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May 21, 2024

Via Federal eRulemaking Portal at www.regulations.gov
Docket No. PTO-P-2023-0058

Attn: Michael P. Tierney, Vice Chief Administrative Patent Judge, and Scott C. Moore, Acting Senior Lead Administrative Patent Judge

Re: Request for Comments on Notice of Proposed Rulemaking for Expanding Opportunities To Appear Before the Patent Trial and Appeal Board

I write on behalf of the PTAB Bar Association (the “Association”) to respond to the request by the United States Patent and Trademark Office (“the Office”) for public comments in response to the Office’s Notice of Proposed Rulemaking for Expanding Opportunities To Appear Before the Patent Trial and Appeal Board (“NPRM”), published at 89 Fed. Reg. 13017 (PTO-P-2023-0058, Feb. 21, 2024).

The Association is a voluntary bar association of over 700 members engaged in private and corporate practice and in government service. Members represent a broad spectrum of individuals, companies, and institutions involved in practice before the Patent Trial and Appeal Board (“PTAB” or “Board”) and in patent, administrative and appellate law more generally. Per its bylaws, the Association is dedicated to helping secure the just, speedy, and inexpensive resolution of every PTAB proceeding. Accordingly, the Association strives to present a neutral perspective representing all parties with an interest in PTAB proceedings. The Association also prides itself on leading with diverse perspectives. For example, more than half of our Past Presidents are members of underrepresented communities.

The Association provides the following comments on the various proposed rules in the NPRM. Although the Association has endeavored to comment on several of the proposed rules in the NPRM, to the extent any proposed rule is not specifically addressed below, such silence should not be construed as support for that proposed rule, nor construed as an indication that such proposed rule is noncontroversial.

I. Comments on USPTO NPRM 0651-AD75: Expanding Opportunities To Appear Before the Patent Trial and Appeal Board

42.10 Counsel.

(a) If a party is represented by counsel, the party must designate a lead counsel and at least one back-up counsel who can conduct business on behalf of the lead counsel, unless good cause is shown. ~~The Board may permit a party to proceed without back-up counsel upon a showing of good cause, subject to the condition that lead counsel be a registered practitioner. A party may show good cause by demonstrating that it lacks the financial resources to retain both lead and backup counsel.~~

The Association does not discern any need to change the USPTO's current rules for the involved parties to each designate at least one lead counsel and at least one back-up counsel. It is important for both the Board and opposing counsel to be able to communicate quickly and effectively with counsel for a party, particularly given the expedited timelines associated with every AIA proceeding. It is also important for the parties to be able to coordinate the many case deadlines, including witness cross-examinations and Board conference calls, within often narrow windows of time, sometimes on a moment's notice. Given the inherent complexity and expense inherent in AIA proceedings, it is not unreasonable to require a represented party to designate at least two practitioners for the Board and opposing counsel to contact. Otherwise, effective and timely communication will likely be frustrated by the inability to contact a single counsel (e.g., because of other case commitments, vacations, unknown whereabouts, etc.). And the availability of counsel to participate in important case events will likely be significantly hindered. Further, allowing designation of a single counsel invites the potential for litigation gamesmanship, allowing one party to effectively dictate the timing of important case events based on that party's sole practitioner's schedule. Accordingly, the present rules provide an appropriate balance between cost-efficient representation and timely and effective communication with designated counsel in the proceedings.

The Association also submits that the requirement for a lead counsel and at least one back-up counsel could expand opportunities for young attorneys and underrepresented members of the legal profession. A study conducted by Professor Jordana Goodman at the BU/MIT Technology Law Clinic at the Boston University School of Law found that the practice of identifying only one practitioner on public-facing legal documents results in misattribution or under-attribution of credit that disparately impacts women and attorneys from disadvantaged communities. Goodman, J., *Ms. Attribution: How Authorship Credit Contributes to the Gender Gap*, 25 Yale J. L. & Tech. 309 (2023). Analyzing practitioner signatures from patent application and office actions, the study ultimately proposes amendments to USPTO procedures and forms, including adding more signatures lines on all patent application paperwork, to facilitate equitable attribution for contributors.

Given the findings of the study, the Association further proposes that the USPTO adopt express guidance encouraging parties to identify all practitioners who have materially contributed to a proceeding in the parties' mandatory notices. While an attribution gap may not have an immediate impact on a junior attorney's current status, the study underscores the collective impact over time. "For example, an attorney will likely have more difficulty acquiring clients, achieving notoriety, and advancing in their career without proper attributions for their work at a firm." *Id.* at 313.

Companies, like Western Digital, have revised their outside counsel guidelines to incorporate the recommendations from the study to ensure that all practitioners receive recognition for their work. *See* Goodman, J. and Truesdale, S., *Double Attribution: Crediting Practitioners*, Innovators Diversity Pilots Conference (Nov. 18, 2022).

