



FIRESIDE CHAT AND KEYNOTE



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Patent Trial and Appeals Board
USPTO



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DISCLAIMER

The following presentation reflects the personal opinions of its authors and does not necessarily represent the views of their respective clients, partners, employers or of the U.S. Patent and Trademark Office, the New York Intellectual Property Law Association, the PTAB Committee, or its members.

Additionally, the following content is presented solely for the purposes of discussion and illustration, and does not comprise, nor is to be considered, as legal advice.

USPTO EXTENDS DIRECTOR REVIEW (DR) OPTION TO INSTITUTION DECISIONS, RETIRES THE PRECEDENTIAL OPINION PANEL (POP), AND UPDATES INTERIM DR PROCEDURES

July 24, 2023

Beginning July 24, 2023, the United States Patent and Trademark Office (USPTO) has updated our procedures for the interim Director Review (DR) of Patent Trial and Appeal Board (PTAB) decisions. Updates to the interim DR process include:

- Expanding the process to permit parties to request DR of PTAB decisions on institution in America Invents Act (AIA) proceedings;
- Providing updated guidance as to what types of issues the Director will consider in DR, as well as additional guidance on various topics, such as the initiation of DR at the sole discretion of the Director (sua sponte DR), remands to PTAB for further proceedings, and sanction authority of the Director;
- Providing the Director the option to delegate review to a new independent panel called the Delegated Rehearing Panel (DRP); and
- Creating a new Appeals Review Panel (ARP), which may be convened by the Director sua sponte, to review PTAB ex parte, reexamination, or reissue appeal decisions.

In light of these revisions, PTAB processes have been updated to reflect the retirement of the Precedential Opinion Panel (POP) process.

Director
Review
And
Precedential
Opinion
Panels

USPTO REQUESTS COMMENTS REGARDING MOTION TO AMEND PILOT PROGRAM AND RELATED RULES BEFORE THE PTAB

Motion to Amend Pilot Program

May 23, 2023

The U.S. Patent and Trademark Office (USPTO) announced a **request for comments** (RFC) in the Federal Register seeking public input on the **Motion to Amend (MTA) Pilot Program** and the **rules of practice to allocate the burden of persuasion on motions to amend in trial proceedings before the Patent Trial and Appeal Board** (PTAB) (MTA burden-allocation rules). The MTA Pilot Program provides a standardized framework of MTA procedures that include the option to provide the parties with the Board's preliminary guidance on the merits of the MTA and an additional option for a revised MTA, while reasonably fitting these options within the one-year statutory period from institution to a final written decision.

Specifically, we're seeking public input on whether the MTA Pilot Program procedures should be made permanent, and if so, whether any modifications would be beneficial. We're also inviting input on the practical effects of the MTA burden-allocation rules, and whether modifications to the rules or additional guidance on implementing the rules, would be beneficial. Additionally, we're requesting input on whether the PTAB should have broader authority to raise sua sponte grounds in the MTA process.

USPTO ANNOUNCES ADVANCE NOTICE OF PROPOSED RULEMAKING FOR POTENTIAL PTAB REFORMS

Advanced Notice of Proposed Rulemaking

April 20, 2023

WASHINGTON—To ensure robust and transparent engagement throughout the rulemaking process, the U.S. Patent and Trademark Office (USPTO) today announced an **Advance Notice of Proposed Rulemaking (ANPRM)** seeking public input regarding proposed changes to discretionary institution practices, petition word limits, and settlement practices for America Invents Act (AIA) proceedings before the Patent Trial and Appeal Board (PTAB). The ANPRM allows the public to provide initial feedback on proposals from both the USPTO and the public before the USPTO shapes potential rules in a Notice of Proposed Rulemaking (NPRM).to raise sua sponte grounds in the MTA process.

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Key Areas of the Specific Proposals

Key Area 1: Better ensure our practices align with the USPTO's mission to promote and protect innovation and investment, and with the congressional intent behind the AIA to provide a less expensive alternative to district court litigation to resolve certain patentability issues while also protecting against patentee harassment

Key Area 2: Enhance and build on existing precedent and guidance regarding exercise of Director's discretion to determine whether to institute an AIA proceeding

Key Area 3: Provide threshold definitions that apply to one or more categories of petitions subject to discretionary denials, setting forth criteria used to determine "substantial relationship," "substantial overlap," and "compelling merits"

Key Area 4: Provide procedural enhancements

Key Area 5: Clarify filing requirements for Settlement Agreements

USPTO OPENS OPPORTUNITIES TO PRACTICE BEFORE THE AGENCY BY EVOLVING ADMISSIONS CRITERIA FOR PATENT BAR

May 16, 2023

On October 18, 2022, the United States Patent and Trademark Office (USPTO) published a [Federal Register Notice \(FRN\)](#) requesting public input on whether to modify the scientific and technical criteria for admission to practice in all patent matters. Per the General Requirements Bulletin for Admission to the Examination for Registration to Practice in Patent Cases Before the United States Patent and Trademark Office (GRB), there are three categories of technical and scientific qualifications that typically make applicants eligible to sit for the registration examination in order to practice in all patent matters: (1) Category A for specified bachelor's, master's, or Ph.D. degrees; (2) Category B for other bachelor's, master's, or Ph.D. degrees with technical and scientific training; and (3) Category C for practical engineering or scientific experience.

