

The way Kathi Vidal is using director review makes a lot of sense, says former top PTAB judge

William New
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Scott Weidenfeller served as one of four Vice Chief Administrative Patent Judges at a critical time for the Patent Trial and Appeal Board. His tenure, between 2017 and 2021, saw him serve as adviser to the Director of the USPTO when key Supreme Court rulings such as *United States v Arthrex* were being implemented. He returned to private practice with Covington & Burling a year ago.

Weidenfeller spoke recently with IAM about Kathi Vidal's approach to the review process, the evolution of the PTAB and broader concerns about the patent system. His answers have been edited for clarity and IAM style.

During your time on the PTAB you helped to implement the director review procedure, could you explain your role and how the review is helpful to judges?

I was there when we put the current interim director review process in place. There were a lot of people who worked on it: it was officially the chief judge at the direction of Drew Hirschfeld, who was then acting as director. It was my job to create the process and implement the *Arthrex* decisions.

The director review process provides a transparent, relatively efficient way for the director to set precedent governing and guiding the board. Panels, I think, are finding it useful that the director will take up a case and say what should happen in the particular scenario and make it precedential. It's clear it's the director saying it and the three judges on the panel can say: 'Yeah, I'm going to follow that. It's the director who told me they do it.' It's not: 'I'm signing on to an opinion that says it.'

Do you think current director Kathi Vidal is using the review process in the way that was first envisioned?

She's using it more than I expected. You never know when you create a new process how interested the director will be in using it, but I think that she is very interested in using it. I don't know what Director [Andrei] Iancu would have done. He might have done similar things, similarly used it aggressively. The way Director Vidal is using it makes a lot of sense to me.

All the directors I worked with had different levels of interest in the nitty gritty of a PTAB case. Knowing Director Vidal a little bit I was not expecting her to show up and have no interest in the PTAB.

You never know who the next director will be – it could have been someone who was really focused on international norms for patents or something. If that's what the director wants, they're not going to be sitting down doing the work required to do a director review of the number of cases that Director Vidal has done.

Do you feel like the patent system is in trouble and needs significant reform?

I don't think it needs significant reform. I understand the PTAB is something that is bad for patent owners because they can't get really anything good out of a PTAB trial. All they can get is to keep their patent. If the PTAB has said it's patentable, then that's a pretty nice gold star on top of your patent. But you can't win anything in the PTAB if you're a patent owner.

The agency's expertise is on the patentability side. It makes sense to have the PTAB looking at patentability issues instead of a jury. I understand that it's frustrating for patent owners, but I think there is some sense to having the expert body at the agency reviewing both rejections and grants by an examiner.

I don't think the patent system is broken, but if it is, it is because of the America Invents Act not what's happening at PTAB with *Fintiv*. I think that the real concerns that people have with the PTAB is that it exists, and my job wasn't to question whether it should exist or not.

But I come back to the notion that we're still issuing a lot of patents. It doesn't seem to me like people have stopped filing patent applications or have stopped getting patents. The number of petitions for *inter partes* review is higher than we anticipated, but it's not outlandish I don't think.

Do outcomes really depend on which mix of judges you get?

It does vary. They're judges exercising their own judgment and who bring their own experiences and backgrounds. One of the things I focused on when I was there was consistency across judges. You want them all to be working from the same framework. You may disagree with what the playbook says, but everyone knows what it looks like.

At the end of the day, you are asking a three-judge panel to exercise their judgment on patentability one way or the other. People have different views of exactly how to apply *KSR* to a particular set of claims and it does vary somewhat. One of the things that's beneficial for three-judge panels is that you end up building a consensus with three people which ends up with less likelihood that you're going to be an outlier because three people are agreeing to this.

What are your thoughts on current legislation to reform the PTAB?

I don't see anything earth shattering in the pending PTAB reform legislation. It's a lot more incremental. I think it's good for the system that we're chipping away at it for incremental things instead of having wholesale changes. There was a lot of uncertainty after the AIA and we're not fully there yet but we're getting there. I don't see the next *Oil States* or the next *Arthrex*, I think we're done with those, we'll have a clearer system going forward. But you never know, there might be someone thinking up something big.

There has been surprisingly little about the substantive changes in the AIA to Section 102. I think there are a lot of things in there that haven't really been answered or they have been answered by the PTO, but they haven't really been tested as to whether the PTO's interpretation is correct. I've been surprised that there hasn't been more litigation in that area and so maybe that will finally happen when more and more post-AIA patents are being enforced.

What should IP officers do differently to ensure their case is as strong as possible?

Knowing that the PTAB is there means that maybe you should be devoting more resources upfront, and not just getting a patent to get a patent but getting a portfolio of patents that you've actually done a reasonable search on yourself and tried to figure out the prior art landscape. A responsible chief IP counsel would not focus on just getting a patent, but getting a patent that can survive the PTAB, and that means putting in a little more resources upfront.

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