KEKER
VAN NEST
& PETERS

A Survey of Pending Patent Legislation

KVP CLE Workshop
January 19, 2023

Presenters

Sharif Jacob

sjacob@keker.com

Kristen Lovin

klovin@keker.com

Stephanie Goldberg

sgoldberg@keker.com

Agenda

- **Patent Eligibility Under § 101**
- **USPTO**
- **PTAB**
- **International Trade Commission**
- **Standard Essential Patents**
- **Inclusive Innovation**

Patent Eligibility Under § 101

§ 101 Reform – How did we get here?

- **March 5, 2021: Letter from Sens. Tillis, Coons, Hirono, Cotton to USPTO**

> If the United States is going to continue leading in all of these technology sectors, we can no longer continue to ignore the fact that current eligibility jurisprudence has had a dramatic negative impact on investment, research, and innovation. The lack of clarity has not only
>
> It is past time that Congress act to address this issue. To assist us as we consider what legislative action should be taken to reform our eligibility laws, we ask that you publish a request for information on the current state of patent eligibility jurisprudence in the United States, evaluate the responses, and provide us with a detailed summary of your findings. We are particularly

- **July 9, 2021 – October 15, 2021: USPTO solicited and received comments**

SUMMARY:

At the request of Senators Tillis, Hirono, Cotton, and Coons, the United States Patent and Trademark Office (USPTO) is undertaking a study on the current state of patent eligibility jurisprudence in the United States, and how the current jurisprudence has impacted investment and innovation, particularly in critical technologies like quantum computing, artificial intelligence, precision medicine, diagnostic methods, and pharmaceutical treatments. The USPTO seeks public input on these matters to assist in preparing the study.

§ 101 Legislative Proposal

Patent Eligibility Restoration Act of 2022, S.4734

- Introduced 8/2/2022 in 117th Congress by Thom Tillis (R-NC)
- Latest action: 8/2/2022 - Read twice and referred to the Committee on the Judiciary
- Not yet re-introduced

Patent Eligibility Restoration Act of 2022, S.4734

Lays out particular "eligibility exclusions"

"(b) ELIGIBILITY EXCLUSIONS.—

"(1) IN GENERAL.—Subject to paragraph (2), a person may not obtain a patent for any of the following, if claimed as such:

"(A) A mathematical formula, apart from a useful invention or discovery.

"(B) A process that—

"(i) is a non-technological economic, financial, business, social, cultural, or artistic process;

"(ii) is a mental process performed solely in the human mind; or

"(iii) occurs in nature wholly independent of, and prior to, any human activity.

"(C) An unmodified human gene, as that gene exists in the human body.

"(D) An unmodified natural material, as that material exists in nature.

"(2) CONDITIONS.—

"(A) CERTAIN PROCESSES.—Notwithstanding paragraph (1)(B)(i), a person may obtain a patent for a claimed invention that is a process described in such provision if that process is embodied in a machine or manufacture, unless that machine or manufacture is recited in a patent claim without integrating, beyond merely storing and executing, the steps of the process that the machine or manufacture perform.

"(B) HUMAN GENES AND NATURAL MATERIALS.—For the purposes of subparagraphs (C) and (D) of paragraph (1), a human gene or natural material that is isolated, purified, enriched, or otherwise altered by human activity, or that is otherwise employed in a useful invention or discovery, shall not be considered to be unmodified.

Patent Eligibility Restoration Act of 2022, S.4734

Gives guidance on determining eligibility

"(c) ELIGIBILITY.—

"(1) IN GENERAL.—In determining whether, under this section, a claimed invention is eligible for a patent, eligibility shall be determined—

"(A) by considering the claimed invention as a whole and without discounting or disregarding any claim element; and

"(B) without regard to—

"(i) the manner in which the claimed invention was made;

"(ii) whether a claim element is known, conventional, routine, or naturally occurring;

"(iii) the state of the applicable art, as of the date on which the claimed invention is invented; or

"(iv) any other consideration in section 102, 103, or 112.

Patent Eligibility Restoration Act of 2022, S.4734

Implications for scope

- Diagnostic techniques and treatments are patentable
- Potentially expands eligibility to software that would otherwise be an invalid abstract idea—i.e., “technological” economic, financial, business, social, cultural, or artistic processes
- Potentially brings back machine or transformation test
- Potentially expands the scope of coverage for genes and natural material—i.e., if “unmodified”

Patent Eligibility Restoration Act of 2022, S.4734

Many vague terms – may not be clearer than *Alice* itself

"(b) ELIGIBILITY EXCLUSIONS.—

"(1) IN GENERAL.—Subject to paragraph (2), a person may not obtain a patent for any of the following, if claimed as such:

"(A) A mathematical formula, apart from a **useful** invention or discovery.

