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The Honorable Katherine K. Vidal
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
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Leason Ellis LLP Comments on Expanding Admission Criteria for Registration to Practice in Patent Cases Before the United States Patent and Trademark Office (Docket No. PTO-P-2022-0027-0001)

Introduction

Leason Ellis LLP is pleased to respond to the United States Patent and Trademark Office's (USPTO) request for comments on Expanding Admission Criteria for Registration to Practice in Patent Cases Before the United States Patent and Trademark Office that published in 87 Fed. Reg. 63044 on October 18, 2022 (Docket No. PTO-P-2022-0027-0001). Leason Ellis is an IP boutique law firm based in White Plains, New York. Founded in 2008, the firm is now home to more than thirty lawyers dedicated to the practice of intellectual property law. The firm handles matters related to all types of IP including trademark, utility patent, copyright, and a significant number of design patents filed in the U.S. and abroad. Our lawyers prosecute and litigate patents of all types. The USPTO has requested comments on four topics. Our comments are focused on Request 3: Possible Creation of a Separate Design Patent Practitioner Bar.

I. Request 3: Possible Creation of a Separate Design Patent Practitioner Bar

The USPTO is considering whether a separate Design Patent Practitioner Bar would be beneficial to the public and the Office. As a firm that handles all forms of IP, including utility patents, design patents, copyrights, and trademarks, we believe that a new Design Patent Practitioner Bar would benefit inventors, the public at large, and the IP community.

Leason Ellis suggests creating a new Design Patent Practitioner Bar for attorneys and patent agents who *only* seek to prosecute design patent applications, not utility patent applications. Importantly, attorneys and patent agents who are admitted to the traditional Patent Bar, and those who become admitted in the future, should be able to continue to handle

design patent applications without additional admission criteria and should not be impacted by the new limited Design Patent Practitioner Bar in any way.

The USPTO has asked about criteria for admission to a proposed new Design Patent Practitioner Bar. Leason Ellis believes that there should be two separate criteria for U.S. attorneys or Design Patent Agents to gain admission to the new Design Patent Practitioner Bar:

Criteria 1 – U.S. Attorneys:

1. Be an active member in good standing of the bar of the highest court of any state; and
2. Take the current registration exam

Criteria 2 – Design Patent Agents:

1. Hold a qualifying degree in industrial design, product design, architecture, applied arts, graphic design, fine/studio arts, art teacher education, or another relevant discipline; and
2. Take the current registration exam

Admission of U.S. Attorneys

For Criteria 1, we believe there is potential benefit to the IP community in allowing U.S. attorneys who are motivated to study for and pass the existing registration examination to be permitted to file and prosecute design patent applications. Design patents are unique in that the subject matter they are designed to protect, ornamental designs of products and packaging, inherently overlaps with other aspects of intellectual property, including utility patent, copyright, and trade dress law.

When an inventor seeks legal counsel for help protecting an ornamental design of a new product, counsel should be able to articulate an efficient and effective strategy for protecting the IP, which may touch on several different legally recognized IP rights. Under the current USPTO rules an inventor of a new automobile, mobile phone, or medical device can be well served by counsel who has expertise in both utility and design patents. However, we believe there is a blind spot for designs that are more closely associated with trade dress and copyright protection, such as jewelry, liquor bottles, and shoe designs. In the latter category, the product might not include any subject matter that is eligible for utility patent protection, but there could be significant added value for pursuing copyright and trade dress protection, in addition to a design patent. In such a case, the inventor would be best served by seeking counsel who is a registered *design* patent attorney with expertise in copyright, trade dress, and trademark law. Creating a new Design Patent Practitioner Bar with no underlying technical requirement to sit for the registration exam would encourage more attorneys to be fluent in design, copyright, and trade dress law, which would ultimately benefit the public at large. We believe the current

admission rules create a barrier for lawyers to practice at the intersection of design, copyright, and trade dress law.

An example of how design patents are related to copyrights and trade dress is the Crystal Head vodka brand, developed by actor Dan Aykroyd and Artist John Alexander– (https://www.crystalheadvodka.com/ourstory, visited Jan. 13, 2023). The product is sold in a unique glass skull bottle, which other manufactures have since tried to imitate.

