

## USAGE OF PATENTS IN EMPLOYMENT-BASED PETITIONS

BY BRIAN C. SCHMITT & NATHAN A. WAXMAN

*That reminds me to remark, in passing, that the very first official thing I did, in my administration—and it was on the first day of it, too—was to start a patent office; for I knew that a country without a patent office and good patent laws was just a crab, and couldn't travel any way but sideways or backwards.*

— Mark Twain<sup>1</sup>

### Introduction

Many beneficiaries and some petitioners have an urge to present evidence of intellectual property and/or patentable subject matter in certain employment-based preference petitions. For example, a beneficiary of an EB-1 extraordinary ability petition may feel patentable subject matter should be disclosed in the petition as evidence of a contribution of major significance or commercial success to the field.<sup>2</sup> Or a beneficiary may want to disclose such evidence in support of a *NYSDOT* national interest waiver petition.<sup>3</sup> This kind of evidence can take the following forms: a printed publication, an uncatalogued doctoral thesis, a paper that is not yet published, an internal disclosure of an invention, a manuscript, or a grant application. This paper explores why including such materials in an employment-based petition is unlikely to create issues with regard to seeking a patent on the subject matter in the future; it also examines some practical issues to consider when submitting this kind of material in such a petition.

### I. USAGE OF PATENTABLE SUBJECT MATTER IN EMPLOYMENT-BASED PETITIONS FROM A PATENT LAW PERSPECTIVE

Section 101 of the Patent Act sets forth categories of patentable subject matter: “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.”<sup>4</sup>

“Invention” is defined as an “invention or discovery,”<sup>5</sup> which indicates that the invention may include discovering new processes or products, as opposed to creating them.<sup>6</sup>

An invention must be “new” to be patentable.<sup>7</sup> Under 35 U.S.C. § 102, the invention must be new with regard to three distinct legal bases:<sup>8</sup> (1) anticipation;<sup>9</sup> (2) priority;<sup>10</sup> and (3) derivation.<sup>11</sup> Our focus here is on anticipation.

Anticipation bars a patent for an invention that was already publicly known.<sup>12</sup> The statute states:

(a) Novelty; prior art. A person shall be entitled to a patent unless—

(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention; . . .<sup>13</sup>

An invention is not patentable if it is in a publication or product or other evidence of public knowledge, in the various sources that contain references to all elements of the claimed invention.<sup>14</sup> A reference is a printed publication when it has been disseminated or otherwise made available such that “persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it.”<sup>15</sup> For example, “a doctoral thesis indexed and shelved in a library is sufficiently accessible to the public to constitute prior

<sup>5</sup> 35 U.S.C. § 100(a).

<sup>6</sup> Stephen M. McJohn, *Intellectual Property Examples and Explanations* 105 (2003).

<sup>7</sup> *Id.* at 127.

<sup>8</sup> *Id.* at 128.

<sup>9</sup> 35 U.S.C. § 102(a).

<sup>10</sup> 35 U.S.C. § 102(g).

<sup>11</sup> 35 U.S.C. § 102(f).

<sup>12</sup> McJohn, *supra* note 6, at 128.

<sup>13</sup> 35 U.S.C. § 102(a)(1).

<sup>14</sup> McJohn, *supra* note 6, at 128.

<sup>15</sup> *Manual of Patent Examining Procedure* § 2128 (9th ed. 2014) (“MPEP”).

<sup>1</sup> Mark Twain, *A Connecticut Yankee in King Arthur's Court* 65 (1889).

<sup>2</sup> 8 C.F.R. § 204.5(h)(3)(v), (x).

<sup>3</sup> *Matter of N.Y. State Dep't of Transp.*, 22 I. & N. Dec. 215 (Acting Assoc. Comm'r, Programs 1998) (“*NYSDOT*”).

