

UNITED STATES
PATENT AND TRADEMARK OFFICE



Patent Trial and Appeal Board Boardside Chat:

Fireside Chat with Deputy Director Derrick Brent and Requests for Comments about Patent Bar and PTAB Practitioners

Deputy Director Derrick Brent

Supervisory Patent Attorney Krista Flanagan

Acting Vice Chief Administrative Patent Judge Scott Moore

OED Staff Attorney Jennifer Harchick

Administrative Patent Judge Russell Cass

December 15, 2022



UNITED STATES
PATENT AND TRADEMARK OFFICE ®

Agenda

- Fireside chat with Deputy Director Derrick Brent
- USPTO Registration Exam requirements and Request for Comments
- PTAB practitioner Request for Comments



Question/comment submission

- To send in questions or comments during the webinar, please email:
 - PTABBoardsideChat@uspto.gov



Interview by Supervisory Patent Attorney Krista Flanagan

Fireside Chat with Deputy Director Derrick Brent

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¿Con interés en el PTAB?



- Our “New to PTAB” webpages are now available in other languages
 - Spanish
 - German
 - More languages coming soon (French, Korean, Japanese, Mandarin, and Hindi)
- **Online visitors can learn about PTAB**
 - Ex parte appeals and AIA proceedings
 - PTAB hearings
 - Other basic information about the Board

<https://www.uspto.gov/patents/patent-trial-and-appeal-board/about-ptab/new-ptab>



Staff Attorney Jennifer Harchick

Office of Enrollment and Discipline (OED)

Registration Exam Requirements and Request for Comments

Registration exam requirements

History of the Patent Bar

- Patent Act of 1790
- Patent Act of 1793
- Patent Act of 1836
- Patent Act of 1897
- First written examination by Board of Enrollment
Patent Act of 1922
- Additional updates in 1934, 1949, 1974, 1985,
1998, 2004 and 2020



First phase of the patent system: Patent Act of 1790

- Patents granted by cabinet-level review
- Only anecdotal records of patent practitioners
- Arguments presented by written petition

Second phase: Patent Act of 1793

- Patents by registration (not examination)
 - prepare an application,
 - swear an oath that invention believed to be new and useful, and
 - present materials with a thirty-dollar fee
- Patent practitioners were rare under this system
- Validity determined by infringement proceeding

Third phase: Act of 1836

- Examination via correspondence by professional examiners
- Emergence of the patent bar:
 - Both attorneys and non-attorneys called “patent attorneys”
 - Included corporate entities and firms
- First authority to refuse recognition:
 - Act of 1861, Rules and Directions of 1869.
- Earliest surviving listing of patent practitioners published 1883
- 1897 – Earliest surviving rules regarding registration as a patent practitioner
 - Attorney, or
 - Certificate by a judge
 - Scientific and technical qualifications generally by affidavits
- Act of 1922 – express statutory authority to regulate recognition
 - Competence issues were a concern

Fourth phase: registration exam

- 1934 – first written registration exam by Board of Enrollment
 - Patent Office Practice and Procedure
 - Preparation of a specification
- 1949 – major refresh of the roster by Committee on Enrollment and Disbarment
- 1974 – first roster distinction between agent and attorney, and only permitting individuals to be recognized
- 1985 – disciplinary investigations transferred from Solicitor to newly formed Office of Enrollment and Discipline (OED)
- 1998 – beginning of modern multiple choice format
- 2004 – first computerized exam
- 2020 – USPTO no longer offers direct administration of exam

Legal authority

35 U.S.C. § 2(b)(2)(D) - enables the USPTO to establish regulations that require that applicants possess:

- good moral character and reputation; and
- the necessary qualifications to render valuable service, advice, and assistance in the presentation or prosecution of applications or other business before the USPTO

37 C.F.R. § 11.7(2)(ii) - requires that applicants possess:

- scientific and technical qualifications, i.e., appropriate *education/degree and/or experience*, and
- legal qualifications, i.e., passing the *registration examination*



