



Next USPTO administration should stress “a strong IP ecosystem”, says Kathi Vidal

Angela Morris

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Kathi Vidal, partner in Winston & Strawn/file photo

Coke Morgan Stewart is moving into her office to become acting director of the US Patent and Trademark Office until President Donald Trump nominates a permanent director and the Senate confirms the person to office. Former US Patent and Trademark Office Director Kathi Vidal says she hopes the new administration will prioritise a strong intellectual property ecosystem.

Vidal resigned as USPTO director on 13 December and “took the weekend off” before re-starting her former position as a partner in Winston & Strawn in Silicon Valley. In an exclusive interview with IAM, Vidal reflected on her legacy at the patent office, laid out plans for future IP policy advocacy in the courts, and shared advice for her successor.

“We as a country need a strong IP ecosystem that continues to fuel our economy and that helps us solve for community and world problems such as wildfires and the next pandemic. We need to cut down on uses of the system for private gain that effects a tax on US industry. And, we need to solve for all of this while leaning in hard on AI policy and leadership in standardised technology (both on the innovation side and on the implementation side),” states Vidal. “To do all this, we must prioritise people first and have good working relationships with the unions (three of which represent employees of the USPTO). I will not speak to the next administration except to say that I’m here to support from the private sector as we work together to move our country forward.”

When asked how the next leadership should approach standard essential patent policy, Vidal replies that the US could “step up and play a meaningful role where one is needed to impart a balance”. Her approach was to seek stakeholder feedback and to implement ideas that were best for the country. While in office, Vidal recalls, the USPTO and other agencies gave feedback on SEP policies in Europe and China.

“Generally speaking, we need to make sure policies advanced outside of the US do not put the US or our allies at an unfair advantage when it comes to innovation,” Vidal comments.

We interviewed Vidal as part of our monthly [Women in IP](#) profile series. Our stories featuring top-level female IP executives pick their brains about substantive issues surrounding intellectual property strategy, team leadership, negotiation skills and market developments.

USPTO legacy

President Joe Biden nominated Vidal as USPTO director in October 2021 and the Senate confirmed her in April 2022. Reflecting on her time in office, Vidal says it was a team effort and, “we stuck the landing”. After hearing feedback from 2,000 USPTO employees, Vidal says she made advances in the agency.

“We gave up a pay raise the patent examiners that hadn't happened in 15 years,” she says. “We entered into agreements with the unions that hadn't been entered into in decades.”

Three unions represent USPTO workers: the Patent Office Professional Association, the National Treasury Employees Union (NTEU) Chapter 243 and and NTEU Chapter 245.

The office worked with other administrative agencies, she says.

“We really reoriented the USPTO to being proactive, not waiting for people to call on the USPTO as part of the interagency process at the end of decision making, but leaning in heavily across the government at the beginning of decisions and having a seat at the table so that all of the policy that was shaped was shaped with innovation policy, IP policy in mind,” says Vidal. “That's not just the list of accomplishments. ... It was also stopping things from happening that would have been destructive.”

For example, Vidal says the agency stopped forced tech transfer in global agreements and a design law treaty and advocated against extending the TRIPS waiver to covid diagnostics and therapeutics.

One big accomplishment in Vidal's opinion was increasing transparency in the Patent Trial and Appeal Board. The USPTO issued director review rules, rules for internal decision circulation and review procedures, and a policy memo for panelling judges. The effort aimed at “making everything public, making our procedures public, making sure that the director was not interfering with individual judges, that they had their own judicial independence, making sure we weren't panelling judges on cases that they had any stock in a company. That whole bucket was pretty important”, states Vidal.

The USPTO website lists additional [strategic plan accomplishments](#) under Vidal's tenure. Among other things, the agency:

- Withdrew the 2019 SEP joint statement, helped develop the US Government National Standards Strategy for Critical and Emerging Technology and entered a memorandum of understanding with the UK Intellectual Property Office on SEP policies;
- Advanced innovator diversity efforts by strengthening the Patent Pro Bono Programme, releasing the National Strategy for Inclusive Innovation and engaging through multiple diversity and inclusivity programmes;
- Advanced patent practitioner diversity by creating a new design patent bar, expanding the PTAB and USPTO bars and focusing on DEI within the USPTO workforce;
- Boosted public outreach by opening a public engagement business unit, new outreach offices and engaging with educators, K-6 students, colleges and libraries;
- Issued guidance for AI-assisted inventions, the use of AI tools by the patent bar, and subject matter eligibility for AI inventions and studied the use of AI to improve patent examination speed and quality.
- Acted to reduce scams and fraudulent activities in trademark registrations.

She is also proud of the agency's outreach to the wider patent community. It engaged with smaller organisations that normally do not keep IP on their agenda. The office put forth rulemaking packages and listened to stakeholder feedback to solve complicated IP issues, says Vidal. Because the policies were issued via official rulemaking processes, they are more likely to persist and become permanent, she points out.

She mentions she got almost all her priorities across the finish line, with one exception.

