

# 85 PATENT PRACTITIONERS

March 28, 2021

Via Email [Nicholas A. Fraser@omb.eop.gov](mailto:Nicholas.A.Fraser@omb.eop.gov); [InformationCollection@uspto.gov](mailto:InformationCollection@uspto.gov);  
[William.Covey@uspto.gov](mailto:William.Covey@uspto.gov)

Nicholas A. Fraser, Desk Officer  
Office of Information and Regulatory Affairs  
Office of Management and Budget  
New Executive Office Building  
725 17th St. NW  
Washington D.C. 20503

Kimberly Hardy  
Office of Chief Administrative Officer  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313

Re: 0651-0012 information request, ICR Ref. 202102-0651-003, *Admission to Practice and Roster of Registered Patent Attorneys and Agents Admitted to Practice Before the United States Patent and Trademark Office*, 30-day notice at 86 Fed. Reg. 11731 (Feb. 26, 2021)

Dear Mr. Fraser and Ms. Hardy:

We write as 85 patent practitioners. We write in support of the PTO's request for clearance of Control Number 0651-0012, subject to terms of clearance that approve only *status quo ante* collections of information. In August and October of 2020, the PTO issued two new collections of information without statutory procedure: one by guidance, one by a new regulation dropped into a final rule without an NPRM, neither with any of the antecedent procedure required by the Paperwork Reduction Act (PRA), OIRA's Information Collection regulations, or Executive Order 12866.<sup>1</sup> The new regulation and proposed guidance document propose that the PTO intends to (1) collect information regarding continuing legal education for patent practitioners, in the form of (2) a required biennial practitioner registration statement. The information gathering burden of these two collections of information is currently in full effect, even though first submission to the agency won't be required until March 1, 2022, and even though the PTO's Supporting Statement admits the PTO has no clearance.<sup>2</sup>

OIRA should disallow these new collections of information. These collections are already creating substantial annual paperwork burden. We observe that the PTO's Supporting Statement estimates the burden for these collections to be only \$1.6

---

<sup>1</sup> 37 C.F.R. § 11.11 as amended in *Setting and Adjusting Patent Fees During Fiscal Year 2020, Final Rule*, 85 Fed. Reg. 46932, 46947-48, 46960-69 (Aug. 3, 2020); *Proposed Continuing Legal Education Guidelines*, 85 Fed. Reg. 64128 (Oct. 9, 2020).

<sup>2</sup> Supporting Statement (Feb. 26, 2021), <https://www.reginfo.gov/public/do/DownloadDocument?objectID=109594900> at 9.

million,<sup>3</sup> but as demonstrated herein and in 60-day and rulemaking comments, this number is far too low. Estimates of burden range from \$120 to \$150 million annually. None of the three relevant Federal Register notices proposed burden estimates, and none requested comment as required by 44 U.S.C. § 3506(c)(2)(A).

The Supporting Statement tells OIRA that the two relevant collections of information are “not currently being implemented,” so the Supporting Statement does not request clearance. But the PTO’s most-recent Federal Register notice is to the contrary: “mandatory” and “required” collection will begin March 1, 2022 of information gathered over the previous two years, and persons must begin “generating information,” “reviewing instructions,” “searching data sources,” “adjusting existing ways to comply,” “training personnel to be able to respond,” and the like, **now** so that two years’ worth of information “may” be submitted in 2022.<sup>4</sup> Burden is likely accumulating at about \$20 million per month,<sup>5</sup> even though the PTO has never even sought a clearance.

As OIRA did in 2008 with an earlier rulemaking,<sup>6</sup> terms of clearance should permit the PTO to continue under *status quo ante* regulations, but should not permit the PTO to implement its continuing legal education or biennial registration statement” per the August 2020 amendments or the October 2020 *CLE Guidelines*. As in 2008, the PTO should post a Federal Register notice<sup>7</sup> forthwith, that these two collections of information lack procedural foundation, and will not go into effect until the PTO has observed all requirements of law. The public should not bear the burden of these two collections, when the PTO’s Supporting Statement admits that no clearance exists, and *none is sought*.

## Background

This ICR relates to a special statute unique to the PTO. 35 U.S.C. § 2(b)(2)(D), § 32; 5 U.S.C. § 500(e) (carving out the PTO from the scheme that governs all other

---

<sup>3</sup> Supporting Statement, note 2, *supra*, at 14, line 5.

<sup>4</sup> *CLE Guidelines*, note 1, *supra*, 85 Fed. Reg. at 64128 col. 1 (“... registered patent practitioners and [other covered] individuals ... *will be required* to biennially submit a *mandatory* registration statement beginning on March 1, 2022,” emphasis added).

<sup>5</sup> Exhibit A shows that burden will be about \$128-\$150 million per year, \$11 million per month, once the rule is operating at “steady state.” However, because the PTO has not responded to public comments received in January, no one knows what the final requirements will be, and what CLE the PTO will recognize and what it won’t. Whenever the PTO issues an update, the public will have only until March 2022 to gather two years’ worth of information.

<sup>6</sup> OIRA has approved with terms of clearance that back-date to an earlier version of regulations, e.g., [https://www.reginfo.gov/public/do/PRAViewICR?ref\\_nbr=200809-0651-003](https://www.reginfo.gov/public/do/PRAViewICR?ref_nbr=200809-0651-003) even after a revision has been published as a final rule.

<sup>7</sup> This notice would be analogous to *Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals; Delay of Effective and Applicability Dates*, 73 Fed. Reg. 74972 (Dec. 10, 2008) explaining that certain rules will not go into effect.

agencies). The PTO has a separate bar of admitted attorneys and agents, parallel to state bar admissions. This permits the PTO to recognize attorneys who have a specialty in patent law, and creates a special class of “patent agents,” who are persons with technical education but not admitted as lawyers in any state. Statute (§ 32) likewise permits the PTO to suspend or exclude attorneys based on certain specific misconduct criteria enumerated in statute.

More specifically, this ICR is about a PTO proposal to require attorneys to certify to attendance at continuing legal education classes, most offered by the PTO itself and with only narrow recognitions of state-approved substitutes. That CLE information will be required via a biennial “registration statement.”

In a Federal Register NPRM of July 2019,<sup>8</sup> the PTO proposed to create a requirement that patent practitioners “voluntarily” certify that they had completed a certain number of hours of continuing legal education (CLE) hours per biennial cycle, in return for a fee reduction. After extensive adverse comment (filling 10 pages of the Federal Register final rule notice<sup>9</sup>), the PTO promised to stand down on the idea. The PTO declined to answer over 80 public comments, indicating that answers were unnecessary because of that stand down.

In the same final rule notice of August of 2020, the USPTO amended 37 C.F.R. § 11.11, to create a new requirement, for a “biennial registration statement” of all attorneys and agents.<sup>10</sup> The NPRM<sup>11</sup> had made no mention of a “registration statement.”

But then, only 67 days later, the PTO reversed its promise of a stand down. On October 9, the PTO issued the 2020 *CLE Guidelines*.<sup>12</sup> This document is styled as a notice of “proposed” guidance, but nonetheless sets a date certain (March 1, 2022) to go effective, and imposes substantive collections of CLE information, “required to obtain a benefit,” essentially identical to, and in many ways more burdensome than, those that the PTO had just withdrawn.

In a comment letter on the *CLE Guidelines*, the American Intellectual Property Law Association (AIPLA), the largest trade association for the regulated public, wrote to oppose these requirements. The AIPLA’s letter of January 7, 2021 is attached as Exhibit B. AIPLA identifies substantial burden—though AIPLA does not attach specific numbers, a reasonable monetization of its estimates would exceed \$100 million per year.

---

<sup>8</sup> *Setting and Adjusting Patent Fees During Fiscal Year 2020*, NPRM, 84 Fed. Reg. 37398 (Jul. 31, 2019).

<sup>9</sup> *Fee Setting final rule*, note 1, *supra*.

<sup>10</sup> *Fee Setting final rule*, note 1, *supra*, 85 Fed. Reg. at 46960-69.

<sup>11</sup> *Fee Setting NPRM*, note 8, *supra*.

<sup>12</sup> *CLE Guidelines*, note 1, *supra*.

Additionally, during the 60-day comment period, the PTO received one comment letter, with 109 signatories, attached hereto as Exhibit C. Among these 109 signatories are the following—each signing in their individual rather than organizational capacities, but nonetheless representative of the seriousness with which the patent bar takes this ICR:

- A former member of the PTO’s Patent Public Advisory Board.<sup>13</sup>
- A former member of the Board of Directors of AIPLA.
- The president of the National Association of Patent Practitioners, the third-largest organization of attorneys, mostly representing small firm and solo practitioners.
- The co-head of intellectual property at Qualcomm, a U.S. company heavily dependent on patents.

The comment letter includes several important points concerning the burden of CLE. One point is worth noting: Under the 2020 *CLE Guidelines* as promulgated, the public must attend courses offered by the PTO. While the PTO is certainly qualified to teach CLE courses concerning its own regulations and procedures, the PTO isn’t involved in any of the phases of a patent’s life that create value (litigation, licensing, sale, etc.). The benefit of the CLE offered by the PTO is therefore of limited utility.

The PTO’s Supporting Statement purports to address both the 2020 *CLE Guidelines* and the August 2020 amendments to regulation. These are related, and, as noted below, each raises concerns.

### **Procedural omissions and errors in the NPRM, final rule, and *CLE Guidelines* guidance**

The PTO’s NPRM neglected any cost-benefit analysis of the CLE rule under Executive Order 12866, apparently because the CLE rule was contained in a Federal Register notice that, the PTO claims, incidentally involved a “transfer payment.”<sup>14</sup> We know of no estimate that places direct cost of these two collections of information at less than \$100 million per year.

---

<sup>13</sup> 35 U.S.C. § 5.

<sup>14</sup> NPRM, note 8, *supra*, 84 Fed. Reg. at 37400 col. 3. Our understanding of the term “transfer payment” as defined in Circular A-4 is that user fees exclusively for government consumption (with no subsidy in cash or in kind realized by any private sector entity, and no resources made available to any private sector entity for that party’s consumption) are not “transfer payments.” Many agencies set blanket user fees to cover 100% of agency costs; imprecise matching of individuated user fee to agency cost in regulating the specific party does not create a “transfer payment.” Likewise, our understanding is that a transfer payment in one part of a Federal Register notice does not exempt all other regulatory content of the notice, especially when the alleged transfer payment and the other regulatory content are entirely unrelated.

Similarly, the PTO's rulemaking omitted all disclosure of burden estimates, omitted request for comment, and was not accompanied by OMB filings required by the Part 1320 Information Collection regulations. In the NPRM<sup>15</sup> and final rule<sup>16</sup> notices, the PTO excused its omission of burden and request for comment based on a claim to have already obtained OIRA approval, when the public record shows the PTO made no relevant submission to OIRA. For example, in the NPRM, the PTO claimed that "The collection of information involved in this proposed rule has been reviewed and previously approved by OMB." 84 Fed. Reg. at 37431 col. 1:

U.S.C. 3501–3549). The collection of information involved in this proposed rule has been reviewed and previously approved by OMB under control numbers 0651–0012, 0651–0016, 0651–0020, 0651–0021, 0651–0031, 0651–0032, 0651–0033, 0651–0059, 0651–0063, 0651–0064, 0651–0069, and 0651–0075.

The PTO's claim is not correct. No relevant filings near the relevant times are visible at the relevant pages on OIRA's web site, let alone approvals.<sup>17,18</sup>

The October 2020 *CLE Guidelines* notice has no "Rulemaking considerations" section at all, so it cures none of these omissions.

It's not clear what meaning the PTO attaches to the word "proposed." The PTO states that the 2020 *CLE Guidelines* are to go into effect on March 1, 2022, with no contingency or required further action by the PTO. One consequence of this is that the guidelines are in effect immediately as a practical matter. The public has to start attending classes—for which the PTO is the only authorized provider—in order to have the requisite CLE credits by March 2022.

The 2020 CLE Guidance goes well beyond interpreting ambiguity in any regulation or statute. It is expressly designed to regulate conduct outside the agency. It therefore required "legislative" rather than "interpretative" rulemaking, and "substantive" rather than "procedural." But it contained no "Rulemaking considerations" section, and thus failed to comply with the Paperwork Reduction Act and several executive orders. Because the guidelines require practitioner action today, the PTO has promulgated the new collection of information by mere guidance in October 2020, with no published

---

<sup>15</sup> *Fee Setting NPRM*, note 8, *supra*, 84 Fed. Reg. at 37431 col. 1.

<sup>16</sup> *Fee Setting final rule*, note 1, *supra*, 85 Fed. Reg. at 46966 col. 3, at 46985, col. 2.

<sup>17</sup> <https://www.reginfo.gov/public/do/PRAOMBHistory?ombControlNumber=0651-0012>

<sup>18</sup> This has become a pattern in the PTO's recent NPRM and final rule notices: the PTO claims to have "previous approval" in one of a long list of control numbers, when no actual approval seems plausible, because none even have a relevant filing in the relevant time window.

estimates, no § 1320.8(a) and (b) internal review, no § 1320.8(c) submission to OIRA, no § 1320.8(d) comment period, no § 3506(c)(1)(B)(iii)(V) notice, and no clearance. There is no cost-benefit analysis under Executive Order 12866 and there is no indication of OIRA approval.

Additionally, we observe that Executive Order 12866 requires the PTO to “seek to harmonize Federal regulatory actions with related State, local, and tribal regulatory and other governmental functions.” The PTO made only the slightest effort to harmonize its CLE guidelines with state attorney bar regulation. States have good cross-recognition of CLE courses, but PTO proposes only minimal cross-recognition. This will create substantial duplication of costs, as attorneys comply with state and federal requirements that should be concurrent, but aren’t.

The PTO’s Supporting Statement in support of this ICR contains numerous omissions and inaccuracies. These are listed below.

- The Supporting Statement states<sup>19</sup> that “[the CLE provision] is not included in the information collection requests.... Additionally, the USPTO has not implemented collection of the biennial registration statement as detailed in the Final Rule published on Aug. 3, 2020.” The PTO’s representation to OIRA is not correct.
  - First, the PTO’s most-recent Federal Register notice says the opposite: the relevant regulated persons “will be *required* to biennially submit a *mandatory* registration statement beginning on March 1, 2022. On the registration statement, practitioners may state whether they have completed 6 credits of CLE within the previous 24 months.”<sup>20</sup> To submit information in March 2022, persons must prepare information **now**, while the PTO has no approval and states it is not even seeking one.
  - Second, the 2020 *CLE Guidelines* are characterized as mere “guidance,”<sup>21</sup> but the PTO proposes to attach binding, substantive, “required to obtain a benefit,” regulatory effect to this guidance, with an effective date of March 1, 2022.
  - Third, the registration requirement and CLE provision are not separable the way the PTO represents: the whole purpose of the PTO’s amendment to the “biennial registration statement” and its regulations is to collect CLE information.
- Attorney malpractice carriers may well set rates based on these certifications—they are unlikely to remain “voluntary” in any meaningful sense.

---

<sup>19</sup> Supporting Statement, note 2, *supra*, at 9.

<sup>20</sup> *CLE Guidelines*, note 1, *supra*, 85 Fed. Reg. at 64128 col. 1, emphasis added.

<sup>21</sup> *CLE Guidelines*, note 1, *supra*.



- In the Supporting Statement, the only discussion of the “registration statement” is the representation that it is “not implemented.” But the PTO simultaneously requests clearance for 11,000 additional responses for the very collection it represents as “not implemented.”
- The Supporting Statement ambiguously states that “Implementation of the voluntary CLE provisions is currently under development and the Office will update relevant information collections in advance of the collection of any information.” Again, this is not correct, because the practitioner burden is in effect **now** as a practical matter.
- The Supporting Statement represents as follows:

The USPTO has long-standing relationships with groups who frequently communicate their views on information collections, including the American Bar Association (ABA) and American Intellectual Property Law Association (AIPLA), as well as business groups and inventor associations. Views expressed by these groups are considered in developing proposals for information collection requirements and during the renewal of an information collection.

But AIPLA firmly opposed the CLE and registration requirements (Exhibit B).

### **Future Information Collection Request for CLE information**

If OIRA does clear Control Number 0651-0012, the terms of clearance should set the following conditions on any future PTO ICR governing any collection of CLE information:

- The PTO should be directed to run a Federal Register notice that no CLE information will be collected starting March 1, 2022, and that PTO will observe all requirements of the Paperwork Reduction Act and Information Collection Regulations before any such collection goes into effect. To prevent uncleared burden of collecting information, this notice should be run *immediately*.
- Public comment letters estimated costs of the PTO’s proposal at \$128 to \$153 million per year (see Exhibit A and Exhibit C), falling significantly on small entities. Any future ICR should start with those estimates, and proceed accordingly.
- The PTO should consult with the public and observe the regulatory principles and procedures of Executive Order 12866, including a Regulatory Impact Analysis for any rule expected to result in direct costs over \$100 million per year, before PTO submits any statement under the Executive Order or any further ICR.
- OIRA should remind the PTO of its statutory obligations, including the obligation to consult with the public to develop objective estimates of burden that can be included in an NPRM. The PTO’s \$1.6 million estimate of burden is hopelessly

unrealistic for a CLE program affecting several tens of thousands of professionals. After some inquiry with AIPLA and ABA, we were unable to locate any person with whom the PTO “conferred” to develop burden estimates; certainly no estimates were included in the NPRM or published contemporaneously with the NPRM. The PTO did not ask for comment on burden in the NPRM. The PTO did not take into account the reasoned estimates provided in public comments. Terms of clearance should remind the PTO of its obligation to propose burden estimates, to “fairly evaluate” comments, and to explain “how any collection of information contained in the final rule responds to the comments, if any, filed by the Director or the public.”<sup>22</sup>

- When the PTO “substantially modified” its proposal between NPRM and final rule, the PTO was required to make a submission to OIRA before publishing a final rule, with updated estimates and a public opportunity to comment on them.<sup>23</sup> Reginfo.gov shows no such submission.

In short, any collection of CLE information is not at the finish line, requiring only a simple “update [of] relevant information collections” as suggested in the Supporting Statement.<sup>24</sup> Terms of clearance should remind the PTO that even “voluntary” collections of information must meet all requirements of statute, regulation, and executive order. Almost certainly, that means going back to the pre-NPRM starting line. Most members of the public welcome meeting the PTO at that starting line, and engaging the PTO in the “consultation” required by law.

## **Biennial registration statement**

With particular regard to the biennial registration statements, the PTO’s Supporting Statement relates to August 2020 amendments to 37 C.F.R. § 11.11 and form PTO-107S (see Exhibit E). There are concerns here as well.

Why does the PTO need these changes to practitioner recognition? It is evident that the PTO’s rationale behind these changes is tied to the CLE mandate in the 2020 CLE Guidelines. With this realization, it is easy to see that all of the concerns expressed above regarding CLE apply equally to the “registration statement.”

Form PTO-107S originated in 2012, as a survey instrument to gather basic demographic information from admitted attorneys and agents. It asks for name, home and business address and contact information, other states in which an attorney is admitted, and whether the attorney has been disciplined, suspended, or disbarred in another state, or convicted of a crime. The major purpose was to “ping” attorneys

---

<sup>22</sup> 44 U.S.C. § 3506(c)(2), § 3507(a)(1)(D)(ii)(V), § 3507(d)(1)(A); 5 C.F.R. § 1320.5(a)(1) and (3), § 1320.8(a) and (d), and § 1320.11(b).

<sup>23</sup> 44 U.S.C. § 3507(d)(4)(D) and 5 C.F.R. § 1320.11(h)(2).

<sup>24</sup> Supporting Statement, note 2, *supra*, at 9-10.



periodically to ascertain whether they were still in the practice of law. Form PTO-107S was first added in ICR 201701-0651-001<sup>25</sup>, which the PTO designated “No material or nonsubstantive change to a currently approved collection.”

### **Procedural omissions and errors relating to the biennial registration statement**

The PTO made no mention of Form PTO-107S in any of three Federal Register notices, let alone any suggestion of expansion.<sup>26</sup> The PTO’s 60-day notice gave no explanation, and took no note of even the bare fact that the PTO was changing the numbers, let alone any program change that would explain a 3.3X increase. The only time the PTO has explained Form PTO-107S to OIRA, the PTO has characterized it as “No material or nonsubstantive change.”<sup>27</sup> The PTO’s Supporting Statement expressly declines to offer any differing explanation.

The PTO proposes to increase Form PTO 107S from 5000 responses per year, at 0.5 hours each, to 16,333 responses per year, at 0.25 hours each. But the PTO gives no rationale for either upping the number or dropping the burden per response. In fact, the Supporting Statement states expressly that PTO has no intent to use Form PTO-107S for any purpose at all (**bold emphasis added**), but rather seeks clearance of Form PTO-107S as a placeholder for a “player to be named later,” an entirely different collection of information.<sup>28</sup>

The Office has included PTO 107S as a draft modeled after the mandatory survey, and this version of the form **is not currently being implemented**. .... The estimated numbers published for PTO 107S represent a 3-year average of the number of respondents that **would** submit the biennial registration statement, **if** implemented, over the 3 years covered by this information collection. **If** the biennial registration statement is implemented, the Office will ensure any relevant information collections, including any associated estimated burdens, are updated prior to the collection of any information.

At best, the Supporting Statement is opaque, internally-contradictory, and confusing. Clearances are not fungible. The PTO cannot ask for clearance for Form PTO-107S today, and “bank it” for a different information collection in the future. OMB’s regulations require agencies to provide “objective support” for any increase in burden, which has never been provided. Because OIRA communicates with agencies *ex parte*, the rules of attorney professional ethics require that agencies be “candid” with OIRA.

---

<sup>25</sup> [https://www.reginfo.gov/public/do/PRAViewICR?ref\\_nbr=201701-0651-001](https://www.reginfo.gov/public/do/PRAViewICR?ref_nbr=201701-0651-001)

<sup>26</sup> *Proposed CLE Guidelines*, note 1, *supra*; Final rule, note 1, *supra*, 85 Fed. Reg. at 46992; or NPRM, note 8, *supra*, 84 Fed. Reg. at 37400 col. 3.

<sup>27</sup> [https://www.reginfo.gov/public/do/PRAViewICR?ref\\_nbr=201701-0651-001#section0\\_anchor](https://www.reginfo.gov/public/do/PRAViewICR?ref_nbr=201701-0651-001#section0_anchor)

<sup>28</sup> Supporting Statement, note 2, *supra*, at 9-10.

The Supporting Statement tells OIRA that PTO-107S “is not currently being implemented.” The PTO’s representation is inconsistent with the PTO’s other statements, and internally inconsistent with itself: the PTO’s most-recent Federal Register notice tells the public that “required” submission will begin March 1, 2022,<sup>29</sup> that persons must begin gathering information now so it can be submitted in 2022, and the Supporting Statement requests 11,333 new responses.<sup>30</sup>

Form PTO-107S, to the degree it would implement a future biennial registration statement, suffers from the same procedural omissions and errors we listed above for the CLE requirement:

- The PTO did not “confer with the public” in advance of the NPRM to assess practical utility or develop objective estimates of burden, did not publish estimates in the NPRM, did not ask the four questions required by § 3506(c)(2)(A), did not make the filing with OIRA that was required when the PTO made a “material change” between NPRM and final rule, did not publish revised estimates or response to comment in the final rule, and did not fairly respond to comments.<sup>31</sup>
- During the 60-day comment period, the PTO received one comment through regulations.gov,<sup>32</sup> and an unknown quantity more via email and other submission channels. The PTO’s Supporting Statement cannot be characterized as a “fair evaluation,” § 3506(c)(1), of the comment letter: For example, the letter challenged the PTO’s numerical estimates, and offered a rationale under which the estimate for Form PTO-107S should be retained at 0.5 hours. The Supporting Statement takes no note of the issue, let alone the fair response to comments implied by § 3507(d)(2)(A). Because the PTO does not explain otherwise, OIRA should read the Supporting Statement as a disclaimer of any future intent to use Form PTO-107S for any purpose other than its current use.
- Any form that has to be completed only once every two years, and that bears a legend in red that it is **MANDATORY** with the threat that an attorney is about to lose one’s livelihood, requires considerable time to review instructions, to collect, validate, and verify information, to complete the information into a PDF form (the PTO’s PDF forms are seldom configured for simple automated generation—most require hand-keying of information), and recordkeeping (5 C.F.R. § 1320.3(b)—

---

<sup>29</sup> *CLE Guidelines*, note 1, *supra*, 85 Fed. Reg. at 64128 col. 1 (“... registered patent practitioners and [other covered] individuals ... *will be required* to biennially submit a *mandatory* registration statement beginning on March 1, 2022” with no contingencies, emphasis added).

