



# An Introduction to Administrative Patent Judges at the Patent Trial and Appeal Board

By Michael Wagner

The Patent Trial and Appeal Board (PTAB) is a relatively new entity. Created on Sept. 16, 2012, as part of the America Invents Act (AIA), the PTAB replaced its predecessor, the Board of Patent Appeals and Interferences. Due in part to the additional procedures created by the America Invents Act, the PTAB handles a broad spectrum of patent issues at the United States Patent and Trademark Office (USPTO). The PTAB handles written appeals from patent applicants challenging the decisions of patent examiners, appeals of reexamination proceedings, derivation proceedings, inter partes review proceedings, and post-grant review proceedings.<sup>1</sup>

The PTAB is currently made up of more than 225 administrative law judges working in the USPTO headquarters in Alexandria, Virginia, and in the newly established satellite offices in Denver, Detroit, Dallas, and Silicon Valley. The USPTO is rumored to be looking to appoint an additional 60 PTAB judges by the end of the 2015 fiscal year. This trend outpaces USPTO Deputy Director Michele Lee's stated goal of 200 judges by midyear 2014.<sup>2</sup> As a comparison, in 2010, the board was made up of only 80 judges and had increased to 160 judges by the end of 2012.<sup>3</sup>

The chief judge of the PTAB is James D. Smith. Under the chief judge are two vice chief judges that each manage separate divisions. Within each division are more than 10 separate sections—each having a lead judge and several other judges.<sup>4</sup>

The PTAB judges are spread throughout the country in the newly established USPTO office locations. Currently, the majority of the judges are in the Alexandria office, with 175 judges. The Menlo Park, California, office currently has 20 judges, Denver and Dallas each have 12 judges, and Detroit has nine judges. While there are judges located in each of the regional USPTO offices, only certain proceedings are allowed to take place outside of the Alexandria office. At this time, ex parte appeals hearings are

ongoing in the Denver office, but all trial hearings are held in Alexandria. Moving forward, trial hearings may also be scheduled in the regional offices.

To prevent the judges in regional offices from having to constantly travel to and from Alexandria, those judges commonly participate on panels via video. The regional offices, along with the Alexandria office, have been outfitted with video conferencing equipment to allow for the judges to hear cases held in Alexandria.

The respective backgrounds of the judges also span a large range of patent experience. The USPTO evaluates potential judicial applicants on both objective criteria and subjective criteria, with a preference for candidates with 10 to 15 years patent prosecution and/or patent litigation experience.<sup>5</sup> Their backgrounds include private practice at both large and small firms, government practice from within the USPTO itself and from other federal agencies, and in-house counsel at large and small corporations. The judges' areas of practice and expertise are also varied, including patent prosecution, litigation, and licensing. The respective backgrounds of the judges also span a large range of patent and technical experience. With this broad amount of experience, the PTAB provides a well-rounded perspective and expertise in the area of patent law. If an incoming judge, however, feels that he or she would benefit from additional training, the PTAB provides additional optional training for its incoming judges to ease the transition into working towards the PTAB's unique mission of administratively adjudicating patent issues, including training on how to use all the new video conferencing technology that has been integrated into the offices.<sup>6</sup>

Due to the varying backgrounds of the judges and the varying technology areas that are seen by the PTAB, the PTAB has particular procedures for assigning cases to the judges and determining the appropriate judges for panels. In general, the chief judge

designates judges for panels to decide ex parte appeals, ex parte reexaminations, and inter partes reviews based on the judges' legal and technical expertise. The chief judge also designates a judge or judges to hear interferences. The judges are not allowed to change panels without authority of the chief judge or vice chief judge. When assigned to a panel for ex parte appeals, the judges are also assigned a particular role, labeled "Number 1, Number 2, and Number 3."<sup>7</sup>

The PTAB judges have been keeping busy attempting to keep up with the rigorous requirements of the newly established AIA proceedings, such as inter partes reviews (IPRs), covered business method reviews (CBMRs), post-grant reviews (PGRs), and derivation proceedings. Since those proceedings became available in 2012, through Jan. 15, 2015, there have been 2,345 IPR filings, 285 CBMR filings, three PGR filings, and eight derivation filings. So far, the PTAB has written a combined 1,531 decisions on whether the proceedings should be instituted, resulting in 1,083 trials being instituted. Of those 1,083 instituted trials, 398 have ended in settlement, 57 have resulted in adverse judgments without a written decision, and 236 have resulted in final written decisions.<sup>8</sup> Many of those final decisions have now been appealed to the Federal Circuit, which just issued its first two decisions regarding post-AIA proceedings.<sup>9</sup> Both decisions affirmed the findings of PTAB.

In addition to their new responsibilities created by the AIA, the PTAB judges also handle ex parte appeals, ex parte reexamination appeals, and a few remaining inter partes reexamination and interference proceedings. At the end of 2014, the PTAB had a staggering 25,370 ex parte appeals still awaiting decision. Of those appeals, 14,508 have been pending for more than 14 months. Adding to the workload, the PTAB also has 44 outstanding ex parte reexamination appeals, 126 inter partes reexamination appeals, and 28 interference proceedings.<sup>10</sup>

While obtaining permission to interview a PTAB judge can be difficult, prior interviews shed light on the judges' interests and concerns.<sup>11</sup> The judges generally share a concern about the growing workload created by the AIA on top of the already existing backlog but at the same time believe that the increasing number of judges has substantially alleviated those concerns. The judges also find many of the cases challenging—particularly with the changes in the law and quickly advancing technology. The judges also suggest that those challenges are what make the job interesting and enjoyable. From these public comments, it appears that the PTAB judges enjoy their work and take pride in what they do.

