

**UNITED STATES
PATENT AND TRADEMARK OFFICE**



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

Thomas Krause, Deputy General Counsel for Intellectual
Property Law and Solicitor, Office of the Solicitor

October 21, 2021

UNITED STATES
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Question/comment submission

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

Topics

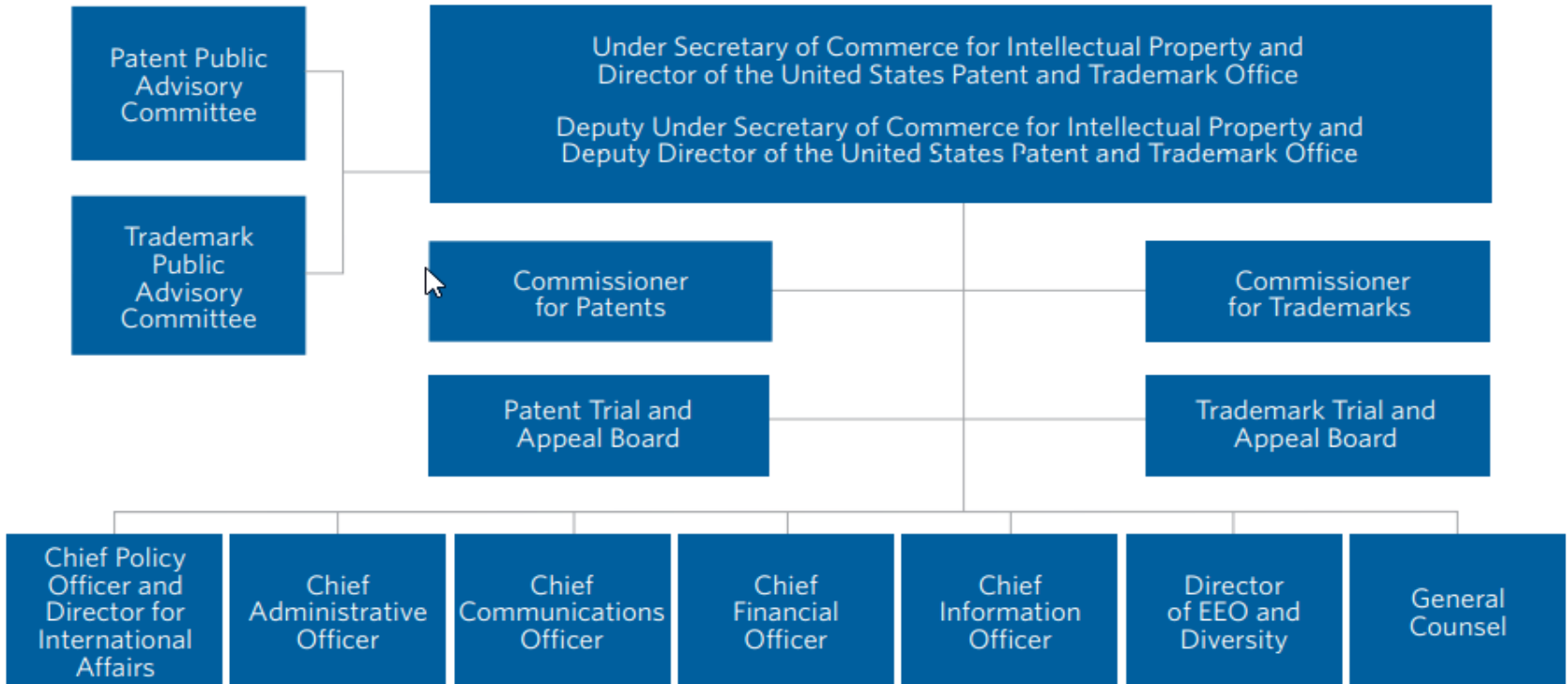
- Overview of the USPTO's Office of the Solicitor
 - Organization and composition of the Office
- Solicitor's Responsibility
 - Legal advice
 - Appellate and district court litigation
 - Prosecuting practitioners
- Workload Summary and Statistics



Thomas Krause, Deputy General Counsel for IP Law and Solicitor, Office of the Solicitor

Office of the Solicitor

Organization of the USPTO



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:
 - 35 U.S.C. § 145 (patents)
 - 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)

