"Are We Certifiable?" Redux - A Strategic Plan for Maintaining Patent Practice Competence

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"We do not disparage the law as a profession when we insist that, like a carpenter or an electrician, the advocate must know how to use the tools of his 'trade."[3]

I. INTRODUCTION

As part of its sweeping 21st Century Strategic Plan,[4] the PTO proposes "Periodic Certification for Registered Practitioners" through a periodic mandatory exam, a periodic optional exam, or a combination of mandatory and optional exams. This article will review the PTO's plan, and several alternative options, before presenting the authors' proposed option. The authors' proposal features online interactive training at set intervals or as dictated by practice changes, providing instant feedback for the patent practitioner's benefit. This interactive method is particularly suited to facilitate absorption of new developments in PTO practice. The online training would be complemented by a continuing legal education (CLE) requirement. The authors believe that their proposal would promote the PTO's goal of maintaining practitioner proficiency without unduly burdening the profession.

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3. Warren E. Burger, *The Special Skills of Advocacy: Are Specialized Training and Certification of Advocates Essential to our System of Justice?*, 42 FORDHAM L. REV., 227, 233 (1973).

II. BACKGROUND

In order to put the PTO's proposal in perspective, it is helpful to examine the history of PTO registration and compare the existing patent practitioner registration process to certification programs for attorney specialists.[5] The power to regulate practice before the Patent Office was granted by Congress in 1861. The Commissioner of Patents first exercised that power in 1869 by providing that "[a]ny person of intelligence and good moral character may appear as the attorney in fact or agent of an applicant upon filing proper power of attorney."[6] Although the Commissioner of Patents began requiring registration of patent practitioners in 1899,[7] it was not until 1922 that Congress amended the PTO's governing statute to expressly grant to the PTO the power to do so.[8]

The PTO has used testing for patent practitioner registration for the better part of the last century. Existing requirements are identified in the

4.The 21st Century Strategic Plan is available at http://www.uspto.gov/web/offices/com/strat2001/index.htm [hereinafter Strategic Plan].

5. The authors note that the comparison is made between certification procedures (for the certification of attorneys as specialists within a field) and the PTO registration process (for the registration of both patent agents and patent attorneys to practice before the PTO). This can be seen as an "apples" versus "oranges" comparison. The legal background in which the certification programs operate is very different from that of patent law. The programs relate to practice areas in which any attorney can practice. The certification serves not to establish an elite amongst practitioners in the subject practice areas, but rather serves as an initial filter "to identify to the public attorneys who have demonstrated proficiency" in the practice area. The Rules Governing the State Bar of California Program for Certifying Legal Specialists, Rule 1.0, California Board of Legal Specialization, revised effective 6/1/1997 [hereinafter California Rules]. Accordingly, one model for such programs involves only an initial exam "to verify that an applicant has a basic knowledge of the usual procedures and substantive law that should be common to specialists in the field of law." Id. at Rule 8.1. But see, Standards for Certification of Lawyers Specializing in Tax Law, II(C), Arizona Board of Legal Specialization revised 4/18/1997 [hereinafter Arizona Tax Rules] (identifying that the applicant demonstrate a "degree of competence...substantially higher than that possessed by a general practitioner who regularly handles a tax matter."). After passing the examination, no recertification examination is required. Rather, a CLE requirement is imposed, accompanied by a continued practice requirement. California Rule 12.1 (25% of the applicant's "occupational endeavors" must be in the field in question); Arizona Tax Rule III "at least one-half of a full time practice in which issues of tax law are significant factors." The authors believe, however, that a comparison of the approaches outlined by the PTO to those currently in use by accrediting agencies has merit. Such a comparison provides a real world perspective on the burdens and benefits of mandatory certification.

6. Rules and Directions for Proceedings in the Patent Office, § 127 (Aug. 1 1869), cited in Sperry v. Florida, 373 U.S. 379, 388-89, 83 S. Ct. 1322 (1963).