<sup>4</sup> 35 U.S.C. § 101.

art as a 'printed publication.'"<sup>16</sup> Additionally, a paper presented orally "in a forum open to all interested persons constitutes a 'printed publication' if written copies are disseminated without restriction."<sup>17</sup> By contrast, "documents and items only distributed internally within an organization which are intended to remain confidential are not 'printed publications' no matter how many copies are distributed."<sup>18</sup> Ultimately a patent claim "is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."<sup>19</sup>

For our purposes, let us assume that the beneficiary of an EB-1 or EB-2 NIW petition has written a paper that describes the entire invention. The paper has not yet been published, but his employer has indicated that it will be seeking patent protection for the technology. The beneficiary wishes to include the unpublished paper in his petition. USCIS is not required to treat employment-based petitions confidentially.<sup>20</sup> Will the disclosure of the invention to USCIS create any problems in seeking a patent in the future? Applying the above analysis, the answer is likely no. Including the paper is not a dissemination as such because those persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, would not reasonably be able to locate it.

Assume all of the facts of the preceding paragraph are in play and the underlying employment-based petition is denied. Further assume that an appeal is filed where the USCIS Administrative Appeals Office (AAO) remands the case to the service center, ordering it to approve the petition. The entire invention is disclosed in the AAO opinion, which is posted publicly to the AAO website. Will this publication create any problems in seeking to patent the invention in the future? The U.S. Court of Federal Claims held that "[w]hile distribution to government agencies and personnel alone may not constitute publication

(*Ex parte Suozzi*, 125 USPQ 445 (P.O. Bd. App. 1959)), distribution to commercial companies without restriction on use clearly does."<sup>21</sup> The Manual of Patent Examining Procedure goes on to state:

Four reports on the AESOP-B military computer system which were not under security classification were distributed to about fifty organizations involved in the AESOP-B project. One document contained the legend "Reproduction or further dissemination is not authorized." The other documents were of the class that would contain this legend. The documents were housed in Mitre Corporation's library. Access to this library was restricted to those involved in the AESOP-B project. The court held that public access was insufficient to make the documents "printed publications."<sup>22</sup>

*Garrett Corp. v. United States* does not squarely address our hypothetical because the invention was disclosed to a government agency, but the AAO, in turn, published the full invention disclosure on its website, which is available to anyone interested and ordinarily skilled in the subject matter.<sup>23</sup> Similarly, the MPEP's summary of *Northern Telecom Inc. v. Datapoint Corp.* does not squarely address our hypothetical either, because the disclosure was not submitted to the government agency (USCIS AAO) with any security classification or request for confidentiality.<sup>24</sup> Arguably, USCIS could disregard evidence that is labeled confidential. On the flip side, USCIS could also lawfully disregard such a request and publish the disclosure anyway, provided that doing so would not violate the Privacy Act of 1974.<sup>25</sup> Additionally, the publication of the material at issue was restricted to individuals involved in a government project, whereas the materials in our hypothetical would be available to anyone with an internet connection.<sup>26</sup> As such, the disclosure in the hypothetical could very well create issues with the patentability of the disclosed subject matter.

Of course, the possibility of the AAO publishing the disclosure in an opinion is infinitesimal. However,

<sup>16</sup> MPEP § 2128.01 (citing *In re Hall*, 781 F.2d 897 (Fed. Cir. 1986)).

<sup>17</sup> *Id.* (citing *Massachusetts Institute of Technology v. AB Fortia*, 774 F.2d 1104, 1109 (Fed. Cir. 1985)).

<sup>18</sup> *Id.*

<sup>19</sup> MPEP § 2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987)).

<sup>20</sup> Department of Homeland Security (DHS) is required to treat certain information related to T and U applications with confidentiality. 8 U.S.C. § 1367; 8 C.F.R. § 214.14(e). Additionally, DHS is required to treat certain information related to asylum applications confidentially. 8 C.F.R. §§ 208.6, 1208.6.

<sup>21</sup> *Garrett Corp. v. United States*, 422 F.2d 874, 878 (Ct. Cl. 1970).

<sup>22</sup> MPEP § 2128.02 (citing *Northern Telecom Inc. v. Datapoint Corp.*, 908 F.2d 931 (Fed. Cir. 1990)).

<sup>23</sup> MPEP § 2128.

<sup>24</sup> MPEP § 2128.02.

<sup>25</sup> 5 U.S.C. § 552a.

<sup>26</sup> MPEP § 2128.02.

given that there is a non-zero risk of disclosure, a discussion of ways to mitigate this risk is in order.

