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October 24, 2011

Janet A. Gongola

Patent Reform Coordinator

Office of the Under Secretary of Commerce

for IP and Director USPTO

600 Dulany St., Madison West

Alexandria, Va. 22314

Dear Ms. Gongola:

Thank you for your help in directing me to John J. Calvert, who invited me to attend the meeting at the Dolly Madison Building on February 21, 2011, in which Director Kappos and Chief Judge Rader attended. As Director Kappos and Judge Rader pointed out, the patent costs for all inventors, not just *pro bono, pro hac vices* and *pro se* inventors, is an urgent consideration under the American Inventors' Act of 2011.(AIA). Senator Leahy likewise in his talk before the AIPLA on October 21, 2011 thanked the Congress, the PTO and Director Kappos for such efforts under the AIA.

I have made extensive efforts to decrease the costs for *pro bono, pro hac vices and pro se* inventors in *pro bono* programs for AARP, the U.S.D.O.E., and also in Maryland, DC and New York State, especially Suffolk County and the Village Court of the Village of Belle Terre, NY, for whom as *the pro bono* Director I filed a successful *pro bono* Amicus Brief in ***Parker v. Chakrabarty***, 477 U.S 303 (1980). *See* also Cases 08-5089, 10-5096,10-5223 and 11-5278, for which I am *the pro bono, pro hac vices* and *pro se* practitioner in the Court of Appeals for the District of Columbia.

One key element in my *pro bono* programs has emphasized the legacy *pro bono, pro hac vices* and *pro se* inventors and practitioners provide to the public

for their publications on demand in the public domain. To that end, the PTO cooperates as publisher on the broad band internet after the statutory requirements are met under 35 U.S.C.§101, §102, §103 and §112. I believe Congress has made that a primary goal of the AIA by reducing the limitations of the gate keeper function of the USPTO for trademark and copyright practitioners in view of the failure of the $1,000,0000 PTO program to limit the number of patent practitioners by gratuitous insinuations concerning the ethics of all lawyers. That effort was far more crafty and false than anything that could be justifiably charged against those who hold themselves out as practitioners, or are so held out to practice, by trying to impose restrictions on the number of Continuations that can be filed by *pro bono, pro hac vices, pro se* and all other inventors.

Efforts to protect the speech and press rights of *pro bono, pro hac vices* and *pro se* inventors must be strengthened by your *AIA Rules*. To that end, the new rules must allow the PTO to recognize the proper place of trademark practitioners and other intellectual property lawyers as agents without temporary or permanent registrations in the PTO to act *pro bono* for *pro se* inventors who need mentors, editors, assistants, co-inventors, assignors, assignees and close family members to help them say through their pencils what they dare not think.

Many *pro se* inventors hold themselves out to practice or are so held out before the PTO in *pro bono* trademark and patent cases as practitioners. It is necessary not to criminalize them, e.g., in Patent Office interviews as practitioners where they act as experts, authors, editors, managers, representatives, and for co-inventors as agents and attorneys in fact, at least in provisional patent applications and other filings or appearances in the PTO not directed to obtaining a patent monopoly as trolls or without being registered as such.

Inventors often aim ultimately to have the PTO publish their names as the author of a particular picture claim for the public benefit before or at the end of the patent term to emblazon their *names* on demand as authors of a creative work in a fully protected, pure, content based expression on the broad band internet after meeting the statutory requirements for such a work. Their primary concern is having their *name* and identity permanently identified as the author of a specific copyrightable and patentable text describing their innovation. The principle motivation is to be permanently identified as the author of a particular creative work. Nobel prize winners create works for the public domain without

necessarily being motivated by the financial reward. They want their name to be recognized for what they created.

Inventors and their trademark and copyright attorneys often use picture claims or disclaimers to renounce full-blown patent protection without losing their right of copyright as original authors. What they crave is publication of their creative and inventive work on the broad band internet on demand. Publication of only one copy satisfies their creative motivation. Nevertheless, they now face actual, unjust, irreparable harm by imminent prosecution for not being registered. That chills their First Amendment rights by imminent prosecution for committing jail-able offenses and actual harm in fact from fines of up to $10,000 under 35 U.S.C. §186 or §33. The latter states that:

Whoever, not being recognized to practice before the Patent and Trademark Office, holds himself out or permits himself to be held out as so recognized, or as being qualified to prepare or prosecute applications for patent, shall be fined not more than $1,000 for each offense.

