Patent Trial and Appeal Board
Boardside Chat: The mechanics of admission to practice before the Board

Kimberly Weinreich, Attorney, Office of Enrollment and Discipline
Steven J. Fulk, Supervisory Patent Attorney, Patent Trial and Appeal Board (PTAB)
June 17, 2021
Question/comment submission

• To send in questions or comments during the webinar, please email:
  – PTABBoardsideChat@uspto.gov
Topics

• Admission to practice before the USPTO
  – Current requirements for patent bar
  – Proposed administrative updates and comments received from the public

• Pro hac vice admission before the PTAB
Admission to practice before the USPTO in patent matters
Requirements for registration

- 37 C.F.R. § 11.7:
  - (a) No individual will be registered to practice before the Office unless he or she has:
    - (1) Applied to the USPTO Director in writing by completing an application for registration form supplied by the OED Director and furnishing all requested information and material; and
    - (2) Established to the satisfaction of the OED Director that he or she:
      - (i) Possesses good moral character and reputation;
      - (ii) Possesses the legal, scientific, and technical qualifications necessary for him or her to render applicants valuable service; and
      - (iii) Is competent to advise and assist patent applicants in the presentation and prosecution of their applications before the Office
First page of application:

- Name, address, phone, **EMAIL**, citizenship
- Whether waiver applies
- Previously applied for admission, passed examination or registered to practice
- Bar membership
Moral character questions
- arrests and charges
- previously disciplined regarding:
  - license
  - education
  - job
  - military discharge
  - delinquent on debt

Education (scientific and technical qualifications)
History of requirements

- **July 31, 1790** - first U.S. patent signed by George Washington; Patent Board/Office located in State Department in NYC

- *Topliff v. Topliff*, 145 U.S. 156, 171 (**1892**) - The Supreme Court noted over 125 years ago that “[t]he specification and claim of a patent, particularly if the invention be at all complicated, constitute one of the most difficult legal instruments to draw with accuracy…”

- **July 1899** - Patent Office Rule 17 required registration of attorneys and patent agents practicing in patent matters before the Office. Attorneys were not required to demonstrate possession of scientific and technical qualifications
History of requirements (cont’d)

- **1912-1915** – The Commissioner of Patents proposed to Congress the creation of a patent bar with a “higher standard of qualifications for registry” and stated “[f]undamentally, knowledge of the invention is more important than knowledge of the rules...”
- **The Patent Act of 1922** – expressly authorized the Commissioner of Patents to prescribe regulations for the recognition of attorneys and agents (now 35 USC § 2(b)(2)(D)).
- **1922-1933** – Rule 17 revised to require all practitioners possess scientific and technical qualifications
- **1933** – Registration examination instituted
The General Requirements Bulletin (GRB)

• Sets forth guidance for complying with 37 CFR § 11.7
• Sets forth three categories which may be used to demonstrate possession of the required technical and scientific training
• If an applicant does not qualify under any of the categories, the USPTO will conduct an independent review for compliance with the scientific and technical training requirement
**GRB**

- **Category A**: bachelor’s degree in a recognized technical subject

<table>
<thead>
<tr>
<th>Biology</th>
<th>Pharmacology</th>
<th>Electrochemical Engineering</th>
</tr>
</thead>
<tbody>
<tr>
<td>Biochemistry</td>
<td>Physics</td>
<td>Engineering Physics</td>
</tr>
<tr>
<td>Botany</td>
<td>Textile Technology</td>
<td>General Engineering</td>
</tr>
<tr>
<td>Computer Science*</td>
<td>Aeronautical Engineering</td>
<td>Geological Engineering</td>
</tr>
<tr>
<td>Electronics Technology</td>
<td>Agricultural Engineering</td>
<td>Industrial Engineering</td>
</tr>
<tr>
<td>Food Technology</td>
<td>Biomedical Engineering</td>
<td>Mechanical Engineering</td>
</tr>
<tr>
<td>General Chemistry</td>
<td>Ceramic Engineering</td>
<td>Metallurgical Engineering</td>
</tr>
<tr>
<td>Marine Technology</td>
<td>Chemical Engineering</td>
<td>Mining Engineering</td>
</tr>
<tr>
<td>Microbiology</td>
<td>Civil Engineering</td>
<td>Nuclear Engineering</td>
</tr>
<tr>
<td>Molecular Biology</td>
<td>Computer Engineering</td>
<td>Petroleum Engineering</td>
</tr>
<tr>
<td>Organic Chemistry</td>
<td>Electrical Engineering</td>
<td></td>
</tr>
</tbody>
</table>

