April 14, 2007

Mr. Harry I. Moatz
OED Director
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

RE: Changes to Representation of Others Before the United States Patent and Trademark Office; Federal Register/Vol. 72, No. 39 (February 28, 2007)

Dear Mr. Moatz:

Thank you for the opportunity to provide comments concerning proposed rule changes. I believe two sections in the proposed changes warrant comment, namely sections 11.5 and sections 11.25.

Section 11.5

There is no legal precedent which clarifies whether preparation of patent assignments is 'incident to prosecution,' and a standard should be explicitly provided by the USPTO in Section 11.5. Failure to provide such a standard will confuse inventors and leave patent agents vulnerable to state legislation and lawsuits by state bar associations.

With regard to Section 11.5, the Office solicits comments 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. The Office should explicitly provide for a patent agent's causing an assignment selected by a client to be executed to prevent confusion on the part of inventors and the courts.

Leaving this determination to the states would have several undesirable consequences. Clients expect patent agents to handle certain key steps of the patent preparation process. If an assignment is obligatory for an inventor due to his employment contract, causing the execution of a standardized assignment on behalf of said company should not require state bar passage. Obviously, if the inventor believes the assignment to be unnecessary or too restrictive, he or she is free to seek legal counsel. In this case, the inventor is not the agent's client; his or her employer is. (Indeed, even if the practitioner was an attorney, such a situation would create a conflict and the practitioner could represent the inventor on as a client in this matter.)

Leaving this matter up to the states could cause a great deal of confusion to both inventors and to the courts. Practice before the USPTO is widely understood by inventors to be a federal endeavor. Leaving this decision to the state bar organizations creates a power vacuum which would serve as a breeding ground for significant state-to-state differences in what patent agents may and may not do. This will only serve to confuse inventors seeking the services of said practitioners, and discourage them from seeking the services of patent agents. Further, the state bar associations have repeatedly and successfully lobbied to artificially raise the bar on entry into the legal profession, with the result that entry into the legal profession is now restricted to those select few who can afford to pay for three years

of on-campus presence at a law school. Given the opportunity, there is no reason to believe these modern-day guilds will not work to legislate and enjoin patent agents completely out of existence. In *Sperry v. Florida,* 373 US 379 (1963) the Florida Bar Association attempted this very feat, and was thwarted only by clear USPTO regulations which trumped the relevant state law.

Allowing state prohibition of these services could cause patent agents to lose their corporate clients. Additionally, if only attorneys may effect the signing of a standardized document, costs for corporations lacking or having only limited in-house patent counsel will skyrocket. The USPTO will only exacerbate these types of problems if it bars agents from effecting the execution of a standardized document.

Clients wronged by incompetent or unlicensed participation in negotiations and/or drafting of contracts already have legal recourse; they can pursue a civil action against offending patent agents and/or attorneys unlicensed to practice law in their state. It is for this reason that patent agents and attorneys typically carry malpractice insurance.

Since there are no legal precedents which clarify whether preparation of patent assignments is incident to prosecution, it is vital for the USPTO to explicitly adopt a definition. **Taking the issues enumerated above into account, the USPTO should explicitly adopt a standard which allows an agent, at the request of the client for whom an application is being prepared, to effect the execution of standardized, pre-existing, or client-selected assignment forms.**

Section 11.25

The proposed changes to 11.25, and more specifically, the removal of the exception for "misdemeanor traffic offenses or traffic ordinance violations" contained in 11.25(c) of the originally proposed rules will only serve to inundate the OED Director with meaningless paperwork, and needlessly burden practitioners with providing notice of trivial traffic ticket convictions and plea bargains, and will not serve any public good.

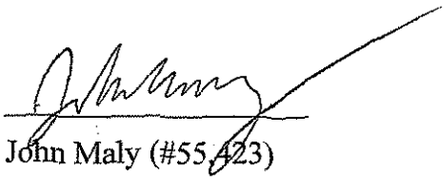
This proposed change, if adopted, would require practitioners to notify the OED Director of trivial traffic infractions. However, requiring practitioners to notify the OED Director of traffic infraction convictions accomplishes no public good. Inventors do not need to be protected from a practitioner who was convicted of driving with a broken taillight, or from a practitioner who was pulled over for driving 62 miles per hour in a 55 mile-per-hour zone. Such infractions manifestly reflect neither on the integrity nor on the professionalism of the practitioner.

Also of significance is the increasing nationwide issuance of citations for traffic infractions as traffic enforcement has become a major industry and source of revenue for municipalities in the United States. Further, according to the National Motorists Association, only a handful of states currently have laws prohibiting exploitive speed traps. See: http://www.speedtrap.org/stetlaws.htm. Finally, an unfortunately small number of motorists attempt to contest exploitive traffic tickets, and "guilty" outcomes from traffic citations approach 90% in many states, counties, and cities.

The abundance of registered practitioners combined with the increased prevalence of traffic citations and large number of states which still allow exploitive speed traps will only serve to inundate the Director with paperwork which is irrelevant to practitioners' professional and ethical standing to practice.

Accordingly, the "misdemeanor traffic offenses or traffic ordinance violations" exception should be reinserted into 11.25.

Sincerely,



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