



American Intellectual Property Law Association

May 21, 2024

Michael Tierney
Vice Chief Administrative Patent Judge
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
Submitted electronically via: Federal eRulemaking Portal (www.regulations.gov)

Re: Docket No. PTO-P-2023-0058 Notice of Proposed Rulemaking on Expanding Opportunities to Appear Before the Patent Trial and Appeal Board

Dear Judge Tierney:

The American Intellectual Property Law Association (“AIPLA”) is pleased to have the opportunity to present its views to the United States Patent and Trademark Office (“Office”) in response to the Notice of Proposed Rulemaking on “Expanding Opportunities to Appear Before the Patent Trial and Appeal Board,” 89 Fed. Reg. 13017 (February 21, 2024).

Founded in 1897, the American Intellectual Property Law Association is a national bar association of approximately 7,000 members who are primarily lawyers and patent agents engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public’s interest in healthy competition, reasonable costs, and basic fairness.

AIPLA appreciates the Office’s efforts to expand access to practice before the Patent Trial and Appeal Board (“PTAB”) while continuing to protect the public from unqualified practitioners. AIPLA further appreciates the Office’s efforts to support individuals, smaller entities, and others who may be under-resourced in its rulemaking.

AIPLA previously provided its response to the Office’s Request for Comments on Expanding Opportunities to Appear Before the Patent Trial and Appeal Board (Vol. 87, No. 200 Federal Register, Tuesday, Oct. 18, 2022) Docket No. PTO-P.2022-0032. The Office’s rulemaking appears to be largely consistent with AIPLA’s response.

Even so, AIPLA takes this opportunity to comment on the specific proposal in this Notice in order to ensure consistency of the rules, and to open the door for further considerations in either this or future related rulemaking.

Goals for Expansion of Practice

AIPLA appreciates the merits of expanding access to the USPTO in all forms, including in terms of opportunities for counsel who may advise clients on PTAB Trial proceedings. Such expansion of access carries benefits of costs and other efficiencies to parties, and can further contribute to diversity goals in the profession. So long as questions of accountability and protection of the public from unqualified counsel are kept in mind, this effort is laudable.

However, it is unclear that this rules package serves to expand opportunities to appear before the PTAB in any meaningful way. The administrative efficiencies, while welcome, largely simplify the process for counsel who are already before the PTAB rather than expanding the pool. The provisions for under-resourced parties actually eliminate a co-counsel position. And allowing *pro hac vice* counsel to serve as lead counsel instead of backup counsel is largely cosmetic, since registered practitioner co-counsel is still required.

So while AIPLA favors advancing the rules package consistent with these remarks, it does not appear that the rules actually further the expansion of opportunities to appear before the PTAB.

Expansion of Practice: Administrative Efficiencies

AIPLA recognizes and appreciates the administrative efficiencies created in streamlining the process for *pro hac vice* admission of persons other than registered practitioners as PTAB-recognized counsel.

It does not appear possible for a party to use this process to back door a situation where no registered practitioner co-counsel is of record. This appears so even if registered practitioner co-counsel becomes disabled or otherwise unavailable. However, it may be helpful for the rules to better clarify the situation where the registered practitioner co-counsel becomes unavailable, leaving only the *pro hac vice* counsel active during the trial.

Requirement for Registered Practitioner Co-Counsel

AIPLA continues to believe that requiring a registered practitioner as co-counsel (either lead or backup) is essential to the Office's goal of protecting the public from unqualified practitioners. The Office may accomplish this goal by retaining disciplinary jurisdiction over not only the PTAB trials themselves, but also conduct before the USPTO more broadly as it relates to those PTAB trials. The proposed rules appear to accommodate this need.

However, AIPLA acknowledges that significant portions of a PTAB trial can proceed on the basis of knowledge held by experienced litigating attorneys who are not registered practitioners. If the PTAB reaches a point of bifurcating issues that are the purview of registered practitioners, such as (at least in part) by the elimination or creation of a separate process for amendments in conjunction with PTAB trials, then it may suffice for a registered practitioner to enter an appearance on only one side of the bifurcation. But such bifurcation of a trial, to the degree required to eliminate the need for a registered practitioner co-counsel, would likely add significant complexity to the proceedings, as well as costs and other inefficiencies for a registered practitioner to catch up with the proceedings when needed if not already engaged, and would not necessarily be advisable.