<sup>30</sup> Supporting Statement, note 2, *supra*, at 14 line 5 (this line in 2017 requested 5000 responses; the PTO now requests 16,333).

<sup>31</sup> See the section on “Procedural omissions”, *supra*.

<sup>32</sup> <https://www.regulations.gov/document/PTO-P-2020-0070-0001/comment>

0.5 hours is the **lowest** credible estimate. The PTO offers no explanation for reducing its estimate to 0.25 hours, and it seems noncredible.

- The PTO certifies<sup>33</sup> that § 11.11 and Form PTO-107S “will be consistent and compatible with current reporting and recordkeeping practices.” Yet no existing recordkeeping practice corresponds to the PTO’s expansion of use of this form.
- The PTO certifies<sup>33</sup> that the August 2020 amendments to § 11.11 and its proposed use of Form PTO-107S are “developed by an office that has planned and allocated resources for the efficient and effective management and use of the information to be collected.” In contrast, neither the NPRM nor the final rule articulated anything more than “theoretical” utility to the agency or the public.

As with the CLE collection of information, the procedural problems prevent clearance for the “biennial registration statement.”

### **Terms of clearance for this ICR, and limits on any future ICR directed to Form PTO-107S and the “biennial registration statement”**

Terms of clearance should limit the PTO’s collection of Form PTO-107S accordingly—its old number of responses (5000 per year), old burden per response (0.5 hours), for its old purpose (as needed when attorneys change their contact information, and for statistical purposes).

The alternative would require that OIRA assume that PTO envisions an ulterior purpose—the imposition of an annual fee or other proposed practitioner requirements. As the AIPLA noted in its January 7 letter (Exhibit B at pages 2-3):

AIPLA believes that the biennial registration requirements and CLE reporting systems are unnecessary and will ultimately lead to an active practitioner fee. ... The Office has not identified the specific benefit to users of the Office’s services or to the general public that may result from this proposed expansion. And with respect to the present proposal, the Office has identified no legitimate need or purpose for the proposed expansion, specifically, imposing a federal CLE program and biennial registration statement requirement. The proposal thus appears to fail substantively to meet the requirements for agency action.

As the AIPLA and others wrote in a January 2021 comment period,<sup>34</sup> many fear that this collection of information is a beachhead for future “slippery slope” expansion beyond

---

<sup>33</sup> [https://www.reginfo.gov/public/do/PRAViewICR?ref\\_nbr=202102-0651-003#section0\\_anchor](https://www.reginfo.gov/public/do/PRAViewICR?ref_nbr=202102-0651-003#section0_anchor)

<sup>34</sup> <https://www.uspto.gov/learning-and-resources/patent-and-trademark-practitioners/cle-guidelines-request-comments>

PTO's statutory authority to "recognize" attorneys. This fear is laid out in AIPLA's letter (Exhibit B at pages 3-4).

Terms of clearance should note these limits on the PTO's use of Form PTO-107S:

- Any regulatory requirement for any "biennial registration statement" was promulgated without observance of law. 5 C.F.R. § 1320.8, .9, and .11.
- Agencies may not request information that is "unnecessarily duplicative of information otherwise reasonably accessible to the agency."<sup>35</sup> The information the PTO would receive by biennial use of PTO-107S would be entirely duplicative, and unnecessarily so. Attorneys and agents are currently required to provide contact information and to update their contact information when they move. The PTO already has the information it requests, and offers no explanation for why biennial duplicative collection is required.
- Agencies may only request information of "practical utility," "not merely theoretical."<sup>36</sup> The PTO made no showing of "practical utility" or need for Form PTO-107S in any of its 2019-2020 Federal Register notices. The PTO mentions "theoretical or potential usefulness" to the agency, but the PTO offers no "demonstrate[ion of] actual timely use for the information either to carry out its functions or make it available to third-parties or the public," as required by § 1320.3(l).
- Form PTO-107S was first added in ICR 201701-0651-001, which the PTO designated "No material or nonsubstantive change to a currently approved collection." In its January 2017 Supporting Statement, the PTO explained its use of Form PTO-107S, "Statistical methods will be used in the survey." In contrast, in this Supporting Statement, the PTO states (§ 18(b)), "This collection of information does not employ statistical methods." There are two incongruities—in 2017, adding a 2500-hour collection of information as "no material change," and today's representation that is opposite the PTO's claim in 2017. If Form PTO-107S will no longer be used for statistical purposes, the PTO seems to have abandoned its only claim for "practical utility." Clearance should be limited accordingly.
- The PTO's Supporting Statement (§ 5) claims "This collection of information does not impose a significant economic impact on small entities or small businesses." A sizeable fraction of attorneys and agents that would be affected by the PTO's new use of Form PTO-107S are solo practitioners, employed by small entity law

---

<sup>35</sup> 44 U.S.C. § 3506(c)(3); 5 C.F.R. § 1320.5(d)(1)(ii).

<sup>36</sup> 44 U.S.C. § 3502(11), § 3506(c)(2)(A)(i), § 3506(c)(3)(A); 5 C.F.R. § 1320.3(l)

firms, and/or represent small entity clients. OIRA should read the Supporting Statement as a disclaimer of any intent to add any “biennial registration statement” use of Form PTO-107S that would have any effect on these persons.

- The PTO is required to “minimize the burden of the collection of information on those who are to respond, including through the use of automated collection techniques or other forms of information technology.” 44 U.S.C. § 3506(c)(2)(A)(iv). The PTO only seeks clearance for a paper form, rather than, for example, a web page that has the attorney’s current information pre-seeded, and allows updating of specific fields.

### **Another rulemaking implicating control number 0651-0012**

In July 2020, the PTO ran another NPRM, *Changes to Representation of Others Before the United States Patent and Trademark Office*, 85 Fed. Reg. 45812 (Jul. 30, 2020). A few of the additional collections of information are rather large. For example, the rules for reinstatement after suspension or lapse are significantly changed. Strikingly, even though the changes can alter careers for affected individuals, the PTO claims that the rule is “not significant” under Executive Order 12866. This NPRM proposes no estimates, and neglects to ask the statutorily-required questions to seek comment on the estimates. This NPRM claims that “The collections of information involved in this rulemaking have been reviewed and previously approved by OMB under OMB control numbers 0651-0012 [and 0017]” when no relevant filings at OMB are observable at [reginfo.gov](https://www.reginfo.gov). The PTO would be well advised to run a replacement Notice of Proposed Rulemaking, updated to reflect its current proposal, as a vehicle for compliance with the PRA.

### **Conclusion**

Terms of clearance should limit the PTO to only the collections of information cleared in 2017.<sup>37</sup> There should be no clearance for the collections of information embodied in the October 2020 *CLE Guidelines* or the August 2020 amendments to § 11.11, because the PTO failed to lay the procedural prerequisites during rulemaking, and this ICR is insufficient to cure past omissions. OIRA should remind the PTO that future clearance will not be available for these collections of information via a simple “update” of its information collections and should remind the PTO to proceed in

---

<sup>37</sup> ICR 201908-0651-007 and 202007-0651-003 were both characterized as “No material or nonsubstantive change to a currently approved collection,” and only proposed fee adjustments, no program-related change to burden.

accordance with law in the future.<sup>38</sup> As AIPLA notes, among the most important obligations of law is to give meaningful response to comments, not avoidant or evasive.<sup>39</sup>

OIRA should direct the PTO to publish a “stand down” notice immediately. Though the PTO represents to OIRA that these two collections of information are not “implemented,”<sup>40</sup> that representation is not correct. One is in full effect now, 85 Fed. Reg. 46932 (effective date of Oct. 2, 2020), and the other creates burden now, for “generating and retaining information,” 5 C.F.R. § 1320.3(b)(1) for submission in the future.

A single point of contact can refer specific issues to specific authors of various sections of this letter. Please route any questions or further inquiries to David Boundy, [DavidBoundyEsq@gmail.com](mailto:DavidBoundyEsq@gmail.com), (646) 472-9737.

Respectfully submitted,  
85 Patent Practitioners

---

<sup>38</sup> In 2011, in response to Executive Order 13563, the PTO requested comment on improvements to its regulatory processes. One of the comment letters laid out a fairly complete step-by-step checklist. David Boundy, *Improving Regulation and Regulatory Review*, <https://www.uspto.gov/sites/default/files/documents/boundy23may2011.pdf> at pages 6-3 (May 23, 2011). Another, by Dr. Richard Belzer, pointed out systematic deficiencies that could be corrected. <https://www.uspto.gov/sites/default/files/patents/law/comments/belzer14apr2011.pdf> Those two letters may be helpful to the PTO now.

<sup>39</sup> Exhibit B at 4 n. 8, 5; 44 U.S.C. § 3506(c)(1).§ 3507(a)(1)(B) and § 3507(d)(2)(A) and (B); 5 C.F.R. § 1320.5(a)(1)(ii), 5 C.F.R. § 1320.8(d)(1), and § 1320.11(f).

<sup>40</sup> Supporting Statement, note 2, *supra*, at 9.



David S Alavi  
Eugene, OR

Matthew S. Anderson  
Munck Wilson Mandala LLP  
Dallas, TX

Richard A. Baker, Jr  
New England Intellectual Property, LLC  
West Newbury, MA

Owen J. Bates  
Law Office of Owen J. Bates  
San Jose, CA

Sid Bennett  
Brinks Gilson & Lione  
Chicago, IL

Robert A. Blaha  
Smith Tempel Blaha LLC  
Atlanta, GA

Matthew J. Booth  
Matthew J Booth PC  
Austin, TX

David Boundy  
Cambridge Technology Law LLC  
Cambridge, MA

Roger L. Browdy  
Browdy and Neimark, PLLC  
Washington, DC

Michael J. Brown  
Michael J Brown Law Office LLC  
Livingston, NJ

Julie Burke  
IP Quality Pro LLC  
Laguna Beach, CA

Edward Caja  
Walter Haverfield LLP  
Cleveland, OH

Brian Cronquist  
MonolithIC 3D Inc.  
Klamath Falls, OR

David H. Chervitz  
Stoma Ventures, LLC  
Chesterfield, MO

Marcellus A. Chase  
Randall Danskin, PS  
Spokane, WA

Timothy Dell  
Colchester, VT

William Eshelman  
Law Office of William Eshelman  
Front Royal, VA

John K Fitzgerald  
Fitzgerald IP Law  
Box Elder, SD

Derek P. Freyberg  
Menlo Park, CA

Luis Figarella  
Matrix Patent Agency  
Nashua, NH

Daniel Feigelson  
Rehovot, Israel

Ury Fischer  
Lott & Fischer, PL  
Coral Gables, FL

Charles L. Gholz  
Oblon  
Alexandria, VA

Bernard J. Greenspan  
Greenspan IP Management  
San Diego, CA

Gregory B. Gulliver  
Addyhart, P.C.  
Chicago, IL

Diana Hamlet-Cox  
Millen White Zelano & Branigan PC  
Arlington VA

John M. Hammond  
Patent Innovations LLC  
Lakeville, NY

Steven Hertzberg  
New York, NY

Greg Holtrigel  
CooperVision, Inc.  
San Clemente, CA

Allen Hoover  
Fitch Even  
Chicago, IL

Kenneth E. Horton  
Kirtan McConkie PC  
Salt Lake City, UT

Krista S. Jacobsen  
Jacobsen IP Law  
Campbell, CA

Ronni S. Jillions  
Browdy and Neimark, PLLC  
Washington, DC

Todd L. Juneau  
Juneau & Mitchell IP Law  
Alexandria, VA

Jeffrey S Kapteyn  
Price Heneveld LLP  
Michigan

Ronald R Kilponen  
Kilponen Law Office  
Novi, MI

Karen King  
South Plainfield, NJ

Katherine Koenig  
Koenig IP Works, PLLC  
Fort Lauderdale, FL

Herb Lacey  
Innatricity

James E. Lake  
Randall Danskin, PS  
Spokane, WA

Guy Letourneau  
Vytis, Ltd.  
Phoenix, AZ

Gary Levin  
Karnei Shomron, Israel

Mary Frances Ludwig  
Kintner IP, LLC  
Kintnersville, PA

Guy Manning  
Law Offices of Guy V Manning  
Fort Worth, Texas

Steven K Martin  
Altman & Martin  
Boston, MA

Craig McLaughlin  
AddyHart, P.C.

Kevin J. McNeely  
Browdy and Neimark, PLLC  
Washington, DC

Matthew G. Miller  
MG Miller IP Law, LLC  
New York, NY

Richard Neifeld  
Neifeld IP Law, PLLC  
Fairfax, VA

Sam L. Nguyen  
HDC IP Law, LLP  
Saratoga, CA

Tim Nolan  
Tim Nolan Patent Agent LLC  
Blacksburg, VA

Mark S. Nowotarski  
Markets, Patents & Alliances LLC  
Darien, CT

Sean O'Connell  
Sean O'Connell, PLLC  
Edmond, OK

Gary O'Neill  
Examiners Edge  
Dallas, Texas

Neil R. Ormos  
Arlington Heights, IL

Karen Oster  
Lake Oswego, OR

Henry Park  
Law Office of Henry Park, PC

Gerald T. Peters  
JTT Patent Services, LLC  
West Lebanon NH

John K. Pike  
Law Office of John K. Pike, PLLC  
Alexandria, VA

Margaret Polson  
Polson IP Law, PC  
Westminster, CO

David M. Quinlan  
David M. Quinlan, P.C.  
Princeton, NJ

C. Dale Quisenberry  
Quisenberry Law PLLC  
Houston, TX

Leah M. Reimer  
Cantor Colburn LLP  
Hartford, CT

Z. Peter Sawicki  
Westman, Champlin & Koehler  
Minneapolis, MN

Jeffrey E. Semprebon  
Semprebon Patent Services  
Claremont, NH

Richard A. Schafer  
Schafer IP Law  
Houston, TX

Brian Siritzky  
Siritzky Law, PLLC  
McLean, VA

Alex R. Sluzas  
Paul and Paul

Marlin R. Smith  
Smith IP Services, P.C.  
Rockwall, TX

Timothy M. Smith  
Smith & Woldesenbet Law Group, PLLC  
Sugar Land, TX

Rodney L. Sparks  
RenovaCare, Inc.  
Roseland, NJ

Dana Stangel  
MacMillan, Sobanski & Todd LLC  
Fort Collins, CO

Richard Straussman  
Weitzman Law Offices, LLC  
Roseland, NJ

Jack F Stuart II  
Martensen IP  
Colorado Springs, CO

Suzannah K. Sundby  
Canady + Lortz LLP  
Washington DC

Alan Taboada  
Moser Taboada  
Shrewsbury, NJ

Daniel A. Tesler  
Law Offices of Daniel A. Tesler, LLC  
Beverly, MA

Doreen Y. Trujillo  
Saul Ewing Arnstein & Lehr LLP  
Chesterbrook, PA

Louis Ventre, Jr.  
Law Firm of Louis Ventre, Jr.  
Oakton, VA

Eitan Waks  
Israel

Patricia P. Werschulz  
Werschulz Patent Law, LLC

Warren Wolfeld  
Half Moon Bay, CA

Terrence M. Wyles  
Startup IP Law, LLC

Bruce A. Young  
Young's Patent Services, LLC  
Le Mars, IA

Allen Yun  
Browdy and Neimark, PLLC  
Washington, DC

Attachments:

Exhibit A Calculation of numbers used in this letter

Exhibit B Comment letter of American Intellectual Property Law Association (AIPLA) on *Proposed Continuing Legal Education Guidelines*, Docket No. PTO-P-2020-0042, 85 Fed. Reg. 64128 (Oct. 9, 2020), [https://www.uspto.gov/sites/default/files/documents/AIPLA Letter to USPTO on CLE Guidance 010721 FINAL.pdf](https://www.uspto.gov/sites/default/files/documents/AIPLA%20Letter%20to%20USPTO%20on%20CLE%20Guidance%20010721%20FINAL.pdf) (Jan. 7, 2021)

Exhibit C 60-day comment letter of 109 Patent Practitioners re Information Collection 0651-0012, from <https://www.regulations.gov/comment/PTO-P-2020-0070-0002>

Exhibit D Comment letters on *Proposed Continuing Legal Education Guidelines*, 85 Fed. Reg. 64128 (Oct. 9, 2020).

Exhibit E Form PTO-107S, 2020 and 2013 versions, from [https://www.uspto.gov/sites/default/files/documents/PTO107S\\_Mandatory\\_Survey.pdf](https://www.uspto.gov/sites/default/files/documents/PTO107S_Mandatory_Survey.pdf)

# **Exhibit A**

## **Calculations**

**assumptions**

attorneys in no-CLE states, and agents (that is, agents and attorneys with no existing CLE requirement)	13066
attorneys in CLE states	19600
percentage overlap: for PTO-approved CLE, how many courses does the PTO submit to states for state credit?	50%
percentage of courses by non-PTO private sector providers	67%
percentage of courses taken live (as opposed to online)	25%
hours travel for each live course (round trip)	2
for live courses, average travel cost (about 1/3 require a hotel)	150
percentage that aren't free	50%
for non-fee courses, average tuition	400
agent/attorney rate	400

20%

**Scenario 1: 50% overlap**

	number of instances	instances per capita	total
<b>Compute total number of course hours</b>			
total number of course hours for agents and for attorneys in states with no existing CLE requirement	13,066	6	78,396
incremental course hours for attorneys in CLE states	19,600	3	58,800
total number of course hours biennially			<b>137,196</b>

**Scenario 2: 20% overlap**

instances per capita	total
6	78,396
4.8	94,080
	<b>172,476</b>

hourly burden per TWO year reporting cycle	agents and non-CLE states	CLE states	
incremental hours browsing CLE catalogs	6	4	156,796
incremental hours registering, calendar management	1.8	0.9	41,159
hours maintaining records	1.2	0.8	31,359
hours travel			68,598
taking the courses (one hour each)			137,196
hours to collect the papers and report	1	1	32,666
total hours per two-year cycle			<b>467,774</b>

CLE states	
4	156,796
0.9	41,159
0.8	31,359
	86,238
	172,476
1	32,666
	<b>520,694</b>

<b>convert biennial to annual, convert hours to \$</b>			
attorney rate	400		<b>\$93,554,800</b>

	<b>\$104,138,800</b>



<b>non-hour costs</b>			
annual tuition costs			\$13,719,600
for live courses, annual total travel costs			\$5,144,850

<b>total burden on attorney/agent</b>			<b>\$112,419,250</b>
---------------------------------------	--	--	----------------------

<b>Burden on private-sector CLE providers to obtain PTO approval for PTO CLE credit</b>	number of instances annually	burden per instance	
Annual accreditation fee per provider	500	\$500	\$250,000
Per course approval fee	2,000	\$75	\$150,000
Presenter's prep per course (first time)	1,000	\$7,000	\$7,000,000
Presenter's prep per course (repeat offering)	1,000	\$2,000	\$2,000,000
Infrastructure for presentation: promotion, room, a second person as host/moderator/interlocutor, videographer and/or technology support, recordkeeping in case of audit, certificates (generation, sending, replacement of loss)	2,000	\$3,000	\$6,000,000
<b>burden on private sector CLE providers</b>			<b>\$15,400,000</b>

<b>Cost to PTO to obtain state MCLE Board approval for courses offered by PTO</b>			
Annual accreditation fees paid to states	35	\$300	\$10,500
Per-course or per-capita fees paid to states to obtain state approval of PTO-offered CLE	7000	55	\$385,000
PTO's salary cost -- assume 1 FTE			\$150,000
staff time to present CLE -- counted at zero, because the PTO is already doing so. 5 C.F.R. § 1320.3(b)(2)			0
<b>Cost to PTO</b>			<b>\$545,500</b>

<b>total burden</b>			<b>\$128,364,750</b>
---------------------	--	--	----------------------

	\$17,247,600
	\$6,467,850

	<b>\$127,854,250</b>
--	----------------------

number of instances annually	burden in scenario 2
500	\$250,000
3,200	\$240,000
1,600	\$11,200,000
1,600	\$3,200,000
3,200	\$9,600,000
	<b>\$24,490,000</b>

35	\$10,500
7000	\$385,000
	\$150,000
	0
	<b>\$545,500</b>

	<b>\$152,889,750</b>
--	----------------------

## **Exhibit B**

### **Comment letter of American Intellectual Property Law Association (AIPPLA) on Proposed Continuing Legal Education Guidelines (Jan. 7, 2021)**



## American Intellectual Property Law Association

January 7, 2021

Attn: William Covey, Director for the Office of Enrollment and Discipline  
Mail Stop OED  
The United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

*Via Email: [CLEguidelines@uspto.gov](mailto:CLEguidelines@uspto.gov)*

**Re: Request for Comments on Proposed Continuing Legal Education Guidelines  
[Docket No. PTO-P-2020-0042]**

Dear Director Covey:

The American Intellectual Property Law Association (“AIPLA”) is pleased to have the opportunity to present its views to the United States Patent and Trademark Office (“Office” or “USPTO”) in response to the Request for Comments on Proposed Continuing Legal Education Guidelines published in 85 Fed. Reg. 197 (October 9, 2020) (“2020 CLE Guidelines”).

Founded in 1897, the American Intellectual Property Law Association is a national bar association of approximately 8,500 members who are primarily engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public’s interest in healthy competition, reasonable costs, and basic fairness.

AIPLA values its long relationship of working in partnership with the Office to foster innovation. In this instance, AIPLA’s member advocacy requires us to provide the following feedback that expresses our opposition to the Office’s proposal for CLE oversight.

The Office issued proposed 2020 CLE Guidelines that state:

The goal of the proposed guidelines is to clarify for registered practitioners and those granted limited recognition pursuant to 37 C.F.R. § 11.9(b) what types of CLE classes or activities will qualify for USPTO CLE credit. The guidelines also seek to establish a procedure for approving CLE courses that would qualify for USPTO CLE credit. Finally, the guidelines seek to establish the type of recognition practitioners will receive if they certify on their registration

statements that they have completed 6 credits of CLE in the preceding 24 months.<sup>1</sup>

AIPLA is concerned that the Office's proposal will eventually result in a mandatory CLE program and an infrastructure to support its efforts, which will necessitate costly administrative resources. Ultimately, these costs will be passed onto innovators and the public. AIPLA strongly objects to these proposals and expansion of administrative activities.

More specifically:

1. While AIPLA supports practitioners maintaining professional competency, including by participating in CLE, we *oppose* the ongoing efforts by the Office to institute a *de facto* CLE requirement and establish federal oversight of such requirement, which appears to burden both the public and the Office, particularly when the Office never sufficiently analyzed such burdens or any potential benefit to the public.
2. AIPLA *opposes* the Office implementing a *federal* CLE reporting system. Practitioners are required to maintain legal competency under at least 37 C.F.R. §§ 11.6, 7, and 101. No further public notice beyond the current system is needed.
3. AIPLA *opposes* the Office's efforts to define what constitutes a qualifying IP-related CLE program. Numerous states already define and certify CLE programs. Adding federal definition or certification would unnecessarily duplicate and possibly conflict with state determinations.
4. AIPLA is further concerned rulemaking efforts regarding 37 C.F.R. § 11.11 fail to comply with federal rulemaking requirements, including, but not limited to, failure to comply with the Notice and Comment provisions of 5 U.S.C. § 553. We are concerned that establishing final rules under, for example, § 11.11 as set forth in 85 Fed. Reg. 197 (October 9, 2020), did not comply with statutory requirements and should be withdrawn.
5. AIPLA believes that the biennial registration requirements and CLE reporting systems are unnecessary and will ultimately lead to an active practitioner fee.