"(B) A process that—

"(i) is a **non-technological** economic, financial, business, social, cultural, or artistic process;

"(ii) is a mental process performed solely in the human mind; or

"(iii) occurs in nature wholly independent of, and prior to, any human activity.

"(C) An **unmodified** human gene, as that gene exists in the human body.

"(D) An **unmodified** natural material, as that material exists in nature.

"(2) CONDITIONS.—

"(A) CERTAIN PROCESSES.—Notwithstanding paragraph (1)(B)(i), a person may obtain a patent for a claimed invention that is a process described in such provision if that process is embodied in a machine or manufacture, unless that machine or manufacture is recited in a patent claim without integrating, **beyond merely storing and executing**, the steps of the process that the machine or manufacture perform.

"(B) HUMAN GENES AND NATURAL MATERIALS.—For the purposes of subparagraphs (C) and (D) of paragraph (1), a human gene or natural material that is isolated, purified, enriched, or **otherwise altered** by human activity, or that is otherwise employed in a **useful** invention or discovery, shall not be considered to be unmodified.

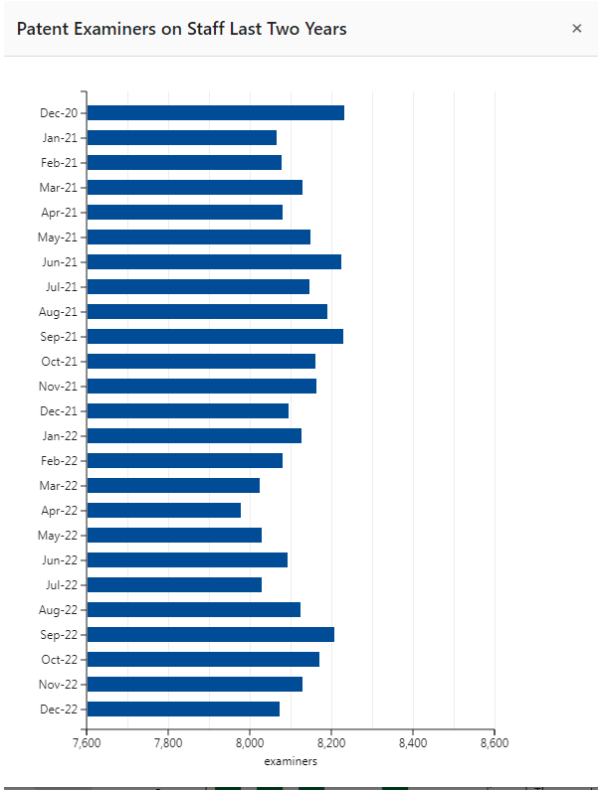
Patent Eligibility Restoration Act of 2022, S.4734