Both the current and proposed revisions to the rules require that a motion to appear *pro hac vice* by counsel who is not a registered practitioner may be granted upon showing that counsel has an established “familiarity with the subject matter at issue in the proceeding.” This requirement seems fluid, as if a registered practitioner is co-counseling and has familiarity with the *technical* subject matter, perhaps the *pro hac vice* counsel would not need such technical subject matter familiarity themselves. However, absent registered practitioner co-counsel, *pro hac vice* counsel may be expected to further demonstrate familiarity with the technical subject matter in order to meet this requirement.

Regardless, it may be helpful at this juncture if the Office were to clarify what serves as sufficient basis to demonstrate familiarity with the subject matter at issue in the proceeding.

Provisions for Under-Resourced Parties

AIPLA appreciates the concession made to under-resourced parties regarding permission to proceed without back-up counsel upon showing of good cause. AIPLA urges care in adoption of certain standards for showing good cause—a party who qualifies as a small- or micro-entity may not be truly under-resourced, for example, for the purposes of this provision. This provision should be handled case-by-case, and qualifying for other USPTO programs and pro bono offerings from local and national IP organizations and firms may be a factor for consideration by the PTAB, but not solely determinative.

Consistency of Terminology: “Non-Registered Practitioner” and “Counsel Who is Not a Registered Practitioner” Should be Reconciled

As noted in AIPLA’s response to the RFC of October 18, 2022, the Office has relied on usage of the term “non-registered practitioner” that is inconsistent with 37 C.F.R. § 11.1, which *defines a “practitioner”* as an attorney or agent registered to practice before the Office in patent matters, *or (if not registered)*, authorized to practice under 5 U.S.C. 500(b); 37 C.F.R. § 11.14(a), (b), and (c); 37 C.F.R. § 11.9(a) or (b); or 37 C.F.R. § 11.16(d). None of these sections are relevant to *pro hac vice* authorization to practice before the PTAB.

37 C.F.R. § 42.10, which is the subject of the proposed amendment in this Notice, instead uses the language “counsel who is not a registered practitioner.” This existing phrasing is consistent with 37 C.F.R. § 42.5 indicating that for a *pro hac vice* appearance, “[t]he Board may authorize a person other than a registered practitioner to appear as counsel in a specific proceeding.” Consistent usage of this phrasing throughout the proposed rules is essential to avoid confusion with either registered or non-registered practitioners within the meaning of 37 C.F.R. § 11.1.

Simply put, *pro hac vice* counsel are not, by definition, “practitioners” (whether registered or not). And by the use of “counsel” in the language of 37 C.F.R. § 42.10, it appears that the Office does not intend to include the actual class of non-registered practitioners (*e.g.*, law students receiving limited recognition, others receiving limited recognition under 37 C.F.R. § 11.9(a) or (b) due to immigration status, etc.) in this expansion, but rather specifically attorneys authorized to practice by a state bar who are not qualified as “registered practitioners.”

AIPLA therefore recommends the following revisions to the proposed rules:

(c)(1) *Pro hac vice recognition of ~~non-registered practitioners~~ a person other than a registered practitioner.* The Board may recognize counsel who is not a registered practitioner *pro hac vice* during a proceeding, as either lead or back-up counsel, upon a showing of good cause, subject to the condition that at least one other counsel designated to appear on behalf of the party is a registered practitioner, and to any other conditions as the Board may impose. For example, a motion to permit counsel who is not a registered practitioner to appear *pro hac vice* in a proceeding may be granted upon a showing that counsel is an experienced litigating attorney and that back-up counsel will be a registered practitioner.

(2) *Pro hac vice recognition of PTAB-recognized ~~practitioners~~ counsel.*

(i) ~~A non-registered practitioner~~ Counsel who is not a registered practitioner who has been previously recognized *pro hac vice* in a Board proceeding, and who has not subsequently been denied permission to appear *pro hac vice* in a Board proceeding, shall be considered a PTAB-recognized ~~practitioner~~ counsel. PTAB-recognized ~~practitioners~~ counsel shall be eligible for automatic *pro hac vice* admission in subsequent proceedings, as either lead or back-up counsel, subject to the following conditions.

