

PATENT PRACTITIONER CERTIFICATION REVISITED

By *Dale L. Carlson, **William B. Slate, and *Carolyn J. Vacchiano

The PTO released a sweeping 21st Century Strategic Plan, in 2002, spurring public debate on many of its proposals. The proposed "Periodic Certification for Registered Practitioners" stayed under the radar, however, avoiding comment and debate despite 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, including the removal of the patent certification proposal altogether at one point, the PTO published a new version of the Strategic Plan on its website at <http://www.uspto.gov/web/offices/com/s trat21/index.htm>. The most recent version, posted on April 2, 2003, revisits practitioner certification in Action Paper No. 44. The PTO's current plan proposes self-verifying training on the Internet as a key component. The authors believe that this new version warrants serious consideration by the profession, and possible further revision. To that end, this article summarizes the PTO's latest proposal and offers more in-depth suggestions for implementation.

I) The PTO's Patent Practitioner Certification Proposal

The PTO originally proposed five options in its periodic certification proposal. Option one provides 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 provides an optional periodic exam to certify "current expertise in patent practice." The PTO conditions 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 can be reasonably inferred that the PTO will pursue this option only if insurers were to make the exam effectively mandatory, thereby causing widespread usage. If the testing were 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 is identified as the combination of option one and option two. It is intended to provide a mandatory periodic exam of basic knowledge and skills, with an optional exam to measure higher levels of competence. 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.

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 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...." Although the proposal provides no elaboration, the issue appears to be one of the PTO's enforcing its existing rules.

While still outlining the five options originally proposed, the current PTO plan 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." PTO Action Paper No. 44 states that "[t]he Patent and Trademark operations are currently beta testing commercially available software to verify comprehension of training materials." The proposal does not elaborate further but the authors propose the following means of implementing this current patent practitioner certification proposal.

II) The Authors' Proposed Protocol

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." Part A of the CPE program involves periodic on-line training sessions run by the PTO, 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 but should not be perceived as overly burdensome for patent practitioners. 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 loans. See e.g., KHEAA Online Loan Exit Training, at <http://ww2.kheaa.com/exit.asp>. 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 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. 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:

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 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.

Additional information on the authors' proposal is provided in a recent JPTOS article entitled "'Are We Certifiable?' Redux - A Strategic Plan for Maintaining Patent Practice Competence" (April 2003, pp 287-300).

III) Further Developments

The AIPLA's Patent Law Committee heard a presentation on the PTO proposals by two of the authors (Dale & Will) on the subject on May 14th at its Spring Meeting in Atlanta. The discussion that followed delved into the advantages associated with on-line interactive training, as opposed to a more traditional paper or electronic test. On-line training would be a particularly effective vehicle for providing periodic

updates on PTO practice and procedure changes.

A PTO representative in attendance, James Toupin, indicated that substantial changes were contemplated beyond the April, 2003 proposal, and noted that notice of proposed rulemaking will appear in the Official Gazette shortly.

Our Committee on License to Practice Requirements will re-visit the PTO's proposal then.

ENDNOTES

*Attorneys at Wiggin & Dana LLP, New Haven, CT. (see www.wiggin.com). The views expressed herein are solely those of the authors. © 2003 Dale L. Carlson, William B. Slate, and Carolyn J. Vacchiano.

*Attorney at Bachman & LaPointe, P.C., New Haven, CT.