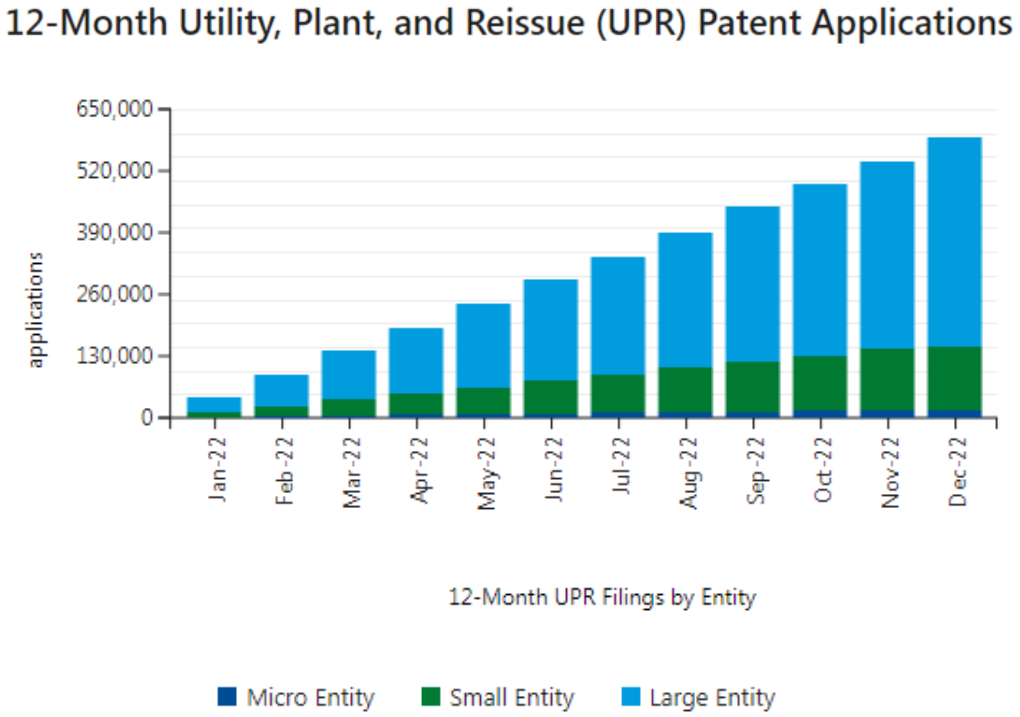
Implications for process

- Uses step 1 lens of looking at the "claim as a whole"
- Eliminates step 2 considerations re: conventionality
  - Shifts fight to one-level question of whether the claim falls within one of the categorical exclusions
- Unclear whether *Berkheimer*/*Aatrix* still applies – may make § 101 more of a legal inquiry that can be decided on Rule 12 motions

USPTO

Patent Examination





Source: USPTO (https://www.uspto.gov/dashboard/patents/)

USPTO Quality Metrics

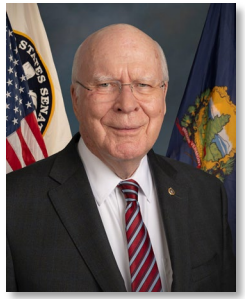
Compliance of Office Actions						
	Action Type Reviewed	**No** (count)	**Yes** (count)	**Total** (count)	**% No**	**% Yes**
Was office action compliant under 35 USC 101?	Allowance	62	4465	4527	1.4%	98.6%
	Final Rejection	37	2517	2554	1.4%	98.6%
	Non-Final Rejection	109	4846	4955	2.2%	97.8%
	Total	208	11828	12036	1.7%	98.3%
Was office action compliant under 35 USC 102?	Allowance	95	4432	4527	2.1%	97.9%
	Final Rejection	138	2416	2554	5.4%	94.6%
	Non-Final Rejection	362	4593	4955	7.3%	92.7%
	Total	595	11441	12036	4.9%	95.1%
Was office action compliant under 35 USC 103?	Allowance	73	4454	4527	1.6%	98.4%
	Final Rejection	394	2160	2554	15.4%	84.6%
	Non-Final Rejection	647	4308	4955	13.1%	86.9%
	Total	1114	10922	12036	9.3%	90.7%
Was office action compliant under 35 USC 112?	Allowance	171	4356	4527	3.8%	96.2%
	Final Rejection	232	2322	2554	9.1%	90.9%
	Non-Final Rejection	534	4421	4955	10.8%	89.2%
	Total	937	11099	12036	7.8%	92.2%
Was office action compliant under all statutes?	Allowance	370	4157	4527	8.2%	91.8%
	Final Rejection	657	1897	2554	25.7%	74.3%
	Non-Final Rejection	1293	3662	4955	26.1%	73.9%
	Total	2320	9716	12036	19.3%	80.7%

Source: USPTO (https://www.uspto.gov/sites/default/files/documents/MRF-Data-Tables-FY21.xlsx)

Examination & Ownership Legislative Proposals

Patent Examination and Quality Improvement Act of 2022, S.4704

- Introduced in the 117th Congress on 8/2/2022 by Thom Tillis (R-N.C.) and Patrick Leahy (D-Vt.)
- Latest action: 8/2/2022 - Read twice and referred to the Committee on the Judiciary
- Not yet reintroduced



Pride in Patent Ownership Act, S.2774

- Introduced in the 117th Congress on 9/21/2021 by Patrick Leahy (D-Vt.) and Thom Tillis (R-N.C.)
- Latest action: 9/21/2021 - Read twice and referred to the Committee on the Judiciary
- Not yet reintroduced

Patent Examination and Quality Improvement Act, S.4704

- Comptroller General must submit a report within 1 year on how to improve the patent examination process and overall quality of patents. Areas of focus include:
  - Patent examination process on Sections 101, 102, 103 and 112
  - What constitutes a thorough patent search
  - Whether examiners need more time
  - Whether examiner interviews need to be recorded and placed in record
- Director must develop guidance for examiners per the report within 1 year
- Director must submit report to Congress within 2 years on:
  - Improving examiner technical training
  - Status of IT capabilities and modernization thereof
  - Accounting of the use of advanced data science analytics to improve examination process

Pride in Patent Ownership Act, S.2774

- Patent owners must record ownership, or lose right to punitive damages for pre-recordation infringement

> If a patentee fails to comply … no party may recover, for infringement of the applicable patent in any action, increased monetary damages under section 284 during the period beginning on the date that is 91 days after the effective date of the issuance, assignment, grant, or conveyance with respect to the patent, as applicable, and ending on the date on which that issuance, assignment, grant, or conveyance is properly requested to be recorded.

