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From: schlafly@gmail.com on behalf of Roger Schlafly [roger@schlafly.net]
Sent: Monday, March 05, 2007 3:04 AM
To: ethicsrules comments
Subject: Proposed 37 CFR 11.5 revisions

I am commenting on the proposed 37 CFR 11.5 revisions, and the explanation that appeared in the Feb. 28, 2007 Federal Register. That explanation said:

> Accordingly, "participation" in drafting applications and activities "incident to the preparation and prosecution of patent applications before the Patent Office" are no longer included in the definition.

The quote in the above sentence is rather strange, because it does not appear in the old rule. It is a quote from the US Supreme Court opinion, Sperry v. Florida, 373 U.S. 379 (1963).

The PTO can change its rules, but it cannot change a Supreme Court definition.

The Federal Register continues:

> 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.

This suggests that the PTO wants to authorize patent agent activities that are "incident" to patent applications, and is only asking whether more explicit rules are needed.

I do not believe that listing explicit circumstances is either necessary or helpful. There are patent agents in solo practice, agents who work for attorneys, agents who work for companies, firms that use standardized assignment forms, agents who are really attorneys but acting as agents representing out-of-state clients, and many other possibilities. Any change in the rules is likely to cause hardships to attorneys, agents, and clients, and you would have to hold hearings on what rules might cause what hardships.

Moreover, any restrictive rules should complement state regulations about the practice of law. And yet none of the 50 states is showing any interest in regulating patent agents handling assignments. If some state had passed some regulations in this area in order to protect clients who might be getting inadequate legal advice from patent agents, and if those regulations conflicted with federal law, then there might be some need for some clarification from the PTO. But no such problems have been reported, as far as I know.

The actual textual changes to Rule 10.5 are not so bad. My objection is to the "Discussion of Specific Rules" that does not match the actual text changes very well.

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