



## American Intellectual Property Law Association

August 3, 2023

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

Via Federal eRulemaking Portal: [www.regulations.gov](http://www.regulations.gov)

Re: **Comments in response to the Notice of Proposed Rulemaking entitled:  
*Changes to the Representation of Others in Design Patent Matters Before  
the United States Patent and Trademark Office (Vol. 88, No. 94 Federal  
Register, Tuesday, May 16, 2023) Docket No.: PTO-C-2023-0010***

Dear Director Covey:

The American Intellectual Property Law Association (the “AIPLA”) is pleased to offer its comments in response to *Changes to the Representation of Others in Design Patent Matters Before the United States Patent and Trademark Office* (“NPRM”). These comments supplement our [January 26, 2023 letter](#) responsive to the USPTO’s Request for Comments (*Expanding Admission Criteria for Registration to Practice in Patent Cases Before the United States Patent and Trademark Office*).

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 revising the standards and eligibility to practice before the USPTO in patent matters. AIPLA previously submitted a number of comments related to this topic, including regarding expanding eligibility criteria, diversity initiatives, and updates to Category A requirements from the General Requirements Bulletin. The comments of AIPLA, address our organization’s continued concerns regarding the proposal for a design patent bar, and

efforts that can be undertaken by OED and the USPTO to ensure fair and appropriate criteria for registration to practice in patent matters. AIPLA is committed to diversity, equity, and inclusion and maintains those core values in both a Diversity Statement, and the efforts undertaken to improve access to the IP system for inventors and practitioners alike.<sup>1</sup> However, we believe that a design patent bar does not further such interests.

### **A Design Patent Bar Is Not Needed**

As an organization, AIPLA remains concerned about this proposal because it could splinter an already confusing marketplace of intellectual property attorneys—causing harm for unsophisticated users of the legal system. Without restating our prior comments, we reiterate our belief that practitioners, clients, and the public would not benefit from a design patent bar. Instead, AIPLA suggests that the USPTO focus efforts to expand admission criteria in other ways, as well as focus efforts on creating a pipeline of diverse candidates through the education system and into the job market.<sup>2</sup>

In the event the USPTO ultimately proceeds in creating a design patent bar in a Final Rule, we provide comments below regarding additional issues we believe should be considered.

### **Additional Study**

In order for AIPLA, members of the public, and the patent bar to properly participate in this rulemaking process, AIPLA believes the Office should provide more information on the basis and purpose of this rulemaking, including further studies of this issue, its impact on applicants/clients, and its overall effect on an efficient and reliable patent system.

### **Educational Criteria**

The NPRM states that an “applicant should have a bachelor's, master's, or doctorate of philosophy degree in any of the following areas from an accredited college or university: industrial design, product design, architecture, applied arts, graphic design, fine/studio arts, or art teacher education, or a degree equivalent to one of the listed degrees.” Yet, the criteria for USPTO Design Patent Examiners include these degrees, as well as further option that appears to be related to Category B of the General Requirements Bulletin. AIPLA suggests clarification regarding whether the USPTO will similarly accept candidates with coursework within these categories and/or work experience, as currently accepted for USPTO employment. *See, e.g.*, Office of Personnel Management, Design Patent Examining Series 1226, Individual Occupational Requirements.

Additionally, under the current design patent bar proposal, design patent applications would be best prosecuted by individuals with specific industrial or product design expertise, rather than a

---

<sup>1</sup> See <https://www.aipla.org/about/about-us/Diversity-Statement>.

<sup>2</sup> AIPLA understands that very low numbers of diverse candidates come from within the design fields. *See, e.g.*, Reuther, Karen Korellis, *Shrink It and Pink It: Gender Bias in Product Design*, Harvard Advanced Leadership Initiative, Social Impact Review (October 25, 2023) (19 percent of practicing industrial designers are women).

general art background. Therefore, AIPLA suggests that “a degree equivalent to one of the listed degrees” be carefully interpreted.

### **Public Protection**

AIPLA believes one of the most critical issues with a design patent bar is the protection of the public. While we believe that the USPTO Rules of Professional Conduct and the USPTO Rules of Practice in Patent Cases will appropriately guide a design practitioner’s conduct, there are additional concerns related to confusion by prospective clients and the public with respect to design practitioners. We provide below two examples of such potential confusion.

#### *Use of “Design” Designation Does Not Imply Specialization*

Some AIPLA members have expressed concern that practitioners may claim, or that clients may inappropriately believe, that design practitioners have *specialized* skills, training, or approval beyond traditional patent practitioners, providing them with expertise in design. AIPLA urges the USPTO to consider whether design practitioners must indicate any limits on their authorization to practice, such as “practice limited to design, not including other invention, patents”. This would be consistent with the USPTO’s ethics rules. *See, e.g., 37 CFR 11.704(d).*

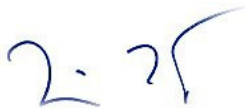
#### *Registration Number*

In addition to the concerns raised in the preceding paragraph, AIPLA believes it is imperative that any registration number provided to design practitioners make clear that such practitioners are not “full patent practitioners.” As such, we believe that considering a limited-recognition type designation, along with a preceding letter would be appropriate. We note that the letter “D,” while seemingly relevant, could cause confusion with the nomenclature used for issued design patents. As such, AIPLA proposes a designation such as “DP” for design practitioners.

### **Conclusion**

AIPLA gratefully acknowledges the efforts by the USPTO to improve and examine criteria for registration to practice in patent matters before the USPTO. We thank you for the opportunity to provide such comments and are happy to discuss further.

Sincerely,



Brian H. Batzli  
President  
American Intellectual Property Law Association