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LEGAL STATUS

Expanding Opportunities To Appear Before the Patent Trial and Appeal Board

A Proposed Rule by the [Patent and Trademark Office](#) on 02/21/2024

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Written comments must be received on or before May 21, 2024.

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Expanding Opportunities to Appear Before the Patent Trial and Appeal Board

PTO-P-2023-0058 (<https://www.regulations.gov/docket/PTO-P-2023-0058>)

PUBLISHED DOCUMENT

AGENCY:

United States Patent and Trademark Office, Department of Commerce.

ACTION:

Notice of proposed rulemaking.

SUMMARY:

As part of its initiatives to expand access to practice before the U.S. Patent and Trademark Office (USPTO or Office), the USPTO proposes to amend the rules regarding admission to practice before the Patent Trial and Appeal Board (PTAB or Board) in proceedings under the Leahy-Smith America Invents Act (AIA proceedings) to give parties the option to designate non-registered practitioners who are recognized *pro hac vice* (*i.e.*, granted recognition in a specific PTAB proceeding) as lead counsel; excuse parties from the requirement to designate back-up counsel upon a showing of good cause such as a lack of resources to hire two counsel; establish a streamlined alternative procedure for recognizing counsel *pro hac vice* that is available when counsel has previously been recognized *pro hac vice* in a different PTAB proceeding; and clarify that those recognized *pro hac vice* have a duty to inform the Board of subsequent events that render inaccurate or incomplete representations they made to obtain *pro hac vice* recognition.

DATES:

Written comments must be received on or before May 21, 2024.

ADDRESSES:

For reasons of government efficiency, comments must be submitted through the Federal eRulemaking Portal at www.regulations.gov (<http://www.regulations.gov>). To submit comments via the portal, one should enter docket number PTO-P-2023-0058 on the homepage and select “search.” The site will provide search results

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listing all documents associated with this docket. Commenters can find a reference to this proposed rule and select the “Comment” icon, complete the required fields, and enter or attach their comments. Attachments to electronic comments will be accepted in Adobe® portable document format or Microsoft Word® format. Because comments will be made available for public inspection, information that the submitter does not desire to make public, such as an address or phone number, should not be included in the comments.

Visit the Federal eRulemaking Portal for additional instructions on providing comments via the portal. If electronic submission of or access to comments is not feasible due to a lack of access to a computer and/or the internet, please contact the USPTO using the contact information below for special instructions.

FOR FURTHER INFORMATION CONTACT:

Michael P. Tierney, Vice Chief Administrative Patent Judge, or Scott C. Moore, Acting Senior Lead Administrative Patent Judge, at 571-272-9797.

SUPPLEMENTARY INFORMATION:

Background

The Director of the USPTO has statutory authority to require those seeking to practice before the Office to show that they possess “the necessary qualifications to render applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office.” 35 U.S.C. 2(b)(2)(D) (<https://www.govinfo.gov/link/uscode/35/2>). Thus, courts have determined that the USPTO Director bears the primary responsibility for protecting the public from unqualified practitioners. See *Hsuan-Yeh Chang v. Kappos*, 890 F. Supp. 2d 110, 116-17 (D.D.C. 2012) (“Title 35 vests the [Director of the USPTO], not the courts, with the responsibility to protect [US]PTO proceedings from unqualified practitioners.”) (quoting *Premysler v. Lehman*, 71 F.3d 387, 389 (Fed. Cir. 1995)), *aff’d sub nom.*, *Hsuan-Yeh Chang v. Rea*, 530 F. App’x 958 (Fed. Cir. 2013).