As set out in greater detail below, the Office has repeatedly proposed to expand the Office of Enrollment and Discipline (OED), and to impose the increased administrative costs of this expansion on patent practitioners through a registration fee system.<sup>2</sup> Several of these prior proposals have not been enacted, yet, the Office continues to propose this expansion in various forms. This expansion would: (1) require additional staff and resources to monitor and oversee as-yet undefined programs; (2) create new administrative burdens on practitioners; (3) disproportionately affect patent applicants—small and individual inventors and their counsel—who can least afford to pay these increases; and (4) create additional mandates for the Office that distract from the fundamental mission of the Office to examine patent applications.

---

<sup>1</sup> CLE Guidelines, 85 Fed. Reg. at 64128 (Oct. 9, 2020) ["Proposed 2020 CLE Guidelines"]

<sup>2</sup> See Section I, *infra*.

Under the Administrative Procedure Act (APA), Paperwork Reduction Act, and other statutes, the Office is required to justify these proposals substantively. It has not. The Office has not sufficiently identified any need that would justify expanding OED's function. The Office has not identified the specific benefit to users of the Office's services or to the general public that may result from this proposed expansion. And with respect to the present proposal, the Office has identified no legitimate need or purpose for the proposed expansion, specifically, imposing a federal CLE program and biennial registration statement requirement. The proposal thus appears to fail substantively to meet the requirements for agency action. Further, by failing to consider public comments, AIPLA is concerned that the Office did not comply with the requirements of the APA for Notice and Comment Rulemaking.

AIPLA emphasizes that our objections relate to our significant concerns about the Office's involvement in any aspect of controlling, monitoring, or publishing CLE requirements or compliance. We do, nonetheless, encourage all patent practitioners to continue their legal education. Many organizations, including AIPLA, provide IP-related CLE that is monitored and approved by many state bars. AIPLA sees no benefit in adding federal oversight and administrative burden to an otherwise functioning CLE system.

The remainder of our comments address the evolution of the Office's efforts, greater detail outlining the positions noted above and fundamental faults with the Office's recent rulemaking.

## **I. Prior CLE and Practitioner-Fee Rulemaking Attempts**

Since at least 2003, the Office has attempted to expand its oversight of practitioners by, *inter alia*, proposing additional administrative burdens to practitioners and new practitioner fees to pay for such activities, and establishing oversight and management of Continuing Legal Education (CLE) requirements.<sup>3</sup>

In 2003, the USPTO published a Notice of Proposed Rulemaking (NPRM) aimed at changing the rules of practice before the Office ("2003 NPRM").<sup>4</sup> The USPTO did not issue a final rule following this 2003 NPRM, but in 2007 did issue a new federal register notice that made revisions to the original proposals ("2007 NPRM").<sup>5</sup>

---

<sup>3</sup> See, e.g., USPTO, *OED Federal Register Notices*, available at <https://www.uspto.gov/learning-and-resources/patent-and-trademark-practitioners/oed-federal-register-notices>. In 2003, the USPTO proposed, in part, that "(t)o maintain active status, the practitioner would pay the annual fee required under §§ 1.21(a)(7)(i) and 11.8(d) and comply with the continuing legal education (CLE) requirements under §§ 11.12(a) and (e)." See *Changes to Representation of Others Before the United States Patent and Trademark Office*, 68 Fed. Reg. 69442 (Dec. 12, 2003). The instant AIPLA letter responds to the Office's Oct. 9, 2020 request for comments where "... the Office seeks feedback and information regarding the proposed CLE guidelines attached as Appendix 1. The goal of the proposed guidelines is to clarify for registered practitioners and those granted limited recognition pursuant to 37 C.F.R. § 11.9(b) what types of CLE classes or activities will qualify for USPTO CLE credit. The guidelines also seek to establish a procedure for approving CLE courses that would qualify for USPTO CLE credit. Finally, the guidelines seek to establish the type of recognition practitioners will receive if they certify on their registration statements that they have completed 6 credits of CLE in the preceding 24 months." Proposed 2020 CLE Guidelines.

<sup>4</sup> 68 Fed. Reg. 69442.

<sup>5</sup> 72 Fed. Reg. 9196 (Feb. 28, 2007). The Office "proposed amendments to, *inter alia*, the rules governing disciplinary proceedings for attorneys and agents who practice before the Office, principally rules 11.2, 11.3, 11.5, and 11.14 through 11.62. One hundred fifty-seven written comments were received. After reviewing the

Following receipt of comments to the 2007 NPRM, the Office decided that, because the “revised proposed sections eliminate or introduce substantive and procedural changes to the proposed rules,”<sup>6</sup> it would not specifically address the comments it received.

On August 14, 2008, the Office issued a final rule based on the 2007 NPRM titled “Changes to Representation of Others Before the United States Patent and Trademark Office”<sup>7</sup> (“2008 Final Rule”) where the Office declined to implement the previously proposed practitioner fee and CLE requirements. In this 2008 Final Rule, the Office also declined to answer the bulk of the comments that had been submitted<sup>8</sup> and the matter seemed to have been dropped by the Office until formally revisited as part of an NPRM issued on July 31, 2019 (“2019 NPRM”),<sup>9</sup> some eleven years later.

Despite the repeated efforts that yielded no promulgation of rules, there is a continued attempt to implement CLE and practitioner-fee rules with no explanation of why they are needed now. AIPLA is unaware of what, if anything, has changed.

## II. 2019 NPRM and 2020 Final Rule

### A. Summary

As part of the authorities granted under Section 10 of the Leahy-Smith America Invents Act (“AIA”), the USPTO issued the 2019 NPRM proposing an active patent practitioner fee and an associated discount for completion of an undefined CLE requirement.<sup>10</sup>

The USPTO received 84 comments critiquing both the necessity for the patent practitioner fee (PPF) and the merits of a USPTO administered CLE program. In the Final Rule notice,<sup>11</sup> the Office stated *eighty times* that it declined to address the merits of most comments, because it would not be acting in this area.<sup>12</sup> Instead, the USPTO withdrew the PPF requirement. However, with only minimal discussion in the rule preamble,<sup>13</sup> the Office created a new requirement that practitioners file an as-yet undefined biennial practitioner registration

---

written comments, the Office has decided to revise several of the rules as then proposed and request additional comments on those revised proposals. Other proposed rules contained in the earlier Notice of Proposed Rule making remain under consideration by the Office. This supplemental notice of proposed rule making sets forth revisions that the Office is proposing to the rules governing the conduct of investigations and disciplinary proceedings. Interested individuals are invited to comment on the proposed revisions in the rules.”

<sup>6</sup> 72 Fed. Reg. 9196, 9197.

<sup>7</sup> 73 Fed. Reg. 47650 (Aug. 14, 2008).

<sup>8</sup> In the 2008 Final Rule, the Office noted that it had received at least 157 comments regarding their rulemaking efforts. The 2008 Final Rule only responded to 65 of the comments, avoiding addressing issues relating to, among other things, practitioner fees and CLE requirements.

<sup>9</sup> 84 Fed. Reg. 37398 (July 31, 2019).

<sup>10</sup> 85 Fed. Reg. 46932, 46947-8 (Aug. 3, 2020). “In the NPRM, the USPTO proposed a new fee called the annual active patent practitioner fee, and an associated fee structure, under 37 C.F.R. §§ 1.21 and 11.8, so that patent practitioners, who directly benefit from registration, would bear the costs associated with maintaining the integrity of their profession, including the costs of OED’s register maintenance and disciplinary functions. . . . The annual active patent practitioner fee was proposed to be \$340, with a \$100 annual fee discount for those who certified completion of a certain number of CLE.”

<sup>11</sup> 85 Fed. Reg. 46932, 46960-68.

<sup>12</sup> 85 Fed. Reg. 46932, 46960-69, Responses to comments 81-163.

<sup>13</sup> 85 Fed. Reg. 46932, 46964.



statement in a final rule issued.<sup>14</sup> The Office also decided to postpone implementing this practitioner registration until March 1, 2022.<sup>15</sup> And, although the 2020 Final Rule indicates that the USPTO Director *may*<sup>16</sup> implement the registration statement, the USPTO appears to have interpreted the registration statement to be a *requirement* as promulgated in the proposed 2020 CLE Guidelines.<sup>17</sup>

In shifting policy and, at the same time, promulgating a Final Rule without answering the public's comments on the 2019 proposed rule, the USPTO summarily dismissed responding to the public's many concerns regarding CLE by stating that, as they did not adopt an "annual patent practitioner fee . . . there is no CLE discount in the Final Rule. . . [and] CLE remains voluntary, there was no need to address the public's concerns. However, [the Final Rule] provides that practitioners may be recognized in the online practitioner directory for completing" some CLE requirements.<sup>18,19</sup>

## **B. Proposed Expansion of OED**

### **1. CLE**

The Office has provided no evidence that IP CLE programs, more than those already available through a multitude of sources, are needed. Still further, AIPLA is unaware why the Office, via its OED, needs to implement any type of CLE program. AIPLA is also greatly concerned about the Office's intent to insert itself as an arbiter of CLE for patent practitioners. The Office's proposal of a *de facto* CLE requirement is also unjustified and should be withdrawn.

Most state bar associations require CLE for maintaining active bar membership. For state bars that do not require CLE, professional competence drives regular participation in educational programs. Similarly, for non-attorney IP practitioners, the continuous and evolving nature of IP law and practice acts as practical motivation for CLE. For example, patent prosecutors need to stay abreast of Office policy and procedures, court decisions, and changes in laws to comply with the Office's regulatory requirements under at least 37 C.F.R. §§ 11.5, 6, and 101.

### **2. Registration Statement**

The Office issued a rule to implement a proposed Biennial Registration Statement.

---

<sup>14</sup> See 37 C.F.R. § 11.11 as listed in 85 Fed. Reg. 46932, 46992.

<sup>15</sup> 85 Fed. Reg. 64128.

<sup>16</sup> See Final Rule of 37 C.F.R. § 11.11(a)(2) ("(2) Biennially, registered practitioners and persons granted limited recognition *may* be required to file a registration statement with the OED director for the purpose of ascertaining whether such practitioner desires to remain in an active status. Any registered practitioner, or person granted limited recognition under § 11.9(b), failing to file the registration statement or give any information requested by the OED director within a time limit specified shall be subject to administrative suspension under paragraph (b) of this section.); 37 C.F.R. § 11.11(a)(3)(i) ("A registered practitioner, or person granted limited recognition under § 11.9(b), who has completed, in the past 24 months, five hours of continuing legal education credits in patent law and practice and one hour of continuing legal education credit in ethics, *may* certify such completion to the OED director.") (Emphases added.)

<sup>17</sup> See, e.g., 85 Fed. Reg. 46932, 46942, 46948.

<sup>18</sup> 85 Fed. Reg. 46932, 46963, Response to Comment 109.

<sup>19</sup> The Final Rule published on August 3, 2020 (85 Fed. Reg. 46932), *in the absence of a previously proposed rule open to comment*, amends 37 C.F.R. § 11.11 to establish a biennial patent practitioner registration statement and a voluntary CLE certification.

AIPLA is not opposed, in principle, to registered patent practitioners maintaining current contact information and status on file with the Office. In fact, AIPLA supports the Office's requirement for practitioners to maintain up-to-date contact information as needed. AIPLA is, however, opposed to any rule requiring practitioners to periodically verify information in the absence of any change by the practitioner. If the goal is to clear the roster of inactive practitioners, AIPLA believes that there are easier ways to implement such a system.

The need to provide a registration statement biennially—when the practitioner needs to make no changes—is simply an additional administrative burden on the practitioners and the Office. Practitioners would need to docket and comply with additional paperwork that does nothing to enhance or support their ability to represent and advocate for inventors and innovators. This new paperwork is covered by the Paperwork Reduction Act,<sup>20</sup> but in the Final Rule notice, the Office declined to seek clearance under the Paperwork Reduction Act. Consider, for example, that in the Aug. 3, 2020 Final Fee Rule, the Office states that “(t)he collection of information involved in this Final Rule have been reviewed and previously approved by the OMB.”<sup>21</sup> According to the Office of Information and Regulatory Review's (OIRA) website, however, OMB review was not sought until *after* the Final Fee Rule was promulgated. Further, according the OIRA website, the information collection was not materially changed from prior approved collections,<sup>22</sup> whereas the changes to 37 C.F.R. § 11.11 are entirely new.

The Office would have to build an infrastructure, including hardware, software, and personnel, to establish and maintain records of biennial registration statements, as well as the new procedures for notifying compliance or lack thereof, the procedures for rectifying lack of compliance, and disciplinary action for practitioners who otherwise comply with all other requirements.

The Office's ongoing attempts at increasing oversight will set up a new cycle of compliance that is unrelated to core activities like preparing, prosecuting, defending, and supporting patent applications and patents.

### **C. Potential Duplication of State Efforts**

AIPLA is concerned that, should the Office act in any active capacity regarding CLE programs, it may unnecessarily duplicate state CLE requirements for attorney practitioners, potentially creating confusion and additional costs. Already, practitioners licensed in multiple jurisdictions must address differing requirements. The Office's proposal would add another layer of administrative complexity. Before the Office implements a program already underway in most states, it should first answer several critical questions about these duplicated efforts:

*How will the Office coordinate with state bar programs?*

---

<sup>20</sup> Paperwork Reduction Act 44 § USC 3506(c)(2). This 1980 Act is designed to reduce the total amount of paperwork burden the federal government imposes on private businesses and citizens.

<sup>21</sup> See 85 Fed. Reg. 46932, 46985.

<sup>22</sup> See *View ICR – OIRA Conclusion*, re Control No. 0651-0012, Office of Information and Regulatory Affairs, Office of Management and Budget, Executive Office of the President, [Reginfo.gov](https://www.reginfo.gov/public/do/PRAViewICR?ref_nbr=202007-0651-003), available at [https://www.reginfo.gov/public/do/PRAViewICR?ref\\_nbr=202007-0651-003](https://www.reginfo.gov/public/do/PRAViewICR?ref_nbr=202007-0651-003).

*If the Office gets in the business of certifying CLE programs, will it expand its staff to accommodate CLE oversight?*

*How will the Office resolve conflict between state and federal requirements?*

*Will the Office institute additional fees to pay for the staff and resources needed to certify a CLE program?*

*Will CLE providers (professional organizations, non-government entities (NGO's), and other CLE providers) be taxed to garner revenue for the Office to pay for its expansion?*

*From the perspective of current CLE providers, if a practitioner participates in a federal CLE program, will these CLE providers then have to convince state CLE regulators to accept such a program as compliance with state requirements?*

*Has the Office analyzed and justified the additional costs on patent agents? On CLE providers?*

The Office should consider further whether this additional federal involvement acts to hamper CLE providers from maintaining and updating their programs. For example, a CLE provider might be disincentivized if every new program would need state and now *federal* review.

#### **D. USPTO Has Not Adequately Quantified Burdens of Proposed Expansion**

The 2020 Final Rule establishes—*without a prior comment period*—37 C.F.R. § 11.11(a)(3), that practitioners may voluntarily certify their participation in CLE programs.<sup>23</sup> Aside from the Office's failure to comply with administrative procedures requiring public input, AIPLA is concerned that the suggestion that practitioners might voluntarily certify compliance with completion of CLE programs will significantly harm both practitioners and the clients they represent. For example, while the Office proposes CLE certification is voluntary, such certification will be publicized. The public will likely not understand the distinction between a voluntary and required certification. A public record that reports a lack of certification—by omission—essentially makes the CLE requirement mandatory. The public would not be on notice regarding *why* a practitioner might or might not choose to make a “voluntary” submission. In addition, patent agents and attorneys who do not have a state CLE requirement may have more difficulty meeting the requirements for CLE certification. This may include obtaining appropriate documentation of CLE certification, since often certification by states is done using bar numbers, and patent agents have none. Moreover, existing CLE providers may be excluded from the proposed expansion.

---

<sup>23</sup> 37 C.F.R. § 11.11(a)(3)(i) (“A registered practitioner, or person granted limited recognition under § 11.9(b), who has completed, in the past 24 months, five hours of continuing legal education credits in patent law and practice and one hour of continuing legal education credit in ethics, may certify such completion to the OED director.”); *Id.* at (ii) (“A registered practitioner, or person granted limited recognition under § 11.9(b), may earn up to two of the five hours of continuing legal education credit in patent law and practice by providing patent *pro bono* legal services through the USPTO Patent Pro Bono Program. One hour of continuing legal education credit in patent law and practice may be earned for every three hours of patent *pro bono* legal service.”)

Further, the specter of an OED investigation based on individual certification of the merits of a CLE program (as indicated in the proposed 2020 CLE Guidelines and new rule § 11.11), is unacceptable as this is a *voluntary* certification. Further exacerbating this problem is the proposed need for practitioners to maintain records of completion of CLE programs (currently undefined). This is particularly problematic because at least some practitioners, including patent agents and attorneys in states that do not require CLE, may have no way to obtain appropriate documentation of CLE certification.

In the proposed 2020 CLE Guidelines, the Office imposes additional burdens on practitioners. In the 2020 CLE Guidelines at § III, the Guidelines state that “[i]t is recommended that practitioners who certify completion of CLE keep records that substantiate such completion for three previous reporting periods (i.e., six years). Although there is no specific recordkeeping requirement, practitioners should be aware that the USPTO’s OED may request that a practitioner supply documentation that substantiates his or her completion of CLE or ‘other activities.’”

It is unclear how something can be voluntary, not require recordkeeping, and still be subject to requirements to produce documentation—documentation that, if not produced, could result in disciplinary action up to and including disbarment.

Given such consequences for a “voluntary” act, especially in the absence of a defined, existing problem that implementing a voluntary certification would solve, AIPLA submits that the USPTO must address a number of important questions before implementing such a burden on practitioners and their clients.

Further, the Office appears to have overlooked a requirement of law that even “voluntary” certifications are covered by the Paperwork Reduction Act.<sup>24</sup> Thus, if the Office intends to proceed with this “voluntary” program, it must start over and comply with the regulatory requirements and public review processes required by law.

*a. How will practitioners decide what records are required and how long to maintain such a paper trail?*<sup>25</sup>

Consider, for example, where a practitioner certifies that they took a class and therefore complied with the Office’s conception of CLE. Unless the class was pre-certified by some recognized entity, the practitioner would be uncertain whether the class was actually an appropriate CLE program. Currently, some states permit self-certification *of the fact that they participated in a CLE program that was previously endorsed by those states’ bar associations*. In these states, practitioners are *not* making a determination or certification that any specific CLE program meets any particular standard.

---

<sup>24</sup> See 5 C.F.R. § 1320.3I (coverage includes both “reporting” and “recordkeeping,” whether “voluntary, or required to obtain or retain a benefit”); § 1320.3I(4)(i) (coverage extends to “any requirement contained in a rule of general applicability”); *Id* at §§ 1320.10, .12 (coverage extends to paperwork whether created by regulation or by guidance).

<sup>25</sup> 44 USC § 3506(c)(2). See also Executive Order (E.O.) 12866, *Regulatory Planning and Review*, 58 Fed. Reg. 51735 (Oct. 4, 1993); OMB Circular A-4, *Regulatory Analysis*, 68 FR 58366 (Oct. 9, 2003).

*b. What public policy is served by the Office's current efforts? How do the Office's efforts support innovation and innovators? Why does the Office seek to expand the OED's activities with no justification and when no problem or issue has been identified and debated as required by at least 35 U.S.C. § 2?*

The Office has only made vague and unsubstantiated allegations of the need for the Office certifying CLE. It is understood that the Office is charged with regulating practice before the Office, but these new oversight authorities serve no apparent practical purpose. The Office provides no evidence that: 1) establishes significant lack of CLE participation in the patent bar; 2) establishes a problem that voluntary CLE is intended to solve; 3) voluntary CLE would actually solve such a problem; or 4) any public benefit is outweighed by the costs of establishing voluntary CLE.

Further, AIPLA submits that practitioner CLE certification with OED will lead to unintended consequences including additional burdens on both practitioners and the Office, and increased applicant costs (which disproportionately affect solo, small, and medium sized entities (SMEs)). It will also raise the specter of yet another way to render patents unenforceable as a result of practitioners being accused of failing to properly comply with yet another set of administrative requirements. This raises yet another important question.

*c. Where does the Office obtain the required resources to implement the proposed programs?*

AIPLA is concerned that the administrative and practical complexities of creating a new federal CLE oversight system would tax Office resources that would be required to qualify the CLE activities of federal, state, and non-governmental entities. Such time and economic expense would far outweigh any potential benefit to the public. There is no evidence to support the assertion that federal oversight or management of CLE will add any value to the public. If the Office persists in its desire to regulate CLE programs, the Office will require additional personnel to review CLE programs, monitor compliance, and add another layer of oversight for practitioners—time, money, and resources that could be better spent in representing inventors and fostering innovation and invention. AIPLA has expressed some of its concerns in prior submissions to the Office<sup>26</sup> that the Office has declined to address directly in each round of the decades of successive attempts at instituting a federal CLE program.

In summary, voluntary CLE certification would unfairly prejudice the public and burden practitioners, would be complex and costly for the Office to administer, and would be more of a burden to practitioners than a benefit to the public. The costs of administration, including certifying CLE courses, maintaining and recording CLE records, would likely result in the

---

<sup>26</sup> AIPLA Comments on USPTO Setting and Adjusting Patent Fees During Fiscal Year 2020 [Docket No. PTO-P-2018-0031] at pp. 5-9 (September 30, 2019) (commenting on proposed annual practitioner fee and CLE discount), available at AIPLA Comments on USPTO Setting and Adjusting Patent Fees; AIPLA Comments on Supplemental Comments on Annual Patent Practitioner Fee Proposal in USPTO Setting and Adjusting Patent Fees During Fiscal Year 2020 [Docket No. PTO-P-2018-0031] (Nov. 8, 2019) (same), available at AIPLA Comments to USPTO on Annual Patent Practitioner Fee Proposal; AIPLA Comments to the Patent Public Advisory Committee Public Hearing on the Proposed Patent Fee Schedule [Docket No. PTO-P-2018-0046] at pp. 4-6 (Sept. 11, 2018) (same), available at AIPLA Comments to the Patent Public Advisory Committee Public Hearing in the Proposed Patent Fee Schedule; AIPLA testimony provided during Patent Public Advisory Committee Meeting Fee Setting Hearing (Sept. 6, 2018).

need for additional fees, the costs of which would ultimately be borne by inventors and other stakeholders.<sup>27</sup>

### **E. USPTO May Not Have Adequately Complied with the Laws Governing Rulemaking**

As discussed above, the 2020 Final Rule implements CLE and registration rules that are *substantively different* from the 2019 NPRM, and no public comment period has been opened on these new and substantively different rules. AIPLA is concerned that 37 C.F.R. § 11.11 has not been lawfully promulgated, and cannot serve as support for implementing guidance for at least the following reasons:

- As the Office itself acknowledges, by refusing to answer public comments on the proposed CLE rule, the final registration rule is not a “logical outgrowth” of the proposed CLE rule.<sup>28</sup> The Administrative Procedure Act<sup>29</sup> bars rule promulgation without a new round of notice and comment.<sup>30</sup> On the other hand, if the proposed and final rules are logically related, the Office erred in refusing *eighty times* to answer the public comments.
- This is a new “collection of information” covered by the Paperwork Reduction Act (“PRA”),<sup>31</sup> and thus a proper notice-and-comment period is required to evaluate the four questions required by statute.<sup>32</sup> This biennial registration will be covered by the PRA even if the Office elects to act by guidance rather than regulation.<sup>33</sup> Neither the July 2019 NPRM nor the August 2020 Final Rule observe the requirements of this statute. In fact, the Final Rule states that the Office specifically elected *not* to do so.<sup>34</sup>
- The Office did not perform a regulatory flexibility analysis with respect to any rule governing those practitioners that qualify as small entities in violation of the Regulatory Flexibility Act.<sup>35</sup> In fact, the Office specifically *declined* to do so.<sup>36</sup>
- The Office apparently failed to comply with a number of Executive Orders: Executive Order 12866 requires the Office to identify a specific and necessary “compelling public need, such as material failures of private markets to protect or improve . . . the well-being of the American people”;<sup>37</sup> Section 1(b)(5) of that Executive Order provides that an agency “shall consider incentives for innovation, . . . costs of enforcement and compliance (to the government, regulated entities, and the public)”;<sup>38</sup>

---

<sup>27</sup> While our concerns are primarily focused on the voluntary CLE certification, the biennial registration requirement presents similar issues in terms of administrative costs, especially in addressing logistical issues of persons who unintentionally fail to submit a registration statement. If the purpose of the registration statement is to confirm that practitioners wish to maintain active status, then the statement could be implemented as a simple statement by those who no longer wish to remain active. Such an optional statement should be far less costly to administer. Maintaining current contact information should be all that is needed to maintain the practitioner rolls.

