

Recertification of Patent Practitioners: It's a Good Idea*

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"Often do the spirits of great events stride on before the events, and in today already walks tomorrow."

Samuel Taylor Coleridge [1772-1834]

INTRODUCTION

Just two years ago, relatively only yesterday in the distinguished history of our profession, the PTO released a sweeping "21st Century Strategic Plan" that spurred public debate on many of its proposals. The proposed "Periodic Certification for Registered Practitioners" stayed under the radar, however, evoking a modicum of comment¹ and little debate in spite of the fact that this proposal might lead to a periodic mandatory exam, a periodic optional exam, or a combination of mandatory and optional exams for patent practitioners.

After several modifications, and the removal of the patent certification proposal altogether at one point, the PTO published a new version of the Strategic Plan on its website². The most recent version, posted to the website on April 2, 2003, describes the PTO's plan for practitioner certification in Action Paper No. 44. The PTO's current plan proposes self-verifying training on the Internet as a key component.

A mechanism for implementing the PTO's recertification plan is outlined in one of the proposed new rules³ published in the Federal Register on December 12, 2003. The author believes that this mechanism warrants serious consideration and comment⁴ by the profession.

To that end, this article addresses the

history of the PTO's recertification plan, the author's suggestions from the April 2003 article⁵, and the section of the Proposed Rules relating to recertification.

HISTORY OF THE PTO'S RECERTIFICATION PROPOSAL

Under the Original 21st Century Strategic Plan

The PTO originally proposed⁶ five options in its periodic certification proposal within the Strategic Plan. Option one provided a periodic mandatory exam of all patent practitioners addressing "their expected level of competency in law, regulations, and practices and procedures. The exam could include frequently encountered problems, recent case law, new office policies, and procedures."

Option two provided an optional periodic exam to certify "current expertise in patent practice." The PTO conditioned this option on an economic incentive, presumably in the form of a malpractice insurance rate reduction, to those patent practitioners who pass the exam. It is reasonable to infer that the PTO would have pursued this option only if insurers were to make the exam effectively mandatory, thereby causing widespread usage.

If the testing regimen was tied to economic incentives, firms would likely require that their patent practitioners maintain the option two certification to reduce the cost of malpractice insurance and add to the marketing value of the firm. Insured independent patent practitioners would have a similar, if not greater, incentive inasmuch as the insurance companies might scrutinize them closely. This leaves uninsured independent practitioners as potentially lacking sufficient incentive to attempt certification, however, they may be among those for whom practice improvements may be most necessary.

Option three was identified as the combination of option one and option two. It was apparently intended to provide a

mandatory periodic exam of basic knowledge and skills, with an optional exam to measure higher levels of competence.

In their July 5, 2002 version of the Strategic Plan⁷, the PTO recommended the selection of option three among the options available in the event that insurance carriers choose not to provide a sufficient economic incentive to patent practitioners under option two.

Option four was not a separate option, but rather is a statement that a paper version of any exam may be required to meet the needs of a number of patent practitioners. Given the level of legal, scientific, and technical qualifications required for registration, and in light of the movement of the PTO away from paper filing and communication, a paper version of any exam implemented by the PTO is arguably unnecessary and possibly even counterproductive.

Option five was also not a separate option, but rather a statement that the PTO will enforce rules prohibiting patent practitioners from practicing before the PTO when their registration has been suspended. The PTO noted that many "practitioners who are removed from the roster for failure to reply to a letter addressed to them by OED ... continue to practice...." Although the proposal provided no further elaboration, the issue appears to be an internal one mandating that the PTO enforce its existing rules.

Under the Current 21st Century Strategic Plan

While still outlining the five options originally proposed, the current PTO Strategic Plan⁸ states that the "proposal is modeled both on existing state bar Continuing Legal Education (CLE) programs and on existing off-the-shelf software used to deliver self-verifying training on the Internet." The PTO's Action Paper No. 44 further states that "[t]he Patent and Trademark operations are currently beta testing commercially available software to verify comprehension of training materials." The current PTO plan itself does not elaborate further on an implementation protocol. However, as discussed later in this article, Section 11.12 of the Proposed Rules does.

In their current version of the Strategic Plan, the PTO recommends the selection of Options 3, 4 and 5, as summarized in

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Section a) above. However, the December 12, 2003 Proposed Rules appear to be modeled after a combination of Options 1, 4 and 5 as discussed in Section a) above.

