



American Intellectual Property Law Association

**RECOMMENDATIONS REGARDING QUALIFICATIONS FOR
THE NEXT DIRECTOR AND DEPUTY DIRECTOR OF
THE U.S. PATENT AND TRADEMARK OFFICE**

Revised and approved, July 2018

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Introduction

The United States Patent and Trademark Office (“USPTO”) is a federal agency in the Department of Commerce, headquartered in Alexandria, Virginia with satellite offices throughout the United States, with over 13,000 employees. Through the examination and grant of high-quality patents, the USPTO encourages technological innovation by providing incentives to invent, invest in, and disclose new technology. Through the registration of trademarks, the agency assists businesses by protecting their investments in promoting goods and services, and safeguards consumers against confusion and deception in the marketplace. By disseminating both patent and trademark information, the USPTO promotes an understanding of intellectual property protection and facilitates the development and sharing of new technologies.

An efficient and responsive USPTO that delivers its services in a consistent, uniform, equitable, and transparent manner is critical for the effective operation of this country's patent and trademark systems. Effective and adaptive leadership of the USPTO is crucial to the achievement of its mission goals and objectives. This paper provides some views of the American Intellectual Property Law Association (“AIPLA”) on the desired qualifications for any Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (“Director”) and the Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the United States Patent and Trademark Office (“Deputy Director”).

The USPTO requires strong leadership and executive management capabilities in its Director and Deputy Director. These individuals, who should be top-caliber, knowledgeable, intellectual property executives, must have the ability and commitment to encourage innovation and economic growth in the U.S., and must be experienced, highly respected leaders having integrity, in whom the President, Congress, and the intellectual property, business, and international communities can place their full confidence. Together they should have strong legal and executive leadership skills, an extensive understanding of domestic and foreign intellectual property law, particularly patent and trademark law, preferably including experience in one or more of patent prosecution, trademark prosecution, product clearance, licensing, and intellectual property litigation. A strong understanding of federal organization constraints is encouraged. This level of expertise should provide the business acumen, practical insight, and knowledge the Director and Deputy Director will need to ensure the U.S. maintains its global leadership role in promoting innovation and also to drive economic growth in America.

AIPLA's Members Have an Interest in Efficient, Effective Operation of the USPTO

AIPLA is a national bar association of approximately 13,500 members engaged in private and corporate practice, government service, and the academic community. AIPLA members represent a diverse spectrum of individuals, companies, and institutions involved directly and indirectly in the practice of patent, trademark, copyright, trade secret and unfair competition law, as well as other fields of law affecting intellectual property. AIPLA members practice before the USPTO in securing issuance of patents, registration of trademarks, resolution of disputes regarding patentability and registration, and on both sides of administrative trial proceedings before the Patent Trial & Appeal Board and the Trademark Trial & Appeal Board. AIPLA members also represent owners of intellectual property who may be asserting a patent or trademark, or users of technology who are defending against a charge of patent or trademark infringement in federal court litigation. AIPLA thus has a continuing interest in seeing that the USPTO is led by a Director and Deputy Director with the highest qualifications.

Responsibilities of the Director and Deputy Director

The Director is appointed by the President of the United States by and with the advice and consent of the Senate and reports to the Secretary of Commerce. The Director is responsible for providing policy direction and management supervision of USPTO's issuance of patents and registration of trademarks, and for consulting with the Patent Public Advisory Committee and the Trademark Public Advisory Committee. In particular, the Director is charged with supervising the performance of the following functions, and the Director is assisted in carrying out these functions by the Deputy Director, who acts in the capacity of Director in the absence or incapacity of the Director:

- Supervising the personnel and resources of the USPTO;
- Administering the laws relating to the granting and issuing of patents and registration of trademarks;
- Administering the laws relating to the dissemination to the public of information with respect to patents and trademarks;
- Advising the Secretary on intellectual property policy, subject to the policy direction of the Secretary advising federal departments and agencies on matters of intellectual property policy in the United States and intellectual property protection in other countries, and advising the President, through the Secretary, on national and certain international intellectual property policy issues;
- Conducting programs, studies, and exchanges of items and services regarding intellectual property;

- Conducting cooperative programs with nongovernmental organizations, foreign intellectual property offices, and international intergovernmental organizations;
- Serving as the focal point for intellectual property matters within the Commerce Department, and being prepared, when requested by appropriate authority and subject to the policy direction of the Secretary, to serve as spokesperson for the Executive Branch on the broad range of domestic and international intellectual property issues confronting the Nation; and
- Performing other functions required or deemed necessary and proper by the Under Secretary in exercising the authority delegated.

Recommended Background, Qualifications and Experience

Candidates for the positions of Director and Deputy Director should be experienced intellectual property (IP) attorneys with political acumen and public service motivation who are well-respected and are of the highest integrity. Ideally, candidates should have at least 15 years of IP experience in the private, industry, or public sectors (preferably at the USPTO), with 10 or more years of managerial experience with fiscal responsibility in a corporation, administrative agency, or law firm.

