

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# **Patent Trial and Appeal Board Boardside Chat: The mechanics of admission to practice before the Board**

Kimberly Weinreich, Attorney, Office of Enrollment and Discipline

Steven J. Fulk, Supervisory Patent Attorney, Patent Trial and Appeal Board (PTAB)

June 17, 2021

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# Question/comment submission

- To send in questions or comments during the webinar, please email:
  - [PTABBoardsideChat@uspto.gov](mailto:PTABBoardsideChat@uspto.gov)

# Topics

- Admission to practice before the USPTO
  - Current requirements for patent bar
  - Proposed administrative updates and comments received from the public
- *Pro hac vice* admission before the PTAB

Kimberly Weinreich, Attorney, Office of Enrollment and Discipline

# **Admission to practice before the USPTO in patent matters**

# Requirements for registration

- 37 C.F.R. § 11.7:
  - (a) No individual will be registered to practice before the Office unless he or she has:
    - (1) Applied to the USPTO Director in writing by completing an application for registration form supplied by the OED Director and furnishing all requested information and material; and
    - (2) Established to the satisfaction of the OED Director that he or she:
      - (i) Possesses good moral character and reputation;
      - (ii) Possesses the legal, scientific, and technical qualifications necessary for him or her to render applicants valuable service; and
      - (iii) Is competent to advise and assist patent applicants in the presentation and prosecution of their applications before the Office

# First page of application:

- Name, address, phone, **EMAIL**, citizenship
- Whether waiver applies
- Previously applied for admission, passed examination or registered to practice
- Bar membership

| U.S. PATENT AND TRADEMARK OFFICE  |                        |   |  | OMB No. 0651-0012   Approved through 04/30/2021   FORM PTO-151 |                              |
|---|------------------------|---|--|--|------------------------------|
| APPLICATION FOR REGISTRATION TO PRACTICE BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE   |                        |   |  |  |                              |
| 1A. LEGAL NAME  |                        | Last Name   | First Name   | Middle Name  | FOR USPTO USE ONLY           |
| <input type="checkbox"/> Mr. <input type="checkbox"/> Ms.   |                        |   |  |  |                              |
| 1B. NAME SHOWN ON VALID GOVERNMENT ID   |                        | <input type="checkbox"/> same as above  |  |  |                              |
| 1C. ADDRESS<br>(street, bldg., suite, etc.) (This address will be used for official correspondence.)  |                        | Employer, corporation, law firm, U.S. Government agency. Indicate if student or unemployed. |  |  |                              |
|   |                        | <input type="checkbox"/> REASONABLE ACCOMMODATION REQUEST ATTACHED                          |  |  |                              |
| 1D. CITY  |                        | 1E. STATE   | 1F. COUNTRY  |  | 1G. ZIP CODE                 |
| 1H. PHONE NUMBER (anytime)  |                        | 1I. E-MAIL (primary)  |  | 1J. E-MAIL (secondary)   |                              |
| 2. CITIZENSHIP (country)  |                        | 3. DATE OF BIRTH (month, day, year)   |  | 4. PLACE OF BIRTH (City, State, Country)                       |                              |
