



American Intellectual Property Law Association

July 11, 2022

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

Via email: Director_Review_Suggestions@uspto.gov

Re: Interim Process for Director Review

Dear Director Vidal:

The American Intellectual Property Law Association (“AIPLA”) is pleased to offer its initial views to the United States Patent and Trademark Office (“Office”) in response to the “Interim Process for Director Review,” published online at <https://www.uspto.gov/patents/patent-trial-and-appeal-board/interim-process-director-review> (hereinafter “Process for Director Review”). The Office also recently published an “Interim process for PTAB decision circulation and internal PTAB review, online at <https://www.uspto.gov/interim-process-ptab-decision-circulation-and-internal-ptab-review> (hereinafter “Process for PTAB Decision Circulation”). As the PTAB Decision Circulation information is similarly aimed at providing transparency with respect to the independence of PTAB Administrative Patent Judges (APJs), AIPLA also takes this opportunity to provide initial views on PTAB Decision Circulation.

Founded in 1897, the American Intellectual Property Law Association is a national bar association of approximately 8,500 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 AIA trial proceedings, which have become pervasive since their initial implementation in September 2012. AIPLA appreciates the Office’s focus on improving fairness to all parties and achieving more consistency and predictability in these proceedings. In the last few years, the Office has taken efforts to address concerns of stakeholders, including through designating decisions as precedential or informative, implementing 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. AIPLA previously has expressed its position on issues

relevant to the Interim Process for Director Review.¹ Further, to cure any Constitutional infirmity under the Appointments Clause, AIPLA's Board of Directors adopted a proposal favoring, in principle, action by Congress to create a small set of Presidentially appointed, Senate-confirmed senior administrative patent judges to review final PTAB decisions. We can provide more details upon request.

General Comments on Interim Process for Director Review

AIPLA applauds the Office's efforts to adopt a transparent process for Director review. PTAB decision-making should be transparent to ensure accountability and facilitate review on appeal. We take this opportunity to provide initial feedback and we intend to provide further feedback as part of the request-for-comments ("RFC") process.

We note that the Process for Director Review does not identify circumstances in which the Director will provide a separate written opinion after granting a request for rehearing. *See* Process for Director Review, Questions 14–15 (describing a "decision"). In general, we recommend that the Process for Director Review specify the nature of the decisions and the circumstances in which the Director will provide a rationale for her decision. For example, we generally believe that a decision reversing or modifying a panel's decision should include the reasons for such modification. The record should explain any deviations adopted by the Director on review. Documenting such decisions will protect the system and improve the public's trust and understanding of the PTAB's decision-making process.

AIPLA notes some additional issues that could be clarified before the final RFC issues. With respect to "Focusing and Prioritizing Issues" discussed in Question 10, it would be helpful for the Process for Director Review to provide examples of issues and explanations that would be appropriate for a Rehearing Request by the Director. In addition, it would be helpful for any Order granting Director Review to identify the issues that will be considered in the Director Review. This would be helpful to focus briefing on the issues for both parties and amici. With respect to "Responsive or amicus briefing," discussed Question 11, AIPLA welcomes the opportunity to participate as amicus in appropriate cases. For AIPLA to take a position, our committees must first prepare a recommendation for Board review and our Board of Directors must review and approve an amicus brief before filing. As a practical matter, AIPLA typically requires a minimum of 4–6 weeks to file an amicus brief. To the extent possible, we appreciate adequate time and notice for filing amicus briefs in appropriate cases.

We are still considering other aspects of the Process for Director Review and plan to weigh in as part of the RFC process.

General Comments on Interim Process for PTAB Decision Circulation and Internal PTAB Review

As discussed above, transparency surrounding PTAB decision-making is important to promote public confidence. While the Process for PTAB Decision Circulation provides details that clarify the internal practices promoting consistency and quality in PTAB decisions, several

¹ Br. of Amicus Curiae AIPLA, in Support of Reversal, *United States v. Arthrex, Inc.*, No. 19-1434 (December 2, 2020) (arguing that PTAB APJs are inferior officers), available at https://www.aipla.org/docs/default-source/advocacy/judicial/aipla_amicus_arthrex_sctus_12022020.pdf?sfvrsn=ba153e93_2.

July 11, 2022

Page 3

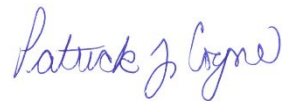
aspects of the process could be clarified. We take the opportunity to provide some initial comments on the Process for PTAB Decision Circulation and may provide additional comments later.

The Process for PTAB Decision Circulation is silent as to when the terms of individual judges on the Circulation Judge Pool (“CJP”) will start and end relative to one another. All CJP judges starting their terms at the same time could potentially create inconsistencies in CJP feedback. Staggering the terms of the CJP judges would improve institutional knowledge and consistency.

The Process for PTAB Decision Circulation does not specify how judges serving on the CJP will be credited for their service on the CJP and whether they will also continue to maintain a full PTAB case docket. To ensure that the CJP provides the desired quality and consistency in PTAB decisions, members of the CJP should be credited for their CJP work and given adequate time and resources to thoroughly review decisions. Giving judges on the CJP credit for time spent on their CJP tasks would incentivize them to dedicate appropriate time to the tasks.

AIPLA appreciates the opportunity to provide feedback to the Office on the Process for Director Review and the Process for PTAB Decision Circulation. AIPLA looks forward to further dialogue with the Office with regard to the issues raised above.

Sincerely,



Patrick J. Coyne

President

American Intellectual Property Law Association