- Patent applicants must disclose if "any governmental entity, including a foreign governmental entity" has paid patent preparation, prosecution, or maintenance fees (including attorney fees)
  - Must provide a "statement describing the amount and source of the funding"

PTAB

PTAB – Quick Review

PTAB: Administrative tribunal within USPTO that reviews examiner rejections and decides petitions for *inter partes* review (IPRs)

IPRs:

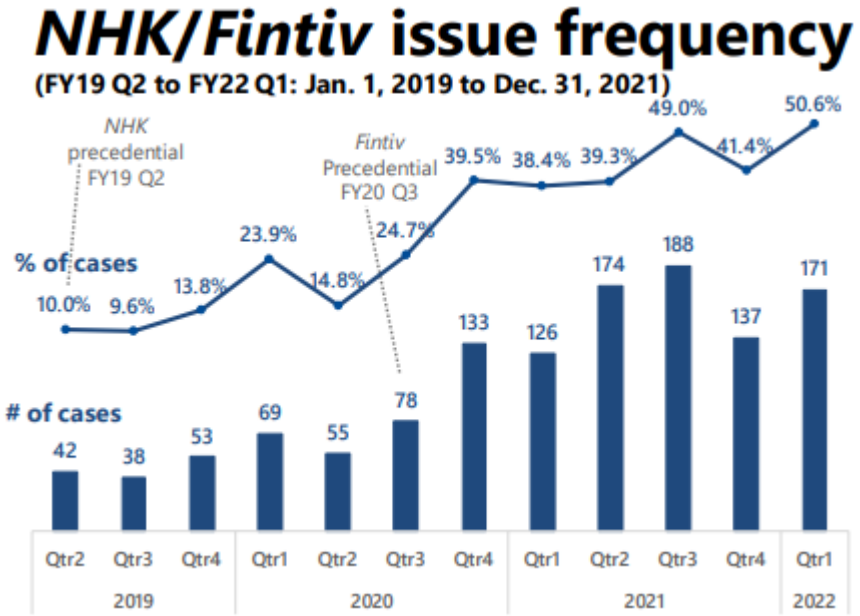
- Administrative trial proceeding within USPTO to challenge validity of patent claims
- Limited to anticipation and obviousness challenges based on prior art patents and printed publications
- Time limit: must be commenced within 1 year of service of complaint for patent infringement

PTAB Reform – How did we get here?

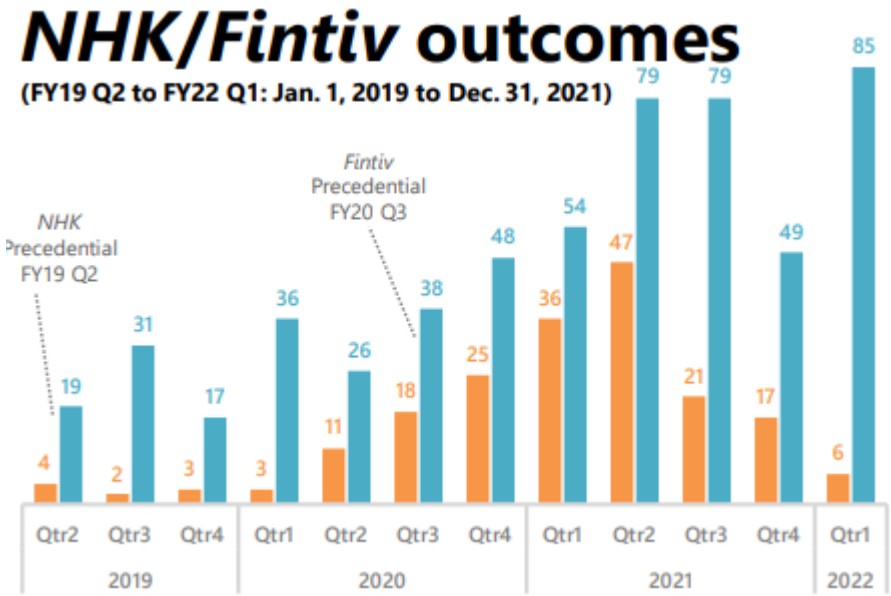
Emerging Trends:

- Discretionary Denials
  - *NHK Spring v. Intri-Plex Techs* (IPR2018-00752) – denied institution of IPR based on parallel litigation
  - *Apple v. Fintiv* (IPR2020-00019) – 6 factor test
- Perceived gamesmanship and abuses
  - Repeat petitions
  - Deliberately delaying or losing an instituted challenge in exchange for consideration
    - *OpenSky Industries v. VLSI* (IPR2021-01064) & *Patent Quality Assurance v. VLSI* (IPR2021-01229)

Discretionary Denials



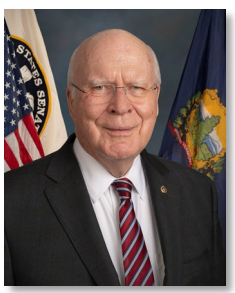
In this graphic, the bars show the number of cases where *NHK/Fintiv* was raised, and the line shows the percent of all cases in which *NHK/Fintiv* was raised.

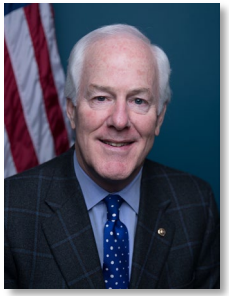


This graphic shows the outcomes of DIs that analyze *NHK/Fintiv*, specifically, the number of **NHK/Fintiv denials (orange)** versus the number of **NHK/Fintiv institutions (light blue)**.

Source: USPTO (https://www.uspto.gov/sites/default/files/documents/ptab_parallel_litigation_study_20220621_.pdf)

Legislative Proposal





Patent Trial and Appeal Board Reform Act of 2022, S.4417

- Introduced 6/16/2022 in 117th Congress by Patrick Leahy (D-Vt.), Thom Tillis (R-N.C.), and John Cornyn (R-Texas)
- Latest action: 6/16/2022 - Read twice and referred to the Committee on the Judiciary
- Not yet reintroduced

Patent Trial and Appeal Board Reform Act of 2022

1. Eliminates discretionary denials based on parallel litigation
2. Provisions to combat abuses
3. Modifies certain legal standards and rights
4. Procedural changes

Patent Trial and Appeal Board Reform Act of 2022

1. Eliminates discretionary denials

"(f) INSTITUTION NOT TO BE DENIED BASED ON PARALLEL PROCEEDINGS.—In deciding whether to institute an inter partes review proceeding, the Director shall not in any respect consider an ongoing civil action or a proceeding before the International Trade Commission under section 337 of the Tariff Act of 1930 (19 U.S.C. 1337), other than with respect to—

Pros:

- Addresses current complaints about *Fintiv*, i.e.:
  - Encourages forum-shopping to fast-to-trial districts
  - Relies on unpredictable trial dates

Cons:

- Too draconian – the USPTO should be left to work through these kinks itself

Patent Trial and Appeal Board Reform Act of 2022

2. Provisions to combat abuses:

- **Repeat petitions:** IPR cannot be instituted if IPR was previously instituted on one or more claims filed on a different day by the same petitioner, or a real party in interest or privy
  - *Does not cover multiple petitions filed on the same day*
- **Bad faith conduct:** Director must prescribe sanctions against petitioners who offer to deliberately delay or lose an instituted challenge for consideration

Patent Trial and Appeal Board Reform Act of 2022

3. Provisions re: legal standards, rights, & entitlements:

- **Claim construction standard:** must use same standard used in civil actions (*Philips*, as opposed to broadest reasonable interpretation)
  - *Does not change standard of review to be same as civil actions (clear and convincing, as opposed to preponderance)*
- **Right to appeal:** any party that reasonably expects another person to assert estoppel based on a final written decision has the right to appeal to the Federal Circuit
  - *No need to show Article III standing*
- PTO must cover the reasonable litigation expenses of small businesses

Patent Trial and Appeal Board Reform Act of 2022

4. Procedural changes:

- Supervisors who are not members of a panel cannot engage in *ex parte* communication with a panel concerning a matter pending before them
- Any rehearing decision must be issued in a separate opinion
- After a final written decision issues, Director must cancel claims determined to be unpatentable within 60 days
- Director must decide any request for reconsideration within 120 days

International Trade Commission

ITC & Section 337 – Quick Review

ITC: quasi-judicial federal agency that investigates unfair trade practices

Section 337 of the U.S. Tariff Act of 1930:

- Infringement of a U.S. patent, copyright, registered trademark, or mask work is an unlawful practice in the import trade
- Must establish "domestic industry" – that an industry in the US relating to the protected articles protected "exists or is in the process of being established"
- If there is a violation, ITC may issue an exclusion order barring the importation of the infringing product