| FOR ALIENS ONLY →   | 5. VISA CLASSIFICATION |   | 6. PERMANENT RESIDENT OF THE UNITED STATES<br><input type="checkbox"/> YES Attach copy of both sides of permanent residence documentation<br><input type="checkbox"/> NO |  | 7. ALIEN REGISTRATION NUMBER |
| You are required to update the foregoing information promptly upon any change. Check all the following that apply. Applicants should carefully review the General Requirements Bulletin for detailed instructions upon completing this application.   |                        |   |  |  |                              |
| 8A. APPLICATION FEE: (PLEASE REFER TO THE GENERAL REQUIREMENTS BULLETIN AND 37 CFR § 11.7)  |                        |   |  |  |                              |
| <input type="checkbox"/> Enclosed is the non-refundable \$110.00 application fee set forth in 37 CFR § 1.21(a)(1)(i).   |                        |   |  |  |                              |
| OR  |                        |   |  |  |                              |
| <input type="checkbox"/> Enclosed is the \$1,680.00 fee set forth in 37 CFR § 1.21(a)(10).  |                        |   |  |  |                              |
| 8B. REGISTRATION EXAMINATION FEE:   |                        |   |  |  |                              |
| <input type="checkbox"/> I will utilize a commercial test administration service. Enclosed is the Government registration examination fee of \$210.00 for test administration by a commercial entity. 37 CFR § 1.21(a)(1)(ii)(A). See the General Requirements Bulletin for information about fees that may be charged by the commercial test administration service.                   |                        |   |  |  |                              |
| 9. WAIVER OF EXAMINATION: I AM A FORMER USPTO EMPLOYEE AND SATISFY THE REQUIREMENTS OF:   |                        |   |  |  |                              |
| <input type="checkbox"/> 37 CFR § 11.7(d)(1). <input type="checkbox"/> 37 CFR § 11.7(d)(2). <input type="checkbox"/> 37 CFR § 11.7(d)(3). Enclosed is the application fee under BA, above.  |                        |   |  |  |                              |
| 10. PREVIOUSLY PASSED EXAMINATION:  |                        |   |  |  |                              |
| <input type="checkbox"/> I passed an examination on ____/____/____. Enclosed is the required fee of \$210.00 (37 CFR § 1.21(a)(2)) and a completed data sheet.  |                        |   |  |  |                              |
| 11. PREVIOUSLY APPLIED FOR ADMISSION:   |                        |   |  |  |                              |
| <input type="checkbox"/> I previously applied for admission to the registration examination or requested the Office of Enrollment and Discipline to evaluate my scientific and technical qualifications. Enclosed is my application fee under BA, along with the registration exam fee under BB. Date of Previous Application: ____/____/____. Name on Application, if different: _____ |                        |   |  |  |                              |
| 12. PREVIOUSLY REGISTERED TO PRACTICE:  |                        |   |  |  |                              |
| <input type="checkbox"/> I was previously registered to practice in patent cases before the United States Patent and Trademark Office as an attorney or agent. Registration No. _____   |                        |   |  |  |                              |
| 13. BAR MEMBERSHIP:   |                        |   |  |  |                              |
| <input type="checkbox"/> I am a member in good standing of the bar of the highest court of a State or Territory of the United States. A list of all said courts and corresponding bar membership number(s) follows: _____   |                        |   |  |  |                              |

