

Administrative Patent Judges: Not Your Typical Federal Judge

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In the less than two years since the institution of trials before the United States Patent and Trademark Office made available by the America Invents Act, a close watch has been kept over the statistics for these trials, which include inter partes reviews, covered business methods, and post-grant reviews. However, as the numbers of petitions for USPTO trials filed have increased, little attention has been focused on a related and equally rapidly growing number: that of the administrative patent judges deciding these cases.

The AIA-created administrative proceedings take place before the Patent Trial and Appeal Board, which is an administrative tribunal within the USPTO. Board members are administrative patent judges. From September 2012 to February 2014, the number of judges on the board doubled to just under 180 judges. USPTO Deputy Director Michelle Lee had stated a goal of 200 judges by mid-year 2014. The challenge is staffing the numbers of administrative patent judges needed while maintaining the quality of those hires such that all have both the technical background and knowledge of patent law necessary for the position.

The formal requirements for application to the position of administrative patent judge include both objective and subjective criteria to help achieve this goal. The objective criteria are as expected, including being a U.S. citizen or national, completing an application with accompanying documents such as resume and transcripts, and providing proof of technical and law degrees, as well as proof of active bar membership in good standing.

The subjective criteria include a “demonstrated ability to litigate or draft decisions around patentability” and a writing sample of no more than 8,000 characters on the topic of the strengths, weaknesses and impacts of *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), on the patentability decision. The board also “prefers” candidates with 10-15 years patent prosecution and/or litigation experience, preferably in the fields of “electrical, computer, mechanical or data processing.”

In practice, many of these requirements seem to hold up. Based on a sampling of about half of the current

administrative patent judges from their LinkedIn profiles, most in fact have the “preferred” 10-plus years of experience. A full 84 percent are former patent attorneys having practiced in the private sector. However, the number is heavily weighted toward patent litigation experience. About one quarter (23 percent) have experience as examiners or other USPTO roles prior to becoming an administrative patent judge. A good number (12 percent) have experience clerking for the U.S. Court of Appeals for the Federal Circuit. And 4 percent have experience in either the military, the Department of Justice or the International Trade Commission.

Administrative patent judges serve in various areas of USPTO such as ex parte appeals, interferences, inter partes reexamination appeals, and management functions, in addition to trials. According to the recruitment brochure, all administrative patent judges “begin with a docket of ex parte appeals,” with assignments to other areas being on an as needed basis. However, the same brochure shows that a full 39 percent of administrative patent judges now are staffed on trials. These statistics also play out in reality. While many trial administrative patent judges are seasoned veteran judges, there are several staffed on trials who have less the two years experience.

A sampling of a few of the administrative patent judges with the highest caseloads appears to be representative. Of five of the judges with the greatest number of trials docketed to them, two are experienced judges well-known to the interference bar, with more than 10 years experience in inter partes matters at the board: Jameson Lee and Sally C. Medley.

Lee was admitted to the bar in 1986 and has been an administrative law judge since at least 1997. He was the lead judge in the decision in *Garmin v. Cuozzo Speed Tech.*, IPR2012-00001 (PTAB 2013)—the first inter partes review decision on the merits. Medley worked as a systems engineer for five years for Lockheed and for NASA’s Kennedy Space Center. She joined the USPTO as an examiner in 1993 and became an APJ in 2000.

A few recently hired administrative patent judges who handle a large number of AIA trials include Brian J. McNamara, Thomas L. Gianetti, and Jennifer Bisk, all of whom became administrative patent judges in 2012.

McNamara has more than 14 years experience as an engineer, 13 years experience as an adjunct professor of law, and 25 years experience in private practice. Gianetti worked as an engineer for over five years, and was in private practice for 24 years. Bisk worked as an engineer for several years, clerked for several years at the U.S. Court of Federal Claims and then the Court of Appeals for the Federal Circuit, and spent about three years in private practice before becoming an administrative patent judge.

A closer look at a few of the most recent appointees shows that highly successful attorneys from the private sector continue to see being an administrative patent judge as an attractive prospect. For example, Charles Boudreau and John Horvath. Boudreau became an administrative patent judge in May. He most recently served as an associate general counsel after spending almost nine years in private practice. Prior to that he clerked for the Federal Circuit for two years, and worked as a technology specialist and a research chemist.

Horvath became an administrative patent judge in June. He has been a patent attorney for almost 15 years, having spent more than 10 years in law firms.

One possible reason the position continues to attract these well-established attorneys is better work-life balance. According to Bart A. Gerstenblith, in private practice he was challenged professionally but also suffered personal challenges, feeling “torn between” staying late at the office and arriving home before his kids went to bed. As an administrative patent judge, Gerstenblith says he continues to feel challenged professionally, but the personal challenges are no more. After just over a year as an administrative law judge, he had moved to a fulltime teleworking schedule, and notes that he is able to actually “sign off” when not working, an increasingly rare expectation in private practice.

What all this reveals is that the USPTO is delivering on its goal of recruiting administrative patent judges with strong technical backgrounds and extensive experience practicing patent law.

Understanding the backgrounds of the administrative patent judges can serve an important strategic role. As in so many other contexts, the well-worn adage of “know your audience” is critical to success in America Invents Act trials. These are not your typical federal court judges - most administrative patent judges have devoted their entire careers to the practice of patent law.

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