Exemplary of preferred candidates for the Director and Deputy Director are those with: (a) at least 10 years of experience as the chief or ranking deputy IP counsel of a major, IP-dependent company; (b) at least 10 years of experience as a partner/shareholder of an IP law firm or significant IP department in a major general firm, serving as managing partner, as a practice group chair, or in a significant law firm management role, for at least 5 of those years; (c) at least 10 years of managerial and budget experience at the USPTO, at least five 5 years of which was as a Senior Executive Service employee; or (d) at least 10 years of other comparable experience in obtaining, licensing, or litigating patents or trademarks, preferably representing both intellectual property owners and accused infringers.

Pertinent skills and attributes for the positions of Director and Deputy Director preferably include some combination of several of the following:

- Experience in patent prosecution, licensing, or litigation, and knowledge of the relevant law and procedures governing those activities;
- Experience in trademark prosecution, licensing, or litigation, and knowledge of the relevant law and procedure governing those activities;

- Working knowledge of copyright, domain names, genetic resources, traditional knowledge, and geographical indications policy issues that arise in domestic and international policy negotiations;
- A proven track record of successfully managing and leading a large enterprise, including proven success in labor/management relations and employee retention;
- Demonstrated capabilities in strategic planning, budgeting, and financial management;
- Experience in congressional and international intellectual property policy advocacy, especially in policy development, and proven diplomacy skills;
- A demonstrated commitment and willingness to engage and listen to the stakeholder community in transparent and constructive discourse when contemplating and evaluating office operations, regulatory changes and policy decisions;
- Working knowledge of information technology and a demonstrated willingness to embrace new technological solutions to improve efficiency and effectiveness; and
- Working knowledge of government management and personnel practices.

The Director and Deputy Director also should possess the personal competencies defined in the United States Office of Personnel Management Guide to Senior Executive Service. Particularly, the Director and Deputy Director should collectively exhibit the executive core qualifications to:

(1) lead change by establishing an organizational vision and to implement it in a continuously changing environment; (2) lead people, fostering development of others, facilitating cooperation and teamwork and supporting constructive resolution of conflicts; (3) be results-driven to produce high-quality results by applying technical knowledge, analyzing problems, and calculating risks; (4) manage human, financial, and information resources strategically; and (5) build coalitions internally and with other federal agencies, state and local governments, nonprofit and private sector organizations, foreign governments, or international organizations to achieve common goals. Given the important and growing role that intellectual property and related rights play in the U.S. economy, AIPLA urges that the individuals selected to be the Director and Deputy Director of the USPTO possess many of the qualifications outlined above, in particular when combined with experience in patent or trademark law.

Relevant Statutory Sections

35 U.S.C. 2 Powers and duties.

(a) IN GENERAL.— The United States Patent and Trademark Office, subject to the policy direction of the Secretary of Commerce—

- (1) shall be responsible for the granting and issuing of patents and the registration of trademarks; and
- (2) shall be responsible for disseminating to the public information with respect to patents and trademarks.

(b) SPECIFIC POWERS.— The Office—

- (1) shall adopt and use a seal of the Office, which shall be judicially noticed and with which letters patent, certificates of trademark registrations, and papers issued by the Office shall be authenticated;
- (2) may establish regulations, not inconsistent with law, which—
 - (A) shall govern the conduct of proceedings in the Office;
 - (B) shall be made in accordance with section 553 of title 5;
 - (C) shall facilitate and expedite the processing of patent applications, particularly those which can be filed, stored, processed, searched, and retrieved electronically, subject to the provisions of section [122](#) relating to the confidential status of applications;
 - (D) may govern the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Office, and may require them, before being recognized as representatives of applicants or other persons, to show that they are of good moral character and reputation and are possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office;
 - (E) shall recognize the public interest in continuing to safeguard broad access to the United States patent system through the reduced fee structure for small entities under section 41(h)(1);
 - (F) provide for the development of a performance-based process that includes quantitative and qualitative measures and standards for evaluating cost-effectiveness and is consistent with the principles of impartiality and competitiveness; and
 - (G) may, subject to any conditions prescribed by the Director and at the request of the patent applicant, provide for prioritization of examination of applications for products, processes, or technologies that are important to the national economy or national competitiveness without recovering the aggregate extra cost of providing such prioritization, notwithstanding section 41 or any other provision of law;
- (3) may acquire, construct, purchase, lease, hold, manage, operate, improve, alter, and renovate any real, personal, or mixed property, or any interest therein, as it considers necessary to carry out its functions;

(4)

(A) may make such purchases, contracts for the construction, maintenance, or management and operation of facilities, and contracts for supplies or services, without regard to the provisions of subtitle I and chapter 33 of title 40, division C (except sections 3302, 3501(b), 3509, 3906, 4710, and 4711) of subtitle I of title 41, and the McKinney-Vento Homeless Assistance Act (42 U.S.C. 11301 et seq.); and

(B) may enter into and perform such purchases and contracts for printing services, including the process of composition, platemaking, presswork, silk screen processes, binding, microform, and the products of such processes, as it considers necessary to carry out the functions of the Office, without regard to sections 501 through 517 and 1101 through 1123 of title 44;

