

## **Modernizing the General Requirements Bulletin**

To: U.S. Patent and Trademark Office  
From: [#]Signatories listed on Appendix A  
Date: May xx, 2021  
Re: Comments regarding the USPTO's Federal Register Notice: Administrative Updates to the General Requirements Bulletin for Admission to the Examination for Registration To Practice in Patent Cases Before the United States Patent and Trademark Office [Docket No. PTO-2021-0005]

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In an effort to align the General Requirements Bulletin with contemporary STEM degrees, the Office is currently proposing minor changes to the technical requirements of the General Requirements Bulletin and seeks public comment.

We are primarily private sector intellectual property researchers (henceforth searchers). We conduct patentability, infringement and validity searches professionally for a wide range of clients. Among the signatories there are ...

We note that the subject Notice includes the statement "...the Office welcomes comments from the public on any portion of the proposed updates to the General Requirements Bulletin (GRB) for registration to practice in patent matters." We understand this statement to mean that submitted comments may be directed to any portion of the GRB and are not necessarily limited to the three enumerated proposals.

We will demonstrate that 1) the GRB is overly restrictive independent of the technical requirement, 2) argue neglect to define valuable service underpins a 20 year history of failed efforts to improve the prior art search function and 3) posit that defining valuable service is necessary to modernizing the GRB.

### **1. Regulation 37 C.F.R. § 10.7(a)(2)(ii) is unnecessarily constrictive**

The Request for Comments is directed to the "necessary qualifications" requirement of the authorizing Statute. That is, who can sit for the exam that licenses one to prosecute applications based on a qualification provided by specific technical degrees. We put that aside and look at the rest of the Statute. We point out beforehand, that "valuable service" to the public is the objective of passing the exam.

Federal Statute 35 USC §2(d) is implemented by Regulation 37 C.F.R. § 10.7(a)(2)(ii). When compared side by side it is quickly apparent the Regulation narrows and limits the Statute to the detriment, we argue, of the public and the patent system.

The Statute reads (numbering added):

“...possessed of the necessary qualifications to render 1) applicants or 2) other persons 3) valuable service, 4) advice, and assistance in the 5) presentation or 6) prosecution of their applications or 7) other business before the office....”

And the regulation in part:

“(a) No individual will be registered to practice before the Office unless he or she shall:

(2) Establish to the satisfaction of the Director that he or she is:

(ii) Possessed of the legal, scientific, and technical qualification necessary to enable him or her to render 1) applicants for patents 3) valuable service.”

The Statute is broad, the Regulation is narrow. The regulation plainly restricts the recipients of valuable service to patent applicants. In other words, the 6) “prosecution of applications for applicants” is the only officially recognized form of valuable service that the public can receive. This logic is flawed.

Starting at the top, do “other persons” exist? Of course “other persons” exist. It is not uncommon for prospective patentees to solicit pre-examination searches from commercial searchers in order to gather and evaluate the identified evidence and make an informed decision about proceeding to an attorney or agent to write and prosecute an application. In this first example the prior art searcher has provided “advice” to an “other person.” It is more likely though that a patent attorney will commission a search. Regardless of who generated the search request, if an application ensues, the prior art found by the searcher accompanies the application and, therefore by deed, the searcher assisted in the presentation of an application. Another example of an “other person” that includes “other business” is the petitioner in an Inter-Parties Review (IPR). IPRs are based on prior art, §102 or §103 printed publication evidence, nothing else. Therefore, the searcher who found the prior art submitted to the PTO in an IPR has provided valuable service to persons who are not applicants and who also are engaged in “other business” before the Office. Interestingly, we note that a patent litigator without a technical degree cannot argue in an IPR proceeding despite the fact that he or she would be providing “valuable service” to an “other person” who “has business before the Office” for which the attorney is otherwise qualified.

In short, the Statute provides for 1) “other persons” distinct from “applicants,” 2) “advice, and assistance in the presentation of” distinct from “prosecution of” applications, 3) “other persons” distinct from “applicants” and 4) “other business” distinct from “prosecution of applications.”

It is our position that the act of providing prior art is a second form of valuable service to the public unrecognized within the contours of the GRB.

## 2. Valuable service is undefined

We argue that valuable service is any functional activity that makes a substantive contribution to the patent process.