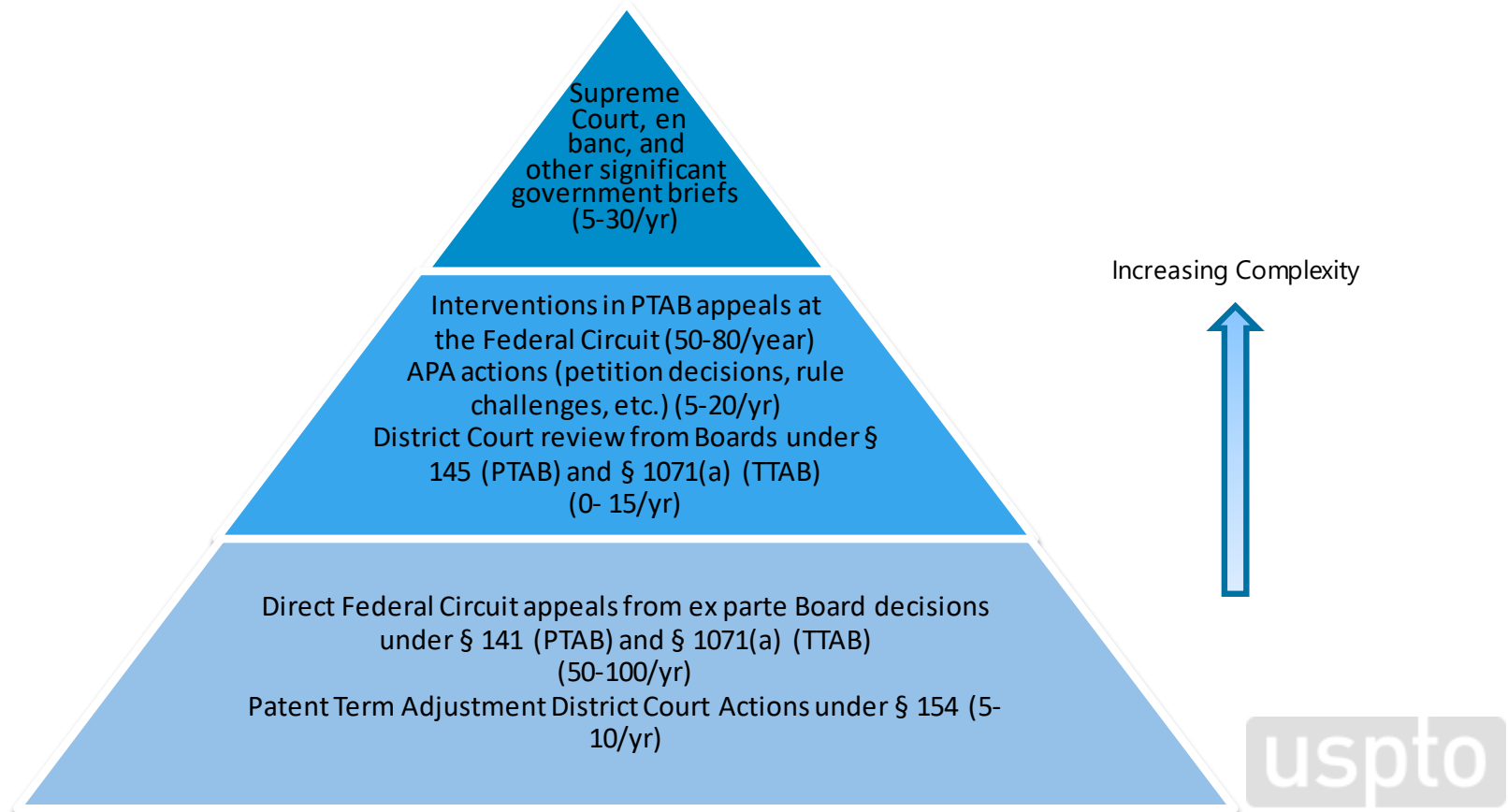
Appellate Litigation

- 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

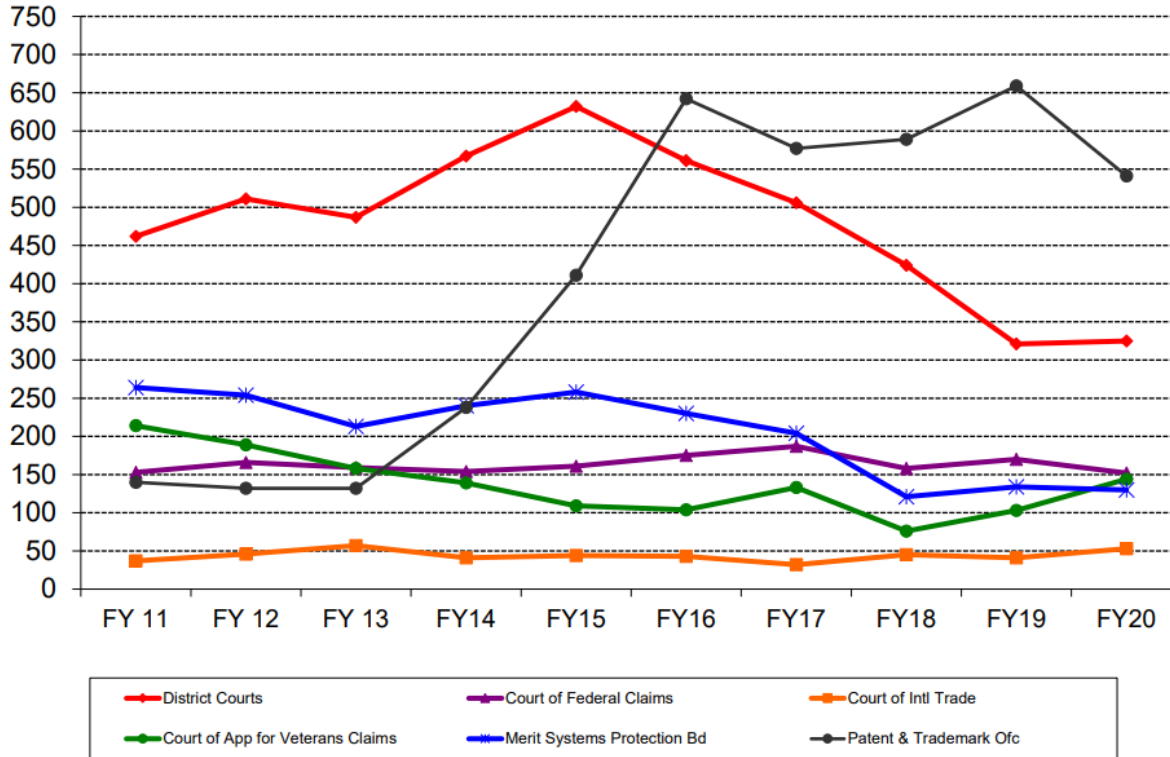
- En banc as party
 - recent cases
- En banc participation as amicus
 - recent cases

