

3 COVID-19 Changes IP Attys Want To Keep & 1 That Must Go

By **Dani Kass**

Law360 (April 2, 2020, 8:38 PM EDT) -- To cope with the COVID-19 pandemic, the U.S. Patent and Trademark Office, Federal Circuit and other patent-heavy courts have adjusted some of their long-standing requirements. For the most part, intellectual property attorneys want the changes to stick around after the threat has passed, but there's one adjustment they think may take things too far.

While lawyers say they're happy to have more procedural hearings over the phone and by video, they don't want to give up on in-person oral arguments and trials. They're also particularly pleased to be saving thousands of dollars by not having to mail in paper copies of documents they already submitted online.

"I don't think we'll return fully from the practices that we're now adopting," King & Spalding LLP partner Gerald J. Flattmann Jr. said. "This has forced [courts to embrace technology] very, very quickly, and figure out not whether we're going to make it work, but how we're going to make it work, because we have to."

Keep It: Going Fully Paperless

If there's one thing attorneys don't want to come back, it's a requirement to give the Federal Circuit and U.S. International Trade Commission paper copies of filings they made electronically.

"If there's a large number of pages that are involved, you could be spending thousands of dollars on paper copies that no one is ever going to see, when it would have simply just cost you an hour of staff time to handle everything electronically only," said Fish & Richardson PC principal David B. Conrad.

Alston & Bird LLP partner Matthew W. Howell agreed the cost of sending documents to the Federal Circuit can easily be in the thousands, and that younger clerks and some judges are more likely to use the electronic copies anyway.

"It's nice shifting the printing burden a little bit more on an as-needed basis as opposed to just printing off copies of the entire record for every appeal just because that's what the rules say," Howell said.

He added that ITC complaints are equally frustrating to print out, as they feature several appendices.

Lowenstein & Weatherwax LLP partner Bridget Smith also said it's time for the “antiquated” practice to go.

“I’m quite frankly surprised that in 2020 the paper filings were still a common practice,” she said. “Welcome to the 21st century, finally.”

Keep It: No Handwritten Signatures

Saving another step of paperwork, the USPTO is no longer requiring handwritten signatures for payments, and attorneys hope it stays that way.

Hogene L. Choi, who runs Baker Botts LLP’s patent prosecution practice, said the credit card forms that require handwritten signatures — yes, you need to print a form, sign it in ink and then mail or scan it — are largely used by pro se inventors. Attorneys generally have accounts set up where they can pay online without the paperwork.

Choi suggested that the agency set up some kind of system like when shoppers pay as guests on retail stores’ websites, where they don’t have to make an official account but can still process a credit card digitally.

Paul Hastings LLP partner Naveen Modi agreed that it was an “outdated requirement,” and said “it would be nice to see [the forms] go away.”

During the pandemic, the USPTO has also waived signature and notary requirements for the Patent Electronic System Verification Form, which attorneys fill out when they start practicing at the agency, or switch employers.

Choi said this is one place where resuming signatures make sense as a fraud preventative.

“It is the one and only touchpoint at the USPTO where they require that you appear before someone — which is the notary — in person and that person can verify that you are who you say you are,” she said. “Otherwise, it’s just like the rest of the internet where it’s the wild wild west and you can be anybody.”

Keep It: Remote Procedural Hearings

At the Patent Trial and Appeal Board, attorneys are used to some level of videoconferencing. It’s not uncommon for one or two judges on the panel to join oral arguments remotely, and disputes over more procedural questions are often held remotely.

“They’ve been doing this for years,” King & Spalding’s Flattmann said. “They’ve already had technology

in place and they've been very adept at switching over to having even a greater percentage of hearings done telephonically."

Now it's time for courts to catch up, and attorneys are hoping they permanently start using phone or video conferences to handle more procedural or administrative motions. For example, Fish's Conrad said pretrial conferences have traditionally been held in person, when they could be moved remote — especially given that patent lawyers aren't necessarily practicing in their home town.

"It would be much less expensive," he added. "Patent law in particular is a very nationwide practice. Your lawyer may be in a different part of the country from where the hearings are being held, that's where you might find the best lawyer for your case. It would be more efficient if a lot of that can be done remotely."

Not all hearings fall neatly into these categories though, and it's unclear what will happen with proceedings that require evidence and witnesses, like those over evidence, preliminary injunctions and temporarily restraining orders, Conrad said.

What attorneys believe was the first remote Markman hearing took place last week.

"I think time will tell how that works out," Paul Hastings' Modi said

Toss It: Remote Oral Arguments, Trials

While remote hearings offer numerous benefits, lawyers don't want them when it's time to make their case for good. Flattmann said not being in the same room as a jury, judge or panel during a trial or oral argument undermines a lawyer's ability to advocate for a client. So far, attorneys said their trials have been postponed, rather than held over video, but it's not entirely clear where things are headed as the pandemic continues.

"There's something special about the vocation of oral advocacy that would be lost through moving everything to telephonic or virtual hearings," he said. "As a trial advocate there's really no substitute for being in the same room with the judge and with your adversary and reading their responses to what you're saying and their body language in real time."

Lowenstein & Weatherwax's Smith likewise said body language is a major concern, as it's harder to decide whether your argument is flopping, if the judges want to hear more or if the judges are hoping to get in a question.

"There's so many nuances in body language that we take for granted when we interact on a person-to-person basis that are lost over video conference," Smith said, adding that it's even more difficult over the phone. "Video conferencing you can cue in those a little bit more, but it's still so difficult, especially when you're talking about valuable patents and intellectual property rights."

McKool Smith PC principal Scott W. Hejny also said it's much harder to properly conduct a trial over video conference, especially when you're talking about something as complex as patents.

"Our job as trial lawyers is to share a compelling story with the jury and to develop a personal rapport with both the jury and the judge as we advocate for our clients," he said. "I don't think that same level of rapport can be achieved via video conference, which is a much more sterile environment."

Even at the PTAB, where video conferencing is common, it still isn't a perfect situation, said Morrison & Foerster LLP partner Alex S. Yap, a former administrative patent judge. The internet may work well, and the office provides a professional backdrop for its judges, but interacting with other people through technology can be strange, he said.

"It's a really different feeling when you have a video conference hearing, it's just really bizarre," he said. "... it is really weird when people are talking to you but they're not really looking at you. The back and forth is really awkward."

Smith, who works at a PTAB boutique, said it'd be especially hard when someone doesn't have access to AV technology as good as the agency has. That's an unfair position to put clients in and favors firms with more resources, she said.

"I know if I was doing this from my home right now, it would look like it was being filmed with a potato," Smith said. "I wouldn't want my client to be prejudiced by an unreliable internet connection. When we're talking about these really valuable IP rights, the idea of an unreliable internet connection potentially jeopardizing the flow of an important hearing is not ideal."

--Editing by Emily Kokoll.