“The one thing that we didn't push across because we wanted buy-in from the next administration, is the rule package on discretionary denial. It's teed up and ready to get across the finish line if the next administration has buy-in. If they want to tweak it, certainly it's in a position where they can tweak it,” says Vidal. “We wanted to make sure that we did a lot of groundwork, did a lot of listening, put out requests for comments, so that the next administration could also have a similar trajectory, where they could take things on early, interact with stakeholders and make a positive impact.”

Though the discretionary denial rulemaking package did not become final, Vidal did place her stamp on the agency's use of discretionary denials. She issued a policy memo in 2022 that clarified and limited how the PTAB should use the procedure. IAM has reported data showing the impact was a drastic decrease in discretionary denials. Overall, the institution grant rate inched up during the years of Vidal's tenure. But she says that was not her intent.

“The intent of the memo – and other decision-making – was to create more clarity and certainty for the PTAB judges as well as the parties and public at large. Prior to issuance of the memo, each panel of three judges could weigh the *Fintiv* factors however they wished, creating inconsistent decision-making,” Vidal expresses. “There was never any policy advanced to

effect outcomes. It was all about making the system stronger, clearer and more certain.”

Another rulemaking proposal that brought backlash from the patent community dealt with terminal disclaimers. Patentees with a continuation application strategy would see a negative impact. Before Vidal left office, the USPTO withdrew the idea. We asked her why. Vidal replied that the agency took the public comments seriously. She adds: “We reviewed the comments and determined that in light of resource constraints, we would not move forward.”

Joseph Hetz, partner in Crowell & Moring in Chicago, states via email that the terminal disclaimer proposal was controversial and may impact Vidal’s legacy.

“Director Vidal’s stated mission was to ‘rethink everything’, and under her leadership, the USPTO proposed several rule changes. While some of those rule changes were implemented, Ms. Vidal will likely be remembered for controversial proposals that were not implemented. For example, the USPTO withdrew a proposed change to terminal disclaimer practice in the face of concerns that the changes were outside of the USPTO’s authority. Those changes, if implemented, would have discouraged an applicant from filing continuations,” explains Hetz. “Even proposals that were implemented, such as the increased fees for filing RCEs and a tier-fee structure related to priority claims, are seen by some as an impediment to filing continuations, which is a statutory right.”

Susan Natland and Zach Rufa, attorneys at Knobbe Martens, wrote in IAM’s sister platform [World Trademark Review](#) that they will remember Vidal for her improvements to engagement, access and inclusion for employees and stakeholders; and her leadership of the agency’s approach to the AI revolution”.

“Vidal embraced her role as the agency’s principal officer by finalising the rules governing [director review](#). This consequential rulemaking, coupled with Vidal’s issuance of [guidance](#) regarding discretionary denials under *Fintiv*, showed a willingness to expand and update USPTO operations and procedures while maintaining a commitment to transparency,” they wrote. “She made tangible strides in the agency’s efforts to increase access to intellectual property and to increase diversity, equity and inclusion in the IP ecosystem.”

Future plans

Vidal has been back at Winston for a little over a month now. She reveals: “It’s been a whirlwind already, which has been really exciting. A couple of the cases that I was on before I went to the PTO are now going to trial.”

Other clients she served previously have requested Vidal on their matters, and she has accepted work as an expert witness on a case, though she warns she’s doing expert work sparingly. Vidal adds: “If it seems to be a good fit and makes sense, then I’m happy to consider those. But that’s not going to be bread and butter for me.”

Some other departments at Winston have knocked on Vidal’s door for help with US policy topics she worked on during her government service. For example, the firm’s government contracts group has consulted with her about semiconductor clients implementing the Chips and Science Act and looking for funding opportunities. Projects like this fulfil Vidal, she mentions, because “we can not only serve clients, but do the greater the greater good, the greater work of helping to shore up supply chains for the US and our allies”.

Her vision for her law practice going forward is to advance cases that make an impact. Compared to an administrative agency’s limited authority, legal advocacy in the judiciary can play an outsized role in shaping IP policy, she points out.

“I’ve identified two areas where I’m looking to do amicus briefing and really help shape the law. I’m working on a couple of projects related to that. I’m looking for opportunities to help clients weigh in at the intersection of AI and copyright in the district courts. I think that’s an important place where we need to shape the law and the cases from the get-go,” explains Vidal. “Same thing with standard essential patents: I’m really wanting to lean in heavily on that and make sure that we’re shaping that in the right way – that it’s not used to pick winners and losers when it comes to the next technologies, to the extent that that might mean that the US is not a winner, or allies are not winners.”

Other major issues where Vidal would consider amicus work include:

- Constitutional trademark issues reaching the US Court of Appeals for the Federal Circuit, like the “Trump too small” debate about the description of a brand;
- Patent eligibility law;
- Design patent law in the aftermath of LKQ and the impact on industries like fashion, consumer goods and automotive; and
- US International Trade Commission advocacy to cut down on counterfeit goods.

Vidal says she would consider writing public comments or testifying before Congress for issues she feels will impact the US and its allies.

“I only want to do that where I truly believe it’s best for the country, as opposed to somebody paying me saying, ‘Can you please go advocate for this?’ That’s not that’s not something I’m interested in,” she notes.



Angela Morris

Deputy editor
IAM

angela.morris@lbresearch.com

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