Types of Cases Handled by the Solicitor's Office



United States Court of Appeals for the Federal Circuit

Appeals Filed in Major Origins

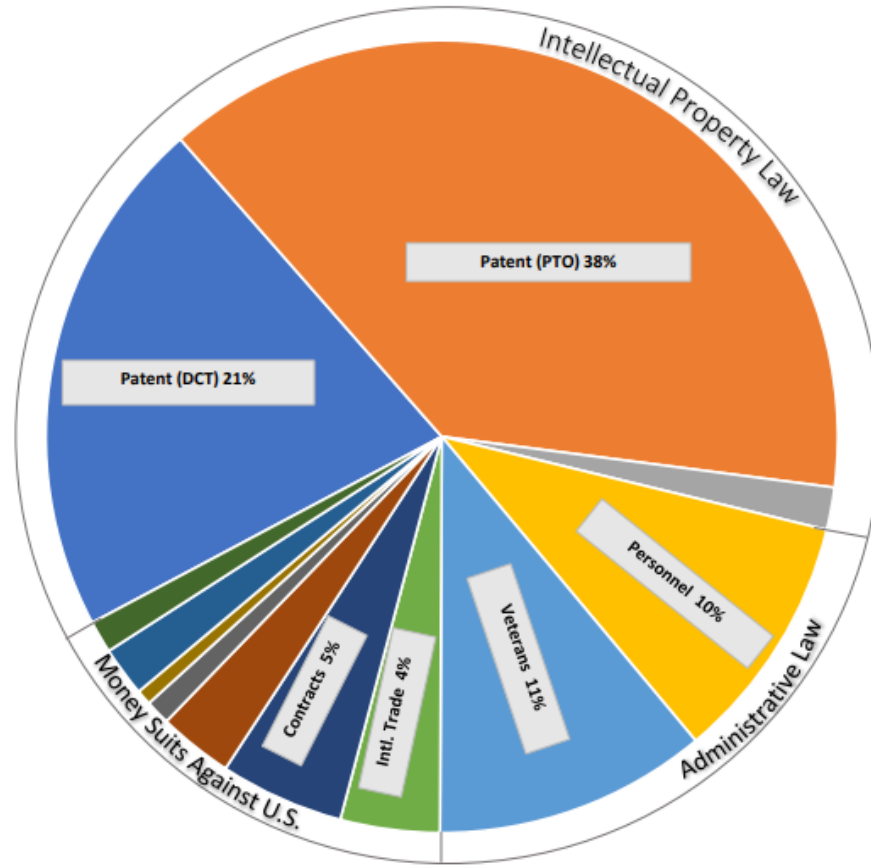


Notes: Includes reinstated, cross-, and consolidated appeals.