*Acceptable Computer Science degrees must be accredited by the Computer Science Accreditation Commission (CSAC) of the Computing Sciences Accreditation Board (CSAB), or by the Computing Accreditation Commission (CAC) of the Accreditation Board for Engineering and Technology (ABET), on or before the date the degree was awarded. Computer science degrees that are accredited may be found on the Internet (http://www.abet.org).*
• **Category B**: bachelor’s degree in another subject:
  – must show equivalence to Category A by fulfilling requirements of Options 1-4, other training or other education
  
  • **Option 1**: 24 semester hours in physics
  • **Option 2**: 32 semester hours (8 chemistry or physics; 24 biology, botany, microbiology, or molecular biology)
  • **Option 3**: 30 semester hours in chemistry
  • **Option 4**: 40 semester hours (8 chemistry or physics; 32 chemistry, physics, biology, botany, microbiology, molecular biology, or engineering)
GRB

• **Category C**: practical engineering or scientific experience
  
  – Take and pass the Fundamentals of Engineering Test administered by a State Board of Engineering Examiners
Becoming a patent practitioner webpage

Request for comments–proposed administrative updates to the GRB
Request for comments
86 FR 15467

• Administrative Updates to the General Requirements Bulletin for Admission to the Examination for Registration To Practice in Patent Cases Before the United States Patent and Trademark Office

• Proposal 1: expand the list of Category A degrees to expressly include the following degrees that are routinely accepted:
  – aerospace engineering, bioengineering, biological science, biophysics, electronics engineering, genetic engineering, genetics, marine engineering, materials engineering, materials science, neuroscience, ocean engineering, and textile engineering
• **Proposal 2:** Accept master’s or doctoral degrees in a Category A subject

• **Proposal 3:**
  - revising Category B, Option 4 by changing “8 semester hours in chemistry or 8 semester hours of physics ... obtained in two sequential courses, each containing a lab” to “eight semester hours in a combination of chemistry, physics, and/or biology, with at least one course including a lab.”
  - revising Category B, Option 2, which already requires training in biology, would be revised to require at least “eight semester hours in a combination of chemistry and physics, with at least one course including a lab.”
Request for comments
86 FR 15467

• Comments were due by May 24, 2021
• We received about 32 comments. Some were signed by multiple individuals and/or entities
  – 32 individuals, 7 organizations, 1 law firm, 20 universities, 2 corporations
  – overall, the comments were supportive of the proposals
Request for comments
86 FR 15467

• Next steps:
  – Review and analyze comments
    • Consider additional suggested degrees for Category A
    • Master’s degree requirements
  – Based on proposals and comments, decide whether to adopt each of the proposals
  – If the decision is to adopt any of the proposals, revise the GRB and implement updates for enrollment team
Question/comment submission

• To send in questions or comments during the webinar, please email:
  – PTABBoardsideChat@uspto.gov
Fast-track pilot programs

Fast-Track Appeals Pilot Program

• Pilot program to expedite ex parte appeals before the PTAB
• Appellant can request appeal be expedited out of turn by filing a petition and a fee
• Learn more about the Fast-Track Appeals Pilot Program at: www.uspto.gov/patents/ptab/fast-track-appeals-pilot-program

Fast-Track Pilot Program for Appeals Related to COVID-19

• Pilot program to expedite ex parte appeals related to COVID-19 before the PTAB
• Appellant can request appeal be expedited out of turn by filing a petition WITHOUT a fee
• Learn more about the Fast-Track Pilot Program for Appeals Related to COVID-19 at: www.uspto.gov/patents/patent-trial-and-appeal-board/covid-fast-track-appeals-pilot-program
Appearing *pro hac vice* at the PTAB: best practices for being admitted

Steven J. Fulk, Supervisory Patent Attorney, PTAB
Admission *pro hac vice* at the PTAB

- *Pro hac vice* (PHV) motions allow non-registered attorneys to represent parties during trial proceedings
- FY2021 first half statistics
  - Nearly 700 trial petitions filed
  - Over 450 PHV motions in ~300 trial proceedings
  - Over 160 PHV attorneys admitted
Agenda

• Process for filing PHV motion
  – Authorization and timing
  – Documents needed
  – Fees

• Requirements for admission
  – Content of documents
  – Examples of denied motions
Trial practice before the PTAB

• 37 C.F.R. § 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.
  – (c) The Board may recognize counsel *pro hac vice* during a proceeding *upon a showing of good cause*, subject to the condition that *lead counsel be a registered practitioner* and to *any other conditions* as the Board may impose.