Pursuant to that authority and responsibility, the USPTO has promulgated regulations, administered by the Office of Enrollment and Discipline (OED), that provide that registration to practice before the USPTO in patent matters or design patent matters requires a practitioner to demonstrate possession of “the legal, scientific, and technical qualifications necessary for him or her to render applicants valuable service.” 37 CFR 11.7(a)(2)(ii) ([https://www.ecfr.gov/current/title-37/section-11.7#p-11.7\(a\)\(2\)\(ii\)](https://www.ecfr.gov/current/title-37/section-11.7#p-11.7(a)(2)(ii))).^[1] The USPTO determines whether an applicant possesses the legal qualification by administering a registration examination, which applicants must pass before being admitted to practice. See 37 CFR 11.7(b)(ii) ([https://www.ecfr.gov/current/title-37/section-11.7#p-11.7\(b\)\(ii\)](https://www.ecfr.gov/current/title-37/section-11.7#p-11.7(b)(ii))). The USPTO sets forth guidance for establishing possession of scientific and technical qualifications in 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). The GRB is available at www.uspto.gov/sites/default/files/documents/OED_GRB.pdf (http://www.uspto.gov/sites/default/files/documents/OED_GRB.pdf). The GRB also contains the “Application for Registration to Practice before the United States Patent and Trademark Office.”

The rules that currently govern practice before the PTAB in AIA proceedings differ somewhat from the rules that govern other types of USPTO proceedings. In an AIA proceeding, 37 CFR 42.10(a) ([https://www.ecfr.gov/current/title-37/section-42.10#p-42.10\(a\)](https://www.ecfr.gov/current/title-37/section-42.10#p-42.10(a))) requires that each represented party designate a lead counsel and at least one back-up counsel. The regulation requires that the lead counsel be a registered practitioner. The regulation allows non-registered practitioners to be back-up counsel, but only “where the lead counsel is a registered practitioner,” and when “a motion to appear *pro hac vice* by counsel who is not a registered practitioner [is] granted upon showing that counsel is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding.” *Id.*

The Board typically requires that *pro hac vice* motions be filed in accordance with the “Order Authorizing Motion for *Pro Hac Vice* Admission” in *Unified Patents, Inc. v. Parallel Iron, LLC*, IPR2013-00639, Paper 7 (PTAB Oct. 15, 2013) (the *Unified Patents* Order). The *Unified Patents* Order requires that a motion for *pro hac vice* admission must:

- a. Contain a statement of facts showing there is good cause for the Board to recognize counsel *pro hac vice* during the proceeding [; and]
- b. Be accompanied by an affidavit or declaration of the individual seeking to appear attesting to the following:
 - 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;
 - 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 CFR;
 - vi. The individual will be subject to the USPTO Rules of Professional Conduct set forth in 37 CFR 11.101 (<https://www.ecfr.gov/current/title-37/section-11.101>) *et. seq.* and disciplinary jurisdiction under 37 CFR 11.19(a) ([https://www.ecfr.gov/current/title-37/section-11.19#p-11.19\(a\)](https://www.ecfr.gov/current/title-37/section-11.19#p-11.19(a)));
 - vii. All other proceedings before the Office for which the individual has applied to appear *pro hac vice* in the last three years; and
 - viii. Familiarity with the subject matter at issue in the proceeding.

Id. at 3. If the affiant or declarant is unable to provide any of the information requested above or make any of the required statements or representations under oath, the *Unified Patents* Order requires that the individual provide a full explanation of the circumstances as part of the affidavit or declaration. *Id.* at 4.

Proposed Changes

On October 18, 2022, the USPTO published a Request for Comments in which the USPTO requested comments on potential ways to expand opportunities for non-registered practitioners to appear before the Patent Trial and Appeal Board. 87 FR 63047 (/citation/87-FR-63047). The request asked several questions,

including: (1) whether the USPTO should permit non-registered practitioners to appear as lead counsel in AIA proceedings, and if so, whether they should need to be accompanied by a registered practitioner as back-up counsel; (2) whether the USPTO should establish a new procedure by which non-registered practitioners could be admitted to practice before the PTAB; (3) what impact various proposals would have on the cost of representation; and (4) whether any changes should be implemented initially as a pilot program. The Office received nine comments in response to the request. Five comments were in favor of retaining existing limits on non-registered practitioners, while four comments generally supported expanding the ways in which non-registered practitioners can participate in AIA proceedings. During the comment period, the Office received several comments in favor of expanding the ways in which non-registered practitioners can participate in PTAB AIA proceedings, and several comments opposing such changes.

