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# Expanding Opportunities To Appear Before the Patent Trial and Appeal Board

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A Rule by the [Patent and Trademark Office](#) on 10/10/2024

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**Agency/Docket Number:** Docket No. PTO-P-2023-0058

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37 CFR Part 42  
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## **AGENCY:**

United States Patent and Trademark Office, Department of Commerce.

## **ACTION:**

Final rule.

## **SUMMARY:**

As part of its initiatives to expand access to practice before the U.S. Patent and Trademark Office (USPTO or Office), the USPTO modifies the rules regarding representation by counsel at the Patent Trial and Appeal Board (PTAB or Board) in proceedings under the Leahy-Smith America Invents Act (AIA proceedings) to: permit parties to proceed without 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:**

This rule is effective November 12, 2024.

## **FOR FURTHER INFORMATION CONTACT:**

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

## **SUPPLEMENTARY INFORMATION:**

## Background

The USPTO is focused on expanding American innovation for and from all and has been examining the rules governing practice before the Office to ensure that they are properly aligned with the types of work performed by practitioners and the needs of clients. As part of this effort, the USPTO recently expanded the admission (□ print page 82173) criteria for patent bar applicants and established a separate design patent bar that is open to applicants who previously would not have been eligible to practice before the Office. See Expanding Admission Criteria for Registration To Practice in Patent Cases Before the United States Patent and Trademark Office, 88 FR 31249 (/citation/88-FR-31249) (May 16, 2023); Representation of Others in Design Patent Matters Before the United States Patent and Trademark Office, 88 FR 78644 (/citation/88-FR-78644) (November 16, 2023). In this final rule, the USPTO updates the rules governing practice before the Board to simplify and streamline the *pro hac vice* admission process and reduce litigation costs while ensuring parties continue to receive high quality representation.

## Rules Regarding Representation by Counsel in AIA Proceedings Prior to This Final Rule

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, 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 [them] 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))).<sup>[1]</sup> 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) ([http://www.uspto.gov/sites/default/files/documents/OED\\_GRB.pdf](http://www.uspto.gov/sites/default/files/documents/OED_GRB.pdf)).

The rules that 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 lead counsel be a registered practitioner. The regulation allows non-registered practitioners to be back-up counsel upon a showing of good cause. For example, “where the lead counsel is a registered practitioner, 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.” 37 CFR 42.10(c) ([https://www.ecfr.gov/current/title-37/section-42.10#p-42.10\(c\)](https://www.ecfr.gov/current/title-37/section-42.10#p-42.10(c))).

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 37 CFR part 42 (<https://www.ecfr.gov/current/title-37/part-42>);
- 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.

## **Development of the Final Rule**

On October 18, 2022, the USPTO published a request for comments in which the Office sought feedback on potential ways to expand opportunities for non-registered practitioners to appear before the PTAB. Expanding Opportunities 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 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 USPTO 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.

The comments were split on the issue of whether non-registered practitioners should be permitted to appear as lead counsel. However, some of the comments suggested that any potential issues with allowing non-registered practitioners to serve as lead counsel could be remedied 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 (□ print page 82174) certification procedure that would permit non-registered practitioners to avoid filing separate *pro hac vice* motions in each individual case. Several comments indicated that the rule requiring that parties retain both lead and back-up counsel might increase cost. Some of these comments asserted that the additional costs were justified to maintain the Office's high standards of representation, and others argued 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 comments that discussed 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 the Office 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.

On February 21, 2024, after careful consideration of the public input received in response to the request for comments, the USPTO published a notice of proposed rulemaking (NPRM). See Expanding Opportunities To Appear Before the Patent Trial and Appeal Board, 89 FR 13017 (/citation/89-FR-13017). The NPRM granted a 90-day comment period and proposed 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 NPRM also proposed to amend § 42.10(c) to provide that (1) 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 (2) 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 the payment of a fee. The NPRM also proposed to amend § 42.10(c) to 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 might have materially impacted the grant of *pro hac vice* admission had the information been presented at the time of grant.

## **Proposed Rule: Comments and Responses**

The USPTO received a total of seven comments from five organizations and two individuals. The Office appreciates the thoughtful comments representing views from various public stakeholder communities. The comments are publicly available at the Federal eRulemaking Portal at [www.regulations.gov/docket/PTO-P-2023-0058](http://www.regulations.gov/docket/PTO-P-2023-0058) (<http://www.regulations.gov/docket/PTO-P-2023-0058>) and are addressed below.