Filing a PHV motion – authorization

- Authorization to file PHV motion given in Notice of Filing Date Accorded to Petition

The parties are advised that under 37 C.F.R. § 42.10(c), recognition of counsel pro hac vice requires a showing of good cause. The parties are authorized to file motions for pro hac vice admission under 37 C.F.R. § 42.10(c). Such motions shall be filed in accordance with the “Order -- Authorizing Motion for Pro Hac Vice Admission” in Case IPR2013-00639, Paper 7, a copy of which is available on the Board Web site.

Filing a PHV motion – timing

- **Unified Patents** specifies time for filing PHV motion – no sooner than 21 days after service of the petition
- Opposition to PHV motion due within one week of motion filing date
- Notify Board if a deposition is occurring shortly after PHV motion is filed

³ Contact trials staff at [Trials@uspto.gov](mailto:Trials@uspto.gov) or 571-272-7822
Filing a PHV motion – documents

- Motion showing good cause
- Affidavit or declaration attesting to *Unified Patents* criteria – filed as an exhibit per § 42.63
- Power of attorney per § 42.10(b)
- Mandatory notices per § 42.8
Filing a PHV motion – fees

- Non-registered practitioner fee of $250, per attorney and per trial\(^4\)
- Once motion is granted, the counsel is admitted for the entire duration of a proceeding


Current USPTO fee schedule available at [https://www.uspto.gov/learning-and-resources/fees-and-payment](https://www.uspto.gov/learning-and-resources/fees-and-payment); 37 C.F.R. § 42.15 - Fees
Requirements for admission PHV

- § 42.10(c) – Showing of good cause and “any other conditions” as the Board may impose

- **Unified Patents**
  - Motion containing a statement of facts showing there is good cause for admission
  - Affidavit or declaration attesting to eight criteria, or explanation of circumstances
PHV motion requirements

• Statement of facts showing “good cause”
  – Counsel is an experienced litigation attorney
  – Has an established familiarity with the subject matter at issue in the proceeding

• Example - Motion denied
  – Attorney stated *general* technical expertise, but did not attest to any familiarity with the *specific* subject matter at issue in the proceeding, e.g., the patent, prior art, etc.
Affidavit or declaration requirements

- § 42.2 – **Affidavit** means affidavit or declaration under § 1.68 . . . [or] a declaration under 28 U.S.C. § 1746
  - Affidavit, § 1.66 – oath and official seal
  - Declaration, § 1.68 – willful false statements punishable by fine/imprisonment
  - Declaration, 28 U.S.C. § 1746 – under penalty of perjury
Affidavit or declaration requirements

• Examples - Motions denied
  – Affidavit with no official seal, no statement regarding penalties
  – Declaration without either § 1.68 or 28 U.S.C. § 1746 statements and signature
Affidavit or declaration requirements

• *Unified Patents* criteria (i-iv)
  
i. Membership in good standing of the Bar of at least one State or the District of Columbia;

ii. No suspensions or disbarments from practice before any court or administrative body;

iii. No application for admission to practice before any court or administrative body ever denied;

iv. No sanctions or contempt citations imposed by any court or administrative body;
Affidavit or declaration requirements

• Examples - Motions denied
  – Bar membership had lapsed for failure to pay dues
  – Failure to disclose prior sanction imposed by state bar
Affidavit or declaration requirements

- *Unified Patents* criteria (v and vi)
  
  v. The individual seeking to appear has read and will comply with the Office Patent Trial Practice Guide and the Board’s Rules of Practice for Trials set forth in part 42 of 37 C.F.R.;

  vi. The individual will be subject to the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 et. seq. and disciplinary jurisdiction under 37 C.F.R. § 11.19(a);
Affidavit or declaration requirements

