Patent Bar Requirements
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In 1892, the Supreme Court noted that patents "constitute one of the most difficult legal instruments to draw with accuracy," Topliff v. Topliff, 145 U.S. 156, 171. In a 1965 letter to Congress, the Department of Commerce reinforced that proposition. It stated that, although only thirty-eight general lawyers had been recognized to prosecute individual applications over a ten-year period, thirty-six files had been abandoned — this despite the presence of patentable subject matter in some or all of them and a 60% successful prosecution rate. Heeding such arguments, Congress gave, in what is now 5 U.S.C. § 500(e), the unique capacity to require members of state bars to pass a patent bar examination.

Despite the perceived need for focused regulation of patent practitioners, the Inspector General of the Commerce Department later identified significant tension between the responsibility of PTO's Office of Enrollment and Discipline (OED) to oversee both admission and discipline. Between 1986 and 1998, OED's staff remained limited to three persons, but admissions-related tasks more than quadrupled. Thus, in FY 1997, for example, OED was able to complete only four disciplinary investigations, leaving an "inventory of pending complaints and investigations [that] had grown to 296, up from 145 at the end of FY 1995."

Such problems were exacerbated by a need, under 28 U.S.C. § 2462, to resolve disciplinary cases within five years. Moreover, OED reported that "a significant percentage of practitioners about whom they receive complaints have already lost their license in at least one state."

Kroll v. Finnerty, 242 F.3d 1359 (Fed. Cir. 2001) subsequently held that membership in the patent bar does not divest state authority to discipline those who harm their citizens. If not already commenced, active cooperation with state bars would permit OED to focus more attention on problems illustrated by Klein v. Peterson, 866 F.2d 412 (Fed. Cir. 1989) — ones directly affecting PTO operations.

Inventors and others harmed by incompetent or dishonest practitioners would also be better served were OED to more effectively focus its efforts in screening applicants for the patent bar. That a handful of special admittees were found to be mostly incompetent forty years ago says little about that.

Over the past thirty years, I've talked to many students who were denied permission to sit. Yet, anyone who passes our demanding patent prosecution courses, not to mention those who also receive high marks in externships and summer jobs, surely satisfies the requirements of 37 C.F.R. § 10.7(a)(2)(ii). Prior to Diamond v. Chakrabarty, 447 U.S. 303 (1980), however, that would have made no difference for students holding degrees in biology. Since then, it has made little difference to many others with technical credentials, grades and experience found attractive by leading patent boutiques.

Apparently intending to represent the latter constituency in 1989, ABA members, stressing a 470% annual increase in software patents, asked OED to accept more people familiar with the technology. Rejecting their plea, the Commissioner argued that complying with their request would thwart his goal of parity with regard to the formal training of examiners and practitioners. For more detail, see the appendix to an article by Michelle Burke and myself at http://www.piercelaw.edu/tfield/ptoExam.htm.

Computer science standards are now a bit more liberal (apparently for both practitioners and examiners). Despite that, trying to require educational parity between examiners and *practitioners* makes little sense. Parity is needed only

between examiners and *inventors,* an objective best served by patent classification, not by standards for admission to practice.

The proposition advanced in *Topliff* is undisputable, but §§ 102 and 103 make anything learned in college unpatentable. On that basis alone, it is apparent that practitioners must be able to prosecute applications covering technologies outside the scope of their formal training.

The Office should therefore bear a substantial burden in requiring technical credentials beyond those demanded by sophisticated clients and firms that serve them. It has never come close.

The PTO denies that its standards are "rules," but the detailed requirements to sit for its bar exam cannot be otherwise regarded. Those requirements have waxed and waned as though the rulemaking requirements of the Administrative Procedure Act did not exist. That the PTO's approach was not rejected in the peculiar circumstances described in Premysler v. Lehman, 71 F.3d 387 (Fed. Cir. 1995) does not justify persistent failure to conduct a thorough public airing of OED's requirements. Indeed, subsequently enacted 35 U.S.C. § 2(b)(2) suggests otherwise.