In order to mitigate against this small risk, the petitioner or beneficiary could hastily file a provisional patent application.<sup>27</sup> The filing of a provisional patent application, including a specification, cover sheet, any required drawings, and the requisite fee, would allow a domestic patent applicant to gain priority by filing.<sup>28</sup> The applicant then has twelve months to convert a provisional application to a nonprovisional application.<sup>29</sup> In essence, this would preserve the inventor's ability to seek a nonprovisional application within twelve months. Therefore, if the inventor in our hypothetical made a disclosure, the inventor would still be able to seek a nonprovisional application on the material, provided it was filed within twelve months regardless of whether the AAO published the enabling disclosure. Provisional patent applications can be assembled quickly and cheaply. A good patent lawyer could convert the paper in our hypothetical into a provisional patent application in a matter of hours. The inventor and lawyer need only fulfill the minimal requirements set forth in the statute.<sup>30</sup> The U.S. Patent and Trademark Office filing fee for a provisional patent application is \$260.00.<sup>31</sup> Filing a regular utility patent application can achieve the same protection, but there are additional requirements and fees.<sup>32</sup>

Another way to mitigate against inadvertent government disclosure is to not disclose each and every element that is patentable. For example, the inventor and experts with knowledge of the invention can summarize the invention and the impact that the invention had on the field without creating an anticipation issue, provided that each and every element of the invention is not disclosed.<sup>33</sup> This can be easily done with expert testimonials and/or testimony from the beneficiary, where the subject matter and its significance to the field are adequately summarized without describing the actual invention in great detail.

A third way to mitigate against the publication of the disclosure in the employment-based arena is for the

petitioner and beneficiary to consider not disclosing the subject matter in the employment-based petition.

In considering the various ways one may mitigate against risk in disclosing patentable subject matter, one may ask: If it has not been publicly disclosed, how would others in the field even know of the invention (such as expert letter writers); how could it be a contribution of major significance to the field; or how could it be a proven commercial success? The subject matter could very well be unknown, with no demonstrably significant contribution to the field. However, there are other forms of intellectual property protection outside of the realm of patents, domestic and international. For example, the subject matter could be very well-known by key players in the field because it has been marketed to them with a nondisclosure agreement, a licensing agreement, or a combination of both agreements.

A nondisclosure agreement is used when a party seeks to disclose information to another party, but wants to preserve its ability to seek a patent.<sup>34</sup> Owners of patentable subject matter not yet patented frequently wish to market the technology to industry prior to seeking patent protection. Some owners of patentable subject matter have licensees seek patent protection on the invention through license agreements. Such a license agreement allows the owner of the intellectual property to permit the usage of said intellectual property for a fee. Additionally, the rights to a patent or a patent pending may be assigned to another party and recorded with the U.S. Patent and Trademark Office.<sup>35</sup> License agreements and assignments are good evidence of the viability or commercial success of intellectual property. For example, if a licensee pays a large fee to the owner of a patent and then implements the invention commercially, such actions are good evidence of the commercial success of the invention. However, presenting such evidence in the context of an employment-based petition can be challenging because the parties to the license agreement may not want the details of the agreement disclosed.

## II. PRACTICAL PROBLEMS IN USING PATENTABLE SUBJECT MATTER IN EMPLOYMENT-BASED PETITIONS

Some beneficiaries and petitioners believe including evidence of patentable subject matter will show that the beneficiary has contributed significantly

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<sup>27</sup> 35 U.S.C. § 111(b); *see also* MPEP § 201.04.

<sup>28</sup> MPEP § 201.04.

<sup>29</sup> *Id.*

<sup>30</sup> 35 U.S.C. § 111(b).

<sup>31</sup> 37 C.F.R. § 1.16(d). Note that the fees are lower for small and micro entities.

<sup>32</sup> 35 U.S.C. § 111(a); MPEP § 601.

<sup>33</sup> MPEP § 2131.

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<sup>34</sup> David V. Radack, *Understanding Confidentiality Agreements*, 46 (5) JOM 68 (1994).

<sup>35</sup> 35 U.S.C. § 261; MPEP 301.

to the field or commercial success in the field. Disclosing a patent or even referencing a patent application on a CV can be confusing and antagonistic to an adjudicator. As such, the inclusion of a patent application or patentable subject matter can induce adjudicators to issue requests for evidence (RFEs). These RFEs often focus on the question of how the patentable subject matter has contributed significantly to the field or is evidence of commercial success. Of course, the grant of a patent does not necessarily prove value with regard to the impact on the field or commercial success. After all, a patented invention is broadly defined as "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof."<sup>36</sup> Therefore, USCIS will require more than the disclosure of the patented or patentable subject matter; it will require testimony from experts that the invention is a contribution of major significance to the field. In the context of commercial success, evidence that the invention has been licensed by industry and is being produced or practiced commercially would be required.