<sup>28</sup> See Responses 81-163, 85 Fed. Reg. 46932.

<sup>29</sup> See, e.g., 5 U.S.C. § 553.

<sup>30</sup> See *Mid-Continent Nail Corp. v. U.S.*, 846 F.3d 1364, 1373-74 (Fed. Cir. 2017).

<sup>31</sup> 44 U.S.C. § 4501 *et seq.*

<sup>32</sup> 44 U.S.C. § 3506(c)(2)(A); 5 C.F.R. § 1320.8(d)(1).

<sup>33</sup> 5 C.F.R. § 1320.10.

<sup>34</sup> Responses 130 and 135, 85 Fed. Reg. 46932.

<sup>35</sup> 5 U.S.C. §§ 601 *et seq.*; 85 Fed. Reg. 46932, 46979.

<sup>36</sup> 85 Fed. Reg. 46932, 46979, col. 3.

<sup>37</sup> E.O. 12866 §§ 1(a), 1(b)(1).

<sup>38</sup> See Responses 85, 126, and 137, 85 Fed. Reg. at 46961, col. 1, and 45697, col. 1.



and Executive Order 13771 requires a cost-benefit analysis, and a two-for-one deregulatory action. The Office also apparently declined to consider regulatory principles of Executive Orders 12866, 13563, or 13771.<sup>39</sup> Whatever rationales may have been offered before do not apply to the current registration rule.

AIPLA provided comments to the 2019 NPRM and opposed, in part, to both an annual practitioner fee (APF) and an associated discount for “certifying compliance with approved continuing legal education” (“2019 Comments”).<sup>40</sup> However, those comments, and many other similar comments, were not addressed in the 2020 Final Rule.

Specifically, following receipt of negative comments, the Office finalized the 2020 Fee schedule that included new alterations to 37 C.F.R. § 11.11. The *new* text and authorities were *first* presented in the Final Rule notice of August 3, 2020.<sup>41</sup> For example, in the 2019 NPRM, 37 C.F.R. §§ 11.11(a)(2) and (3)(i) did not exist. Nonetheless, in the August 3, 2020 Final Rule, the Office added authorities to authorize a biennial practitioner registration *statement* (substantively different from the proposed fee) and to permit registered practitioners to certify CLE completion (substantively different from the proposed discount). By presenting the changes to 37 C.F.R. § 11.11(a)(2) in the 2020 Final rules *for the first time*, the Office has promulgated such Final Rules without regard to 35 U.S.C. § 2(b)(2)(B), which requires, in those limited instances where the Office is permitted to engage in rulemaking, that they comply with the Notice and Comment provisions of at least 5 U.S.C. § 553.

AIPLA is concerned that the 2020 Final Rule is a stepwise approach to instituting an active practitioner fee and mandatory CLE requirements in the face of overwhelming public opposition. Thus, the Office’s shift between the 2019 NPRM and 2020 Final Rule avoids regulatory oversight by first creating unfunded, unfounded, and unnecessary programs that will then require adding fees to support such programs. As such, the 2020 Final Rule should be withdrawn, at least with respect to the CLE rules and the biennial registration statement.

### **III. Answers to Questions Regarding the Proposed CLE Guidelines**

AIPLA now addresses the underlying substance of CLE programs even though we continue our strong objections to the Office expanding its non-core function and administrative activities.

#### **1. What course topics should qualify for USPTO patent CLE credit?**

Subject to our objections, AIPLA supports CLE programs that include any course or activity that trains and educates practitioners in patent law and practice.

Since each educational program is unique, any attempt to prescribe *a priori* qualifications for CLE programs invites subjective and arbitrary standards. Thus, AIPLA believes that attempts

---

<sup>39</sup> Responses 85, 126, and 137, 85 Fed. Reg. at 46932.

<sup>40</sup> Sheldon Klein, President, American Intellectual Property Law Association, *Letter re: Comments on USPTO setting and adjusting patent fees during fiscal year 2020* [Docket No. PTO-P-2018-0031], page 5, September 30, 2019 (“2019 Comments”) available at [https://www.aipla.org/docs/default-source/advocacy/documents/aipla-comments-on-fy2020-patent-fee-setting-nprm-2019sep27.pdf?sfvrsn=c4c344ce\\_0](https://www.aipla.org/docs/default-source/advocacy/documents/aipla-comments-on-fy2020-patent-fee-setting-nprm-2019sep27.pdf?sfvrsn=c4c344ce_0).

<sup>41</sup> 75 Fed. Reg. at 46992.

to define CLE programs in more detail than, e.g., patent-related subject matter, is ill-advised. AIPLA declines to elaborate further.

The definition provided under the “American Bar Association Model Rule for Minimum Continuing Legal Education (MCLE) and Comments” should be sufficient. CLE credits may be earned by participating in legal education programs that have a significant intellectual or practical content designed to increase or maintain the patent practitioner’s professional competence and skills as a patent practitioner.<sup>42</sup>

**2. What parameters should be used to determine what subject matters beyond those listed in 37 C.F.R. § 11.5(b)(1) would qualify for patent CLE credit, if any?**

AIPLA urges that it is inappropriate for the USPTO to attempt to define the scope of CLE programs.

37 C.F.R. § 11.5(b)(1) provides a non-exhaustive list of matters that are undertaken by patent practitioners. Any attempt to define “parameters” to determine whether a particular CLE program would be useful to practitioners and those they represent will *by necessity* result in a non-exhaustive list. That list would invite argument, form a potential basis for punishing practitioners for noncompliance, form a basis for allegations of patent unenforceability, and omit appropriate subject matter. AIPLA submits that all courses that help educate and train practitioners in their patent-related practice should qualify to satisfy the requirements of, among other things, 37 C.F.R. § 11.101 – Competence.<sup>43</sup>

**3. What activities should qualify for USPTO CLE credit, either in patent law and practice or ethics?**

Again, AIPLA objects to the Office involving itself in what activities that would qualify for CLE credit.

Currently, patent practitioners are required to maintain professional competency.<sup>44</sup> Trying to define *how* that is done or what activities one engages in when maintaining that competency is an effort that would require considering each individual’s activity and its nexus to IP-related matters.<sup>45</sup>

To the extent that practitioners engage in IP-related activities, AIPLA recommends that practitioners, CLE providers, and CLE regulators consider all matters reasonably related to

---

<sup>42</sup> See American Bar Association, *ABA Model Rule for Minimum Continuing Legal Education (MCLE) and Comments*, Sections 1(A) and 4(A), February 6, 2017.

<sup>43</sup> 37 C.F.R. § 11.101 (“A practitioner shall provide competent representation to a client. Competent representation requires the legal, scientific, and technical knowledge, skill, thoroughness and preparation reasonably necessary for the representation.”)

<sup>44</sup> See, e.g., 37 C.F.R. § 11.101 – Competence.

<sup>45</sup> 37 C.F.R. § 11.101. See also 37 C.F.R. § 11.7 that states, in part, that “(a) No individual will be registered to practice before the Office unless he or she has: . . . (2) Established to the satisfaction of the OED Director that he or she: (i) Possesses good moral character and reputation; (ii) Possesses the legal, scientific, and technical qualifications necessary for him or her to render applicants valuable service; and (iii) Is competent to advise and assist patent applicants in the presentation and prosecution of their applications before the Office.”

providing IP support to the public be within its scope. Any activity that should qualify for CLE, so long as it is directed to the overall goal of training and educating practitioners in patent law and practice.

**4. Should organizations or providers outside the USPTO be authorized to deliver USPTO CLE courses? If so, how should such courses be approved?**

Subject to our objections, any provider that can deliver IP-related subject matter should be permitted and encouraged to do so.

AIPLA therefore recommends that CLE providers should include any entities (governmental, professional, NGO, etc.) with the ability to manage and deliver IP-related education. The Office should minimize resources, including expense and oversight, dedicated to certifying CLE courses or providers. It is unclear what public benefit would be obtained from having the Office *approve* any CLE program or provider.

**5. In what manner should the USPTO recognize practitioners who make the CLE certification on their mandatory registration statement?**

AIPLA reiterates its position that the USPTO should not publicly recognize practitioners who participate in CLE programs, or conversely, identify those who do not certify CLE participation.

AIPLA is concerned that recognizing practitioners who voluntarily certify their CLE certification would unfairly prejudice the public against practitioners, including patent agents and attorneys who do not have a state CLE requirement. No USPTO recognition is appropriate because regulations already require that practitioners be legally and technically competent.

USPTO publication of practitioner participation in CLE programs is undesirable. By meeting the requirements for practice before the Office and obtaining a registration number, all practitioners are asserting that they are competent, both legally and technically, to practice before the Office. If the Office now publishes or recognizes some “super” certification, the public may not understand its meaning. Is the person who has a CLE certification somehow better qualified than other practitioners? Why? Does this indicate an insufficiency in the USPTO’s current accreditation system? If not, why would further certification be needed and what does it mean?

The USPTO’s assertion that CLE certification is “voluntary” is questionable in light of the Office’s efforts to institute a federal CLE program and near-term ramifications of practitioner “self-certification.” If a practitioner does not voluntarily certify CLE compliance, then they may be branded as less competent than those who do. If one certifies that they participated in some CLE, does that mean that they are somehow more competent than required by, e.g., 37 C.F.R. § 11.7(a)(2)?<sup>46</sup>

---

<sup>46</sup> 37 C.F.R. § 11.7 states, in part, that “(a) No individual will be registered to practice before the Office unless he or she has: (1) Applied to the USPTO Director in writing by completing an application for registration form supplied by the OED Director and furnishing all requested information and material; and (2) Established to the satisfaction of the OED Director that he or she: (i) Possesses good moral character and reputation; (ii) Possesses

In addition, the cost of administering a recognition program for practitioners would provide little benefit to the public. A showing of participation in CLE is not a requirement that qualifies one to practice before the Office in patent matters. The costs of administration, including certifying CLE courses, maintaining CLE records, will likely result in the need for additional fees, the costs of which will ultimately be borne by inventors and other stakeholders.

**6. Are there any other issues or concerns that the USPTO should consider regarding the CLE guidelines? If so, what are they and how and why would they apply?**

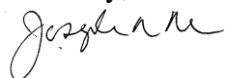
AIPLA is concerned that the proposed CLE guidelines may impose particular burdens on patent agents and other practitioners who are not otherwise required to meet state-related CLE requirements. Many patent attorney practitioners have CLE requirements for their state bars, but patent agents do not have to meet any state CLE requirements. Further, because patent agents are not required to meet state-related CLE requirements, and indeed, are not able to join some state bar organizations, their ability to obtain certifications from providers attesting to CLE attendance or otherwise proving CLE compliance is more challenging. Thus, the cost, availability, and proof of qualifying CLEs for patent agents may disproportionately adversely affect patent agents.

Further, for many inventors and inventive entities (especially small and medium-sized entities), patent agents represent a pool of advisors who are often less expensive than attorneys. Adding additional costs and burdens to practitioners will result in those costs ultimately being passed on to those very same inventors and entities who are least well positioned to pay higher fees. Any imposition of additional practitioner burdens should be accompanied by a regulatory compliance cost analysis as *required* under the Administrative Procedure Act and related statutes.

In addition, AIPLA is concerned that the proposal for mandatory registration and voluntary CLE certification may be especially burdensome to solo practitioners, practitioners from small firms, and corporate practitioners who may opt not to self-certify due to potential financial burdens for CLE. Lack of recognition for those practitioners may impact them disproportionately, as lack of self-certification may be viewed by the public as indicating lower ability relative to those who self-certify.

AIPLA appreciates the opportunity to provide feedback to the Office on the Request. AIPLA looks forward to further dialogue with the Office with regard to the issues raised above.

Sincerely,



Joseph R. Re  
President

American Intellectual Property Law Association

---

the legal, scientific, and technical qualifications necessary for him or her to render applicants valuable service; and (iii) Is competent to advise and assist patent applicants in the presentation and prosecution of their applications before the Office.”

## **Exhibit C**

**60-day comment letter of 109 Patent  
Practitioners re Information Collection  
0651-0012, from**

# 109 PATENT PRACTITIONERS

February 22, 2021

Via Email [InformationCollection@uspto.gov](mailto:InformationCollection@uspto.gov); [William.Covey@uspto.gov](mailto:William.Covey@uspto.gov);  
[Dahlia.George@uspto.gov](mailto:Dahlia.George@uspto.gov)

Kimberly Hardy  
Office of the Chief Administrative Officer  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

William Covey, Director for the Office of Enrollment and Discipline  
Mail Stop OED  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Re: 0651-0012 comment, *Admission to Practice and Roster of Registered Patent Attorneys and Agents Admitted to Practice Before the United States Patent and Trademark Office*, Notice of information collection; request for comment, Control Number 0651-0012, 85 Fed. Reg. 83903 (Dec. 23, 2020)

Dear Ms. Hardy and Mr. Covey:

We write as 109 patent practitioners to explain the implications of certain silences and omissions from the December 23, 2020 *Paperwork Request for Comment*, and to request that the PTO issue a Federal Register Notice that conforms the text of 37 C.F.R. § 11.11 and the PTO's *CLE Guidelines* to the scope that the December *Paperwork Request for Comment* implies. The omissions from and limited scope of the *Paperwork Request for Comment* requires rescission of the 2020 amendments to § 11.11 (restoring the 2019 *status quo ante*) and withdrawal of the October 2020 *Proposed CLE Guidelines*.

The signatories are members of several email listserv groups, and subscribers to several organizational blogs. The signatories taken together have filed many thousands of patent applications at the PTO during the past ten years. One signatory is a former member of the Patent Public Advisory Committee (PPAC). Another, David Boundy, is regarded as the leading expert on administrative law as it applies to the PTO: the Federal Circuit invited Mr. Boundy to chair a panel on the topic at the Federal Circuit Judicial Conference in March 2018, and Judge Plager has recommended Mr. Boundy's published articles.

The Paperwork Reduction Act requires the PTO to establish "objective" estimates of burden, and to use comment periods like this one to solicit recommendations to "reduce[ ] to the extent practicable and appropriate the burden on persons" who file papers at the agency. 44 U.S.C. § 3506(c)(3)(C).

In this case, we observe several silences in recent Federal Register notices, and offer the PTO a lawful resolution. The December 23, 2020 *Paperwork Request for Comment* on its face proposes to seek approval for only current Form PTO-107S (attached as Exhibit E), upping the annual responses from 5000 to 16, 333. On its face, the December 23, 2020 *Paperwork Request for Comment* does not propose to seek clearance for any CLE reporting or the biennial “registration statement” under 37 C.F.R. § 11.11 (as amended by *Setting and Adjusting Patent Fees During Fiscal Year 2020*, 85 Fed. Reg. 46932, 46992 (Aug. 3, 2020)), or by the October 2020 *Proposed Continuing Legal Education Guidelines*, 85 Fed. Reg. 64128 (Oct. 9, 2020) (hereinafter, the two “CLE rules”). Because the PTO has not performed the requisite steps for approval of the paperwork embedded in the two CLE rules or the registration statement rule, and the estimates proposed in the December 23, 2020 *Paperwork Request for Comment* can only be accurate and “objectively supported” if the two CLE rules are excluded, it is apparent that the PTO intends to *not* seek clearance for the CLE rules. We ask that the PTO make that implication clear, by expressly stating in its submissions to OMB that no approval is requested for the two CLE rules or the registration statement rule.

The Paperwork Reduction Act provides for triennial review of all burden for paperwork that an agency imposes to collect from the public.<sup>1</sup> Before any notice of proposed rulemaking (NPRM), the agency must “consult with members of the public” to establish “objectively supported estimates” of burden,<sup>2</sup> so that those estimates can be published in the NPRM for public comment.<sup>3</sup> In the NPRM, the agency must provide “specific, objectively supported estimate of burden” for public comment,<sup>4</sup> and seek public comment on four specific issues specified by statute.<sup>5</sup> The PTO was obligated to make filings with OMB in connection with the 2020 *Fee-Setting* NPRM, and also in connection with the October 2020 *Proposed CLE Guidelines*,<sup>6</sup> with the certifications of 44 U.S.C. § 3506(c)(3) and 5 C.F.R. § 1320.9. In a response to comments, the PTO must (typically in the final rule notice) “fairly evaluate” the comments,<sup>7</sup> and explain “how any collection of information contained in the final rule responds to the comments, if any, filed by the Director or the public.”<sup>8</sup>

As discussed in section I of this letter, the December 23, 2020 *Paperwork Request for Comment* does not request clearance for the burden of the two CLE rules. Likewise, the PTO

---

<sup>1</sup> 44 U.S.C. § 3507(c); 5 C.F.R. § 1320.10(b); § 1320.12(j).

<sup>2</sup> 44 U.S.C. § 3506(c)(2)(B) and 5 C.F.R. § 1320.8(d).

<sup>3</sup> 44 U.S.C. § 3506(c)(2); 5 C.F.R. § 1320.8(d)(1)(ii).

<sup>4</sup> 44 U.S.C. § 3506(c)(1)(A)(iv); § 3506(c)(2)(A)(ii); § 3507(a)(1)(D)(ii)(V); 5 C.F.R. § 1320.5(a)(1)(iv)(B)(5); § 1320.8(a)(4).

<sup>5</sup> 44 U.S.C. § 3506(c)(2)(A); 5 C.F.R. § 1320.8(d)(1)(i).

<sup>6</sup> 44 U.S.C. § 3507(d)(1) and § 3506(c)(2)(A); see also Executive Order 12,866 § 6(a).

<sup>7</sup> 44 U.S.C. § 3506(c)(1), 5 C.F.R. § 1320.8(d)(1).

<sup>8</sup> 44 U.S.C. § 3507(a)(1)(B) and § 3507(d)(2)(A) and (B); 5 C.F.R. § 1320.5(a)(1)(ii) and § 1320.11(f).

neglected its obligations under the Paperwork Reduction Act with respect to the biennial registration statement. 44 U.S.C. § 3507(a) applies: “An agency shall not conduct or sponsor the collection of information unless in advance of the adoption or revision of the collection of information” the agency has sought and obtained that clearance. As discussed in section II of this letter, the PTO neglected multiple requirements of law in the October 2020 *Proposed CLE* notice, in the August 2020 *Fee-Setting* final rule notice, and in the July 2019 *Fee-setting* NPRM, including essentially every obligation under the Paperwork Reduction Act set out in the previous paragraph. As one simple example, because the PTO did not ask the four statutorily-required questions in the July 2019 2020 *Fee-Setting* NPRM, the PTO was unable to provide relevant answers in the August 2020 2020 *Fee-Setting* final rule.

The Paperwork Reduction Act requires agencies to write their rules “using plain, coherent, and unambiguous terminology.”<sup>9</sup> If the PTO hasn’t done the work required by law to validly promulgate the two CLE rules, they are reduced to dead letter, as acknowledged *sub silentio* by omission in the December 23, 2020 *Paperwork Request for Comment*. They should not remain in the public record as false statements. Instead, they should be expressly rescinded.

**I. The December 23, 2020 *Paperwork Request for Comment* does not propose to recognize the burden of the two CLE rules, let alone estimate them or seek approval**

The two CLE rules are covered by the Paperwork Reduction Act. The Act covers “voluntary” certifications, 5 C.F.R. § 1320.3(c) (coverage includes both “reporting” and “recordkeeping,” whether “voluntary, or required to obtain or retain a benefit”), covers any requirement that an agency creates as “a rule of general applicability,” § 1320.3(c)(4)(i), and covers paperwork created by regulation or by guidance. §§ 1320.10, .11, .12. The PTO represents in its 2020 *Fee-Setting* notices and the October 2020 *Proposed CLE Guidelines* that CLE is required “training ... to be able to respond to a collection of information,” and the burden is therefore covered. 5 C.F.R. § 1320.3(b)(1)(vi).

**A. Estimate of burden for the CLE rules**

In the October 2020 *Proposed CLE Guidelines* notice, OED proposes two new collections of information: (a) a mandatory biennial registration statement (which was apparently first introduced into regulation by the 2020 *Fee-Setting* final rule), and (b) as part of that biennial statement, a certification of CLE completion.

Reading between the lines of the December 23, 2020 *Paperwork Request for Comment*, the PTO estimates there are about 32,666 attorneys and agents (2×16,333, 85 Fed. Reg. at 83904, line 5). We estimate that 40%, 13,066, have no existing CLE requirement (because they are either patent agents or attorneys in states with no existing mandatory CLE requirement). For the other 60%, attorneys in states with existing CLE requirements, 19,600 attorneys, we estimate that they will have to take three additional courses in each biennial reporting cycle, because some fraction of the courses they take for their existing state CLE requirements will not be eligible for

---

<sup>9</sup> 44 U.S.C. § 3506(c)(3)(D); 5 C.F.R. § 1320.9(d).



PTO CLE credit, or vice versa—for example, state courses may be directed to non-patent topics, or will be taken from a provider that doesn't seek PTO approval of CLE credit, or a PTO CLE course may lack sufficient content to qualify under state CLE regulations or the PTO may not apply as an accredited provider for state CLE credit.

The following burden must be accounted for in any information collection request. We estimate burden as follows (note that we carefully segregate the costs that are incremental to the CLE rules, and exclude burden that attorneys already bear for their states' mandatory CLE, 5 C.F.R. § 1320.3(b)(2)):

- Time browsing CLE catalogs and sifting through emails from CLE providers to find relevant courses (six hours per biennial cycle for the 40%, four hours for the 60%). Attorneys that take CLE requirements seriously sign up for multiple emails and catalogs to find courses relevant to their practice and that promise to provide significant intellectual or practical content designed to increase or maintain the patent practitioner's professional competence and skills as a patent practitioner. Reviewing them takes time.
- Registering for the courses and paying for them (1.8 hours per cycle for the 40%, 0.9 hours for the 60%).
- Recordkeeping to maintain attendance certificates (1.2 hours per cycle for the 40%, 0.8 for the 60%).
- Travel to and attendance of courses (we assume that 25% will be live attendance with an average of two hours' travel time, and 75% are either video or at a conference that the person is already at, so no travel time), plus \$150 per live event in travel costs (about 1/3 of live courses involve a hotel stay).
- We assume that 50% of courses that get credit by the PTO will also be eligible for state CLE credit. Given the lack of discussion in the October 2020 *Proposed CLE Guidelines* of any genuine plan by the PTO to ensure that courses offered by the PTO will be eligible for state credit (*see, e.g.*, § I.B.3 below), or that non-ethics credit for state courses will be eligible for PTO credit, we believe that estimate is generous.
- Attending the courses, an hour each.
- Program cost and tuition: we estimate that 50% of courses will be free, and 50% will be at an average cost of \$400.
- Assembling and reporting the attendance certificates at the time of filling out the CLE certification in the biennial statement (one hour per biennial cycle).
- Burden on CLE providers to seek PTO approval for CLE credit (*see* § I.B of this letter)

This totals to 468,000 hours per two-year reporting cycle. At \$400/hour, hour cost burden on attorneys/agents comes to \$93.6 million per year. Adding in the cost of non-hourly cost burden (tuition cost and travel cost), we estimate total burden at \$112 million per year on attorneys and agents. The details of our assumptions and calculations are set forth in Exhibit A.