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The comments were split on the issue of whether non-registered practitioners should be permitted to appear as lead counsel. Some of the comments, however, suggested that any potential issues with allowing non-registered practitioners to serve as lead counsel could be ameliorated by requiring that they be accompanied by a registered practitioner as back-up counsel. Most of the comments indicated that the Office should continue to require non-registered practitioners to meet fitness-to-practice standards, but several comments agreed that it might be more efficient and less costly to the parties to establish a separate registry or certification procedure that would permit non-registered practitioners to avoid filing separate *pro hac vice* motions in each individual case. Several commentators indicated that the rule requiring that parties retain both lead and back-up counsel might increase cost, but their comments were split, with some arguing that the additional costs were justified in order to maintain the Office's high standards of representation, and others arguing that the additional costs might adversely impact certain parties. Most of the comments expressed no opinion on whether any changes should be addressed as a pilot program. Of the three commentators that addressed this issue, one favored implementing any changes as a pilot program, one indicated that a pilot program would be unnecessary, and one indicated a pilot program would be unnecessary if we were to permit non-registered practitioners to appear as lead counsel with a registered practitioner as back-up without making other substantive changes to admissions standards.

Therefore, to advance its goal of expanding access to practice before the USPTO while continuing to protect the public from unqualified practitioners, and based on the input from stakeholders and commenters, this proposed rule would retain the requirement that parties be represented by a registered practitioner, but would permit parties to designate a non-registered practitioner as lead counsel and the registered practitioner as back-up counsel. This proposed change would better the chances that teams doing work before the PTAB have the requisite qualifications to engage in all matters before the PTAB, including in quasi-prosecution work such as claim amendments. For instance, the proposed change would help ensure that counsel have the qualifications to advise their clients of all available options before the Office, including the ability of patent owners to amend claims in an issued patent through a reissue application or a request for reexamination before, during, or after an AIA proceeding at the PTAB.^[2]

In order to support individuals, smaller entities and others who may be under-resourced, this proposed rule would permit parties to file a motion to be excused from the requirement of retaining both lead and back-up counsel for good cause including in the event that it lacked the financial resources to retain two counsel.

In order to increase efficiency and reduce unnecessary expenses, this proposed rule would also establish a streamlined procedure for counsel who were previously recognized *pro hac vice* in a PTAB proceeding, minimizing the burden of expense of seeking *pro hac vice* admission in subsequent cases, while still ensuring compliance with fitness-to-practice standards.

All who appear before the Board, including those recognized *pro hac vice*, have a duty of candor and good faith to the Office pursuant to 37 CFR 42.11 (<https://www.ecfr.gov/current/title-37/section-42.11>). In order to provide more specific guidance regarding the obligations of those recognized *pro hac vice*, this proposed rule would clarify that such persons must inform the Board of subsequent developments that render materially incomplete or incorrect information that was provided in connection with a request for *pro hac vice* recognition. For example, notification would be required if a non-registered practitioner admitted *pro hac vice* in a proceeding was subsequently sanctioned, cited for contempt, suspended, disbarred, or denied admission by any court or administrative agency, or if the non-registered practitioner were to no longer qualify as a member in good standing of the Bar of at least one State or the District of Columbia.

The Office intends to proceed with rulemaking, rather than a pilot program, because the Office, based on its experience in conducting AIA proceedings, and having considered the comments received, agrees that a pilot program is not necessary for the successful implementation of the desired change.

The USPTO promulgated a final rule effective January 2, 2024, which advised that “[f]or avoidance of doubt, the USPTO clarifies that the term “registered practitioner,” as used in parts 41 and 42, and the term “USPTO patent practitioner,” as used in § 42.57, encompasses “design patent practitioners,” as defined in § 11.1.” 88 FR 78649 (/citation/88-FR-78649). For clarity, the USPTO reminds the public that § 11.5(b)(2) authorizes design patent practitioners to “draft[] a communication for an interference, derivation, and/or reexamination proceeding, a petition, an appeal to or any other design patent proceeding before the Patent Trial and Appeal Board, or any other design patent proceeding.” *Id.*

Discussion of Proposed Rule Changes

The USPTO proposes to amend § 42.10(a) to provide that upon a showing of good cause, the Board may permit a party to proceed without separate back-up counsel so long as lead counsel is a registered practitioner.