- **Unified Patents criteria (vii and viii)**
  
  vii. All other proceedings before the Office for which the individual has applied to appear *pro hac vice* in the last three (3) years; and
  
  viii. Familiarity with the subject matter at issue in the proceeding

- **Example - Motion denied**
  
  - Failure to list all appearances in last 3 years
Pro hac vice – best practices checklist

☐ File PHV motion as paper
  ☐ Filed by registered counsel of record
  ☐ Includes “good cause” statement – litigation experience and specific familiarity with subject matter/record (§ 42.10(c); Unified Patents Order)

☐ File affidavit or declaration as exhibit
  ☐ Properly executed/signed per § 42.2
  ☐ Includes statements attesting to items i-viii of Unified Patents Order, or explanation of circumstances

☐ Pay proper fee
  ☐ $250 per attorney, per proceeding
  ☐ E2E system links to PTO Financial Manager website – return to E2E after payment and submit documents

☐ Update power of attorney (§ 42.10(b)) and mandatory notices (§ 42.8)

➢ Contact Trials Staff with any questions: trials@uspto.gov or 571-272-7822
Filing a PHV motion – E2E system
Filing a PHV motion – E2E system

Motion Request For AIA Review No: IPR2021 -00XXX

5 https://ptab.uspto.gov
Filing a PHV motion – E2E system

Motion Documents

- **Type**: Paper
- **Name**: Pro Hac Vice admission request for Mr. Counsel
- **Attach a document**: Choose File | No file chosen
- **Availability**: Available for everyone

The $250 admission fee is per attorney per case filing a PHV. If the motion seeks PHV admission for more than one attorney, please indicate the number of attorneys in the “Quantity” field below.

<table>
<thead>
<tr>
<th>Quantity</th>
<th>Type of Fee</th>
<th>Unit Cost</th>
<th>Subtotal</th>
</tr>
</thead>
<tbody>
<tr>
<td>1</td>
<td>Pro Hac Vice admission fee</td>
<td>$250.00</td>
<td>$250.00</td>
</tr>
</tbody>
</table>

Pay
Filing a PHV motion – E2E system

The $250 admission fee is per attorney per case filing a PHV. If the motion seeks PHV admission for more than one attorney, please indicate the number of attorneys in the "Quantity" field below.

<table>
<thead>
<tr>
<th>Quantity</th>
<th>Type of Fee</th>
<th>Unit Cost</th>
<th>Subtotal</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>Pro Hac Vice admission fee</td>
<td>$250.00</td>
<td>$500.00</td>
</tr>
</tbody>
</table>

<table>
<thead>
<tr>
<th>Paper#</th>
<th>Filing Date</th>
<th>Type</th>
<th>Paper Type</th>
<th>Title</th>
<th>Pages</th>
<th>Filing Party</th>
<th>Availability</th>
<th>Actions</th>
</tr>
</thead>
<tbody>
<tr>
<td></td>
<td>04/23/2021</td>
<td>PAPER</td>
<td>Motion</td>
<td>Pro Hac Vice admission request for Mr. Counsel</td>
<td>86</td>
<td>petitioner</td>
<td>PUBLIC</td>
<td></td>
</tr>
</tbody>
</table>

Your Payment Has Been Received for AIA Review IPR2021-00649

To view and submit your motion, click here.
Filing a PHV motion – E2E system

1. The $250 admission fee is per attorney per case filing a PHV. If the motion seeks PHV admission for more than one attorney, please indicate the number of attorneys in the “Quantity” field below.

2. Click “Submit” to complete the filing process.
Question/comment submission

• To send in questions or comments during the webinar, please email:
  – PTABBoardsideChat@uspto.gov
LEAP

- **Legal Experience and Advancement Program (LEAP)**

- Designed to:
  - Aid in development of the next generation of patent practitioners
  - Encourage a diverse group of advocates to develop their skills before the Board

- To qualify, a patent agent or attorney must have:
  - Three or fewer substantive oral arguments in any federal tribunal, including PTAB, and
  - Seven or fewer years of experience as a licensed attorney or agent
Next Boardside Chat

• July 15, 2021, at 12-1 p.m. ET
• Topic: RCE versus Appeal
• Register for and learn about upcoming Boardside Chats and access past Boardside Chats at: www.uspto.gov/patents/ptab/ptab-boardside-chats