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May 29, 2007

Jon W. Dudas
Under Secretary of Commerce for Intellectual Property
and Director of the U.S. Patent and Trademark Office
Mail Stop OED-Ethics Rules
U.S. Patent and Trademark Office
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RE: Comments regarding Proposed Changes to the Rules Regulating Representation of Others Before the United States Patent and Trademark Office
Federal Register, Vol. 72, No. 39, pages 9196-9220 (February 28, 2007)

Dear Sir:

I would like to thank the Office for the opportunity to make comments on the proposed rules referred to above. I am a patent practitioner at the law firm of McDermott Will & Emery in the firm's Washington, DC office. I have the following comments with respect to the proposed rules.

Rule 11.2(c) prohibits the staying of other proceedings when a petition is filed regarding enrollment or recognition. The rule is not clear as to what "other proceedings" mean. If it is a petition challenging an action taken by OED in a proceedingt, then the prospective registrant should be given the opportunity to file such a petition and to have it decided before the due date of the proceeding. It is suggested that the rule be amended to allow the Director discretion to stay other proceedings or to stay the proceedings based on good and sufficient reasons presented by the prospective registrant in the petition.

Rule 11.5(b) and its subsections: Rule 11.5(b) says that practice before the Office "includes, but is not limited to ...." While the proposed rule goes on to define practice in patent cases and trademark cases, the aforesaid language is vague and indefinite since it does not put the public on notice as to what else would constitute patent practice before the Office. The Office needs to define exactly what constitutes the practice of patent law subject to USPTO jurisdiction. The *Sperry* case allows a patent agent or an attorney who is practicing patent law, but who is not licensed to practice in the jurisdiction in which he or she resides to practice patent law under the license granted by the Office. There are facets of patent law that are closely related to the preparation and prosecution of patent applications. Assignments and licenses just two major

examples. While they are both contractual matters, a person practicing before the Office has exposure to assignments and licensing. Over time, patent practitioners become proficient in assignment and licensing matters. The same is true for rendering opinions on validity and infringement. It is suggested that the rule be amended to define practice before the Office as prosecution of patent applications before the Office, preparing assignments and licenses for patent applicants and patentees and rendering opinions on validity and infringement for clients. In this way, the practice of patent law is a federal matter as expressed by the Court in *Sperry*. The language used in the proposed rule may not allow a patent agent or the attorney licensed in another jurisdiction to engage in activities with respect to assignments, licensing, and rendering opinions.

Rule 11.14(a): It is not clear why "Registration as a patent attorney does not itself entitle an individual to practice before the Office in trademark matters." If such a person is an attorney and a member in good standing of a State or Federal bar, then by definition, any patent attorney meeting this qualification can practice before the Trademark Office. It is suggested that unless there is a specific reason for the provision that it not be adopted in the proposed rule.

Rule 11.18(b)(2)(i): What is meant by the terms "unnecessary delay" or "needless increase"? If this is directed to prosecution laches, did not the change in 35 U.S.C. § 154 to the 20 year term effectively dilute, if not eliminate, prosecution laches? Also, what if there is good and sufficient reasons for a delay, such as poverty. Should a patent applicant loss patent rights because he or she does not have the ready cash to prosecute a patent application? Should we as practitioners advise poor clients that because the filing of application to keep your case alive would be regarded as unnecessary delay, you must abandon your application? The terms need to be further defined or the proposed rule should not be adopted.

Rule 11.19(b)(1): While I agree that the conviction of crimes as a basis for discipline is needed, what is a "serious crime"? Is assault and battery, or DWI, or driving with a suspended or revoked driver's license, or driving a vehicle with a suspended registration, or driving 80 mph in a 60 mph zone, a "serious crime"? The term needs to be further clarified in order to give the public notice as to what constitutes the scope of a "serious crime".

Rule 11.19(b)(3): This section is not understood. Does this section mean that a disciplined practitioner who does not comply with proposed Rule 11.58(b) can again be disciplined upon seeking reinstatement because he or she did not comply with Rule 11.58(b)? The same for a State Court that stipulates how the practitioner should wind up his or her business after a disciplinary action. I would suggest that if this proposed rule cannot be clarified, it should not be adopted.

Rule 11.19(b)(4): The expression "imperative USPTO Rules of Professional Conduct" has no meaning since the Office has not adopted the rules it proposed in December 2003. It is suggested that the expression be changed to -- USPTO Rules of Professional Conduct as set forth in §§ 10.20 to 10.112 of Part 10 of this Subchapter -- until the new disciplinary rules are adopted.

Rule 11.19(c): The reference to "through 11.806" is indefinite. There is no rule proposed beyond Rule 11.61. Rules 11.62 through 11.806 do not exist. It is suggested that the language be changed to -- §§ 11.19 through 11.61 and §§ 10.20 to 10.112 of Part 10 of this Subchapter --.

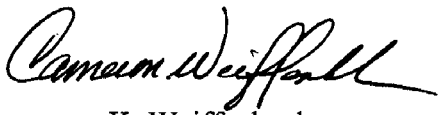
Rule 11.20(a)(3): The office has provided for both private and public reprimand. The public should have notice that both exist. It is suggested that the language be changed to -- Private or public reprimand --.

Rule 11.22(f)(2): The term "§§11.100 et seq." is indefinite because the rules do not exist. It is suggested that the language be changed to -- §§ 10.20 to 10.112 of Part 10 of this Subchapter --.

Rule 11.25(a): What constitutes a crime? A speeding ticket? Does the Office expect practitioner's to report all moving violations or parking tickets? The term "crime" is indefinite and needs to be defined. Also, what constitutes a "serious crime"? Is it hunting without a license or violation of any municipal ordinance or any kind of misdemeanor (e.g. jay walking). The terms "crime" or "serious crime" as used in the proposed rule do not put the public on notice as to the scope of these terms.

Other than what I have commented on above, the rules with respect to reciprocal discipline and interim suspensions as well as procedures for handling incapacitated practitioners were needed. They fill gaps left open by the existing rules.

Respectfully yours,



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