



Work in Their Own Words: Administrative Law Judges



**Hon. Susan L.
Biro**



**Hon. Beverly
Bunting**



**Hon. Bart A.
Gerstenblith**



**Hon. Peter B.
Silvain**

What was your practice background before you became an administrative law judge (ALJ)?

SLB

I was a partner in a law firm in Washington, D.C., specializing in civil litigation, including commercial, construction, medical malpractice, and contested adoption cases.

BB

There does not seem to be a “typical” background for an administrative patent judge (APJ) at the Patent Trial and Appeal Board (PTAB) of the U.S. Patent and Trademark Office (USPTO), other than we each have a technical background in addition to our legal qualifications. In my case, I was a design and development engineer for an automotive company during the day and law student at night. At the suggestion of a friend, I became a patent attorney and transitioned to the general counsel’s office as the company’s first female patent attorney. In order to better balance family demands, I went into private practice with an intellectual property (IP) boutique firm, doing patent preparation and prosecution. Later, seeking new challenges, I moved to a general litigation firm to gain more patent litigation and licensing experience.

BAG

My practice background was primarily in patent litigation, owing largely to my experience clerking for Judge Kent A. Jordan at the U.S. District Court for the District of Delaware and now-Chief Judge Sharon Prost at the U.S. Court of Appeals for the Federal Circuit following law school. I also had experience handling prosecution matters before the Patent and Trademark Office, an interest that was kindled by working as an intern during my last semester of law school for Administrative Patent Judge Eric Grimes at the Board of Patent Appeals and Interferences, as the board was known then.

PBS

After clerking, I worked for several years as a trial attorney both in private practice and as an assistant county attorney. Then I worked for eight years trying appellate cases for the U.S. Department of Labor before administrative appellate bodies and the U.S. Courts of Appeal.

What appointment or selection process did you go through to become an ALJ?

SLB

All federal ALJs go through the same appointment/selection process. The U.S. Office of Personnel Management (OPM) periodically holds a competitive examination for the ALJ position. The examination is given in three parts: a qualifications section, a written examination, and an oral examination. OPM then creates a numerical list of qualified candidates for hire based upon the exam results. All the federal agencies fill their openings for ALJs from the list or by placing an advertisement and selecting a current ALJ serving at another agency. I applied and sat for the examination in about March 1993. As is the case with most ALJs, I was initially hired as an ALJ off the list by the Social Security Administration

(SSA) and assigned to its office in the Bronx, New York, in October 1994.^[1] After two years with SSA, I applied for an open ALJ position with the Environmental Protection Agency (EPA) in Washington, D.C. I began as an ALJ with EPA in November 1996 and was selected by the EPA administrator to be EPA’s chief ALJ in February 1997.

BB

The opening of the first satellite office of the USPTO in July 2012 created the opportunity for me to become an APJ. The application itself involved responding to detailed questions concerning my patent prosecution and litigation experience as well as technical background. Additionally, I provided representative writing samples indicative of my analytical and communication skills. After being selected, as this is an appointed position, my candidacy ultimately had to be approved by the U.S. Secretary of Commerce.

BAG

I applied by submitting the requested application materials in response to a posting at usajobs.gov. After receiving confirmation that my application met the minimum qualifications and was forwarded to the selecting official, I attended an in-person interview at the Patent and Trademark Office before Chief Administrative Patent Judge James D. Smith, now-Acting Deputy Chief Administrative Patent Judge Scott Boalick, and two of the section Lead Administrative Patent Judges. Thereafter, I was appointed by the Secretary of Commerce as an administrative patent judge.

PBS

The process took almost a year. Initially, candidates submit extensive information about their legal experience and its applicability to the position of being an administrative judge. After an initial review by the Office of Personnel Management (OPM), a portion of the candidates were selected to continue the process. This entailed a four-hour written examination, an extensive panel interview with senior judges and OPM management, and a security background investigation. OPM then provided the candidates with competitive scores and placed them on a register for agencies to interview for potential appointments.

What kind of matters do you handle?

SLB

I adjudicate adversarial administrative cases arising under federal environment laws, including the Clean Water Act; Clean Air Act; Federal Insecticide, Fungicide, and Rodenticide Act; Resource Conservation and Recovery Act; Toxic Substances Control Act; and Emergency Planning and Community Right-to-Know Act, as well as selected cases brought before a variety of other administrative agencies, including cases brought before the National Oceanic and Atmospheric Administration involving the Marine Mammal Protection Act and the Magnuson-Stevens Fishery Conservation and Management Act, pursuant to a reimbursable interagency agreement.

