

*Before the*  
**United States Patent and Trademark Office**  
Alexandria, VA

*In re*

Expanding Opportunities to Appear Before  
the Patent Trial and Appeal Board

Docket No. PTO-P-2022-0032

**COMMENTS OF  
COMPUTER & COMMUNICATIONS INDUSTRY ASSOCIATION**

The Computer & Communications Industry (CCIA)<sup>1</sup> submits the following comments in response to the U.S. Patent and Trademark Office’s October 18, 2022, Request for Comments.<sup>2</sup>

CCIA is an international, not-for-profit trade association representing a broad cross section of communications and technology firms. For more than fifty years, CCIA has promoted open markets, open systems, and open networks. CCIA members employ more than 1.6 million workers, invest more than \$100 billion in research and development, and contribute trillions of dollars in productivity to the global economy.

CCIA members are at the forefront of research and development in technological fields such as artificial intelligence and machine learning<sup>3</sup>, quantum computing<sup>4</sup>, and other computer-related inventions. CCIA members are also active participants in the patent system, holding approximately 5% of all active U.S. patents and significant patent holdings in other jurisdictions such as the EU and China. CCIA members also actively utilize the PTAB, including for *inter partes* reviews and for appeals of their own patent applications. Our members believe that increasing opportunities for participation before the PTAB will lead to a more efficient, more effective system for second-look review of patents.

**I. Summary**

CCIA supports the Office’s efforts to expand participation in AIA proceedings. In order to best serve this goal, CCIA believes that the technical degree requirement for the patent bar should be eliminated entirely, as addressed in more detail in our comments filed today in Dkt. No. PTO-P-2022-0027. While CCIA supports eliminating the technical degree requirement, we believe that registration and examination should generally remain required. This would eliminate the major hurdle to participation, as well as having other beneficial impacts.

---

<sup>1</sup> A list of CCIA members is available online at <https://www.ccianet.org/about/members>.

<sup>2</sup> Request for Comments on Expanding Opportunities to Appear Before the Patent Trial and Appeal Board, 87 Fed. Reg. 63047 (Oct. 18, 2022) (hereinafter “Request”).

<sup>3</sup> USPTO, *Inventing AI*, Fig. 6 (Oct. 2020), <https://www.uspto.gov/sites/default/files/documents/OCE-DH-AI.pdf>.

<sup>4</sup> See Elliott Mason, *Trends in quantum computing patents* (May 24, 2021), <https://quantumconsortium.org/blog/trends-in-quantum-computing-patents/>.

Even if the Office does not entirely eliminate the technical degree requirement, CCIA suggests that the Office establish a separate PTAB practitioner registry, open to any attorney who meets the fitness-to-practice standards. Such a registry would open up access to the PTAB while still providing a simple mechanism for the Office to manage access to AIA proceedings.

Beyond this, CCIA suggests that while prior experience may be valuable, a prior experience requirement is likely to reinforce existing structural inequalities and limit actual expansion of the practitioner pool. Similarly, while training might be helpful and the USPTO should provide training materials to any interested practitioner, a training requirement is unlikely to be helpful and would serve solely to drive up costs.

Finally, CCIA notes that the general trend with regards to occupation licensing is that such licensing increases costs without any concomitant increase in quality. There is no reason to believe that the current system of limiting practitioner access to AIA proceedings is any different from that general trend. Accordingly, eliminating the technical degree requirement for attorneys or otherwise opening up AIA practice to a wider set of practitioners would likely reduce the cost to stakeholders of AIA proceedings while not harming practitioner quality.

## **II. Should The Office Change Its Rules To Expand Opportunities To Serve As Counsel In AIA Proceedings?**

CCIA suggests, in response to the Request's first question, that significant changes to the PTAB rules would be appropriate in order to expand access. In particular, CCIA proposes that appearing before the PTAB should generally be available to any attorney, regardless of whether they qualify for patent bar admission.