7. Rules of Practice in the United States Patent Office, § 17 (July 18, 1899), cited in Sperry, 373 U.S. at 390.

8. Act of February 18, 1922, c. 58, § 3, 42 Stat. 390, cited in Sperry, 373 U.S. at 390.

PTO's General Requirements Bulletin.[9] Those most affected by certification are patent practitioners themselves. The certification process will require practitioners to invest time and money, and risk being unable to obtain certification.

Malpractice insurance carriers should also have a strong interest in patent practitioner certification. Legal malpractice claims in the patent, trademark, and copyright areas, collectively referred to as "intellectual property law," have become increasingly common. This increase is notable when one looks at claims, and reported incidents, during the past decade. For instance, between 1990 and 1995, intellectual property claims were an insignificant portion of the total legal malpractice claims in the United States.[10] More recently, the Attorney Liability Assurance Society, Inc. (ALAS), a legal malpractice insurer, reported a disturbing increase in the number of intellectual property claims,[11] or incidents that may lead to claims. Importantly, the majority involve patents, with missed filing dates among those patent claims most frequently encountered.[12] Damages typically include long term lost profits, and losses abroad when foreign patent rights are adversely affected.[13] The total amounts of the damages are often astronomical.[14]

Patent practitioners have previously recognized shortcomings in the PTO registration protocol. As early as 1994, one commentator contrasted the registration procedures for patent practitioners with the American Bar

9. Herbert C. Wamsley, The Rulemaking Power of the Commissioner of Patents and Trademarks, 64 JPTOS pt. 1, 490, 500 (1982) (citing Rules of Practice United States Patent Office, Vol. 1). Over the course of years, the General Requirements Bulletin has had several different names, including, "Information to Persons Having Business to Transact with the Patent Office," "Guide to the Practice of the Patent Office," and "Rules and Directions for Proceedings in the Patent Office." Id.

10. ABA STANDING COMMITTEE ON LAWYER'S PROFESSIONAL LIABILITY, LEGAL MALPRACTICE CLAIMS IN THE 1990S (1996) (Intellectual property claims make up less than one percent of the total legal malpractice claims in the United States).

11. Brian J. Redding, Intellectual Property Update - Patent Prosecution Claims Continue to Predominate, ALAS LOSS PREVENTION J., May 2000; Brian J. Redding, Alleged Failure to File Patent Applications on Time: Why Are We Getting So Many Claims From High-Quality Firms?, ALAS LOSS PREVENTION J., SEPT. 1998. (Reporting from 1995-to 1998 shows that ALAS had approximately 30 claims or incidents that may have led to claims involving failure to timely file a patent application. That number is approximately one-half of the total number of claims or incidents resulting from failure to file a patent application in ALAS' history.)

Mary Beth S. Robinson, Legal Malpractice in the Intellectual Property Practice, 710 PLI/Pat 485, 490 (2002).

12. Id. Of course, missed filing dates may not always be prevented by means of certification programs. Errors involving the patent docketing system, or a lack of attentiveness by the individual patent practitioner, may be to blame, rather than the practitioner's knowledge of practice and procedure.

13. Id. at 490.

14. Id at 490.

Association (ABA) requirements for accrediting an organization to certify attorneys as specialists in a particular field.[15] In the 1994 study, the patent practitioner registration procedures did not compare favorably to the ABA accreditation requirements. More specifically:

[T]he general standards established for registration that seemed so protective of the consuming public at one time may not be sufficient in today's environment.... To be registered as a patent practitioner, one has to (1) be technically qualified, (2) be in good standing as an attorney [sic***], and (3) pass an examination. There is no requirement that a patent practitioner actually spend a certain amount of time practicing as a "patent attorney" to maintain a registration. Neither is there a requirement to take a given number of hours in continuing legal education pertaining to the practice or to be "re-registered" after a certain number of years. The only things that are required to maintain a registration is to abide by the disciplinary rules and answer a questionnaire every so often that maintenance of registration is desired.

