May 21, 2024

Michael P. Tierney, Vice Chief Administrative Patent Judge
Scott C. Moore, Acting Senior Lead Administrative Patent Judge
U.S. Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

Submitted via: https://www.regulations.gov

Dear Judges Tierney and Moore:

Intellectual Property Owners Association (IPO) appreciates the opportunity to respond to the USPTO’s Notice of ProposedRulemaking (NPRM), published on February 21, 2024, in the Federal Register, concerning Expanding Opportunities To Appear Before the Patent Trial and Appeal Board.

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.

With that background, IPO wishes to thank the Office for its initiative in promulgating regulations intended to reduce restrictions on practitioners authorized to represent clients before the Patent Trial and Appeals Board (PTAB) in post-grant proceedings, including inter partes review. We come to this issue with three primary objectives: (1) to maximize our members’ ability to engage trusted counsel of their choosing, without being unduly burdened by unnecessary limitations on their choice of legal representatives; (2) to expand the pool of practitioners qualified to practice before the PTAB, to facilitate price competition among counsel, and to ensure that the PTAB operates as a lower-cost alternative to district court litigation; while at the same time (3) ensuring that only counsel truly qualified to represent clients in post-grant proceedings are permitted to do so.

We believe that the Office’s NPRM properly balances these considerations. Post-grant review proceedings include some features that are similar to district court or appellate litigation and other features that resemble patent prosecution. As the NPRM recognizes, in the latter category are...
procedures associated with drafting proposed claim amendments. But according to the *PTAB Motion to Amend (MTA) Study*, patent owners file motions to amend in only about 10% of cases. USPTO 3 (Mar. 31, 2023), https://www.uspto.gov/sites/default/files/documents/mta_installment_8_.pdf. In our view, the relative infrequency of motions to amend weighs strongly against over-indexing practitioners’ competence to address such motions when considering minimum qualifications to represent clients before the PTAB. Generally speaking, requiring a PTO registered practitioner to be among the counsel of record—whether as lead counsel or backup counsel—adequately ensures proper representation.

We also believe that, in unusual cases, the requirement to engage a PTO registered practitioner should be relaxed or waived. Under the NPRM, a party may be excused from engaging a backup counsel upon a showing of good cause, such as financial hardship. But the NPRM requires in those cases that lead counsel be a recognized practitioner. IPO believes that, in special circumstances and upon a showing of good cause, the Board should retain flexibility to allow a party to proceed without a registered practitioner. For example, if the challenged patent is expired and cannot be amended, the need for the specialized advice of a registered practitioner may be attenuated. A “good cause” standard should be applied as a high bar that will still provide the Board the flexibility to address circumstances as they arise.

We also agree that the Office should offer expedited procedures to allow for the appearance of PTAB-recognized practitioners, *i.e.*, non-registered practitioners who have previously appeared *pro hac vice*. Such counsel have presumably developed familiarity with the applicable regulations and processes pertaining to post-grant proceedings. Requiring the PTAB to repeatedly scrutinize a *pro hac vice* application for such practitioners, where there is no objection by an opposing party, would be an unfruitful use of the PTAB’s limited resources and would add unnecessary expenses for the parties. We agree with the NPRM’s proposed requirement, however, that a PTAB-recognized practitioner must attest that each of the requirements for *pro hac vice* appearance have been satisfied, especially that the practitioner is familiar with the subject matter of the proceeding.

In sum, we reiterate our appreciation for the Office’s careful consideration of the competing goals of ensuring clients competent representation before the PTAB and maximizing client choice while minimizing expense. We believe the approaches outlined in the NPRM represent a reasonable mechanism for accommodating these valid concerns, and we would suggest increasing the Board’s discretion even further as explained above.

Sincerely,

Krish Gupta
President