### *A. The Technical Degree Requirement Serves Little Purpose*

As CCIA noted in its comments on expanding eligibility for the patent bar, also submitted today, the technical degree requirement is of questionable merit. The possession of a degree in electrical engineering or in textile engineering qualifies a practitioner to defend a pharmaceutical patent (and vice versa), while possession of a degree in the history of pharmaceuticals—a topic of far more potential relevance to the validity of a pharmaceutical patent—would not. More broadly, technical degrees are simply not a helpful requirement for AIA proceedings. As the Supreme Court has acknowledged, these proceedings are “similar to court proceedings”<sup>5</sup> in many ways. Many top-tier patent litigators lack a technical degree. Despite this lack, they are able advocates in patent lawsuits, advised by technical experts as to the scope of the technology, and there is no reason they would not be equally capable in AIA proceedings.

Patent owners and petitioners can be generally trusted to identify appropriate counsel to represent them before the PTAB, even if those counsel are not eligible for the patent bar or lack prior experience. AIA proceedings are estimated to cost a median amount upwards of \$250,000 in legal fees<sup>6</sup>; given the large amount likely to be spent, parties are likely to be sophisticated and to make careful selection of their counsel. The USPTO does not need to put a thumb on the scale as to who may participate.

---

<sup>5</sup> *Cuozzo Speed Techs, LLC v. Lee*, 136 S. Ct. 2131, 2143 (2016).

<sup>6</sup> AIPLA, *Report of the Economic Survey 2021* (2021).

*B. Ensuring USPTO Capability To Manage Access To Its Proceedings*

Although CCIA believes that any attorney should be able to participate, regardless of technical degree, we also acknowledge that the USPTO has an interest in ensuring that attorneys who abuse the system cannot continue to appear before it. The simplest mechanism to achieve this goal would be to eliminate the technical degree requirement, or to add a juris doctorate to the list of approved degrees. If the technical degree requirement were eliminated in this way, then practitioners could simply take the patent bar exam and become registered patent practitioners. This would ensure both that the field of practitioners is not artificially restricted and that practitioners have a basic understanding of patent procedure.

Alternatively, CCIA suggests that, if the Office does not remove the technical degree requirement, the Office of Enrollment and Discipline create a separate registry for PTAB practitioners. This registry would be open to any attorney that meets the fitness to practice standards the Office currently employs, regardless of patent bar status. Attorneys who are not enrolled in this separate PTAB practitioner registry should still be unable to participate in PTAB proceedings, regardless of whether they are admitted to the patent bar.

In either circumstance, practitioners before the PTAB would be subject to the Office's enrollment and discipline proceedings. This would allow the Office to appropriately manage access to its proceedings, while still broadening the field of available practitioners.

*C. Should Prior Experience Be Required For Non-Registered Practitioners?*

No prior experience should be required of practitioners wishing to practice before the PTAB. Patentees and petitioners will select counsel carefully, given the significant costs and risks at stake; if they wish to select counsel they trust who lack PTAB experience, the USPTO should not stand in their way.

Further, requiring prior experience reinforces existing challenges for those who may not be able to easily obtain such experience. Individuals from underrepresented groups are less likely to be recruited to the firms that make up the majority of PTAB practitioners at present. This is not because those individuals are less capable attorneys, but rather represents a legacy of structural biases against those groups. Requiring prior experience will serve to reinforce those structural barriers while not providing any benefit to the Office or to stakeholders.

Accordingly, CCIA suggests that any prior experience requirement would have little to no beneficial effect and would specifically harm underrepresented groups.

*D. Should Non-Registered Practitioners Be Required To Receive Training?*

While training might be helpful to the attorney, it is unclear if such a requirement would really serve much purpose. A responsible attorney will seek out such training on their own, as their professional ethics requires<sup>7</sup>; an irresponsible attorney required to go through training is unlikely to gain much from the training, as they will not seek to learn. Training thus only seems helpful to those who would do it even if not required, making a requirement unnecessary.

With that in mind, the availability of high-quality training materials would certainly be beneficial. CCIA suggests that, particularly bearing in mind resource constraints for the

---

<sup>7</sup> ABA Model Rules of Professional Conduct 1.1, note 4 (“A lawyer may accept representation where the requisite level of competence can be achieved by reasonable preparation.”)

practitioners most likely to take this path, the USPTO should make such training materials available and provide any training free of charge.

### **III. Should Non-Registered Practitioners Be Required To Have A Registered Practitioner As Lead or Back-Up Counsel?**

Again, as noted above, CCIA believes the technical degree requirement for registration should be eliminated entirely. If this were to occur, there would be no need for such a requirement, as any attorney could simply register for and take the exam.

