



Request for Proposals—February 3, 2022

U.S. Patent Small Claims Court

The Administrative Conference of the United States (ACUS) is seeking a consultant(s) to participate in an independent study for the U.S. Patent & Trademark Office (USPTO) on the feasibility of a potential small claims patent court. The consultant(s) will work in partnership with the ACUS Office of the Chairman to produce a report that will be submitted to USPTO on behalf of the Office of the Chairman.

Project Description and Consultant Responsibilities

Since at least the late 1980s, concerns have been raised that the high cost of patent litigation deters small- and medium-sized enterprises, particularly those owned by traditionally underrepresented groups, from seeking patent protection enforcement. Policymakers, scholars, and organizations have studied whether a small-claims procedure is needed for resolving patent disputes. They have reached different conclusions and proposed different actions.

The Department of Commerce has also considered the possibility of a small claims patent court. Most recently, in December 2012, the USPTO issued a *Federal Register* notice requesting public comment on “whether the United States should develop a small claims proceeding for patent enforcement” (77 Fed. Reg. 74830 (Dec. 18, 2012)).

Given ongoing interest in the topic, USPTO is engaging ACUS to conduct an independent study of issues associated with and options for designing a small claims patent court. The resulting report, which will ultimately be submitted to Congress, will address topics including:

- Whether there is need for a small claims patent court;
- The operation and structure of similar small claims intellectual property tribunals in the United States and elsewhere;
- The relevant laws that would govern the establishment of a small claims patent court, including the United States Constitution and applicable statutes and regulations;
- The policy and practical considerations in establishing a small claims patent court;
- The institutional placement, structure, and internal organization of a potential small claims patent court, including whether it should be established within the federal courts, as or within an Article I court, or as an administrative tribunal;

- The selection, appointment, management, and oversight of officials who preside over proceedings in a potential small claims patent court;
- The subject-matter jurisdiction of a potential small claims patent court, whether participation in such proceedings would be mandatory or voluntary, and whether parties can remove cases to another administrative tribunal or federal court;
- The procedures and rules of practice for a potential small claims patent court, including, as relevant, pleadings, discovery, and alternative dispute resolution;
- The remedies that a potential small claims patent court would be able to provide;
- The legal effect of decisions of a potential small claims patent court; and
- Opportunities for administrative and/or judicial review of small claims patent court decisions.

The consultant(s) will be expected to work with the Office of the Chairman to complete a draft report by January 20, 2023, and deliver a final report to USPTO by March 31, 2023. In researching and writing the report, it is anticipated that ACUS staff will focus primarily on general topics of administrative law and procedure while the consultant(s) will focus on subjects requiring greater expertise in patent law.

The report will be submitted to USPTO in the name of the Office of the Chairman with members of the research team, including participating consultant(s), listed as authors on the cover. The report will also be published on the ACUS website. Because the report is being prepared by the Office of the Chairman for USPTO, the consultant(s) will not have the right to independently publish or arrange for publication of any materials produced, collected, created, or written under contract with ACUS, including draft and final reports.

The Conference may select a single consultant or assemble a team of consultants depending on the proposals it receives. The total value of consulting fees for this project will not exceed \$75,000, to be apportioned in accordance with the number of consultants and division of responsibilities.

Submitting a Proposal and Evaluation Criteria

If you are interested in serving as a consultant for the report, send an email to Kazia Nowacki (knowacki@acus.gov) with the phrase “ACUS Project Proposal” in the subject line. Attach your curriculum vitae to the email, along with a short statement (ideally no more than two pages) that addresses your interest in this study, describes specific topics you would be interested in researching and the methodologies you might employ to do so, and identifies any relevant scholarship you have published.

All responsible sources must submit a proposal by 5:00 p.m. Eastern Time on March 4, 2022, in order to be guaranteed consideration by the agency.

Proposals will be evaluated based on quality, clarity, and the proposer's qualifications, including a record of published scholarship. The Conference has a strong preference for consultants who have previously authored and published relevant scholarly work, such as in the fields of administrative law and procedure and patent law.