By contrast, the minimum certification requirements for an accredited certification program [demand that the applicant] (1) be in good standing as an attorney, (2) be substantially involved in practice (at least 25%), (3) be deemed qualified by five "peers", (4) pass a written examination, and (5) have taken 36 hours of CLE in the specialty during a three year period preceding the examination. Recertification of all certified persons must occur at least every five years (Article 4.08), wherein requirements are the same for certification with respect to (1) substantial involvement, (2) peer review, (3) educational (i.e., CLE) experience, and (4) evidence of good standing. [16]

Justice Burger's 1973 criticism of trial lawyers [17] motivated the authors to review the certification and recertification protocols put in place by the National Board of Trial Advocacy (NBTA). Perhaps not surprisingly, patent practitioner registration requirements do not measure up to the initial certification requirements for trial lawyers. Even tougher than the requirements for state certified specialists [18], NBTA

15. Frank S. Vaden III, State Bar Section News: Attorney Specialization, 3 TEX. INTELL. PROP. L.J. 3 (1994). Mr. Vaden's analysis focuses on attorneys and ignores patent agent practitioners.

16. Vaden, supra note 11, at 11.

17. Burger, supra note 1. Perhaps it is no coincidence that the establishment of the NBTA took place in 1977, just four years after Justice Burger's call to action.

18. See note 3 supra.

applicants are subject to a rigorous initial certification, followed by recertification every five years. To achieve initial certification, a NBTA applicant must (1) be a member in good standing of the bar, submitting a "comprehensive history" and disclosing any past or pending disciplinary procedures; (2) show a minimum of 30% concentration in trial advocacy in the three years immediately prior to the application; (3) submit a trial brief, written by the applicant and submitted to a court in the three years immediately prior to the application; (4) participate in a minimum of 45 CLE course hours pertaining to trial advocacy in the three years immediately prior to the application; (5) provide references of at least three judges and three attorneys familiar with the attorney's courtroom ability; (6) serve as lead counsel in a minimum number of trials to judgment or verdict; (7) satisfy a list of trial and courtroom skills documented in checklist form; and (8) successfully pass the NBTA essay examination covering trial techniques, evidence, and ethics.[19]

If a protocol analogous to NBTA's certification requirements were applied to patent practitioners, a patent apprenticeship would be necessary prior to registration. A patent apprenticeship is a requisite for registering as a European patent attorney.[20] An advantage of apprenticeship is that it provides a real world experience that is impossible to duplicate in a course or exam.

The recertification requirements for NBTA certified attorneys are similar to those for initial certification. The only exceptions are that: (a) there is no written examination; (b) the references of only one judge and two attorneys are required; and (c) the trial experience requirement is changed to not less than fifteen days of trial participation as either lead or co-counsel in the five years between certification and recertification..[21] These recertification requirements are somewhat different from the PTO's proposed periodic certification requirements. The authors believe that inclusion of a practice requirement makes good sense, and have incorporated one into their proposal presented in Section IV below.

19. About the National Board of Trial Advocacy, at http://www.nbtanet.org/public/misc/about-nbta-shtml.
20. See "How to Become a European patent attorney", p. 2 under the heading "professional activity", available online at http://www.european-patent-office.org/epo/pubs/pat_attorney/e/.
21. Id.

III. The PTO's proposed periodic certification options:

The PTO has proposed five options for the periodic certification program. Option one provides a periodic mandatory exam of all patent practitioners addressing "their expected level of competency in law, regulations, and practices and procedures.[22] The exam could include frequently encountered problems, recent case law, new office policies, and procedures." This mandatory exam would likely face substantial resistance from patent practitioners, especially those who have been away from formalized testing for many years.

Option two provides an optional periodic exam to certify "current expertise in patent practice."[23] The PTO conditions this option on malpractice insurers providing an "economic incentive,"[24] presumably in the form of an insurance rate reduction, to those patent practitioners who pass the exam. It can be reasonably inferred that the PTO desires to pursue this option only if insurers were to make the exam effectively mandatory, thereby causing widespread usage. In such a situation, it is reasonably likely that the format and level of difficulty of the exam would be comparable to that of option one. Otherwise, the exam would be more difficult and exclusionary than might be palatable to practitioners.

