



## American Intellectual Property Law Association

November 29, 2023

The Honorable Katherine K. Vidal  
Under Secretary of Commerce for Intellectual Property and Director of the United States  
Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

*Submitted electronically via:* Federal eRulemaking Portal ([www.regulations.gov](http://www.regulations.gov))

**Re: Docket No. PTO-P-2023-0012**

### **Notice of Proposed Rulemaking on Rules Governing Pre-Issuance Internal Circulation and Review of Decisions Within the Patent Trial and Appeal Board**

Dear Director Vidal:

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 “Rules Governing Pre-Issuance Internal Circulation and Review of Decisions Within the Patent Trial and Appeal Board,” 88 Fed. Reg. 69578 (Oct. 6, 2023).

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 improve America Invents Act (“AIA”) trial proceedings, which have become pervasive since their initial implementation in September 2012, including the Office’s focus on improving fairness to all parties and providing a framework to achieve more consistency and predictability in these proceedings. In the last few years, the Office has taken efforts to address concerns of stakeholders, including through designation of decisions as precedential or informative, implementation of Standard Operating Procedure 2, establishing Precedential Opinion Panel review, implementing the pilot program for motions to amend, providing guidance memoranda, and updating the Trial Practice Guide.

The Notice of Proposed Rulemaking largely follows from Questions 13 and 14 in the “Request for Comments on Director Review, Precedential Opinion Panel Review, and Internal

Circulation and Review of Patent Trial and Appeal Board Decisions,” 87 Fed. Reg. 43249, 52 (July 20, 2022), which asked “Should any changes be made to the interim PTAB decision circulation and internal review processes, and if so, what changes and why?” and “Are there any other considerations the USPTO should take into account with respect to the interim PTAB decision circulation and internal review processes?”

AIPLA acknowledges with appreciation that the Office has endeavored to implement its proposed changes through notice and comment rulemaking, giving the public an opportunity to provide vital feedback. AIPLA supports policies for decision-making that are not only efficient and transparent, but also predictable. Frequent policy changes, particularly those driven by precedential decision-making rather than through notice and comment rulemaking, can create uncertainty in the patent process, devalue intellectual property, and even potentially limit the creation and/or public disclosure of important intellectual property developments.

Consistent with its response to the RFC of July 20, 2022, AIPLA reiterates the importance of transparency, consistency, and efficiency surrounding the source of decision-making at the PTAB. AIPLA applauds the Office’s efforts to adopt a process for internal review that ensures transparency. The source of decision-making at the PTAB should be transparent, to ensure accountability and facilitate review on appeal.

The majority of AIPLA’s response to the RFC of July 20, 2022, is addressed by the implementation of the accompanying PTAB SOP 4, including matters regarding the membership of the Circulation Judge Pool (“CJP”) and regarding staggered terms and appointment to the CJP.

AIPLA has specific concerns about transparency with respect to proposed § 43.4(b) and corresponding PTAB SOP 4(II). When a panel has requested input from a PTAB Management Pre-Issuance Optional Review team, it is ultimately up to the panel whether to adopt any suggestions provided. This request for input is not publicly available, nor are the suggestions provided in response.

While administrative patent judges should feel comfortable seeking internal input to promote consistency and efficiency without the potential chilling effect of public scrutiny even before the rendering of a decision, AIPLA notes that stakeholders value transparency. The need for a panel to seek pre-issuance input from PTAB management may be material to the parties for various reasons. For example, knowing that PTAB management was consulted may be material in determining whether to seek Director Review of that decision. And the reason itself for seeking input from PTAB management may be material.

Recognizing, however, that full transparency on this matter may not be practical or even desirable, AIPLA requests the Office to provide at least some degree of transparency in the form of statistical information regarding how often a panel seeks input from PTAB management. Access to this information would go a substantial way toward keeping the public reasonably informed without hampering the PTAB’s decision-making process. It would also inform parties seeking Director Review of current trends in panels seeking input from PTAB management. While it is not necessary to go into the specifics of each request, the public remains interested in understanding how often (and for what purpose) this mechanism is being used. AIPLA appreciates the opportunity to provide feedback to the Office on the process for

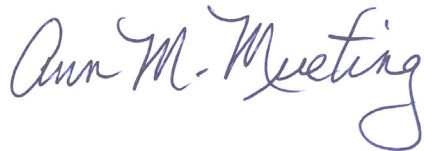
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pre-issuance internal circulation and review of PTAB decisions. AIPLA looks forward to further dialogue with the Office with regard to the issues raised above.

Sincerely,

Ann M. Muetting

A handwritten signature in blue ink that reads "Ann M. Muetting". The signature is written in a cursive, flowing style.

President  
American Intellectual Property Law Association