# Second page of application:

- Moral character questions
  - arrests and charges
  - previously disciplined regarding:
    - license
    - education
    - job
  - military discharge
  - delinquent on debt
- Education (scientific and technical qualifications)

| Page 2 of 3  |  | OMB No. 0651-0012   Approved for use through 04/30/2021   FORM PTO-158   |  |  |         |               |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |
|--|--|--|--|--|---------|---------------|--|--|--|--|--|--|--|--|--|--|--|--|--|--|--|--|--|
| <p><b>BACKGROUND INFORMATION:</b> Candor and truthfulness are significant elements of fitness relevant to practice before the United States Patent and Trademark Office. You should, therefore, provide the Office of Enrollment and Discipline with all available information, however unfavorable, even if its relevance is in doubt, with regard to the questions asked below. For each question answered "YES," provide a detailed statement setting forth all relevant facts and dates along with verified copies of relevant documents. Your responses must be updated, as necessary, prior to your registration. Any documents, evidence or proofs previously filed in a prior application need not be resubmitted unless your response to a question must be changed. Failure to disclose the requested information may result in denial of registration or in disciplinary proceedings, should you become registered. See 37 CFR §§ 11.7(a)(2)(i), 11.19, and 11.801.</p> |  |  |  |  |         |               |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |
| 14.  | <input type="checkbox"/> YES <input type="checkbox"/> NO   | Have you ever been disciplined, reprimanded, suspended, expelled, or agreed to surrender a license or have any charges ever been proffered against you in connection with your practice before any Federal or State court, municipal bureau, commission, office, or agency of any kind or character?   |  |  |         |               |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |
| 15.  | <input type="checkbox"/> YES <input type="checkbox"/> NO   | Have you ever been arrested, charged, or held by Federal, State, or other law enforcement authorities for any violation of any Federal or State law, or any country or municipal law, regulation, or ordinance? (Do not include any misdemeanor before your 16th birthday or traffic violations for which the fine was \$100.00 or less.)                                      |  |  |         |               |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |
| 16.  | <input type="checkbox"/> YES <input type="checkbox"/> NO   | Have you ever been disciplined, reprimanded, suspended, expelled, or asked to resign or withdraw from any educational institution, or have you resigned or withdrawn from any such institution in time to avoid a request to resign or in time to avoid discipline, reprimand, suspension, or expulsion for conduct involving dishonesty, fraud, misrepresentation, or deceit? |  |  |         |               |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |
| 17.  | <input type="checkbox"/> YES <input type="checkbox"/> NO   | Have you ever been disciplined, reprimanded, or suspended in any job for conduct involving dishonesty, fraud, misrepresentation, deceit, or for any violation of Federal or State laws or regulations?   |  |  |         |               |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |
| 18.  | <input type="checkbox"/> YES <input type="checkbox"/> NO   | Have you ever been fired or discharged from any job, or have you been asked to resign or quit for conduct involving dishonesty, fraud, misrepresentation, deceit, or any violation of Federal or State laws or regulations?  |  |  |         |               |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |
| 19.  | <input type="checkbox"/> YES <input type="checkbox"/> NO   | Have you ever resigned or quit a job when you were under investigation or inquiry for conduct which could have been considered as involving dishonesty, fraud, misrepresentation, deceit, or violation of Federal or State laws or regulations, or after receiving notice or been advised of possible investigation, inquiry, or disciplinary action for such conduct?         |  |  |         |               |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |
| 20.  | <input type="checkbox"/> YES <input type="checkbox"/> NO   | Have you ever been discharged from military service under conditions "other than honorable," or by reason of the sentence of a Court Martial or being dropped from the rolls?  |  |  |         |               |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |
| 21.  | <input type="checkbox"/> YES <input type="checkbox"/> NO   | Are you delinquent on any State or Federal debt? (Include delinquencies arising from Federal or State taxes, loans, overpayment of benefits, and other debts to the U.S. Government and defaults on Federally guaranteed or insured loans such as student and home mortgage loans.)  |  |  |         |               |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |
| 22.  | <p><b>EDUCATION:</b> List all degrees conferred. Attach any required documentation as discussed in the General Requirements Bulletin. If you applied previously for an exam, please see the General Requirements Bulletin section titled "REAPPLYING TO TAKE THE EXAMINATION" for what you must submit.</p> <table border="1"> <thead> <tr> <th>Degree Received as indicated on Transcript</th> <th>College</th> <th>Date Received</th> <th>Major Subject as indicated on Transcript</th> </tr> </thead> <tbody> <tr><td> </td><td> </td><td> </td><td> </td></tr> <tr><td> </td><td> </td><td> </td><td> </td></tr> <tr><td> </td><td> </td><td> </td><td> </td></tr> <tr><td> </td><td> </td><td> </td><td> </td></tr> </tbody> </table> |  |  | Degree Received as indicated on Transcript | College | Date Received | Major Subject as indicated on Transcript |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |
| Degree Received as indicated on Transcript   | College  | Date Received  | Major Subject as indicated on Transcript |  |         |               |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |
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|  |  |  |  |  |         |               |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |
| <p>Upon the basis of the foregoing information and any attached documents, I hereby apply for registration to practice in patent matters before the United States Patent and Trademark Office. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001.</p>  |  |  |  |  |         |               |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |
| 23.  | SIGNATURE OF APPLICANT   |  | DATE                                     |  |         |               |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |
| <p>MAIL COMPLETED APPLICATION TO:<br/> <b>MAIL STOP OED, UNITED STATES PATENT AND TRADEMARK OFFICE, P. O. BOX 1450, ALEXANDRIA, VA 22313-1450</b></p>  |  |  |  |  |         |               |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |  |



# History of requirements

- **July 31, 1790** - first U.S. patent signed by George Washington; Patent Board/Office located in State Department in NYC
- *Topliff v. Topliff*, 145 U.S. 156, 171 (**1892**) - The Supreme Court noted over 125 years ago that “[t]he specification and claim of a patent, particularly if the invention be at all complicated, constitute one of the most difficult legal instruments to draw with accuracy...”
- **July 1899** - Patent Office Rule 17 required registration of attorneys and patent agents practicing in patent matters before the Office. Attorneys were not required to demonstrate possession of scientific and technical qualifications