The authors believe that the incentives will almost surely be sufficient. Firms would likely require that their patent practitioners maintain the option two certification to reduce the cost of malpractice insurance, and for marketing purposes. 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. Ironically, they may be among those

22. Strategic Plan, supra note 2, at p-51, p.2. Although the PTO points to a number of problems with patent practitioner competence before outlining their proposals, it is does so without citing to any source or empirical data. In fact, the PTO cites to public complaints about patent practitioners but provides little in the way of even anecdotal evidence. Although the authors do not dispute that there may be substantial competence problems in the profession, we note that the PTO has failed to show that public complaints concerning patent practitioners are due to actual, rather than perceived, lack of competence. It has also failed to show that the PTO's proposed actions will appropriately address this lack of competence. It is difficult to determine, absent this much needed evidence, that the process of "recertifying" patent practitioners on a periodic basis will obviate such problems. In Section IV below, the authors propose an online interactive training and CLE combination as a means of addressing some of the potential ills.

23. Strategic Plan, supra note 2, at p-51, p.3.

24. Id.

for whom practice improvements may be most necessary.

Option three is identified as the combination of option one and option two.[25] It is intended to provide a mandatory periodic exam of basic knowledge and skills, with an optional exam to measure higher levels of competence.[26] The PTO recommends option three in the event that insurance carriers choose not to provide a sufficient economic incentive to patent practitioners under option two.[27] Without such a mandated incentive, the PTO would be presumably be freer to make the optional exam more difficult than under option two.

Option four is 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"[28] 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 is also not a separate option, but rather is a statement that the PTO will enforce rules prohibiting patent practitioners from practicing before the PTO when their registration has been suspended. The PTO notes that many "practitioners who are removed from the roster for failure to reply to a letter addressed to them by OED ... continue to practice...."[29] The proposal provides no elaboration. However, the issue appears to be one of the PTO's enforcing its existing rules. Accordingly, the authors will not comment further on this option.

IV. Alternative Approaches:

There are a number of additional approaches for addressing the PTO's concerns regarding practitioner proficiency. Several of these options have been debated by patent practitioners in the past. The authors touch briefly upon a handful of alternative approaches, as illustrative of the universe of options, before turning to their

25. Id.

26. Id. The ABA Section of Intellectual Property Law's Specialization Committee is currently working toward a specialization plan for intellectual property attorneys. One question that is the subject of debate is whether the committee should look toward one certification to cover intellectual property law as a whole, or should focus on narrower specialties. Chair's Bulletin, Vol. 7, No. 2, October 2002.

27. Strategic Plan, supra note 2, at p-51, p.3.

28. PTO, General Requirements Bulletin, p.2 (2002), at http://www.uspto.gov/web/offices/dcom/olia/oed/grb0403.pdf.

29. Strategic Plan, supra note 2, at p-51, p.1.

recommended approach.

A. Eliminate Waiver of Patent Examiners and Foreign Patent Agents

The PTO offers a waiver of the patent bar examination to certain foreign patent agents, and to patent examiners who have worked in the PTO for a minimum of four years. The PTO explicitly identifies the problems associated with these waivers in the following statements:

> For some [examiners], the more advanced training given to patent examiners is the last formal training they received. There is no periodic testing/training that ensures that the examiners maintained an expected level of competency in law before the registration examination is waived. Moreover, there is no requirement for periodic training/testing to ensure that these former examiners, after becoming registered practitioners, maintain an expected level of competency in law, regulations, and practices and procedures [30]

> By long-standing custom, they [foreign patent agents] are not required to take and pass the registration examination. Moreover, there is no requirement for periodic training/testing to ensure that these foreign patent agents, after becoming registered practitioners, maintain an expected level of competency in law, regulations, and practices and procedures.[31]

Examiner waiver represents a "loophole" in the existing PTO registration exam requirement on the theory that experience in the PTO's examining corps provides the examiner with significant exposure to practice and procedure. Nonetheless, difficulties may arise for patent practitioners who began their careers as patent examiners. They may find it difficult to make the transition from the role of an adversary to the patent applicant to the role of an advocate for the patent applicant. Illustratively, the patent examiner might be trained to prefer narrow claims and narrow specifications, whereas the patent practitioner should seek the broadest coverage possible for the client's invention. Similarly, foreign agents may be biased toward their home country practice even when this does not comport with U.S. practice.