One significant problem in presenting evidence of commercial success or impact on the field is that many licensees will not want to disclose the license to anyone because of the potential impact on competition. For example, Monsanto would not want DuPont or BASF to see the terms of a licensing agreement it has with a university that was the source of a biotechnology invention. If DuPont or BASF were able to detect Monsanto's interest in that technology, it could redouble its efforts to explore that and related technologies. For this reason, these kinds of companies may include clauses in their license agreements that prohibit the disclosure of the terms of the agreement to any outside sources. Similarly, scientists with intimate knowledge of the commercial success or impact on the field may be restricted from weighing in on such issues because of employee confidentiality agreements. Responding to an RFE when such restrictions are in place would be like trying to go in to a fight with your hands tied behind your back.

Three questions should be asked when considering whether to introduce patentable subject matter: (1) Has the material been licensed? (2) Can licensing show impact on the field in question; and (3) Can the license and/or the impact on the field be legally shown with competent evidence? If you cannot answer yes to all of these questions, you should strongly consider not including evidence of the patentable

subject matter. For example, if the patentable subject matter has a patent application filed and pending, but you cannot show the license and the impact on the field because of the confidentiality provisions in the licensing agreement, there is a high likelihood you will draw an RFE that you will not be able to properly respond to. Assuming the petition was approvable without the inclusion of the patentable subject matter, the inclusion of the material may put a winnable case in jeopardy.

Alternatively, one way to include patentable subject matter when you cannot show licensure and impact on the field is to state that you have met the relevant legal standard and argue that the incomplete subject matter is supplemental evidence that further confirms the beneficiary meets the standard.

### III. MAXIMIZING THE IMPACT OF PATENTS IN THE EB-1 AND EB-2 SCENARIOS

Case law and agency memoranda provide limited guidance to advocates in deciding whether to offer evidence of contribution to intellectual property claims. Nonetheless, some guidance can be gleaned from an intertextual reading of *NYSDOT*<sup>37</sup> and the Ninth Circuit decision relating to EB-1(1) extraordinary ability petitions, the *Kazarian* case,<sup>38</sup> which USCIS has adopted as a *de facto* precedent decision applicable not only to EB-1(1) but to EB-1(2) and EB-2 exceptional ability cases as well.

*NYSDOT* established a generally relatively workable three-part test for an EB-2 NIW beneficiary's eligibility in terms of two innocuous considerations: the substantial importance of the beneficiary's field and the national scope of his or her potential impact; and one more challenging consideration: whether the waiver seeker's contribution warrants exemption from labor certification by being significantly more impactful than that of a minimally qualified performer of those same ostensibly nationally significant activities.

While the structural engineer beneficiary in *NYSDOT* did not present evidence of his personal contribution to patentable or otherwise proprietary technology, he did premise his case on his alleged undertaking of innovative bridge repair methodologies covered by intellectual property protection.

*NYSDOT* does provide, albeit in *obiter dicta*, at least ambivalent encouragement to those seeking

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<sup>36</sup> 35 U.S.C. § 101.

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<sup>37</sup> 22 I. & N. Dec. 215 (Acting Assoc. Comm'r, Programs 1998).

<sup>38</sup> *Kazarian v. USCIS*, 596 F.3d 1115 (9th Cir. 2010).

EB-2 exemption from labor certification whose eligibility involves invention or innovation, with the observation in Footnote 2 that "An alien's job-related training in a new method, whatever its importance, cannot be considered to be an achievement or contribution comparable to the innovation of that new method"<sup>39</sup>

However, the AAO goes on in Footnote 7 to temper the rising expectations of advocates and prospective waiver seekers alike by cautioning that "such innovation is not always sufficient to meet the national interest threshold. For example, an alien cannot secure a national interest waiver simply by demonstrating that he or she holds a patent."<sup>40</sup>

USCIS adjudicators have frequently taken the minatory tone of Footnote 2 to heart, challenging eligibility for labor certification exemption on the basis that the waiver applicant's invention, innovation, or discovery, as manifested in a patent, whether issued or pending, fails to surmount the challenge presented by *NYS DOT*'s third leg. Indeed, overzealous adjudicators have been known to issue RFEs challenging whether a waiver-seeking beneficiary's contribution to a patent warrants approval of the waiver even in instances where the patent was merely mentioned in a CV or referenced in a testimonial statement, but otherwise not offered by counsel as a compelling factor in support of the petition.