Recent Complaints

- Bar for domestic industry is low – engaging in patent licensing and litigation is enough
- NPE filings in ITC are on the rise
  - Since 2017, almost a quarter of the ITC's docket involved complaints brought by patent licensing entities
- Demands can be egregious
  - *In the Matter of Certain Touch-Controlled Mobile Devices, Computers, and Components Thereof* (Inv. No. 337-TA-162): NPE sought to ban 80% of U.S. imports on Android tablets, 86% of Windows tablets, and over 50% of Android smartphones

Legislative Proposal

Advancing America's Interests Act, H.R. 5184

- Introduced in the 117th Congress 9/7/2021 by Suzan DelBene (D-WA) and David Schweikert (R-AZ)
- Latest action: 9/7/2021 - Referred to the Subcommittee on Trade
- Not yet reintroduced

Advancing America's Interests Act, H.R. 5184

Amends Section 337 to exclude NPEs

(3) For purposes of paragraph (2), an industry in the United States shall be considered to exist if there is in the United States, with respect to the articles protected by the patent, copyright, trademark, mask work, or design concerned—

(A)significant investment in plant and equipment;

(B)significant employment of labor or capital; ~~or~~

(C)substantial investment in its exploitation, including ~~engineering, research and development, or licensing.~~ engineering and research and development; or

(D) substantial investment in licensing activities that leads to the adoption and development of articles that incorporate the patent, copyright, trademark, mask work, or design.

(4) For purposes of paragraph (3), the complainant may not rely upon activities by its licensees unless the license leads to the adoption and development of articles that incorporate the claimed patent, copyright, trademark, mask work, or design for sale in the United States.

Standard Essential Patents

Standard Essential Patents (SEPs) – Quick Review

- **Standard Essential Patents (SEPs):** patents that must be practiced in order to accomplish the standard
  - Essentiality is determined by "whether the claim elements read onto mandatory portions of a standard that standard-compliant devices must incorporate." *Godo Kaisha IP Bridge 1 v. TCL Commc'n Tech. Holdings Ltd.*, 967 F.3d 1380, 1385 (Fed. Cir. 2020).
- Creates a windfall for owners of patents covering a technology employed by the standard
- Standards-setting organizations often require owners of standard-essential patents to promise to license their patents on FRAND terms

Standard Essential Patents (SEPs) – Trends

1. **Piecemeal Adjudication:** Different US courts deciding essentiality and the FRAND rate
2. **Injunctions:** SEP owner's threat of seeking injunction may coerce the accused infringer to accept higher, non-FRAND rates
3. **Global FRAND determinations:** Court orders parties to enter into global license
4. **Anti-suit injunctions:** Court enjoins a party from enforcing patents in another jurisdiction
   - China has done this with increasing frequency
     - But we've done it too. *See, e.g., Microsoft v. Motorola,* 2013 U.S. Dist. LEXIS 60233 (W.D. Wash., 2013), ***aff'd*** 795 F.3d 1024 (9th Cir. 2015) (barring Motorola Mobility from enforcing Mannheim SEP injunctions).
   - 2/22/2022: EU requested WTO dispute consultations with China over its ASI practices, as inconsistent with TRIPS (WT/DS611/1) – consultation was held in April but no settlement was reached
   - 12/7/2022: EU requests a WTO panel hear its dispute with China
   – 12/20/2022: WTO dispute board heard the statements from EU and China and agrees to revert should a member request

US “Policy” on Injunctions

WITHDRAWAL OF 2019 POLICY STATEMENT ON REMEDIES FOR STANDARDS-ESSENTIAL PATENTS SUBJECT TO VOLUNTARY F/RAND COMMITMENTS

June 8, 2022

“The U.S. Patent & Trademark Office (USPTO), the National Institute of Standards and Technology (NIST), and the U.S. Department of Justice, Antitrust Division (DOJ) hereby withdraw the December 19, 2019 Policy Statement on Remedies for Standards-Essential Patents Subject to Voluntary F/RAND Commitments (2019 Policy Statement). After considering potential revisions to that statement, the Agencies have concluded that withdrawal best serves the interests of innovation and competition.”

