

Questions for the Record from Mr. Darrell Issa for the Honorable Kathi Vidal  
Oversight of the U.S. Patent and Trademark Office, April 27, 2023

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1. Provisions of the Patent Act and the America Invents Act (AIA) provide rulemaking authority for the agency to promulgate regulations to administer PTAB proceedings. Do you agree that regulations promulgated under this authority must remain within the bounds of the statutes you administer?
2. USPTO released an advance notice of proposed rulemaking (ANPRM) last week that proposes a host of new regulations governing PTAB, most of which impose various substantive restrictions on entities seeking PTAB review of patents. Where in the AIA or any other statute are such restrictions mentioned or contemplated?
3. Section 311(a) of Title 35 says that anyone who is not the owner of the patent can file a petition seeking review of it. USPTO's proposed rules include a proposed ban on petitions filed by what it calls "for-profit non-competitive" entities. What statutory language does USPTO believe contemplates banning such entities from filing PTAB petitions?
4. Section 315(b) of Title 35 says that PTAB petitions are barred if they are filed more than one year after service of a complaint alleging infringement of a patent. USPTO's proposed rules include a proposed bar on petitions filed even within the one year period based on how fast the district court reaches trial on average, as well as other proposed restrictions that would cut the one year period short for some petitioners. What statutory language does USPTO believe contemplates reducing the one year time period for filing petitions based on the average speed to trial in district court or any other factor proposed in the ANPRM?
5. Currently, certain judicial districts have an average time to trial less than 18 months such that anyone sued for infringement in those districts would be presumptively banned from filing PTAB petitions unless they meet various new requirements under the rules proposed in the ANPRM. Where in Section 315(b), or any other statutory provision, is the basis for banning petitions based on which court they are sued in?
6. Section 314(a) of Title 35 says that, in all cases, you cannot institute an IPR unless the petition shows a "reasonable likelihood of prevailing." USPTO's proposed rules include a proposed change to that standard in certain cases, requiring the petition to instead show "compelling evidence of unpatentability." What statutory language contemplates that the Section 314(a) standard will be modified to this "compelling evidence" standard in certain cases?
7. USPTO's recent notice proposes rules that would ask PTAB judges to investigate the petitioner's relationships to third parties, contractual agreements, corporate structures, investments in certain products or services, and other such issues. Although they are

experts in patent law and have scientific or technical expertise, do you believe PTAB judges have appropriate expertise and are equipped to address all of those issues as well?

8. Where in the AIA, or any other statute, do you believe Congress contemplated PTAB judges adjudicating issues of corporate law, contract law, finance, business practices, etc.?
9. USPTO's recent notice proposes some rules it says are aimed at preventing repeated abusive attacks on patents at PTAB. But two studies that USPTO has conducted and published indicate that very few PTAB cases involved repeated serial attacks on patents. Does USPTO believe that repeated serial attacks on patents is a substantial problem, and what data is the agency relying on that supports that conclusion?
10. USPTO, like all executive agencies, must comply with the Congressional Review Act (CRA) for any agency statement "of general or particular applicability and future effect designed to implement, interpret, or prescribe law or policy or describing the organization, procedure, or practice requirements" of the USPTO, and that compliance is required before any such statement takes effect, as set forth in 5 U.S.C. § 801(a). Does USPTO intend to comply with the Congressional Review Act and submit the required report and materials to Congress and the Comptroller General before any final rule is ultimately issued from your recent ANPRM?
11. Does USPTO agree that its subject matter eligibility guidances have general or particular applicability and future effect since they apply to all patent applications currently pending and filed in the future; that the guidances are designed to implement, interpret, or prescribe law or policy; and that the guidances describe the procedure or practice requirements of USPTO, including that of patent examiners and PTAB?
12. Does USPTO agree that its 2022 memorandum prescribing guidance as to discretionary denials of PTAB petitions has general or particular applicability and future effect since it applied to all PTAB petitions pending at that time or filed in the future; that the memorandum is designed to implement, interpret, or prescribe policy; and that the memorandum describes the procedure or practice requirements of USPTO and PTAB?
13. Does USPTO agree that at least some of its designations of precedential PTAB decisions have general or particular applicability and future effect because they are binding on all PTAB judges and apply to all cases going forward; that those designations are designed to implement, interpret, or prescribe law or policy; and that those designations describe the procedure or practice requirements of USPTO and PTAB?
14. The stated basis for many of USPTO's PTAB rules such as the NHK/Fintiv rule and many of the proposed rules in its recent ANPRM is Section 314(a). Does USPTO believe that Section 314(a) grants the Director the authority to impose any condition on institution that the Director deems appropriate and, if not, what are the limits on the Director's authority?

