

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: RIN 0651-AB55

For: **Notice of Proposed Rulemaking:
Changes to Representation of
Others Before the United States
Patent and Trademark Office**

**72 Fed. Reg. 9196
(February 28, 2007)**

***Comments In Reply To the Notice of Proposed Rulemaking Entitled
"Changes to Representation of Others before the United States Patent and
Trademark Office"***

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Attn: Harry I. Moatz

Sir:

In reply to the Notice of Proposed Rulemaking published February 28, 2007, at 72 Fed. Reg. 9196, the PTO Practice Committee at Sterne, Kessler, Goldstein & Fox P.L.L.C. submits the following comments.

1. The Office solicits comment on whether it should explicitly provide for circumstances in which a patent agent's causing an assignment to be executed might be appropriate incidental to preparing and filing an application. We have the following comments. We have separate comments for (1) submission of documents and (2) causing such documents to be executed.

Submission of documents

(a) The physical or electronic submission of documents for recordation at the Office is incidental to the preparation and prosecution of patent applications or incidental to the record for an issued patent. It is our opinion that 35 U.S.C. § 31 expressly permits the Commissioner to decide who has authority to submit documents for recordation.

(b) A patent agent or patent attorney who is registered before the Office is the proper representative to submit such documents as it is such a

registered patent agent or patent attorney who understands the requirements that the Office has for recordation.

(c) A requirement that if a document is submitted for recordation by an attorney or agent, that the attorney or agent submitting the document must be separately licensed by the state bar in which the assignor and/or assignee lives, in addition to being licensed by the Office, would be unworkable, unpractical and cause needless expense for many applicants, assignees or assignors. This requirement is needless because the rules for submission of a document for recordation are not state specific. This requirement is unworkable because many documents involve a transfer of U.S. rights from a foreign assignor and/or foreign assignee, very few of whom also hold Office registration numbers.

Preparation and Causing a Document to be Executed

(a) There is no need for the Office to explicitly provide for circumstances in which a patent agent's preparing an assignment and/or causing an assignment to be executed is appropriate. The assignment of patent applications or patents is incidental to the preparation and prosecution of patent applications or incidental to the record for an issued patent.

(b) The long-standing position of the Office that a registered patent agent may prepare a patent assignment and cause such assignment to be executed if not prohibited by state law, is sufficient. No explicit examples need to be provided. Any attorney or agent who has a question in this regard should seek advice of his or her state bar or local ethics counsel.

(c) It would be an undue hardship on both the assignor and assignee to require that the applicant must involve an attorney who is licensed in the state of the assignee and/or assignor if an assignment is involved. This would add an unnecessary layer of complexity on the patent process.

First, many assignors and assignees would end up having to have two sets of attorneys and/or agents - those that substantively prosecute patent applications and those that are licensed in specific states where the assignor/assignee reside and that therefore could prepare and cause assignments to be executed.

Second, it is not unusual for an application that is to be assigned to have multiple inventors who live in different states. The need to hire an attorney for each state simply to cause an assignment to be executed in such state is a

unnecessary administrative burden with no substantive advantage to either the assignor or assignee.

Third, it is not clear how the transfer of rights in the U.S. invention from a foreign inventor to a foreign company would be handled. Would the Office refuse to record any assignment or agreement that was not drafted and caused by be executed by an attorney or agent who was registered in that country and/or in the U.S.?

Fourth, it would be very difficult and perhaps impossible to find a foreign attorney who is also a registered U.S. patent attorney to prepare such an assignment.

Fifth, it could be difficult for the assignor or assignee to find an attorney in every state who would be willing to be involved with the transfer of rights in an application or patent but not handle the entire substantive prosecution. An attorney or agent who simply causes an assignment to be executed could be conflicted from later attacking the substance of the application or patent by virtue of having assisted with the assignment. Attorneys and agents in states that have a relatively small number of registered patent attorneys/agents would be especially impacted.

(d) It would compromise an attorney or agent's ability to fully practice in front of the Office if the attorney or agent who is handling the substantive prosecution could not at least cause an assignment to be executed and record the same, no matter where the assignor or assignees lived. The attorney or agent who is handling the substantive prosecution needs to be able to act fast to resolve ownership questions, for example to file a terminal disclaimer, or, for example, to ensure the correctness of the assignment recordation affirmations that the prosecuting attorney or agent makes when submitting the assignee's name on the issue fee transmittal sheet. The overlay of having a state bar requirement is clearly inconsistent with the authority granted to the Commissioner by 35 U.S.C. § 31 in this regard.

(2) Proposed § 11.5(a)

(a) Proposed § 11.5(a) states: "A register of attorneys and agents . . . recognized as entitled to represent applicants . . . in the *preparation and prosecution* of patent applications." Should this text also refer to privileges before the Board of Patent Appeals and Interferences (BPAI)? Because "prosecution" is closed at the BPAI stage, the phrase "preparation and prosecution" does not necessarily encompass meaning that the registered

attorney/agent is also recognized in matters that proceed before the BPAI. The current text could be construed to imply that preparation and prosecution privileges do not encompass BPAI privileges. An alternate proposal for this language is ". . . in the preparation and prosecution of patent applications, including representing applicants in patent matters before the Board of Patent Appeals and Interferences."

(3) Proposed § 11.5(b)(1)

Similarly, proposed § 11.5(b)(1) states that practice before the Office in patent matters includes, but is not limited to, "drafting" a communication for an appeal before the BPAI. By referring specifically only to the "drafting" of a communication, the text implies that full representation, including signing and submitting such communications, and representing the applicant in oral arguments before the BPAI, may not be included. Proposed alternative text is "drafting and submission of a communication for a public use, interference, or reexamination proceeding, petition, appeal to the Board of Patent Appeals and interferences, or other proceeding, and participation in the same."

Conclusion

Consideration of the above comments is respectfully requested.

Respectfully submitted,

The Patent Practice Committee at
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