

## Ex-PTAB Leader Reflects On USPTO After Leaving Agency

By **Dani Kass**

*Law360 (September 15, 2025, 10:15 PM EDT)* -- One of the Patent Trial and Appeal Board's most senior judges has left the U.S. Patent and Trademark Office after more than 13 years, and soon after joining private practice she spoke with Law360 about her history at the agency and the current dynamics playing out at the office.

Jackie Wright Bonilla started at Sterne Kessler Goldstein & Fox PLLC earlier this month after serving as deputy chief administrative patent judge and acting director of the Central Reexamination Unit, which handles a type of patent challenge where the review is conducted by a panel of examiners, rather than APJs, and the challenger does not participate.



Jackie Wright Bonilla

Bonilla joins several other high-profile employees leaving the agency, which is facing rapid changes, particularly with respect to staffing and practice at the PTAB.

In particular, the changes relating to PTAB practice center on acting USPTO Director Coke Morgan Stewart bifurcating the process of deciding whether to institute inter partes or post-grant reviews, with her reviewing non-merits discretionary factors and the PTAB reviewing the merits of petitions she has cleared.

Bonilla said having policy swings between administrations is standard, even if it's "always discombobulating," but that during her time at the agency, "we have never seen changes at this level."

"This type of thing is not specific to the USPTO, of course, but it is certainly happening there, too," she said.

Before joining the agency in 2012 as an administrative patent judge and then working her way up to leadership, Bonilla practiced with Foley & Lardner LLP and Finnegan Henderson Farabow Garrett & Dunner LLP, and clerked for now-retired Federal Circuit Judge Randall Rader.

She earned a Ph.D. in pharmacology and her law degree from the University of Virginia, and an undergraduate degree in biochemistry from the University of California, Berkeley.

At her new job, she'll be using that Ph.D. to focus on life sciences litigation, including at the PTAB and CRU. She's joining two other former APJs — one of whom joined Sterne Kessler in April, and the other in 2022 — to provide insight on an evolving agency.

Representatives for the USPTO didn't immediately respond to a request for comment Monday.

This interview has been edited for length and clarity.

### **What drew you to the PTAB?**

While I was at Foley, I did a lot of interference work, including some intense ones relating to vaccines. As part of that process, I really admired the board judges. I just thought they were so smart. I thought, "Wow, that'd be really cool to do that someday." And then years later, the America Invents Act passed, and they were hiring at the board. It was very difficult to get a job at the board, especially if you were just somebody from a random law firm. But once it became clear they were hiring, I leaped at it.

### **What stood out to you during your time as a deputy chief administrative patent judge?**

For eight years up until recently, we worked on the issue of discretionary denials or discretionary considerations for AIA institutions. We started out in 2017, thinking about precedent for what we call serial petitions, where there's more than one petition filed by a petitioner or a related petitioner.

We thought about things like Section 325(d), and that's when the same or substantially the same arguments are before the office and how that jurisprudence looks. We thought about what we call parallel petitions, which is when the same petitioner files more than one petition at the same time. And we came up with factors that we take into account about whether we would allow that or not, trying to be mindful of areas where there might be abuse, but also mindful that there might be circumstances where it does actually make sense as a matter of fairness.

And of course, the infamous Fintiv jurisprudence — what happens when a district court is also dealing with the patent, and if it's likely that the district court is going to deal with the same issues that PTAB will, and if the case will actually go to trial before we can even get to a final written decision. We did a lot of work there.

### **How do you suggest attorneys deal with rapidly developing policy at the USPTO?**

Things are in a state of flux right now, and honestly, it can change by the day. The bifurcated process to determine whether institution is right has led to a lot of uncertainty for many at the moment, just because people aren't exactly sure what's going on. That's probably why it's good to have a patent attorney helping you. But pay attention to what's the latest and greatest so that you can make sure that, whether you're a patent owner or a challenger, you really know the lay of the land as it's happening.

### **The acting director has been advocating for more PGRs or ex parte reexaminations, rather than IPRs. What was your experience at the Central Reexamination Unit, and are you seeing that play out?**

I worked with the CRU for a little over two months before I left, and I was very impressed with the CRU's work. The people there are so hardworking and really smart.

There is a thought out there with all the uncertainty as it relates to IPRs, as well as having a rate of denial of institution that is unprecedented under the new process, that ex parte reexams may increase and may become more important. I don't know if we have seen that yet. I don't recall seeing a spike in filings of ex parte reexams overall, but it is something to pay attention to.

I think it makes sense for the stakeholders to understand their options there and how reexams differ from IPRs and what their options are, and when it makes sense to do one versus the other.

**The acting director just reassigned Chief PTAB Judge Scott R. Boalick and Vice Chief PTAB Judge Mike Tierney to the CRU. Did it seem like resources were being shifted?**

I think it's preliminary because, at this exact moment, you're seeing people leave the [USPTO]. The CRU, just like everywhere else at the office, lost some people. I think that that's also in a state of flux at the moment.

But I also think that the fact that they [reassigned] me from PTAB to go over, and now Scott Boalick and Mike Tierney to go over — who are excellent leaders, and they've maneuvered through all sorts of things at the PTAB — shows the importance of what reexaminations are to the office and the agency making sure they have good leadership there.

**What are you looking forward to at Sterne Kessler?**

I'm hoping I can provide some value in terms of the perspective on the interplay between what happens at the USPTO and what happens in IP litigation.

I'm also really excited about joining my former PTAB colleagues Jennifer Chagnon and Melissa Haapala, who were both prior leaders at PTAB who I've worked with. Just having the three of us together brings a rare insider's perspective that enhances the firm's ability to advise clients, particularly on complex patent litigation and strategy. That's what I'm hoping I can bring to the table at a firm that's clearly already good at it.

--Editing by Alanna Weissman.