That imposes a summary, retroactive *criminal* penalty for the *mere intention of an utterance or writing* of what is, or may be perceived as, a false statement of fact – without anything more. Actually, *pro se* practice is merely the publication of a fully protectable creative work. There is no clear and present danger of unlawful conduct. That statute opens up a whole new category of First Amendment exceptions by holding *pro se* and *pro bono* practitioners up to the false light of not being recognized to practice when as a practitioner they are not showing fraudulent, dangerous, or injurious conduct - merely an intent to utter pure speech.

The government should have the burden of proving harm or fraudulent, dangerous or injurious conduct, either as speech or otherwise. Precedent makes clear that even knowing factual error is insufficient "to remove the constitutional shield from criticism of official conduct." ***Sullivan,*** 376 U.S. at 273,

As pointed out by OED employees, which included William J. Griffin in the above mentioned meeting before Chief Judge Rader and Director KAPPOS, even inexperienced, part-time student apprentices are allowed to practice "*before* being recognized as representatives of applicants [emphasis added]," under 35 U.S.C. §2(a)(2)(D). To that end, they are allowed temporary registrations to practice. Also, *pro se* inventors are given Certificates of successful completion of

a computer review of the PTO requirements that apply to them under a program instituted and directed by John Calvert without being recognized under 35 U.S.C. §2(a)(2)(D). The intent is to encourage *pro bono, pro hac vices* and *pro se* inventors to file applications and prosecute them, not to discourage them by unnecessary requirements and regulations.

In view of the above, your new rules under the AIA must open the practice of *pro bono, pro hac vices* and *pro se* practice at least to trademark, copyright and other intellectual property lawyers as patent agents or practitioners who hold themselves out to practice in the Patent Office *before* they are registered under 35 U.S.C. 2(a)(2)(D). That frees *pro bono* inventors to seek the help of experienced mentors, and talent scouts without unjust or unfair, discrimination in a fit of ill humor that poisons "the air" by gratuitous restraints due to insinuations that they are falsely, deceptively or misleadingly advertising. ***In re R.M.J.*, 455 U.S. 191, 200 (1982).** That can still be taken care of on a case-by-case basis by OED, the FTC and the state disciplinary agencies, which in many cases actually allow lawyer advertising for practice in the PTO. *See* 37 C.F.R. §10.32.

Likewise, your new rules must allow *pro bono* co-inventors and assignees, as well as *pro hac vices* and *pro se* inventors to so hold themselves out or to be held out to practice without being charged with misleading the public if they so hold themselves out without being registered as such, even with temporary registrations. *See* ***Bates v. State of Ariz.*, 433 U.S. 350, 383 (1977),** which was cited in **715 F.Supp. 2d 56, 58-60 (D.D.C. 2010).** In that case, the General Counsel of the PTO for the Acting Director of the PTO on 3/31/2009 unreservedly approved of unregistered *pro se* practice, but only so long as the practitioner is a sole inventor. But the solicitor barred any and all unregistered practice by a *pro se* practitioner before the Patent Office by a summary, virtual, retroactive administrative disability inactivity without registration under 37 C.F.R. §10.7. That requirement is a new unconstitutional exception to the First Amendment.

That understanding is especially important not only in the field of *pro bono* patent practice, but also at the same time in the fields of copyright and trademark practice, where at least some publication on demand, dual coverage and unregistered practice have long been held to be well-established.

Please add my comments to those submitted by the public under the APA or otherwise for your new AIA Rules. Thank you.

To that end also, it is requested that your new rules approve the enclosed Power of Attorney and Correspondence Address Indication Form PTO SB/81 for *pro bono* practitioners, and add a suggested Confidentiality Agreement.

Respectfully submitted,

Cornell D. M. Judge Cornish

Date: Cornell D.M. Judge Cornish

encl: PTO-SB/81

cc: John J. Calvert (without encl.)

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☐ Assignee of record of the entire interest. See 37 CFR 3.71.
Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

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Signature		Date	
Name		Telephone	
Title and Company			

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 37 CFR 1.31, 1.32 and 1.33. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to proc take 3 minutes to complete, includ vidual case. Any comments on the a mation Officer, U.S. Patent and T COMPLETED FORMS TO THIS ADDRESS. SEND TO: **Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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