(ii) If a party seeks to be represented in a proceeding by a PTAB-recognized ~~Practitioner~~ counsel, that party may file a notice of intent to designate a PTAB-recognized ~~practitioner~~ counsel as either lead or back-up counsel. No fee is required for such a notice. The notice shall:

- (A) Identify a registered practitioner who will serve as co-counsel, and
- (B) Be accompanied by a certification in the form of a declaration or affidavit, in which the PTAB-recognized ~~practitioner~~ counsel attests to satisfying all requirements set forth by the Board for *pro hac vice* recognition of a PTAB-recognized ~~practitioner~~ counsel, and agrees to be subject to the USPTO Rules of Professional Conduct set forth in §§ 11.101 et seq. of this chapter and disciplinary jurisdiction under § 11.19(a) of this chapter.

(iii) Any objection shall be filed within five business days after the filing of the notice. If an objection is not filed within five business days, the PTAB-recognized ~~practitioner~~ counsel shall be deemed admitted *pro hac vice* in that proceeding upon filing of updated mandatory notices identifying that ~~practitioner~~ counsel as counsel of record. If an objection is filed within five business days, unless the Board orders otherwise within ten business days after the objection is filed, the PTAB-recognized ~~practitioner~~ counsel shall be deemed admitted *pro hac vice* after updated mandatory notices identifying that ~~practitioner~~ counsel as counsel of record are then filed.

(iv) If a PTAB-recognized ~~practitioner~~ counsel is unable to satisfy any of the requirements set forth by the Board, or is unable to make any of the required attestations under oath, this procedure is not available, and *pro hac vice* recognition must instead be sought under the process set forth in paragraph (c)(1) of this section.

(3) *Continuing duty of ~~non-registered practitioners~~ a person recognized *pro hac vice*.* For the entire duration of any proceeding in which a ~~non-registered~~ counsel who is not a registered practitioner is recognized *pro hac vice* pursuant to paragraph (c)(1) or (2) of this section, the ~~non-registered~~ counsel who is not a registered practitioner has a continuing duty to notify the Board in writing within five business days if:

- (i) The ~~non-registered~~ counsel who is not a registered practitioner is sanctioned, cited for contempt, suspended, disbarred, or denied admission by any court or administrative agency;
- (ii) The ~~non-registered~~ counsel who is not a registered practitioner no longer qualifies as a member in good standing of the Bar of at least one State or the District of Columbia; or
- (iii) Any other event occurs that renders materially inaccurate or incomplete any representation that was made to the Board in connection with the request for *pro hac vice* recognition, provided, however, that ~~non-registered~~ counsel who is not a registered practitioner is not required to inform the Board of subsequent applications for *pro hac vice* recognition unless such an application is denied.

In resolving these inconsistencies, AIPLA also identified a similar inconsistency in 37 C.F.R. § 42.15(e). This existing language should likewise be revised at this opportunity to reconcile the terminology, to read “Fee for ~~non-registered~~ counsel who are not registered practitioners or PTAB-recognized counsel to appear *pro hac vice* before the Patent Trial and Appeal Board: \$250.00.” Additionally, 37 C.F.R. § 11.19(a) would need to be revised to refer to “all ~~practitioners~~ counsel authorized under § 41.5(a) or § 42.10(c) of this chapter.” There may be other revisions needed.

As a perhaps simpler alternative, 37 C.F.R. § 11.1 can be revised to include an additional definition under “Practitioner” to include a new category of **non-registered** practitioner. This approach suffers from the issue that a non-registered practitioner used elsewhere also includes (2), (3), and (4)—but **counsel** (under § 42.10(c)) who is a non-registered practitioner might be sufficiently clear to exclude those and reach the correct meaning. This alternative reads:

- (1) An attorney or agent registered to practice before the Office in patent matters under § 11.6;
- (2) An individual authorized under 5 U.S.C. 500(b), or otherwise as provided by § 11.14(a) through (c), to practice before the Office in trademark matters or other non-patent matters;
- (3) An individual authorized to practice before the Office in patent matters under § 11.9(a) or (b); ~~or~~
- (4) An individual authorized to practice before the Office under § 11.16(d); or
- (5) Counsel authorized to practice *pro hac vice* before the Patent Trial and Appeal Board under § 41.5(a) or § 42.10(c).

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Conclusion

AIPLA gratefully acknowledges the efforts by the USPTO to improve and revisit the requirements for practice before the PTAB. We thank you for the opportunity to provide these comments and are happy to discuss further.

Sincerely,

A handwritten signature in blue ink that reads "Ann M. Muetting". The signature is written in a cursive style with a large, looping "M" and "g".

Ann M. Muetting

President

American Intellectual Property Law Association