Valuable service entered the conversation in 1897 when the registration roster was created.<sup>1</sup> The problem that registration addressed was unethical practitioners committing fraud by obtaining patents for patentees that “...while valid for all they claimed, were worthless...”<sup>2</sup> because they were improperly claimed.<sup>3</sup> The argument that the public was being cheated by these actors required action. The roster gave the patent office a tool to address fraud upon the public. There was no restriction on who could register. In 1897, prosecution and claiming were the immediate focus of valuable service. The technical requirement arrived in 1952 with the Patent Act of the same year as a means to continue tightening – the written exam was added in 1933 – the requisites necessary to draft an application and write patent claims.

In 1952 the notion that valuable service to the public could only be conveyed through drafting and prosecuting an application was reasonable despite the fact that the Statute anticipated much more. A narrow concept of valuable service was congruent with the intellectual property environment of that day much as it was in 1897.

Over the past 20 years there has been significant emphasis directed to prior art. Briefly, 1) the **2002** Strategic Plan envisioned Certified Search Authorities; 2) in **2007**, the PTO proffered Applicant Quality Submission (AQS) statements, essentially mandatory search reports in comments supporting the Patent Reform Act of 2007, 3) in **2009**, Senate Bill 610 included incentives for voluntary AQS statements; 4) in **2010**, a PPAC taskforce published a report of public comments<sup>4</sup> directed to Patent Quality that defined patent quality as claim validity and included an extensive discussion of search; exploring half a dozen proposals to improve the search product<sup>5</sup> including a) Third Party Search Assistance, b) Search Specialist Examiners and c) Incentivizing Applicant Searching among other things; 5) in **2011** Post Grant Review proceedings became law allowing the invalidation of patented claims based exclusively on prior art; 6) in **2015** the PTO held a Patent Quality Summit devoting the entire first afternoon to brainstorming and audience discussion directed to Automated Pre-Examination searching; and in **2016**, the GAO published a paper entitled Patent Office Should Strengthen Search Capabilities. Patent reform has been on the back burner since 2017. We expect an interest in §102 and §103 issues to reemerge during the current Congress.

Two decades have passed since Certified Search Authorities were proposed. Despite years of debate, no proposals to improve the process of identifying and acquiring prior art in patent applications have been implemented. We fail to see how policy changes to this function of the patent process will ever materialize in view of the fact that the function is neither explicitly or

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<sup>1</sup> Report of the commissioner of Patents for the year 1897, p. XV.

<sup>2</sup> Ibid

<sup>3</sup> Ibid.

<sup>4</sup> Patent Quality Taskforce: Preliminary report, Initial Public comments, March 2010.

<sup>5</sup> Ibid, pp. 21-29.

implicitly recognized as valuable to the process despite the direct impact to patent validity. Stated a different way: if the contributions of this function are to be realized the function must be recognized by the GRB. How can Applicant Quality Statements or Search Specialist Examiners be seriously debated, when neither the people or the function are officially recognized as part of the patent system? Policy improvements can only occur after this fundamental fact is acknowledged.

The meaning of valuable service has not changed since it was first conceived 124 years ago.

### **3. Reformulating the GRB**

As the PTO begins adjusting the technical requirements, to better reflect the realities of a contemporary STEM education, we strongly emphasize that the patent field is bigger than the patent bar and other parts of the GRB as discussed herein, need to be addressed. For a lot of people finding prior art is challenging, intellectually satisfying and a more interesting patent based function than writing applications. In view of the substantive contribution the “search specialist” makes to patent quality and patent validity, we believe the GRB should acknowledge the role.

A second roster for patent professionals who contribute to either the prosecution or patent enforcement process but do not prosecute applications is an idea warranting further investigation. A category of mid-level practitioner similar to a Physician’s Assistant in medicine is conceivable since application writing would not be permissible with only a second roster credential. Maybe an entirely different exam would be appropriate, perhaps one where STEM-adjacent college coursework would qualify since identifying prior art does not take the technical skills of a practicing engineer or bench scientist. On the other hand, we absolutely do contend that a substantially long search career can and does demonstrate technical qualifications sufficient to draft and prosecute patent applications. Perhaps a long search career can serve as an alternative route to qualify for the actual patent bar exam.

The GRB is grounded in the idea that the public must be protected from fraudulent actors. Is that still the problem today? Considering that patents are frequently cancelled through fraud by no one, either upon the public or upon the Office, strongly suggests otherwise. Using potential fraud as a reason to not expand either the GRB or “necessary qualifications” is out of date.

The intellectual property environment of 2021 looks nothing like the one of 1952. The PTO should take the current opportunity to explicitly define valuable service and thereby expand professional opportunities in the patent field and improve patent quality in the process.

## **Appendix A: Signatories**

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