

Before the
United States Patent and Trademark Office
Alexandria, VA

In re

CHANGES TO THE REPRESENTATION
OF OTHERS IN DESIGN PATENT
MATTERS BEFORE THE UNITED
STATES PATENT AND TRADEMARK
OFFICE

Docket No. PTO-C-2023-0010

**COMMENTS OF
COMPUTER & COMMUNICATIONS INDUSTRY ASSOCIATION**

The Computer & Communications Industry (CCIA)¹ submits the following comments in response to the U.S. Patent and Trademark Office’s May 16, 2023, Request for Comments.²

CCIA is an international, not-for-profit trade association representing a broad cross section of communications and technology firms. For more than fifty years, CCIA has promoted open markets, open systems, and open networks. CCIA members employ more than 1.6 million workers, invest more than \$100 billion in research and development, and contribute trillions of dollars in productivity to the global economy. CCIA members are at the forefront of research and development in technological fields such as artificial intelligence and machine learning, semiconductor manufacturing, and other computer-related inventions. CCIA members are also active participants in the patent system, holding approximately 5% of all active U.S. patents and significant patent holdings in other jurisdictions such as the EU and China.

CCIA appreciates the opportunity to respond to the Office’s Request for Comments regarding the creation of a separate design patent practitioner bar. CCIA supports the proposed rulemaking which would create a separate design patent practitioner bar as it would enable more attorneys with relevant background to prosecute design patents, and help remedy the current gender gap among patent prosecutors.

While CCIA supports the expansion of the eligibility requirement to include degrees relevant to design patents, CCIA also believes that the USPTO should consider removing the degree requirement for patent prosecution altogether for licensed attorneys, allowing them to prosecute patents so long as they pass the patent bar exam.

¹ A list of CCIA members is available online at <https://www.ccianet.org/about/members>.

² 88 Fed. Reg. 31209 (May 16, 2023).

I. Allowing Design-Trained Individuals To Prosecute Design Patents Will Enhance Access To Design Prosecution

CCIA agrees with the USPTO's proposed rulemaking, which would create a new design patent practitioner bar, and believes doing so is a step in the right direction. In particular, it would help to align PTO requirements with the reality and practicalities of design patent prosecution. The proposed regulation would also eliminate unnecessary roadblocks for those with the requisite skills and capabilities who have been barred from practicing in the space due to the current requirements.

However, CCIA encourages the USPTO to take further action along the lines of the suggestions below.

A. *The USPTO should reconsider whether to maintain the degree requirement for both design and utility patents*

While expanding the eligibility requirement to include design related degrees on its surface likely will address some of the difficulties with the current system, CCIA believes it may be more worthwhile for the PTO to consider eliminating the degree requirement altogether and allowing any licensed attorney to sit for the patent bar. This is particularly true in light of the fact that under the proposed regime, utility practitioners would still be able to prosecute design patents. A degree in electrical engineering or biology without any experience in industrial design does not make the degree-holder any more qualified than someone with a history or English degree to prosecute design patents. If degrees matter, then utility practitioners should not be able to prosecute design patents, and practitioners with electrical degrees should not be permitted to prosecute pharmaceutical patents. If, as the Office's current approach suggests, degrees are relatively unimportant to capability to prosecute patents, then the degree requirement serves only to artificially restrict access to the patent bar and the USPTO should consider eliminating this requirement for licensed attorneys.³

Eliminating the degree requirement will more effectively reduce the barriers to entry as well as embrace the realities of patent prosecution. It is important to note that, much like utility prosecution, the act of design patent prosecution relies heavily on general lawyering skills rather than familiarity with the principles of design or technology.⁴ On the application and advising side, design prosecutors need to "understand design patent law rather than design *per se*."⁵ The various legal strategies that are important components of advising prospective patentees require skills learnable by all trained attorneys.⁶ Utility patents are no different; while "a deep knowledge of the scientific or technical subject matter **may, in some cases**, be necessary for effective prosecution,"⁷ in many cases that deep knowledge is unnecessary or may be provided by the client. Further, while clients may not be able to judge an attorney's understanding of

³ CCIA does not suggest eliminating the degree requirement for patent agents.

⁴ Sarah Burstein, *Burstein Patent Bar Comments in PTO-P-2022-0027* at 9 (Jan. 31, 2023); Christopher Buccafusco & Jeanne Curtis, *The Design Patent Bar: An Occupational Licensing Failure*, 37 *CARDOZO ARTS & ENT. L. J.* 263, 286 (2019).

⁵ Burstein at 9.

⁶ Buccafusco at 296.

⁷ Burstein at 9 (emphasis added).

patent prosecution law and practice, clients can judge for themselves the level of technical knowledge that a practitioner should have for their particular needs.⁸

B. Eliminating the degree requirement for licensed attorneys would significantly expand access to patent prosecution and is unlikely to have a strong negative effect on patent prosecutor quality

The effects of eliminating the degree requirement for licensed attorneys would be a significant expansion in the number of eligible patent prosecutors, which would increase competition and reduce the cost of obtaining patents. This “maximizes the size of the pool of design patent prosecutors without seriously risking design or utility patent quality”⁹ and would have similar effects on the utility patent prosecutor pool. Further, it would help remedy the gender disparity among patent prosecutors.¹⁰ The technical degree requirement for the patent practitioner bar “unnecessarily excludes women by failing to acknowledge the degrees in which women are statistically more likely to obtain.”¹¹ Because women are underrepresented in STEM education¹², they are consequently underrepresented among patent prosecutors, despite the fact that undergraduate education often bears little resemblance to the technology in which a utility patent prosecutor works.

II. Conclusion

The technical degree requirement does not provide any real benefit, and creates very real costs by reducing the pool of potential attorneys. It also operates to reinforce structural barriers that limit the accessibility of design patent prosecution to underrepresented groups. Thus, CCIA believes that eliminating the technical degree requirement entirely for licensed attorneys is the most efficient and effective route towards the PTO’s desired goals.

While the elimination of the degree requirement could perhaps more effectively serve the ends the PTO seeks, CCIA does believe that the expansion of the degree requirement to include design related degrees could still produce some of the positive consequences discussed above, and supports the PTO’s proposed rule. Further, CCIA suggests that if a technical degree is maintained, permitting utility practitioners to prosecute design patents makes little sense. To address this, the PTO should consider slightly increasing the amount of design patent material on the existing registration exam, exposing utility practitioners to more design patent material, or removing the ability of newly registered utility practitioners to prosecute design patents.

Overall, while CCIA believes the Office should consider further reducing barriers to entry into patent prosecution by removing the degree requirement for licensed attorneys, this proposed rulemaking represents important progress.

⁸ Will Hubbard, *Razing the Patent Bar*, 59 Ariz. L. Rev. 383, 407-408 (2017).

⁹ Buccafusco at 297

¹⁰ See Hannon, Mary T., *The Patent Bar Gender Gap: Expanding the Eligibility Requirements to Foster Inclusion and Innovation in the U.S. Patent System*, 10 IP Theory 1, 12 (2020).

¹¹ Hannon at 13.

¹² Hannon at 6.

Respectfully submitted,

Joshua Landau

Reg. No. 71,491

Senior Counsel, Innovation Policy

Dalia Wrocherinsky

Law Clerk

Computer & Communications Industry Association

25 Massachusetts Ave NW

Suite 300C

Washington, DC 20001

jlandau@ccianet.org