade secret protection, or design patent and trade dress protection. These mixed-subject-matter courses are important to educate patent practitioners for "consulting with or giving advice to a client in contemplation of filing a patent application or other document with the Office," as specified in 37 CFR 11.5(b)(1). The Section recommends that the Proposed CLE Guidelines clarify that CLE courses containing both patent-related and non-patent related content qualify for USPTO CLE credit even though the entirety of the content is not directed to patent practice before the Office.

3. What activities should qualify for USPTO CLE credit, either in patent law and practice or ethics?

As previously stated, the Section is concerned that the USPTO’s proposed model of three hours of pro bono service to obtain one hour of CLE credit does not sufficiently emphasize the importance of pro bono service. Therefore, the Section supports providing one hour of CLE credit for one hour of pro bono service in the USPTO Patent Pro Bono Program. For example, patent practitioners who engage in pro bono service will certainly provide more than two hours of pro bono service for a given pro bono assignment. A one-to-one approach would encourage more patent practitioners to provide pro bono services and as such contribute to the overall pro bono legal services provided in a given year.¹

The Guidelines state that “Practitioners may earn [USPTO CLE credit] for either speaking at a *USPTO-accredited CLE course* or preparing written materials for such a CLE course.” The Section supports providing USPTO CLE credit for either speaking at or preparing written materials for “USPTO-accredited CLE courses,” but would like clarification of the term “USPTO-accredited CLE course.” For example, it is unclear whether a USPTO-accredited CLE course is any CLE course that falls within the scope of section II(A) of the Proposed CLE Guidelines, or whether it is a CLE course that the USPTO has explicitly accredited. The Section advocates for the broader definition so that a patent practitioner would receive USPTO CLE credit for any CLE course that falls within the scope of section II(A) of the Proposed CLE Guidelines.

4. Should organizations or providers outside the USPTO be authorized to deliver USPTO CLE courses? If so, how should such courses be approved?

The Section recommends that the USPTO should recognize any course on “Patent Law and Practice” that has been approved for CLE credit. Relevant CLE courses that are approved or qualify for CLE credit pursuant to rules of a jurisdiction, for example, by a state bar, should receive automatic approval for USPTO CLE credit.

The Section believes that organizations and providers outside of the USPTO should be authorized to deliver USPTO-approved CLE courses. Allowing other organizations or providers outside the USPTO will encourage patent practitioners to attend CLE courses that are in-person, interactive, and generally provide for a robust discussion that can be lacking via presentations via the Office virtual venue. Further, allowing a broader group of organizations and providers to deliver USPTO-approved CLE content will expand the range and type of content available for practitioners as well as increase the number of CLE courses available to meet practitioner schedule needs.

¹ The ABA Model Rules of Professional Conduct encourages every lawyer to provide legal services to those unable to pay and aspire to provide at least 50 hours of pro bono legal services per year. ABA Model Rule 6.1.

5. In what manner should the USPTO recognize practitioners who make the CLE certification on their mandatory registration statement?

The Section recommends using the register of active patent practitioners maintained by the OED to recognize a practitioner's compliance with the USPTO CLE requirements. Existing practitioners are familiar with the format and details of the register, and the register is freely searchable by the public. This provides a convenient, searchable record for interested parties.

6. Are there any other issues or concerns that the USPTO should consider regarding the CLE guidelines?

The Section recommends that the Office consider broad categories for CLE requirements as opposed to seeking to narrow the courses that are approved for USPTO CLE credit as indicated in responses to the questions above in response to Questions 2 and 3.

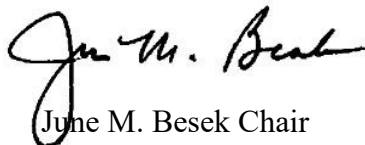
Additionally, the Section encourages the Office to keep records for patent practitioners that attend USPTO-led CLE courses. Records compliance maintained by any entity or agency authorized in a jurisdiction, for example, a state bar that requires and maintains a registry of CLE for licensed attorneys, should suffice to meet the record keeping burden proposed by the Office and the OED.

Conclusion

The Section gratefully acknowledges the efforts by the Office to formulate reasonable USPTO CLE guidelines. The aforementioned comments have been provided in the spirit of making proposed changes in a way that is compatible with the needs of our members. We thank the Office for the opportunity to provide comments on the Notice.

If the Office has any questions regarding the Section's comments, please feel free to contact me. Either I or another member of the leadership of the Section will respond to any inquiry.

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June M. Besek Chair
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