The USPTO proposes to amend § 42.10(c) to provide that a non-registered practitioner admitted *pro hac vice* may serve as either lead or back-up counsel for a party so long as a registered practitioner is also counsel of record for that party, and to provide that a non-registered practitioner who was previously recognized *pro hac vice* in an AIA proceeding and not subsequently denied recognition *pro hac vice* shall be considered a PTAB-recognized practitioner, and shall be eligible for automatic *pro hac vice* admission in subsequent proceedings via a simplified and expedited process that does not require payment of a fee. The amendment would also provide that those recognized *pro hac vice* have a duty to inform the Office of any developments that occur during the course of a proceeding that that might have materially impacted the grant of *pro hac vice* admission had the information been presented at the time of grant.

Rulemaking Requirements

A. Administrative Procedure Act: The changes proposed by this rulemaking involve rules of agency practice and procedure, and/or interpretive rules, and do not require notice-and-comment rulemaking. See *Perez v. Mortg. Bankers Ass'n*, 575 U.S. 92, 97, 101 (2015) (explaining that interpretive rules “advise the public of the agency's construction of the statutes and rules which it administers” and do not require notice and comment when issued or amended); *Cooper Techs. Co. v. Dudas*, 536 F.3d 1330, 1336-37 (Fed. Cir. 2008) (5 U.S.C. 553 (<https://www.govinfo.gov/link/uscode/5/553>), and thus 35 U.S.C. 2(b)(2)(B) (<https://www.govinfo.gov/link/uscode/35/2>), do not require notice-and-comment rulemaking for

“interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice”); and *JEM Broadcasting Co. v. F.C.C.*, 22 F.3d 320, 328 (D.C. Cir. 1994) (explaining that rules are not legislative because they do not “foreclose effective opportunity to make one's case on the merits”).

Nevertheless, the USPTO is publishing this proposed rule for comment to seek the benefit of the public's views on the Office's proposed regulatory changes.

B. Regulatory Flexibility Act: For the reasons set forth in this rulemaking, the Senior Counsel for Regulatory and Legislative Affairs, Office of General Law, of the USPTO, has certified to the Chief Counsel for Advocacy of the Small Business Administration that the changes proposed in this rule will not have a significant economic impact on a substantial number of small entities. See 5 U.S.C. 605(b) (<https://www.govinfo.gov/link/uscode/5/605>).

This proposed rule would permit non-registered practitioners to serve as lead counsel in Board proceedings; permit parties to proceed without back-up counsel upon a showing of good cause; create a new streamlined procedure for admitting counsel *pro hac vice* that is available for counsel who have previously been admitted *pro hac vice* in a different Board proceeding; and clarify that those recognized *pro hac vice* have a duty to inform the Board if the information presented in a request for *pro hac vice* recognition is no longer accurate or complete. These changes would not limit or restrict counsel who meet current eligibility criteria to practice before the Board and would not limit or restrict the ability of parties to designate counsel of their choosing. The USPTO does not collect or maintain statistics on the size status of impacted entities, which would be required to determine the number of small entities that would be affected by the rule. However, the changes in this rule are not expected to have any material impact on otherwise regulated entities because the changes to the regulations are procedural in nature, do not impose any significant new burdens or requirements on parties or counsel, and are designed to reduce the cost and complexity of Board proceedings. Although this proposal includes a new requirement to inform the Board if information submitted in a request for *pro hac vice* recognition is no longer accurate or complete, the number of impacted entities is expected to be very small and any additional cost burden is expected to be minimal. Accordingly, the changes proposed in this rule are expected to be of minimal additional burden to those practicing before the Office.

For the reasons discussed above, this rulemaking will not have a significant economic impact on a substantial number of small entities.