Clearly care should be exercised by counsel in the preparation of NIW petitions to avoid the appearance that the waiver seeker is premising eligibility on a patent that cannot be successfully shown, in the words of Footnote 6 to *NYS DOT*, to "serve the national interest to a substantially greater extent than the majority of his or her colleagues."<sup>41</sup>

The ever-controversial *Kazarian* decision, now applied by USCIS beyond its original precedential focus, which was EB-1(1), to EB-1(2) and EB-2 cases premised on exceptional ability, does not explicitly reference patents, as the self-petitioner was a theoretical astrophysics instructor in his native Armenia and apparently did not attempt to premise his eligibility on any patentable innovation or invention.

Admittedly, *Kazarian*'s application by USCIS may benefit some technological and scientific innovators by precluding the adjudicator from imposing extra-regulatory requirements, such as evidence of the

scholarly community's favorable reaction to a scholarly paper, or the imposition of unrealistic constraints on activities that constitute judging the work of others.<sup>42</sup>

While *Kazarian*'s deferral to due process in precluding adjudicators from imposing innovative constraints on qualifying criteria may be beneficial to some innovators, as a practical matter *Kazarian* constitutes a major setback to those innovators or inventors who are unable to surmount its somewhat opaque "final merits determination."<sup>43</sup> Under *Kazarian*, while satisfaction of regulatory criteria is a necessary condition for EB-1 eligibility, passing the inscrutable "merits determination" is necessary for establishing that the beneficiary is "at the very top" of his or her field of endeavor.

The impact of this "final merits determination" mechanism, and its inherent opacity in many case scenarios previously approvable under the regulatory criteria, arguably diminish the value of patents in EB-1 advocacy, absent substantial and objective documentation of the impact of the patent on the field, industry, or market.

Additionally, many suspect that immigration officers devalue or misconstrue the significance of a patent's pendency, believing, as many outside the patent community do, that only a granted patent constitutes evidence of originality or innovation. As discussed previously, a significant invention may have already had an impact on the field before a patent application is even filed, given the usage of nondisclosure and license agreements. Clearly, as discussed above, successful advocacy regarding patents and other forms of intellectual property mandates the persuasive presentation of objective testimonial evidence, evidence of the impact or implementation of the innovation, and/or published material whether journalistic, technical, or scientific, to corroborate the implementation, adoption, or acceptance of the imputed innovation.

Finally, it should be noted that while *Kazarian* itself is silent on the impact of patents, the USCIS Request for Evidence<sup>44</sup> template issued in the decision's wake does include patents and licensed technology as examples of contributions that might qualify as original scientific, scholarly, or business contributions to the field.<sup>45</sup>

<sup>39</sup> *NYS DOT*, 22 I. & N. Dec. at 221.

<sup>40</sup> *Id.* at 221.

<sup>41</sup> *Id.* at 219.

<sup>42</sup> *Kazarian*, 596 F.3d at 1122.

<sup>43</sup> *Id.*

<sup>44</sup> Request for Evidence: I-140 E11 Alien of Extraordinary Ability, *Reprinted at* 16 Bender's Immigr. Bull. 952, 969 (App. D) (June 1, 2011).

<sup>45</sup> 8 C.F.R. § 204.5(h)(3)(v).



The template seems to restrict patents of relevance to this criterion to those "currently being utilized and shown to be significant to the field."<sup>46</sup> Arguably, this limitation devalues patents associated with theoretical scientific discoveries in such fields as pharmacological chemistry or computational science.

#### IV. DEFENSIVE STRATEGIES IN RESPONSE TO USCIS SKEPTICISM REGARDING THE IMPACT OF INNOVATION OR DISCOVERY

Despite the presentation of a persuasive EB-1 or EB-2 case, RFEs and, indeed, in some instances, the far more draconian NOID, may be anticipated in response to the presentation of expert testimony in support of a claim of significant innovation or discovery.