### **Proposed Amendment to § 42.10(a) Permitting Parties To Proceed Without Back-Up Counsel Upon Showing of Good Cause**

Five comments supported the proposal 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. Three of these comments favored the requirement that parties without back-up counsel be represented by a registered practitioner, noting that this requirement is essential to ensure quality representation and protect represented parties. One comment noted that this proposal would allow parties with limited resources to consider participating in AIA trial proceedings, thereby increasing opportunities for attorneys from small law firms and solo practitioners. Another comment suggested that the Board should go further and retain flexibility to allow a party to proceed without a registered practitioner in special circumstances. Yet another commenter supported the proposed amendments to § 42.10(a) but suggested that the requirement to retain a registered practitioner might limit the proposed rule's impact.

One comment opposed the proposed amendment to § 42.10(a), arguing that no need has been shown for such a change, that this proposal might lead to situations in which a single counsel's limited availability frustrates the progress of proceedings, and that allowing

parties to proceed without back-up counsel might limit opportunities for young attorneys and under-represented members of the legal profession.

After considering the input from the comments, the USPTO is moving forward with a final rule providing that, upon a showing of good cause, the Board may permit a party to proceed without separate back-up counsel. For example, good cause may be present if a party demonstrates that it lacks the financial resources to retain both lead and back-up counsel. However, the Office notes that it would likely be difficult for a party to demonstrate a lack of financial resources where that party has also elected to pursue litigation involving the challenged patents in other forums. The Office also notes that the good cause inquiry focuses on the needs of the party seeking relief, not the needs or preferences of counsel. Thus, for example, the fact that lead counsel is a solo practitioner who prefers to work alone would not constitute good cause for a party to proceed without separate back-up counsel.

Based on the comments and the Board's experience, the USPTO believes this rule will permit flexibility in situations in which good cause is shown, while ensuring that parties are represented by counsel having the requisite qualifications to engage in all matters before the PTAB, including in quasi-prosecution work such as claim amendments or reissue applications.<sup>[2]</sup> The Office believes that permitting a represented party to proceed without a registered practitioner as either lead or back-up counsel would create an unacceptable risk that the party would not receive complete advice and guidance. The Office further notes that absent a stipulation of the parties, schedule changes require approval from the Board. The Board also has authority to reconsider prior decisions granting discretionary relief, and could thus revoke permission to proceed without back-up counsel, if appropriate. Therefore, the Board has adequate authority to prevent scheduling considerations from unduly prejudicing a party.

### **Proposed Amendment to § 42.10(c) Permitting Non-Registered Counsel To Serve as Lead Counsel With a Registered Practitioner as Back-Up Counsel**

Three comments supported the proposal to amend § 42.10(c) to permit non-registered counsel admitted *pro hac vice* to serve as lead counsel in AIA proceedings, so long as back-up counsel is a registered practitioner. However, two of these commenters indicated that they were uncertain whether allowing lead and back-up counsel to switch roles would have the desired effect of expanding opportunities at the PTAB.



Three comments opposed this proposal. These comments argued that it is important that lead counsel be qualified to discuss technical matters and quasi-prosecution matters such as claim amendments, that allowing non- ( print page 82175) registered counsel to serve in the lead counsel role would weaken the Office's efforts to protect the public and facilitate robust and reliable intellectual property rights, and that no need has been shown to justify amending this portion of § 42.10(c). These comments also suggested permitting non-registered counsel to serve as lead counsel would devalue the importance of a separate patent bar, increase the likelihood of sharp district court-like litigation tactics, and weaken safeguards against litigation misconduct.

In addition, two comments noted that the proposed rule omitted language in the current rule pertaining to *pro hac vice* applicants having “an established familiarity with the subject matter at issue” in a proceeding. One of these comments suggested adding this language back into the rule, and the second requested clarification regarding whether *pro hac vice* counsel must have technical familiarity with the subject matter of a proceeding, rather than just legal familiarity.

Further, the USPTO notes that it is focused on issuing and maintaining robust and reliable intellectual property rights, including robust and reliable patents resulting from amendments made in PTAB proceedings or amendments made through reissue or reexamination before, during, or after an AIA proceeding.<sup>[3]</sup> Based on the Board's experience, the Office believes that requiring that lead counsel be a registered practitioner will help advance the USPTO's objectives by ensuring that parties are fully briefed on available quasi-prosecution options and have competent counsel to pursue quasi-prosecution amendments.

Based on the input from commenters and the USPTO's experience and objectives, the Office believes that a cautious approach is appropriate and will not move forward at this time with a final rule permitting non-registered counsel admitted *pro hac vice* to serve as lead counsel in AIA proceedings. Instead, the Office plans to explore a pilot project under which non-registered counsel who are admitted *pro hac vice* would be permitted to serve as lead counsel in at least some circumstances. The Office may consider moving forward at a future date with a rule permitting non-registered counsel admitted *pro hac vice* to serve as lead counsel in AIA proceedings, either in a limited or full capacity.