C. Executive Order 12866 (/executive-order/12866) (Regulatory Planning and Review): This rulemaking has been determined to be not significant for purposes of E.O. 12866 (/executive-order/12866) (Sept. 30, 1993), as amended by E.O. 14094 (/executive-order/14094) (Apr. 6, 2023).

D. Executive Order 13563 (/executive-order/13563) (Improving Regulation and Regulatory Review): The Office has complied with Executive Order 13563 (/executive-order/13563) (Jan. 18, 2011). Specifically, and as discussed above, the Office has, to the extent feasible and applicable: (1) made a reasoned determination that the benefits justify the costs of the rule; (2) tailored the rule to impose the least burden on society consistent with obtaining the regulatory objectives; (3) selected a regulatory approach that maximizes net benefits; (4) specified performance objectives; (5) identified and assessed available alternatives; (6) involved the public in an open exchange of information and perspectives among experts in relevant disciplines, affected stakeholders in the private sector, and the public as a whole, and provided online access to the rulemaking docket; (7) attempted to promote coordination, simplification, and harmonization across

Government agencies and identified goals designed to promote innovation; (8) considered approaches that reduce burdens and maintain flexibility and freedom of choice for the public; and (9) ensured the objectivity of scientific and technological information and processes.

E. Executive Order 13132 (/executive-order/13132) (Federalism): This rulemaking pertains strictly to federal agency procedures and does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under E.O. 13132 (/executive-order/13132) (Aug. 4, 1999).

F. Executive Order 13175 (/executive-order/13175) (Tribal Consultation): This rulemaking will not: (1) have substantial direct effects on one or more Indian tribes; (2) impose substantial direct compliance costs on Indian tribal governments; or (3) preempt tribal law. Therefore, a tribal summary impact statement is not required under E.O. 13175 (/executive-order/13175) (Nov. 6, 2000).

G. Executive Order 13211 (/executive-order/13211) (Energy Effects): This rulemaking is not a significant energy action under E.O. 13211 (/executive-order/13211) because this rulemaking is not likely to have a significant adverse effect on the supply, distribution, or use of energy. Therefore, a Statement of Energy Effects is not required under E.O. 13211 (/executive-order/13211) (May 18, 2001).

H. Executive Order 12988 (/executive-order/12988) (Civil Justice Reform): This rulemaking meets applicable standards to minimize litigation, eliminate ambiguity, and reduce burden, as set forth in sections 3(a) and 3(b)(2) of E.O. 12988 (/executive-order/12988) (Feb. 5, 1996).

I. Executive Order 13045 (/executive-order/13045) (Protection of Children): This rulemaking does not concern an environmental risk to health or safety that may disproportionately affect children under E.O. 13045 (/executive-order/13045) (Apr. 21, 1997).

J. Executive Order 12630 (/executive-order/12630) (Taking of Private Property): This rulemaking will not effect a taking of private property or otherwise have taking implications under E.O. 12630 (/executive-order/12630) (Mar. 15, 1988).

K. Congressional Review Act: Under the Congressional Review Act provisions of the Small Business Regulatory Enforcement Fairness Act of 1996 (5 U.S.C. 801 (<https://www.govinfo.gov/link/uscode/5/801>) *et seq.*), prior to issuing any final rule, the USPTO will submit a report containing the final rule and other required information to the U.S. Senate, the U.S. House of Representatives, and the Comptroller General of the Government Accountability Office. The changes in this rulemaking are not expected to result in an annual effect on the economy of \$100 million or more, a major increase in costs or prices, or significant adverse effects on competition, employment, investment, productivity, innovation, or the ability of U.S.-based enterprises to compete with foreign-based enterprises in domestic and export markets. Therefore, this rulemaking is not expected to result in a “major rule” as defined in 5 U.S.C. 804(2) (<https://www.govinfo.gov/link/uscode/5/804>).

