

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# Patent Trial and Appeal Board Boardside Chat: PTAB Judicial Law Clerk Program

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July 14, 2022

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# Agenda

- Discussion of PTAB's Judicial Law Clerk Program
- Questions for our panel throughout the discussion
- Questions from the audience



# Question/comment submission

- To send in questions or comments during the webinar, please email:
  - [PTABBoardsideChat@uspto.gov](mailto:PTABBoardsideChat@uspto.gov)

# Goals

- Create a stronger patent bar
  - Train individuals to have specific PTAB *ex parte* appeal and America Invents Act (AIA) trial experience
  - Infuse private sector with PTAB judicial law clerks
- Develop future PTAB practitioners through training
- Mentor junior practitioners

# Panel questions



What is it like working with a former PTAB law clerk?

How has the PTAB clerkship prepared you for your career?

# Similarities with traditional clerkships

- Term limited position — one year
- Paid clerkship
- Learn about the inner workings of the judicial system
- Work closely with a judge
- Hone legal experience and writing skills
  - Conduct legal research
  - View oral hearings
  - Draft bench memos, orders, and decisions
  - Discuss cases with judges

# Differences from traditional clerkships

- Work with multiple judges — different judicial writing styles
- Patent law only
- Specialize in PTAB practice — experience complete life cycle of different PTAB cases, including AIA proceedings
- Potential rotation with the Under Secretary and Director of the USPTO



# PTAB judges

- Technically and legally trained — in addition to Bachelor and J.D., other degrees include Ph.D., M.D., LL.M., and M.S.
- Extensive previous experience in private practice, corporate, or other government organizations
- Based in USPTO offices (Alexandria, Detroit, Denver, Dallas, San Jose) and nationwide under the USPTO Telework Program

# PTAB judge dockets

- Adjudicate *ex parte* appeals and AIA proceedings
- *Ex parte* appeals — determine whether the examiner correctly rejected the claims of a patent application or reexamined patent
- AIA proceedings — determine whether the petitioner established the unpatentability of the challenged claims in an issued patent

# Panel questions



Why did you volunteer to serve as a mentor judge for a law clerk?

What is it like working with PTAB judges?

# Responsibilities

- Assist PTAB Judges
  - Review briefs
  - Conduct legal research
  - Attend hearings and pre/post hearing conferences
  - Help draft bench memos, orders, and decisions
  - Verify citations and proofread judges' decisions
- Work collaboratively with PTAB staff
- Participate in PTAB meetings and functions
- Attend conferences
- Create and participate in presentations

# Benefits

- Receive great training for your legal career
- Increase your market value with valuable credentials that will follow you throughout your career
- Gain valuable mentors
- Learn at the hands of experienced practitioners
- See a variety of cases with different substantive and procedural issues
- Get exposure to a wide variety of legal strategies
- Become a more efficient and effective legal writer
- Be part of a broad network of past and future clerks



# Panel questions



What is a typical day during your clerkship?

What are the most valuable things you learned during your clerkship?

# Panel questions



Is there something in particular that you do to make sure your law clerk is prepared for the next step in their career?

What skills do you actively look for in prospective associates?



# Application requirements

- Law Degree
  - Earned prior to start date of clerkship program
- Bar Admission
  - State Bar admission is not required, but encouraged
  - Patent Bar admission is not required, but encouraged
- U.S. citizen



# Application documents

- **Resume**
  - Education
  - Work experience
  - Information that sets you apart from other applicants
- **Transcripts**
  - Undergraduate
  - Graduate, if applicable
  - Law school
- **Cover letter (optional)**
  - Why do you want the position

# How to apply

- All government hiring is conducted through the USAJobs website
- The posting for the PTAB clerkship beginning in Fall 2023 will be on USAJobs.gov, and it is called Patent Attorney (Law Clerk)

# Hiring timeline

- Posting will close around **August 2022**
- Interviews in **October/November 2022**
- Offers extended in **November/December 2022**
- Start date in **September 2023**

# Panel questions

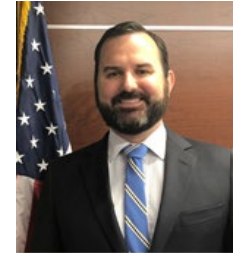


Why did you apply to be a PTAB law clerk?

