Patent Trial and Appeal Board
Boardside Chat: The USPTO’s Office of the Solicitor

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October 21, 2021
Question/comment submission

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

• Overview of the USPTO’s Office of the Solicitor
  – Organization and composition of the Office

• Solicitor’s Responsibility
  – Legal advice
  – Appellate and district court litigation
  – Prosecuting practitioners

• Workload Summary and Statistics
Office of the Solicitor
Organization of the USPTO

Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office
Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the United States Patent and Trademark Office

Commissioner for Patents
Commissioner for Trademarks
Patent Trial and Appeal Board
Trademark Trial and Appeal Board

Chief Policy Officer and Director for International Affairs
Chief Administrative Officer
Chief Communications Officer
Chief Financial Officer
Chief Information Officer
Director of EEO and Diversity
General Counsel
Office of the General Counsel

Office of the Solicitor

Office of General Law

Office of Enrollment and Discipline
Composition of the Solicitor’s Office

- 31 attorneys
- ~39% (12/31) were Federal Circuit Clerks
- ~26% (8/31) were clerks in other courts
- ~13% (4/31) were patent examiners
- 4 PhDs (all technical)
- 8 Masters degrees (including 2 LL.Ms)
- 20 technical degrees – BS, MS, and/or PhD in science or engineering, covering relevant fields handled by the USPTO (EE, ME, IE, chemistry, biology, biochemistry, math, molecular biology).
Solicitor’s Responsibility

- **Advise:** Provide legal & policy advice on complex legal/technical issues

- **Litigate:** Represent the agency in federal court and advise DOJ on cases involving intellectual property (patents, trademarks, and copyrights)

- **Prosecute:** Prosecute practitioners who violate USPTO Rules of Professional Conduct (37 C.F.R. § 11.101—11.901)
Legal Advice

• Proposed rules
• Guidelines
  • Indefiniteness
  • Obviousness
  • Patentable Subject Matter
• MPEP revisions
• Legislative & policy questions (internal and external)
District Court Litigation

• “Appeals” from the PTAB and TTAB:
  – 15 U.S.C. § 1071(b) (trademarks)
District Court Litigation

• Challenges to decisions by the Director:
  – 35 U.S.C. § 154 (patent term adjustment)
  – APA actions (e.g., some petition decisions, rules, other agency actions)
Appellate Litigation

• Federal Circuit appeals from the Boards:
  – Approximately 100+/year
  – Patent cases (80-90%)
  – Trademark cases (10-20%)

• Intervention:
  – *Inter partes* reexams and AIA trials

• Appeals from district court cases
Appellate Litigation

• En banc as party
  – recent cases

• En banc participation as amicus
  – recent cases
Types of Cases Handled by the Solicitor’s Office

- Supreme Court, en banc, and other significant government briefs (5-30/yr)
- Interventions in PTAB appeals at the Federal Circuit (50-80/year)
  APA actions (petition decisions, rule challenges, etc.) (5-20/yr)
  District Court review from Boards under §145 (PTAB) and §1071(a) (TTAB) (0-15/yr)
- Direct Federal Circuit appeals from ex parte Board decisions under §141 (PTAB) and §1071(a) (TTAB) (50-100/yr)
  Patent Term Adjustment District Court Actions under §154 (5-10/yr)

Increasing Complexity
United States Court of Appeals for the Federal Circuit

AppealsFiled in Major Origins

FY 11 FY 12 FY 13 FY 14 FY 15 FY 16 FY 17 FY 18 FY 19 FY 20

District Courts
Court of Federal Claims
Court of Int'l Trade
Court of App for Veterans Claims
Merit Systems Protection Bd
Patent & Trademark Ofc

Notes: Includes reinstated, cross-, and consolidated appeals.
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Supreme Court Cases

• The Solicitor General
  – SG’s Office represents the government in the United States Supreme Court
    • United States v. Arthrex
Supreme Court Cases

• USPTO Involvement
  – As a party
    – *Arthrex* as petitioner
  – As an amicus (in nearly all Supreme Court cases involving IP)
  – Answering a Call for the Views of the Solicitor General (CVSG)
    – *American Axle & Manufacturing, Inc. v. Neapco Holdings LLC*
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SO Workload Summary (FY 2017-FY 2021)
Current Stats

**FY 2020**

- CAFC Ex Parte Appeals: 61
- CAFC Inter-Partes Interventions: 141
- CAFC Rehearing Petitions: 50
- CAFC Inter Partes Monitoring: 469
- District Court Complaints: 16
- Supreme Court Cases: 22
- Disciplinary Complaints Filed with an Administrative Law Judge: 10
- Reciprocal Cases: 8

**FY 2021**

- CAFC Ex Parte Appeals: 46
- CAFC Inter-Partes Interventions: 134
- CAFC Rehearing Petitions: 28
- CAFC Inter Partes Monitoring: 415
- District Court Complaints: 24
- Supreme Court Cases: 26
- Disciplinary Complaints Filed with an Administrative Law Judge: 10
- Reciprocal Cases: 6
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Solicitor’s Office and the PTAB

• Defend Board in ex parte appeals at CAFC or in section 145 actions

• Intervene in AIA appeals
  – On important issues
  – When party drops out
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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

• November 18, 2021, 12-1 p.m. ET
• Topic: Objective indicia of non-obviousness
• Register for and learn about upcoming Boardside Chats and access past Boardside Chats at: www.uspto.gov/patents/ptab/ptab-boardside-chats