

AIPLA

American Intellectual Property Law Association

January 26, 2022

Via Federal eRulemaking Portal: www.regulations.gov

Mr. William R. Covey, Esquire
Deputy General Counsel for Enrollment and Discipline
and Director of the Office of Enrollment and Discipline
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Re: Comments in response to the Request for Comments entitled: *Expanding Admission Criteria for Registration to Practice in Patent Cases Before the United States Patent and Trademark Office* (Vol. 87, No. 200 *Federal Register*, Tuesday, Oct. 18, 2022, Request for Comments) Docket No.: PTO-C-2022-0027

Dear Director Covey:

The American Intellectual Property Law Association (the “AIPLA”) is pleased to offer its comments in response to the *Expanding Admission Criteria for Registration to Practice in Patent Cases Before the United States Patent and Trademark Office* (“Request for Comments”).

Founded in 1897, the American Intellectual Property Law Association is a national voluntary bar association of approximately 7,000 members who are engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public’s interest in healthy competition, reasonable costs, and basic fairness.

AIPLA appreciates the USPTO’s interest in soliciting feedback and information on potentially revising and improving the criteria for registration to practice before the USPTO in patent matters. AIPLA has previously submitted comments related to this topic, including comments regarding Category A degrees, as well as Accreditation Board for Engineering and Technology (ABET) accreditation, among others. AIPLA’s comments in this letter provide suggestions regarding the proposal for a design patent bar, and efforts that can be undertaken by the Office of Enrollment and Discipline (OED) and the USPTO to ensure fair and appropriate criteria for registration to practice.

A diverse intellectual property ecosystem requires an inclusive system that affords opportunity for innovation and practice. The “patent bar” should be as diverse as the inventors they

represent, and include individuals from different genders, races, cultures, religions, and other factors who are competent to practice before the USPTO. AIPLA applauds the USPTO for continued efforts to advance and create an equitable innovation system.

Request 1: Require the USPTO to Periodically Review Applicant Degrees and Add Commonly Accepted Category B Degrees to Category A on a Predetermined Timeframe

AIPLA appreciates the USPTO's willingness to periodically review applicant degrees that qualify under Category B, and allow them to qualify under Category A. We believe that a review at least every three years is appropriate to keep up with changes in technology and innovation. AIPLA suggests that this process be transparent and open to the public. For example, with the advent of virtual webinars, OED can publish a proposal and provide historical data regarding degrees, statistics regarding the taxonomy of such degrees, and their prevalence. In turn, the public, including practitioners, registration applicants, and inventors can provide crucial feedback.

Request 2: Modify the Accreditation Requirement for Computer Science Degrees Under Category A to Accept Bachelor of Science Computer Science Degrees.

AIPLA understands that the requirements for ABET accreditation of Computer Science programs do not appear to be different from those required by general college and university accreditation organizations. *See generally*, <https://www.abet.org/accreditation/what-is-accreditation/eligibility-requirements/>. While the specific criteria include a requirement of fifteen credits in mathematics, it is unclear what the purpose of such a requirement is when it is not otherwise required under Category B. Further, mathematics is not a Category A degree. As such, AIPLA respectfully believes that any Computer Science degree awarded by an accredited college or university should qualify for Category A treatment, without an additional mathematics requirement. This would broaden access to patent practitioners in one of the fastest growing areas of patent prosecution and innovation.

Request 3: Possible Creation of a Separate Design Patent Practitioner Bar

AIPLA supports, appreciates, and encourages initiatives to diversify the Patent Bar. AIPLA believes that efforts to diversify the Patent Bar will provide a range of benefits, leading to a higher-quality system, and improved representation of clients and the public interest before the USPTO. The current system for registering patent attorneys and agents to practice before the USPTO provides a workable framework that serves the interest of the public and the USPTO. Establishing a new, separate design patent practitioner bar is a substantial undertaking that could potentially: (i) cause confusion and increase costs to the public; (ii) add significant administrative and policing costs to the USPTO; and (iii) increase the risk of potential malpractice and ethical concerns.

The Request for Comments discusses the main proposal for the creation of a separate design patent practitioner bar, along with three specific options for its implementation. AIPLA does not support the creation of a separate design patent practitioner bar for the following reasons.

