

COMMENTS OF THE SECTION ON PATENT, TRADEMARK AND COPYRIGHT
LAW OF THE DISTRICT OF COLUMBIA BAR ON CHANGES TO
PATENT RULES IN 37 CFR PART 10 PROPOSED BY U.S.
PATENT AND TRADEMARK OFFICE

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August 9, 1988

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Section of Patent, Trademark and Copyright Law of the D.C. Bar
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August 9, 1988

SUMMARY OF COMMENTS BY SECTION OF PATENT, TRADEMARK AND
COPYRIGHT LAW ON CHANGES TO PATENT RULES PROPOSED
BY U.S. PATENT AND TRADEMARK OFFICE

The Section of Patent, Trademark and Copyright Law of the District of Columbia Bar (hereafter the "Bar Section") is submitting these comments in response to a notice of proposed rule making published by the U.S. Patent and Trademark Office at 53 Fed.Reg. 20871.

The Bar Section endorses the deletion of Section 10.6(d) and recommends the addition of a new Section 10.6(d) (proposal enclosed) adapted from 1064 O.G. 12 and a new Section 10.66(e) adapted from the newly proposed Section 10.10(d). We also recommend the deletion or substantial revisions of the last paragraph of the newly proposed Section 10.10(b) so that inconsistencies with Section 10.23(c)(13) might be avoided.

The Bar Section also endorses the newly proposed Sections 10.10(c) and (d), but recommends that the latter provision be accompanied with additional explanatory commentary to help guide the government employed practitioner.

The newly proposed Sections 10.23(19) and (20) are endorsed, but with a recommended change in (20).

We also propose that the publication of the Final Rules indicate whether government practitioners need to contact the Office of Enrollment and Discipline about a possible change in status.

COMMENTS OF THE SECTION OF PATENT, TRADEMARK AND COPYRIGHT
LAW OF THE DISTRICT OF COLUMBIA BAR ON PROPOSED AMENDMENTS
OF PATENT RULES PUBLISHED BY THE U.S. PATENT AND TRADEMARK
OFFICE IN FEDERAL REGISTER OF JUNE 7, 1988

The Section of Patent, Trademark and Copyright Law of the District of Columbia Bar submits these comments in response to the request for public comments published by the U.S. Patent and Trademark Office in the Federal Register at 53 Fed.Reg. 20871.

The Bar Section endorses the deletion of Section 10.6(d). However, in order to clarify the effect of the deletion upon the so-called "five-year rule" of the PTO Office of Enrollment and Discipline as set-forth in 1064 O.G. 12 (March 11, 1986), we recommend that a new Section 10.11(c) be included in the Final Rules which reiterates the title and text of the "five-year rule" (1064 O.G. 12), but with deletions of any reference to "inactive" status or Section 10.6(d) in connection with the "five-year rule." A proposed version is enclosed.

We recommend that the Final Rules and/or the commentary accompanying same state that the Office of Enrollment and Discipline will no longer require a statement of official duties from government employees who seek "active" registration under Section 10.6, as amended.

The Final Rules and/or the commentary accompanying same should address what will be done to correct the situation of those who have been endorsed as "inactive" under former Section 10.6(d), or had been refused registration solely because of Section 10.6(d) or had lost their registration solely because of Section 10.6(d) and the aforementioned "five-year rule" (i.e. endorsed "inactive" for over five (5) years). The Bar Section recommends that the first group (those currently with "inactive" registrations) be advised by the Final Rules and/or the accompanying commentary, that they are automatically registered as "active" as of the effective date of the Final Rules and that they need not contact the Office of Enrollment and Discipline regarding the change of status. The Bar Section urges that the Final Rules or its commentary advise members of the latter two categories that they will be registered and/or reinstated by the Office of Enrollment and Discipline upon their request and in the absence of any other reason to deny their being registered.

The Bar Section finds that the last paragraph of the newly proposed Section 10.10(b) is more inclusive in proscribing activities than the newly proposed Section 10.23 (c)(13) to which it refers. In particular, Section 10.10 (b) (last paragraph) includes "providing assistance", whereas Section 10.23(c)(13) does not; and Section 10.23(c)(13) recites "knowingly", whereas the other provision does not. The last paragraph of Section 10.10(b) might also be considered redundant. We therefore recommend the deletion of the last paragraph of Section 10.10(b), or having it revised to more closely conform with the terms of Section 10.23(c)(13).

The Bar Section perceives the purpose of the newly proposed Section 10.10(d) as providing a needed warning to government employed practitioners of possible violations of federal conflict of interest laws and regulations, particularly 18 U.S.C. 205. To this end, the Bar Section recommends that the commentary which accompanies the Final Rules further explain that even with the present rule changes, the Office of Enrollment and Discipline generally does not approve of patent practice by government employees before the PTO on behalf of private parties in view of the Advisory Opinion of the U.S. Attorney General dated July 18, 1949, 625 O.G. 565.

The Bar Section questions whether the Advisory Opinion should still be given full effect in all circumstances.

The Bar Section proposes that Section 10.66 be amended to include a new paragraph (e) that is similar to the newly proposed 10.10(d) to make Section 10.66 more complete. With regard to the newly proposed Section 10.23(c)(20), the Bar Section endorses same, but respectfully suggests that the term "contrary to" be changed to -- in violation of --.

Lastly, the Bar Section recommends that any reference in the Final Rules or its commentary to the decision in Athridge v. Quigg, 655 F. Supp. 779 (D.D.C 1987) be accompanied by citation to In re Athridge, 4 U.S.P.Q.2d 1656 (Comm. PTO 1987), which indicates that ultimately, Mr. Athridge's name was entered on the "active" list of registered attorneys and agents.

PROPOSED SECTION 10.11(c)

Reinstatement of Patent Attorneys and Agents

Any person whose name has been removed from the register of attorneys and agents pursuant to 37 CFR 10.11(b), or its predecessor, 37 CFR 1.347, or whose name has been endorsed as inactive on the register pursuant to 37 CFR 10.6(d), or its predecessor, 37 CFR 1.341(f), may request reinstatement on the register. However, where the person seeks reinstatement to the register five (5) or more years after his or her name was removed pursuant to 37 CFR 10.11(b), or its predecessor, or where other circumstances indicate that the person whose name was removed from the register may no longer be qualified for registration, that person will be required to again meet the requirements of 37 CFR 10.7, including taking and passing the examination under Section 10.7(b) before reinstatement is granted.

Those persons who show that they continue to possess the legal qualifications necessary to render applicants for patent valuable service despite the lapse of five or more years will not be required to take the examination. The legal qualifications include knowledge and proficiency in current patent law and Patent and Trademark Office procedure, an ability to draft acceptable patent claims, and familiarity with current patent practice as well as patent statutes and regulations. In appropriate circumstances, any person whose name was removed from the register may be required to establish to the satisfaction of the Director of Enrollment and Discipline that he or she is of good moral character and repute pursuant to Section 10.7 regardless of the period his or her name was removed from the register.