BB

As an APJ, I handle both ex parte appeals and American Invents Act of 2011 (AIA) trial matters. In an ex parte appeal, the patent applicant is challenging the adverse final decision by the patent examiner as to the patentability of the particular patent application. I also consider AIA petitions challenging the patentability of issued patents and manage the AIA trial, if determined to institute trial, through to the final written decision. The review of both types of proceedings involves primarily the written record. The main difference, however, is that the ex parte appeal can be resolved in a matter of weeks once the panel begins its review and deliberation; whereas, once an AIA trial is instituted, resolution occurs, by statute, one year from date of institution.

BAG

I principally handle ex parte appeals and post-grant reviews, most commonly inter partes reviews and covered business method patent reviews.

PBS

In the Department of Labor's Office of Administrative Law Judges, we preside over formal adversarial hearings concerning many labor and employment related matters. We hear and decide cases arising from over 80 labor-related statutes and regulations. These include cases concerning coal miners' claims for black lung benefits, longshore workers' and defense contractors' compensation claims, whistleblower complaints (involving corporate fraud, nuclear, environmental, pipeline safety, aviation and commercial trucking statutes), civil rights, alien labor certifications and attestations, minimum-wage disputes, enforcement actions involving the working conditions of migrant farm laborers, discrimination and civil fraud claims in federal contracts and programs, disputes involving employee polygraph tests, ERISA recordkeeping requirements and standards of conduct in union elections.

What is your approach to resolving matters?

SLB

I believe the litigants appearing before me would say that I take a very pragmatic approach to resolving matters. All parties in cases coming before EPA's Office of Administrative Law Judges are first offered an opportunity to conserve time and money and reach a mutually agreeable resolution, without proceeding to hearing, by participating in a strictly time-limited alternative dispute resolution (ADR) process with an ALJ serving as the neutral. If the ADR process fails, and the case is assigned to me for adjudication, I endeavor to move the case expeditiously towards hearing and thus resolution by maintaining tight case-management controls and setting clear and firm filing requirements and time deadlines in order to focus the hearing only on the critical matters actually in dispute. Parties are also encouraged to file a variety of prehearing motions and engage in prehearing procedures to maximize the amount and quality of the time spent at hearing on the factual issues that are actually in dispute.

BB

My goal is to get it right. Therefore, in considering both ex parte appeals and AIA trial matters, my personal strategy is to resist forming an opinion until I have thoroughly reviewed and considered the entire record. In certain situations, I let the opinion "rest" a short period of time and revisit using a fresh perspective.

BAG

My goal is to render decisions fairly and impartially. I strive to reach the "right" answer. I am also mindful of the relative burdens on the parties appearing before me. Many times, an issue can be decided based on whether a particular burden has or has not been met, especially when an issue may be a very close call.

PBS

After providing an adequate period of discovery, I hold a formal adversarial hearing. On most occasions I travel to a courthouse in the area where the parties and witnesses are located. These hearings can range from a few hours to several weeks, depending on the complexity of the issues and the number of witnesses. After reviewing a transcript of the proceedings, the parties submit post-hearing briefs. I then draft and issue a detailed written decision. The Office of Administrative Law Judges' mission is to render fair and equitable decisions under the governing law and the facts of each case.

Do you have a staff, and, if so, how do you use them?

SLB

The Office of Administrative Law Judges is presently staffed by three full-time ALJs, one part-time retired annuitant ALJ, four staff attorneys, one office administrator, one docket clerk, and two legal assistants. The staff attorneys, judges, and other staff work collaboratively to efficiently process all the cases pending on all of the judges' dockets.

BB

APJs do not have staff personnel assigned directly. Rather, we interact closely with and rely on a team of professionals, including staff attorneys and paralegals, throughout the entire decision-making process. For example, the paralegals are responsible for docketing, processing, and mailing of our decisions.

BAG

Most Administrative Patent Judges do not have a personal staff; rather, we share a team of administrative professionals and paralegal support staff. The administrative and paralegal staff perform very important and necessary functions in supporting the work of the Administrative Patent Judges. The administrative staff working in information technology and human resources keep our workstations operational, manage hearings, and perform a lot of work "behind the scene." Our paralegals review nearly all filings and our draft decisions, handle our correspondence with the parties, and in some instances, assemble the relevant documents in a given case.

PBS

The Judges have legal technicians and law clerks (who become attorney advisors after passing the bar) to assist in handling our cases. They are essential to the process, and we are very fortunate to have experienced and dedicated staff.