Understanding the PTAB and the judges making the decisions is important for anyone practicing patent prosecution or patent litigation. As more and more cases are filed before the PTAB—including on many patents concurrently asserted in district court litigation—the PTAB and its decisions will likely have an even greater importance. ©



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## Endnotes

<sup>1</sup>35 U.S.C. § 6(b).

<sup>2</sup>Jennifer Bush, Administrative Patent Judges: Not Your Typical Federal Judge (July 24, 2014), [www.mondaq.com/unitedstates/x/329902/Patent/Administrative+Patent+Judges+Not+Your+Typical+Federal+Judge](http://www.mondaq.com/unitedstates/x/329902/Patent/Administrative+Patent+Judges+Not+Your+Typical+Federal+Judge).

<sup>3</sup>Patent Public Advisory Committee Meeting Patent Trial and Appeal Board Update, USPTO (Dec. 13, 2012), [www.uspto.gov/sites/default/files/about/advisory/ppac/121312-04-ptab-update.pdf](http://www.uspto.gov/sites/default/files/about/advisory/ppac/121312-04-ptab-update.pdf).

<sup>4</sup>About the PTAB, U.S. Patent and Trademark Office, [www.uspto.gov/ip/boards/bpai/ptab\\_about.jsp](http://www.uspto.gov/ip/boards/bpai/ptab_about.jsp) (last visited Jan. 18, 2015).

<sup>5</sup>Jennifer Bush, Administrative Patent Judges: Not Your Typical Federal Judge (July 24, 2014), [www.mondaq.com/unitedstates/x/329902/Patent/Administrative+Patent+Judges+Not+Your+Typical+Federal+Judge](http://www.mondaq.com/unitedstates/x/329902/Patent/Administrative+Patent+Judges+Not+Your+Typical+Federal+Judge).

<sup>6</sup>Denise DeFranco, Profiles in IP Law: An Interview with Judge James Smith, Chief Administrative Patent Judge, U.S. Patent and Trademark Office, *LANDSLIDE* Vol. 5 No. 2 (Nov. 2012), available at [www.americanbar.org/publications/landslide/2012\\_13/november\\_december/an\\_interview\\_with\\_judge\\_james\\_smith\\_chief\\_administrative\\_patent\\_judge\\_united\\_states\\_patent\\_and\\_trademark\\_office.html](http://www.americanbar.org/publications/landslide/2012_13/november_december/an_interview_with_judge_james_smith_chief_administrative_patent_judge_united_states_patent_and_trademark_office.html).

<sup>7</sup>See PTAB Standard Operating Procedure 1 (Rev. 13), available at [www.uspto.gov/sites/default/files/documents/sop1.pdf](http://www.uspto.gov/sites/default/files/documents/sop1.pdf).

<sup>8</sup>AIA Progress, U.S. Patent and Trademark Office (Jan. 15, 2015), [www.uspto.gov/ip/boards/bpai/stats/011515\\_aia\\_stat\\_graph.pdf](http://www.uspto.gov/ip/boards/bpai/stats/011515_aia_stat_graph.pdf); Patent Trial and Appeal Board AIA Progress, United States Patent and Trademark Office (Jan. 15, 2015), [www.uspto.gov/ip/boards/bpai/stats/aia\\_statistics\\_01-15-2015.pdf](http://www.uspto.gov/ip/boards/bpai/stats/aia_statistics_01-15-2015.pdf).

<sup>9</sup>*In re Cuozzo Speed Techs. LLC*, Case No. 2014-1301 (Fed. Cir., Feb. 4, 2015); *Softview LLC v. Kyocera Corp.*, Case No. 2014-1599, -1600 (Feb. 9, 2015) (per curiam affirmation).

<sup>10</sup>December 2014 Patent Trial and Appeal Board (PTAB) Data, Data Visualization Center, USPTO (December 2014), [www.uspto.gov/dashboards/patenttrialandappealboard/main.dashxml](http://www.uspto.gov/dashboards/patenttrialandappealboard/main.dashxml).

<sup>11</sup>Gene Quinn, Exclusive: Chief Judge James Smith and Vice-Chief James Moore, *IPWATCHDOG* (Jan. 1, 2013), [www.ipwatchdog.com/2013/01/01/exclusive-chief-judge-james-smith-and-vice-chief-james-moore/id=32132/](http://www.ipwatchdog.com/2013/01/01/exclusive-chief-judge-james-smith-and-vice-chief-james-moore/id=32132/); Denise DeFranco, Profiles in IP Law: An Interview with Judge James Smith, Chief Administrative Patent Judge, U.S. Patent and Trademark Office, *LANDSLIDE* Vol. 5 No. 2 (Nov. 2012), available at [www.americanbar.org/publications/landslide/2012\\_13/november\\_december/an\\_interview\\_with\\_judge\\_james\\_smithchief\\_administrative\\_patent\\_judge\\_united\\_states\\_patent\\_and\\_trademark\\_office.html](http://www.americanbar.org/publications/landslide/2012_13/november_december/an_interview_with_judge_james_smithchief_administrative_patent_judge_united_states_patent_and_trademark_office.html); Jennifer Bush, Administrative Patent Judges: Not Your Typical Federal Judge, *MONDAQ* (July 24, 2014), [www.mondaq.com/unitedstates/x/329902/Patent/Administrative+Patent+Judges+Not+Your+Typical+Federal+Judge](http://www.mondaq.com/unitedstates/x/329902/Patent/Administrative+Patent+Judges+Not+Your+Typical+Federal+Judge); A Day in the Life of An Administrative Patent Judge, USPTO, [www.uspto.gov/ip/boards/bpai/a\\_day\\_in\\_the\\_life\\_of\\_an\\_apj.pdf](http://www.uspto.gov/ip/boards/bpai/a_day_in_the_life_of_an_apj.pdf) (last visited Feb. 12, 2015).