(c)(1) *Pro hac vice* recognition of nonregistered practitioners. 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 has an established familiarity with the subject matter at issue in the proceeding that back-up counsel will be a registered practitioner.

The PTAB's current *pro hac vice* rules do not unreasonably restrict any attorney or agent from appearing before the PTAB. To our knowledge, the PTAB routinely grants every *pro hac vice* application as a matter of course, and we are aware of only **very** few instances in which any attorney or agent was denied an opportunity to appear before the PTAB because of the *pro hac vice* rules. *See, e.g.*, IPR2020-00836, Paper 23, and PTAB-IPR2020-00750, Papers 25, 43 (concerns over accuracy of representations made in the application). These limited instances would not hinder broad efforts designed to secure more inclusive pool of practitioners. Further, the PTAB's *pro hac vice* practice mirrors the similar practice in the U.S. district courts, which ensures that attorneys who are not licensed in the presiding court's jurisdiction attest to, *inter alia*, being familiar and complying with the court's rules and procedures.

The Association also does not discern any need to change the USPTO's current requirement that lead counsel be a registered USPTO practitioner. This requirement ensures that the lead attorney or agent for the involved Petitioner, and the lead attorney or agent for the involved Patent Owner, has demonstrated fundamental competence with USPTO practice in general and the ethical obligations incumbent upon all attorneys and agents who practice before the USPTO, and is subject to USPTO discipline. As in the *pro hac vice* practice in U.S. district courts, the USPTO should ensure that the attorney or agent responsible for the case is admitted to practice before that tribunal, and is thus subject to that tribunal's rules, discipline, and sanctions. Congress and the Federal Circuit have determined that a special value is attached to a separate Patent Bar, which has been integral to the USPTO for decades. *E.g., Right of persons to be represented in matters before Federal agencies*, H.R. Rep. No. 1141, 89th Cong., 1st Sess. at 7-9 (1965). The constitutionality of PTAB reviews supports similar representation requirements, at least for the counsel in charge of the representation before the USPTO. *See, e.g., Oil States Energy v. Greene's Energy Group*, 138 S. Ct. 1365, 1374 (2018) (explaining that PTAB "review involves the same basic matter as the grant of a patent."). The USPTO also values and advocates for the importance of a separate Patent Bar, and there has been no suggestion that non-registered practitioners participate as lead counsel in other patent proceedings before the USPTO. The proposed amendment devalues the vital importance of the Patent Bar in arguably the most complex and expensive proceedings before the USPTO, while (as discussed below) the proposed

fundamental changes to USPTO practice provide no substantive benefit for non-registered practitioners.

Some members observed that based on their experience, dropping the requirement that lead counsel be a registered practitioner has the potential unexpected consequence of decreasing the diversity of practitioners appearing as lead counsel in AIA proceedings. This observation is based on the experience of those members and expectations about the types of practitioners who would push to serve as lead counsel if the requirement for being a registered practitioner were eliminated. While there are real and understandable concerns about the lack of diversity of practitioners before the PTAB, these members do not think that those issues would be addressed or helped by dropping this requirement that lead counsel be a registered practitioner. Rather, such concerns are best addressed by, e.g., ensuring the Category A eligibility list for sitting for the patent bar is robust and complete and through the LEAP program.

The Association submits that both the Board and registered practitioners enjoy the benefits of the relative civility and collegiality of proceedings led by members of the Patent Bar. The USPTO should zealously protect the demeanor of that practice as serving the legislative objectives of securing a just and efficient resolution of these proceedings. In particular, the PTAB allows back-up counsel (including *pro hac vice* back-up counsel) to participate in all aspects of the AIA proceeding, including briefing, cross-examinations, teleconferences, and the final hearing. Thus, the designation of a USPTO registered practitioner as “lead counsel” does not unfairly restrict any non-USPTO registered practitioner from appearing before the PTAB in any substantive manner. The PTAB’s “lead counsel” practice mirrors the similar practice in the U.S. district courts for identifying “local counsel,” who is a member of the presiding court’s bar, when other participating counsel are licensed in one or more different jurisdictions. Nor is there any industry recognition that distinguishes between the roles of lead and back-up counsel. Indeed, practitioners are better recognized when a party uses an expansive list of back-up counsel.

Members submit that requiring a lead counsel who is a registered practitioner served as an ethical safeguard that ensures the PTAB remains largely free of abusive litigation tactics. For example, some members noted that certain jurisdictions are more likely to see practitioners allege rules violations for leverage. It is not uncommon in these jurisdictions for practitioners to allege ethics violations and seek fee shifting. These practices can destroy the economics of PTAB practice, thereby undermining the stated objective of securing a just and efficient resolution of these proceedings.