Describe a typical week at work for you.

SLB

There are two typical types of workweeks. If I am in hearing, usually I fly to the hearing locale on Sunday or Monday, continuing to prepare for the hearing along the way. The hearing takes place over the following days, day after day, often from very early in the morning until the courthouse closes (and sometimes ever after that), in an effort to most efficiently complete the hearing within the time allocated to it and save both government and party resources. If I am not in hearing, I arrive in the office at 6:30 a.m. and work usually until 5 p.m. or later drafting orders on motions and decisions after hearing, and otherwise managing the office, including its staffing, budgeting, cases, and intra-agency and interagency relations.

BB

Currently, my docket includes primarily AIA trial matters, as well as some ex parte appeals. With over 25,000 docketed ex parte appeals and averaging over 100 AIA petitions filed each month, there is no shortage of work! In fact, the PTAB's AIA trial docket has quickly become one the busiest patent courts in the United States. We review ex parte appeals and AIA trial matters generally as a three-judge panel. Although I am located in the Detroit satellite office of the USPTO, paneling is not geographic specific, enabling interaction with colleagues across the country. In an ex parte appeal, our review is based on the written record, and the appellant can request an oral hearing before the panel. Because an AIA trial matter is more akin to district court litigation and involves limited discovery, the panel has more interaction with the petitioner and patent owner. For example, the panel considers motions and otherwise resolves disputes between the parties, usually through conference calls and written orders. In addition, the APJs meet periodically via webinars to facilitate the exchange of ideas, share experiences, and discuss recent developments in patent law.

BAG

I now telework 100 percent of the time, so unless there is a hearing or in-person meeting at the office, I usually work from home. All of our files are electronic, which makes telework incredibly convenient and efficient, saving me two-plus hours of a commute each day. A typical week involves me reviewing anywhere from two to three ex parte appeals, assigned to me as the primary author, three to five ex parte appeals on which I am paneled, and one to four post-grant review filings, including petitions, motions, or other issues that arise.

U.S. Federal Agencies Utilizing Administrative Law Judges

Coast Guard
 Commodity Futures Trading Commission
 Department of Agriculture
 Department of Health and Human Services/
 Department Appeals Board
 Department of Health and Human Services/
 Office of Medicare Hearings and Appeals
 Department of Housing and Urban Development
 Department of the Interior
 Department of Justice/Executive Office for
 Immigration Review
 Department of Labor
 Department of Transportation
 Department of Veterans Affairs
 Drug Enforcement Administration
 Environmental Protection Agency
 Equal Employment Opportunity Commission
 Federal Aviation Administration
 Federal Communications Commission
 Federal Energy Regulatory Commission
 Federal Labor Relations Authority
 Federal Maritime Commission
 Federal Mine Safety and Health Review
 Commission
 Federal Trade Commission
 Food and Drug Administration
 International Trade Commission
 Merit Systems Protection Board
 National Labor Relations Board
 National Transportation Safety Board
 Nuclear Regulatory Commission
 Occupational Safety and Health Review
 Commission
 Office of Financial Institution Adjudication
 Patent and Trademark Office
 Postal Service
 Securities and Exchange Commission
 Small Business Administration
 Social Security Administration

Other federal agencies may request the U.S. Office of Personnel Management to lend them Administrative Law Judges from other federal agencies for a period of up to six months.

Source: www.aalj.org/agencies-employing-administrative-law-judges

PBS Most weeks involve writing decisions in cases which have been tried, issuing orders resolving parties' disputes, holding telephone status conferences with parties, preparing for hearings, and conducting hearings.

What was the toughest matter you had to resolve?

SLB Frankly, I always view the decision I am currently drafting as my toughest. Currently, most of my EPA cases involve very complex areas of science and novel issues of law and will potentially affect practices across a whole industry and/or the relinquishment of hundreds of thousands of dollars or more in civil administrative penalties. They are aggressively and effectively contested by very experienced and competent attorneys for both sides. As such, in order to reach a decision, I must go through a labyrinthine process of evaluating all the evidence, both documentary and testimonial, and researching all the applicable law, including the often elaborate regulatory schemes and history. Once I reach a conclusion, I must then draft a written decision which will clearly, simply, and logically explain the basis for my conclusion, incorporating therein all the relevant evidence, law, and arguments offered by the parties. These decisions can be 100 pages or more in length.

