Patent Bar Requirements Revisited

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Five years ago, I briefly reviewed the history behind the PTO's unique authority to regulate attorneys who wish to prosecute patents. Perhaps the most significant antecedent mentioned there is a 1965 letter to Congress from the Department of Commerce. It stated that, although only thirty-eight general lawyers had been recognized to prosecute individual applications over a ten-year period, they abandoned thirty-six files despite the presence of patentable subject matter in some or all of them. Heeding such arguments, Congress left 35 U.S.C. § 31 — subsequently replaced by § 2(b)(2)(D) — intact and explicitly authorized the PTO to require more than state bar membership from attorneys who wish to prosecute patents. See 5 U.S.C. § 500(e).

The PTO delegates that authority to the Office of Enrollment and Discipline (OED), an entity with less than a stellar record with regard to either enrollment or discipline. These comments focus on the former, but see, e.g., Goldstein v. Moatz, 445 F.3d 747 (4th Cir. 2006) (recounting experiences that led a lawyer to file suit against OED and others). See also, U.S. Department of Commerce, Office of Inspector General, PTO: Office of Enrollment and Discipline Must Conduct More Timely Investigations of Complaints Against Practitioners (1998).

Since I began teaching at Franklin Pierce (now the UNH School of Law) in 1973, I've encountered many who were denied permission to sit for the patent bar. It is surprising that some students who do well in demanding patent prosecution courses, not to mention externships and summer jobs, are nevertheless found unqualified to sit.

Bob Shaw, an experienced patent lawyer, who taught highly-regarded patent prosecution courses for many years, was surely in a better position than anyone within OED to assess the technical and legal competence of would-be practitioners. At one time this was appreciated, and a few candidates with atypical credentials were permitted to sit based on his assurance of competence. If any were later found technically deficient, I never heard about it. By the 1980s, however, his assurances were rejected out of hand.

Insofar as OED's criteria to sit for the exam — particularly those related to computer science — had long seemed too narrowly focused, in February 2006, I petitioned for rule making to subject OED's requirements to public scrutiny. That petition, with related documents, is online. The file contains a declaration by Professor Stanley C. Eisenstat, Dept. of Computer Science, Yale University, explaining why the highly unusual criteria for determining the competency of computer science majors are in fact counter-productive. It also contains a May 2006 letter from James A. Toupin, then General Counsel of the PTO, denying the petition.

Also in May 2006, Professor Ralph Clifford, of the University of Massachusetts College of Law, requested related information under the Freedom of Information Act. As a result, the PTO supplied nearly 55,000 suitably redacted pages of scanned

applications filed by almost 27,000 members of the patent bar. With the assistance of my colleague, Jon Cavicchi, and two students, that information was entered into a database for subsequent statistical analysis.

Our paper, A Statistical Analysis of the Patent Bar: Where are the Software-Savvy Patent Attorneys?, 11 N. Car. J. Law & Tech. 223, 257-65 (2010), summarizes much of the PTO-supplied data in four tables. A fifth summarizes the number of patents granted for various technologies over time. Id. at 266. As the paper demonstrates, the number of practitioners formally qualified to prosecute software patents, compared to the number of software patents granted, has actually diminished over time.

The situation would surely be different were OED to bear a substantial burden in requiring technical credentials beyond those demanded by sophisticated clients and firms that serve them. Instead, the burden falls on anyone whose education does not conform to narrow standards that have never been subjected to public scrutiny.

In refusing my request that the PTO do so, Mr. Toupin said, “An applicant… who does not meet the specific guidelines set forth in the [General Requirements] Bulletin could submit an application asserting that he or she nonetheless possesses the requisite legal, scientific and technical qualifications. If, after being given an opportunity to overcome any cited shortcomings, the applicant is denied admission to the examination, the applicant could petition the OED Director to review the decision. The OED Director would consider such a petition on its merits, and if the OED Director's decision were unfavorable, the applicant could petition for review under 37 C.F.R. § 11.2(d).”

The likelihood of success is unknown. Only one PTO opinion, In re Application of John Doe, 26 U.S.P.Q.2d 1235, 1992 WL 469803 (Com’r 1993), has been found. “Doe” (a pseudonym) lost, as did all others who sought review in the courts. Opinions since Gager v. Ladd, 212 F.Supp. 671 (D. D.C. 1963), suggest that the odds of prevailing are vanishingly slim. That may account for the lack of challenges since 1994.

If Mr. Toupin was being forthright in his letter, at least some candidates must have succeeded at the first or second level of intramural review. Yet no record, much less an opinion, has been found. For anyone considering a challenge, knowing why some candidates have failed is useful but not nearly as useful as knowing that some succeeded and how. It is perhaps time for some of them to be published.