THE AUTHOR'S PROPOSAL REGARDING RECERTIFICATION

In an April 2003 article⁹, the author joined two co-authors in recommending a two-part mandatory Continuing Patent Education (CPE) program to address the concerns voiced by the PTO in the original version of the PTO's 21st Century Strategic Plan. Specifically, the PTO expressed concern over patent practitioners' competence "in law and regulations, and practices and procedures." In order to address the PTO's concern, Part A of the CPE program would require periodic on-line training sessions run by the PTO, principally addressing procedural issues in PTO practice. Part B, modeled after state CLE programs, involves third-party provided courses principally addressing substantive issues such as case law.

The April 2003 article emphasized that CPE accomplishes the PTO's goal of maintaining practitioner competence, and should not be perceived as overly burdensome for patent practitioners. Illustratively, this approach is less cumbersome than the periodic certification procedures that thousands of lawyers undergo to be recertified as specialists in fields such as trial law. In addition, the CLE burden would be mitigated by overlap with state CLE obligations for those patent attorneys who are already subject to such obligations.

Part A - Online Interactive Training Session

The online training might be provided at specified periodic intervals or it might be mandated immediately after significant PTO rule changes are promulgated. The training format could be modeled after counseling programs used in other fields. One illustration is the "exit loan counseling" program used by financial aid offices for graduating students who have taken out federal loans¹⁰. Patent practitioners would be required to take each session within a specific window of time (e.g., 2 months of its posting). Security for the program might be provided by the existing Public Key Infrastructure ("PKI") used by the PTO for electronic filing. In addition to assuring security, the PKI creates and maintains an audit trail that would be useful in administering and monitoring the program.

Illustratively, after logging onto the training site, the practitioner would view a screen containing information on the first topic for the practitioner to review. This would be followed by a required question and answer sequence. Each portion of the session would review a specific topic. Key issues would be highlighted to focus the practitioner's attention. At the end of each portion of the session, a number of questions, either multiple choice, true/false, or fill-in-the-blank, would query the practitioner's recall of the material from that portion. If the patent practitioner answers the questions correctly, they would be passed to the next portion. When a patent practitioner answers one or more questions incorrectly, the computer would return them to the information screen. The practitioner would then be prompted to reread the information before re-answering the questions. A final, overall question section at the end of the session could review, and reinforce, all of the topics covered in the session.

The online training is not intended to examine the patent practitioner's prior knowledge of the material, or ability to commit it to long term memory. In contrast, it is devised to provide key information to the patent practitioner, in a manner that assures that the patent practitioner reads it, and hopefully understands it at that point in time. The online interactive training would guide the patent practitioner through the material, making sure that each subject covered is viewed for sufficient time to insure that it is both read and digested. This method eliminates the threatened burden to patent practitioners of sitting for an exam periodically and also lowers the cost to the PTO. The online training eliminates the cost of on site exams which require the sites and proctoring. At the same time, implementing the online interactive program should help alleviate the cost associated with errors resulting from patent practitioners who have not kept abreast of developments in PTO rules.

This method is not without its problems. Some of the problems are common to any computer based regimen. There are several problems, however, that are unique to online training. First, there is a risk that a practitioner may attempt to "short circuit" the session by choosing random answers without reading the material. Second, there is the potential for a "stand-in" to take the exam on behalf of the practitioner. Third, on-line training is not well-suited to a

paper format. The immediate feedback and corrective teaching components of on-line training are not available off-line.

These problems are not insurmountable. The potential for a practitioner to select answers randomly is somewhat self-limiting, due to the nature of the training session itself. As the session progresses, the practitioner would soon realize that it progresses more quickly when the training information is read and honest answers are given to the questions presented. The average practitioner should be able to digest the material and answer the questions correctly in less time than it would take to guess at questions (and then re-visit the material in response to wrong answers). The potential for this problem might also be mitigated by including "fill-in-the-blanks" questions where appropriate.

It should also be unnecessary, and might even be considered counterproductive, to mandate production of a paper version of any exam implemented by the PTO. First and foremost, patent practitioners are required to have a technical or scientific background. In light of this, practitioners should be expected to be able to master the limited use of the computer that the online training session would require. Second, the PTO is moving away from paper filing toward a paperless prosecution system. For example, information disclosure statements may now be submitted electronically to the PTO via the PTO's Electronic Filing System.