# History of requirements (cont'd)

- **1912-1915** – The Commissioner of Patents proposed to Congress the creation of a patent bar with a “higher standard of qualifications for registry” and stated “[f]undamentally, knowledge of the invention is more important than knowledge of the rules...”
- **The Patent Act of 1922** – expressly authorized the Commissioner of Patents to prescribe regulations for the recognition of attorneys and agents (now 35 USC § 2(b)(2)(D)).
- **1922-1933** – Rule 17 revised to require all practitioners possess scientific and technical qualifications
- **1933** – Registration examination instituted

# The General Requirements Bulletin (GRB)

- Sets forth guidance for complying with 37 CFR § 11.7
- Sets forth three categories which may be used to demonstrate possession of the required technical and scientific training
- If an applicant does not qualify under any of the categories, the USPTO will conduct an independent review for compliance with the scientific and technical training requirement

# GRB

- Category A: bachelor's degree in a recognized technical subject

Biology  
Biochemistry  
Botany  
Computer Science\*  
Electronics Technology  
Food Technology  
General Chemistry  
Marine Technology  
Microbiology  
Molecular Biology  
Organic Chemistry

Pharmacology  
Physics  
Textile Technology  
Aeronautical Engineering  
Agricultural Engineering  
Biomedical Engineering  
Ceramic Engineering  
Chemical Engineering  
Civil Engineering  
Computer Engineering  
Electrical Engineering

Electrochemical Engineering  
Engineering Physics  
General Engineering  
Geological Engineering  
Industrial Engineering  
Mechanical Engineering  
Metallurgical Engineering  
Mining Engineering  
Nuclear Engineering  
Petroleum Engineering

\*Acceptable Computer Science degrees must be accredited by the Computer Science Accreditation Commission (CSAC) of the Computing Sciences Accreditation Board (CSAB), or by the Computing Accreditation Commission (CAC) of the Accreditation Board for Engineering and Technology (ABET), on or before the date the degree was awarded. Computer science degrees that are accredited may be found on the Internet (<http://www.abet.org>).

# GRB

- Category B: bachelor's degree in another subject:
  - must show equivalence to Category A by fulfilling requirements of Options 1-4, other training or other education
    - **Option 1**: 24 semester hours in physics
    - **Option 2**: 32 semester hours (8 chemistry or physics; 24 biology, botany, microbiology, or molecular biology)
    - **Option 3**: 30 semester hours in chemistry
    - **Option 4**: 40 semester hours (8 chemistry or physics; 32 chemistry, physics, biology, botany, microbiology, molecular biology, or engineering)

# GRB

- Category C: practical engineering or scientific experience
  - Take and pass the Fundamentals of Engineering Test administered by a State Board of Engineering Examiners

# Becoming a patent practitioner webpage

- [www.uspto.gov/learning-and-resources/patent-and-trademark-practitioners/becoming-patent-practitioner](https://www.uspto.gov/learning-and-resources/patent-and-trademark-practitioners/becoming-patent-practitioner)

The screenshot shows the USPTO website interface. At the top, the USPTO logo and 'UNITED STATES PATENT AND TRADEMARK OFFICE' are visible. Navigation links include 'About Us', 'Jobs', 'Contact Us', and 'MyUSPTO'. A search bar is present with the text 'Search uspto.gov'. Below the navigation is a menu with 'Patents', 'Trademarks', 'IP Policy', and 'Learning and Resources', along with a 'Find It Fast' button. The breadcrumb trail reads: 'Home > Learning and Resources > Patent and Trademark Practitioners > Becoming a patent practitioner'. The main content area is titled 'Becoming a patent practitioner' and includes a sub-header 'Patent & trademark practitioners'. The page content is organized into sections: 'Becoming a patent practitioner' (highlighted), 'Registration examination', 'General requirements bulletin', 'Finding a patent practitioner', 'Becoming a trademark practitioner', 'Finding a trademark practitioner', 'Information for current practitioners', 'Intellectual property legal assistance programs', 'About OED', and 'OED FAQs'. The main text under 'Becoming a patent practitioner' states: 'Learn about applying for registration to practice in patent matters before the USPTO, including requirements, forms, and exam information.' It also mentions that attorneys and agents practicing before the USPTO in trademark or patent matters are subject to the USPTO Rules of Professional Conduct. The 'Registration examination' section states: 'Learn about the contents of the examination for registration to practice before the USPTO, updates to the exam, exam statistics, and review sessions.' The 'General Requirements Bulletin' section states: 'Individuals seeking registration or recognition must meet the requirements of 37 CFR § 11.7, including the legal, scientific, and technical qualifications, as well as good moral character and reputation. General instructions for demonstrating possession of the necessary qualifications can be found in the General Requirements Bulletin. The bulletin also contains information regarding applicable fees and includes the application form (PTO 158) and credit card authorization form (PTO 2038).' A button labeled 'General Requirements Bulletin' is visible. The 'Application and Registration Process' section is partially visible at the bottom.