**B. Burden on CLE providers, including the PTO itself**

CLE providers will bear costs as well.

**1. Estimate of burden on private sector CLE providers to obtain PTO approval for PTO CLE credit**

We assume that the PTO will charge private sector CLE providers for the service of reviewing and accrediting providers and courses. Using the Illinois<sup>10</sup> and Virginia<sup>11</sup> fee structures as models, we assume fees might be something like this:

- Illinois charges an annual fee to providers for annual review and accreditation of that provider. That fee runs from \$300 to \$2000 per provider. We assume the PTO will charge providers an annual fee of \$500 each to register to provide PTO CLE credit, and 500 providers will pay for the privilege.
- Some states charge a per-course fee for review of the course materials; some charge a per-attendee fee. Virginia charges \$75-150 per course,<sup>11</sup> Illinois charges 75¢ per attendee. We expect 2000 courses per year to seek PTO approval, and we have assumed \$75 per course in fees payable to the PTO.
- Private sector providers want to deliver CLE from top people in the field, people that charge \$500 to \$1000 per hour. Preparing a course takes on average 6 to 12 hours. We assume \$6000 of prep time, for 1000 courses per year. We assume \$2000 in prep time for second-and-subsequent offerings of a course.

This totals about \$15.4 million per year.

**2. Estimate of burden on the PTO to seek CLE approval from state CLE authorities**

The PTO will, we assume, seek state CLE approval for its own courses, so that attorneys can count the PTO's CLE courses against both their state and PTO CLE requirements. That will involve the PTO paying fees to state bar regulators. Those fees will be passed on to applicants. Therefore, those charges must be booked as "burden."

- We estimate that 35 states will charge an average of \$300 each to accredit the PTO as a provider.
- We estimate that for each course, the PTO will seek accreditation from 35 states, and that the PTO intends to offer 200 courses a year, and that states will charge \$55 per state per course.
- The PTO will need staff to manage state CLE approvals. We assume one staff FTE, at \$150,000/yr.

That comes to \$545,000 per year.

---

<sup>10</sup> [https://www.mcleboard.org/files/Providers/Fee\\_Schedule/files/ProviderFeeSchedule.aspx](https://www.mcleboard.org/files/Providers/Fee_Schedule/files/ProviderFeeSchedule.aspx)

<sup>11</sup> [https://www.vsb.org/docs/mcle-form4\\_sponsors.pdf](https://www.vsb.org/docs/mcle-form4_sponsors.pdf)

### 3. Will the PTO's courses meet state requirements for state CLE credit?

We note that the PTO is not currently an approved CLE Accredited Sponsor for the State of Virginia, in the list updated Aug 26, 2020:

<https://www.vsb.org/docs/accredited-sponsors.pdf>

At least some of the PTO's recent courses are unlikely to qualify for CLE approval. As one example, in January 2021, the PTO offered a course *Learn online how examiners approach After Final Practice*, <https://www.uspto.gov/about-us/events/learn-online-how-examiners-approach-after-final-practice>. The PTO represented that this course is CLE eligible. However, from the slides (attached as Exhibit C), it's apparent that this is a course directed to *examiners*. The slides instruct *examiners* in ministerial tasks: how to check off checkboxes on a form, the ongoing obligation to answer issues, etc. There's no citation to case law, no advice to applicants or practitioners, no guidance to patent practitioners regarding rights and options during after final practice.

To certify a course for CLE credit, the Virginia [Mandatory Continuing Legal Education Regulations](#), Regulation 103(b), requires:

- (b) The course must have significant intellectual or practical content. Its **primary objective** must be to increase the attendee's professional competence and skills **as an attorney**, and to improve the quality of legal services rendered to the public.

The *After Final Practice* course clearly does not meet this requirement. Likewise, Virginia requires naming the presenters. The PTO did not provide a roster of presenters for the *After Final Practice* CLE.

This raises four issues.

- The Paperwork Reduction Act does not speak directly to this issue, but implicit is an obligation on agencies not to expend people's time on information with no practical utility.
- In the PTO's [Information Quality Guidelines](#), the PTO commits to dissemination of only information of "[quality](#)" and "[utility](#)." This CLE course violates an obligation that the PTO has undertaken as a legal commitment.
- If a course does not meet a state's requirements for "primary objective" and "significant intellectual content," will the PTO be able to represent to state CLE authorities that the course is worthy of credit?
- If the PTO intends to award CLE credit for courses that *don't* meet state requirements for "primary objective" and "significant intellectual content," what are state bar regulators, and the patent bar, to make of that?

If the *After Final Practice* program is representative, we fear the following:

- The programs will be "dumbed down" and lacking substance.
- After an attorney/agent attends the program, state CLE accreditation boards may be reluctant to award credit—perhaps to the point of retroactively revoking approval.

- The courses will be directed to the PTO's point of view—entry-level attorneys/agents will be subjected to an unacceptably one-sided (and not client-oriented) point of view

#### 4. Alternative burden estimate, if the PTO's course offerings are not approved for CLE credit

In computing burden above, we took the view most favorable to the Office, and assumed that the PTO would seek CLE credit from all state bars for its own course offerings. Based on the history we discuss in § I.B.3, this assumption may be counterfactual.

In the above calculations, we assumed that 50% of courses would be eligible for both state and PTO CLE credit (for attorneys in states with mandatory CLE requirements). If we assume only 20% of courses will be eligible for simultaneous credit, the burden goes up by about \$24 million per year, to total burden of \$153 million per year.

### C. Total burden

Total burden adds as follows (with the full details set out in Exhibit A):

	assumption that 50% of courses eligible for both state and PTO credit	assumption that 20% of courses eligible for both state and PTO credit
total burden on attorney/agent	\$112 million	\$127 million
burden on private sector CLE providers	\$15.4 million	\$24.5 million
Cost to PTO to obtain state MCLE Board approval for courses offered by PTO	545,500	545,500
total burden	\$128 million	\$153 million

### D. The silence in the December 23, 2020 *Paperwork Request for Comment* is a waiver or stand-down on the CLE Rules

The December 23, 2020 *Paperwork Request for Comment* makes no direct mention of the two CLE rules, or any other change to paperwork burden relative to the PTO's last request for clearance in December 2017, ICR 201712-0651-022.<sup>12</sup> The December 23, 2020 *Paperwork Request for Comment* estimates total burden for the entire 0651-0012 control number at \$8.14 million. If the PTO intended to include the cost of the CLE rules in the December 2020 *Paperwork Request for Comment* Paperwork clearance request, the PTO underestimated total burden by a factor of 16.

There are two apparent explanations:

---

<sup>12</sup> [https://www.reginfo.gov/public/do/PRAViewICR?ref\\_nbr=201712-0651-022](https://www.reginfo.gov/public/do/PRAViewICR?ref_nbr=201712-0651-022) The PTO has filed two ICR updates, but both were designated "No material or nonsubstantive change to a currently approved collection" so, by definition, they sought no clearance for new burden.

- (a) the PTO has intentionally chosen to **not** to seek clearance for the information collection burden of the two CLE rules—and the PTO thereby abandons them—or else
- (b) the PTO has chosen to materially deceive OMB as to the magnitude of the burden.

Because OMB’s review will include *ex parte* consideration, we assume that the PTO would not ask its attorneys to violate the rules of professional responsibility by misrepresenting or hiding material facts from OMB. We therefore assume that the PTO, particularly OED, has made a good faith choice consistent with law, that is, choice (a). Under that assumption, the public is entitled to prompt notice that the two CLE rules are rescinded.

**E. Conclusion: the PTO’s failure to provide any estimate of any biennial CLE is a waiver of the PTO’s authority to collect the information**

Because the PTO has never run the two CLE rules through the procedures required by the Paperwork Reduction Act, and does not now seek clearance for them, the PTO may not collect CLE information, 44 U.S.C. § 3507(a) (“An agency shall not conduct or sponsor the collection of information unless in advance of the adoption or revision of the collection of information...”); 5 C.F.R. § 1320.5(a), and may not impose any penalty for noncompliance.<sup>13</sup> See also AIPLA’s letter (Exhibit B at pages 7-9 and 14). Any ICR submission to OMB should *expressly* state that no clearance is sought for collection of CLE information, and should indicate that the PTO will remind the public that it has no clearance, and is not authorized to collect information relevant to the two CLE rules. 44 U.S.C. § 3507(a).

**II. The PTO neglected multiple statutory requirements for the two CLE rules, including laws prerequisite to seeking OIRA approval under the Paperwork Reduction Act—collections of information contained in the two CLE rules should not be submitted to OIRA for approval**

AIPLA’s letter (Exhibit B at pages 10-11) and Boundy’s letter (Exhibit D at pages 5-12) note a number of omissions by the PTO, failures to observe requirements of law. To give a short-form summary:

1. The PTO published the *Proposed CLE Guidelines* as proposed guidance, not as regulation. The Patent Act only gives OED authority to regulate practitioners by regulation, 35 U.S.C. § 2(b)(2)(D), not guidance. Only months ago, the Federal Circuit reminded the PTO that the word “regulation” in a statutory grant requires full legislative rulemaking procedure. *Facebook, Inc. v. Windy City*, 973 F.3d 1321, 1349-50 (Fed. Cir. 2020).

The content of the October 2020 *Proposed CLE Guidelines* notice is neither “procedural” nor “interpretative” for purposes of 5 U.S.C. § 553. For example, fleshing out the general CLE requirement of § 11.11(a) with the numerical requirement of six hours is a legislative rule that cannot be promulgated by guidance or other interpretative rule. *Hector v. Dept. of Agriculture*,

---

<sup>13</sup> 44 U.S.C. § 3512; 5 C.F.R. § 1320.6(a).

82 F.3d 165, 169-70 (7th Cir. 1996) (Posner, J.). Since neither the “procedural” nor “interpretative” exemption applies, the *CLE Guidelines* required full legislative rulemaking under the Administrative Procedure Act. The PTO’s failure to follow legislative rulemaking procedure is a fatal defect that renders the *CLE guidelines* unenforceable.<sup>14</sup>

2. On September 28, 2020, the Department of Commerce, in *Promoting the Rule of Law Through Improved Agency Guidance Documents*, 85 Fed. Reg. 60694, 60696 (Sep. 28, 2020) promulgated 15 C.F.R. § 29.2(a), which forbids Commerce component agencies from relying on guidance in any mandatory manner. The *Proposed CLE Guidelines* proposes to impose mandatory reporting obligations on practitioners. As of the October 9, 2020 publication date of the *Proposed CLE Guidelines*, the PTO lacked authority to act by guidance.

3. The Supreme Court warned agencies that it’s inappropriate to “promulgate vague and open-ended regulations that they can later interpret as they see fit.” *Christopher v. SmithKline Beecham Corp.*, 567 U.S. 142, 158 (2012). Agencies may not use guidance to avoid the obligations of rulemaking. To create rules with binding effect against the public, an agency must act by notice-and-comment regulation. *Appalachian Power Co. v. EPA*, 208 F.3d 1015, 1020 (D.C. Cir. 2000). A vague regulation in August 2020 *2020 Fee-Setting* final rule is not valid support for later definitive guidance on CLE.

4. The August 2020 *2020 Fee-Setting* final rule recharacterizes the public comments on the various CLE provisions, and gives evasive answers. As the PTO itself acknowledges by refusing to answer public comments on the July 2019 proposed CLE rule, Responses 81-163, 85 Fed. Reg. at 46960-69, § 11.11(a)(2) was not a “logical outgrowth” of anything proposed in the July 2019 NPRM. Thus, the Administrative Procedure Act forbade promulgation of § 11.11(a)(2) without a new round of notice and comment. *Mid-Continent Nail Corp. v. U.S.*, 846 F.3d 1364, 1373-74 (Fed. Cir. 2017). On the other hand, if the proposed and final rules are logically related, the PTO erred in declining to answer dozens of the public comments that were relevant to a “registration statement.”

5. The Paperwork Reduction Act has a parallel requirement: if information to be collected is “substantially modified” at any time between the Notice of Proposed Rulemaking and publication as a final rule, the PTO must resubmit the rule to OMB for another round of comment, at least 60 days before publication of the final rule. 44 U.S.C. § 3507(d)(4)(D); 5 C.F.R. § 1320.11(h)(2). The PTO didn’t.

6. The 2019 and 2020 *2020 Fee-Setting* notices and October 2020 *Proposed CLE Guidelines* all lack the notices and analysis with respect to any rule governing small entity

---

<sup>14</sup> *Perez v. Mortgage Bankers Ass’n*, 135 S.Ct. 1199, 1204 (2015) (“[The] convenience [of invoking the “interpretive” exemption to avoid notice and comment] comes at a price: Interpretive rules ‘do not have the force and effect of law and are not accorded that weight in the adjudicatory process.’”); 44 U.S.C. § 3512 (rule promulgated without procedures of the Paperwork Reduction Act may not be enforced);



practitioners, 85 Fed. Reg. at 46979, in violation of the Regulatory Flexibility Act, 5 U.S.C. §§ 603, 604. In fact, the PTO specifically *declined* to do so. 85 Fed. Reg. at 46979, col. 3. The Regulatory Flexibility Act is designed to ensure that agencies take into account and minimize adverse economic impact on small entities. The vast majority of all patent attorneys practice in small entity law firms, or advise small-entity clients. The PTO's compliance with the Regulatory Flexibility Act is of major importance to the patent bar.

Likewise, the Regulatory Flexibility Act is administered on an *ex parte* basis by the Small Business Administration. Lack of candor with the SBA, via evasion of review, would create significant ethical problems for a number of attorneys at the PTO. Professional Responsibility Rule 3.3(d).

7. The October 2020 *Proposed CLE Guidelines* notice observes none of the procedures required by the Paperwork Reduction Act. 44 U.S.C. § 3506(c)(2)(A); 5 C.F.R. § 1320.8(d)(1).

8. The PTO is required to explain why the CLE rules are “necessary for the proper performance of the functions of the agency,” 44 U.S.C. § 3506(c)(2)(A)(i), 5 C.F.R. § 1320.5(d)(1)(i), and then *certify* that the CLE rules are “necessary.” 44 U.S.C. § 3506(c)(3)(A); 5 C.F.R. § 1320.9(a). The PTO will be required to “demonstrate that it has taken every reasonable step to ensure [that the CLE disclosure requirement is] the least burdensome [means] necessary for the proper performance of the agency's functions to comply with legal requirements and achieve program objectives.” 5 C.F.R. § 1320.5d(1)(i). The PTO has run an attorney registration program for a century without a CLE requirement. AIPLA's letter (Exhibit B at pages 3-4) lays out several past efforts by the PTO to implement a CLE requirement, and notes that the PTO offers “no explanation of why they are needed now. AIPLA is unaware of what, if anything, has changed.” What has changed to make CLE “necessary” now? Unless the PTO provides a “demonstration,” proceeding further would be without support of law.

9. The PTO may only request CLE information if it can certify that it the information has “practical utility.” 44 U.S.C. § 3506(c)(3)(A); 5 C.F.R. § 1320.5(d)(1)(iii). “Practical utility means the actual, not merely the theoretical or potential, usefulness of information to or for an agency, taking into account ... the agency's ability to process the information it collects (or a person's ability to receive and process that which is disclosed, in the case of a third-party or public disclosure) in a useful and timely fashion.” 5 C.F.R. § 1320.3(l). Neither the 2020 *Fee-Setting* notices nor the October 2020 *Proposed CLE Guidelines* propose any use the PTO proposes to make of the information, let alone “practical utility.” The PTO can't make the necessary certification.

10. In the July 2019 2020 *Fee-Setting* NPRM, the PTO claimed to have existing approvals for its CLE rules. That was incorrect—the OMB web site<sup>15</sup> showed that no such

---

<sup>15</sup> <https://www.reginfo.gov/public/do/PRAOMBHistory?ombControlNumber=0651-0012>.

filings had been made as of July 2019. In the August 2020 *2020 Fee-Setting* final rule, the PTO again claimed to have existing approvals for § 11.11(a)(2), and that other “information collections as a result of this Final Rule have been submitted to the OMB ... as nonsubstantive change requests.” Both claim—falsely—that the CLE rules have already been approved by OMB, or that filings had been made by July 2020 (85 Fed. Reg. 46972, col. 3):

*Comment 184:* One commenter claimed the USPTO has made no filing seeking any substantive change to 0651–0012 since 2014.

*Response:* The USPTO has complied with the PRA in considering the paperwork burdens associated with this Final Rule. The USPTO has previously received OMB approval for associated burdens and submitted additional statements to address revisions.

No such filing with respect to the CLE rules is apparent at the relevant web page.<sup>15</sup> Any new collection of information that requires *new* paperwork is not eligible for clearance as a “nonsubstantive change request.” No corresponding line item is visible in Table 1, Table 2, or Table 3 of the December 23 *Paperwork Request for Comment*. As explained in § I.A of this letter, if the PTO seeks clearance of burden for the CLE rules, the PTO underestimates by 93%.

Of course the PTO is aware that the PTO bears the burden of proof in all Paperwork proceedings at OMB. A party that bears the burden of proof can’t make something true simply by saying so. Perhaps we overlooked the PTO’s “compliance with the PRA in considering the paperwork burdens associated with” the CLE rules that the PTO claimed to have in its Response 184. If so, the PTO can clarify the misunderstanding by identifying specific ICR reference numbers and item line numbers in a past ICR, and then identify the relevant table lines in the December 2020 tables, directed to each element of burden identified in section I.A of this letter.

11. Neither the July 2019 *Fee-setting* NPRM and August 2020 *Fee-Setting* final rule notice nor the October 2020 *Proposed CLE Guidance* notice ask the four questions required by § 3506(c)(2)(A); 5 C.F.R. § 1320.8(d)(1)(i). In fact, the August 2020 *2020 Fee-Setting* final rule states that the PTO specifically elected *not* to do so. Responses 130 and 135, 85 Fed. Reg. at 46966, col. 1 and 3. The four questions appear in the December 23, 2020 *Paperwork Request for Comment*, 85 Fed. Reg. 83906, but asking them now as part of the triennial review does not cure the PTO’s past omissions in failing to ask them at the time required by statute, as part of rulemaking. 5 C.F.R. § 1320.8(d)(1); § 1320.9 (procedures required in an NPRM); § 1320.10 (procedures required for paperwork promulgated in guidance). As noted in point 10, the public comment letters alerted the PTO to a problem, in time for the PTO to issue a corrected NPRM. The PTO declined the opportunity.

12. The December 23, 2020 *Paperwork Request for Comment* explains neither the reason for a 3.3X raise in the number of responses, nor an explanation for cutting the burden per response in half. How has Form PTO-017S been simplified to cut its time burden in half? This is a fatal defect in the December 23, 2020 *Paperwork Request for Comment*. Without an



explanation, the public has no informed basis to comment. All information and bases for an agency's rulemaking must be made available during the notice and comment period in the rule making file, so that the information can be vetted by the public:<sup>16</sup>

The purpose of the comment period is to allow interested members of the public to communicate information, concerns, and criticisms to the agency during the rule-making process. If the notice of proposed rule-making fails to provide an accurate picture of the reasoning that has led the agency to the proposed rule, interested parties will not be able to comment meaningfully upon the agency's proposals. ... To allow an agency to play hunt the peanut with technical information, hiding or disguising the information that it employs, is to condone a practice in which the agency treats what should be a genuine interchange as mere bureaucratic sport. An agency commits serious procedural error when it fails to reveal portions of the technical basis for a proposed rule in time to allow for meaningful commentary.

Without a full disclosure of the agency's plans and rationale, the public cannot offer informed comment. The December 23, 2020 *Paperwork Request for Comment* fails to meet the obligation of 44 U.S.C. § 3506(c)(2)(A), and cannot be approved.

13. As noted in § I.C of this letter, the CLE rules are a "regulatory action ... [having] an annual effect on the economy of \$100 million or more" and therefore constitute an "economically significant regulatory action" under Executive Order 12866. The PTO followed none of the requisite requirements arising under Executive Order 12866.

The PTO failed to meet numerous prerequisites for the two CLE rules when the PTO promulgated them. The defects cannot be cured by sweeping them under the rug in a triennial renewal. If the PTO wishes to implement the CLE rules, we know of no alternative open to the PTO other than to start over at the beginning. Rulemaking requires a proper Notice of Proposed Rulemaking, with proper Paperwork Reduction Act and Regulatory Flexibility Act disclosure, proper and fair response to comment, all requisite filings with OMB and the Small Business Administration, and the like. Each step builds on its predecessors; omissions early in the process often can't be papered over later. And that's where the two CLE rules are today.

---

<sup>16</sup> *Connecticut Light & Power Co. v. Nuclear Regulatory Comm'n*, 673 F.2d 525, 531–32 (D.C. Cir. 1982); see also *Kern County Farm Bureau v. Allen*, 450 F.3d 1072, 1076 (9th Cir. 2006) ("An agency commits serious procedural error when it fails to reveal portions of the technical basis for a proposed rule in time to allow for meaningful commentary.'").

**III. Form PTO-107S cannot be approved for more than its 2017 approval of 5000 annual responses, nor can PTO-107S be modified to request CLE information**

Form PTO-107S, *Registration Statement of Patent Attorneys and Agents*<sup>17</sup> (attached as Exhibit E to this letter) was approved in 2017, and is currently approved at 5000 responses per year, at a half hour each in the PTO's 2017 Supporting Statement:<sup>18</sup>

11	Mandatory Survey – Register of Patent Attorneys and Agents PTO-107S	0.50	5,000	2,500	\$438.00	\$1,095,000.00
----	--	------	-------	-------	----------	----------------

and in the PTO's current inventory<sup>19</sup>:

Mandatory Survey – Register of Patent Attorneys and Agents (PTO-107S)	Unchanged	5000	2500	0	Form	PTO-107S
--	-----------	------	------	---	------	----------

The December 23, 2020 *Paperwork Request for Comment* seeks approval for 16,333 responses per year, at 0.25 hours each (85 Fed. Reg. at 83904):

5	Registration Statement of Patent Attorneys and Agents. PTO-107S .....	16,333	16,333	0.25	4,083	400	1,633,200
---	--	--------	--------	------	-------	-----	-----------

In other words, the PTO proposes a **3.3X** change in the number of responses, and estimates (for no stated reason) that the time per response falls in half.

The following are **not** in the December 23, 2020 *Paperwork Request for Comment*:

- Any estimate for CLE reporting, or any explanation for the incongruity that *adding* CLE reporting to Form PTO-107S would *reduce* response time.
- Any amendment to Form PTO-107S, or any new form for reporting CLE
- Any basis for changing the estimate for existing Form PTO-107S from 0.5 hours to 0.25
- Any explanation for why the number of responses grows from 5000 to 16,333, a growth of 3.3X

We have no objection to OMB approval of Form PTO-107S in its current role, reporting attorney change of address, change of law firm, and the like. Since the December 23, 2020 *Paperwork Request for Comment* offers no basis to expand that clearance, the PTO's follow-up filing with OMB should request approval for only 5000 responses per year at 0.5 hours, and expressly disclaim either expansion of purpose or expansion of number of annual responses.