In some instances the presentation of extensive and objective rebuttal evidence will suffice to overcome the adjudicator's skepticism. However, EB-I(1) and (2), as well as EB-2 NIW petitions, based, at least in part, on the submission of clear and probative expert testimony are frequently challenged and not infrequently denied on the adjudicator's assertion that "the opinion of experts in the field cannot form a cornerstone of a successful claim."

This extra-regulatory and, indeed, counterintuitive dismissal of evidence that might well be more than sufficient to win the day before a broad range of administrative or judicial tribunals may appear to be the death knell to many otherwise meritorious petitions.

While primarily anchored in testimony, EB-1 or NIW petitions on behalf of inventors or innovators are undeniably vulnerable to challenge. However, effective use of AAO case law may turn the tide in some otherwise seemingly doomed scenarios.

In a 2003 nonprecedent decision approving an NIW petition whose factual circumstances were curiously reminiscent of those in *NYSDOT*, the AAO vacated the denial of a petition submitted on behalf of a mechanical engineer holding a master's degree who had neither published internationally nor achieved recognition beyond a narrow range of colleagues and clients.<sup>47</sup>

The decisive factor in *Kaiser* that seemed to distinguish its outcome on appeal from *NYSDOT*'s would seem to be that the engineer in *Kaiser* had contributed significantly to the redesign of rudder mechanisms (i.e., actuators) that were used on Boeing commercial aircraft.<sup>48</sup>

Although the *Kaiser* technology was proprietary, there was no indication that the beneficiary had been an innovator or inventor, but he had been an extremely knowledgeable and versatile "shirt-sleeve" gear engineer who could be counted on by Boeing, *Kaiser*'s principal customer, to resolve practical manufacturing and post-production issues concerning gear assemblies on Boeing commercial aircraft.<sup>49</sup> Unsurprisingly, in the near wake of the *NYSDOT* decision, which also involved a master's-level unpublished engineer, the *Kaiser* petition was denied in light of USCIS aversion to petitions grounded in expert testimony and, moreover, the adjudicator's perception that gear engineering was a generic activity inappropriate for exemption from labor certification.<sup>50</sup>

It is important to note that the *Kaiser* petition was supported by detailed non-conclusory testimony from senior Boeing commercial aircraft personnel who were familiar with specific improvements the *Kaiser* beneficiary had made on MD-80 rudder assemblies.<sup>51</sup> The AAO indicated in *Kaiser* that the circumstances of the beneficiary's employment compelled it to give due deference to the testimony of Boeing executives, despite the fact that Boeing was in fact *Kaiser*'s principal client.<sup>52</sup> While the nonprecedent *Kaiser* decision may be anomalous, owing more to concern about the safety of air travel than to abstract principles of law, it should be noted that the beneficiary in this instance held a non-generic and indisputably responsible job at a Boeing subcontractor, whereas his counterpart engineer in *NYSDOT* held a fairly generic mid-level engineering position at one of ten regional offices of that state agency.

Two practice pointers may be extracted from *Kaiser*'s interpretation of *NYSDOT* that may benefit advocates of innovators or inventors: *NYSDOT* does not mandate any specific form of achievement of recognition and does not specifically bar any form of expert testimony, particularly that which is objective, detailed,

<sup>46</sup> Reprinted at 16 Bender's Immigr. Bull. 977 (App. D) (June 1, 2011).

<sup>47</sup> Matter of Kaiser Aerospace & Electronics Corp., 28 Immig. Rptr. B2-1, 2003 Immig. Rptr. LEXIS 4033, 2003 Immig. Rptr. LEXIS 4055, and 2003 Immigr. Rptr. LEXIS 4143 (AAO Mar. 28, 2003).

<sup>48</sup> *Id.* at 4.

<sup>49</sup> *Id.*

<sup>50</sup> *Id.* at 5.

<sup>51</sup> *Id.* at 4-5.

<sup>52</sup> *Id.* at 6.

and relevant to the case at hand. Further, *NYS DOT* does indicate that the qualitative standard of accomplishment or recognition required for the waiver is one of significant superiority to minimally acceptable performance. Accordingly, a highly accomplished technology innovator whose services significantly augment public safety, security, or other hot button concerns may well surmount adjudicator aversion to testimonially anchored petitions, if circumstances analogous to those in *Kaiser* can be substantiated.

