

AIPLA

American Intellectual Property Law Association

January 26, 2022

Via Federal eRulemaking Portal: www.regulations.gov

Michael Tierney
Vice Chief Administrative Patent Judge
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Re: Comments in response to the Request for Comments entitled: *Expanding Opportunities To Appear Before the Patent Trial and Appeal Board* (Vol. 87, No. 200 *Federal Register*, Tuesday, Oct. 18, 2022, Request for Comments) Docket No.: PTO-P-2022-0032

Dear Judge Tierney:

The American Intellectual Property Law Association (the “AIPLA”) is pleased to offer its comments in response to the *Expanding Opportunities To Appear Before the Patent Trial and Appeal Board* (“Request for Comments”).

Founded in 1897, the American Intellectual Property Law Association is a national bar association of approximately 7,000 members who are 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 USPTO’s interest in soliciting feedback and information on potentially revising the criteria to practice before the Patent Trial and Appeal Board (“PTAB”), including changes to the PTAB’s Legal Experience and Advancement Program (“LEAP”). AIPLA understands that these changes are intended to increase opportunities for practitioners to practice before the PTAB. AIPLA first acknowledges the tremendous efforts undertaken by the USPTO in recent months to strengthen opportunity for practitioners, and to create pathways to IP practice via efforts that serve underrepresented inventors, applicants, and even practitioners. These include focusing on diversity, equity, and inclusion. We provide our comments to the Request for Comments, below.

As a general comment, AIPLA notes that the USPTO’s usage of “non-registered practitioners” throughout the Request for Comments appears to be inconsistent with 37 CFR § 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). The usage of “non-registered practitioner” here appears to instead mean, using the language of 37 C.F.R. § 42.10, “counsel who is not a registered practitioner.” AIPLA recommends that the USPTO use this or similar language to refer to individuals subject to any possible expansion here. However, for the sake of consistency with the Request for Comments, AIPLA’s comments use the phrase “non-registered practitioner” to mean “counsel who is not a registered practitioner.”

Request 1: Expanding Opportunities to Practice Before the PTAB by Allowing Non-Registered Practitioners to Be Admitted to Practice Before the PTAB

At this time, AIPLA does not believe there is a need to remove the requirement for registration to practice before the USPTO as a prerequisite for practicing before the PTAB. To the extent trials and proceedings before the PTAB have increased, non-registered practitioners already have the opportunity to appear *pro hac vice* in proceedings without limitation (*i.e.*, a non-patent attorney could continuously apply to be counsel in dozens of proceedings without seeking registration, provided they otherwise comply with the rules).

Request 2: Expanding Opportunities for Non-registered Practitioners to Appear as the Lead Counsel

AIPLA also does not believe there is a need specifically to adjust the rules to permit non-registered practitioners to appear as lead counsel. Similar to other *pro hac vice* situations, AIPLA believes that lead counsel who has satisfied the requirements to practice before a tribunal should be responsible for the whole case, even if their *pro hac vice* counsel ultimately withdraws. Regardless, the fact that both lead counsel and back-up *pro hac vice* counsel are of record should not create any undue burden for the non-registered practitioner not designated as lead counsel. If the USPTO believes that allowing non-registered practitioners to specifically appear as lead counsel is necessary, AIPLA would recommend that a registered practitioner be required to otherwise be of record as back-up counsel.

Request 3: Other Considerations Regarding Non-Registered Practitioners

AIPLA believes that one of the main purposes of registration to practice before the USPTO is to ensure USPTO-specific legal knowledge, with the technical acumen to apply the USPTO-specific legal knowledge to the specialized technical circumstances of a matter. Apart from the registration exam, there is no other validation that a practitioner has enough knowledge to practice before the USPTO.

In the course of a PTAB trial, a number of USPTO practice-specific matters may arise, which a non-registered practitioner may not be sufficiently competent to handle. One example would be claim amendments during trial. Claim drafting, whether in the limited setting of a PTAB trial or in the expansive course of patent examination, is a core area of competence for registered practitioners. Likewise, the interplay of the PTAB trial with other related pending matters before the USPTO is the core competence of registered practitioners. By ensuring that a registered practitioner is at least of record in the proceeding, whether lead or back-up, the PTAB can expect that a represented party is competently represented on all issues that may arise during a PTAB trial.

In the questions section of the Request for Comments, the USPTO asks whether, if a rule is adopted containing no requirement for lead or back-up counsel to be registered practitioners, if there are any circumstances or events that might occur (i.e., contemplated or actual filing of a motion to amend) that might warrant requiring an appearance of a registered practitioner at that point. It is AIPLA's position that a registered practitioner should be of record from the outset. This is in order to properly account for motions to amend, as well as to consider the interplay of any such motions with the full body of USPTO rules at all times. A non-registered practitioner may not be able to, for example, recommend alternative approaches in a pending continuation, reexamination, or reissue based on the posture of the PTAB trial.

Additionally in the questions section of the Request for Comments, the USPTO asks about cost impacts related to requiring an appearance by a registered practitioner. AIPLA believes that a number of non-registered practitioners, particularly some who have made numerous appearances in PTAB trials, likely possess broad knowledge of USPTO rules, and in such cases a registered practitioner might be an additional cost. However, by ensuring that a registered practitioner is of record, the USPTO retains disciplinary jurisdiction over not only the PTAB trials, but also conduct before the USPTO more broadly as it relates to those PTAB trials.

Request 4: Training and Development Programs and Potential Changes to LEAP

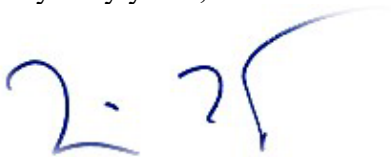
AIPLA commends the USPTO's use of the LEAP program to provide less-experienced and newer practitioners more opportunities to learn and grow through practical experience in oral arguments before the PTAB. AIPLA encourages more in-person training events for newer lawyers, along with mentorship opportunities.

As noted elsewhere, there are functionally few differences between lead and back-up counsel in a PTAB trial proceeding and, therefore, focusing efforts on promoting practitioners to lead counsel may not be the most efficient use of resources.

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 such comments, and are happy to discuss further.

Very truly yours,



Brian H. Batzli
President
American Intellectual Property Law Association