The PTO acknowledges in the above-quoted statement that waiver can pose problems. Assuming that a certification protocol is implemented, those practitioners may practice at unsatisfactory levels for several years after waiver but prior to their first certification. The

30. *Id.*
31. *Id*

clear way to address these problems is to eliminate waiver.

B. Limit the Number of Times an Applicant May Sit for the Registration Exam

The PTO should also consider limiting the number of times an applicant is permitted to sit for the registration examination, as a number of states have done with their bar examinations.[32] Arguably, a pass on the nth attempt indicates a fluke more than it indicates competence in patent law and practice. Accordingly, the PTO should consider limiting the number of failed attempts to three, adopting an "X number of strikes and you're out" approach.

C. Eliminate the Registration of Patent Agents

A long debated option proposes an end to the registration of patent agents.[33] Ever-changing statutes, rules, and precedent expose patent practitioners to legal complexities not experienced by prior generations of patent practitioners. Although law school attendance itself cannot insure that a graduate will possess an appreciation for the impact of these changes on a patent practitioner's work, patent agents face a more difficult hurdle than patent attorneys. Patent agents face patent practice without the benefit of formal legal training. This may limit the patent agent's perspective on developments in the law. A narrow perspective, for example, on the case law relating to claim drafting, poses a risk that the client's invention will not be protected as fully as might otherwise be possible. Furthermore, even in the absence of any direct relationship between the legal training of law school and patent practice, state bar membership acts as a filter against practitioners who lack the ability to succeed in law school and pass a bar exam.

The PTO ceased recognizing non-attorneys for practice in trademark matters as of January 1, 1957.[34] The PTO should also consider

32. For example, Montana requires an applicant to obtain permission from the state supreme court to sit for the bar a fourth time. Rules for Admission to the Bar of Montana, at http://www.montanabar.org/admission/admissionrules.html. Similarly, Rhode Island limits candidates to five attempts at passing its bar examination. Rules and Practices of the Supreme Court and Board of Bar Examiners of the State of Rhode Island Governing Admission to the Bar, at http://www.courts.state.ri.us/supreme/bar/rules.pdf.

33. Sperry, 373 U.S. at 391-92, 396-97 (discussing a debate of the merits and drawbacks associated with the continued registration of patent agents).

Trademark agents who were recognized as of that date continue to be entitled to practice before the PTO. See 37 C.F.R. Section 10.14(b).

eliminating registration of non-attorneys for practice in patent matters.

D. Introduce Mandatory CLE Requirements

Another option, borrowed from the state bar arena, is the use of mandatory CLE requirements. This would present the PTO with issues such as course provider approval, course approval, and compliance monitoring. For course content, the PTO could minimize its own burden by approving private providers. There are several established state bar approved CLE course providers in the patent law area.[35] This option is explored further in Section V below.

E. Expand the PTO's Role in Patent CLE Programs

The PTO could serve to sanction, sponsor, or otherwise support, mandatory or elective CLE courses. In recent years, the PTO has provided beneficial training materials to patent practitioners both online and through organized symposia. Examples of PTO "customer outreach programs" have included seminars on electronic filing of patent applications, as well as programs relating to the American Inventors Protection Act of 1999 (AIPA).[36] As discussed further in Section V, below, the PTO could build upon these programs and use the Internet to widely disseminate on-line programs at minimal cost.

F. Limit the Patent Practitioner's Registration to Specific Technologies

Currently, a registered patent practitioner may practice in any technology in which a client is willing to engage the practitioner's services. The PTO could consider limiting registration of patent practitioners to specific technology areas in which the practitioners have technical backgrounds. Beyond the technical competence issues associated with understanding a particular technology, different technologies pose different patent practice issues, militating in favor of

35. There are two particularly significant private CLE providers operating in the patent/intellectual property arena. First, the Practicing Law Institute (PLI), is located in New York, NY. For further information see http://www.PLI.edu. Second, the Patent Resources Group (PRG), is located in Washington, DC. For further information, see http://www.patentresources.com.

