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# PTAB HIGHLIGHTS

New developments in post-issuance proceedings

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## “Your PTAB Judges Will Be Experts” – Right? ... Not So Fast

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July 26, 2016 — One of the alleged benefits of *inter partes* reviews (IPRs) of patents is that the Patent Trial and Appeal Board (PTAB) is filled with judges who are experts in the technologies they are handling. Right? ... Not so fast.

First, background. The PTAB has an organization established by patent law, 35 U.S.C. § 6. “There shall be in the Office a Patent Trial and Appeal Board. The Director, the Deputy Director, the Commissioner for Patents, the Commissioner for Trademarks, and the administrative patent judges shall constitute the Patent Trial and Appeal Board.” After making four specific U.S. Patent and Trademark Office (PTO) officers and an unstated number of administrative patent judges (APJs) members of the PTAB, the law continues with a spare statement of two qualifications for the APJs. “The administrative patent judges shall be persons of competent legal knowledge and scientific ability ...” (The law also requires three member PTAB IPR panels.)

The PTO’s document, “Organization of the Board,” states that, tripling in size in the last three years due to IPRs and other AIA trials, the PTAB includes among the APJs a Chief APJ, a Deputy Chief APJ, Vice Chief APJs, Lead APJs, and then regular APJs. See <http://www.uspto.gov/sites/default/files/documents/Organizational%20Structure%20of%20the%20Board%20May%2012%202015.pdf>. (They are assisted by Supervisory Patent Attorneys, Patent Attorneys, Paralegal Specialists, Legal Instrument Examiners, Administrators, Analysts, and Support Specialists.) The Chief and Deputy Chief APJs are the “Office of the Chief Judge.” The Deputy reports to the Chief.

The PTO has a Manual of Patent Classification and Examiner Group Art Units. Just like these divisions of technology and personnel, the PTAB has 12 sections of technology. “Each section covers a broad technical focus.” Each must cover a broad focus, as the U.S. Patent Classification (USPC) system breaks technology into classes from 002 to 987 and beyond. There are two PTAB divisions each made up of six sections, such that there are two Vice Chiefs for the divisions, and 12 Lead APJs, one Lead for each “broad technical focus.”

Doing the math, with about 225 APJs at the PTAB, see e.g. <http://www.fitcheven.com/?t=40&an=38049&anc=99&format=xml&p=5488>, deducting the Chief, Deputy Chief, and two Vice Chiefs as largely administrative, and dividing the remaining 221 APJs by 12 for the 12 sections, there are about 18 APJs per section. Assuming about a hundred classes of technology as indicated by the USPC system, divided by 12, each section of 18 APJs is responsible for about 10 classes of technology.

Up to here, the organization of the PTAB seems neat and orderly. The “Organization of the Board” does state that “many judges in a section may carry dockets that span a number of technical disciplines,” but given the breadth of the sections, that is to be expected. The APJs in a section must work across many USPC classes.

But the “Organization’s” statement seems to be euphemism. What is the truth, by examples from IPRs to date, is that PTAB APJs sometimes judge patents on technologies far outside their educations and experiences. As just one example, consider IPRs 2016-00431, 00432, and 00433. All three of these IPRs concern injection molding machine patents. More specifically, they concern “valve gates” and the drive mechanisms for them. From an institution decision, in one embodiment, a “transmission assembly comprises a plurality of transmission rollers that include annular rings which extend axially along the length of each roller, and a rotatable elongated cylinder than includes a central threaded bore.” What is the technology? Mechanical, of course — injection molding machines, drives, transmission assemblies.

But the backgrounds of the APJs can be traced through the files of other IPRs, LinkedIn, the PTO attorney search function, and many other sources. One of the APJs in these IPRs judged a patent in another IPR on a “process for the removal of permanganate reducing compounds ... and alkyl iodides formed by the carbonylation of methanol in the presence of a Group VIII metal carbonylation catalyst.” In another, he judged a patent on “a process for the manufacture of diesel range hydrocarbons from bio oils and fats, commonly called ‘biodiesel.’” He was the attorney of record for a patent for monoclonal antibodies. Before becoming an APJ, he was a patent attorney and then assistant general counsel for a biopharmaceutical company. Another of the three APJs had a bachelor’s degree in chemical engineering and a master’s degree in biotechnology. The third had a bachelor’s degree in chemistry.

Plainly, not one of the three APJs was educated or had experience in engineering in relation to injection molding machines, transmissions, rollers, rings, cylinders, bores, and mechanical engineering. Striking is that all three have in common that they are involved in chemical and biotechnology matters. They must be among the “many judges in a section (theirs likely biotechnology) [who] carry dockets that span a number of technical disciplines (theirs chemistry, chemical engineering, biopharmaceuticals, biotechnology *and injection molding*).”

If you think that in an IPR your APJs will have education or experience in your technical area, or even in the relevant engineering discipline from among the mechanical, electrical, chemical, etc. disciplines, think again. The patent law requires of your APJs only that they have “competent legal knowledge and scientific *ability*.” They aren’t required to have *competent scientific educations or experiences in the technologies they judge*. Consistently, be forewarned: your injection molding machine PTAB APJs may not have any mechanical engineering education or experience whatsoever — more broadly, your [fill in your technology] PTAB APJs may not have any [fill in your engineering discipline] education or experience whatsoever.

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*The Leahy-Smith America Invents Act established new patent post-issuance proceedings, including the inter partes review, post grant review and transitional program for covered business method patents, that offer a less costly, streamlined alternative to district court litigation. With the U.S. Patent and Trademark Office’s Patent Trial and Appeal Board conducting a large and increasing number of these proceedings, and with the law developing rapidly, Banner & Witcoff will offer frequent summaries of the board’s significant decisions and subsequent appeals at the U.S. Court of Appeals for the Federal Circuit.*



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