A second AAO decision of conceivable value to EB-1 and EB-2 beneficiaries arises in an unexpected context: the P-3 culturally unique performance visa. In *Matter of Skirball Cultural Center*,<sup>53</sup> a precedent decision, the AAO addressed the critical issue to innovators of the acceptability of expert witness testimony as evidence under 8 C.F.R. § 214.2(p)(6)(ii)(A).<sup>54</sup> *Skirball* confirms that expert testimony that is uncontroverted, reliable, relevant, and probative as to the specific facts at issue constitutes qualifying evidence in support of an immigration petition.<sup>55</sup>

*Skirball* distinguishes such expert evidence from that which is given less weight because "it is not in accord with other information in the record or . . . is in any way questionable."<sup>56</sup> Such dubious expert testimony is deemed inappropriate in *Matter of Caron International, Inc.*,<sup>57</sup> a favorite case with agency adjudicators who inappropriately cite it as support for their refusal to grant EB-1 or NIW petitions that attempt to rely on probative and objective evidence, notwithstanding *Skirball's* designation as a precedent decision.

Advocates should not hesitate to remind adjudicators who cite in RFEs or NOIDs the 1998 *Caron* case as the basis for rejecting probative testimony that *Skirball* significantly reduces *Caron's* scope to that testimony that has been found to be inconsistent or questionable.

*Skirball* may prove to be particularly serviceable where objective testimony regarding the impact, licensing, or scientific or economic significance of a patent or innovation is offered as the primary means of establishing the importance of the beneficiary's contribution.

Our discussion thus far has focused on the development and submission of probative and persuasive initial evidence. Advocates of inventors and innovators will

frequently wish to supplement the record of proceeding with additional evidence. In the patent scenario, for example, licensing agreements or other forms of technology transfer might ensue after submission of an I-140 petition. An invention or discovery unknown to the public at the time of filing might attract attention of a specialized or generalized audience. To what extent might post-filing achievements be offered in response to an RFE or a NOID?

Petitioners should anticipate adjudicator reliance upon *Matter of Katigbak*.<sup>58</sup> *Katigbak* held that an I-140 beneficiary must meet all requirements specified on his or her employer's labor certification application as of the date of the application's submission.<sup>59</sup> While the proposition is clearly justifiable in the context of a labor certification-based I-140, it would seem to have little relevance in the NIW scenario. Nonetheless, NIW and EB-1 denials still invoke this arguably inapposite precedent decision to bar the consideration of post-filing accomplishments. Petitioners should offer evidence corroborating the acceptance or adoption of a discovery or innovation, whether covered by patent or not. If such post-filing developments relate back to innovation preceding the date of filing of the I-140 petition, petitioners should not hesitate to explain the inapplicability of *Katigbak* when submitting such evidence, whether in response to RFEs or NOIDs, or in extreme instances, in support of MTRs or administrative appeals.

## Conclusion

This article examined the usage of patentable subject matter in employment based petitions from the patent and immigration law perspectives. Applying the principles of this article hopefully will assist practitioners in determining whether and how to use such subject matter. Applying some of the defense techniques hopefully will help practitioners fight back when USCIS resists inventions and innovation.

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**Brian C. Schmitt** is a partner at Hake & Schmitt, an immigration law firm in New Windsor, Maryland. He concentrates on J-1 waiver matters. He is also a registered patent attorney. His publications are listed at [www.hake.com/pc](http://www.hake.com/pc).

**Nathan A. Waxman** is a national leader in the practice of business, professional, and academic immigration law, where he represents clients throughout the

<sup>53</sup> 25 I. & N. Dec. 799 (AAO May 15, 2012).

<sup>54</sup> *Id.* at 802.

<sup>55</sup> *Id.* at 806.

<sup>56</sup> *Id.* at 805.

<sup>57</sup> 19 I. & N. Dec. 791, 795 (Comm'r 1988).

<sup>58</sup> 14 I. & N. Dec. 45 (Comm'r 1971).

<sup>59</sup> *Id.* at 46.

entire realm of employment-based immigration. He has written and lectured on many business and immigration topics. His publications are listed at [www.waxlaw.com](http://www.waxlaw.com).

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