The USPTO further notes that the language in § 42.10(c) pertaining to *pro hac vice* applicants having an established familiarity with the subject matter of a proceeding is used as an example and does not impose a requirement. Nevertheless, in view of the comments, the Office modifies the rule to clarify that this language refers to legal familiarity with the subject matter of a proceeding. This change will resolve the ambiguity noted above by making clear that non-registered counsel need not demonstrate technical familiarity with the subject matter of a proceeding to demonstrate good cause for *pro hac vice* recognition. It also aligns with the new streamlined *pro hac vice* procedures. Though the USPTO expects counsel to likewise have technical familiarity with the subject matter, making technical familiarity a condition of admission would indicate that technical familiarity would have to be established for each new matter.

### **Proposed Amendment to § 42.10(c) Streamlining Pro Hac Vice Admission Practice for Previous Pro Hac Vice Admittees**

Four comments supported the proposal to amend § 42.10(c) to establish a streamlined procedure for *pro hac vice* recognition of counsel who were so recognized in a previous PTAB proceeding without requiring a fee. These comments noted that this proposal would streamline the *pro hac vice* admission process, decrease demands on the Board's scarce resources, and reduce expenses for the parties.

One comment supported streamlining the *pro hac vice* recognition process for counsel who were previously so recognized but argued that recognition for such counsel should not be automatic and that the requestor should still be required to show good cause. One commenter opposed this proposal, arguing that it would result in a single grant of a *pro hac vice* motion effectively granting permission for a non-registered attorney to appear in all future PTAB proceedings.

After considering the input from the commenters, the USPTO is moving forward with a final rule that establishes a streamlined procedure for *pro hac vice* recognition of counsel who were recognized in a previous PTAB proceeding without requiring a fee. Based on the comments and the Board's experience, the Office believes that such a rule will minimize the burden and expense of seeking *pro hac vice* recognition in subsequent cases, while ensuring compliance with fitness-to-practice standards. The Office notes that the proposed rule contains language requiring the party seeking recognition to file a declaration or affidavit affirming that all requirements set forth by the Board for *pro hac vice* recognition are met and gives the opposing counsel an opportunity to object. These

requirements, which are included in this final rule, require the requestor to demonstrate eligibility for *pro hac vice* recognition and ensure that *pro hac vice* recognition is not automatic in situations in which an opposing party contends *pro hac vice* recognition is not appropriate.

### **Proposed Amendment to § 42.10(c) Designating Previous Pro Hac Vice Admittees as “PTAB-Recognized Practitioners”**

The proposed amendment to § 42.10(c) used the term “PTAB-recognized practitioners” to refer to non-registered counsel who were previously recognized *pro hac vice* by the Board. Two comments generally supported using this terminology to refer to counsel who were previously recognized *pro hac vice*. In contrast, two other comments argued that this terminology might lead members of the public to mistakenly believe that PTAB-recognized practitioners are registered practitioners, thereby diluting the importance of the patent bar. One other comment did not have a substantive objection to the term “PTAB-recognized practitioners” but contended that this terminology is inconsistent with the definition of “practitioners” contained in § 11.1. That comment asserted that the definition of “practitioner” in § 11.1 does not encompass non-registered counsel who are admitted *pro hac vice* in Board proceedings. Thus, the commenter argued, § 42.10(c) should not use the term “PTAB-recognized practitioners” to refer to non-registered counsel who are seeking or who were granted *pro hac vice* recognition. That comment noted that the same terminology problem appears in § 42.15(e), which also uses the term “practitioners” to refer to counsel recognized *pro hac vice*. The comment suggested that §§ 42.10(c) and 42.15(e) be revised to use the term “counsel” rather than “practitioner” to refer to non-registered attorneys who are seeking or have been granted *pro hac vice* recognition. The comment further suggested that § 42.15(e), which sets forth the fee for *pro hac vice* recognition, be revised to conform with the new procedure set forth in § 42.10(c)(2) of this rule, which does not require the payment of a fee.