Congressional inquiry and updates

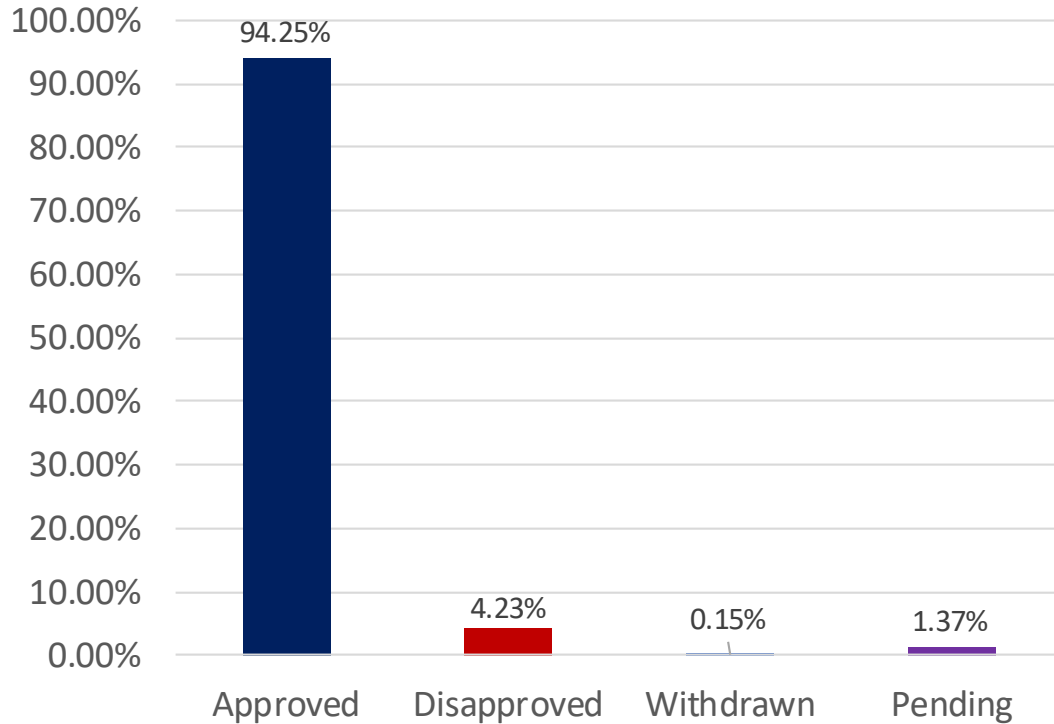
- **December 11, 2020** – inquiry from U.S. Senators Tillis, Hirono, and Coons
- **January 19, 2021** – USPTO response
- **September 15, 2021** – supplemental response
- **September 22, 2021** – updates to scientific and technical qualifications

Response to Congressional inquiry

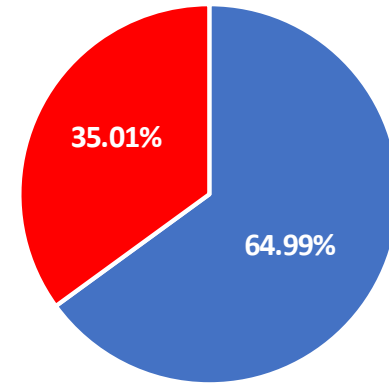
- USPTO is not authorized to collect gender data from applicants for registration exam
- Since FY2015, applications for exam include "Mr./Ms." salutation field
 - 65% "Mr." and 35% "Ms."
- Identified possible updates to scientific and technical qualifications
- Outreach – to address pipeline issue:
 - Law School Clinic Certification Program – expansion through January 5, 2024
 - Council for Inclusive Innovation (CI²)



Applicant statistical data



Salutation



■ Mr. ■ Ms.



Expanding Admission Criteria for Registration To Practice in Patent
Cases Before the United States Patent and Trademark Office

Request for Comments

Request for Comments (2021)

- Requested input on 3 updates to the scientific and technical criteria
- In September 2021, OED implemented the following updates:
 - (1) Added more degrees to Category A
 - (2) Now accepts advanced degrees under Category A
 - (3) Now accepts broad combination of core sciences under Category B (with lab)

Request for Comments (2022)

- On October 18, 2022, OED published a request for comments regarding the following (87 Fed. Reg. 63044):
 - (1) Periodically review applicant degrees and add commonly accepted Category B degrees to Category A
 - Every 3 years
 - (2) Modify accreditation requirement for computer science degrees under Category A
 - Accept Bachelor of Science Computer Science Degrees under Category A

Request for Comments (2022) (cont'd)

- (3) Possible creation of a separate design patent practitioner bar
- Take current registration exam with modified scientific and technical requirements
 - Be a U.S. attorney
 - Take separate design bar examination

(4) Clarify instructions in General Requirements Bulletin for Admission to the Examination for Registration to Practice in Patent Cases before the United States Patent and Trademark Office (GRB) for limited recognition applicants