<sup>17</sup> [https://www.uspto.gov/sites/default/files/documents/PTO107S\\_Mandatory\\_Survey.pdf](https://www.uspto.gov/sites/default/files/documents/PTO107S_Mandatory_Survey.pdf)

<sup>18</sup> 0651-0012 Supporting Statement (Dec. 2017),  
<https://www.reginfo.gov/public/do/DownloadDocument?objectID=103311401>

<sup>19</sup> [https://www.reginfo.gov/public/do/PRAICList?ref\\_nbr=202007-0651-003](https://www.reginfo.gov/public/do/PRAICList?ref_nbr=202007-0651-003)

**A. The clearance for Form PTO-107S cannot be expanded beyond its current clearance of 5000 responses, or otherwise expanded for any mandatory biennial “registration statement”**

The December 23, 2020 *Paperwork Request for Comment* seeks clearance for 16,333 responses per year. Clearance should not expand from 5000 to 16,333 for several reasons:

- Apparently, there was no regulatory support for Form PTO-107S before the August 2020 *2020 Fee-Setting* final rule. So while the PTO had a Paperwork clearance for 5000 responses, there was no supporting regulation, and none is identified in the PTO’s 2017 Supporting Statement.<sup>18</sup> Because no regulation existed, the PTO could not possibly have complied with the obligations of the Paperwork Reduction Act that must accompany a Notice of Proposed Rulemaking and Final Rule.<sup>20</sup> Without that statutorily-required procedure in the past, 44 U.S.C. § 3507(a), no expansion of clearance can be sought now. The Paperwork Reduction Act couples procedural steps under the PRA to steps of APA rulemaking—the law ensures that the public sees a full, integrated view of any regulation and its implications so that the public can offer informed comment. There is no lawful approach that decouples them.
- No biennial “registration statement” was even mentioned in the July 2019 *2020 Fee-Setting* NPRM. In dozens of responses to questions, the PTO asserted that comments on the July 2019 proposal were irrelevant to any issue in the August 2020 *2020 Fee-Setting* final rule. By the PTO’s own admission, the August 2020 “registration statement” is not a “logical outgrowth” for the July 2019 proposal. Therefore, the “registration statement” required a new NPRM under the Administrative Procedure Act, new estimates under the Paperwork Reduction Act, and a new Regulatory Flexibility Act analysis, and a new analysis for compliance with Executive Order 12866. The August 2020 *2020 Fee-Setting* final rule provided none of them.
- When the PTO did put the biennial registration statement up for comment, AIPLA’s letter (Exhibit B at page 6) noted that it was unnecessarily burdensome, and the same goals could be implemented at lower cost, if the PTO simply sought the public participation and consultation required by law.
- Likewise, the PTO did not observe the requirements of the Paperwork Reduction Act relating to collections of information that substantially evolve between Notice of Proposed Rulemaking and publication as a final rule. 44 U.S.C. § 3507(d)(4)(D); 5 C.F.R. § 1320.11(h)(2). The PTO failed to lay the groundwork necessary for this triennial renewal, if there was no initial approval.
- The PTO will be required to *certify* that Form PTO-107S is “necessary for the proper performance of the functions of the agency.” The PTO has gone without a biennial registration survey for two centuries—why has it now become necessary? Form

---

<sup>20</sup> E.g., 44 U.S.C. §§ 3506(c)(2)(B), 3506(c)(3), 3507(d)(1)(A), 3507(d)(4)(D); 5 C.F.R. §§ 1320.5(a)(3), 1320.5(d)(1), 1320.8(d)(1), 1320.9, 1320.11(b), 1320.11(h)(2).

- PTO-107S has existed for nearly a decade for use on an “as needed” basis—why has mandatory biennial compliance become “necessary?” The PTO has not explained.
- In almost all cases, almost all the information on the form will already be in possession of the PTO. The Paperwork Reduction Act forbids agencies from collecting information that is “unnecessarily duplicative.”<sup>21</sup> As currently configured, Form PTO-107S is almost entirely duplicative. The PTO does not explain why the duplicative collection is “necessary.”
  - The 2020 *Fee-Setting* notices do not mention a pilot for a biennial registration statement, nor explain why such a pilot is not “appropriate.” Without one of the two, the biennial registration statement fails the legal obligation of 44 U.S.C. § 3506(c)(1)(A)(v) and 5 C.F.R. § 1320.8(a)(6). We are aware of the abortive attempt at a similar program a decade ago—why was this not explained in the 2020 *Fee-Setting* notices? What were the lessons learned? How does this proposal avoid the problems that led the PTO to drop the prior effort?
  - For “statistical surveys and studies,” such as Form PTO-107S, the PTO is subject to a heightened obligation to “fully and accurately” inform the public of purposes and uses. 44 U.S.C. § 3506(e). The PTO may not use a survey such as Form PTO-107S as a “submarine” vehicle to impose a CLE requirement. Executive Order 12866 (§ 1(b)(9)) requires “agencies shall seek to harmonize Federal regulatory actions with related State, local, and tribal regulatory and other governmental functions)” The PTO didn’t follow that law, as pointed out in AIPLA’s letter (Exhibit B at pages 6-7).

The PTO will be unable to certify, 44 U.S.C. § 3506(c)(3); 5 C.F.R. § 1320.9, to the necessary prerequisites for seeking clearance of Form PTO-107S to the degree the PTO intends to attach the collection of CLE information to Form PTO-107S.

Something is changing, but the December 23, 2020 *Paperwork Request for Comment* gives no hint of what that change may be—it’s hard to avoid an inference that the PTO is trying to “sneak” something past the public and past OMB. The PTO should not request a 3.3X change in the number of responses, and 50% reduction in time per response, without a “fair” explanation required by statute, and the procedures required by the Administrative Procedure Act, Paperwork Reduction Act, and Regulatory Flexibility Act.

We are not fundamentally opposed to a biennial registration statement. However, the Administrative Procedure Act, Paperwork Reduction Act, and Regulatory Flexibility Act exist for a reason—to assist agencies in asking the right questions so as to take burden on the public into account, and avoid unintended consequences. In past rulemakings where the PTO has attempted to sidestep these three statutes or executive orders, the PTO has failed to inform itself

---

<sup>21</sup> 44 U.S.C. § 3506(c)(3)(B); 5 C.F.R. § 1320.5(d)(1)(ii).

of the true costs it proposes to place on the public.<sup>22</sup> The various administrative law statutes and executive orders are not there as pointless nuisance. They are there to guide agencies to informed decision-making, and to guide cooperation with the public to find low-cost solutions to joint problems. We urge the PTO to take the Paperwork Reduction Act seriously, and cease the pattern of evasion. This ICR and Form PTO-107S are a good place to start.

**B. The PTO cannot modify Form PTO-107S to sponsor collection of CLE or attorney biennial registration information**

These changes, proper “objectively supported” burden estimates should have been disclosed, and the four questions required by the Paperwork Reduction Act should have been asked, in the 2020 *Fee-Setting* NPRM, the August 2020 2020 *Fee-Setting* final rule notice, and October 2020 *Proposed CLE Guidance* notice so that the public could comment. The statutorily-required questions weren’t asked, and it’s too late now. The rules were invalidly promulgated, and the omissions can’t be cured now. There’s nowhere for them to go but back to the starting line.

**IV. Conclusion**

The December 23 *Paperwork Request for Comment* suggests that the PTO does not intend to seek Paperwork clearance for the two CLE rules. Without that clearance, the Paperwork Reduction Act bars the PTO from enforcing them, or imposing any penalty. 44 U.S.C. § 3507(a) (“An agency shall not conduct or sponsor the collection of information unless” the agency has observed the procedural requirements set out in statute); § 3502(14) (“penalty” includes “revocation, suspension, reduction, or denial of a license, privilege, right, grant, or benefit”). It’s too late now to correct the omissions from the earlier Federal Register notices. The PTO is boxed in by its own omissions. If the PTO wants CLE rules, the PTO must start from square one.

In any information collection request forwarded to OMB, the PTO should expressly disclaim coverage for the August 2020 amendments to 37 C.F.R. § 11.11 and the October 2020 *Proposed CLE Guidelines*. The PTO should run a notice in the Federal Register to conform its

---

<sup>22</sup> Examples include the 2006-09 continuations, claims, and IDS rules (RIN 0651-AB93, AB94, and AB95, quashed in ICR 200707-0651-005), the 2007-09 appeal rules (RIN 0651-AC12, quashed in ICR 200809-0651-003), the 2018 “attorney registration information” trademark guidance and “applicant domicile address” rules (no RIN or ICR number, omission of disclosure, procedure and filing discussed in public comment letters for the 60-day comment period for a soon-to-be-filed ICR for 0651-0009), and the 2020 DOCX patent application rule (no RIN or ICR, omission discussed in ICR 202011-0651-005), each of which created between \$50 million and \$7 billion per year in burden in excess of the *status quo ante*. Of these, the PTO’s 2007-08 rulemakings were blocked by OMB. Perhaps the PTO’s consistent omission of required disclosure, procedure, and filings since then is coincidental, perhaps not.

Dr. Richard Belzer explained the PTO’s consistent failure to follow regulatory law in a 2011 comment period *Improving Regulation and Regulatory Review* on the PTO’s web site at <https://www.uspto.gov/sites/default/files/patents/law/comments/belzer14apr2011.pdf>

published regulations to the scope for which the PTO seeks clearance—which means rescinding the July 2020 amendments to 37 C.F.R. Part 11, and the October 2020 *Proposed CLE Guidelines*.

Respectfully submitted,

109 patent practitioners

Joe Agusta  
Chapel Hill, NC

David S. Alavi  
Eugene, OR

Matthew S. Anderson  
Munck Wilson Mandala LLP  
Dallas, TX

Richard A. Baker, Jr.  
New England Intellectual Property, LLC  
West Newbury, MA

Randall B. Bateman  
Bateman IP,

Jordan Michael Bauman  
Acapo AS  
Askoey, Norway

Yehuda Binder  
May Patents Ltd.  
Newton, MA

Robert Blaha  
Smith Tempel Blaha LLC  
Atlanta, GA

Matthew J Booth  
Matthew J Booth PC  
Austin TX

David Boundy  
Cambridge Technology Law  
Cambridge, MA

Roger L. Browdy  
Browdy and Neimark, PLLC  
Washington, DC

Michael J. Brown  
Michael J Brown Law Office LLC  
Livingston, NJ

J. Michael Buchanan  
Cantor Colburn LLP  
Hartford, CT

Julie Burke  
IP Quality Pro LLC  
Laguna Beach CA

Karen S. Canady  
Canady + Lortz LLP  
Los Angeles, CA

Marcellus A. Chase  
Randall Danskin, PS  
Spokane, WA

Brian Cronquist  
MonolithIC 3D Inc.  
Klamath Falls, OR

Anthony Curtis  
Champaign, IL

Timothy J. Dell  
Colchester, VT

David P. Dickerson  
Freising, Germany

Daniel Douglas  
Weitzman Law Offices, LLC  
Roseland, NJ

John S. Economou  
Mandelbaum Silfin Economou LLP  
White Plains, NY



Tom Engellenner  
Nelson Mullins  
Boston, MA

William Eshelman  
Law Office of William Eshelman  
Front Royal, VA

Daniel J. Feigelson  
Rehovot, Israel

Luis Figarella  
Matrix Patent Agency  
Nashua, NH

John K Fitzgerald  
Fitzgerald IP Law  
Box Elder, SD

Frederick A. Flitsch  
OCNY Consulting, LLC  
New Windsor, NY

Derek P. Freyberg  
Menlo Park, CA

Robert A. Frohwerk  
Your Intellectual Property Matters, LLC  
Meridian, ID

Antoinette G Giugliano  
AGG Intellectual Property Law  
Beverly, MA

Charles L. Gholz  
Oblon  
Alexandria, VA

Lee R Golden  
Rehovot, Israel

Bernard Greenspan  
Greenspan IP Management  
San Diego, CA

John M. Hammond  
Patent Innovations LLC  
Lakeville NY

Diana Hamlet-Cox  
Millen White Zelano & Branigan PC

Charles Andrew Hayes  
Wegman Hessler  
Cleveland, OH

Steven M. Hertzberg  
New York, NY

Joell R. Hibshman II  
Claim Construction PLLC  
Warren, NH

Greg S. Hollrigel  
San Clemente, CA

Allen E. Hoover  
Fitch, Even, Tabin & Flannery LLP  
Chicago, IL

Kenneth E. Horton  
Kirton McConkie  
Salt Lake City, UT

Krista S. Jacobsen  
Jacobsen IP Law  
Campbell, CA

Ronni S. Jillions  
Browdy and Neimark, PLLC  
Washington DC

Todd Juneau  
Juneau & Mitchell  
Alexandria, VA

Jeffrey S. Kapteyn  
Price Heneveld LLP  
Grand Rapids, MI

Ron Katznelson  
Bi-Level Technologies  
Encinitas, CA

Paul Keating  
Law.es  
Barcelona, Spain

## 109 PATENT PRACTITIONERS

Page 19 of 21

0651-0012 comment in response to December 23, 2020 request for comment, *Admission to Practice and Roster of Registered Patent Attorneys and Agents*  
February 22, 2021

Ronald R Kilponen  
Kilponen IP Law  
Novi, MI

Karen L Kimble  
Technology Law PLLC  
Sanford, MI

Howard J Klein  
Klein, O'Neill & Singh, LLP  
Irvine, CA

Wendy W. Koba  
Wendy W. Koba, Esq.  
Springtown, PA

Katherine Koenig  
Koenig IP Works, PLLC  
Fort Lauderdale, FL

Herb Lacey  
Innatricity  
Clayton, NC

James E. Lake  
Randall Danskin, PS  
Spokane, WA

Joseph T. Leone  
DeWitt LLP  
Madison, WI

Stuart Levy  
Law Firm of Stuart S. Levy  
District of Columbia

Mary Frances Ludwig  
Kintner IP, LLC  
Kintnersville, PA

Howard A. MacCord, Jr.  
MacCord Mason PLLC  
Greensboro, NC

Steven K Martin  
Altman & Martin  
Boston, MA

Jose R. Mata  
Mata Patent Law  
Bend, OR

Ira S Matsil  
Slater Matsil, LLP  
Dallas, TX

Eric C. Merenstein  
Lowenstein Sandler LLP  
Roseland, NJ

M.P. Moon  
Wilmington, DE

James E. Mrose  
Browdy and Neimark, PLLC  
Washington, DC

Jeanette Meng Nakagawa  
Nashville, TN

Richard Neifeld  
Neifeld IP Law, PLLC  
Fairfax, VA

Sam L. Nguyen  
HDC IP Law, LLP  
Saratoga, CA

Tiep Nguyen  
Fujitsu Limited  
Alexandria, VA

G. Peter Nichols  
Barnes & Thornburg LLP  
Chicago, IL

Stephen M. Nipper  
Colby Nipper PLLC  
Boise, ID

Axel Nix  
Smartpat PLC  
Detroit, MI

Tim Nolan  
Tim Nolan Patent Agent LLC



## 109 PATENT PRACTITIONERS

Page 20 of 21

0651-0012 comment in response to December 23, 2020 request for comment, *Admission to Practice and Roster of Registered Patent Attorneys and Agents*

February 22, 2021

Blacksburg, VA

Carol Nottenburg  
Cougar Patent Law  
Renton WA

Mark Nowotarski  
Markets, Patents & Alliances LLC  
Darien, CT

Gary O'Neill  
Duncanville, TX

Carl Oppedahl  
Oppedahl Patent Law Firm LLC  
Westminster, CO

Neil R. Ormos  
Arlington Heights, IL

Karen Oster  
Green, Howard, & Mughal, LLP  
Lake Oswego, OR

Miriam Paton  
Integral Intellectual Property Inc.  
Toronto, Canada

Gerald T. Peters  
JTT Patent Services, LLC  
West Lebanon NH

John Pietrangelo  
Tech Valley Patent, LLC  
Glens Falls, NY

Alexander Pokot  
AP Patents  
Williams Bay, WI

Margaret Polson  
Polson IP Law, PC  
Westminster, CO

Umair A. Qadeer  
Hojka Qadeer, LLC  
Chicago, IL

David M. Quinlan

David M. Quinlan, P.C.  
Princeton, NJ

C. Dale Quisenberry  
Quisenberry Law PLLC  
Houston, TX

Graham Ross  
Blue Sky Technical Advisors  
San Diego, CA

Z. Peter Sawicki  
Westman, Champlin & Koehler  
Minneapolis, MN

Richard A. Schafer  
Schafer IP Law  
Houston, TX

David S. Shobe  
Lawrence, KS

Brian Siritzky  
Siritzky Law, PLLC  
McLean, VA

Alex R. Sluzas  
Paul and Paul  
Philadelphia, PA

Marlin R. Smith  
Smith IP Services, P.C.  
Rockwall, TX

Timothy M. Smith  
Smith & Woldesenbet Law Group, PLLC  
Sugar Land, TX

Dana Stangel  
MacMillan, Sobanski & Todd, LLC  
Fort Collins, CO

Richard Straussman  
Weitzman Law Offices, LLC  
Roseland, NJ

Jack F. Stuart II  
Martensen IP

## 109 PATENT PRACTITIONERS

Page 21 of 21

0651-0012 comment in response to December 23, 2020 request for comment, *Admission to Practice and Roster of Registered Patent Attorneys and Agents*

February 22, 2021

Colorado Springs, CO

Suzannah K. Sundby  
Canady + Lortz LLP  
Washington DC

Dan Swirsky  
Beit Shemesh, Israel

Judith Szepesi  
NDWE LLP  
San Jose, CA

Jeroen Valensa  
Pewaukee, WI

Louis Ventre, Jr.  
Law Firm of Louis Ventre, Jr.  
Oakton, VA

Eric S. Wachspress

Chicago, IL

Shalom Wertsberger  
Saltamar Innovations  
Rochester, NY

George P. White  
G. White Patents  
Long Beach, CA

Warren Wolfeld  
Half Moon Bay, CA

Bruce A. Young  
Young's Patent Services LLC  
Le Mars, IA

Allen C. Yun  
Browdy and Neimark, PLLC  
Washington DC

### Attachments:

Exhibit A: Calculation of numbers used in this letter

Exhibit B: Comment letter of American Intellectual Property Law Association (AIPLA) on *Proposed Continuing Legal Education Guidelines*, Docket No. PTO-P-2020-0042, 85 Fed. Reg. 64128 (Oct. 9, 2020), [https://www.uspto.gov/sites/default/files/documents/AIPLA\\_Letter\\_to\\_USPTO\\_on\\_CLE\\_Guidance\\_010721\\_FINAL.pdf](https://www.uspto.gov/sites/default/files/documents/AIPLA_Letter_to_USPTO_on_CLE_Guidance_010721_FINAL.pdf) (Jan. 7, 2021)

Exhibit C: Slides from the PTO's course, *Learn online how examiners approach After Final Practice*

Exhibit D: Comment letter of David Boundy on *Proposed Continuing Legal Education Guidelines*, Docket No. PTO-P-2020-0042, 85 Fed. Reg. 64128 (Oct. 9, 2020), [https://www.uspto.gov/sites/default/files/documents/2021-01-11\\_revised\\_letter\\_re\\_PTO\\_CLE\\_engrossed\\_DEB\\_to\\_PTO.pdf](https://www.uspto.gov/sites/default/files/documents/2021-01-11_revised_letter_re_PTO_CLE_engrossed_DEB_to_PTO.pdf) (Jan. 11, 2021)

Exhibit E: Form PTO-107S, from [https://www.uspto.gov/sites/default/files/documents/PTO107S\\_Mandatory\\_Survey.pdf](https://www.uspto.gov/sites/default/files/documents/PTO107S_Mandatory_Survey.pdf)

## **Exhibit D**

**Comment letters on *Proposed Continuing Legal Education Guidelines*, 85 Fed. Reg. 64128 (Oct. 9, 2020).**

# CAMBRIDGE TECHNOLOGY LAW LLC

TECHNOLOGY LAW WITH A BUSINESS PERSPECTIVE

---

DAVID E. BOUNDY

686 MASSACHUSETTS AVE., SUITE 201, CAMBRIDGE, MA 02139

MAILING: P.O. Box 590638, NEWTON MA 02459

PHONE: 646.472.9737

FAX: 978.443.4812

E-MAIL: DBOUNDY@CAMBRIDGETECHLAW.COM

HTTP://WWW.CAMBRIDGETECHLAW.COM

January 11, 2021 (replacing an earlier version of January 7)

Via Email [CLEguidelines@uspto.gov](mailto:CLEguidelines@uspto.gov)

William Covey, Director for the Office of Enrollment and Discipline

Mail Stop OED

United States Patent and Trademark Office

P.O. Box 1450

Alexandria, VA 22313-1450

Re: *Proposed Continuing Legal Education Guidelines*, Docket No. PTO-P-2020-0042, 85 Fed. Reg. 64128 (Oct. 9, 2020)

Dear Director Covey:

CLE may or may not be a good idea. However, as proposed in the *Proposed CLE Guidelines*, it can't work. The basic economic incentives are misaligned, and parties will not behave as the *Guidelines* notice seems to assume.

There's a far bigger problem. However well intentioned your plan may be, it can't go forward if it isn't implemented within the law. The *Proposed CLE Guidelines* are classic subject matter that requires a "legislative rule" with full-dress *regulation* procedure. The word "regulation" in 35 U.S.C. § 2(b)(2)(D) requires advance "consultation with members of the public" under the Paperwork Reduction Act (PRA), Administrative Procedure Act (APA) notice-and-comment without the shortcuts of the October 9 notice, full procedure under the PRA, a full RegFlex analysis or certification under the Regulatory Flexibility Act, and various procedures under several executive orders. The attempt to fly the *Proposed CLE Guidelines* under the radar as guidance is a transparent effort to evade, and thereby violate, multiple laws. Main Commerce's regulations govern component agencies' use of subregulatory guidance; it's shocking to see a PTO Federal Register notice that squarely defies a formal *regulation* from Secretary Ross. The overall approach communicates contempt for the rule of law.

As will be shown below, this *Proposed CLE Guidelines* notice, the August 3, 2020 *Fee Setting* notice ("August 2020 Final Fee Rule"),<sup>1</sup> and the July 2020 *Changes to Representation of*

---

<sup>1</sup> Patent and Trademark Office, *Setting and Adjusting Patent Fees During Fiscal Year 2020*, 85 Fed. Reg. 46932, 46948 (Aug 3, 2020)

United States Patent and Trademark Office re Proposed Continuing Legal Education Guidelines,  
Docket No. PTO-P-2020-0042, 85 Fed. Reg. 64128 (Oct. 9, 2020)  
January 11, 2021

*Others* (“July 2020 *Changes NPRM*”)<sup>2</sup> contain nearly two dozen omissions and falsehoods, all to the same three ends: (a) to get out of doing work required by law and to avoid informing the public of the scope of topics open for comment, (b) to generate fees and reduce costs for the PTO even if that imposes disproportionate and unlawful costs on the public, and (c) to evade various regulatory review laws that require cost-benefit analysis and written consideration of public interest factors, thereby to evade oversight by *ex parte* tribunals,<sup>3</sup> so that these oversight tribunals can’t interfere with the PTO’s monetary interests of (b). The single most reasonable inference from this ongoing pattern is not helpful to an ethics regulator.

You should run a notice *forthwith* that the *Proposed CLE Guidelines* and the August 2020 amendments to 37 C.F.R. Part 11 are rescinded. If changes in recognition of attorneys and agents, or a CLE rule, are good ideas, they must be done by the book, observing all requirements of law, without disingenuously evading response to comment, and without falsehoods that evade candor with *ex parte* tribunals.

---

<sup>2</sup> Patent and Trademark Office, *Changes to Representation of Others Before the United States Patent and Trademark Office*, Notice of Proposed Rulemaking, 85 Fed. Reg. 45812 (Jul 30, 2020).

<sup>3</sup> Rules—whether promulgated as regulation or as guidance are subject to at least three *ex parte* reviews by regulatory oversight agencies.

- (a) Before an NPRM and before a final rule, and agency is supposed to submit rules to the Office of Information and Regulatory Affairs (OIRA) in the Executive Office of the President for review under Executive Orders 12866 and 13771. E.O. 12866 requires agencies to be careful to regulate in the public interest, not in the agency’s self interest, and to make cost-benefit showings. E.O. 13771 is President Trump’s “two for one” executive order. There are exemptions for certain classes of rule; because false exemption claims have no direct forum for review, the PTO’s rulemaking notices have been absolutely shameless since the Toupin years in falsely claiming these exemptions.
- (b) The PRA, 44 U.S.C. § 3501 *et seq.* requires certain cost-benefit analysis in agency NPRM’s to ensure that an agency minimizes its paperwork burden, and submission to OIRA for review around the time of a Final Rule notice. The PTO has been equally disingenuous in claiming exemption. Several examples are in § V of this letter.
- (c) The RegFlex Act, 5 U.S.C. § 601 *et seq.* likewise requires cost-benefit analysis relating to small entities in NPRMs and in Final Rule notices, and submission to the Small Business Administration, Office of Advocacy.

