

living trust, gathers information from a consumer, forwards the information to a "factory," where the lawyer may assist in preparing and reviewing living trust documents, and the non-lawyer delivers the documents to the consumer, but the attorney has no personal contact with the consumer. An attorney was found to have aided the unauthorized practice of law to process workmen's compensation claims by permitting a disbarred attorney to obtain clients' signatures on retainer agreements, gather factual information from clients, and have the clients execute medical authorization forms, and it was inferred that the disbarred attorney was called upon to explain the retainer agreement and other legal documents. See *In re Discipio*, 645 N.E.2d 906 (Ill. 1994). See also *Wayne County Bar Ass'n. v. Naumoff*, 660 N.E.2d (Ohio 1996); *Comm. On Professional Ethics & Conduct v. Baker*, 492 N.W.2d 695 (Iowa 1992); and *In re Komar*, 532 N.E.2d 801 (Ill. 1988). The situations are analogous to invention promoters entering into agreements with inventors to engage a practitioner to prepare and prosecute a patent application for the inventor's invention, the promoter gathers information from the inventor for an application, then forwards the information and drawings to the practitioner to prepare an application, and thereafter secures the inventor's signature on the application. There is no direct communication between the practitioner and inventor.

Clearly, the Office does not desire to have practitioners aiding non-lawyers and non-practitioners in the unauthorized practice of law. Section 11.505 would proscribe a practitioner from aiding in the unauthorized practice of law. Accordingly, adoption of proposed rule § 11.104(a)(1) would require a practitioner, receiving clients from an invention promoter, to communicate directly with the client, and promptly report each Office action directly to the client.

Further, the Director found that the guidance in the second of the two Notices was not "intended to significantly extend the coverage of the first Notice to practitioners using invention developers as intermediaries, and concluded that the omission of invention developers from the Notices supports the inference that invention developers were not intended to be included as permissible intermediaries. *Moatz v. Colitz*, 2002 WL 32056607, (Com'r. Pat. & Trademarks Dec 03, 2002). With the adoption of the proposed rules, the Notices (Official Gazette, 1086 OG 457 (December 10, 1987), and 1091 OG 26 regarding the "Responsibilities of Practitioners

Representing Clients in Proceedings Before The Patent and Trademark Office") would be withdrawn and superseded by these comments.

*Practitioners Must Maintain a Direct Relationship With Their Clients.* Some practitioners relied upon promoters to obtain from the inventor all information used to prepare the patent application. In obtaining information for preparation of patent applications, the promoter may be a barrier to a direct relationship between the practitioner and the client-inventor. The barrier arises, for example, where the promoter instructs the inventor to communicate with the promoter and suggests that the inventor may incur additional charges if the inventor communicates directly with the practitioner. The barrier also might arise where the promoter provides the practitioner with a description of the invention that differs from or alters the inventor's description of the invention. For example, the information and drawings furnished by some promoters to the practitioner change an invention to have one or more surface indicia or elements not described by the inventor. Some unsophisticated inventors first learn of the changes when they receive their applications for review and signature. The inventors, being cautioned by a promoter that the inventors may incur additional costs by communicating with the practitioner, direct their questions to the promoter about the changes. The promoters advise the inventors that the changes were provided to improve the invention's potential to succeed in the market, and that the inventors should sign the declaration.

A promoter also can interfere with communications when the practitioner relies on the promoter to convey communications, including the collection of Office fees. For example, some promoters have delayed or failed to forward to the inventor-clients copies of Office actions the promoter receives from the practitioner, or requests for funds. As a result of the delay or lack of communication with the inventor-client, if the Office action is reported to the inventor-client, it may not be reported until after the period of response has expired. The patent application may become abandoned in these circumstances. Alternatively, a promoter may interfere with communications by instructing the inventor-clients to make their checks for filing or issue fees payable to the USPTO Director, deposit the checks in the promoter's own account, and issue their own checks that are sometimes returned to the Office unpaid. In these situations, the patent application

becomes abandoned. It is problematic whether the funds delivered to the promoter may be recoverable.

A practitioner receiving referrals from a promoter may be motivated to provide the shortest and least expensive reply to an Office action. Such practitioners can receive a relatively small, set fee from the promoter for a reply to the Office action, regardless of the length or complexity needed to respond. Minimizing communication with the inventor-client reduces overhead costs, and maximizes time available to produce responses for multiples of such clients. It also can avoid providing the inventor-client with an opportunity to suggest presentation of affidavit, e.g., an antedating affidavit under 37 CFR 1.131, or comparative test results under 37 CFR 1.132. Accordingly, the practitioner may not report an Office action to the inventor-client until after a response has been prepared and filed. This deprives the unsophisticated inventor-client of the opportunity to contribute to the response.

*Paragraph (1) of § 11.104(a)* would require practitioners receiving clients from an invention promoter to communicate directly with the client, and promptly report Office actions and replies directly to the client.

*Paragraph (2) of § 11.104(a)* would provide that a practitioner accepting referrals from a foreign attorney or foreign agent located in a foreign country may, with the written consent of a client located in a foreign country, conduct said communications with the client through said foreign attorney or agent. It is common for instructions relating to the application of a foreign patent and trademark owner, who is the practitioner's client, to be given to the practitioner through a foreign attorney or foreign patent agent. The fact that a practitioner receives instructions from an invention or trademark owner through a foreign attorney or agent does not change the fact that the client is still the foreign invention or trademark owner. See *Strojirensti v. Toyota*, 2 USPQ2d 1222 (Comm'r Pat. 1986), which at 1223 cited *Toulmin v. Becker*, 105 USPQ 511 (Ohio Ct. App. 1954) for the principle that "foreign patent agents or attorneys were not clients of U.S. patent attorney."

A practitioner would be permitted to communicate through, rely on instructions of, and accept payment from the foreign attorney or agent only if the practitioner has obtained the consent of the client after full disclosure in accordance with the provisions of §§ 11.106(a)(1) and (d), 11.107(a) and (b), and 11.108(f). An agreement between the client and the foreign