(5) General request for additional suggestions on updating the scientific and technical requirements

Request for Comments (2022) (cont'd)

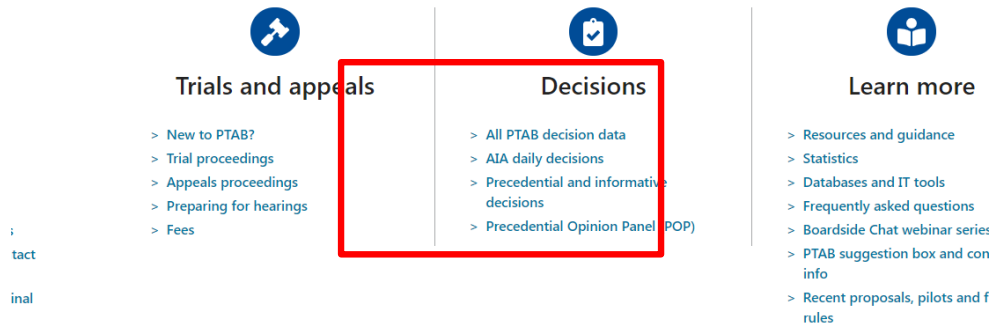
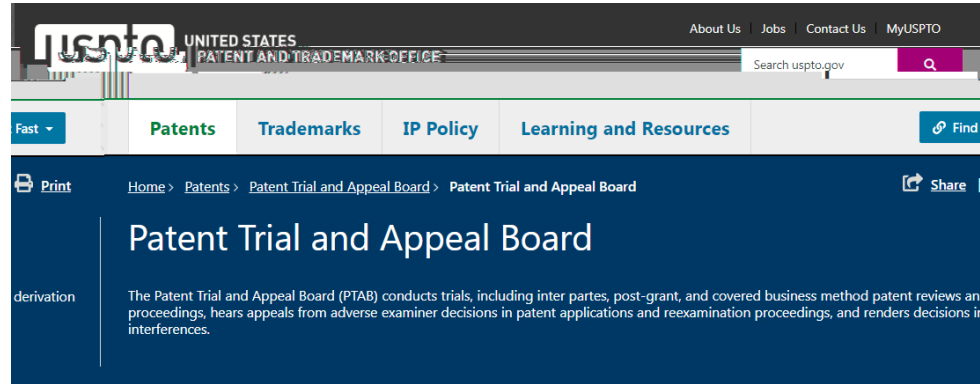
- Link to Federal Register Notice:
<https://www.govinfo.gov/content/pkg/FR-2022-10-18/pdf/2022-22569.pdf>
- To comment, go to <http://www.regulations.gov/> and search for docket number PTO-P-2022-0027, then click on the “Comment” button
- Comment period closes January 17, 2023



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Where to find PTAB decisions: uspto.gov/patents/ptab



Acting Vice Chief Administrative Patent Judge Scott Moore

**Request for Comments: Expanding
Opportunities To Appear Before
the Patent Trial and Appeal Board**

Summary of RFC

- The USPTO seeks feedback and information on revising the criteria to practice before the PTAB in **AIA proceedings**
- The USPTO is also exploring changes or improvements to training and development programs, such as the PTAB's Legal Experience and Advancement Program (LEAP), to increase opportunities for practitioners who wish to appear before the PTAB

**Existing admission requirements
for PTAB AIA proceedings; LEAP**

Existing requirements to practice before the PTAB

- Represented parties must appoint lead and backup counsel
- Lead counsel must be a registered practitioner (i.e., a member of the Patent Bar)
- Backup counsel may be a non-registered practitioner, but only if admitted *pro hac vice (PHV)*

See 37 C.F.R. § 42.10



Existing requirements to practice before the PTAB: PHV admission

- Motion that demonstrates good cause for PHV admission of non-registered practitioner
- Affidavit or declaration attesting to eight separate qualifications, including state bar membership, lack of disciplinary history, agreement to comply with PTAB practice rules and Office professional conduct rules, and familiarity with relevant subject matter

See Unified Patents, Inc. v. Parallel Iron, LLC, IPR2013-00639, Paper 7 (PTAB Oct. 15, 2013)

Existing LEAP

- Developed to help less experienced advocates gain practical experience in proceedings before the PTAB
- Open to registered and non-registered practitioners who have had three or fewer substantive oral arguments in any federal tribunal, including the PTAB
- Parties are offered up to 15-minutes of additional oral argument time, if they allow a LEAP practitioner to participate substantively in oral arguments
- Includes additional training and development opportunities, such as oral argument training and a mock trial program



Expanding Opportunities To Appear Before the Patent Trial and
Appeal Board

Request for Comments

Request 1: admitting non-registered practitioners to practice before PTAB

- Should the USPTO allow non-registered practitioners an additional option to be admitted to practice before the PTAB, much like certain district courts allow both *pro hac vice* admissions and general admissions?
 - If so, should there be additional standards for admission above and beyond PHV requirements?
 - If so, should additional training and/or experience be required?

