

## Day in the Life of an Administrative Patent Judge

*Guest blog by Administrative Patent Judges Michael Astorino, Matt Clements, Bart A. Gerstenblith, and Meredith Petravick*

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*Judge Astorino is an Administrative Patent Judge in the Alexandria, Virginia office.*

I have been told by some that being an Administrative Patent Judge is fun and by others that it is hard, and depending on the day, it is both. I am happy to say that I am thankful for both days.



It is quite enjoyable to discuss patent related issues with others who are as passionate about them as I am. A natural consequence of each these collaborations is that each of the other members of the Patent Trial and Appeal Board have helped me become a better judge and I, in-turn, have helped them. For example, by sharing our respective views concerning claim interpretation, application of facts, and arguments presented in any particular appeal, my skills have improved. I am grateful for the opportunities and the experiences that I have had, that I am currently having, and those I will have in the future.

Although I am grateful for these opportunities and experiences, the path has had its challenges. After twelve years of examining patents, I was ready to try something new. Immediately upon arriving at the Board of Patent Appeals and Interferences, it was clear that while some of my skills were well-honed, due to my experience as a patent examiner, others needed to be better developed. The other members of the Board were very helpful and soon many things began to click. I started to embrace the precise analysis and writing required in Board decisions, along with the independence and impartiality required of a judge. The challenges of this job have necessitated my constant evolution as a judge and have instilled in me an unceasing desire to learn.

So now, on the verge of entering my seventeenth year at the United States Patent and Trademark Office, I feel blessed to have the opportunity to continue my career as an Administrative Patent Judge.

*Judge Clements is an Administrative Patent Judge in the Silicon Valley satellite office.*

December marks my ninth month since joining the Patent Trial and Appeal Board as an Administrative Patent Judge in the Silicon Valley satellite office. The transition from private practice to the Board has been welcome in many ways, but one of the most pleasant experiences has been the collegial atmosphere here.



The Board's cases are decided by three-judge panels. Unlike in private practice, where the most senior attorney may get the final word, each judge on a panel has an equal voice regardless of seniority. While the most senior judge often has very valuable input, (s)he cannot dictate that a change be made if the other panel members are not persuaded. As a result, even the most senior judges propose changes persuasively rather than issuing them as edicts. Such collegiality is the rule, not the exception. That collegiality is even more remarkable when one considers that so many of the judges come to the Board with decades of experience in private practice, in the USPTO, in the ITC, in the DOJ, or in other government agencies.

In the satellite offices, judges work exactly as we would if in Virginia. Same cases. Same panel members. We do see fewer colleagues face-to-face, but with many judges in Alexandria taking advantage of the USPTO's excellent telework options, conferences between judges occur primarily by phone anyway. When one of us has a hearing, we appear by videoconference in a Hearing Room in Alexandria.

To paraphrase Mark Twain, the report of the shelving of the Silicon Valley office was an exaggeration.<sup>1</sup> Since I joined in March, the Board has added thirteen judges, including three in Silicon Valley, which brings our office to nine judges. We recently secured permanent space in San Jose City Hall with room for 18 judges and a Hearing Room. If you are an experienced patent litigator with a

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<sup>1</sup> <http://news.yahoo.com/silicon-valley-patent-office-shelved-140337163.html>

desire to live in Silicon Valley, Denver, Dallas, Detroit, or Alexandria, I strongly encourage you to apply!

*Judge Gerstenblith is an Administrative Patent Judge in the Alexandria, Virginia office.*

I certainly have enjoyed working as an Administrative Patent Judge for the past fifteen months. I decided to join the Board for three primary reasons: to have a more predictable schedule and time with my family; to work at the forefront of patent law; and to work with great people. I'm happy to report that each of these desires translated into reality.