Based on the comments and support received, the USPTO [published an FRN](#) implementing the suggested changes. These changes include: (1) requiring the USPTO to review certain applicant degrees in Category B every three years to determine whether they should be moved to Category A, (2) making a modification to the accreditation requirement for computer science degrees such that all Bachelor of Science in computer science degrees from an accredited university or college will be accepted under Category A, and (3) providing clarifying instructions to applicants for limited recognition.

<https://www.uspto.gov/subscription-center/2023/uspto-opens-opportunities-practice-agency-evolving-admissions-criteria>

USPTO MOVES FORWARD WITH RULEMAKING TO CREATE A DESIGN PATENT PRACTITIONER BAR

May 15, 2023

On October 18, 2022, the United States Patent and Trademark Office (USPTO) published a [Federal Register Notice](#) requesting public input on the possible creation and implementation of a design patent practitioner bar. Based on the comments and support received, the USPTO will publish a [Notice of Proposed Rulemaking \(NPRM\)](#) on May 16, 2023.

The USPTO is proposing that the criteria for admission to the design patent practitioner bar require that an applicant has a bachelor's, master's, or Ph.D. degree in one of the areas the USPTO considers when hiring design patent examiners (or an equivalent): industrial design, product design, architecture, applied arts, graphic design, fine/studio arts, or art teacher education. In addition to the degree requirements, applicants would have to meet the other requirements to register for the bar, including taking and passing the current registration examination and passing a moral character evaluation.

<https://www.uspto.gov/subscription-center/2023/uspto-moves-forward-rulemaking-create-design-patent-practitioner-bar>

Bar
Admission

LEGAL EXPERIENCE AND ADVANCEMENT PROGRAM (LEAP)

LEAP

As part of its commitment to fostering a strong and vital patent system, the United States Patent and Trademark Office (USPTO) has developed and implemented the Legal Experience and Advancement Program (LEAP). This program provides training and oral advocacy opportunities for less experienced advocates in proceedings before the Patent Trial and Appeal Board (PTAB).

This practical experience helps advocates support and represent their clients' interests more effectively. Additionally, as part of the program, the PTAB may grant up to 15 minutes of additional argument time to each party that chooses to participate, depending on the length of the proceeding and the PTAB's hearing schedule.

See the LEAP brochure, LEAP statistics, and this page for more information about the program. View images from previous LEAP events below.

Eligibility

As of November 18, 2021, the USPTO has removed the requirement that practitioners must have seven or fewer years of experience to qualify for LEAP.

To qualify as a LEAP practitioner, a patent agent or attorney must now have three or fewer substantive oral arguments in any federal tribunal, including the PTAB.

Pro bono arguments (including PTAB pro bono arguments) do not count toward a practitioner's limit of three or fewer substantive oral arguments. Practitioners with questions about LEAP eligibility may seek guidance by emailing LEAP@uspto.gov.

FAST-TRACK APPEALS PILOT PROGRAM (REGULAR)

Petitions received in this quarter : 5

Available slots in this quarter: 120

Average time to decide petition: 3.8 days

Average time to decision on appeal: 2.45 months

Need an expedited decision on your appeal? Use the Fast-Track Appeals Pilot Program.

What is the Fast-Track Appeals Pilot Program?

Under the Fast-Track Appeals Pilot Program, appellants can have their ex parte appeals advanced out of turn. Appellants simply file a petition to request fast-track review of their ex parte appeal and pay a \$420 petition fee. The Patent Trial and Appeal Board (PTAB or Board) has set a target of issuing a decision within six months from the date the petition is granted and the ex parte appeal is entered into the pilot program.

The Fast-Track Appeals Pilot Program became effective on July 2, 2020. This pilot program was extended and now will run until July 2, 2024.

Read the [Federal Register Notice here](#).

Read the [extension Federal Registry Notice here](#).

Fast-Track
Appeals

ARTIFICIAL INTELLIGENCE

The USPTO is focused on incentivizing more innovation, inclusively and in key technology areas such as artificial intelligence (AI) and other emerging technologies (ET) (e.g., quantum computing, synthetic biology, blockchain, precision medicine, and virtual reality), protecting that innovation and bringing it to impact to enhance our country's economic prosperity and national security and to solve world problems.



AI/ET Partnership

The AI/ET Partnership provides an opportunity to bring stakeholders together through a series of engagements to share ideas, feedback, experiences, and insights, and foster opportunities to collaborate on the intersection of IP and AI/ET.

> [Learn more about the AI/ET Partnership](#)



Notices, blogs, and reports

Find our reports, Federal Register Notices (FRNs), USPTO leadership speeches and blogs, and other important information concerning AI IP policy.

> [View latest news and reports](#)



Resources

Discover AI-related patent resources and USPTO engagement with other agencies and IP offices.

> [AI-related patent resources](#)
> [Public sector engagements](#)

Artificial
Intelligence
and other
emerging
technologies

**THANK YOU
FOR JOINING US!**

Please join the
PTAB Committee
to keep up to
date with the
latest activities in
the PTAB
(Zoom Meeting,
third Tuesday of
every month at
4:00 p.m. ET)