Request 2: allowing non-registered practitioners to appear as lead counsel

- Should the USPTO allow non-registered practitioners who are admitted under the “Request 1” proposal, or admitted PHV, to act as lead counsel?
 - If so, should additional training and/or experience be required?

Request 3: other considerations regarding non-registered practitioners

- Should any rule permitting a non-registered practitioner to be admitted to practice before the PTAB, or to appear as lead counsel in an AIA proceeding, also require that a registered practitioner appear as back-up counsel?
- Should any rule permitting a party to be represented solely by a non-registered practitioner require the party to later retain a registered practitioner as back-up counsel if certain circumstances or events occur?
- Should any of the contemplated changes discussed above, if adopted, be implemented initially as a pilot program?

Request 4: training and development programs; changes to LEAP

- Are there additional training and/or development options that the USPTO should offer to increase opportunities for less-experienced practitioners to appear as counsel in AIA proceedings and/or serve as lead counsel in AIA proceedings?
- Should the USPTO make changes to LEAP to increase opportunities for candidates to appear before the PTAB in AIA proceedings and/or serve as lead counsel in AIA proceedings?



Specific questions in RFC

1. Are there any changes to PTAB rules or procedures that the Office or the PTAB should make to increase opportunities to appear and/or serve as counsel and/or the lead counsel in AIA proceedings, such as any discussed in Requests 1-3 above?

1.1. If you answered “yes” to question 1 as to the lead counsel, should the rules require that a non-registered practitioner have prior experience in AIA proceedings and/or have completed training before being designated as the lead counsel? What level of experience and/or type of training should be required? 2. Should any rule or procedure revised by the Office that permits a non-registered practitioner to be designated as the lead counsel in an AIA proceeding also require that any such non-registered practitioner be accompanied by a registered practitioner as back-up counsel? If not, are there any circumstances or events that might occur during the course of an AIA proceeding (*e.g.*, the contemplated or actual filing of a motion to amend) that might warrant requiring a registered practitioner to then appear as back-up counsel?

3. Would a rule requiring that the lead counsel or back-up counsel in an AIA proceeding be a registered practitioner have a significant impact on the costs of such a proceeding? If so, what would the impact be, and would the impact be justified?

4. Should any of the changes discussed above, if adopted, be implemented as a pilot program?

5. Are there additional training and/or development programs the Office should offer to increase opportunities for less-experienced practitioners to appear as counsel and/or serve as the lead counsel in AIA proceedings?

6. Are there any changes to LEAP that the Office should make to increase opportunities to appear and/or serve as the lead counsel in AIA proceedings?

**Additional information and
instructions**

Additional information and instructions

- Link to Federal Register Notice:
<https://www.federalregister.gov/documents/2022/10/18/2022-22572/expanding-opportunities-to-appear-before-the-patent-trial-and-appeal-board>
- To comment, go to <http://www.regulations.gov/> and search for docket number PTO-P-2022-0032, then click on the “Comment” button
- Comment period closes January 17, 2023



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USPTO Director review



- The USPTO has published information on the Director Review process to increase openness as it formalizes the process
- Details on the interim process and suggestions for parties who wish to request Director review

<https://www.uspto.gov/patents/patent-trial-and-appeal-board/interim-process-director-review>

- Status of Director review requests
 - Information about the proceedings in which Director review has been granted
 - Monthly updated spreadsheet with the status of all Director review requests

<https://www.uspto.gov/patents/patent-trial-and-appeal-board/status-director-review-requests>



QUESTIONS?



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Next Boardside Chat



- Thursday, December 22, 2022, at 12-1 pm ET
- Topic: APJ job opening and how to apply
- Register for and learn about upcoming Boardside Chats, and access past Boardside Chats at:
<https://www.uspto.gov/patents/ptab/ptab-boardside-chats>



