



In Written Responses to Senators' Questions, Vidal Supports Iancu's 101 Guidance 'In Principle'



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In written answers to Senators' questions for the record submitted today by Kathi Vidal, President Joe Biden's nominee for the next U.S. Patent and Trademark Office (USPTO) Director, Vidal said that she “support[s] the principle of” former USPTO Director



Andrei Iancu's 2019 Revised Patent Subject Matter Eligibility Guidance for examiners, but stopped short of wholly endorsing the present guidance or committing to keeping it in

place. Instead, Vidal said she would review the guidance in light of intervening case law and comments on the USPTO's study on the state of patent eligibility jurisprudence to determine if updates are needed.

Only Senator Thom Tillis (R-NC) asked Vidal directly about her approach to patent eligibility. The topic also came up in her response to Senator Chuck Grassley's (R-IA) query about which policies of the previous administration she would keep in place, to which she replied that she would continue reforms made "in patent strength, trademark registry integrity, transparency and inclusiveness." As part of that, Vidal said she would "also review and update as appropriate guidance on 101 (patent eligibility) based on the results of USPTO study Senators Tillis, Hirono, Cotton and Coons requested on the current state of patent eligibility jurisprudence in the United States and on how that jurisprudence has impacted investment and innovation and based on intervening law since the last update in October 2019."

Additionally, Vidal said she would review stakeholder feedback on the Patent Trial and Appeal Board (PTAB) solicited under Iancu "to determine if prior policies strike the right balance and whether more is needed."

But in her reply to Tillis' more direct question on Iancu's examiner guidance, Vidal punted on addressing whether she actually supports it.

Tillis asked: "As you know, the previous USPTO Director issued examiner guidance related to patent eligibility. Do you support that guidance?"

And Vidal replied: "Given the uncertainty in the law, USPTO examination guidance was and is necessary to optimize consistent decision-making across art units and examiners. I support the principle of such guidance."

During her recent hearing in the Senate Judiciary Committee, as well as in her written responses, Vidal acknowledged that today's jurisprudence on patent eligibility "provides neither clarity nor consistency," and implied that the current examiner guidance is presently consistent with the law. But her written responses raise a question about whether her promises to review the guidance in light of intervening jurisprudence – which she admits is chaotic – might actually roll back some of the benefits Iancu's changes brought for patent owners.

PTAB and Big Tech Abuse in Focus

All of the senators who submitted questions for the record asked Vidal about her plans for the PTAB. Vidal echoed the sentiment of other patent stakeholders who have commented on the topic that, with 10 years of data accumulated since PTAB proceedings were

implemented, it may be time to review and potentially revise the procedures. She explained:

For example, I know based on my experiences (representing both patentees and patent challengers), and through common knowledge, that there is a wide disparity in how different courts deal with the parallel proceedings issue (a patent being challenged simultaneously in both the USPTO and in another tribunal such as district court) and related issues (estoppel, motions in limine related to IPRs and PGRs). Some judges will stay a parallel proceeding once an IPR/PGR is filed, some wait for institution, and some rarely stay. Beyond that, there are other criteria for stay that vary by tribunal, judge and individual case. The impact these procedures may have on small inventors or SME's (Small to Medium-Sized Enterprises), and potential abuses of the IPR/PGR process these procedures allow, should be evaluated to inform potential changes to PTAB practice.

Senators John Kennedy (R-LA) and Marsha Blackburn (R-TN) each asked several questions related to the PTAB and the potential imbalances in the system that may favor Big Tech over small inventors. Kennedy asked if Vidal agrees with the general proposition that the USPTO examination and PTAB processes favor Big Tech and Vidal replied that, while litigation of any kind can disadvantage small entities, “the USPTO applies the same statutory requirements during patent examination and in PTAB adjudications for all, regardless of the size of the applicant, patent owner or petitioner.” She also pointed to the Office’s fee discounts for small and micro entities for patent examination and maintenance, as well as for PTAB appeals, including the USPTO’s pro bono program for patent prosecution and soon-to-be pilot for PTAB appeals. As to concerns over serial filings by Big Tech companies, Vidal said “[t]he latter is somewhat ameliorated by the PTAB’s ability to exercise its discretion under *General Plastic Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357 (PTAB Sept. 6, 2017) (precedential), to prevent the filing of multiple challenges against the same patent.”

Blackburn asked Vidal to comment on pending lawsuits against former USPTO Director Michelle Lee that accuse Lee of “stacking the intellectual property system against inventors” and how Vidal would ensure that such stacking is addressed. Vidal replied: “To the extent there is concern the USPTO and the patent system are stacked to favor large companies and against small inventors, that can diminish confidence in our IP system and can impact innovation and investment in the same. It needs to be investigated.”

She also noted in her reply to Blackburn’s question about whether she, like Lee, has represented Silicon Valley clients in patent matters, that she has had clients across the spectrum, from Fortune 100 and Silicon Valley companies to underrepresented individuals.

However, she also noted in response to a question from Senator Josh Hawley (R-MO) that she has never represented Facebook, Twitter, Apple, Google, or Amazon specifically while at Winston & Strawn. She concluded: “If confirmed, I would commit to working with you, this Committee, and stakeholders to work on initiatives related to any perceived biases, build confidence in our IP system and promote access, education and support for all stakeholders.”

Other Senators included in the QFR responses were Patrick Leahy (D-VT); John Cornyn (R-TX); and Ted Cruz (R-TX).

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