L. Unfunded Mandates Reform Act of 1995: The proposed changes in this rulemaking do not involve a Federal intergovernmental mandate that will result in the expenditure by State, local, and tribal governments, in the aggregate, of \$100 million (as adjusted) or more in any one year, or a Federal private sector mandate that will result in the expenditure by the private sector of \$100 million (as adjusted) or more in any one year, and will not significantly or uniquely affect small governments. Therefore, no actions are necessary under the provisions of the Unfunded Mandates Reform Act of 1995. See 2 U.S.C. 1501 (<https://www.govinfo.gov/link/uscode/2/1501>) *et seq.*

M. National Environmental Policy Act of 1969: This rulemaking will not have any effect on the quality of the environment and is thus categorically excluded from review under the National Environmental Policy Act of 1969. See 42 U.S.C. 4321 (<https://www.govinfo.gov/link/uscode/42/4321>) *et seq.* □

N. National Technology Transfer and Advancement Act of 1995: The requirements of section 12(d) of the National Technology Transfer and Advancement Act of 1995 (15 U.S.C. 272 note (<https://www.govinfo.gov/link/uscode/15/272>)) are not applicable because this rulemaking does not contain provisions that involve the use of technical standards.

O. Paperwork Reduction Act of 1995: The Paperwork Reduction Act of 1995 (44 U.S.C. 3501 (<https://www.govinfo.gov/link/uscode/44/3501>) *et seq.*) requires that the Office consider the impact of paperwork and other information collection burdens imposed on the public. This rulemaking involves information collection requirements that are subject to review and approval by the Office of Management and Budget (OMB) under the Paperwork Reduction Act. The collections of information involved in this rulemaking have been reviewed and previously approved by OMB under OMB control numbers 0651-0069 (Patent Review and Derivation Proceedings). Updates to this information collection that result from the Final Rule will be submitted to the OMB as non-substantive change requests.

Notwithstanding any other provision of law, no person is required to respond to, nor shall a person be subject to a penalty for failure to comply with, a collection of information subject to the requirements of the Paperwork Reduction Act, unless that collection of information has a currently valid OMB control number.

P. E-Government Act Compliance: The USPTO is committed to compliance with the E-Government Act to promote the use of the internet and other information technologies, to provide increased opportunities for citizen access to government information and services, and for other purposes.

List of Subjects in 37 CFR Part 42 (<https://www.ecfr.gov/current/title-37/part-42>)

- Administrative practice and procedure
- Inventions and patents
- Lawyers

For the reasons set forth in the preamble, the USPTO proposes to amend 37 CFR part 42 (<https://www.ecfr.gov/current/title-37/part-42>) as follows:

PART 42—TRIAL PRACTICE BEFORE THE PATENT TRIAL AND APPEAL BOARD

1. The authority citation for part 42 continues to read as follows:

Authority: 35 U.S.C. 2(b)(2) (<https://www.govinfo.gov/link/uscode/35/2>), 6 (<https://www.govinfo.gov/link/uscode/35/6>), 21 (<https://www.govinfo.gov/link/uscode/35/21>), 23 (<https://www.govinfo.gov/link/uscode/35/23>), 41 (<https://www.govinfo.gov/link/uscode/35/41>), 135 (<https://www.govinfo.gov/link/uscode/35/135>), 311 (<https://www.govinfo.gov/link/uscode/35/311>), 312 (<https://www.govinfo.gov/link/uscode/35/312>), 316 (<https://www.govinfo.gov/link/uscode/35/316>), 321-326

(<https://www.govinfo.gov/link/uscode/35/321>); Pub. L. 112-29

(<https://www.govinfo.gov/link/plaw/112/public/29>), 125 Stat. 284; and Pub. L. 112-274

(<https://www.govinfo.gov/link/plaw/112/public/274>), 126 Stat. 2456.

2. Amend § 42.10 by revising paragraphs (a) and (c) to read as follows:

§ 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 who can conduct business on behalf of the lead counsel, unless good cause is shown. The Board may permit a party to proceed without back-up counsel upon a showing of good cause, subject to the condition that lead counsel be a registered practitioner. A party may show good cause by demonstrating that it lacks the financial resources to retain both lead and back-up counsel.