15. In recent years, USPTO has been inundated with trademark applications originating in China that seek registration of marks often based on fraudulent information. The Chinese Communist Party and the government has, in the past, provided incentives to encourage this practice. Has the President or any Biden Administration official, including yourself, discussed the issue of fraudulent trademark registration filings with the Chinese government, and if so, what has been the response of the Chinese government?
16. You've often spoken about the importance and need for strong IP protections for U.S. innovators throughout the world. Do you agree that allowing China and other foreign competitors to waive the IP rights of U.S. innovators is harmful to those innovators and to our country?
17. China supported the waiver of IP protections on COVID-19 vaccines by the WTO, as did the Biden Administration before you became USPTO Director. Do you agree that China's biopharmaceutical industry has or will substantially benefit from having unfettered access to U.S. intellectual property on advanced vaccine and vaccine manufacturing technology?
18. The WTO is currently considering expanding the IP waiver to additional technologies, namely technology that could be used in therapeutics or diagnostics for COVID-19 regardless of whether they have other uses or applications. Do you agree that China's biopharmaceutical industry would substantially benefit from having unfettered access to U.S. intellectual property on these technologies?
19. Although the Biden Administration supported the initial WTO IP waiver, it supported delaying the decision on whether to expand the waiver. Were you or USPTO consulted when the Administration made the decisions on the initial waiver and the delay of the waiver's expansion, and if not, why not?
20. Is USPTO aware of any data indicating that IP rights held by U.S. businesses contributed significantly to any country's inability to vaccinate its population for COVID-19, and if so, what is that data?
21. Do you believe entities that have been sanctioned by the U.S. government, such as being placed on the Department of Commerce's Entity List, should continue to be able to apply for and receive U.S. patents, or enforce those patents against Americans?
22. Successive Administrations of both parties have identified countless instances of Chinese theft of U.S. intellectual property, Chinese attacks on U.S. trademarks via a flood of counterfeit goods, Chinese piracy of copyrighted content by U.S. creators, Chinese attempts to unfairly dominate international standard setting via patents, and other IP-related misconduct. What should Congress and USPTO prioritize and do to best support U.S. innovators and the American public against these urgent threats?
23. How does USPTO measure success in improving patent quality, and how does USPTO determine whether any particular patent quality initiative is successful?

Questions for the Record from Ms. Laurel Lee for the Honorable Kathi Vidal  
Oversight of the U.S. Patent and Trademark Office, April 27, 2023

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1. The USPTO has been investing heavily in AI and machine learning. Will this help reduce the growing examination backlog you have been experiencing? If so, how?
2. The USPTO has made a substantial investment in improving the quality of both the examination of patent applications and the publication of patent data. How would you assess the return on your investment, especially as it relates to patent data publication?
3. What do you see as the greatest challenges for examiners over the next few years, and how can the broader IP community help overcome them?

Questions for the Record from Mr. Nathaniel Moran for the Honorable Kathi Vidal  
Oversight of the U.S. Patent and Trademark Office, April 27, 2023

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1. Are you open to working with Congress to craft legislation that addresses the issues that the Advanced Notice of Proposed Rulemaking (ANPRM) seeks to implement?
2. Would you be willing to delay the effective date of the Rules proposed in the ANPRM, or place a pause on the rule-making process, until such a time that Congress can adequately address the issues the ANPRM seeks to address through the normal legislative process?
3. If the response to the above question is “Yes”, for what period of time would you be willing to recommend that the effective date of the Rules proposed in the ANPRM be delayed, or the rule-making process stayed?
4. One issue I have heard of frequently is the lack of Article III standards for Administrative Patent Judges (APJ), particularly when it comes to financial disclosure requirements. Earlier this year, press accounts surfaced of at least two cases in which an APJ presiding over a case was shown to have a direct financial interest in a company with multiple IPRs before the Patent Trial and Appeal Board (PTAB). I am concerned that at PTAB, where validity decisions are made that can have significant market implications, the lack of Article III standards is promoting a chilling effect on American innovation.
  - a. Has this matter come to your attention?
  - b. Does USPTO currently have a monitoring system in place to proactively identify and review any potential cases of financial conflict of interest?
  - c. In determining the assignment of APJs to specific cases, does PTAB take into consideration any financial conflicts that it should be aware of based upon APJs annual financial disclosure reports? In other words, if an APJ has a known financial holding in a party to a specific IPR could they still be assigned to preside over that case?
  - d. As Director, do you have the legal authority to review any past or ongoing instances in which an APJ has a financial interest in specific inter partes reviews before them? If so, have you personally reviewed any such instances and what actions have you taken?
  - e. Do you believe that IPRs in which an APJ who owns stock in a party directly involved in the review could at least have the appearance of impropriety and a biased outcome?
  - f. Does USPTO currently have the statutory authority to implement a zero-tolerance policy for financial conflicts of interest similar to the federal statute for Article III judges that you adhere to? If so, do you intend to pursue this course?

Questions for the Record from Mr. Hank Johnson for the Honorable Kathi Vidal  
Oversight of the U.S. Patent and Trademark Office, April 27, 2023

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1. I am concerned by the statistics showing continued underrepresentation of women and minority groups as inventors on patents. What steps is the USPTO taking to make patenting more inclusive?
2. What steps, if any, is the USPTO taking to improve the demographic information that it collects on patent applicants?
3. The Trademark Modernization Act of 2020 gave the office new flexibility to change the response times that applicants have to agency actions on trademark applications, updating the law from when the Lanham Act was passed and mail, instead of electronic communications, was the standard form of communication. How has the agency used this new rulemaking authority, and has it observed any benefits from this new flexibility?
4. The recently passed Trademark Modernization Act created new proceedings at the agency to allow for the challenge of issued trademark applications to invalidate trademarks that, in fact, had not been used in U.S. commerce, as required. Now that the agency has had about a year after its implementation of these proceedings, do you view them as a successful addition to the trademark landscape? Are there any alterations you think Congress should consider?
5. The USPTO has been investing heavily in AI and machine learning. Will this help reduce the growing examination backlog you have been experiencing? If so, how?
6. What do you see as the greatest challenges for examiners over the next few years, and how can the broader IP community help overcome them?

Questions for the Record from Ms. Deborah Ross for The Honorable Kathi Vidal  
Oversight of the U.S. Patent and Trademark Office, April 27, 2023

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1. Director Vidal, last year, I introduced the Unleashing American Innovators Act with Representative Mace and Senators Leahy and Tillis. This bill, which was signed into law in December, will have the Office open several smaller satellite offices around the country. How is the Office assessing where these satellite offices should be, and when do you anticipate their opening?
2. Can you tell us how the Office plans to reach out to inventors who are eligible for the law's expanded services, including a timeline?