However, assuming the technical degree requirement is maintained, there may be some limited circumstances where a registered practitioner might be helpful. The Request's example of a motion to amend is one such situation. In these situations, it would be appropriate for the Office to recommend, rather than require, that a patent barred practitioner also participate. Clients will be free to take the Office's advice or not, but the recommendation is likely to carry significant weight.

### **IV. Would A Rule Requiring At Least One Registered Practitioner As Counsel In An AIA Proceeding Impact Costs?**

Systems of professional regulation are generally understood to increase costs, often without providing any benefit. As an FTC study found, "occupational licensing frequently increases prices and imposes substantial costs on consumers."<sup>8</sup> The same study also noted that "many occupational licensing restrictions do not appear to realize the goal of increasing the quality of professionals' services."<sup>9</sup> The default assumption would thus be that reducing constraints on who can participate would be likely to reduce costs to stakeholders without harming those stakeholders.

Given that the current system permits non-registered practitioners to be listed as backup counsel *pro hac vice*, it is unlikely that permitting them to be named as lead counsel with a registered practitioner as backup counsel would significantly impact costs in a positive or negative direction. Under the present system, they would be backup counsel under a registered lead counsel; under a system that permits them to be lead counsel, but requires a registered backup counsel, they would simply switch places. This represents minimal change and thus would minimally impact costs.

However, if the requirement that a registered practitioner be listed as counsel was to be eliminated, it would likely reduce the overall costs of AIA proceedings without significantly affecting the quality of those proceedings. A larger pool of practitioners would be able to represent clients at the PTAB, and attorney diligence in self-education, client care in selecting counsel in a high-stakes proceeding, and the USPTO's backstop ability to reject abusive counsel's participation would ensure that the quality of representation would not decline.

Accordingly, CCIA strongly suggests eliminating the registered practitioner requirement.

---

<sup>8</sup> Carolyn Cox and Susan Foster, *The costs and benefits of occupational regulation* (FTC, October 1990), [https://www.ftc.gov/system/files/documents/reports/costs-benefits-occupational-regulation/cox\\_foster\\_-\\_occupational\\_licensing.pdf](https://www.ftc.gov/system/files/documents/reports/costs-benefits-occupational-regulation/cox_foster_-_occupational_licensing.pdf).

<sup>9</sup> *Id.*

## **V. Should Any Of These Changes Be Implemented As A Pilot Program?**

CCIA is generally supportive of the use of pilot programs to provide a controlled experiment for testing the impact of rule changes. However, changes to who may practice before the PTAB do not seem to be a good candidate for a pilot program approach.

First, it is likely to be extremely difficult to design a true pilot program that would provide a meaningful basis for comparison between barred and non-barred practitioners, given the significant individual differences in both cases and attorneys. One non-barred practitioner might be an excellent attorney, but be retained for a weak case, or might be a weak attorney retained for a strong case. These sorts of differences make a true comparison difficult to achieve, particularly given the likely low sample size.

Second, unlike some of the other randomized pilots the PTO has recently operated, this change would be difficult to operate. In particular, limiting the scope of the program would be effectively impossible. Parties want to select their own counsel, and at least on the petitioner's side, they generally do so before the USPTO is involved. If the USPTO program permits anyone who requests to participate to do so, it is not truly a pilot, but rather a rule change that has not gone through rulemaking. It will also not provide adequate basis for comparison. At the same time, if the USPTO pilot program can reject proposed counsel, then petitioners would be unlikely to select unregistered practitioners due to the risk of having their proposed counsel rejected and being forced to identify new counsel.

Given these challenges, CCIA believes that rule changes in this area are not well suited to a pilot program approach.

## **VI. Conclusion**

CCIA thanks the Office for the opportunity to submit these comments. We would be happy to further discuss any aspect of our comments if helpful to the Office.

Respectfully submitted,

Joshua Landau  
Reg. No. 71,491  
Senior Counsel, Innovation Policy  
Computer & Communications Industry Association  
25 Massachusetts Ave NW  
Suite 300C  
Washington, DC 20001  
[jlandau@ccianet.org](mailto:jlandau@ccianet.org)