In addition, the PTO describes its goal for becoming a more agile organization in the Strategic Plan and states that one means of implementing this goal is to make "electronic end-to-end processing ... the centerpiece of our business model." Accordingly, in the future, a good deal of patent practitioners' communication with the PTO will be performed via computer. As a practical matter, practitioners will be required to have access to an appropriate computer. As a result, the computerized training approach should not be perceived as an undue burden on practitioners.

Part B - Course Requirement

In the author's opinion, the online interactive training procedures should be complemented by a mandatory course requirement. As with many state CLE programs, patent practitioners should be required to complete a given number of course hours during a specified interval of years. Although the task of implementing the course requirements will require an

investment of effort and resources by the PTO, administration of the courses themselves could be largely delegated to third party providers.

The course requirements should not prove overly cumbersome to practitioners. Attorney practitioners will presumably be able to use the courses to satisfy their requirements before the PTO and any state CLE requirements they may have simultaneously.

In addition to CPE, the authors of the April 2003 article recommend that the PTO consider imposing a patent practice requirement. This will weed out registered practitioners who do not maintain their skills in patent prosecution through actual practice. The reason for such a recommendation is that, absent such actual practice, prosecution skills quickly become obsolete, particularly in the current environment in which significant PTO rule changes are being implemented every couple of years.

PROPOSED RULES' SECTION 11.12 REGARDING RECERTIFICATION

Section 11.12 of the Proposed Rules provides a mandatory continuing education requirement that will be required by the PTO on a periodic basis. No more than one mandatory education program would be required per year, and the requirement may be imposed as infrequently as every three years. The author believes that this window of one to three years is a good one, since it would offer the PTO's Director the flexibility to impose the requirement during years when changes in the PTO's rules and procedures are adopted, and not impose it during years when such changes don't occur.

One way to comply with the mandatory education requirement imposed by Section 11.12 is through a PTO-delivered self-assessment update program to be provided over the Internet. Under this protocol, the PTO will publish written material on the Internet, followed by a self-administered question-and-answer learning protocol.

In the author's opinion, this protocol is a good thing because it will insure that all patent practitioners registered before the PTO are exposed to new rules and procedural changes upon adoption or within a reasonably-short window of time thereafter.

Use of the Internet as a vehicle for delivery will provide both "time" and "space" flexibility to registered practitioners since they will be able to undertake the update program from a time and place of their choice. As an alternative to Internet deliv-

ery, a paper version of the update program will also be available.

The author believes that a paper version, although perhaps appropriate for an interim interval until the PTO is assured that all registered practitioners are Internet-savvy, will not be needed in the long term. This is particularly true as electronic filing of patent applications becomes more commonplace.

Another alternative to the Internet-based protocol is to receive CLE through a PTO-approved provider. Proposed Rule 11.13(f)(4) specifically prohibits corporations and law firms from being sponsors for the CLE programs.

The author believes that the PTO should consider a flexible approach to CLE-provider status since it is difficult to envision today the various forms that practitioner education might take tomorrow, much less in future decades.

ENDNOTES

1. See generally Dale L. Carlson, William B. Slate and Carolyn J. Vacchiano, "Are We Certifiable?" *Redux – A Strategic Plan for Maintaining Patent Practice Competence*, 85 J.PAT. & TRADEMARK OFF. SOC'Y 287-300 (April 2003). The author gratefully acknowledges the many contributions of Mr. Slate and Ms. Vacchiano to ideas embodied in this paper.
2. See <http://www.uspto.gov/web/offices/com/strat21/index.htm>
3. See Proposed Rule 11.12 at 68 Fed. Reg. 69442 (December 12, 2003).
4. See 69 Fed. Reg. 9986 (March 3, 2004) indicating that the extended due date for comments on the Proposed Rules is June 11, 2004.
5. Footnote 2 *supra*.
6. "Legislation/Rules 1e" of the PTO's original version of "The 21st Century Strategic Plan" unveiled on July 5, 2002 (not currently posted to the PTO's website).
7. *Id.*
8. "Action Paper 44 Legislative/Rules 1e" of the PTO's current "The 21st Century Strategic Plan" posted to the PTO's website on April 2, 2003.
9. See footnote 2 *supra*.
10. See e.g., KHEAA Online Loan Exit Training, at <http://ww2.kheaa.com/exit.asp>.