Legislative Proposals

Defending American Courts Act, S.3772

- Introduced in the 117th Congress on 3/8/2022 by Thom Tillis (R-N.C.)
- Co-sponsors: Chris Coons (D-DE), Tom Cotton (R-AR), Mazie Hirono (D-HI) , and Rick Scott (R-FL)
- Latest Action: 3/8/2022 Read twice and referred to the Committee on the Judiciary
- Not yet reintroduced

Standard Essential Royalties Act

- Industry proposal
- Not formally before Congress

Defending American Courts Act, S.3772

Imposes disincentives for bad actors seeking to enforce a foreign anti-suit injunction in the US

"(b) CIVIL ACTION PRESUMPTIONS.—Upon a finding of infringement of a patent under section 271 in a civil action against any person that has asserted an anti-suit injunction in any tribunal of the United States seeking to restrict the claim of infringement of the patent on the basis of the anti-suit injunction, the court shall presume that—

"(1) the infringement is willful when determining whether to increase damages under section 284; and

"(2) the action is exceptional when determining whether to award attorney fees under section 285.

"(c) PATENT TRIAL AND APPEAL BOARD.—In determining whether to institute a review under chapter 31 or 32 with respect to a patent, the Director shall decline to institute such a review if the petitioner, real party in interest, or privy of the petitioner has asserted an anti-suit injunction in any tribunal of the United States seeking to restrict a claim for infringement of the patent on the basis of the anti-suit injunction.

Standard Essential Royalties Act

Creates a single court in DC to determine FRAND rates

SEC. 3. TECHNICAL STANDARDS ROYALTY COURT

…

"**§ 221. Appointment of judges; offices.**

"(a) The President shall appoint, by and with the advice and consent of the Senate, five judges who shall constitute a court of record known as the Standards Royalty Court (hereinafter "court" in this chapter). The court is a court established under Article III of the Constitution of the United States.

…

"**§222. Powers and duties.**

"(a) The court's jurisdiction shall be exclusive over and limited to, and the court shall have all powers in law and equity to adjudicate, actions under section 331 of title 35.

"(b) Cases and controversies shall be heard and determined by a panel of at least three judges.

…

Standard Essential Royalties Act

Narrows the scope of patents subject to RAND licensing obligations

"**§ 331. Cause of action.**

"(a) A person shall have remedy by civil action in the Standards Royalty Court (hereinafter "court" in this chapter) to determine a reasonable and non-discriminatory licensing royalty rate for all United States patents that—

"(1) would necessarily be infringed by the practice of a technical standard; and

"(2) are committed to be licensed for reasonable and non-discriminatory royalties or on substantially equivalent terms.

"(b) A patent is committed to be licensed for reasonable and non-discriminatory royalties or on substantially equivalent terms if—

"(1) the patent has been identified by a person that contemporaneously owned the patent in whole or in part as subject to such a commitment; or

"(2) the patent is or has been owned in whole or in part by a person that has committed to license on such terms patents that would necessarily be infringed by the practice of the technical standard.

"(c) A person who participates in a standard-setting process and knowingly allows its technology to be incorporated into the technical standard shall be presumed to have committed to license its patents that claim such technology that is essential to the standard on reasonable and non-discriminatory terms.

Standard Essential Royalties Act

Lays out a legal standard for determining RAND obligations

"**§ 334. Determination and allocation of reasonable royalty rate.**

"(a) The court shall consider all relevant evidence submitted by the parties under section 333. The court may obtain the opinions of independent analysts and experts as to the value, validity, or essentiality of any patent identified under section 333(d)(1), may require by subpoena the production of information or evidence from persons who are not a party to the action, and may assign matters for resolution by a magistrate judge as appropriate.

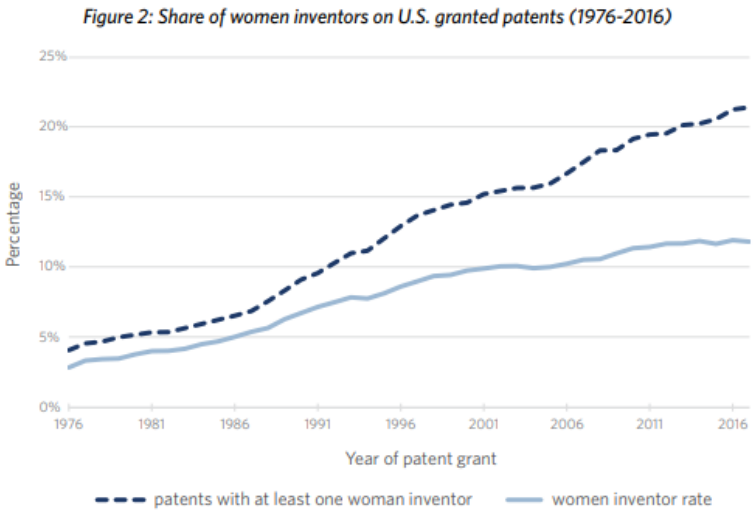
"(b) Upon briefing and a hearing, the court (without jury) shall determine—

> "(1) an overall reasonable royalty rate or rates for implementation of the technical standard;
>
> "(2) each plaintiff's entitlement to its appropriate portion of that royalty rate in view of the value of the technology claimed in the plaintiff's patent claims that is essential to the standard; and
>
> "(3) such other terms as are appropriately included in a license to a defendant.

