May 16, 2007

VIA ELECTRONIC MAIL ADDRESSED TO:
ethicsrules.comments@uspto.gov

Mail Stop OED-Ethics Rules
Attn: Harry I. Moatz
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Re: Notice of Proposed Rulemaking
Changes to Representation of Others Before the
United States Patent and Trademark Office
72 Federal Register 9196 (February 28, 2007)

Dear Mr. Moatz:

Invention Submission Corporation ("ISC") wishes to submit the following comments to the changes proposed by the United States Patent and Trademark Office ("PTO") in the above referenced notice ("Revised Proposed Rules"). The changes set forth in the above referenced notice are revisions to proposed rules that were originally published in a Notice of Proposed Rulemaking on December 12, 2003, at 68 FR 69442 ("Original Proposed Rules"). Several of the Original Proposed Rules were adopted by the PTO as final rules on July 26, 2004. ISC's comments on the Revised Proposed Rules follow below.

Subpart B - Recognition to Practice Before the USPTO

§ 11.5(b) - Practice Before the Office

Section 11.5(b) of the Original Proposed Rules provided an unnecessarily-broad definition of what constitutes "practice before the Office." That definition included all law-related services in connection with a presentation to the PTO, such as communicating with clients concerning matters contemplated to be presented before the PTO.

ISC commented on the original proposed § 11.5(b) that a person who may have prospective business before the PTO may want to utilize both lay and legal service providers in connection with his invention, including nonlawyers who merely assemble information to provide nonlegal services at a much lower cost than practitioners would charge. ISC indicated that by defining "practice before the Office" so broadly in the Initial Proposed Rules, as to include services that are merely law-related, and then threatening disciplinary action against practitioners who are aided by others in presentations before the PTO, the PTO was attempting to prevent practitioners

from accepting referrals from non-practitioners such as invention promoters.
Section 11.5(b) of the Revised Proposed Rules continues to provide a broad definition of "practice before the Office."

In this regard, ISC has highlighted below the objectionable verbiage in Revised Proposed Rule § 11.5(b) which places unnecessary and improper restrictions on practitioners who may work with non-practitioners who have communicated or consulted with clients who may decide to file documents with the PTO:

> (b) Practice before the Office. Practice before the Office includes, but is not limited to, law-related service **that comprehends any matter connected with the presentation to the Office** or any of its officers or employees relating to a client's rights, privileges, duties, or responsibilities under the laws or regulations administered by the Office for the grant of a patent or registration of a trademark, or for enrollment or disciplinary matters. Such presentations include preparing necessary documents **in contemplation of filing the documents** with the Office, corresponding and communicating with the Office, and representing a client through documents or at interviews, hearings and meetings, **as well as communicating with** and advising **a client concerning matters** pending or **contemplated to be presented before the Office**. Nothing in this section proscribes a practitioner from employing non-practitioners assistants under the supervision of the practitioner to assist the practitioner in preparation of said presentations:
>
> > (1) *Practice before the Office in Patent Matters*. Practice before the Office in patent matters includes, but is not limited to, preparing and prosecuting any patent application, **consulting with** or giving advice to **a client in contemplation of filing a patent application or other document with the office**, . . .

A person who may have prospective business before the PTO may want to utilize both lay and legal service providers in connection with his invention, including non-practitioners who merely assemble information to provide nonlegal services at a much lower cost than practitioners would charge. By defining "practice before the Office" so broadly in the Revised Proposed Rules, as to include services that are merely law-related or performed in contemplation of filing a patent application, and then threatening disciplinary action against practitioners who are assisted in these presentations before the PTO, the PTO is attempting to prevent practitioners from accepting assistance from non-practitioners such as invention promoters. This proposed rule is so broad that it would prevent practitioners from using third-party patent searchers who perform patent searches in contemplation of a patent application being filed with the PTO**.** Virtually all third-party patent searchers are not practitioners and are independent contractors whose searches assist practitioners in their patent work.

By including the words highlighted above, the PTO makes clear that it wishes to restrict non-practitioners from assisting clients and practitioners alike in providing low-cost services in a matter connected with a presentation to the PTO or in contemplation of the client applying for a patent. It is unreasonable and improper for the PTO to interfere with the relationship between invention promoters and practitioners by restricting practitioners from working with non-practitioners including invention promoters who may consult or communicate with clients regarding their inventions so long as legal advice and the filing of patent applications, attending hearings, etc. remain the responsibility of the practitioner.

A definition of "practice before the Office" which excludes non-practitioners from merely assembling information and providing nonlegal services at a much lower cost than practitioners would charge and from being able to communicate with clients in connection with their inventions is too limiting in scope.

The PTO did expand somewhat the ability of non-practitioners to assist in presentations before the PTO by adding the following to the end of the introduction of Revised Proposed Rule §11.5(b):

> Nothing in this section proscribes a practitioner from employing non-practitioner assistants under the supervision of the practitioner to assist the practitioner in preparation of said presentations.

ISC submits that this addition does not go far enough and should be broadened to provide that a non-practitioner can be a person or entity which is not technically an *employee* of the practitioner or on the practitioner's payroll, but may be an independent contractor who communicates or consults with a client in working with a practitioner. Of course, the responsibility for presentations and filing of documents with the PTO, attending hearings etc. would rest solely with the practitioner.

ISC submits that Section 11.5(b) should be modified, as follows:

> (b) Practice before the Office. Practice before the Office includes, but is not limited to, law-related service that <u>is directly</u> ~~comprehends any matter~~ connected with the presentation to the Office or any of its officers or employees relating to a client's rights, privileges, duties, or responsibilities under the laws or regulations administered by the Office for the grant of a patent or registration of a trademark, or for enrollment or disciplinary matters. Such presentations include preparing necessary documents <u>for</u> ~~in contemplation of~~ filing ~~the documents~~ with the Office, corresponding and communicating with the Office, and representing a client through documents or at interviews, hearings and meetings~~, as well as communicating with~~ and advising a client concerning matters pending or ~~contemplated~~ to be presented before the Office. Nothing in this section proscribes a practitioner from employing non-practitioners assistants under the supervision of the practitioner to assist the practitioner in preparation of said presentations <u>or from receiving information or documents from a non-practitioner not employed</u>

> by the practitioner, including a person or entity which is an independent contractor, or working with the non-practitioner as long as all presentations to the Office are made under the supervision of the practitioner.
>
> (1) *Practice before the Office in Patent Matters*. Practice before the Office in patent matters includes, but is not limited to, preparing and prosecuting any patent application~~, consulting with~~ or giving advice to a client in the ~~contemplation of~~ filing of a patent application or other document with the office, . . .

Such modifications to Revised Proposed Rule § 11.5(b) will work to reduce legal fees for inventors by allowing nonlawyers such as invention promoters to assemble information, which they can do at a lower cost than practitioners. This supports the PTO's intention expressed in its explanatory comments to the Revised Proposed Rules that, "practitioners may provide their legal services at lower fees, a result favored by the Office and practitioners."

ISC appreciates this opportunity to comment on the Office's proposed changes to Subparts A, B, and C of 37 C.F.R. Part 11.

Very truly yours,

NORA H. MILLER
Compliance Director