(https://en.wikipedia.org/wiki/Crystal_Head_Vodka, visited Jan. 10, 2023).

Aykroyd and Alexander's company, Globefill Incorporated, recently filed an infringement lawsuit against TJ Maxx for selling similar bottles. Globefill Incorporated v. The TJX Companies, Inc. et al, 1:22-cv-01639-CFC (D. Del.). The complaint includes four causes of action: trade dress infringement, unfair competition, copyright infringement, and design patent infringement. If Globefill can succeed on all causes of action, each cause of action would provide different valuable remedies.

The Globefill case illustrates both the overlap between copyright, trade dress, and design patent rights and the need for practitioners who can be well-versed in all three. While Aykroyd is unquestionably a brilliant comedian and Alexander a skilled artist, it is highly unlikely that they specifically engaged legal counsel to file a design patent application or copyright application for the new bottle design. Instead, like many clients, they would have asked their counsel what can be done to protect the unique bottle configuration and to ward off infringers. Had the inventors engaged a counsel who was less familiar with design rights, they might have missed the window for filing a design patent application. Likewise, if they had approached a practitioner who was unfamiliar with trade dress and copyright protection mechanisms, they may have been deprived

of methods to protect the same basic design for far longer than the 15 years afforded by a design patent.

As a firm that handles protection and enforcement of all forms of IP, Leason Ellis sees significant value in allowing attorneys without technical and scientific degrees, including many trademark and copyright lawyers, to learn design patent law and have the opportunity to become admitted to a more limited Design Patent Practitioner Bar by taking the existing registration exam. As illustrated above, this would provide an opportunity to better serve a segment of inventors. We believe it would elevate the profession and provide added value to clients.

Design Patent Agents

In addition to allowing U.S. attorneys to be admitted to the new Design Patent Practitioner Bar, we believe there is also value in creating a new Design Patent Agent designation for non-lawyers who hold certain design related degrees and pass the registration exam. Our firm works with numerous graphic designers who assist our attorneys and patent agents in drafting design patent drawings. Not only are these professionals highly skilled in drafting, but they have also learned the nuances of design patent practice before the USPTO and are able to prepare drawings that are less likely to be rejected by an Examiner. Allowing an avenue for those highly skilled professionals to become Design Patent Agents could raise the quality of design patent applications submitted to the USPTO.

Non-lawyers with specified technical degrees have been qualified to sit for the registration exam and become patent agents when they pass the registration exam. We perceive no detriment to the profession in creating a parallel Design Patent Agent designation for qualified non-lawyers who satisfy requirements as outlined above and pass the same registration exam required of all persons who wish to be registered with the USPTO.

The Necessity of the Registration Exam

Our firm believes that any person who wishes to seek admission to a proposed Design Patent Practitioner Bar must take and pass a registration exam. The statutes, rules, and procedures for prosecuting a design patent application are, of course, different from the rules governing trademark and copyright applications. To avoid degradation of the quality of design patent applications, anyone seeking admission to the Design Patent Practitioner Bar, whether an attorney or prospective design patent agent, must pass either the existing registration exam or some variation thereof. For the sake of implementing a proposed rule change more quickly, we suggest initially requiring passage of the current registration exam, with a target of rolling out a modified exam for design patent practitioners and agents within a few years.

Requiring practitioners to pass the registration exam will also act as a barrier to entry for attorneys who are less committed to learning the nuances of design patent practice. We doubt that there are many attorneys who are willing to take another bar exam on a whim. It seems unlikely to us that any U.S. attorney who does not already have some expertise in design patent law, or is seriously motivated to learn it, would sit for the registration exam. This is particularly true given that the scope of admission provided by the proposed Design Patent Practitioner Bar would be so narrow. Likewise, the registration exam is important to ensure that prospective design patent agents are familiar with patent rules of procedure.

Overall, we see a potential for inventors to be better served by creating a Design Patent Practitioner Bar with different admission criteria for attorneys and Design Patent Agents. As long as the registration exam is required for admission, we see no meaningful downside for the profession, the public, or the Office.

Conclusion

Thank you for the opportunity to comment and for your consideration.