36. See e.g., http://www.uspto.gov/web/offices/dcom/olia/aipa/aipaseminar/index.html.

37. For example, there is the risk that a patent practitioner who is inexperienced in mechanical technologies will write a claim in mechanical technologies as if to describe a two dimensional drawing of an object rather than the three dimensional object depicted in the drawing. Similarly, a non-chemist writing a chemical claim may write independent claims too narrowly, reciting particular compounds in a case where a broad generic identification of structure or function of the compounds may be more appropriate.

specialized registration.[37] Adopting a limited registration system would help to assure that the patent practitioner holds the requisite knowledge and skill level applicable to the particular technical field. Nevertheless, the difficulties associated with drawing rigid lines between technologies might render a technology-limited registration system impractical.

V. The Author's Recommended Approach to Periodic Certification:

In lieu of a periodic certification exam, the authors recommend a two-part mandatory Continuing Patent Education (CPE) program to address the concerns voiced by the PTO in the 21st Century Strategic Plan. Specifically, the PTO expressed concern over patent practitioners' competence "in law and regulations, and practices and procedures"[38] Part A of the CPE program involves periodic PTO-provided on-line training sessions, principally addressing procedural issues in PTO practice. Part B, modeled after state CLE, involves third-party provided courses principally addressing substantive issues such as case law.

CPE accomplishes the PTO's goal of maintaining practitioner competence. CPE shouldn't be perceived as overly burdensome for patent practitioners, since it 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, more advantageously, 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.[39] 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

38.Strategic Plan, supra note 2, at p-51, p.1.

39. One illustration is the "exit loan counseling" program used by financial aid offices for graduating students who have taken out federal loans. See e.g., KHEAA Online Loan Exit Training, at http://ww2.kheaa.com/exit.asp.

40. Further information on PKI is available online at http://www.uspto.gov/ebc/policy_certificate.html.

("PKI") used by the PTO for electronic filing, and the like.[40] 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. Wrong answers would cause the practitioner to be prompted to reread the subject matter before revisiting the overall question section.

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 is not without its problems. Some of the problems are common to any computer based regimen.[41] 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. Neither of these problems is insurmountable. 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

41. By way of illustration, there is the potential for the training session to be taken by a "stand-in" for the patent practitioner.

teaching components of on-line training are not available off-line.

The authors believe that there are two reasons why it is unnecessary and counterproductive to produce a paper version of any exam implemented by the PTO. First and foremost, patent practitioners are required to have a technical or scientific background.[42] 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.[43] 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.

The potential for a practitioner to select answers randomly is another risk to consider. However, this 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.

PART B. COURSE REQUIREMENT:

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 a significant investment of effort and resources by the PTO, administration of the

42. PTO, General Requirements Bulletin, p.3 (2002), at http://www.uspto.gov/web/offices/dcom/olia/oed/grb0403.pdf.

43. 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." Strategic Plan, supra note 2, at p. 5. In fact, when the authors telephoned the PTO's telephone line for questions on the strategic plan, a message requests that feedback on the strategic plan be emailed to the PTO.

44. See e.g., PLI, at http://www.PLI.edu and PRG, at http://www.patentresources.com. The PTO could assert some influence on the course content by, for example, awarding credit only to those courses that target patent practice and procedure.

courses themselves could be largely delegated to third party providers.[44]

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 their state CLE requirements simultaneously.[45]

Practice Requirement:

In addition to CPE, the authors 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. Without such actual practice, prosecution skills quickly become obsolete, particularly in the current environment in which significant PTO rule changes are implemented every couple of years.

VI. CONCLUSION

To date, bar associations and professional organizations appear to have been reluctant to comment on the PTO's proposal concerning practitioner certification.[46] The authors hope that this article, and particularly their proposal, will serve to stimulate debate among the profession, and within the PTO, as to the best course of action.

45. This assumes that the practitioner's state bar has a CLE requirement.

46. See joint comments by the American Intellectual Property Law Association ("AIPLA"), the Biotechnology Industry Organization ("BIO"), the Intellectual Property Owners Association ("IPO"), and the International Trademark Association ("INTA"), in a letter dated October 24, 2002. The letter, which is available online at http://www.ipo.org/2002/IPissues/Strategic_Plan_Letter.htm, is notably silent with respect to the PTO's patent practitioner certification proposal.