The USPTO notes that the observation in the above-referenced comment with respect to the use of the term “practitioner” in § 11.1 is incorrect in that “practitioner,” as defined by § 11.1, encompasses non-registered counsel (□ print page 82176) who are admitted *pro hac vice* in Board proceedings. Nevertheless, based on the totality of input from commenters, the Office revises the terminology in §§ 42.10(c) and 42.15(e) to avoid using the term “practitioner” so as to minimize the likelihood a member of the public will confuse such persons with registered practitioners. This final rule uses the term “provisionally recognized PTAB attorney” to refer to non-registered counsel who are seeking or who have

been granted *pro hac vice* recognition in a Board proceeding, and the terms “counsel” or “person” to refer to those seeking or who have been granted *pro hac vice* recognition. Based on input from comments, this final rule also revises § 42.15(e) to replace the term “non-registered practitioners” with “counsel who are not registered practitioners” and to conform this section with the new procedure created by § 42.10(c)(2) of this final rule, which permits *pro hac vice* recognition in certain circumstances without the payment of a fee. As discussed below, such counsel are required to explicitly agree that they are subject to the USPTO Rules of Professional Conduct set forth in §§ 11.101 *et seq.*

### **Proposed Amendment to § 42.10(c) Clarifying Continuing Disclosure Duties of Pro Hac Vice Admittees**

Four comments supported the proposed amendment to § 42.10(c) clarifying that non-registered counsel recognized *pro hac vice* 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. No comments opposed this proposal.

After considering the input from the commenters, the USPTO is moving forward with the provision clarifying that non-registered counsel recognized *pro hac vice* 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. Based on the comments and the Board's experience, the Office believes this final rule will provide useful clarification and guidance regarding the obligations of those recognized *pro hac vice*.

### **Changes From the Proposed Rule**

In light of the comments received, this final rule makes revisions to the NPRM as follows.

In § 42.10(c)(1), the Office has dropped the proposed language that would have permitted non-registered counsel who are recognized *pro hac vice* to serve as lead counsel in favor of moving forward with a pilot program. The final rule retains the current language of § 42.10(c) in place of the language that was proposed in the NPRM. The final rule includes two modifications to the language in § 42.10(c). First, the following heading has been added to the beginning of § 42.10(c)(1): “*Pro hac vice* recognition of a person other than a registered practitioner.” This language is similar to the heading in the proposed version of § 42.10(c)(1) and does not change the substance of the rule. Second, the term

“established familiarity” has been replaced with “established legal familiarity.” This change clarifies, in response to a comment, that an established legal familiarity with the issues in a proceeding is sufficient to support a request for *pro hac vice* admission, and technical familiarity is not a stated requirement.

To conform § 42.10(c)(2) with the change discussed above, the Office has deleted language that would have permitted a non-registered attorney admitted *pro hac vice* to serve as lead counsel.

In § 42.10(c)(2) and (3), the term “PTAB-recognized practitioner” has been replaced with “provisionally recognized PTAB attorney.” This change was made in response to commenter concerns that the public might confuse “PTAB-recognized practitioners” with registered practitioners. Also, the term “non-registered practitioner” has been replaced with “counsel who is not a registered practitioner,” the term “non-registered practitioners recognized *pro hac vice*” has been replaced with “a person recognized *pro hac vice*,” and certain instances of the term “practitioner” have been replaced with the term “counsel.” These minor changes in terminology remove the use of the term “practitioner” to refer to counsel who are seeking or have been granted *pro hac vice* recognition. Notwithstanding these changes, which are being made to avoid confusion, those admitted *pro hac vice* remain “practitioners” under USPTO rules, and must explicitly agree that they are subject to the USPTO Rules of Professional Conduct set forth in §§ 11.101 *et seq.*

The final rule contains two revisions to § 42.15(e) that were not contained in the NPRM but that commenters indicated were necessary to conform this section to the revised version of § 42.10 set forth in this final rule. First, for the same reasons discussed above, the term “non-registered practitioners” in § 42.15(e) has been replaced with “counsel who are not registered practitioners.” Second, § 42.15(e) has been revised to conform with § 42.10(c)(2) of this final rule, which provides for a new procedure for *pro hac vice* recognition that does not require a fee.

## Discussion of the Final Rule

Section 42.10(a) is amended to clarify that lead counsel must be a registered practitioner and to provide that, upon a showing of good cause, the Board may permit a party to proceed without separate back-up counsel.

Section 42.10(c) is amended to clarify that an established legal familiarity with the subject matter of a proceeding is sufficient to support a request for *pro hac vice* recognition, and technical familiarity is not required. Section 42.10(c) is also amended to provide a new procedure whereby a non-registered attorney who was previously recognized *pro hac vice* in an AIA proceeding and not subsequently denied recognition *pro hac vice* shall be considered a provisionally recognized PTAB practitioner and shall be eligible for automatic *pro hac vice* admission in subsequent proceedings via a simplified and expedited process that does not require the payment of a fee. Section 42.10(c) is further amended to 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 might have materially impacted the grant of *pro hac vice* admission had the information been presented at the time of grant. The terminology of § 42.10(c) is also amended to use the terms “counsel” or “person” rather than “practitioner” to refer to persons who are seeking or have been granted *pro hac vice* recognition.