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(c)(1) *Pro hac vice recognition of non-registered practitioners.* The Board may recognize counsel who is not a registered practitioner *pro hac vice* during a proceeding, as either lead or back-up counsel, upon a showing of good cause, subject to the condition that at least one other counsel designated to appear on behalf of the party is a registered practitioner, and to any other conditions as the Board may impose. For example, a motion to permit counsel who is not a registered practitioner to appear *pro hac vice* in a proceeding may be granted upon a showing that counsel is an experienced litigating attorney and that back-up counsel will be a registered practitioner.

(2) *Pro hac vice recognition of PTAB-recognized practitioners.* (i) A non-registered practitioner who has been previously recognized *pro hac vice* in a Board proceeding, and who has not subsequently been denied permission to appear *pro hac vice* in a Board proceeding, shall be considered a PTAB-recognized practitioner. PTAB-recognized practitioners shall be eligible for automatic *pro hac vice* admission in subsequent proceedings, as either lead or back-up counsel, subject to the following conditions.

(ii) If a party seeks to be represented in a proceeding by a PTAB-recognized practitioner, that party may file a notice of intent to designate a PTAB-recognized practitioner as either lead or back-up counsel. No fee is required for such a notice. The notice shall:

(A) Identify a registered practitioner who will serve as co-counsel, and

(B) Be accompanied by a certification in the form of a declaration or affidavit, in which the PTAB-recognized practitioner attests to satisfying all requirements set forth by the Board for *pro hac vice* recognition of a PTAB-recognized practitioner, and agrees to be subject to the USPTO Rules of Professional Conduct set forth in §§ 11.101 *et seq.* of this chapter and disciplinary jurisdiction under § 11.19(a) of this chapter.

(iii) Any objection shall be filed within five business days after the filing of the notice. If an objection is not filed within five business days, the PTAB-recognized practitioner shall be deemed admitted *pro hac vice* in that proceeding upon filing of updated mandatory notices identifying that practitioner as counsel of record. If an objection is filed within five business days, unless the Board

orders otherwise within ten business days after the objection is filed, the PTAB-recognized practitioner shall be deemed admitted *pro hac vice* after updated mandatory notices identifying that practitioner as counsel of record are then filed.

(iv) If a PTAB-recognized practitioner is unable to satisfy any of the requirements set forth by the Board, or is unable to make any of the required attestations under oath, this procedure is not available, and *pro hac vice* recognition must instead be sought under the process set forth in paragraph (c)(1) of this section.

(3) *Continuing duty of non-registered practitioners recognized pro hac vice.* For the entire duration of any proceeding in which a non-registered practitioner is recognized *pro hac vice* pursuant to paragraph (c)(1) or (2) of this section, the non-registered practitioner has a continuing duty to notify the Board in writing within five business days if:

(i) The non-registered practitioner is sanctioned, cited for contempt, suspended, disbarred, or denied admission by any court or administrative agency;

(ii) The non-registered practitioner no longer qualifies as a member in good standing of the Bar of at least one State or the District of Columbia; or

(iii) Any other event occurs that renders materially inaccurate or incomplete any representation that was made to the Board in connection with the request for *pro hac vice* recognition, provided, however, that non-registered practitioner is not required to inform the Board of subsequent applications for *pro hac vice* recognition unless such an application is denied.

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Katherine K. Vidal,

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

Footnotes

1. *Legal representation before Federal agencies is generally governed by the provisions of 5 U.S.C. 500* (<https://www.govinfo.gov/link/uscode/5/500>). *However, that statute provides a specific exception for representation in patent matters before the USPTO. 5 U.S.C. 500(e)* (<https://www.govinfo.gov/link/uscode/5/500>). *See 35 U.S.C. 2(b)(2)(D)* (<https://www.govinfo.gov/link/uscode/35/2>) (formerly 35 U.S.C. 31) (<https://www.govinfo.gov/link/uscode/35/31>).

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2. *See 84 FR 16654* (/citation/84-FR-16654), *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding (April 2019)*.

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