Working for several years at two Intellectual Property firms, I was challenged both professionally and personally. The professional challenge I enjoyed, the personal challenge I did not. As many of us know, it's not easy to find balance between work and personal life. I often felt torn between staying at the office and leaving, perhaps earlier than others, to arrive home in time to say goodnight to my kids before bed. Well, not any more.

At the Board, I've continued to be challenged professionally—working on cutting-edge scientific technologies, staying on top of developing case law, and honing my writing skills. But, I'm also happy to say that I am no longer challenged personally. I don't have to choose between spending time with my family and working. There's time for both.

The Board is front and center in the new post-America Invents Act patent world, but that does not prevent its members from continuing to enjoy flexible work schedules and telework options. Yes, there are certain times of the day when I may need to be available to conference a case with one or more of my colleagues, join a teleconference, or attend a meeting, but by and large, my schedule is mine to set. And my location is equally flexible. When I started at the Board, I worked full time in Alexandria, Virginia. After just over six months, I switched to a part-time telework schedule. After just over a year, I am now teleworking fulltime. I

can come into the office, though, any time I wish. We have several “hoteling” offices that are available for use just about any day.

When I’m working, I work just as hard as I did in private practice. But, when I sign off, I sign off. That act, however simple it may sound, is one of the biggest differences in my life since joining the Board because it allows me to put aside the work, exciting as it may be, and spend quality, undivided time with my family. My life has much more balance now than it did before and I know I am not the only one in my family who appreciates that change.

*Judge Petravick is an Administrative Patent Judge in the Alexandria, Virginia office.*

I have been employed the USPTO for about 15 years, as: a patent examiner, a primary patent examiner, an appeal conference specialist, a patent attorney, and, currently, as an Administrative Patent Judge (APJ). I like being part of an agency whose mission - “to promote the Progress of Science and the useful Arts, by securing for limited Time . . . to Inventors the exclusive Right to their . . . Discoveries”<sup>2</sup> - comes straight from the Constitution. I feel a great deal of satisfaction in being part of an agency that does the important work of promoting American innovation through the issuance of patents.

As a patent examiner and a primary patent examiner, I examined patent applications to determine whether an applicant should be granted or denied a patent. As an appeal conference specialist, I worked with examiners to determine whether an examiner’s denial should continue onto appeal or not. Now, as an APJ, I review adverse decisions of examiners that applicants appeal to the Patent Trial and Appeal Board (PTAB). I work with at least two fellow APJs to review these adverse determinations and issue written decisions as to whether the examiners’ determinations should stand. Recently, I have started working on

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<sup>2</sup> U.S. Const. art. I, § 8, cl. 8.

post-grant proceedings added to the Board's jurisdiction as part of the America Invents Act.

My first-hand experience of the patent examination process allows me to bring a distinct perspective to my work as an APJ. Many of the patentability issues in examination are the same as the patentability issues in appeals and post-grant proceedings. As a former examiner, I issued adverse determinations on patentability, like those I now review. Therefore, I am familiar with the challenges faced by examiners and applicants when obtaining patents. This familiarity was helpful when I transitioned from being an examiner to a patent attorney to an APJ. Being a patent examiner gave me good foundation upon which to build when faced with new or evolving patentability issues as an APJ.

I find being an APJ rewarding because I am part of a constitutional process that rewards innovators with patents. In reviewing appeals, I am helping examiners and applicants overcome challenges in the process of obtaining a patent. In post-grant proceedings, I am helping to ensure that issued patents have the intended effect of promoting innovation. As a patent examiner, I felt a great deal of satisfaction when I was able to grant an applicant a patent. As an APJ, I have the same feeling of satisfaction when I render a fair and just decision.

As a long-time employee of the USPTO, I am proud to serve in an agency that does the important, constitutional work of promoting American innovation. As President Barack Obama said, "[o]ur single greatest asset is the innovation and the ingenuity and creativity of the American people."<sup>3</sup>

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<sup>3</sup> Address at the Export-Import Bank's Annual Conference (March 11, 2010).