



January 31, 2023

The Honorable Kathi Vidal
Under Secretary of Commerce for Intellectual Property
and Director U.S. Patent and Trademark Office
600 Dulany St.
Alexandria, VA 22314

Via www.regulations.gov

Dear Director Vidal:

Intellectual Property Owners Association submits the following comments and suggestions in response to the USPTO's request for comments (RFC) on "Expanding Opportunities to Appear Before the Patent Trial and Appeal Board," 87 Fed. Reg. 63,047 (Oct. 18, 2022). IPO is an international trade association representing a "big tent" of diverse companies, law firms, service providers and individuals in all industries and fields of technology that own, or are interested in, intellectual property rights. IPO membership includes over 125 companies and spans over 30 countries. IPO advocates for effective and affordable IP ownership rights and offers a wide array of services, including supporting member interests relating to legislative and international issues; analyzing current IP issues; providing information and educational services; supporting and advocating for diversity, equity, and inclusion in IP and innovation; and disseminating information to the public on the importance of IP rights.

IPO's vision is the global acceleration of innovation, creativity, and investment necessary to improve lives. The Board of Directors has adopted a strategic objective to foster diverse engagement in the innovation ecosystem and to integrate diversity, equity, and inclusion in all its work to complement IPO's mission of promoting high quality and enforceable IP rights and predictable legal systems for all industries and technologies.

We appreciate the USPTO's willingness to engage with stakeholders on various aspects of its policy and operations. Responses to the questions posed in the RFC are set forth below. We offer this input with the aim of ensuring quality representation in PTAB proceedings under the Leahy-Smith America Invents Act (AIA) without creating undue restrictions or barriers to entry for practitioners.

1. Are there any changes to PTAB rules or procedures that the Office or the PTAB should make to increase opportunities to appear and/or serve as counsel and/or the lead counsel in AIA proceedings, such as any discussed in Requests 1-3 above?

IPO recommends continuing to require that pro hac vice motions be filed in accordance with the "Order Authorizing Motion for Pro Hac Vice Admission" in Unified Patents, Inc. v. Parallel Iron, LLC, IPR2013-00639, Paper 7 (PTAB Oct. 15, 2013) (the Unified Patents Order) but changing the rules to allow a non-registered practitioner to be lead counsel as long as at least one back-up counsel is a registered practitioner.

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Current *pro hac vice* admissions practice meets the needs of most, if not all, participants in proceedings before the PTAB. The requirements of good cause and fitness provide a good balance between opportunity to practice and quality of representation. The required affidavit provides the PTAB with a sufficient understanding of prior conduct, ability, knowledge, and jurisdiction over practitioners, ensuring that parties have appropriate representation.

**1.1. If you answered “yes” to question 1 as to the lead counsel, should the rules require that a non-registered practitioner have prior experience in AIA proceedings and/or have completed training before being designated as the lead counsel? What level of experience and/or type of training should be required?**

There is no need to provide an additional level of experience or training beyond that required to demonstrate good cause for *pro hac vice* admission, provided that a registered practitioner is counsel of record. A level of experience requirement would further limit, not expand, the opportunity for practitioners to gain the experience before the PTAB.

**2. Should any rule or procedure revised by the Office that permits a non-registered practitioner to be designated as the lead counsel in an AIA proceeding also require that any such non-registered practitioner be accompanied by a registered practitioner as back-up counsel? If not, are there any circumstances or events that might occur during the course of an AIA proceeding (e.g., the contemplated or actual filing of a motion to amend) that might warrant requiring a registered practitioner to then appear as back-up counsel?**

Yes. The USPTO should require at least one registered practitioner to be among the counsels of record for each party. This will ensure that the team understands USPTO practice beyond the Office Patent Trial Practice Guide and the Board's Rules of Practice for Trials. An understanding of PTAB practices alone is insufficient for quality representation, and a non-registered practitioner may have less familiarity with, for example, issues that may arise in a motion to amend and may not be aware of certain reissue and reexamination options available to a patent owner.

**3. Would a rule requiring that the lead counsel or back-up counsel in an AIA proceeding be a registered practitioner have a significant impact on the costs of such a proceeding? If so, what would the impact be, and would the impact be justified?**

Not necessarily. PTAB rules already require designation of a registered practitioner as lead counsel and at least one back-up counsel. The impact on cost of allowing the registered practitioner to be back-up counsel instead of lead counsel would depend on whether the non-registered practitioner is more or less expensive and whether the work was divided any differently in practice between the two because of the change in “lead” and back-up” designations.

**4. Should any of the changes discussed above, if adopted, be implemented as a pilot program?**

The USPTO may revise the PTAB's rules and procedures to permit a non-registered practitioner who is admitted *pro hac vice* in an AIA proceeding to serve as the lead counsel in that proceeding,

if a registered practitioner is back-up counsel, without a pilot program. But if substantive changes are made to the requirements for admission, a pilot program may be appropriate.

**5. Are there additional training and/or development programs the Office should offer to increase opportunities for less-experienced practitioners to appear as counsel and/or serve as the lead counsel in AIA proceedings?**

Yes. One option may be to create an advocacy course available to any practitioner like the National Trial Advocacy College (a partnership between Virginia Continuing Legal Education and the University of Virginia School of Law). In that program, all participants attend daily live lectures and demonstrations. In addition, each participant is assigned to a small group of lawyers with a similar level of experience that learns and practices advocacy skills under the guidance of a faculty member. The culmination of the program is that participants conduct, as lead counsel, a mock trial typically presided over by an experienced federal or state court judge. At the conclusion of the mock trial, the judge will discuss and critique the trial with the participants.

**6. Are there any changes to LEAP that the Office should make to increase opportunities to appear and/or serve as the lead counsel in AIA proceedings?"**

IPO applauds the USPTO's efforts to offer training and development programs such as LEAP that expand opportunities for practitioners desiring to practice before the PTAB. If a LEAP practitioner is a non-registered practitioner, they will benefit from increased opportunities to serve as lead counsel if the rules are changed, which is appropriate with the requirement that at least one back-up counsel must be a registered practitioner.

To the extent a LEAP practitioner is a non-registered practitioner, they will benefit from increased opportunities to appear and/or serve as lead counsel if the rules are changed to allow non-registered practitioners to serve as lead counsel, as long as at least one back-up counsel is a registered practitioner.

Thank you for considering IPO's comments. As one of the primary organizations representing IP owners, IPO would welcome the opportunity for additional dialogue regarding this important topic.

Sincerely,



Karen Cochran  
President