30 Bank Street
New Britain, CT 06051
P (860) 223-4400
F (860) 223-4488

Standing Committee on Professional Ethics

March 17, 2021

Informal Opinion 2021-02
Use of a Vendor in Connection with Filing a Patent Application

A Connecticut patent lawyer asks two questions: (1) whether it is permissible to use a service in which the vendor, using its knowledge and experience, provides guidance on writing a patent application so the application may be "classified" more favorably by the United States Patent and Trademark Office ("USPTO") when the vendor separately provides the USPTO with government contractor services by classifying incoming patent applications; and (2) if it is permissible, whether a lawyer is obliged to use such services for the benefit of a client.

When a patent application is filed at the USPTO, the application is assigned to a patent examiner in an Art Unit[1] that has skill relevant to the invention technology. Based on law and an assessment of what is new and nonobvious, a patent examiner determines whether the application should be allowed, i.e., whether a patent will be granted. While the USPTO's proceedings are a mixture of public and non-public information, with few exceptions, when a patent is granted all information about the patenting process becomes electronically accessible public information. Datamining of such public information can ascertain the statistical likelihood for a favorable outcome—i.e., the allowance of a patent as a function of the examiner's Art Unit. The USPTO has a classification system that is a highly detailed organization of technology (or "art", e.g., chemistry, physics, human necessities, etc.), comprised of more than 150,000 possible codes. Art Units are aligned with this classification system and the USPTO uses a vendor to classify new patent applications.

Here, a vendor that provides classification services to the USPTO also supplies its classification expertise as a commercial service to patent lawyers. The vendor analyzes a prospective application and offers its opinion on how the application will be classified as drafted. In addition, the service makes suggestions about changing the wording and emphasis, so that when it is filed, the application will likely be classified in the Art Unit where the chance for obtaining a patent should be greater, as indicated by public data.

As an initial matter, patent lawyers in the State of Connecticut are not only subject to the Connecticut Rules of Professional Conduct (the "CT Rules"), they are also subject to the United States Patent and Trademark Office's Rules of Professional Conduct (the "USPTO Rules"). *See* CT Rule 8.5(a) (stating "[a] lawyer may be subject to the disciplinary authority of both this jurisdiction and another jurisdiction for the same conduct"). Although the USPTO Rules are similar in many respects, this opinion only addresses whether the conduct in question is permissible under the CT Rules. Consistent with *Sperry v. Florida ex rel. Florida Bar*, 373 U.S. 379, 383 (1963) (agreeing with the determination that the preparation and prosecution of patent applications constitutes the practice of law under Florida law), this Committee has previously concluded that an attorney practicing in Connecticut who seeks to secure letters patent from the USPTO is practicing law in Connecticut. Informal Opinion 12-02. Further, the USPTO Rules recognize the co-extensiveness of state

[1] Patent examiners are organized into "Art Units," focused on different areas of technology (e.g., electronic systems, cooling systems with compressors, etc.).

Connecticut Bar Association

30 Bank Street
New Britain, CT 06051
P (860) 223-4400
F (860) 223-4488

professionalism standards with its regulations. *See* 37 C.F.R. § 10.1.[2] Under the doctrine of federal preemption, a state cannot set the rules by which a lawyer may practice before the USPTO, however "the State maintains control over the practice of law within its borders except to the limited extent necessary for the accomplishment of the federal objectives." *Sperry*, 373 U.S. at 402. "That the PTO and the states may share jurisdiction over certain disciplinary matters, however, does not mean that the states' authority is preempted." *Kroll v. Finnerty*, 242 F.3d 1359, 1365 (Fed. Cir. 2001).

The consideration of this service requires us to consider Rule 8.4. Here, the vendor supplying its expertise for the service provided to a lawyer is also classifying applications into Art Units for review by patent examiners, however we are told that the vendor screens the employees providing the service from the employees tasked with classifying applications for the USPTO. It is also critical to note that while the vendor in its work for the USPTO is responsible for which Art Unit initially reviews a particular application, the substantive review of an application's merits rests with a USPTO patent examiner. Further, supervisors of patent examiners are able to negotiate among themselves a change of classification, and thus a change of Art Unit, when they deem it is appropriate. Thus, the value of the service in question is not that it is able to ensure an application will be passed on to a particular Art Unit, but rather it is providing expert opinion on: (1) what Art Unit the application will likely be assigned to in its current form; and (2) changes to the application that, if made, will increase the likelihood the application is assigned to an Art Unit that public data shows has a more favorable allowance rate and possibly a faster response time.[3]

The service described and represented appears to provide an objective assessment of how the application would be classified as written and how it might be classified differently if altered. It appears that the vendor is providing advice to a patent lawyer using its expertise with respect to how applications are classified at the USPTO, while at the same time it is providing classification services to the USPTO. As presented, there is no indication of a connection between the advice (which the lawyer may or may not follow) and how the patent application might be handled by the vendor if and when it is filed.[4] Thus, as presented, the lawyer's use of the service described above would not appear to violate any provision of Rule 8.4.