BB In patent law, it's all about the claim. The toughest case I had to resolve involved an AIA petition, and the decision whether to institute trial hinged on how we interpreted a particular claim limitation. In the end, however, it was the ambiguity in the patent itself surrounding the particular claim limitation that influenced our construction—which turned out to be different than either party's proposed construction.

BAG After working on over 300 ex parte appeals and numerous post-grant review proceedings, the toughest matters are typically those where the arguments on each side are very poor. In such circumstances, it can take a lot of work just trying to figure out what is being argued before I can even think about how a case should be decided. I believe many of my fellow administrative patent judges feel the same way.

PBS Many of the cases we hear involve inherently complex medical, financial, or scientific evidence. Some of the financially related whistleblower cases (i.e., Sarbanes-Oxley and Dodd-Frank matters) present particularly complex factual scenarios which must be unraveled in making a decision. These often present a significant challenge.

With respect to attorneys appearing before you, what approaches have you seen that work well?

SLB I have great respect for attorneys who know their case, by which I mean they know what they need to prove in order to prevail and what evidence they intend to use to prove it. They thoughtfully utilize the pre-hearing process to narrow the facts and issues in dispute and make the most of the limited time available at hearing. Attorneys who know their case are usually confident and have no difficulty acting courteously and professionally towards their opponent and the tribunal.

BB In both ex parte appeals and AIA trial matters, I tend to favor concise, logical arguments directed to the heart of the dispute. Recognizing that AIA trial matters usually involve long-standing disputes directed to the same patent in other proceedings, e.g., district court or International Trade Commission, I appreciate attorneys that are respectful of our time and cooperate with opposing counsel to resolve differences without seeking panel involvement.

BAG Whether referring to attorneys appearing in person for a hearing or on paper in briefing, the best approach is always to put forth your best arguments and leave out the rest. Clearly explain the position you are advocating and why it should prevail over the other positions put forth in a case. In other words, don't lead us to the edge without telling us how to get over it.

PBS Professionalism is paramount. This includes striving to be professional in the tenor of conversations with opposing counsel, the thoroughness and accuracy of discovery responses, and conduct at the time of trial. The best attorneys are well-prepared, courteous, and well-versed in the rules of practice and procedure.

What approaches do not work well?

SLB Over the years I have found the attorneys most unsuccessful on behalf of their clients are those who are bombastic and who, in an apparent effort to show off in front of their clients, are loud, condescending, and waste time on frivolous motions, objections, and extended arguments.

BB In both ex parte appeals and AIA trial matters, offering numerous arguments just for the sake of argument tends to obfuscate the most persuasive (i.e., winning) argument.

BAG Exaggerating the strength of a position does not work well. I, along with each of my colleagues, will read the document cited and figure out, rather quickly, whether a paraphrase accurately reflects the facts. Exaggerating the strength of a position results in loss of credibility, and [that] is often difficult to regain.

PBS I am not impressed by lackluster preparation, overly aggressive examination of witnesses, and disorganized or incomplete evidence. None of these approaches present a case in its best light.

What other advice would you give to practitioners?

SLB Periodically, I go and speak at bar functions, open to both government and private practitioners, and I have a top-10 list of things to remember to be successful litigating before EPA ALJs. Among the most important items on the list would be: (1) to remember that EPA administrative litigation is very similar to a federal district court bench proceeding; it is not some informal process at which you can sloppily improvise or attempt to procrastinate and be successful; and (2) be creative; think how best to use each step in the process to bring you forward towards your goal.

BB My advice to practitioners is a reminder that the role of APJ is not one of advocate; arguments should be articulated clearly and well-supported by the facts and evidence of record. In AIA trial matters, the rules provide for conference calls to expeditiously raise and resolve issues; practitioners shouldn't wait until the last minute to request a conference call and also should be prepared to address the subject matter of the call.

BAG Zealously advocate for your clients, but know when to concede a point. You don't have to win every issue to win a case. In the context of post-grant review proceedings, understand that when you file a petition for review, your best case and essentially all of your evidence needs to be there and needs to clearly explain how the disclosures in a reference teach the claim language recited. Even though I and my colleagues have advanced technical training, we are not inclined to fill in the gaps for you. You need to make your case as best as possible. If not, the outcome is all too predictable.

PBS While attorneys may strongly disagree with an opposing counsel's assertions, they should strive to maintain their composure. Nothing is lost by maintaining calm, assertive civility. In fact, it is more likely that the attorney will gain additional respect from their client, the judge, and perhaps even from the opposing counsel. ©

SAVE THE DATE



OCTOBER 20, 2015



SECURITIES LAW SEMINAR



More information to come summer 2015.