While the public generally has the ability to file comment letters that are forwarded to OIRA and SBA-OA as part of any review *that actually occurs*, the public has no participation in a review *that the PTO evades via a false claim of an exemption*. Further, once a rule is under review, the public has little to no participation, and review is *ex parte*. For example, for a RegFlex review, the public is given no notice that a review is even under way, let alone opportunity to be heard. For E.O. 12866 review, the public can request meetings at OIRA, but the public isn’t allowed to see the rule that’s under review or the agency’s submission requesting review. Under all three, the agency and OIRA/SBA-OA regulatory reviewers may negotiate terms of the review or modifications to a rule, but the public has no insight or participation in that process, and no opportunity to be heard.

United States Patent and Trademark Office re Proposed Continuing Legal Education Guidelines,  
Docket No. PTO-P-2020-0042, 85 Fed. Reg. 64128 (Oct. 9, 2020)  
January 11, 2021

**I. As published, the *Proposed CLE Guidelines* cannot lead to a sound program**

Before we get into the legal problems with the October *Proposed CLE Guidelines* notice, there are four practical characteristics that guarantee failure. These four factors also disprove any analogy to state bar CLE requirements:

- (a) The August 2020 *Proposed CLE Guidelines* notice indicates that the PTO will offer CLE courses for free. Then, the *Proposed CLE Guidelines* rely on an unstated assumption that a robust market of third-party providers will emerge in parallel—even as the PTO imposes new costs, applications for OED accreditation, generating certificates, and tracking attendance for CLE credits. Those two assumptions are mutually contradictory. Very few businesses can survive, let alone emerge anew, if they’re competing against a free, government competitor that siphons off a large fraction of the business. And if that government entity simultaneously increases regulatory burden, even existing of third-party CLE providers will likely drop out. No state licensing authority that I am aware of competes as aggressively with CLE vendors as the *Proposed CLE Guidelines* propose.
- (b) Unlike any state bar regulator, the PTO is self-funding by user fees from *operations*. The PTO’s CLE courses will be conflicted—the course will teach how to do things in ways that reduce costs for the PTO, no matter how badly those techniques impair the value of the resulting patent. Over time, a CLE pointer that starts out expressed as advisory guidance will gradually turn into “must” in the CLE and as enforced by patent operations, for the benefit of the PTO, not the public or the patent bar. The PTO has a demonstrated record of creating this kind of financial conflict of interest. Several examples:
  - (i) The CLE offered by the Office of Patent Application Processing (OPAP) about Application Data Sheets. The operative regulation, 37 C.F.R. § 1.76, allows priority claims to be listed in any order. OPAP guidance and the CLE offered by OPAP teach the public that priority claims must be listed in reverse-chronological order. The reverse-chronological requirement stands on no authority other than the personal preference of someone in OPAP. The reverse-chronological requirement is now enforced by OPAP as if it were a valid and enforceable “rule.” This reduces costs for OPAP, and generates the \$1600 fees for late priority claims, but creating obligations on the public without the procedures of rulemaking is brazen cheating. I’ve petitioned it repeatedly; the Office of Petitions insists on enforcing rules that don’t exist, if the petitioned issue is coupled to a \$1600 fee.
  - (ii) The SES Executive Performance Agreement for the Deputy Commissioner for Patent Examination Policy states that the first priority for both “Petitions Processing” and for “Quality and Training” is “As a fee-funded agency, the USPTO relies on user fee collections to fund patent operations”—rule of law, and performance of the Director’s “duties in a fair, impartial, and equitable manner,” 35 U.S.C. § 2(a)(2)(A), are nowhere mentioned as compensation metrics. Petition decisions, including those signed by Mr. Bahr, clearly reflect those incentives.

United States Patent and Trademark Office re Proposed Continuing Legal Education Guidelines,  
Docket No. PTO-P-2020-0042, 85 Fed. Reg. 64128 (Oct. 9, 2020)  
January 11, 2021

This history of *creating* rather than controlling financial conflicts does not reassure that the PTO will use CLE in the public interest. Unless the PTO can erect some kind of ethical wall that *completely* and *permanently* decouples the PTO's own CLE from all financial interest of patent operations, any CLE the PTO offers will be an engine of conflicts of interest. No state bar has this kind of built-in financial conflict.

- (c) The PTO's record of delivering *helpful* CLE is extremely limited. Because the PTO has no role in post-issue life of patents, the PTO has developed no expertise on the subject.
  - (i) The talks I've heard over the years given by folks from the Office of Patent Legal and Administration display astonishing naïveté about what makes patents enforceable and valuable.
  - (ii) When Mr. Moatz was OED Director, I heard two of his talks in New York—he opined that some feature of IDSs was required, and would be investigated by OED as an ethics issue. I knew there was no such written rule, so I asked him to identify the rule, and whether he had done the rulemaking required by the APA. I recall my shock at the dismissive view Mr. Moatz expressed for his obligations under the APA.
  - (iii) I also recall Mr. Moatz' naïveté about the practical realities of how clients behave, and what's beyond a lawyer's control.
  - (iv) Another example is the “memo to file” recommended in MPEP § 2004 ¶ 18—any lawyer with any understanding of the Federal Rules of Civil Procedure knows of the obligation to turn over any documents reviewed in preparation for a deposition. Once MPEP § 2004 ¶ 18 memo to file is turned over, that can metastasize into a catastrophic subject matter waiver. I have written on this in several past comment letters—why is this still here? The PTO has a demonstrated record of *not* correcting dissemination of nonsense “education.”

The PTO should not place itself in the position of the “inside track” CLE provider—it lacks the competence to do so. That's why states largely outsource CLE to experts from the private sector—I can't recall ever receiving a CLE invitation from my two state bar regulators.

- (d) As discussed in more detail below, the PTO's Federal Register notices communicate that basic principles of administrative law are not integrated into the day-to-day operational understanding of the PTO legal machinery—and that has now bled over into the Office of Enrollment and Discipline. This October 9 notice, the August 2020 Final Fee Rule notice, and the July 2020 *Changes* NPRM communicate an attitude somewhere between willfully dismissive and brazenly defiant toward the laws that govern agencies and protect the public against agency overreach.

Together, these four factors ensure that any program of CLE reporting, even a supposedly-voluntary one, is doomed to failure and illegal implementation.



United States Patent and Trademark Office re Proposed Continuing Legal Education Guidelines,  
Docket No. PTO-P-2020-0042, 85 Fed. Reg. 64128 (Oct. 9, 2020)  
January 11, 2021

## II. Legal defects in the October notice

The *Proposed CLE Guidelines* request for comment is not adequate as a substitute for a notice of proposed rulemaking for a *regulation*. Before the PTO can go forward, the PTO will have to publish a legally-proper NPRM.

A most remarkable series of facts is difficult to explain as coincidence: a regulation was attempted, blocked by adverse comment, and now the *Proposed CLE Guidelines* notice attempts to achieve the same regulatory ends, bypassing statutorily-required procedure:

- In *Setting and Adjusting Patent Fees During Fiscal Year 2020, Notice of Proposed Rulemaking*, 84 FR 37398, 37438 (Jul. 31, 2019) (the “2019 Fee NPRM”), OED proposed to require a CLE certification, with certain opt-outs. The term “registration statement” is never used. A number of comment letters raised objections. Several of the comment letters raised specific legal objections arising under the APA, PRA, RegFlex Act, and Executive Orders 12866 and 13771.
- In the August 2020 Final Fee Rule notice, OED cured none of the statutory deficiencies noted in the comment letters. OED declined *over eighty times* to answer public comments, excusing itself because no practitioner fee or CLE rule was included in the August notice. The rationale of the August 2020 Final Fee Rule notice is false: § 11.11(a) has a CLE rule on which the public commented adversely.
- The Response to comments section of the August 2020 Final Fee Rule notice, eighty times, declines to answer specific questions. In most cases, the August 2020 Final Fee Rule notice give no answer at all. When there’s some “response,” the response evades the question:

*Comment 86:* One commenter wrote that the USPTO must analyze costs for all patent agents and patent attorneys who do not have an existing CLE requirement that would overlap with any USPTO requirement.

*Response:* As noted in response to Comment 81 above, the USPTO has elected not to implement the proposed annual active patent practitioner fee at

this time. Under this Final Rule, completion of CLE remains voluntary. However, the Final Rule provides that patent practitioners who have completed six credits of CLE within the preceding 24 months may certify such completion to the OED director. The USPTO intends to issue proposed CLE guidelines, with a request for public comment on the proposed guidelines.

Note that the “response” says *nothing* responsive to the comment, giving the appearance of evasion. I located this comment,<sup>4</sup> and it cites two specific laws (the PRA) and Executive Order 12866 that require cost analysis. The August 2020 Final Fee Rule notice sets out none of the cost estimates required by law, identifies no exemption from

---

<sup>4</sup> [https://www.uspto.gov/sites/default/files/documents/Comment\\_Seventy\\_Three\\_Patent\\_Practitioners\\_092719.pdf](https://www.uspto.gov/sites/default/files/documents/Comment_Seventy_Three_Patent_Practitioners_092719.pdf) at page 25.



United States Patent and Trademark Office re Proposed Continuing Legal Education Guidelines,  
Docket No. PTO-P-2020-0042, 85 Fed. Reg. 64128 (Oct. 9, 2020)  
January 11, 2021

either the statute or the Order, and offers no explanation. The single most reasonable inference is that this evasion of law is knowing and intentional.

- Likewise, another comment and response reads:

*Comment 110:* A few commenters stated that the annual active patent practitioner fee would disproportionately affect patent agents because they do not currently have a CLE requirement, and they would therefore incur an extra expense as compared to patent attorneys. Two of these commenters additionally stated that publication of the CLE certification status of practitioners by the OED director may be equivalent to a public shaming of those patent practitioners who do not have a state CLE requirement or who opt to pay the full fee, resulting in unfair prejudice toward those who do not certify completion of

CLE and essentially making CLE mandatory.

*Response:* In this Final Rule, there is no active patent practitioner fee, and thus there is no CLE discount. In addition, under the Final Rule completion of CLE remains voluntary. Separately, this rule provides for publication of a patent practitioner's CLE certification status, which is intended to encourage patent practitioners to participate in CLE and provide information to the public regarding the patent practitioner's CLE status. The USPTO also intends to provide additional free CLE courses to patent practitioners, thus alleviating the financial burden of obtaining CLE credits.

Again, there's no response to the comment, only evasion. Note that the August 2020 Final Fee Rule notice does not disagree with the observation that "public shaming" is intended to make the CLE requirement mandatory.

- Only seven weeks after the August 2020 Final Fee Rule notice, this *Proposed CLE Guidelines* notice sets out "guidelines" that have mandatory requirements and sanctions. The *Proposed CLE Guidelines* contains no "rulemaking considerations" section, and by that omission, avoids all requirements under a number of statutes and executive orders.

The single most reasonable inference is that OED found that it was blocked from proceeding by "regulation," and therefore decided to sneak the same content past various regulatory review procedures by publishing guidance. The single most reasonable inference is that OED intentionally chose to skip out on Executive Order 12866, Executive Order 13771, the PRA and its implementing Information Collection regulations (5 C.F.R. Part 1320), and the RegFlex Act, because those laws blocked the path of "regulation."

However, the legal blocks to the *Proposed CLE Guidelines* as guidance are even higher than for regulation.

First, the Patent Act only gives OED authority to regulate practitioners by *regulation*, not guidance. 35 U.S.C. § 2(b)(2)(D). The Federal Circuit recently reminded the PTO that when Congress uses the word "regulation," it requires full-dress "regulation" procedure. *Facebook, Inc. v. Windy City*, 973 F.3d 1321, 1349-50 (Fed. Cir. 2020) (you may wish to pull my *amicus* brief in the *Windy City* case, and the PTO's, and compare them to the Court's decision, and

United States Patent and Trademark Office re Proposed Continuing Legal Education Guidelines,  
Docket No. PTO-P-2020-0042, 85 Fed. Reg. 64128 (Oct. 9, 2020)  
January 11, 2021

discern for yourself whether my understanding of administrative law or the Solicitor's is more in line with the court's).<sup>5</sup>

Second, OED's authority is limited to "govern the recognition and conduct ... before the Office," not outside, and to require various showings "**before**" recognition. 35 U.S.C. § 2(b)(2)(D). The statute grants OED no authority to govern outside-the-office conduct or ongoing recognition for any reason other than misconduct.

Third, a Department of Commerce regulation, 15 C.F.R. § 29.2(a), forbids Commerce component agencies from using guidance in any mandatory capacity. Whatever past questions there may have been in August 2020 about legality of the PTO imposing new requirements by guidance, those questions were resolved on September 28, 2020, 85 Fed. Reg. at 60694, when the Department of Commerce promulgated 15 C.F.R. § 29.2. 15 C.F.R. § 29.2(a) requires that if the PTO issues this rule in the form of guidance, the PTO must "indicate prominently that each guidance document does not bind the public." To issue a CLE rule—even a hortatory rule—by guidance, the PTO must "comply with Executive Orders 12866, 13563, 13609, 13771 and 13777." 15 C.F.R. § 29.2(b). Executive Orders 12866, 13562, and 13771 require cost-benefit analyses, various disclosures, and "two for one" deregulatory action or justification. By trying to submarine a substantive rule through as guidance—only 11 days after Commerce told component agencies not to do so—the *Proposed CLE Guidelines* notice not only skipped out on multiple legal obligations, but creates an impression of disregard for legal authority.

---

<sup>5</sup> Likewise, it will be recalled that at the 2018 Federal Circuit Judicial Conference I was the invited panel moderator to help the Court understand issues of administrative law. At the Conference, Judge Plager recommended my articles as the best place for the patent bar to begin to understand the administrative law as it applies to the PTO. The Court takes my views on administrative law issues seriously—perhaps OED would find them helpful as well. The single most relevant article is *The PTAB Is Not an Article III Court, Part 3: Precedential and Informative Opinions*, 47 AIPLA Quarterly J. 1-99 (June 2019). The SSRN edition <https://ssrn.com/abstract=3258694> has updates to reflect subsequent case law. PTAB opinions are just one form of guidance, so the analysis in the article applies equally to the *Proposed CLE Guidelines*. Other articles are at <http://ssrn.com/author=2936470>.

United States Patent and Trademark Office re Proposed Continuing Legal Education Guidelines,  
Docket No. PTO-P-2020-0042, 85 Fed. Reg. 64128 (Oct. 9, 2020)  
January 11, 2021

Fourth, under the APA<sup>6</sup> and PRA (44 U.S.C. §§ 3506, 3507), an agency must genuinely respond to public comments—the agency cannot mischaracterize the public comments in order to duck its obligation to fairly answer them. In the August 2020 Final Fee Rule notice, OED evaded its obligation to respond to public comments. OED is now hoist of its own petard. By its evasive response to Comment 110, OED concedes that the “public shaming” of CLE status effectively makes the CLE requirement mandatory. Any claim that CLE is “voluntary” is both irrelevant to any of the laws in this § II of this letter, and further, barred by OED’s evasion of the legal obligation to answer comments fairly and meaningfully.

Fifth, in the past, the PTO has declined to produce a response to comments document for guidance (even though the PTO was under an obligation to do so<sup>7</sup> from 2007 until 2019). Because the *Proposed CLE Guidelines* don’t qualify for any of the exemptions from notice-and-comment of 5 U.S.C. § 553(a) or (b)(A) or (b)(B), that opt-out isn’t available for the *Proposed CLE Guidelines*. OED will have to prepare a full response to comments—and should not evade fair answers the way it did in the August 2020 Final Fee Rule notice.

Sixth, the Office appears to have overlooked the PRA: even “voluntary” certifications are covered. 5 C.F.R. § 1320.3(c) (coverage includes both “reporting” and “recordkeeping,” whether “voluntary, or required to obtain or retain a benefit”); § 1320.3(c)(4)(i) (coverage extends to “any requirement contained in a rule of general applicability”); §§ 1320.10, .11, .12 (coverage extends to paperwork whether created by regulation or by guidance). The *Proposed CLE Guidelines* notice skipped the legally-required procedures.

Seventh, the PRA requires that an agency ask four specific questions to ensure that paperwork the agency proposes to collect have “practical utility” and are as low burden as can be arranged. 44 U.S.C. § 3506(c)(2)(A) and 5 C.F.R. § 1320.8(d)(1). The *Proposed CLE Guidelines* notice skipped the legally-required four questions.

---

<sup>6</sup> *Lilliputian Systems, Inc. v. Pipeline and Hazardous Materials Safety Admin.*, 741 F.3d 1309, 1313-14 (D.C. Cir. 2014) (where comment letters point out a problem with an agency’s rule, and the agency’s response is tangential because it recharacterizes the problem rather than responding to the comment, the agency’s action is arbitrary and capricious); *Kennecott v. Environmental Protection Agency*, 780 F.2d 445, 449 (4th Cir. 1985) (“The court best acts as a check on agency decisionmaking by scrutinizing process... Whether the agency has provided notice and an opportunity to comment, and has fairly considered all significant data and comments, is the heart of the judicial inquiry.”); *Casa de Maryland, Inc. v. Wolf*, 2020 WL 5500165 at \*26 (D. Md. 2020) (where comments raise a significant concern, the agency must “adequately analyze ... the consequences” of its actions. ... It cannot “brush[ ] aside” important facts .. or offer ‘conclusory statements’ to prove that it “consider[ed] [the relevant] priorities”); cf. *City of Vernon, Cal. v. Federal Energy Regulatory Comm’n*, 845 F.2d 1042 (D.C. Cir. 1988) (“No matter how rudimentary a claim, an agency is not entitled under the APA to respond with a *non sequitur*.”).

<sup>7</sup> Executive Office of the President, *Final Bulletin for Agency Good Guidance Practices*, OMB Memorandum M-07-07 (Jan. 18, 2007), reprinted in 72 Fed. Reg. 3432 (Jan. 25, 2007).

United States Patent and Trademark Office re Proposed Continuing Legal Education Guidelines,  
Docket No. PTO-P-2020-0042, 85 Fed. Reg. 64128 (Oct. 9, 2020)  
January 11, 2021

Eighth, any rule that purports to govern conduct outside the Office is a “substantive” rule rather than “procedural.” Any PTO action that is conditioned on a practitioner’s attendance or non-attendance of CLE is “substantive” for purposes of the APA. That triggers a number of obligations under other laws. For example, the RegFlex Act (5 U.S.C. § 603, 604) requires initial and final RegFlex analyses of effect on small entity law firms, lawyers, and agents. Obligations under several executive orders are higher for “substantive” rules than for “procedural.” The *Proposed CLE Guidelines* notice skipped out on these legal obligation.

Ninth, the *Proposed CLE Guidelines* are “significant” under Executive Order 12866: if a rule gives OED authority to discipline a practitioner up to and including loss of livelihood, the rule doesn’t qualify as “not significant.” The Department of Commerce requires that any “significant” rule in guidance be reviewed by the Office of Information and Regulatory Affairs for compliance with Executive Order 12866. 15 C.F.R. § 29.2(c)(1)(iii). Executive Order 12866 § 1(b)(5) requires an agency “shall consider incentives for innovation, ... costs of enforcement and compliance (to the government, regulated entities, and the public.” Neither the August 2020 Final Fee Rule notice or nor the October Request for Comment indicate that the PTO did either. The only mentions of Executive Order 12866 are statements that the PTO declines to observe its requirements. Responses 85, 126, and 137, 85 Fed. Reg. at 46961, col. 1, and 45697, col. 1. The silence in the *Proposed CLE Guidelines* speaks loudly of the level of respect for the rule of law that motivated it.

Tenth, the *Proposed CLE Guidelines* require disclosure to OIRA, and a “two for one” justification under Executive Order 13771.

### **III. The August 2020 amendment to § 11.11(a) is insufficient to support the *CLE Guidelines* as implementing guidance**

The *Proposed CLE Guidelines* claims authority under 37 C.F.R. § 11.11(a)(2). 85 Fed. reg. 64128. 37 C.F.R. § 11.11(a)(2) has not been lawfully promulgated, and cannot serve as support for the *Proposed CLE Guidelines* as implementing guidance:

- § 11.11(a)(2) was (in August 2020) a new “collection of information” covered by the PRA, 44 U.S.C. § 3502(c), § 3506(c); 5 C.F.R. § 1320.3(c), especially § 1320.3(c)(4)(i) and (ii), and thus required publication, comment, analysis, and the four questions required by statute. 44 U.S.C. § 3506(c)(2)(A); 5 C.F.R. § 1320.8(d)(1). Neither the July 2019 NPRM nor the August 2020 Final Fee Rule notice observe the requirements of the PRA. In fact, the Final Rule states that the PTO specifically elected *not* to do so. Responses 130 and 135, 85 Fed. Reg. at 46966, col. 1 and 3. OED hasn’t broken this law yet, but will do so the first time it acts pursuant to § 11.11(a)(2).

United States Patent and Trademark Office re Proposed Continuing Legal Education Guidelines,  
Docket No. PTO-P-2020-0042, 85 Fed. Reg. 64128 (Oct. 9, 2020)  
January 11, 2021

- In the July 2019 Proposed Rule, the PTO claimed to have existing approvals for its CLE rules. That was a falsehood—the OMB web site<sup>8</sup> showed that no such filings had been made as of July 2019. In the August 2020 Final Fee Rule notice, the PTO again claimed to have existing approvals for § 11.11(a)(2), and that other “information collections as a result of this Final Rule have been submitted to the OMB” OMB’s web site shows that both claims are false—no such filings were made, let alone approved.<sup>9</sup> In the August 2020 Final Fee Rule notice, the PTO claimed that any new information collection had been submitted as “as nonsubstantive change requests.” A new collection of information that requires *new* paperwork is not eligible for clearance as a “nonsubstantive change request.” It’s ironic that an ethics regulator would lie three times in order to evade an obligation of candor to an *ex parte* tribunal.
- The regulatory effect of § 11.11(a), governing out-of-agency conduct, is “substantive.” Both the July 2019 NPRM nor the August 2020 Final Fee Rule omit procedural steps required for “substantive” rules. Without those procedures, § 11.11(a) is invalid, and cannot be a launch point for the *Proposed CLE Guidelines*.
- Neither the July 2019 NPRM nor the August 2020 Final Fee Rule notice includes a RegFlex analysis with respect to any rule governing small entity practitioners, 85 Fed. Reg. at 46979, in violation of the RegFlex Act, 5 U.S.C. §§ 603, 604. In fact, the PTO specifically *declined* to do so. 85 Fed. Reg. at 46979, col. 3. The RegFlex Act is administered on an *ex parte* basis by the Small Business Administration. Failure of candor toward an *ex parte* tribunal in an *ethics rulemaking* is striking.
- Executive Order 12866 required the PTO to identify a specific and necessary “compelling public need, such as material failures of private markets to protect or improve ... the well-being of the American people” E.O. 12866 §§ 1(a), 1(b)(1). Executive Order 13771 required a cost-benefit analysis, and a two-for-one deregulatory action. The PTO expressly declined to consider any of the regulatory principles of Executive Orders 12866, 13563, or 13771. Responses 85, 126, and 137, 85 Fed. Reg. at 46961, col. 1, and 45697, col. 1. After the August 2020 Final Fee Rule notice, the Department of Commerce tightened up requirements for component agencies’ rulemaking. 85 Fed. Reg. 55235 (Oct. 15, 2020). Whatever path the PTO’s legal machinery may have mapped for the *Proposed CLE Guidelines* in August 2020, those paths are not open now.
- The Supreme Court warned agencies that it’s inappropriate to “promulgate vague and open-ended regulations that they can later interpret as they see fit.” *Christopher v. SmithKline Beecham Corp.*, 567 U.S. 142, 158 (2012). Agencies can’t use guidance to rewrite or gap-fill their regulations. *Christensen v. Harris Cty.*, 529 U.S. 576, 588 (2000). *Appalachian Power Co. v EPA*, 208 F.3d 1015, 1020 (D.C. Cir. 2000) explained at further length:

---

<sup>8</sup> <https://www.reginfo.gov/public/do/PRAOMBHistory?ombControlNumber=0651-0012>.