**Request for comments–proposed  
administrative updates to the GRB**



# Request for comments

86 FR 15467

- Administrative Updates to the General Requirements Bulletin for Admission to the Examination for Registration To Practice in Patent Cases Before the United States Patent and Trademark Office
- Proposal 1: expand the list of Category A degrees to expressly include the following degrees that are routinely accepted:
  - aerospace engineering, bioengineering, biological science, biophysics, electronics engineering, genetic engineering, genetics, marine engineering, materials engineering, materials science, neuroscience, ocean engineering, and textile engineering

# Request for comments

86 FR 15467

- Proposal 2: Accept master's or doctoral degrees in a Category A subject
- Proposal 3:
  - revising Category B, Option 4 by changing “8 semester hours in chemistry or 8 semester hours of physics ... obtained in two sequential courses, each containing a lab” to “eight semester hours in a combination of chemistry, physics, and/or biology, with at least one course including a lab.”
  - revising Category B, Option 2, which already requires training in biology, would be revised to require at least “eight semester hours in a combination of chemistry and physics, with at least one course including a lab.”

# Request for comments

86 FR 15467

- Comments were due by May 24, 2021
- We received about 32 comments. Some were signed by multiple individuals and/or entities
  - 32 individuals, 7 organizations, 1 law firm, 20 universities, 2 corporations
  - overall, the comments were supportive of the proposals

# Request for comments

86 FR 15467

- Next steps:
  - Review and analyze comments
    - Consider additional suggested degrees for Category A
    - Master's degree requirements
  - Based on proposals and comments, decide whether to adopt each of the proposals
  - If the decision is to adopt any of the proposals, revise the GRB and implement updates for enrollment team

# Question/comment submission

- To send in questions or comments during the webinar, please email:
  - [PTABBoardsideChat@uspto.gov](mailto:PTABBoardsideChat@uspto.gov)

# Fast-track pilot programs



## Fast-Track Appeals Pilot Program

- Pilot program to expedite ex parte appeals before the PTAB
- Appellant can request appeal be expedited out of turn by filing a petition and a fee
- Learn more about the Fast-Track Appeals Pilot Program at: [www.uspto.gov/patents/ptab/fast-track-appeals-pilot-program](http://www.uspto.gov/patents/ptab/fast-track-appeals-pilot-program)

## Fast-Track Pilot Program for Appeals Related to COVID-19

- Pilot program to expedite ex parte appeals related to COVID-19 before the PTAB
- Appellant can request appeal be expedited out of turn by filing a petition WITHOUT a fee
- Learn more about the Fast-Track Pilot Program for Appeals Related to COVID-19 at: [www.uspto.gov/patents/patent-trial-and-appeal-board/covid-fast-track-appeals-pilot-program](http://www.uspto.gov/patents/patent-trial-and-appeal-board/covid-fast-track-appeals-pilot-program)



Steven J. Fulk, Supervisory Patent Attorney, PTAB

**Appearing *pro hac vice* at the PTAB:  
best practices for being admitted**

# Admission *pro hac vice* at the PTAB

- *Pro hac vice* (PHV) motions allow non-registered attorneys to represent parties during trial proceedings
- FY2021 first half statistics
  - Nearly 700 trial petitions filed
  - Over 450 PHV motions in ~300 trial proceedings
  - Over 160 PHV attorneys admitted





# Agenda

- **Process for filing PHV motion**
  - Authorization and timing
  - Documents needed
  - Fees
- **Requirements for admission**
  - Content of documents
  - Examples of denied motions



# Trial practice before the PTAB

- 37 C.F.R. § 42.10 – Counsel<sup>1</sup>
  - (a) If a party is represented by counsel, the party must designate a lead counsel and at least one back-up counsel . . . .
  - (c) 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* as the Board may impose . . . .