(5) may use, with their consent, services, equipment, personnel, and facilities of other departments, agencies, and instrumentalities of the Federal Government, on a reimbursable basis, and cooperate with such other departments, agencies, and instrumentalities in the establishment and use of services, equipment, and facilities of the Office;

(6) may, when the Director determines that it is practicable, efficient, and cost-effective to do so, use, with the consent of the United States and the agency, instrumentality, Patent and Trademark Office, or international organization concerned, the services, records, facilities, or personnel of any State or local government agency or instrumentality or foreign patent and trademark office or international organization to perform functions on its behalf;

(7) may retain and use all of its revenues and receipts, including revenues from the sale, lease, or disposal of any real, personal, or mixed property, or any interest therein, of the Office;

(8) shall advise the President, through the Secretary of Commerce, on national and certain international intellectual property policy issues;

(9) shall advise Federal departments and agencies on matters of intellectual property policy in the United States and intellectual property protection in other countries;

(10) shall provide guidance, as appropriate, with respect to proposals by agencies to assist foreign governments and international intergovernmental organizations on matters of intellectual property protection;

(11) may conduct programs, studies, or exchanges of items or services regarding domestic and international intellectual property law and the effectiveness of intellectual property protection domestically and throughout the world, and the Office is authorized to expend funds to cover the subsistence expenses and travel-related expenses, including per diem, lodging costs, and transportation costs, of persons attending such programs who are not Federal employees;

(12)

(A) shall advise the Secretary of Commerce on programs and studies relating to intellectual property policy that are conducted, or authorized to be conducted, cooperatively with foreign intellectual property offices and international intergovernmental organizations; and

(B) may conduct programs and studies described in subparagraph (A); and

(13)

(A) in coordination with the Department of State, may conduct programs and studies cooperatively with foreign intellectual property offices and international intergovernmental organizations; and

(B) with the concurrence of the Secretary of State, may authorize the transfer of not to exceed \$100,000 in any year to the Department of State for the purpose of making special payments to international intergovernmental organizations for studies and programs for advancing international cooperation concerning patents, trademarks, and other matters.

(c) CLARIFICATION OF SPECIFIC POWERS.—

(1) The special payments under subsection (b)(13)(B) shall be in addition to any other payments or contributions to international organizations described in subsection (b)(13)(B) and shall not be subject to any limitations imposed by law on the amounts of such other payments or contributions by the United States Government.

(2) Nothing in subsection (b) shall derogate from the duties of the Secretary of State or from the duties of the United States Trade Representative as set forth in section 141 of the Trade Act of 1974 (19 U.S.C. 2171).

(3) Nothing in subsection (b) shall derogate from the duties and functions of the Register of Copyrights or otherwise alter current authorities relating to copyright matters.

(4) In exercising the Director's powers under paragraphs (3) and (4)(A) of subsection (b), the Director shall consult with the Administrator of General Services.

(5) In exercising the Director's powers and duties under this section, the Director shall consult with the Register of Copyrights on all copyright and related matters.

(d) CONSTRUCTION.— Nothing in this section shall be construed to nullify, void, cancel, or interrupt any pending request-for-proposal let or contract issued by the General Services Administration for the specific purpose of relocating or leasing space to the United States Patent and Trademark Office.

35 U.S.C. 3 Officers and employees.

(a) UNDER SECRETARY AND DIRECTOR.—

(1) IN GENERAL.— The powers and duties of the United States Patent and Trademark Office shall be vested in an Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (in this title referred to as the "Director"), who shall be a citizen of the United States and who shall be appointed by the President, by and with the advice and consent of the Senate. The Director shall be a person who has a professional background and experience in patent or trademark law.

(2) DUTIES.—

(A) IN GENERAL.— The Director shall be responsible for providing policy direction and management supervision for the Office and for the issuance of patents and the registration of trademarks. The Director shall perform these duties in a fair, impartial, and equitable manner.

(B) CONSULTING WITH THE PUBLIC ADVISORY COMMITTEES.— The Director shall consult with the Patent Public Advisory Committee established in section 5 on a regular basis on matters relating to the patent operations of the Office, shall consult with the Trademark Public Advisory Committee established in section 5 on a regular basis on matters relating to the trademark operations of the Office, and shall consult with the respective Public Advisory Committee before submitting budgetary proposals to the Office of Management and Budget or changing or proposing to change patent or trademark user fees or patent or trademark regulations which are subject to the requirement to provide notice and opportunity for public comment under section 553 of title 5, as the case may be.

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(b) OFFICERS AND EMPLOYEES OF THE OFFICE.—

(1) DEPUTY UNDER SECRETARY AND DEPUTY DIRECTOR.— The Secretary of Commerce, upon nomination by the Director, shall appoint a Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the United States Patent and Trademark Office who shall be vested with the authority to act in the capacity of the Director in the event of the absence or incapacity of the Director. The Deputy Director shall be a citizen of the United States who has a professional background and experience in patent or trademark law.