Finally, given the inherently technical subject matter of AIA proceedings, the Association discerns no reason to dispense with the exemplary requirement that the *pro hac vice* applicant attest that he or she “has an established familiarity with the subject matter at issue in the proceeding.” It is imperative that the practitioners who appear before the Board are, at a minimum, “familiar” with the subject matter at issue.

(2) Pro hac vice recognition of PTAB-recognized practitioners. (i) A nonregistered 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. PTAB-recognized practitioners shall be eligible

for **automatic abbreviated** *pro hac vice* admission in subsequent proceedings, as **either lead or back-up counsel**, subject to the following conditions.

As discussed above, the Association does not discern any need to change the USPTO's current requirement that lead counsel be a registered USPTO practitioner. With regard to the subsequent re-admission of a non-registered practitioner in a *different* case via the *pro hac vice* process, the Association submits subsequent re-admissions should not be *automatic*, but the Association agrees that an *abbreviated* re-admission process could potentially provide improved efficiency and minimize delays in the admission of a PTAB-recognized practitioner. At the outset, the burden of seeking admission to the USPTO via the *pro hac vice* process should always be on the requester – the non-registered practitioner requesting that the PTAB allow him or her to appear before the USPTO in this particular matter. The requesting party (not the opposing party) knows all of the relevant facts and reasons underlying the request. Further, a subsequent case may be directed to different subject matter to which the requester has no familiarity. The proposed amended rule flips the burden to the non-requester, which is inconsistent with the PTAB's usual practice and common litigation practice (*i.e.*, a litigant should always request relief from the tribunal, not simply assume the tribunal will automatically grant that relief) and the *pro hac vice* practice before most (if not all) other tribunals, such as for the U.S. district courts. *E.g.*, 37 C.F.R. § 42.20(c) (“*Burden of proof.* The moving party has the burden of proof to establish that it is entitled to the requested relief.”).

In addition, a prior *pro hac vice* admission was, by definition, admission *for that particular case* (literally translated from Latin “for this occasion”) and was not a blanket admission automatically extended to all future cases. Again, as in U.S. district court practice, for each new case in which a non-registered practitioner wishes to appear before the tribunal, that practitioner should make the affirmative request to do so and satisfy that tribunal's *pro hac vice* requirements. This approach is consistent with the USPTO's limited recognition of non-registered practitioners in other patent matters, which emphasizes the determination proceeds on a case-by-case basis. *E.g.*, 37 C.F.R. § 11.9(a) (“Limited recognition under this paragraph shall not extend further than the application or applications specified.”).

(ii) If a party seeks to be represented in a proceeding by a PTAB-recognized practitioner, that party may file an **abbreviated [opposed/unopposed] motion for *pro hac vice* admission of notice of intent to designate** a PTAB-recognized practitioner as **either lead or back-up counsel**. **The title of the motion shall indicate whether the motion is opposed or unopposed**. No fee is required for such a **motion notice**. The **abbreviated motion notice** shall:

(A) Identify a registered practitioner who will serve as **lead counsel co-counsel, and;**

(B) Identify all AIA proceedings in which the PTAB-recognized practitioner has previously been recognized; and

(C) ~~(B)~~ Be accompanied by . . .

The Association submits that the abbreviated *pro hac vice* re-admission process should include a requirement that the PTAB-recognized practitioner provide a list of the AIA proceedings to which he or she has previously been admitted *pro hac vice*. Because the abbreviated re-admission

procedure relies upon previous *pro hac vice* admissions, an identification of those previous admissions, which serve as the predicate for the requested re-admission, should be identified for ease of review by the Board and the non-movant. This information should be readily available to the requester and easy to compile. Thus, providing this information to the Board and to the non-movant should not be burdensome. In contrast, researching and compiling this information would be far more time consuming and burdensome for the Board and the non-movant. Given the short five-day opposition period, having this information provided with the motion would assist both the Board and the non-movant to assess whether any response to the motion would be deemed appropriate.

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

As discussed above, the burden of seeking *pro hac vice* admission to appear before the PTAB should remain on the requester. In the spirit of the proposed amendments (and in conformance with routine practice before the PTAB), the Association suggests that the grant of the motion for *pro hac vice* admission of a PTAB-recognized practitioner may be an administrative grant, *e.g.*, by the effect of these newly proposed PTAB rules. The remaining suggested revisions are simply for the sake of making the two sentences parallel in structure.

II. Conclusion

The Association and its members are committed to improving all aspects of PTAB practice, and we look forward to continuing to work with the Director and the Office to improve PTAB procedures. We appreciate this opportunity to provide feedback on this important issue, and hope that these comments aid in the development of guidelines and/or regulations.

Submitted on behalf of the PTAB Bar Association, by:



Monica Grewal, President