<sup>1</sup> 37 C.F.R., Part 42, available at <https://ecfr.federalregister.gov/>

# Filing a PHV motion – authorization

- Authorization to file PHV motion given in Notice of Filing Date Accorded to Petition

The parties are advised that under 37 C.F.R. § 42.10(c), recognition of counsel *pro hac vice* requires a showing of good cause. The parties are authorized to file motions for *pro hac vice* admission under 37 C.F.R. § 42.10(c). Such motions shall be filed in accordance with the “Order -- Authorizing Motion *for Pro Hac Vice* Admission” in Case IPR2013-00639, Paper 7, a copy of which is available on the Board Web site<sup>2</sup>.

<sup>2</sup> *Unified Patents, Inc. v. Parallel Iron, LLC*, IPR2013-00639, Paper 7 (PTAB Oct. 15, 2013), available at <https://www.uspto.gov/patents/ptab/decisions/representative-orders-decisions-notices>

# Filing a PHV motion – timing



- *Unified Patents* specifies time for filing PHV motion – no sooner than 21 days after service of the petition
- Opposition to PHV motion due within one week of motion filing date
- Notify Board if a deposition is occurring shortly after PHV motion is filed<sup>3</sup>

<sup>3</sup> Contact trials staff at [Trials@uspto.gov](mailto:Trials@uspto.gov) or 571-272-7822

# Filing a PHV motion – documents

- Motion showing good cause
- Affidavit or declaration attesting to *Unified Patents* criteria – filed as an exhibit per § 42.63
- Power of attorney per § 42.10(b)
- Mandatory notices per § 42.8

# Filing a PHV motion – fees



- Non-registered practitioner fee of \$250, per attorney and per trial<sup>4</sup>
- Once motion is granted, the counsel is admitted for the entire duration of a proceeding

<sup>4</sup> "Setting and Adjusting Patent Fees During Fiscal Year 2020," 85 Fed. Reg. 46,932 at 46,947, available at <https://www.federalregister.gov/>

Current USPTO fee schedule available at <https://www.uspto.gov/learning-and-resources/fees-and-payment>; 37 C.F.R. § 42.15 - Fees




# Requirements for admission PHV

- § 42.10(c) – Showing of good cause and “any other conditions” as the Board may impose
- *Unified Patents*
  - Motion containing a statement of facts showing there is good cause for admission
  - Affidavit or declaration attesting to eight criteria, or explanation of circumstances



# PHV motion requirements


- Statement of facts showing “good cause”
  - Counsel is an experienced litigation attorney
  - Has an established familiarity with the subject matter at issue in the proceeding
- Example - Motion denied 
  - Attorney stated *general* technical expertise, but did not attest to any familiarity with the *specific* subject matter at issue in the proceeding, e.g., the patent, prior art, etc.



# Affidavit or declaration requirements

- § 42.2 – *Affidavit* means affidavit or declaration under § 1.68 . . . [or] a declaration under 28 U.S.C. § 1746
  - Affidavit, § 1.66 – oath and official seal
  - Declaration, § 1.68 – willful false statements punishable by fine/imprisonment
  - Declaration, 28 U.S.C. § 1746 – under penalty of perjury


# Affidavit or declaration requirements

- Examples - Motions denied 
  - Affidavit with no official seal, no statement regarding penalties
  - Declaration without either § 1.68 or 28 U.S.C. § 1746 statements and signature

# Affidavit or declaration requirements

- *Unified Patents* criteria (i-iv)
  - 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;


# Affidavit or declaration requirements

- Examples - Motions denied 
  - Bar membership had lapsed for failure to pay dues
  - Failure to disclose prior sanction imposed by state bar

# Affidavit or declaration requirements

- *Unified Patents* criteria (v and vi)
  - 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 C.F.R.**;
  - vi. The individual will be subject to the USPTO Rules of Professional Conduct set forth in 37 C.F.R. §§ **11.101** et. seq. and disciplinary jurisdiction under 37 C.F.R. § 11.19(a);