Inclusive Innovation

Inclusive Innovation – How did we get here?

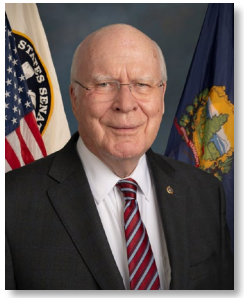
- **2018 USPTO SUCCESS Study**



Ethnicity of U.S.-Born Innovators	Percent of Innovation Sample	Percent of United States Population	Rate of Representation
White	59.6%	59.2%	1.0
Asian	1.5%	1.8%	0.8
Black or African American	0.3%	11.3%	0.0
Hispanic	1.4%	11.5%	0.1
Two or More Races	0.9%	1.9%	0.5
Native American	0.9%	0.9%	1.1
Total U.S.-born	**64.5%**	**86.5%**	**0.7**

Source: USPTO (https://www.uspto.gov/sites/default/files/documents/USPTOSuccessAct.pdf)

Legislative Developments



Unleashing American Innovators Act of 2022, S.2773

- Introduced 9/21/2021 in 117th Congress by Patrick Leahy (D-VT)
- Co-sponsors: Thom Tillis (R-NC), and Mazie Hirono (D-HI)
- Latest actions: Signed into law by President Biden on 12/29/2022, as part of the Consolidated Appropriations Act of 2023

Inventor Diversity for Economic Advancement (IDEA) Act, S.632

- Introduced 3/9/2021 in 117th Congress by Mazie Hirono (D-HI)
- Co-sponsors: Thom Tillis (R-NC), Christopher Coons (D-DE), Patrick Leahy (D-VT), Chuck Grassley (R-IA), Dick Durbin (D-IL), Richard Blumenthal (D-CT), Amy Klobuchar (D-MN), and Alex Padilla (D-CA)
- Latest action: 4/29/2021 - Committee on the Judiciary - Ordered to be reported with an amendment in the nature of a substitute favorably
- Not yet reintroduced

Unleashing American Innovators Act of 2022, S.2773

- USPTO satellite offices:
  - Statutory purpose includes outreach and retention activities targeting underrepresented groups and individuals from economically, geographically, and demographically diverse backgrounds
  - Establish Southeast Regional Office (within 3 years)
  - Report whether additional offices are necessary to increase participation by historically underrepresented groups (within 2 years)
- USPTO community outreach offices:
  - Statutory purpose includes educating prospective inventors, including from underrepresented groups
  - Establish 4 community outreach offices (within 5 years)
    - One in New England
    - No community outreach office located in a state with USPTO HQ or satellite offices

Unleashing American Innovators Act of 2022, S.2773

- USPTO's patent pro bono programs
  - Expand income eligibility to <= $400K
  - Study on USPTO's patent pro bono programs (within 1 year)
    - Must use findings to update pro bono programs
- Pre-prosecution assessment pilot program to help 1st time inventors to assess strengths and weaknesses of potential applications (within 1 year)
- Fee reduction for small and micro entities
  - Small entities discount: 50% → 60%
  - Micro entities discount: 75% → 80%
- Study on fees (within 2 years)
  - Must assess, *inter alia*, whether fees are inhibiting filing of patent applications for small and micro entities

Inventor Diversity for Economic Advancement Act, S.632

- Requires the USPTO to:
  - Request demographic information from the inventors on each patent application submitted to the USPTO
  - Publish an annual public report about the collected data, including the collected data broken down by the types of technology covered by the patent applications
  - Make the underlying data publicly available

PTO Initiatives to Promote Diversity

- **10/18/2022: Request for comment on whether the PTO should:**
  - Revise scientific and technical criteria for admission to practice in patent matters
  - Revise the accreditation requirements for computer science degrees
  - Establish a design patent bar
  - Clarify instructions for limited recognition applicants
- Comments close 1/23/2023


NATIONAL ARCHIVES

FEDERAL REGISTER

The Daily Journal of the United States Government

Notice

Expanding Admission Criteria for Registration To Practice in Patent Cases Before the United States Patent and Trademark Office

A Notice by the Patent and Trademark Office on 10/18/2022

Questions?

Thank you