If the PTAB clerkship existed when you were starting your career, would you have applied?

# Previous judicial law clerk classes

- Inaugural class in 2018-2019
- 4-8 law clerks per class
- 12 clerks now in private practice from coast-to-coast, with 3 more joining firms soon



# Panel questions



What would you say about your experience as a law clerk?

Do you keep in touch with your fellow clerks?

What would you say about your experience working with a former PTAB clerk?



# Judicial Law Clerk Program webpage

<https://www.uspto.gov/patents/patent-trial-and-appeal-board/ptab-judicial-law-clerk-program>

The screenshot shows the top portion of the USPTO website. At the top left is the USPTO logo and the text "UNITED STATES PATENT AND TRADEMARK OFFICE". To the right are links for "About Us", "Jobs", "Contact Us", and "MyUSPTO". Below this is a search bar with the text "Search uspto.gov" and a magnifying glass icon. A navigation bar contains links for "Patents", "Trademarks", "IP Policy", and "Learning and Resources", along with a "Find It Fast" button. Below the navigation bar is a breadcrumb trail: "Home > Patents > Patent Trial and Appeal Board > PTAB Judicial Law Clerk Program". To the right of the breadcrumb trail are "Share" and "Print" icons.

## Main menu

- Patents
- Trademarks
- IP Policy
- Learning and Resources
- About Us
- Jobs
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- MyUSPTO

## PTAB Judicial Law Clerk Program

Are you a second or third-year law student or an attorney at the beginning of your patent law career? Have you ever thought about clerking for a team of Patent Trial and Appeal Board (PTAB) administrative patent judges?

If you answered "yes" to these questions, the PTAB Judicial Law Clerk Program is for you!

The PTAB Judicial Law Clerk Program is designed to give recent law school graduates and junior attorneys hands-on and behind-the-scenes experience working with PTAB judges on America Invents Act (AIA) trials and ex parte appeals. PTAB judicial law clerks become familiar with all aspects of a PTAB trial and gain in-depth knowledge of appeals from adverse examiner decisions. In addition, when our law clerks leave PTAB, they join a collegial and growing network of former PTAB law clerks.

Like traditional clerkships, the PTAB Judicial Law Clerk Program provides clerks the opportunity to work directly with judges and learn about the adjudicatory process, but it is also unique. It focuses exclusively on patent matters—thus providing valuable insight into both prosecution practice and post-grant proceedings.

### Responsibilities of a PTAB judicial law clerk

A PTAB judicial law clerk will be assigned to work primarily with three PTAB judges. A PTAB judicial law clerk assists PTAB judges with PTAB trials and ex parte appeals. Specifically, our law clerks typically review the arguments and evidence of record, analyze pertinent legal and technical issues, and recommend to the PTAB judges how to resolve various issues. PTAB judicial law clerks also attend case conferences, observe oral arguments, and complete a variety of writing assignments, such as bench memoranda, opinions, orders, and summaries of prior art and technology.

Our law clerks also work with others at the PTAB and the United States Patent and Trademark Office (USPTO) on special projects and initiatives concerning patent laws and policy. For example, current and former PTAB judicial law clerks have worked with the Director on a variety of agency-wide issues.

A PTAB judicial law clerk gains significant legal skills, such as legal writing, legal research, and communication about complex issues of law and technology. A PTAB judicial law clerk also hones technical expertise by working in a vast array of technological fields. Over the course of the clerkship, PTAB clerks build a wide-ranging professional network through interactions with other law clerks, USPTO and PTAB staff, and patent practitioners.



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