<sup>9</sup> <https://www.reginfo.gov/public/do/PRAOMBHistory?ombControlNumber=0651-0012>



United States Patent and Trademark Office re Proposed Continuing Legal Education Guidelines,  
Docket No. PTO-P-2020-0042, 85 Fed. Reg. 64128 (Oct. 9, 2020)  
January 11, 2021

The phenomenon we see in this case is familiar. Congress passes a broadly worded statute. The agency follows with regulations containing broad language, open-ended phrases, ambiguous standards and the like. Then as years pass, the agency issues circulars or guidance or memoranda, explaining, interpreting, defining and often expanding the commands in the regulations. One guidance document may yield another and then another and so on. Several words in a regulation may spawn hundreds of pages of text as the agency offers more and more detail regarding what its regulations demand of regulated entities. Law is made, without notice and comment, without public participation, and without publication in the Federal Register or the Code of Federal Regulations.

*Appalachian Power* then goes through several consequences of an agency's attempt to act by creeping guidance, and decides adversely to the agency on all of them.

The law is clear: to add or change rules that create obligations or burdens on the public, an agency must act by *regulation*. This effort to add new obligations on the public by sneaking guidance under the statutory radar will not be enforceable, and does not reflect well on an ethics regulator.

#### IV. Legal defects in the July 31 *Changes to Representation of Others* notice

The evasion of law extends back to *Changes to Representation of Others Before the United States Patent and Trademark Office*, 85 Fed. Reg. 45812 (Jul. 30, 2020). The July 2020 *Changes* NPRM has many of the same errors—almost all directed to evading work and candor to *ex parte* tribunals:

- In the *Administrative Procedure Act* section, 85 Fed. Reg. 45817, OED claims “The changes in this rulemaking involve rules of agency practice and procedure....” This is a falsehood. For example, the revocation of § 11.11(g) appears to be a new grant of substantive authority to the OED Director, and it is “interpretative” of no underlying statute or regulation. The new fee of §§ 1.21(a)(1), 11.7(b), and 11.9(e) is likewise substantive, and not “interpretative” of any existing statute or regulation. The claim that the August 2020 Final Fee Rule covers only “rules of agency practice” is a falsification. The only rationale I can see is to evade work required by rulemaking statutes, and evade candor to *ex parte* regulatory review tribunals.
- In the *Administrative Procedure Act* section, 85 Fed. Reg. 45817, OED claims “The changes in this rulemaking involve ... interpretive rules.” It’s not clear why the PTO would invoke the definition of “interpretive” from *Perez v. Mortgage Bankers Ass’n*, 575 U.S. 92 (2015)—the sentence *immediately following* the one quoted in the Federal Register reads that “[The] convenience [of invoking the “interpretive” exemption from notice and comment] comes at a price: Interpretive rules ‘do not have the force and effect of law and are not accorded that weight in the adjudicatory process.’” What rationale is there for conceding that the agency’s rules “do not have force of law?” The only rationale I can see is that this statement evades work, and evades *ex parte* regulatory review that a truthful representation would require.

United States Patent and Trademark Office re Proposed Continuing Legal Education Guidelines,  
Docket No. PTO-P-2020-0042, 85 Fed. Reg. 64128 (Oct. 9, 2020)  
January 11, 2021

- The claim that “This rulemaking has been determined to be not significant for purposes of E.O. 12866.” 85 Fed. Reg. 45818. By whom? “Not significant” is reserved for rules with no significant effect—if the July NPRM were limited to typo corrections and the like, the “not significant” designation would be sound. But adding § 11.11(g) gives OED the authority to end careers. That qualifies the rule as “significant.” The only observable reason for OED to misdesignate the rule as “not significant” is to evade work required by Executive Orders 12866 and 13771, evade oversight by OIRA, and to evade the “two for one” justification that would be required if the rule were characterized honestly.
- The *Paperwork Reduction Act* discussion (85 Fed. Reg. 45818-19) fails to consider the several new collections of information and associated fees in the July 2020 *Changes* NPRM, and omits a number of the requirements of the Act. The omissions seem to be directed to only two goals: evading work required by statute, and evading candor to OIRA in its *ex parte* role of oversight over paperwork burden.

## V. Other examples of the pattern

A number of other examples of the PTO evading the law are not directly relevant to this rulemaking, but *are* relevant to show a pattern of disregarding the administrative law.

During the last week of December, I noticed that several of the PTO’s patent forms bore the legend “Approved for use through 12/31/2020. OMB 0651-0031.” I went to check OMB’s web site, and confirmed that OMB Control number 0651-0031 had expired on November 30, 2020. Someone in the Office of Patent Legal Administration or in the Office of General Counsel, probably a lawyer, had falsely updated the PTO’s forms, to cover up a lapse in the PTO’s power enforce its rules and collect its fees.

As a second example, I’ve attached an article I wrote about two years ago about a pattern of falsehoods made in Federal Register notices for a PTAB rule, *Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board*, 83 Fed. Reg. 21221 (May 9, 2018) and 83 Fed. Reg. 51340 (Oct. 11, 2018). If a law requires doing work, asking questions of the public to ensure that a rule will operate as intended, and making filings to obtain oversight by *ex parte* tribunals, the PTO’s practice is to state falsehoods to evade that work, filing, and oversight.

As a third example, the Federal Circuit has repeatedly rebuked the PTAB for attempting to end-run the Administrative Procedure Act by conducting rulemaking through precedential decision. The two most recent instances were on March 18 and September 4, 2020, in *Facebook, Inc. v. Windy City Innovations, LLC*, [953 F.3d 1313](#), 1343 (Fed. Cir. 2020) (additional views of unanimous panel), *reaff’d on reh’g* [973 F.3d 1321](#), 1353 (Sep. 4, 2020), in which the court reminded the PTAB that it lacks rulemaking authority, and that therefore PTAB precedential decisions are not entitled to force of law (under *Chevron* or any other principle of law). In 2017, in *Aqua Products v. Matal*, [872 F.3d 1290](#), 1339 (Fed. Cir. 2017), nine judges reached the issue of the PTAB’s rulemaking authority, and seven agreed that “The Patent Office cannot effect an



United States Patent and Trademark Office re Proposed Continuing Legal Education Guidelines,  
Docket No. PTO-P-2020-0042, 85 Fed. Reg. 64128 (Oct. 9, 2020)  
January 11, 2021

end-run around its congressionally delegated authority by conducting rulemaking through adjudication without undertaking the process of promulgating a regulation.” Since *Aqua Products*, the PTAB has done exactly what was forbidden over thirty times. Since *Windy City* in March 2020, the PTAB has designated **ten** additional decisions precedential. Between the *Ordinary Meaning* rule and the PTAB’s “precedential opinion” practice, it’s not clear that the PTAB recognizes that the APA’s rulemaking provisions apply.

As a fourth example, the Administrative Conference of the United States issued recommendations<sup>10</sup> in August 2019 (that is, over a year ago):

1. An agency should not use an interpretive rule to create a standard independent of the statute or legislative rule it interprets. That is, noncompliance with an interpretive rule should not form an independent basis for action in matters that determine the rights and obligations of any member of the public.
2. An agency should afford members of the public a fair opportunity to argue for modification, rescission, or waiver of an interpretive rule. ...
4. An agency should prominently state, in the text of an interpretive rule or elsewhere, that the rule expresses the agency’s current interpretation of the law but that a member of the public will, upon proper request, be accorded a fair opportunity to seek modification, rescission, or waiver of the rule.

An ACUS recommendation is somewhat analogous to an ALI-ABA restatement—it doesn’t carry force of law on its own, but it’s extremely influential with courts (Justice Scalia served a term as chairman). A year after its issue, no evidence of internalization of these ACUS recommendations is visible in the PTO’s behavior. In fact, the *Proposed CLE Guidelines* is a direct clash.

## VI. Conclusion

Rulemaking law can be complex. To assist the PTO, when the PTO asked for comment on its rulemaking processes in 2011, I collected all the relevant law and reduced it to a simple multi-step timeline in a comment letter.<sup>11</sup> The PTO can’t claim to be ignorant. And yet here we are, with a rulemaking that gives every impression of being an intentional effort to evade the law. Isolated mistakes, especially those that could be subject to different views among reasonable people, would be one thing. In contrast, a pattern of multiple omissions under black-and-white law, false representations of black-and-white fact, and an obvious dodge by attempting to

---

<sup>10</sup> Administrative Conference of the United States, *Adoption of Recommendations*, 84 Fed. Reg. 38927 (Aug. 8, 2019), <https://www.govinfo.gov/content/pkg/FR-2019-08-08/pdf/2019-16946.pdf>

<sup>11</sup> David Boundy, *Improving Regulation and Regulatory Review* (Docket No.: PTO-C-2011-0017), 76 Fed. Reg. 15891 (March 22, 2011), <https://www.uspto.gov/sites/default/files/documents/boundy23may2011.pdf> at pages 6- 13 (May 23, 2011)

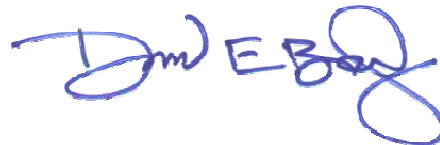
United States Patent and Trademark Office re Proposed Continuing Legal Education Guidelines,  
Docket No. PTO-P-2020-0042, 85 Fed. Reg. 64128 (Oct. 9, 2020)  
January 11, 2021

promulgate a legislative rule as subregulatory guidance, all uniformly directed to evasion of obligations of fair response to comment, evasions of obligations of filings and candor to *ex parte* tribunals, and only *days* after Commerce told the PTO not to, could well lead a reasonable person to infer that the PTO—and OED specifically—has adopted an intentional policy of omission, evasion and falsehood. The PTO's pattern has been when a fork that requires a choice between following the law, giving the public a meaningful opportunity to comment with an honest response-to-comment, and exposing a PTO action to oversight, with the hard work those choices entail, vs. omission and falsehood, the PTO's pattern is the latter. Over and over and over again. Very likely, the initial decisions originated with a lawyer (very likely the person or persons that would have to do the work), and with Patent Legal Administration (because they have obligations to make budget). But OED signed off on this one, and it's OED's reputation for lawfulness and integrity that's on the line.

For these reasons, the *Proposed Guidelines*, the August 2020 amendments to 37 C.F.R. Part 11, and the July 2020 *Changes* NPRM need to go back to square one. OED should promptly run a Federal Register notice that the July 2020 amendments are rescinded, and that the *Proposed Guidelines* and July 2020 *Changes* NPRM will not go final. Before the PTO acts in this area, a number of functions need to be reorganized to remove financial conflicts. The Office of Enrollment and Discipline should turn its investigative spotlight on the PTO itself, and should implement reforms. Individuals that don't want to do the work that statute assigns to them, individuals that think legal obligations are needless nuisance, and lawyers that sign off on non-lawyers' work without careful review, should be given an opportunity to seek other employment. These internal reforms should be completed before the PTO seeks to expand its regulatory reach over ethics of practitioners.

I'm happy to discuss any of this with you. I'm at (646) 472-9737.

Very truly yours,



## **Exhibit E**

**Form PTO-107S, 2020 and 2013 versions,**  
from  
[https://www.uspto.gov/sites/default/files/documents/PTO107S\\_Mandatory\\_Survey.pdf](https://www.uspto.gov/sites/default/files/documents/PTO107S_Mandatory_Survey.pdf)

**MANDATORY SURVEY****DATA SHEET - REGISTER OF PATENT ATTORNEYS AND AGENTS**

You must provide a correspondence/business name, address and telephone number in the boxes below. Government employees must provide the name and address of the department or Government agency in the correspondence/business name, address and telephone number boxes. This will be published in the Government publication **Attorneys and Agents Registered to Practice Before the United States Patent and Trademark Office**. Also provide your home address and telephone number. Only one correspondence address and telephone number will be published. **COMPLETE ALL LINES**

<b>LEGAL NAME</b>	<b>Last Name</b>	<b>First Name</b>	<b>Middle Name</b>	<b>FOR USPTO USE ONLY</b>
<input type="radio"/> Mr. <input type="radio"/> Ms. <b>CORRESPONDENCE/ BUSINESS ADDRESS</b> (street, bldg., suite, etc.) This address will be used for official correspondence.	<b>CORRESPONDENCE/BUSINESS NAME</b> Employer, corporation, law firm, U.S. Government agency. Indicate if student or unemployed.			<b>REGISTRATION NUMBER</b>
<b>CORRESPONDENCE/BUSINESS CITY</b>		<b>CORRESPONDENCE/BUSINESS STATE</b>		<b>CORRESPONDENCE/BUSINESS COUNTRY</b>
<b>CORRESPONDENCE/BUSINESS ZIP CODE</b>		<b>PHONE NUMBER</b> (daytime)		<b>E-MAIL</b> (primary)
<b>E-MAIL</b> (secondary)		<b>CITIZENSHIP</b> (country)		<b>DATE OF BIRTH</b> (month, day, year)
<b>ALTERNATE/HOME ADDRESS</b>				<b>ALTERNATE/HOME PHONE NUMBER</b>
<b>ALTERNATE/HOME CITY</b>	<b>ALTERNATE/HOME STATE</b>	<b>ALTERNATE/HOME COUNTRY</b>		<b>ALTERNATE/HOME ZIP CODE</b>
<b>1.</b> Do you wish to remain on the register? <input type="radio"/> YES <input type="radio"/> NO				
<b>If "NO", do not complete items 3 through 7. Sign, date and return this Data Sheet</b>				
<b>2.</b> Registration Status: <input type="radio"/> ATTORNEY <input type="radio"/> AGENT				
<b>3.</b> If you are an attorney, please list all States of the United States in which you are a member in good standing of the bar of the highest court of the State: _____				
<b>4.</b> <input type="radio"/> YES <input type="radio"/> NO In the last five (5) years, have you been suspended or disbarred from practice on ethical grounds by any duly constituted authority of a State of the United States, or in the case of a practitioner who resides in a foreign country or is registered under 37 CFR § 11.6(c) by any duly constituted authority of the country in which the practitioner resides? If YES, please attach a statement explaining when, where and the grounds for the disbarment or suspension.				
<b>5.</b> <input type="radio"/> YES <input type="radio"/> NO In the last five (5) years, have you been convicted of a felony or misdemeanor (other than a non-criminal traffic violation) by any federal, State or other law enforcement authority? If YES, please attach a statement giving the date, charge, and place of the offense and an explanation of the facts and circumstances leading to the conviction.				
<b>6.</b> <input type="radio"/> YES <input type="radio"/> NO Are you an employee of the United States Government? PLEASE NOTE: U.S. Government employees are not available to accept private clients or to represent clients other than their agency before the United States Patent and Trademark Office. 18 U.S.C. § 205; 37 CFR §§ 11.10(d) and (e).				
<b>7.</b> <input type="radio"/> YES <input type="radio"/> NO Are you a former patent examiner of the United States Patent and Trademark Office?				
<b>I certify that each and every statement or representation in this Data Sheet is true and accurate (a willfully false certification is a criminal offense and is punishable by law (18 U.S.C. § 1001)).</b>				
<b>8.</b> Signature of Applicant				Date

Under the Paperwork Reduction Act of 1995, no person is required to respond to a collection of information unless it displays a valid OMB control number. This collection of information is required by 37 CFR §§ 11.5 through 11.11. This information is used by the public to register to practice before the United States Patent and Trademark Office (USPTO) and by the USPTO to determine the eligibility of the applicant to apply to register to practice before the USPTO. The information on this form will be treated confidentially to the extent allowed under the Privacy Act and the Freedom of Information Act (FOIA). Response to this information collection is voluntary; however, if you do not provide the requested information, the USPTO may not admit you to the registration examination or register you to practice before the USPTO. This form is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the information on the application to the USPTO. Any comments on the amount of time required to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, United States Patent and Trademark Office. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS.**

### **PRIVACY ACT STATEMENT**

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

# SURVEY

Complete and return original form, not a copy

## DATA SHEET - REGISTER OF PATENT ATTORNEYS AND AGENTS

You must provide a correspondence/business name, address and telephone number in the boxes below. Government employees must provide the name and address of the department or Government agency in the correspondence/business name, address and telephone number boxes. This will be published in the Government publication **Attorneys and Agents Registered to Practice Before the United States Patent and Trademark Office**. Also provide your home address and telephone number. Only one correspondence address and telephone number will be published.

**COMPLETE ALL LINES**

NAME	Last Name	First Name	Middle Name	REGISTRATION NUMBER
Mr.				
Ms.				

**CORRESPONDENCE / BUSINESS NAME** (employer, corporation, law firm, or U.S. Government agency, etc.)

**CORRESPONDENCE / BUSINESS ADDRESS** (street, building, suite, etc.)

CITY	STATE	ZIP CODE	CORRESPONDENCE/BUSINESS PHONE
PRIMARY E-MAIL			SECONDARY E-MAIL
HOME ADDRESS			
CITY	STATE	ZIP CODE	HOME PHONE
CITIZENSHIP(country)			DATE OF BIRTH (month, day, year)

1. ☐ YES ☐ NO Do you wish to remain on the register?

(If "NO", do not complete items 2 through 7.  
Sign, date and return this Data Sheet.)

2. Registration Status: ☐ ATTORNEY ☐ AGENT

3. If you are an attorney, please list all States of the United States in which you are a member in good standing of the bar of the highest court of the State:

4. ☐ YES ☐ NO In the last five (5) years, have you been suspended or disbarred from practice on ethical grounds by any duly constituted authority of a State of the United States, or in the case of a practitioner who resides in a foreign country or is registered under 37 CFR § 11.6(c) by any duly constituted authority of the country in which the practitioner resides? If YES, please attach a statement explaining when, where and the grounds for the disbarment or suspension.

5. ☐ YES ☐ NO In the last five (5) years, have you been convicted of a felony or misdemeanor (other than a traffic violation) by any federal, State or other law enforcement authority? If YES, please attach a statement giving the date, charge, and place of the offense and an explanation of the facts and circumstances leading to the conviction.

6. ☐ YES ☐ NO Are you an employee of the United States Government? **PLEASE NOTE: U.S. Government employees are not available to accept private clients or to represent clients other than their agency before the United States Patent and Trademark Office. 18 U.S.C. § 205; 37 CFR §§ 11.10(d) and (e).**

7. ☐ YES ☐ NO Are you a former patent examiner of the United States Patent and Trademark Office?

**FOR UNITED STATES PATENT AND TRADEMARK OFFICE USE ONLY**

AGENT: \_\_\_\_\_

ATTORNEY: \_\_\_\_\_

(See reverse side of form for Privacy Act Statement)

I certify that each and every statement or representation in this Data Sheet is true and accurate (a willfully false certification is a criminal offense and is punishable by law (18 U.S.C. § 1001)).

Signature of Practitioner

Date

Under the Paperwork Reduction Act of 1995, no person is required to respond to a collection of information unless it displays a valid OMB control number. This collection of information is required by 37 CFR §§ 11.5 through 11.11. This information is used by the public to register to practice before the United States Patent and Trademark Office (USPTO) and by the USPTO to determine the eligibility of the applicant to register to practice before the USPTO. The information on this form will be treated confidentially to the extent allowed under the Privacy Act and the Freedom of Information Act (FOIA). Response to this information collection is voluntary; however, if you do not provide the requested information, the USPTO may not register you to practice before the USPTO, or if you are registered, may remove your name from the register of patent attorneys or agents pursuant to 37 CFR §§10.11 and 11.10. This form is estimated to take 20 minutes to complete, including gathering, preparing, and submitting the information on the application to the USPTO. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, United States Patent and Trademark Office, Washington, D.C. 20231. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS.**

**SEND TO: Mail Stop OED, Director, United States Patent and Trademark Office  
P.O. Box 1450, Alexandria, VA 22313-1450**

## PRIVACY ACT ADVISORY STATEMENT

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with the request for information solicited on attached forms PTO-158, PTO-275 and PTO-1209. Accordingly, pursuant to the requirements of the Act, please be advised that (i) the authority for the collection of this data is 35 U.S.C. §§ 1 and 2(b)(2)(D), (ii) furnishing of the information solicited is voluntary, and (iii) the principal purpose for which the data will be used is to maintain current information relating to your eligibility and fitness for registration to practice before the United States Patent and Trademark Office in patent matters. If you do not furnish the requested information, you will not be admitted to the registration examination, registered or reinstated to practice before the United States Patent and Trademark Office.

The information provided by you in this form will be subject to the following routine uses:

1. Information from PTO-158 may be published by the United States Patent and Trademark Office in the *Official Gazette* to solicit information tending to affect your eligibility on moral, ethical, or other grounds for registration pursuant to 37 CFR § 11.7. Information from PTO-275 may be published to provide the public with a roster of registered practitioners pursuant to 37 CFR § 11.11.
2. Disclosure may be made to any Government agency, professional organization or individual, if necessary, to obtain information relevant to an investigation concerning the suitability of an applicant for registration to practice before the United States Patent and Trademark Office.
3. Disclosure may be made to a Federal, state, local, foreign, tribal, or other public authority, of the fact that this system of records contains information relevant to the retention of an employee, retention of a security clearance, the letting of a contract, or the issuance or retention of a license, grant, or other benefit. The other agency or licensing organization may then make a request supported by the written consent of the individual for the entire record if it so chooses. No disclosure will be made unless the information has been determined to be sufficiently reliable to support a referral to another office within the agency, or to another Federal agency for criminal, administrative, personnel, or regulatory action.
4. Disclosure may be made to a court or adjudicative body in a proceeding when: (a) the agency or any component thereof; (b) any employee of the agency in his or her capacity; (c) any employee of the agency in his or her official capacity where the agency has agreed to represent the employee; or (d) the United States Government, is a party to litigation or has an interest in such litigation, and by careful review, the agency determines that the records are both relevant and necessary to the litigation and the use of such records is therefore deemed by the agency to be for a purpose that is compatible with the purpose for which the agency collected the records.
5. Disclosure may be made to a member of Congress or to a congressional staff member in response to an inquiry of the Congressional office made at the written request of the constituent about whom the record is maintained.
6. Information may be disclosed to the Office of Management and Budget (OMB) in connection with a review of private relief legislation (as set forth in OMB Circular No. A-19) at any stage of the legislative coordination and clearance process described in the Circular.
7. The information may be disclosed to the agency contractors, grantees, experts, consultants, or volunteers who have been engaged by the agency to assist in the performance of a service related to this system of records and who have need to have access to the records in order to perform the activity. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. § 552a(m).
8. The information may be disclosed to the Office of Personnel Management (OPM) for personnel research purposes as a data source for management information, for the production of summary descriptive statistics, and analytical studies in support of the function for which the records are collected and maintained, or for related manpower studies.
9. Records from this system of records may be disclosed to the National Archives and Records Administration or to the General Services Administration for records management inspections conducted under 44 U.S.C. §§ 2904 and 2906.
10. When a record on its face, or in conjunction with other records, indicates a violation or potential violation of law, whether civil, criminal, or regulatory in nature, and whether arising by general statute or particular program statute, or by regulation, rule or order issued pursuant thereto, disclosure may be made to the appropriate agency, whether Federal, foreign, state, local or tribal, or other public authority responsible for enforcing, investigating, or prosecuting violations, or charged with enforcing or implementing the statute or rule, regulation, or order issued pursuant thereto, if the information disclosed is relevant to any enforcement, regulatory, investigative, or prospective responsibility of the receiving entity.