Creating a separate bar for design patent practitioners does not serve the public interest. Members of the public may already experience confusion between different intellectual property rights (*i.e.*, patent, trademark, copyright, trade secrets, and data rights). Understanding the nuances between design patents and utility patents and finding counsel who has a specific

patent licensure is burdensome. Splintering licensure like this may cause confusion to the public and increase the cost of identifying appropriate counsel. Particularly because patent rights are subject to a one-year statutory bar, timing is critical. A single designation of Registered Patent Practitioner better serves the public interest by reducing the potential for confusion and cost.

Administering and maintaining separate registration records for a design patent bar is a substantial undertaking. This could impose additional logistical and financial burdens on the USPTO and the Office of Enrollment and Discipline. Creating a separate design patent bar, beyond splintering the patent bar, could also create policing issues, sanctioning practitioners who overreach and advise on a type of patent for which they are not specifically qualified. This could generate liability when they are merely advising the client on available alternatives. *See generally*, 37 CFR 11.5. A separate design patent bar also has the potential to create malpractice issues, where a design patent-only practitioner fails to identify and advise clients on the availability of utility patent protection for the subject matter.

The public benefits from having patent counsel who can advise on *both* design and utility patent protection. Design patents and utility patents are inextricably intertwined. There is substantial overlap between design patents and utility patents in their respective governing laws, regulations, and procedures. The Patent Act expressly provides: “[t]he provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.” 35 U.S.C. §171. Further, the Code of Federal Regulations acknowledges this interrelation stating that: “[t]he rules relating to applications for patents for other inventions or discoveries are also applicable to applications for patents for designs except as otherwise provided.” 37 CFR 1.151. Priority claims under 35 U.S.C. §120 and §119 are also permitted from a utility patent application to a design patent application, and *vice versa*. Prosecuting design patent subject matter frequently requires considering counterpart utility patent subject matter. One study found that 40% of design patent inventors are also named as inventors of utility patents. *See The Arts, New Growth Theory, and Economic Development*, Brookings Institution, May 2012.

The U.S. Patent Act encompasses utility patents, design patents, and plant patents. Registered Patent Practitioners serve as an intermediary between the public and the USPTO for matters regarding the Patent Act. While being a Registered Patent Practitioner does not certify competency to work on all technical subject matter before the USPTO, competence to handle the work is already a requirement for all attorneys in all practice areas. *See generally*, 37 CFR 11.101. USPTO registration assures the public and the USPTO that the individual is competent to work within the patent system, including a solid understanding of patent-specific laws, regulations, and procedures.

Request 4: Clarifying Instructions in the General Requirements Bulletin for Limited Recognition Applicants

AIPLA believes the desire of OED to update the General Requirements Bulletin (*i.e.*, subregulatory guidance) to conform to agency practice is commendable. We understand this information is currently available to grantees of limited recognition within their grant. However, AIPLA suggests that the USPTO explore whether a rule change may be required to put applicants and grantees on notice.

Request 5: General Request for Additional Suggestions on Updating the Scientific and Technical Requirements for Admission to Practice in Patent Matters

AIPLA appreciates that the USPTO is soliciting further efforts to update the scientific and technical requirements for admission. First and foremost, as a way to increase DEI representation in the patent profession, AIPLA recommends more active engagement and recruitment of DEI candidates with Category A or Category B qualifications. Each year, the U.S. awards about 700,000 STEM degrees, the large majority of which would likely qualify under Category A. In 2017, 50% of those degrees were awarded to women; 9% to African Americans, 15% to Latinx individuals. All told, per year, there are about 300,000 STEM degrees awarded to DEI candidates. In comparison, there are only approximately 1,200 newly registered USPTO attorneys/agents per year.

Recruiting even a small percentage of the eligible DEI candidates under Category A per year would substantially increase DEI representation in the patent bar. For example, empowering graduates with knowledge of this opportunity and career path while in a university could expand the talent pool. As such, AIPLA recommends that more effort and investment be made in outreach, to encourage these DEI candidates with Category A or Category B credentials to become registered patent practitioners.

Conclusion

AIPLA gratefully acknowledges the efforts by the USPTO to improve and revisit the requirements and criteria for registration to practice in patent matters before the USPTO. Thank you for this opportunity to comment, and we are happy to discuss this issue further.

Sincerely,

A handwritten signature in blue ink, appearing to read "B. Batzli".

Brian H. Batzli
President
American Intellectual Property Law Association