# Affidavit or declaration requirements

- *Unified Patents* criteria (vii and viii)
  - vii. All other proceedings before the Office for which the individual has applied to appear *pro hac vice* in the last three (3) years; and
  - viii. Familiarity with the subject matter at issue in the proceeding
- **Example - Motion denied** 
  - Failure to list all appearances in last 3 years

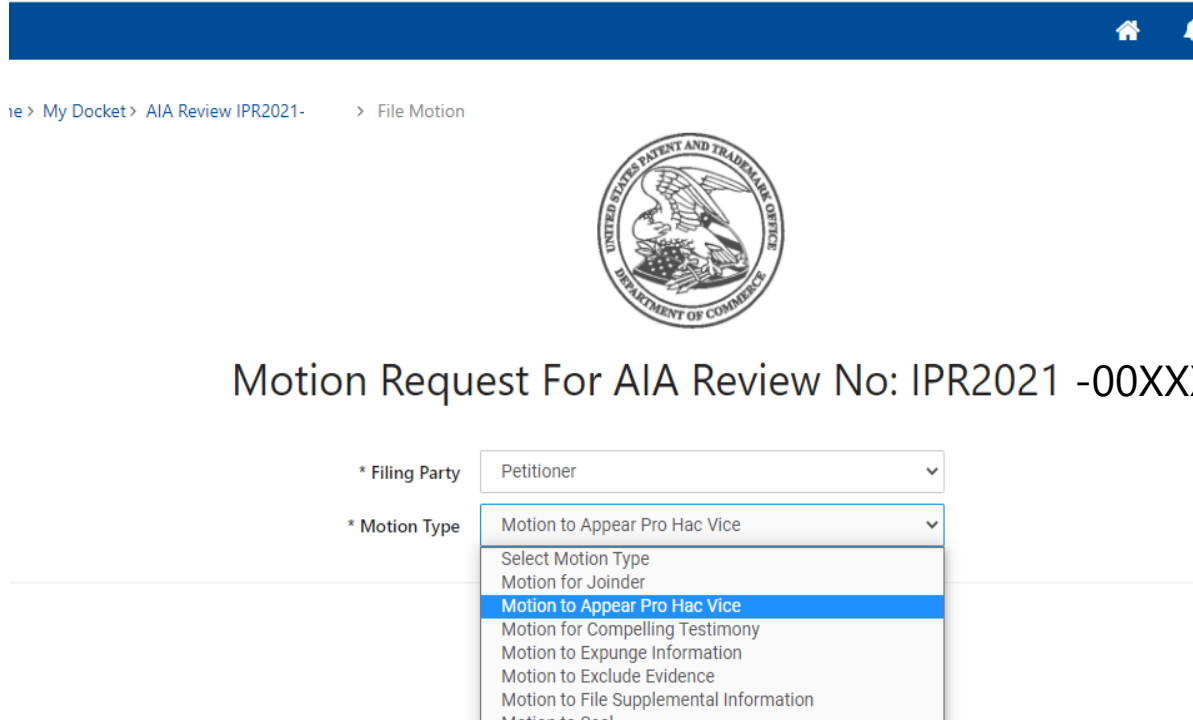
# ***Pro hac vice* – best practices checklist**

- File PHV motion as paper**
  - Filed by registered counsel of record
  - Includes “good cause” statement – litigation experience and specific familiarity with subject matter/record (§ 42.10(c); *Unified Patents Order*)
- File affidavit or declaration as exhibit**
  - Properly executed/signed per § 42.2
  - Includes statements attesting to items i-viii of *Unified Patents Order*, or explanation of circumstances
- Pay proper fee**
  - \$250 per attorney, per proceeding
  - E2E system links to PTO Financial Manager website – [return to E2E after payment and submit documents](#)
- Update power of attorney (§ 42.10(b)) and mandatory notices (§ 42.8)**
- **Contact Trials Staff with any questions: [trials@uspto.gov](mailto:trials@uspto.gov) or 571-272-7822**

**Filing a PHV motion – E2E system**




# Filing a PHV motion – E2E system<sup>5</sup>



The screenshot shows the USPTO E2E system interface. At the top, there is a blue navigation bar with a home icon and a notification bell icon. Below the bar, the breadcrumb navigation reads: "Home > My Docket > AIA Review IPR2021- > File Motion". The USPTO seal is centered on the page. Below the seal, the text reads "Motion Request For AIA Review No: IPR2021 -00XXX". The form contains two dropdown menus: "\* Filing Party" with "Petitioner" selected, and "\* Motion Type" with a dropdown menu open showing several options. The option "Motion to Appear Pro Hac Vice" is highlighted in blue.