United States Court of Appeals for the Federal Circuit

Appeals Filed, by Category
FY 2020



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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*

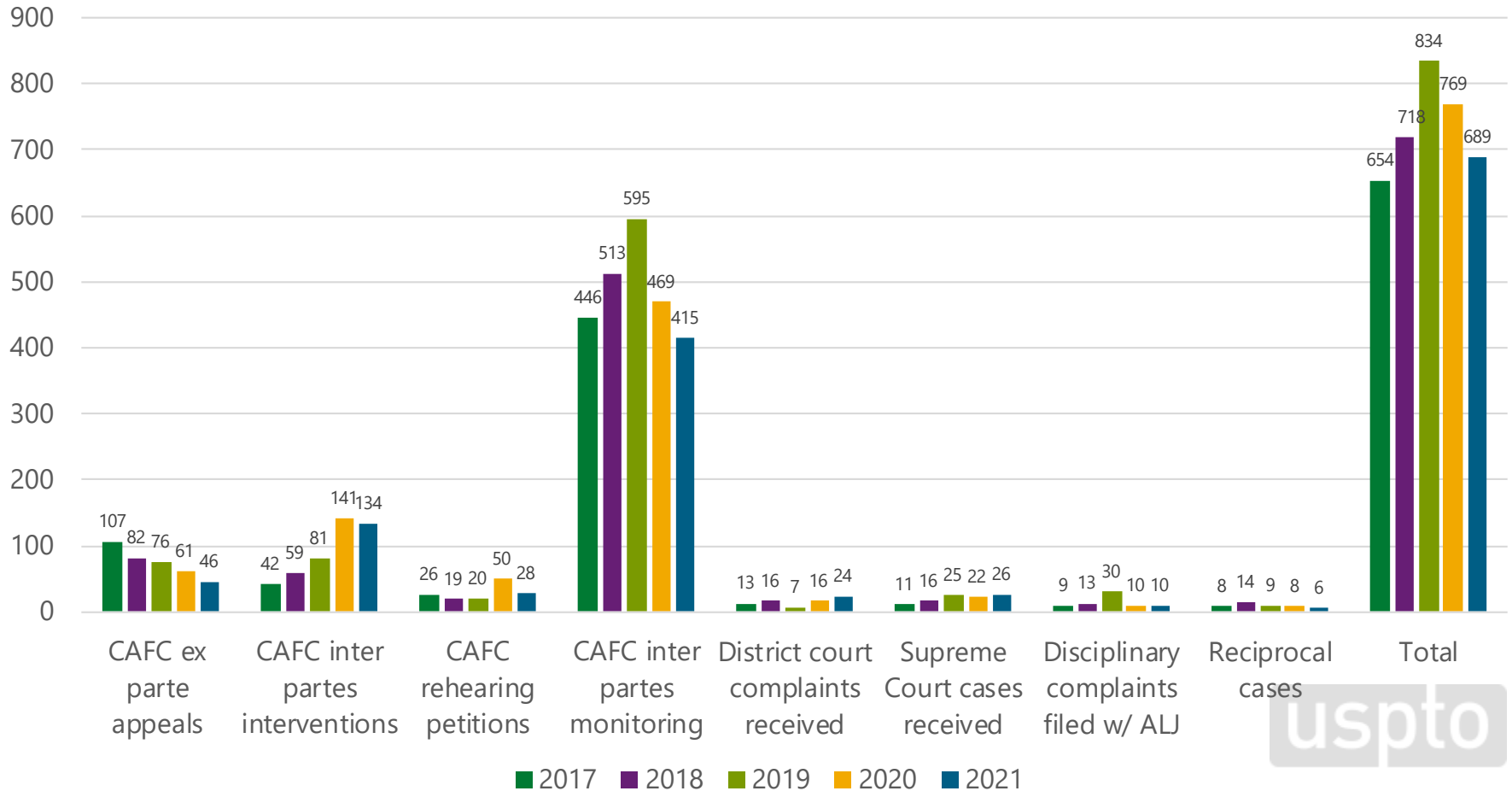
Supreme Court Cases

- 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