Section 42.15(e) is amended to replace the term “non-registered practitioners” with the term “counsel who are not registered practitioners” and to conform with § 42.10(c)(2) of this final rule, which permits certain persons to seek *pro hac vice* recognition without the payment of a fee.

## Rulemaking Requirements

*A. Administrative Procedure Act:* The changes in 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. (□ print page 82177) 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 chose to seek public comment before implementing this rule to benefit from the public's input.

*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 in this final 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 rule permits parties to proceed without back-up counsel upon a showing of good cause, creates a new streamlined procedure for recognizing counsel *pro hac vice* that is available for counsel who have previously been recognized *pro hac vice* in a different Board proceeding, and clarifies 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 do 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 will 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 rule 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 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 affect 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.*), 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 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 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 ( print page 82178) 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 number 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 amends 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>), 3 (<https://www.govinfo.gov/link/uscode/35/3>), 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>), 134 (<https://www.govinfo.gov/link/uscode/35/134>), 135 (<https://www.govinfo.gov/link/uscode/35/135>), 143 (<https://www.govinfo.gov/link/uscode/35/143>), 153 (<https://www.govinfo.gov/link/uscode/35/153>), 311 (<https://www.govinfo.gov/link/uscode/35/311>), 312 (<https://www.govinfo.gov/link/uscode/35/312>), 314 (<https://www.govinfo.gov/link/uscode/35/314>), 316 (<https://www.govinfo.gov/link/uscode/35/316>), 318 (<https://www.govinfo.gov/link/uscode/35/318>), 321-326 (<https://www.govinfo.gov/link/uscode/35/321>), 328 (<https://www.govinfo.gov/link/uscode/35/328>); 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. Lead counsel must be a registered practitioner. The Board may permit a party to proceed without back-up counsel upon a showing of good cause. A party may show good cause by demonstrating that it lacks the financial resources to retain both lead and back-up counsel.



(c)(1) *Pro hac vice* recognition of a person other than a registered practitioner.

The Board may recognize counsel *pro hac vice* during a proceeding upon a showing of good cause, subject to the condition that lead counsel be a registered practitioner and to any other conditions the Board may impose. For example, where the lead counsel is a registered practitioner, a motion to appear *pro hac vice* by counsel who is not a registered practitioner may be granted upon showing that counsel is an experienced litigating attorney and has an established legal familiarity with the subject matter at issue in the proceeding.

(2) *Pro hac vice* recognition of provisionally recognized PTAB attorneys. (i) Any counsel who is not a 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 provisionally recognized PTAB attorney. Provisionally recognized PTAB attorneys shall be eligible for automatic *pro hac vice* admission in subsequent proceedings, subject to the following conditions.

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

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

(B) Be accompanied by a certification in the form of a declaration or affidavit in which the provisionally recognized PTAB attorney attests to satisfying all requirements set forth by the Board for *pro hac vice* recognition of a provisionally recognized PTAB attorney 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 by a party within five business days after the filing of the notice. If an objection is not filed within five business days, the provisionally recognized PTAB attorney shall be deemed admitted *pro hac vice* in that proceeding upon filing of updated mandatory notices identifying that counsel as counsel of record. If an objection is filed by a party within 5 business

days, unless the Board orders otherwise within 10 business days after the objection is filed, the provisionally recognized PTAB attorney shall be deemed admitted *pro hac vice* after updated mandatory notices identifying that counsel as counsel of record are then filed.

(iv) If a provisionally recognized PTAB attorney 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 persons recognized pro hac vice.* For the entire duration of any proceeding in which counsel who is not a registered practitioner is recognized *pro hac vice* pursuant to paragraph (c)(1) or (2) of this section, the counsel who is not a registered practitioner has a continuing duty to notify the Board in writing within five business days if:

(i) The counsel who is not a registered practitioner is sanctioned, cited for contempt, suspended, disbarred, or denied admission by any court or administrative agency;

(ii) The counsel who is not a 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 counsel who is not a 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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**3.** Amend § 42.15 by revising paragraph (e) to read as follows:

**§ 42.15 Fees.**

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(e) Fee for counsel who are not registered practitioners, and who are not seeking automatic recognition pursuant to § 42.10(c)(2), to appear *pro hac vice* (□ print page 82179) before the Patent Trial and Appeal Board: \$250.00

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 Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding, 84 FR 16654 (/citation/84-FR-16654) (April 22, 2019).*

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3. *See supra n 2.*

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