Home > My Docket > AIA Review IPR2021- > File Motion



Motion Request For AIA Review No: IPR2021 -00XXX

\* Filing Party: Petitioner

\* Motion Type: Motion to Appear Pro Hac Vice

- Select Motion Type
- Motion for Joinder
- Motion to Appear Pro Hac Vice**
- Motion for Compelling Testimony
- Motion to Expunge Information
- Motion to Exclude Evidence
- Motion to File Supplemental Information
- Motion to Seal

<sup>5</sup> <https://ptab.uspto.gov>

# Filing a PHV motion – E2E system

## Motion Documents

\* Type

\* Paper Type

\* Name

\* Attach a document  No file chosen

\* Availability

The \$250 admission fee is per attorney per case filing a PHV. If the motion seeks PHV admission for more than one attorney, please indicate the number of attorneys in the "Quantity" field below.

| Quantity                       | Type of Fee                | Unit Cost | Subtotal |
|--------------------------------|----------------------------|-----------|----------|
| <input type="text" value="1"/> | Pro Hac Vice admission fee | \$250.00  | \$250.00 |

# Filing a PHV motion – E2E system

The \$250 admission fee is per attorney per case filing a PHV. If the motion seeks PHV admission for more than one attorney, please indicate the number of attorneys in the "Quantity" field below.

| Quantity                       | Type of Fee                | Unit Cost | Subtotal |
|--------------------------------|----------------------------|-----------|----------|
| <input type="text" value="2"/> | Pro Hac Vice admission fee | \$250.00  | \$500.00 |

[Pay](#)

| Paper# | Filing Date | Type  | Paper Type | Title   | Pages | Filing Party | Availability | Actions                                     |
|--------|-------------|-------|------------|---|-------|--------------|--------------|---|
|        | 04/23/2021  | PAPER | Motion     | Pro Hac Vice admission request for Mr. Counsel4 | 86    | petitioner   | PUBLIC       | <a href="#">Edit</a> <a href="#">Delete</a> |

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## Patent Trial and Appeal Board

Dashboard Enter Appearance As Patent Owner/Respondent Initiate New Petition My Docket Payments Search

Dashboard > Payment History > Fees Payment for AIA Review IPR2021-00649

### Fees Payment Receipt for AIA Review IPR2021-

**✓ Your Payment Has Been Received for AIA Review IPR2021-00649!**  
To view and submit your motion [click here.](#)

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# Filing a PHV motion – E2E system

\* Availability  ▼

The \$250 admission fee is per attorney per case filing a PHV. If the motion seeks PHV admission for more than one attorney, please indicate the number of attorneys in the "Quantity" field below.

| Quantity                       | Type of Fee                | Unit Cost | Subtotal |
|--------------------------------|----------------------------|-----------|----------|
| <input type="text" value="1"/> | Pro Hac Vice admission fee | \$250.00  | \$250.00 |

| Paper# | Filing Date | Type  | Paper Type | Title   | Pages | Filing Party | Availability | Actions                          |
|--------|-------------|-------|------------|---|-------|--------------|--------------|----------------------------------|
|        | 04/23/2021  | PAPER | Motion     | Pro Hac Vice admission request for Mr. Counsel4 | 86    | petitioner   | PUBLIC       | <input type="button" value="🗑"/> |

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# Question/comment submission

- To send in questions or comments during the webinar, please email:
  - [PTABBoardsideChat@uspto.gov](mailto:PTABBoardsideChat@uspto.gov)

# 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

- July 15, 2021, at 12-1 p.m. ET
- Topic: RCE versus Appeal
- Register for and learn about upcoming Boardside Chats and access past Boardside Chats at: [www.uspto.gov/patents/ptab/ptab-boardside-chats](https://www.uspto.gov/patents/ptab/ptab-boardside-chats)