The question posed by the lawyer also requires consideration of Rule 5.3(3)(A) which provides that a lawyer who employs, retains, or associates with a non-lawyer is responsible for the conduct of the non-lawyer that would be a violation of the Rules of Professional Conduct if engaged in by a lawyer—provided that the lawyer "orders or, with the knowledge of the specific conduct, ratifies the conduct involved." We are told that the vendor represents its service does not violate any agreement with the USPTO and that the USPTO is aware of the service. Taking this representation at face value and considering the public promotion of the service by the vendor, it appears reasonable to conclude that the USPTO is aware of the service. The commentary to Rule 5.3 states that "a lawyer must make reasonable efforts to ensure that the services are provided in a manner that is compatible with the lawyer's professional obligations." The open and notorious nature of the service appears

[2] "This part governs solely the practice of patent, trademark, and other law before the Patent and Trademark Office. Nothing in this part shall be construed to preempt the authority of each State to regulate the practice of law, except to the extent necessary for the Patent and Trademark Office to accomplish its federal objectives."

[3] For example, an application may be presented as "data center (collection of detailed electronic devices) having a cooling system" which might be classified as "electronic system." It might be recrafted as "cooling system" with little emphasis on what are the electronic components, whereupon it would be classified as "cooling system with compressor/controls."

[4] For reference, about 600–700,000 patent applications are filed with the USPTO each year.

Connecticut Bar Association

30 Bank Street
New Britain, CT 06051
P (860) 223-4400
F (860) 223-4488

to be sufficient to allow the lawyer to conclude that use of the services would not be a violation of Rule 5.3(3)(A).

Accordingly, it is the Committee's opinion that, consistent with Rules 5.3(3) and 8.4(3), the lawyer may use the service described above, provided the lawyer is not aware that the service constitutes a breach of the vendor's obligations to the USPTO.

Based upon the Committee's opinion as to the first question, the lawyer also asks for the Committee's opinion as to whether the lawyer is obligated to use such a service to satisfy Rules 1.1 and 1.3. Rule 1.1 states in relevant part that a "lawyer shall provide competent representation to a client." The commentary to Rule 1.1 provides that a relevant factor in determining whether a lawyer has employed the requisite knowledge and skill is the relative complexity and specialized nature of the matter. Here, arguably the practice of law regarding intellectual property, specifically patents, is inherently specialized based upon the additional academic credentials and examination required. Indeed, Rule 7.2(d) addresses instances in which a lawyer holds him/herself out as a specialist, and the commentary to this rule specifically notes that the "Patent and Trademark Office has a long established policy of designating lawyers practicing before the Office." Accordingly, the obligation of competent representation in the context of a patent application is subject to a different, if not higher, standard under the USPTO Rules. *See* USPTO Rule 11.101 ("A practitioner shall provide competent representation to a client. Competent representation requires the legal, scientific, and technical knowledge, skill, thoroughness and preparation reasonably necessary for the representation.").

Here, the value of the service is that it relies upon the experience obtained from classifying millions of patent applications to predict the likely Art Unit that a prospective application will be classified into. Although the criteria for classifying a patent application are publicly available,[5] a patent lawyer may not be able to appreciate how the USPTO is likely to classify a particular application given the detailed and complex taxonomy of the USPTO's system. Further, the client's objectives factor into whether the service's recommendations would be of value. For example, a client that seeks to obtain any patent might find this service appealing. In contrast a client seeking a patent that provides protection for specific technical aspects may believe that re-crafting the application solely for possible better classification requires unacceptable tradeoffs.

Further, it is worth noting that even if the lawyer implements the vendor's suggested changes and is successful in having the application classified to a more desirable Art Unit, that classification is not final. Indeed, where a supervisory patent examiner "believes an application, either new or amended, does not belong in their art unit, they may request transfer of the application from their art unit (the 'originating' art unit) to another art unit."[6] There can be substantial variation within an Art Unit amongst the examiners with respect to the likelihood of a favorable outcome.[7] So, the value of the vendor's service is that it might provide the client's application with some statistically better chance of having a patent issued. Whether an application altered for classification purposes would result in a diminished degree of desired patent protection is a determination for the patent lawyer to make, consulting with the client as appropriate.

---

[5] *See generally* United States Patent and Trademark Office, MANUAL OF PATENT EXAMINING PROCEDURE, Chapter 900, https://www.uspto.gov/web/offices/pac/mpep/mpep-0900.html (last visited December 24, 2020).
[6] *Id.* at Section 903.08(d)(II).
[7] Data about chance for allowance as a function of named examiner is publicly available, www.patentbots.com/stats.

Connecticut Bar Association

30 Bank Street
New Britain, CT 06051
P (860) 223-4400
F (860) 223-4488

Rule 1.3, states a "lawyer shall act with reasonable diligence and promptness in representing a client." The commentary to Rule 1.3 provides in relevant part, that a "lawyer must also act with commitment and dedication to the interests of the client and with zeal in advocacy upon the client's behalf. A lawyer is not bound, however, to press for every advantage that might be realized for a client." Therefore, in accordance with the lawyer's communication obligations under Rule 1.4(a)(2) and 1.4(b), if the lawyer believes the client's chances of receiving a patent with the desired degree of protection would be materially improved by using the service, the lawyer is encouraged to inform the client of the option and abide by the client's decision.

THE COMMITTEE ON PROFESSIONAL ETHICS

Kim E. Rinehart

_____

BY Kim Rinehart, Chair